

Exhibit 1

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CO., LTD., SAMSUNG ELECTRONICS
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.
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CASE NO. 11-cv-01846-LHK

**SAMSUNG'S PATENT LOCAL RULE
3-3 AND 3-4 DISCLOSURES**

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1 Pursuant to the Court's Minute Order and Case Management Order, and Patent Local Rules
2 3-3 and 3-4, Defendants Samsung Electronic Co., Ltd., Samsung Electronics America, Inc., and
3 Samsung Telecommunications America, LLC (collectively, "Samsung") submit invalidity
4 contentions and document productions for U.S. Patent Numbers 7,812,828 (the "828 Patent");
5 6,493,002 (the "002 Patent"); 7,469,381 (the "381 Patent"); 7,844,915 (the "915 Patent");
6 7,853,891 (the "891 Patent"); 7,663,607 (the "607 Patent"); 7,663,163 (the "163 Patent"); and
7 7,920,129 (the "129 Patent") (collectively, "Apple Asserted Patents"). Apple Inc. is referred to
8 herein as "Apple" or "Plaintiff."

9 **PATENT LOCAL RULE 3-3 DISCLOSURES**

10 1. This disclosure is directed to preliminary invalidity and unenforceability issues
11 only and does not address claim construction or non-infringement. Samsung reserves all rights
12 with respect to such issues, including but not limited to its position that claims of the Apple
13 Asserted Patents are to be construed in a particular manner and are not infringed.

14 2. These invalidity contentions are preliminary and are based on Samsung's current
15 knowledge, understanding, and belief as to the facts and information available as of the date of
16 these contentions. Samsung has not yet completed its investigation, discovery, or analysis of
17 information related to this action, and additional discovery may require Samsung to supplement or
18 amend its invalidity contentions. For instance, Apple has failed to produce prior art, invalidity
19 contentions, expert reports, dispositive motions, prehearing and posthearing briefs, and other
20 relevant materials from its litigations with HTC, Motorola, and Nokia, which include many of the
21 Apple Asserted Patents and related patents. As one example, Apple has not yet produced
22 materials relating to NeXT computers, including the NeXTSTEP source code for multiple versions
23 of the prior art NeXTSTEP operating system, even though Samsung has requested this prior art.
24 Samsung reserves the right to amend or supplement its charts once it gains access to relevant
25 materials Apple has not yet produced. While Samsung has made a good-faith effort to provide a
26 comprehensive list of prior art relevant to this case, Samsung reserves the right to modify or
27 supplement its prior art list and invalidity contentions at a later time with or based upon pertinent
28 information that may be subsequently discovered from Apple or third-parties. Moreover,

1 discovery is ongoing and Samsung reserves the right to pursue all other defenses that may be
2 available to it, including but not limited to defenses that the Apple Asserted Patents are
3 unenforceable based on laches, estoppels, waiver acquiescence, inequitable conduct, patent
4 misuse, patent exhaustion, express or implied license, or any other grounds.

5 3. Any invalidity analysis depends, ultimately, upon claim construction, which is a
6 question of law reserved for the Court. The asserted claims have not yet been construed by the
7 Court in this case and, thus, Samsung has not yet had the opportunity to compare the asserted
8 claims of the Apple Asserted Patents (as construed by the Court) with the prior art. Samsung
9 reserves the right to amend, supplement, or materially modify its invalidity contentions after the
10 claims have been construed by the Court. Samsung also reserves the right to amend, supplement,
11 or materially modify its invalidity contentions based on any claim construction positions that
12 Apple may take in this case. Samsung also reserves the right to assert that a claim is indefinite,
13 not enabled, or fails to meet the written description requirement based on any claim construction
14 position Plaintiff may take in this case or based on any claim construction the Court may adopt in
15 this case.

16 4. Samsung's invalidity contentions are directed to the claims asserted by Plaintiff that
17 are identified in Plaintiff's August 26, 2011 Disclosure of Asserted Claims and Infringement
18 Contentions. In its Infringement Contentions, however, Plaintiff states that it "reserves the right to
19 supplement or amend these disclosures as further facts are revealed during the course of this
20 litigation." Samsung therefore reserves the right to modify, amend, supplement or otherwise alter
21 its invalidity contentions in the event that Plaintiff supplements or amends its infringement
22 contentions or take a claim construction position that is different than or in addition to those set
23 forth in its infringement contentions, or for any other reason constituting good cause to modify,
24 amend, supplement or otherwise alter these invalidity contentions.

25 5. Samsung further contends that Plaintiff appears to be pursuing overly broad
26 constructions of the asserted claims of the Apple Asserted Patents in an effort to piece together an
27 infringement claim where none exists and to accuse products that do not practice the claims as
28 properly construed. At the same time, Plaintiff's infringement contentions are in most places too

1 general and vague to discern exactly how Plaintiff contends each accused product practices each
2 element of the asserted claims. Samsung has requested that Plaintiff remedy the deficiencies in its
3 infringement contentions, but Plaintiff has not done so. Accordingly, these invalidity contentions
4 are not intended to be, and are not, an admission that the asserted claims are infringed by any of
5 Samsung's products or technology, that any particular feature or aspect of any of the accused
6 products practices any elements of the asserted claims, or that any of Plaintiff's proposed
7 constructions are supportable or proper. To the extent that any of the prior art references disclose
8 the same functionality or feature of any of the accused products, Samsung reserves the right to
9 argue that said feature or functionality does not practice any element of any of the asserted claims,
10 and to argue, in the alternative, that if said feature or functionality is found to practice any element
11 of any of the asserted claims of the Apple Asserted Patents, then the prior art reference
12 demonstrates that that element is not novel to the invention and is not patentable.

13 6. Attached hereto are representative claim charts that demonstrate how the asserted
14 claims of the Apple Asserted Patents are invalid in view of certain prior art. The references cited
15 in the attached claim charts may disclose the limitations of the asserted claims of the Apple
16 Asserted Patents either expressly and/or inherently. Moreover, the suggested obviousness
17 combinations are in the alternative to Samsung's anticipated contentions. These obviousness
18 combinations should not be construed to suggest that any reference included in any combination is
19 not anticipatory in its own right.

20 7. In this action, Plaintiff asserts that Samsung infringes certain claims of the Apple
21 Asserted Patents. Although Plaintiff asserts that these claims are either literally infringed or
22 infringed under the doctrine of equivalents, Plaintiff has failed to provide any analysis or
23 explanation regarding alleged infringement of the asserted claims of the patents-in-suit under the
24 doctrine of equivalents. Samsung reserves its rights to modify, amend, supplement or otherwise
25 alter its preliminary infringement contentions in the event Plaintiff is permitted to modify, amend,
26 supplement, or clarify their infringement contentions with respect to direct infringement (literal
27 and under the doctrine of equivalents).

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1 8. Samsung is providing invalidity contentions only for the claims asserted by
2 Plaintiff, but hereby reserves the right to seek invalidation of all claims in each of the Apple
3 Asserted Patents.

4 9. Samsung reserves the right to modify, amend, or supplement these disclosures as
5 additional information becomes available, and as its discovery and investigation proceed.

6 **I. THE '828 PATENT**

7 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

8 At this time, Samsung contends that at least the following prior art references anticipate or
9 render obvious, either alone or in combination, the asserted claims of the '828 Patent:
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11 **1. Patent References¹**

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
A-1	US	4,618,989	10/21/1986	1/21/1983
A-2	US	5,488,204	1/30/1996	6/8/1992
A-3	US	5,583,946	12/10/1996	9/30/1993
A-4	US	5,638,093	6/10/1997	12/7/1993
A-5	US	5,734,751	3/31/1998	7/22/1994
A-6	US	5,812,118	9/22/1998	6/25/1996
A-7	US	5,825,352	10/20/1998	1/4/1996

17 **2. Publications²**

Chart No(s).	Title	Date of Publication	Author	Publisher
A-8	Machine Vision: Theory, Algorithms, Practicalities (2d Ed.) (ISBN 012206092X)	Nov. 1996	E.R. Davies	Academic Press
A-9	Interpretation of Tactile Data from an FSR Pressure Pad Transducer Using Image Processing Techniques, Master's Thesis	Nov. 1994	Apurva M. Desai	Simon Fraser University, Canada

24 Additional prior art that has not been charted, but is still relevant to the invalidity of the
25 '828 Patent is listed in Exhibit B. Samsung reserves the right to amend these invalidity

26 ¹ Samsung incorporates by reference all prior art references cited in the patents listed herein
27 and/or their file histories.

28 ² Samsung incorporates by reference all prior art references identified in the publications
listed herein.

1 contentions to assert these references depending on the claim construction and infringement
2 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these
3 references in combination with other references to render the claims of the '828 Patent obvious in
4 the event Apple takes the position that certain claim limitations are missing from the references
5 charted in Exhibits A and C.

6 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**
7 **Obvious the Asserted Claims**

8 Plaintiff asserts claims 1-3, 6, 9-13, 15-16, 20-31, and 34-35 of the '828 Patent against
9 Samsung in this lawsuit. All of those claims are invalid because the '828 Patent fails to meet one
10 or more of the requirements for patentability. The individual bases for invalidity are provided
11 below and in the claim charts attached as Exhibits A and C. Each of the foregoing listed prior art
12 documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art
13 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

14 Although Samsung has identified at least one citation per limitation for each reference,
15 each and every disclosure of the same limitation in the same reference is not necessarily identified.
16 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
17 references, even where a reference may contain additional support for a particular claim element.
18 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
19 in the context of other publications and literature. Thus, to understand and interpret any specific
20 statement or disclosure within a prior art reference, such persons would rely on other information
21 within the reference, along with other publications and their general scientific knowledge.
22 Samsung may rely upon uncited portions of the prior art references and on other publications and
23 expert testimony to provide context, and as aids to understanding and interpreting the portions that
24 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
25 publications, and the testimony of experts to establish that a person of ordinary skill in the art
26 would have been motivated to modify or combine certain of the cited references so as to render the
27 claims obvious.
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1. Anticipation

Some or all of the asserted claims of the '828 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts included in Exhibit A, which identify specific examples of where each limitation of the asserted claims is found in the prior art references. As explained above, the cited portions of prior art references identified in the attached claim charts are exemplary only and representative of the content and teaching of the prior art references, and should be understood in the context of the reference as a whole and as they would be understood by a person of ordinary skill in the art.

2. Obviousness

To the extent any limitation is deemed not to be exactly met by an item of prior art listed above and in Exhibit A, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

In addition, the references identified above render one or more asserted claims of the '828 Patent obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or all of the references identified above, including all references in Exhibits A, B, and C, for purposes of obviousness depending on the Court's claim construction, positions taken by Apple during this litigation, and further investigation and discovery.

Moreover, to the extent the foregoing references are found not to anticipate the asserted claims, the foregoing references render the asserted claims obvious either alone or in combination with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

1 at the time of the alleged invention of the asserted claims of the '828 Patent to combine the various
2 references cited herein so as to practice the asserted claims of the '828 Patent.

3 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
4 alone or in combination with other references, are outlined below and included in Exhibits A and
5 C, which includes exemplary claim charts for the asserted claims of the '828 Patent showing
6 specifically where in each reference or combinations of references each asserted claim is found,
7 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
8 charts in Exhibit A and C include the motivation to combine references.
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10 In particular, Samsung contends that the asserted claims of the '828 Patent would have
11 been obvious in view of the prior art references identified above. For example, Exhibit C includes
12 exemplary claim charts that describe how the asserted claims of the '828 Patent would have been
13 obvious in view of the following references alone or in combination:
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- 15 • All references identified in Exhibit A, if found not to anticipate the claims of the
16 '828 Patent, render the claims of the '828 Patent obvious alone;
- 17 • Exhibit C-1: U.S. Patent No. 5,168,531 (“Sigel '531”) and Baker '951, Bisset
18 '352, Bertram '157, Davies, Desai, Duwaer '381, and/or Tsukune;
- 19 • Exhibit C-2: U.S. Patent No. 6,738,154 (“Venable '154”) and Baker '951, Bisset
20 '352, Bertram '157, Davies, Desai, Duwaer '381, Konrad, Shieh '118, Takahashi
21 '093, and/or Tsukune '989

22 In addition to the specific combinations of prior art and the specific combinations of
23 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
24 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
25 disclosed within the prosecution history of the references cited herein. These obviousness
26 combinations reflect Samsung's present understanding of the potential scope of the claims that
27 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's
28 interpretation of the patent claims.

1 Samsung also reserves the right to amend or supplement these contentions regarding
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
13 item of prior art each limitation of each asserted claim is found, including for each limitation that
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits A
16 and C.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '828
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
20 disclosures based on further investigation and discovery.

21 **3. Invalidity Based on 35 U.S.C. § 101**

22 The asserted claims of the '828 Patent are invalid under 35 U.S.C. § 101 because they only
23 claim abstract ideas. For example, each asserted claim of the '828 Patent contains the limitation
24 “mathematically fit[ting] an ellipse” or “fitting an ellipse.”
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1 4. **Invalidity Based on Enablement or Written Description Under 35**
2 **U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35**
3 **U.S.C. § 112(2)**

4 Based on Samsung's present understanding of Plaintiff's infringement contentions,
5 Samsung asserts that claims 1-3, 6, 9-13, 15-16, and 20-31 of the '828 Patent are invalid for
6 reciting at least the following claim terms/phrases:

- 7 • “mathematically fit[ting] an ellipse to at least one of the [one or more] pixel
8 groups”
- 9 • “transmit[ting] one or more ellipse parameters as a control signal to an electronic or
10 electromechanical device”
- 11 • “means for producing a proximity image representing a scan of a plurality of
12 electrodes of a touch-sensitive surface”
- 13 • “means for segmenting the proximity image into one or more pixel groups”
- 14 • “means for fitting an ellipse to at least one of the pixel groups”
- 15 • “the touch object comprises at least a portion of a hand”
- 16 • “the touch object comprises at least a portion of one or more fingers”
- 17 • “the touch object comprises at least a portion of a body part”
- 18 • “the body part comprises one or more of a hand, a finger, an ear, or a cheek”
- 19 • “means for transmitting one or more ellipse parameters as a control signal to an
20 electronic or electromechanical device”
- 21 • “means for tracking a path of one or more pixel groups through a plurality of time-
22 sequenced proximity images”
- 23 • “means for fitting an ellipse to at least one of the pixel groups in a plurality
24 successive proximity images”
- 25 • “means for tracking a change in one or more ellipse parameters through a plurality
26 of time-sequenced proximity images”

27 These claim terms/phrases as apparently construed by Apple violate the written description,
28 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
one or more of these claim terms/phrases are indefinite because they are inconsistent with and

1 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
 2 constructions of the claims, any person of ordinary skill in the art at the time of the invention
 3 would not understand what is claimed, even when the claims are read in light of the specification.
 4 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
 5 of the asserted claims in which these claim terms/phrases appear lack written description because
 6 the specification of the '828 Patent demonstrates that the patentee neither conceived of nor
 7 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
 8 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
 9 claims in which these claim terms/phrases appear are invalid because the specification fails to
 10 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
 11 or with which it is most nearly connected, to implement the invention without undue
 12 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

13 **II. THE '002 PATENT**

14 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

15 At this time, Samsung contends that at least the following prior art references anticipate or
 16 render obvious, either alone or in combination, the asserted claims of the '002 Patent:

17 **1. Patent References³**

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
D-1	US	5,754,174	05/19/1998	08/27/1992
D-2	US	5,825,357	10/20/1998	12/13/1993
D-3	US	5,745,096	04/28/1998	06/03/1991
D-4	US	5,542,088	07/30/1996	04/29/1994
D-5	US	5,491,795	2/13/1996	05/04/1993

22 **2. Publications⁴**

Chart No(s).	Title	Date of Publication	Author	Publisher
D-6	Using PC Tools For Windows	July 1993	Halliday, Caroline, et. al.	Que Corporation

26 ³ Samsung incorporates by reference all prior art references cited in the patents listed herein
 27 and/or their file histories.

28 ⁴ Samsung incorporates by reference all prior art references identified in the publications
 listed herein.

1 in the context of other publications and literature. Thus, to understand and interpret any specific
2 statement or disclosure within a prior art reference, such persons would rely on other information
3 within the reference, along with other publications and their general scientific knowledge.
4 Samsung may rely upon uncited portions of the prior art references and on other publications and
5 expert testimony to provide context, and as aids to understanding and interpreting the portions that
6 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
7 publications, and the testimony of experts to establish that a person of ordinary skill in the art
8 would have been motivated to modify or combine certain of the cited references so as to render the
9 claims obvious.

10 4. **Anticipation**

11 Some or all of the asserted claims of the '002 Patent are invalid as anticipated under 35
12 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts
13 included in Exhibit D, which identify specific examples of where each limitation of the asserted
14 claims is found in the prior art references. As explained above, the cited portions of prior art
15 references identified in the attached claim charts are exemplary only and representative of the
16 content and teaching of the prior art references, and should be understood in the context of the
17 reference as a whole and as they would be understood by a person of ordinary skill in the art.

18 5. **Obviousness**

19 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
20 above and in Exhibit D, then any purported differences are such that the claimed subject matter as
21 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in
22 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
23 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

24 In addition, the references identified above render one or more asserted claims of the '002
25 Patent obvious when the references are read in combination with each other, and/or when read in
26 view of the state of the art and knowledge of those skilled in the art. Each and every reference
27 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
28 references disclosed above may be combined to render obvious (and therefore invalid) each of

1 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
2 all of the references identified above, including all references in Exhibits D, E, and F, for purposes
3 of obviousness depending on the Court's claim construction, positions taken by Apple during this
4 litigation, and further investigation and discovery.

5 Moreover, to the extent the foregoing references are found not to anticipate the asserted
6 claims, the foregoing references render the asserted claims obvious either alone or in combination
7 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
8 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
9 at the time of the alleged invention of the asserted claims of the '002 Patent to combine the various
10 references cited herein so as to practice the asserted claims of the '002 Patent.

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12 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
13 alone or in combination with other references, are outlined below and included in Exhibits D and
14 F, which includes exemplary claim charts for the asserted claims of the '002 Patent showing
15 specifically where in each reference or combinations of references each asserted claim is found,
16 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
17 charts in Exhibit D and F include the motivation to combine references.

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19 In particular, Samsung contends that the asserted claims of the '002 Patent would have
20 been obvious in view of the prior art references identified above. For example, Exhibit F includes
21 exemplary claim charts that describe how the asserted claims of the '002 Patent would have been
22 obvious in view of the following references alone or in combination:

- 23 • All references identified in Exhibit D, if found not to anticipate the claims of the
24 '002 Patent or render the claims of the '002 Patent obvious alone;
- 25 • Exhibit F-1: U.S. Patent No. 5,394,521 ("Henderson '521"); U.S. Patent No.
26 5,233,687 ("Henderson '687"); U.S. Patent No. 5,072,412 ("Henderson '412"); D.A.
27 Henderson, Jr. & S. Card, K., "Rooms: The Use of Multiple Virtual Workspaces to
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1 Reduce Space Contention in a Window-Based Graphical User Interface," *ACM*
2 *Transactions on Graphics*, vol. 5, no. 3, pp. 210-243 (Jul. 1986) ("Henderson
3 1986); and Stuart K. Card & Austin Henderson, Jr., "A Multiple, Virtual-
4 Workspace Interface to Support User Task Switching," *CHI '87 Proceedings of the*
5 *SIGCHI/GI conference on Human factors in computing systems and graphics*
6 *interface* (1987) ("Henderson 1987").

- 7 • Exhibit F-2: "Archie RISC OS," PERSONAL COMPUTER WORLD, January 1989;
8 Acorn A3000 Welcome Guide; Acorn A5000 Welcome Guide; RISC OS 2 User
9 Guide; RISC OS 3 User & Apps Guide; RISC OS 2 Programmer's Reference
10 Manual; and RISC OS 3 Programmer's Reference Manual.

11 In addition to the specific combinations of prior art and the specific combinations of
12 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
13 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
14 disclosed within the prosecution history of the references cited herein. These obviousness
15 combinations reflect Samsung's present understanding of the potential scope of the claims that
16 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's
17 interpretation of the patent claims.

18 Samsung also reserves the right to amend or supplement these contentions regarding
19 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
20 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
21 not identified what elements or combinations it alleges were not known to one of ordinary skill in
22 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
23 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
24 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
25 of the same, or that the limitation is disclosed in another of the references disclosed above and in
26 combination would have rendered the asserted claim obvious.

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- 1 • "independently active of any application program"
- 2 • "private window layer"
- 3 • "control strip"
- 4 • Claim 25: "an indicia generation logic coupled to the data display screen"

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6 These claim terms/phrases as apparently construed by Apple violate the written description,
7 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

8 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
9 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
10 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
11 constructions of the claims, any person of ordinary skill in the art at the time of the invention
12 would not understand what is claimed, even when the claims are read in light of the specification.
13 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
14 of the asserted claims in which these claim terms/phrases appear lack written description because
15 the specification of the '002 Patent demonstrates that the patentee neither conceived of nor
16 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
17 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
18 claims in which these claim terms/phrases appear are invalid because the specification fails to
19 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
20 or with which it is most nearly connected, to implement the invention without undue
21 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

22 **III. THE '381 PATENT**

23 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

24 At this time, Samsung contends that at least the following prior art references anticipate or
25 render obvious, either alone or in combination, the asserted claims of the '381 Patent:

1 content and teaching of the prior art references, and should be understood in the context of the
2 reference as a whole and as they would be understood by a person of ordinary skill in the art.

3 **4. Obviousness**

4 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
5 above and in Exhibit G, then any purported differences are such that the claimed subject matter as
6 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in
7 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
8 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

9 In addition, the references identified above render one or more asserted claims of the '381
10 Patent obvious when the references are read in combination with each other, and/or when read in
11 view of the state of the art and knowledge of those skilled in the art. Each and every reference
12 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
13 references disclosed above may be combined to render obvious (and therefore invalid) each of
14 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
15 all of the references identified above, including all references in Exhibits G and H, for purposes of
16 obviousness depending on the Court's claim construction, positions taken by Apple during this
17 litigation, and further investigation and discovery.

18 Moreover, to the extent the foregoing references are found not to anticipate the asserted
19 claims, the foregoing references render the asserted claims obvious either alone or in combination
20 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
21 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
22 at the time of the alleged invention of the asserted claims of the '381 Patent to combine the various
23 references cited herein so as to practice the asserted claims of the '381 Patent.

24
25 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
26 alone or in combination with other references, are outlined below and included in Exhibits G,
27 which includes exemplary claim charts for the asserted claims of the '381 Patent showing
28

1 specifically where in each reference or combinations of references each asserted claim is found,
2 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
3 charts in Exhibit G include the motivation to combine references.

4 In particular, Samsung contends that the asserted claims of the '381 Patent would have
5 been obvious in view of the prior art references identified above. For example, the asserted claims
6 of the '381 Patent would have been obvious in view of the following references alone or in
7 combination:
8

- 9 • All references identified in Exhibit G, if found not to anticipate the claims of the
10 '381 Patent, render the claims of the '381 Patent obvious alone;

11 In addition to the specific combinations of prior art and the specific combinations of
12 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
13 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
14 disclosed within the prosecution history of the references cited herein. These obviousness
15 combinations reflect Samsung's present understanding of the potential scope of the claims that
16 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's
17 interpretation of the patent claims.

18 Samsung also reserves the right to amend or supplement these contentions regarding
19 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
20 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
21 not identified what elements or combinations it alleges were not known to one of ordinary skill in
22 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
23 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
24 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
25 of the same, or that the limitation is disclosed in another of the references disclosed above and in
26 combination would have rendered the asserted claim obvious.

27
28

- 1 • “first direction”
- 2 • "second direction"
- 3 • “display” or “displayed” or “displaying”
- 4 • "translate" or "translated" or "translating" or "translation"
- 5 • "first portion" or "second portion" or "third portion" or "fourth portion"
- 6 • "visually distinct"
- 7 • "programs"
- 8 • "instructions"
- 9 • "computer readable storage medium"
- 10 • "near the touch screen"
- 11 • "elastically attached"
- 12 • "damped motion"
- 13 • "in accordance with a simulation of an equation of motion having friction"

14 These claim terms/phrases as apparently construed by Apple violate the written description,
15 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

16 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
17 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
18 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
19 constructions of the claims, any person of ordinary skill in the art at the time of the invention
20 would not understand what is claimed, even when the claims are read in light of the specification.
21 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
22 of the asserted claims in which these claim terms/phrases appear lack written description because
23 the specification of the '381 Patent demonstrates that the patentee neither conceived of nor
24 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
25 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
26
27
28

claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

IV. THE '915 PATENT

A. Local Patent Rule 3-3(a): Identification of Prior Art

At this time, Samsung contends that at least the following prior art references anticipate or render obvious, either alone or in combination, the asserted claims of the '915 Patent:

1. Patent References¹²

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
J-6	Japan	(Publication No.) 2000-163031	(Published) June 16, 2000	(Filed) November 25, 1998

2. Publications¹³

Chart No(s).	Title	Date of Publication	Author	Publisher
J-1	<i>Multi-user, Multi-display Interaction with a Single-user, Single-display Geospatial Application.</i> Reprinted as <u>Mitsubishi Electronic Research Laboratories ("MERL") Technical Report No. TR2006-083.</u>	October 15, 2006	Chris Forlines, C., Esenther, A., Shen, C., Wigdor, D., and Ryall, K.	UIST '06 (ACM Oct. 15-18 2006) printed in original at pp. 273-276; reprinted by Mitsubishi
J-1	<i>DiamondTouch: a multi-user touch technology</i> Reprinted as <u>MERL TR No. TR2003-125.</u>	2001 (original); 2003 (reprinting)	P.H. Dietz and Leigh, D.	<u>Proc ACM UIST</u> , (ACM 2001) printed in original at pp. 219-226,; reprinted by Mitsubishi
J-1	<i>DiamondTouch SDK: Support for Multi-User, Multi-Touch Applications,</i> <u>MERL TR No. TR2003-125</u>	2003	Alan Esenther, Cliff Forlines, Kathy Ryall, Sam Shipman.	Mitsubishi
J-1	<i>Enabling interaction with single</i>	December	Edward Tse,	<u>Advanced</u>

¹² Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

¹³ Samsung incorporates by reference all prior art references identified in the publications listed herein.

Chart No(s).	Title	Date of Publication	Author	Publisher
	<i>user applications through speech and gestures on a multi-user tabletop. Reprinted as <u>MERL TR No. TR2005-130</u></i>	2005	Chia Shen, Saul Greenberg, Clifton Forlines:	<u>Visual Interfaces</u> ; reprinted by Mitsubishi
J-1	<i>Multi-User Multi-Touch Games on DiamondTouch with the DTFlash Toolkit , printed as <u>MERL Technical Report No. TR2005-105</u></i>	December 2005	Alan Esenther and Kent Wittenburg,	Mitsubishi
J-2	<i>SmartSkin: An Infrastructure for Freehand Manipulation on Interactive Surfaces</i>	2002	Jun Rekimoto	<u>Proceedings of the SIGCHI Conference on Human Factors in Computing Systems: Changing our world, Changing ourselves,</u>
J-2	<i>Concurrent Manipulation of Multiple Components on Graphical User Interface, <u>PhD Dissertation</u></i>	2006	K. Fukuchi	Tokyo Institute of Technology
J-2	<i>Interaction Techniques for SmartSkin</i>	2002	K. Fukuchi and J. Rekimoto	<u>Proceedings of UIST'02, 2002</u>
J-3	<i>The Automatic Recognition of Gestures, <u>PhD Dissertation</u></i>	1991	Dean Rubine	<u>N/A</u>
J-3	<i>Specifying Gestures of Example</i>	July 1, 1991	Dean Rubine	<u>Computer Graphics Vol. 25, No. 4</u>
J-3	<i>Integrating Gesture Recognition and Direct Manipulation</i>	1991	Dean Rubine	<u>Proceedings of '91 USENIX Technical Conference (Summer)</u>
J-3	<i>Combining Gestures and Direct Manipulation</i>	1992	Dean Rubine	<u>CHI-92</u>
J-4	<i>HybridTouch: an intuitive manipulation technique for PDAs using their front and rear surfaces</i>	2006	Masanori Sugimoto and Keiichi Hiroki	<u>Proceedings of the 8th Conference on Human-Computer Interaction with Mobile Devices and Services 2006 ("MobileHCI" '06).</u>
J-5	<i>. <u>Multi-touch interaction wall</u></i>	2006	Jefferson Y. Han.	ACM SIGGRAPH

Chart No(s).	Title	Date of Publication	Author	Publisher
				2006 Emerging technologies (SIGGRAPH '06). ACM, New York, NY, USA, , Article 25 . ("Multi-touch Wall")
J-5	<i>Synthesis and control on large scale multi-touch sensing displays.</i>	2006	Philip L. Davidson and Jefferson Y. Han	In Proceedings of the 2006 conference on New interfaces for musical expression (NIME '06).
J-5	<i>Low-cost multi-touch sensing through frustrated total internal reflection.</i>	2006	Jefferson Y. Han	In Proceedings of the 18th annual ACM symposium on User interface software and technology (UIST '05).
J-5	<i>Unveiling the Genius of Multi-Touch Interface Design (a/k/a "TED Video")</i>	2006	Jefferson Y. Han	available at http://www.ted.com/talks/jeff_han_demos_his_breakthrough_touchscreen.html

3. Systems

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '915 Patent, including documents and source code describing the same:

Chart No(s).	System	Date Offered	Offering Entity
J-1	Diamond Touch Table	At Least as Early as November 2002	Mitsubishi Electronic Research Laboratory
J-2	Sony SmartSkin System	At Least as Early as 2002	Sony Corp.
J-3	Dean Rubine GDP and MDP Systems	1991	Dean Rubine/SGI Inc.
J-4	HybridTouch System	2006	Various
J-5	Jeff Han Multi-Touch System(s)	2004	Jeff Han, Perceptive Pixel, New York University

1 Additional prior art that has not been charted, but is still relevant to the invalidity of the
2 '915 Patent is listed as background or combinatory references in Exhibits J-1 through J-6.
3 Samsung reserves the right to amend these invalidity contentions to assert these references
4 depending on the claim construction and infringement positions Apple may take as the case
5 proceeds. Moreover, Samsung reserves the right to use these references in combination with other
6 references to render the claims of the '915 Patent obvious in the event Apple takes the position
7 that certain claim limitations are missing from the references charted in Exhibits J and L.

8 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**
9 **Obvious the Asserted Claims**

10 Plaintiff asserts claims 1-21 of the '915 Patent against Samsung in this lawsuit. All of
11 those claims are invalid because the '915 Patent fails to meet one or more of the requirements for
12 patentability. The individual bases for invalidity are provided below and in the claim charts
13 attached as Exhibit J. Each of the foregoing listed prior art documents, the underlying work,
14 and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35
15 U.S.C. § 102 and/or 35 U.S.C. § 103.

16 Although Samsung has identified at least one citation per limitation for each reference,
17 each and every disclosure of the same limitation in the same reference is not necessarily identified.
18 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
19 references, even where a reference may contain additional support for a particular claim element.
20 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
21 in the context of other publications and literature. Thus, to understand and interpret any specific
22 statement or disclosure within a prior art reference, such persons would rely on other information
23 within the reference, along with other publications and their general scientific knowledge.
24 Samsung may rely upon uncited portions of the prior art references and on other publications and
25 expert testimony to provide context, and as aids to understanding and interpreting the portions that
26 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
27 publications, and the testimony of experts to establish that a person of ordinary skill in the art
28

1 would have been motivated to modify or combine certain of the cited references so as to render the
2 claims obvious.

3 4. **Anticipation**

4 Some or all of the asserted claims of the '915 Patent are invalid as anticipated under 35
5 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts
6 included in Exhibit J, which identify specific examples of where each limitation of the asserted
7 claims is found in the prior art references. As explained above, the cited portions of prior art
8 references identified in the attached claim charts are exemplary only and representative of the
9 content and teaching of the prior art references, and should be understood in the context of the
10 reference as a whole and as they would be understood by a person of ordinary skill in the art.

11 5. **Obviousness**

12 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
13 above and in Exhibit J, then any purported differences are such that the claimed subject matter as a
14 whole would have been obvious to one skilled in the art at the time of the alleged invention, in
15 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
16 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

17 In addition, the references identified above render one or more asserted claims of the '915
18 Patent obvious when the references are read in combination with each other, and/or when read in
19 view of the state of the art and knowledge of those skilled in the art. Each and every reference
20 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
21 references disclosed above may be combined to render obvious (and therefore invalid) each of
22 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
23 all of the references identified above, including all references in Exhibits J and K, for purposes of
24 obviousness depending on the Court's claim construction, positions taken by Apple during this
25 litigation, and further investigation and discovery.

26 Moreover, to the extent the foregoing references are found not to anticipate the asserted
27 claims, the foregoing references render the asserted claims obvious either alone or in combination
28

1 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
2 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
3 at the time of the alleged invention of the asserted claims of the '915 Patent to combine the various
4 references cited herein so as to practice the asserted claims of the '915 Patent.

5
6 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
7 alone or in combination with other references, are outlined below and included in Exhibits J and L,
8 which includes exemplary claim charts for the asserted claims of the '915 Patent showing
9 specifically where in each reference or combinations of references each asserted claim is found,
10 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
11 charts in Exhibit J and L include the motivation to combine references.

12
13 In particular, Samsung contends that the asserted claims of the '915 Patent would have
14 been obvious in view of the prior art references identified above. For example, Exhibit L includes
15 exemplary claim charts that describe how the asserted claims of the '915 Patent would have been
16 obvious in view of the following references alone or in combination:

- 17 • All references identified in Exhibit J-1 through J-6, if found not to anticipate the
18 claims of the '915 Patent, render the claims of the '915 Patent obvious alone;
- 19 • Exhibit J-2: Sony SmartSkin references disclosed explicitly above under chart J-2
20 for anticipation purposes in combination with one or more of (a) U.S. Patent
21 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav
22 system.
- 23 • Exhibit J-3: Rubine references disclosed explicitly above under chart J-3 for
24 anticipation purposes in combination with one or more of (a) U.S. Patent
25 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav
26 system, Masanori Sugimoto and Keiichi Hiroki. *HybridTouch: an intuitive*
27 *manipulation technique for PDAs using their front and rear surfaces*; Proceedings

1 of the 8th Conference on Human-Computer Interaction with Mobile Devices and
2 Services 2006 (“MobileHCI” ’06). ACM, New York, NY, USA, 137-140.

- 3 • Exhibit J-4: HybridTouch reference disclosed explicitly above under chart J-4 for
4 anticipation purposes in combination with one or more of (a) U.S. Patent
5 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav
6 system.
- 7 • Exhibit J-5: Han references disclosed explicitly above under chart J-5 for
8 anticipation purposes in combination with one or more of (a) U.S. Patent
9 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav
10 system.
- 11 • Exhibit J-6: Nomura Patent disclosed explicitly above under char J-5 for
12 anticipation purposes in combination with one or more of (a) U.S. Patent
13 Publication 2007/0132789 to Ording et al, (b) the LaunchTile system, (c) the XNav
14 system, (d) “The Automatic Recognition of Gestures,” Dean Rubine, PhD Thesis,
15 1991.

16 In addition to the specific combinations of prior art and the specific combinations of
17 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
18 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
19 disclosed within the prosecution history of the references cited herein. These obviousness
20 combinations reflect Samsung’s present understanding of the potential scope of the claims that
21 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s
22 interpretation of the patent claims.

23 Samsung also reserves the right to amend or supplement these contentions regarding
24 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
25 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
26 not identified what elements or combinations it alleges were not known to one of ordinary skill in
27 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
28 particular prior art reference, Samsung reserves the right to assert that any such limitation is either

1 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
2 of the same, or that the limitation is disclosed in another of the references disclosed above and in
3 combination would have rendered the asserted claim obvious.

4 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
5 **Alleged item of Prior Art each Asserted Claim is Found**

6 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
7 item of prior art each limitation of each asserted claim is found, including for each limitation that
8 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
9 material(s) in each item of prior art that performs the claimed function is attached in Exhibits J and
10 L.

11 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

12 Samsung identifies the following grounds for invalidity of the asserted claims of the '915
13 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
14 disclosures based on further investigation and discovery.

15 **6. Invalidity Based on 35 U.S.C. § 101**

16 The asserted claims of the '915 Patent are invalid under 35 U.S.C. § 101 because they only
17 claim abstract ideas. Many limitations in the asserted claims are common abstractions in
18 computer systems and programming languages. For example, both “event object” and “invoking a
19 call” are programming language abstractions; these are concepts, not physical objects or tangible
20 classes.

21 **7. Invalidity Based on Enablement or Written Description Under 35**
22 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

23 Based on Samsung's present understanding of Plaintiff's infringement contentions,
24 Samsung asserts that claims 1-21 of the '915 Patent are invalid for reciting at least the following
25 claim terms/phrases:

- 26 • “event object”
- 27 • “integrated with the device”
- 28 • “invokes a scroll or gesture operation”

- 1 • “view associated with the event object”
- 2 • “based on an amount of a scroll”
- 3 • “predetermined position in relation to the user input”
- 4 • “predetermined maximum displacement”
- 5 • “rubberbanding”
- 6

7 These claim terms/phrases as apparently construed by Apple violate the written description,
8 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

9 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
10 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
11 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
12 constructions of the claims, any person of ordinary skill in the art at the time of the invention
13 would not understand what is claimed, even when the claims are read in light of the specification.
14 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
15 of the asserted claims in which these claim terms/phrases appear lack written description because
16 the specification of the '915 Patent demonstrates that the patentee neither conceived of nor
17 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
18 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
19 claims in which these claim terms/phrases appear are invalid because the specification fails to
20 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
21 or with which it is most nearly connected, to implement the invention without undue
22 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

23 **V. THE '891 PATENT**

24 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

25 At this time, Samsung contends that at least the following prior art references anticipate or
26 render obvious, either alone or in combination, the asserted claims of the '891 Patent:
27
28

1 1. **Patent References**¹⁴

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
M-1	US	6,907,447	6/14/2005	4/30/2001
M-2	US	7,155,729	12/26/2006	3/28/2000
M-3	US	7,249,326	7/24/2007	4/6/2000
M-4	US	7,417,650	8/26/2008	3/16/2000
M-5	US	2002/0143630	10/3/2002	1/10/2001
M-6	EP	1 022 650	7/26/2000	1/19/1999
M-7	WO	01/69387	9/20/2001	3/16/2000

7 2. **Publications**¹⁵

Chart No(s).	Title	Date of Publication	Author	Publisher
M-8	Popout Prism: Adding Perceptual Principles to Overview+Detail Document Interfaces	4/2002	Suh et al.	Association for Computing Machines
M-9	TransPort LT User's Guide	1/20/2000	Micron Electronics Inc.	Micron Electronics Inc.

12 3. **Systems**

13 All versions of the following prior art systems commercially sold, publicly known or used
14 before the priority date of the '891 Patent, including documents and source code describing the
15 same:
16

Chart No(s).	System	Date Offered	Offering Entity
M-10	ATI Multimedia Center	Before 7/10/2002	ATI Technologies Inc.
M-11	Crusader: No Remorse and Crusader: No Regret	Before 7/10/2002	Electronic Arts
M-12	Grand Theft Auto III	Before 7/10/2002	Rockstar Games
M-13	Micron Computers	Before 7/10/2002	Micron
M-14	Sony Computer Displays, including Sony Trinitron, and Computers with Sony Computer Displays	Before 7/10/2002	Sony
M-15	Windows XP and Computers with Windows XP	Before 7/10/2002	Microsoft and/or Various Computer Manufacturers

26 _____
27 ¹⁴ Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

28 ¹⁵ Samsung incorporates by reference all prior art references identified in the publications listed herein.

1 Additional prior art that has not been charted, but is still relevant to the invalidity of the
2 '891 Patent is listed in Exhibit N. Samsung reserves the right to amend these invalidity
3 contentions to assert these references depending on the claim construction and infringement
4 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these
5 references in combination with other references to render the claims of the '891 Patent obvious in
6 the event Apple takes the position that certain claim limitations are missing from the references
7 charted in Exhibits M and O.

8 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**
9 **Obvious the Asserted Claims**

10 Plaintiff asserts claims 1-3, 5-7, 14-21, 23, 24, 26-28, 30-32, 39-46, 48, 49, 51-53, 55-57,
11 64-71, 73, and 74 of the '891 Patent against Samsung in this lawsuit. All of those claims are
12 invalid because the '891 Patent fails to meet one or more of the requirements for patentability.
13 The individual bases for invalidity are provided below and in the claim charts attached as Exhibits
14 M and O. Each of the foregoing listed prior art documents, the underlying work, and/or the
15 underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. §
16 102 and/or 35 U.S.C. § 103.

17 Although Samsung has identified at least one citation per limitation for each reference,
18 each and every disclosure of the same limitation in the same reference is not necessarily identified.
19 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
20 references, even where a reference may contain additional support for a particular claim element.
21 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
22 in the context of other publications and literature. Thus, to understand and interpret any specific
23 statement or disclosure within a prior art reference, such persons would rely on other information
24 within the reference, along with other publications and their general scientific knowledge.
25 Samsung may rely upon uncited portions of the prior art references and on other publications and
26 expert testimony to provide context, and as aids to understanding and interpreting the portions that
27 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
28 publications, and the testimony of experts to establish that a person of ordinary skill in the art

1 would have been motivated to modify or combine certain of the cited references so as to render the
2 claims obvious.

3 **4. Anticipation**

4 Some or all of the asserted claims of the '891 Patent are invalid as anticipated under 35
5 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts
6 included in Exhibit M, which identify specific examples of where each limitation of the asserted
7 claims is found in the prior art references. As explained above, the cited portions of prior art
8 references identified in the attached claim charts are exemplary only and representative of the
9 content and teaching of the prior art references, and should be understood in the context of the
10 reference as a whole and as they would be understood by a person of ordinary skill in the art.

11 **5. Obviousness**

12 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
13 above and in Exhibit M, then any purported differences are such that the claimed subject matter as
14 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in
15 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
16 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

17 In addition, the references identified above render one or more asserted claims of the '891
18 Patent obvious when the references are read in combination with each other, and/or when read in
19 view of the state of the art and knowledge of those skilled in the art. Each and every reference
20 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
21 references disclosed above may be combined to render obvious (and therefore invalid) each of
22 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
23 all of the references identified above, including all references in Exhibits M, N, and O, for
24 purposes of obviousness depending on the Court's claim construction, positions taken by Apple
25 during this litigation, and further investigation and discovery.

26 Moreover, to the extent the foregoing references are found not to anticipate the asserted
27 claims, the foregoing references render the asserted claims obvious either alone or in combination
28

1 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
2 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
3 at the time of the alleged invention of the asserted claims of the '891 Patent to combine the various
4 references cited herein so as to practice the asserted claims of the '891 Patent.

5
6 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
7 alone or in combination with other references, are outlined below and included in Exhibits M and
8 O, which includes exemplary claim charts for the asserted claims of the '891 Patent showing
9 specifically where in each reference or combinations of references each asserted claim is found,
10 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
11 charts in Exhibit M and O include the motivation to combine references.

12
13 In particular, Samsung contends that the asserted claims of the '891 Patent would have
14 been obvious in view of the prior art references identified above. For example, Exhibit O includes
15 exemplary claim charts that describe how the asserted claims of the '891 Patent would have been
16 obvious in view of the following references alone or in combination:

- 17 • All references identified in Exhibit M, if found not to anticipate the claims of the
18 '891 Patent, render the claims of the '891 Patent obvious alone;
- 19 • Exhibit O-1: US 2003/0016253 (Aoki '253) and Cooperman '447, Andrew '729,
20 Stoakley '326, Horvitz '650, Steinman '630, Sakaguchi '650, Suh, Micron, ATI,
21 Crusader, GTA3, Micron Computers, Sony Trinitron, Windows XP, and/or U.S.
Patent Application No. 2003/0051228 ("Martinez")

22 In addition to the specific combinations of prior art and the specific combinations of
23 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
24 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
25 disclosed within the prosecution history of the references cited herein. These obviousness
26 combinations reflect Samsung's present understanding of the potential scope of the claims that
27 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's
28 interpretation of the patent claims.

1 Samsung also reserves the right to amend or supplement these contentions regarding
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
13 item of prior art each limitation of each asserted claim is found, including for each limitation that
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits M
16 and O.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '891
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
20 disclosures based on further investigation and discovery.

21 **1. Invalidity Based on 35 U.S.C. § 101**

22 The asserted claims of the '891 patent are invalid under 35 U.S.C. § 101 because they only
23 claim abstract ideas. For example, “starting a timer”; “closing the first window in response to a
24 determination that the timer expired”; “the first window has been displayed independently from a
25 position of a cursor on the screen”; “displaying a first window”; “the first window being
26 translucent; “at least a portion of a second window being capable of being displayed on the digital
27 processing system under the first window, the portion of the second window, when present, being
28 visible under the first window on a screen”; and “closing the first window without user input” are

1 each programming language abstractions; these are concepts, not physical objects, machines, or
2 transformations.

3 2. **Invalidity Based on Enablement or Written Description Under 35**
4 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

5 Based on Samsung's present understanding of Plaintiff's infringement contentions,
6 Samsung asserts that claims 1-3, 5-7, 14-21, 23, 24, 26-28, 30-32, 39-46, 48, 49, 51-53, 55-57, 64-
7 71, 73, and 74 of the '891 Patent are invalid for reciting at least the following claim terms/phrases:

- 8 • “starting a timer”
- 9 • “closing the first window in response to a determination that the timer expired”
- 10 • “the first window does not close in response to any input from a user input device
11 of the digital processing system”
- 12 • “the first window has been displayed independently from a position of a cursor on
13 the screen”
- 14 • “translucent”
- 15 • “the first window is at a top level in a window displaying hierarchy”
- 16 • “the first window does not respond to any input from a user input device of the
17 digital processing system”
- 18 • “determining a position on a display of the digital processing system independent
19 of a position of a cursor on the display”
- 20 • “restarting the timer in response to receiving a second input for the first window”
- 21 • “closing the first window without user input”
- 22 • “determining whether or not a condition is met”
- 23 • “said closing the first window is in response to a determination that the condition is
24 met”
- 25 • “means for displaying a first window in response to receiving a first input from a
26 user input device of the digital processing system”
- 27 • “means for starting a timer”
- 28 • “means for closing the first window in response to a determination that the timer
 expired”

- 1 • “means for fading out an image of the first window”
- 2 • “means for determining a position on a display of the digital processing system
- 3 independent of a position of a cursor on the display”
- 4 • “means for restarting the timer in response to receiving a second input for the first
- 5 window”
- 6 • “means for displaying a first window, the first window being translucent”
- 7 • “means for closing the first window without user input”
- 8 • “means for determining whether or not a condition is met”

9 These claim terms/phrases as apparently construed by Apple violate the written description,
10 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

11 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
12 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
13 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
14 constructions of the claims, any person of ordinary skill in the art at the time of the invention
15 would not understand what is claimed, even when the claims are read in light of the specification.
16 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
17 of the asserted claims in which these claim terms/phrases appear lack written description because
18 the specification of the '891 Patent demonstrates that the patentee neither conceived of nor
19 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
20 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
21 claims in which these claim terms/phrases appear are invalid because the specification fails to
22 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
23 or with which it is most nearly connected, to implement the invention without undue
24 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

25 **VI. THE '607 PATENT**

26 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

27 At this time, Samsung contends that at least the following prior art references anticipate or
28 render obvious, either alone or in combination, the asserted claims of the '607 Patent:

1 contentions to assert these references depending on the claim construction and infringement
2 positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these
3 references in combination with other references to render the claims of the '607 Patent obvious in
4 the event Apple takes the position that certain claim limitations are missing from the references
5 charted in Exhibits P and R.

6 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**
7 **Obvious the Asserted Claims**

8 Plaintiff asserts claims 1-3, 6-8, and 10-11 of the '607 Patent against Samsung in this
9 lawsuit. All of those claims are invalid because the '607 Patent fails to meet one or more of the
10 requirements for patentability. The individual bases for invalidity are provided below and in the
11 claim charts attached as Exhibits P and R. Each of the foregoing listed prior art documents, the
12 underlying work, and/or the underlying apparatus or method qualifies as prior art under one or
13 more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

14 Although Samsung has identified at least one citation per limitation for each reference,
15 each and every disclosure of the same limitation in the same reference is not necessarily identified.
16 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
17 references, even where a reference may contain additional support for a particular claim element.
18 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
19 in the context of other publications and literature. Thus, to understand and interpret any specific
20 statement or disclosure within a prior art reference, such persons would rely on other information
21 within the reference, along with other publications and their general scientific knowledge.
22 Samsung may rely upon uncited portions of the prior art references and on other publications and
23 expert testimony to provide context, and as aids to understanding and interpreting the portions that
24 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
25 publications, and the testimony of experts to establish that a person of ordinary skill in the art
26 would have been motivated to modify or combine certain of the cited references so as to render the
27 claims obvious.
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4. Anticipation

Some or all of the asserted claims of the '607 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts included in Exhibit P, which identify specific examples of where each limitation of the asserted claims is found in the prior art references. As explained above, the cited portions of prior art references identified in the attached claim charts are exemplary only and representative of the content and teaching of the prior art references, and should be understood in the context of the reference as a whole and as they would be understood by a person of ordinary skill in the art.

5. Obviousness

To the extent any limitation is deemed not to be exactly met by an item of prior art listed above and in Exhibit P, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

In addition, the references identified above render one or more asserted claims of the '607 Patent obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or all of the references identified above, including all references in Exhibits P, Q, and R, for purposes of obviousness depending on the Court's claim construction, positions taken by Apple during this litigation, and further investigation and discovery.

Moreover, to the extent the foregoing references are found not to anticipate the asserted claims, the foregoing references render the asserted claims obvious either alone or in combination with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

1 at the time of the alleged invention of the asserted claims of the '607 Patent to combine the various
2 references cited herein so as to practice the asserted claims of the '607 Patent.

3 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
4 alone or in combination with other references, are outlined below and included in Exhibits P and
5 R, which includes exemplary claim charts for the asserted claims of the '607 Patent showing
6 specifically where in each reference or combinations of references each asserted claim is found,
7 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
8 charts in Exhibit P and R include the motivation to combine references.
9

10 In particular, Samsung contends that the asserted claims of the '607 Patent would have
11 been obvious in view of the prior art references identified above. For example, Exhibit R includes
12 exemplary claim charts that describe how the asserted claims of the '607 Patent would have been
13 obvious in view of the following references alone or in combination:
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- 15 • All references identified in Exhibit P, if found not to anticipate the claims of the
16 '607 Patent, render the claims of the '607 Patent obvious alone;
- 17 • Exhibit R-1: Philipp U.S. Patent No. 6,452,5154 in view of Caldwell et al. U.S.
18 Patent No. 5,572,205
- 19 • Exhibit R-2: Gerpheide et al. U.S. Patent No. 5,565,658 in view of Gerpheide U.S.
20 Patent No. 5,305,017

21 In addition to the specific combinations of prior art and the specific combinations of
22 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
23 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
24 disclosed within the prosecution history of the references cited herein. These obviousness
25 combinations reflect Samsung's present understanding of the potential scope of the claims that
26 Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's
27 interpretation of the patent claims.
28

1 Samsung also reserves the right to amend or supplement these contentions regarding
2 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
3 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
4 not identified what elements or combinations it alleges were not known to one of ordinary skill in
5 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
6 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
7 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
8 of the same, or that the limitation is disclosed in another of the references disclosed above and in
9 combination would have rendered the asserted claim obvious.

10 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
11 **Alleged item of Prior Art each Asserted Claim is Found**

12 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
13 item of prior art each limitation of each asserted claim is found, including for each limitation that
14 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
15 material(s) in each item of prior art that performs the claimed function is attached in Exhibits P
16 and R.

17 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

18 Samsung identifies the following grounds for invalidity of the asserted claims of the '607
19 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
20 disclosures based on further investigation and discovery.

21 **1. Invalidity Based on Enablement or Written Description Under 35**
22 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

23 Based on Samsung's present understanding of Plaintiff's infringement contentions,
24 Samsung asserts that claims 1-3, 6-8, 10, and 11 of the '607 Patent are invalid for reciting at least
25 the following claim terms/phrases:

- 26 • “configured to detect multiple touches or near touches that occur at a same time and
27 at distinct locations”
- 28 • “produce distinct signals”

- 1 • “detect changes in charge coupling between the first conductive lines and the
- 2 second conductive lines”
- 3 • “substantially parallel”
- 4 • “substantially perpendicular”
- 5 • “pixilated image”
- 6 • “recognizing multiple touch events that occur at different locations on the touch
- 7 panel at a same time”
- 8 • “dummy features”
- 9

10 These claim terms/phrases as apparently construed by Apple violate the written description,
11 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

12 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
13 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
14 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
15 constructions of the claims, any person of ordinary skill in the art at the time of the invention
16 would not understand what is claimed, even when the claims are read in light of the specification.
17 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
18 of the asserted claims in which these claim terms/phrases appear lack written description because
19 the specification of the '607 Patent demonstrates that the patentee neither conceived of nor
20 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
21 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
22 claims in which these claim terms/phrases appear are invalid because the specification fails to
23 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
24 or with which it is most nearly connected, to implement the invention without undue
25 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.
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1 **VII. THE '163 PATENT**

2 **A. Local Patent Rule 3-3(a): Identification of Prior Art**

3 At this time, Samsung contends that at least the following prior art references anticipate or
 4 render obvious, either alone or in combination, the asserted claims of the '163 Patent:

5 1. **Patent References¹⁸**

Chart No(s).	Country of Origin	Patent Number	Date of Issue
S-1	United States	6,211,856	April 3, 2001
S-2	United States	7,327,349	February 5, 2008
S-3	United States	5,615,384	March 25, 1997
S-4	United States	5,579,037	November 26, 1996
S-5	United States	4,899,292	February 6, 1990
S-6, U	United States	5,877,751	March 2, 1999
U	United States	7,933,632	April 26, 2011
U	United States	7,089,507	August 8, 2006
U	United States	6,054,990	April 25, 2000
U	United States	7,289,102	October 30, 2007
U	United States	6,157,935	December 5, 2000
U	United States	5,463,725	October 31, 1995
U	United States	7,138,983	November 21, 2006
U	United States	7,522,198	April 21, 2009
U	United States	7,852,357	December 9, 2010
U	United States	7,327,932	February 5, 2008
U	Japan	20000163031A	June 16, 2000

16 2. **Publications¹⁹**

Chart No(s).	Title	Date of Publication	Author	Publisher
S-7, U	AppLens and LaunchTile: Two Designs for One-Handed Thumb Use on Small Devices	2005 (submitted to CHI Conference by Sep. 13, 2004)	Karlson, Amy; Bederson, Benjamin, SanGiovanni, John	Association for Computing Machinery
S-8	West: A Web Browser for Small Terminals	1999	Bjork	Association for Computing Machinery
S-6	2002/0030699 Hand-Held with Auto-Zoom for Graphical Display of Web Page	March 14, 2002	Jan Van Ee (Inventor)	United States Patent Office
S-2	ZoneZoom: Map Navigation for	January 2004	Robbins, Daniel C.; Cutrell,	Association for Computing

18 ¹⁸ Samsung incorporates by reference all prior art references cited in the patents listed herein
 19 and/or their file histories.

20 ¹⁹ Samsung incorporates by reference all prior art references identified in the publications
 21 listed herein.

Chart No(s).	Title	Date of Publication	Author	Publisher
	Smartphones with Recursive View Segmentation		Edward; Sarin, Raman; Horvitz, Eric	Machinery
S-9	2005/0195221 System and Method for Facilitating the Presentation of Content via Device Displays	September 8, 2005	Berger et al.	United States Patent Office
U	2004/0107403 Presenting HTML Content on a Small Screen Terminal Display	June 3, 2004	Jon Stephenson Von Tetzchner	United States Patent Office
U	2006/0048051 Method for Rendering Formatted Content on a Mobile Device	March 2, 2006	Mihal Lazaridis	United States Patent Office
U	2002/0069220 Remote Data Access and Management System Utilizing Handwriting Input	June 6, 2002	Bao Q. Tran	United States Patent Office
U	2009/0135162 System and Method for Detecting the Location, Size, and Shape of Multiple Objects that Interact with a Touch Screen Display	May 28, 2009	Wijdeven et al.	United States Patent Office
U	2006/0101354 Gesture inputs for a Portable Display Device	May 11, 2006	Hashimoto et al.	United States Patent Office
U	2006/0026535 Mode Based Graphical User Interfaces for Touch Sensitive Input Devices	February 2, 2006	Hotelling et al.	United States Patent Office
U	2004/0236790 Systems and Methods for Digital Document Processing	November 25, 2004	Majid Anwar	United States Patent Office
U	2002/0060701 Graphical user interface for displaying and navigating in a directed graph structure	May 23, 2002	Patrick J. Naughton et al.	United States Patent Office

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3. **Systems**²⁰

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '163 Patent, including documents and source code describing the same:

Chart No(s).	System	Date Offered/Known	Offering Entity
S-7	LaunchTile Software ²¹	September 2004	Ben Bederson <i>et al.</i>
S-2	ZoneZoom Flash Prototype	At least as early as January 2004	Microsoft ²²
S-2	SmartPhlow Traffic Monitoring Application	At least as early as January 2004	Microsoft ²³
S-10	XNav	At least as early as August 25, 2005	Ben Bederson <i>et al.</i>
U	Jeff Han's Breakthrough Touchscreen, <i>See</i> http://blog.ted.com/2006/08/01/jeff_han_on_ted	At least as early as August 1, 2006	Jeff Han

Additional prior art that that is relevant to the invalidity of the '163 Patent is listed in Exhibit T. Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with

²⁰ Discovery, and in particular, third party discovery is ongoing. As discovery is in the early stages, Samsung is not yet in possession of all evidence regarding the systems that invalidate the '163 patent. Where possible, Samsung has cited to documentation that evidences the systems' practicing of the invention. However, Samsung anticipates amending these contentions as discovery progresses.

²¹ The LaunchTile software is described in AppLens and LaunchTile: Two Designs for One-Handed Thumb Use on Small Devices, *Bederson et al.*, CHI 2005, ACM, Apr. 2-7, 2005 (Exhibits A-C to the Bederson Declaration filed Aug. 22, Dkt. No. 165); Video Demonstration of LaunchTile (Exhibit D to the Bederson Declaration filed Aug. 22, Dkt. No. 165); PowerPoint slides displayed at the CHI conference (Exhibit E to the Bederson Declaration filed Aug. 22, Dkt. No. 165); Executable version of LaunchTile (Exhibit F to the Bederson Declaration filed Aug. 22, Dkt. No. 165). In addition to being attached the Bederson declaration filed on August 22, these documents have been previously produced in this litigation.

²² *See* ZoneZoom: Map Navigation for Smartphones with Recursive View Segmentation, Robbins *et al.*, ACM Press (Jan. 2004) at 4.1.

²³ *See* ZoneZoom: Map Navigation for Smartphones with Recursive View Segmentation, Robbins *et al.*, ACM Press (Jan. 2004) at 4.2. Samsung is seeking third party discovery on these products. Also relevant is "ZoneZoom: map navigation for smartphones with recursive view segmentation", Robbins et al., AVI '04 Proceedings of the working conference on advanced visual interfaces.

1 other references to render the claims of the '163 Patent obvious in the event Apple takes the
2 position that certain claim limitations are missing from the references charted in Exhibits S and U.

3 **B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**
4 **Obvious the Asserted Claims**

5 Plaintiff asserts claims 2, 4-13, 17-18, 27-42, and 47-52 of the '163 Patent against
6 Samsung in this lawsuit. All of those claims are invalid because the '163 Patent fails to meet one
7 or more of the requirements for patentability. The individual bases for invalidity are provided
8 below and in the claim charts attached as Exhibits S and U. Each of the foregoing listed prior art
9 documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art
10 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

11 Although Samsung has identified at least one citation per limitation for each reference,
12 each and every disclosure of the same limitation in the same reference is not necessarily identified.
13 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
14 references, even where a reference may contain additional support for a particular claim element.
15 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
16 in the context of other publications and literature. Thus, to understand and interpret any specific
17 statement or disclosure within a prior art reference, such persons would rely on other information
18 within the reference, along with other publications and their general scientific knowledge.
19 Samsung may rely upon uncited portions of the prior art references and on other publications and
20 expert testimony to provide context, and as aids to understanding and interpreting the portions that
21 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
22 publications, and the testimony of experts to establish that a person of ordinary skill in the art
23 would have been motivated to modify or combine certain of the cited references so as to render the
24 claims obvious.

25 **4. Anticipation**

26 Some or all of the asserted claims of the '163 Patent are invalid as anticipated under 35
27 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts
28 included in Exhibit S, which identify specific examples of where each limitation of the asserted

1 claims is found in the prior art references. As explained above, the cited portions of prior art
2 references identified in the attached claim charts are exemplary only and representative of the
3 content and teaching of the prior art references, and should be understood in the context of the
4 reference as a whole and as they would be understood by a person of ordinary skill in the art.

5 **5. Obviousness**

6 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
7 above and in Exhibit S, then any purported differences are such that the claimed subject matter as
8 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in
9 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
10 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

11 In addition, the references identified above render one or more asserted claims of the '163
12 Patent obvious when the references are read in combination with each other, and/or when read in
13 view of the state of the art and knowledge of those skilled in the art. Each and every reference
14 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
15 references disclosed above may be combined to render obvious (and therefore invalid) each of
16 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
17 all of the references identified above, including all references in Exhibits S, T, and U, for purposes
18 of obviousness depending on the Court's claim construction, positions taken by Apple during this
19 litigation, and further investigation and discovery.

20 Moreover, to the extent the foregoing references are found not to anticipate the asserted
21 claims, the foregoing references render the asserted claims obvious either alone or in combination
22 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
23 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
24 at the time of the alleged invention of the asserted claims of the '163 Patent to combine the various
25 references cited herein so as to practice the asserted claims of the '163 Patent.

26
27 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
28 alone or in combination with other references, are outlined below and included in Exhibits S and

1 U, which includes exemplary claim charts for the asserted claims of the '163 Patent showing
2 specifically where in each reference or combinations of references each asserted claim is found,
3 and an explanation of why the prior art renders the asserted claim obvious.

4 In particular, Samsung contends that the asserted claims of the '163 patent would have
5 been obvious in view of the prior art references identified above and in Exhibits S, T and U. For
6 example, Exhibits S and U include exemplary claim charts that describe how the asserted claims
7 of the '163 Patent would have been obvious in view of the following references alone or in
8 combination:
9

- 10 • All references identified above and in the claim charts in Exhibit S, if found not to
11 anticipate the claims of the '163 Patent, render the claims of the '163 patent
12 obvious alone;
- 13 • Any reference identified above and in the claim charts in Exhibit S, if found not to
14 anticipate the claims of the '163 patent, can be combined with any other reference
15 identified above and in the claim charts in Exhibit S to render the claims of the
16 '163 patent obvious;
- 17 • To the extent any element is found to be missing from any reference charted in
18 Exhibit S, that reference can be combined with any reference or combination of
19 references disclosing the allegedly missing element and identified in Exhibit U to
20 render the claims of the '163 patent obvious.
- 21 • Any reference identified in Exhibit U may be combined with any other reference or
22 combination of references identified in Exhibit U to render the claims of the '163
23 patent obvious.

24 In addition to these specific combinations of prior art and the specific combinations of
25 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
26 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
27 disclosed within the prosecution history of the references cited herein. These obviousness
28

1 combinations reflect Samsung’s present understanding of the potential scope of the claims that
2 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s
3 interpretation of the patent claims.

4 Samsung also reserves the right to amend or supplement these contentions regarding
5 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
6 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
7 not identified what elements or combinations it alleges were not known to one of ordinary skill in
8 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
9 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
10 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
11 of the same, or that the limitation is disclosed in another of the references disclosed above and in
12 combination would have rendered the asserted claim obvious.

13 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
14 **Alleged item of Prior Art each Asserted Claim is Found**

15 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
16 item of prior art each limitation of each asserted claim is found, including for each limitation that
17 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
18 material(s) in each item of prior art that performs the claimed function is attached in Exhibits S
19 and U.

20 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

21 Samsung identifies the following grounds for invalidity of the asserted claims of the ’163
22 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
23 disclosures based on further investigation and discovery.

24 **1. Invalidity Based on 35 U.S.C. § 101**

25 The asserted claims of the ’163 patent are invalid under 35 U.S.C. § 101 because they only
26 claim abstract ideas. For example, each asserted claim of the ’163 Patent contains the limitations
27 “detecting a first gesture at a location on the displayed portion of the structured electronic
28

1 document” and “determining a first box in the plurality of boxes at the location of the first
2 gesture.” Furthermore, the claims merely contain abstract software instructions.

3 2. **Invalidity Based on Enablement or Written Description Under 35**
4 **U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)**

5 Based on Samsung's present understanding of Plaintiff’s infringement contentions,
6 Samsung asserts that claims 2, 4-13, 17-18, 27-42, & 47-52 of the ’163 Patent are invalid for
7 reciting at least the following claim terms/phrases:

- 8 • “at least a portion of a structured electronic document”
- 9 • “boxes of content,” “first box,” and “second box”
- 10 • “translating”
- 11 • “substantially centered”
- 12 • “enlarging and translating the structured electronic document so that the first box is
13 substantially centered on the touch screen display”
- 14 • “while the first box is enlarged, detecting a second gesture on a second box other
15 than the first box; and translating the structured electronic document so that the
 second box is substantially centered on the touch screen display”
- 16 • “the plurality of boxes are defined by a style sheet language”
- 17 • “the width of the first box is substantially the same as the width of the touch screen
18 display”
- 19 • “means for displaying at least a portion of a structured electronic document on the
20 touch screen display, wherein the structured electronic document comprises a
 plurality of boxes of content”
- 21 • “means for detecting a first gesture at a location on the displayed portion of the
22 structured electronic document”
- 23 • “means for determining a first box in the plurality of boxes at the location of the
24 first gesture”
- 25 • “means for enlarging and translating the structured electronic document so that the
 first box is substantially centered on the touch screen display”
- 26 • “means for, while the first box is enlarged, a second gesture is detected on a second
27 box other than the first box”

- “means for, in response to detecting the second gesture, the structured electronic document is translated so that the second box is substantially centered on the touch screen display”

These claim terms/phrases as apparently construed by Apple violate the written description, enablement, and/or definiteness requirements of 35 U.S.C. § 112.

Based on Samsung's present understanding of Plaintiff's infringement contentions, at least one or more of these claim terms/phrases are indefinite because they are inconsistent with and broader than the alleged invention disclosed in the specification and given Plaintiff's apparent constructions of the claims, any person of ordinary skill in the art at the time of the invention would not understand what is claimed, even when the claims are read in light of the specification. Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '163 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Apple now contends the claims cover. In addition, based on Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

VIII. THE '129 PATENT

A. Local Patent Rule 3-3(a): Identification of Prior Art

At this time, Samsung contends that at least the following prior art references anticipate or render obvious, either alone or in combination, the asserted claims of the '129 Patent:

1. Patent References²⁴

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
V-1	US	4,571,454	2/18/1986	11/11/1982
V-2	US	5,083,118	1/21/1992	4/16/1990
V-3	US	5,113,041	5/12/1992	12/28/1990

²⁴ Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Chart No(s).	Country of Origin	Patent Number	Date of Issue	Priority Date
V-4	US	5,565,658	10/15/1996	7/13/1992
V-5	US	7,218,314	5/15/2007	6/7/2001
V-6	US	7,932,898	4/26/2001	9/20/2005
V-7	WO	2005/114369	12/1/2005	5/6/2004

2. Systems

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '129 Patent, including documents and source code describing the same:

Chart No(s).	System	Date Offered	Offering Entity
V-8	Whirlpool Velos™ Touchscreen	At least as early as December 2005	Whirlpool

Additional prior art that has not been charted, but is still relevant to the invalidity of the '129 Patent is listed in Exhibit W. Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other references to render the claims of the '129 Patent obvious in the event Apple takes the position that certain claim limitations are missing from the references charted in Exhibits V and X.

B. Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims

Plaintiff asserts claims 1-3, 5, 7, 9-12, 14, 16-19, 21-22, 24-26, and 28 of the '129 Patent against Samsung in this lawsuit. All of those claims are invalid because the '129 Patent fails to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the claim charts attached as Exhibits V and X. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

1 Although Samsung has identified at least one citation per limitation for each reference,
2 each and every disclosure of the same limitation in the same reference is not necessarily identified.
3 Rather, in an effort to focus the issues, Samsung has cited representative portions of identified
4 references, even where a reference may contain additional support for a particular claim element.
5 In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and
6 in the context of other publications and literature. Thus, to understand and interpret any specific
7 statement or disclosure within a prior art reference, such persons would rely on other information
8 within the reference, along with other publications and their general scientific knowledge.
9 Samsung may rely upon uncited portions of the prior art references and on other publications and
10 expert testimony to provide context, and as aids to understanding and interpreting the portions that
11 are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed
12 publications, and the testimony of experts to establish that a person of ordinary skill in the art
13 would have been motivated to modify or combine certain of the cited references so as to render the
14 claims obvious.

15 3. **Anticipation**

16 Some or all of the asserted claims of the '129 Patent are invalid as anticipated under 35
17 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts
18 included in Exhibit V, which identify specific examples of where each limitation of the asserted
19 claims is found in the prior art references. As explained above, the cited portions of prior art
20 references identified in the attached claim charts are exemplary only and representative of the
21 content and teaching of the prior art references, and should be understood in the context of the
22 reference as a whole and as they would be understood by a person of ordinary skill in the art.

23 4. **Obviousness**

24 To the extent any limitation is deemed not to be exactly met by an item of prior art listed
25 above and in Exhibit V, then any purported differences are such that the claimed subject matter as
26 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in
27 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,
28 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

1 In addition, the references identified above render one or more asserted claims of the '129
2 Patent obvious when the references are read in combination with each other, and/or when read in
3 view of the state of the art and knowledge of those skilled in the art. Each and every reference
4 identified is also relevant to the state of the art at the time of the alleged invention. Any of the
5 references disclosed above may be combined to render obvious (and therefore invalid) each of
6 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or
7 all of the references identified above, including all references in Exhibits V, W, and X, for
8 purposes of obviousness depending on the Court's claim construction, positions taken by Apple
9 during this litigation, and further investigation and discovery.

10 Moreover, to the extent the foregoing references are found not to anticipate the asserted
11 claims, the foregoing references render the asserted claims obvious either alone or in combination
12 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained
13 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art
14 at the time of the alleged invention of the asserted claims of the '129 Patent to combine the various
15 references cited herein so as to practice the asserted claims of the '129 Patent.

17 In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,
18 alone or in combination with other references, are outlined below and included in Exhibits V and
19 X, which includes exemplary claim charts for the asserted claims of the '129 Patent showing
20 specifically where in each reference or combinations of references each asserted claim is found,
21 and an explanation of why the prior art renders the asserted claim obvious. Where applicable, the
22 charts in Exhibit V and X include the motivation to combine references.

24 In particular, Samsung contends that the asserted claims of the '129 Patent would have
25 been obvious in view of the prior art references identified above. For example, Exhibit X includes
26 exemplary claim charts that describe how the asserted claims of the '129 Patent would have been
27 obvious in view of the following references alone or in combination:
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- 1 • All references identified in Exhibit V, if found not to anticipate the claims of the
- 2 '129 Patent, render the claims of the '129 Patent obvious alone;
- 3 • Exhibit X-1: Exhibit X-1: U.S Patent No. 7,372,455 to Perski (“Perski ’455”) and
- 4 U.S. Patent No. 5,083,118 to Kazama (“Kazama ’118”)

5 In addition to the specific combinations of prior art and the specific combinations of
6 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any
7 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations
8 disclosed within the prosecution history of the references cited herein. These obviousness
9 combinations reflect Samsung’s present understanding of the potential scope of the claims that
10 Plaintiff appears to be advocating and should not be seen as Samsung’s acquiescence to Plaintiff’s
11 interpretation of the patent claims.

12 Samsung also reserves the right to amend or supplement these contentions regarding
13 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,
14 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has
15 not identified what elements or combinations it alleges were not known to one of ordinary skill in
16 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a
17 particular prior art reference, Samsung reserves the right to assert that any such limitation is either
18 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light
19 of the same, or that the limitation is disclosed in another of the references disclosed above and in
20 combination would have rendered the asserted claim obvious.

21 **C. Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
22 **Alleged item of Prior Art each Asserted Claim is Found**

23 Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged
24 item of prior art each limitation of each asserted claim is found, including for each limitation that
25 Apple contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
26 material(s) in each item of prior art that performs the claimed function is attached in Exhibits V
27 and X.

28

1 **D. Local Patent Rule 3-3(d): Other Grounds for Invalidity**

2 Samsung identifies the following grounds for invalidity of the asserted claims of the '129
3 Patent based on 35 U.S.C. §§ 101 and/or 112. Samsung reserves the right to supplement these
4 disclosures based on further investigation and discovery. Invalidity Based on Enablement or
5 Written Description Under 35 U.S.C. § 112(1) and/or Indefiniteness Under 35 U.S.C. § 112(2)

6 Based on Samsung's present understanding of Plaintiff's infringement contentions,
7 Samsung asserts that claims 1-3, 5, 7, 9-12, 14, 16-19, 21-22, 24-26, and 28 of the '129 Patent are
8 invalid for reciting at least the following claim terms/phrases:

- 9 • "one or more widths including a maximum width"
- 10 • "one or more widths including a minimum width"
- 11 • "the minimum width"
- 12 • "substantially greater"
- 13 • "substantially greater"
- 14 • "maximum width"
- 15 • "substantially electrically isolate"
- 16 • "substantially cover"
- 17 • "substantially constant width"

18 These claim terms/phrases as apparently construed by Apple violate the written description,
19 enablement, and/or definiteness requirements of 35 U.S.C. § 112.

20 Based on Samsung's present understanding of Plaintiff's infringement contentions, at least
21 one or more of these claim terms/phrases are indefinite because they are inconsistent with and
22 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent
23 constructions of the claims, any person of ordinary skill in the art at the time of the invention
24 would not understand what is claimed, even when the claims are read in light of the specification.
25 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each
26 of the asserted claims in which these claim terms/phrases appear lack written description because
27 the specification of the '129 Patent demonstrates that the patentee neither conceived of nor
28

1 demonstrated possession of all that Apple now contends the claims cover. In addition, based on
2 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted
3 claims in which these claim terms/phrases appear are invalid because the specification fails to
4 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,
5 or with which it is most nearly connected, to implement the invention without undue
6 experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

7 **PATENT LOCAL RULE 3-4 DISCLOSURES**

8 Pursuant to Patent Rule 3-4(a), Defendants will produce, make available for inspection, or
9 identify publicly available information sufficient to show the operation of any specifically
10 identified aspects or elements of an Accused Instrumentality identified by Plaintiff in its Patent
11 L.R. 3-1(c) chart to the extent such information is in Defendants' possession, custody or control.
12 If such information comprises source code, Defendants will make such source code available for
13 inspection pursuant to the entry of a suitable protective order in this action. Documents produced
14 pursuant to Patent Local Rule 3-4(a) include the following: 43983-44537.

15 Pursuant to Patent Rule 3-4(b), Defendants are producing or making available for
16 inspection copies of each item of prior art identified pursuant to Patent Rule 3-3(a) which does not
17 appear in the file history of the Asserted Patent to the extent such prior art is in Samsung's
18 possession, custody or control. Documents produced pursuant to Patent Local Rule 3-4(a) include
19 the following: SAMNDCA00028457-36167; 36833-43982; and 44538-44674.

20 Defendants reserve the right to identify and produce additional documents pursuant to the
21 Patent Rules and the orders of the Court.

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DATED: October 7, 2011

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TELECOMMUNICATIONS AMERICA, LLC

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on October 7, 2011, I caused **SAMSUNG'S PATENT LOCAL**
3 **RULE 3-3 AND 3-4 DISCLOSURES** to be electronically served on the following via email:

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23

24 I declare under penalty of perjury that the foregoing is true and correct. Executed in Redwood
25 Shores, California on October 7, 2011.

26

/s/ Mark Tung

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