

United States District Court
For the Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., a California Corporation,)	Case No.: 5:12-cv-0630-LHK-PSG
)	
Plaintiff,)	ORDER RE: MOTIONS TO STRIKE
v.)	AND SEAL
)	
SAMSUNG ELECTRONICS CO., LTD., a)	(Re: Docket Nos. 877, 878, 880, 882)
Korean corporation; SAMSUNG)	
ELECTRONICS AMERICA, INC., a New York)	
corporation; and SAMSUNG)	
TELECOMMUNICATIONS AMERICA, LLC,)	
a Delaware limited liability company,)	
)	
Defendants.)	
)	

Imagine if Coach John Heisman had chosen to patent his signature play, the famous fumblerooski. Claim 1 might read:

A method of advancing a football through deception, comprising:

- (a) the quarterback deliberately placing the ball on the ground upon receiving it from the center;
- (b) one or more of the remaining offensive players running to the right; and
- (c) another offensive player picking up the ball and running to the left.

1 If Heisman sued a rival for infringement in this district, his Patent Local Rule 3-1
2 contentions might theorize that the rival practiced the final limitation using a tackle. Now if
3 Heisman's expert later pointed to video of a guard, few would doubt that the expert had
4 inappropriately disregarded the earlier contentions. But if the contentions had merely set forth that
5 a lineman had picked up the ball, and were never challenged as requiring more specific
6 supplementation, the expert would be understood simply to have provided an example of the earlier
7 contention, something she is perfectly free to do long after the rival passed on the chance to seek
8 supplementation of the contentions to specify the particular lineman completing the trickery.
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10 Replace Coach Heisman with Apple or Samsung, and “offensive player” with “imaging
11 device,” “recording circuit,” and the like, and you get an idea of the circumstances before the court.
12 In all but a few instances identified below, in challenging an expert's designation of the right guard,
13 the party complaining has conflated a general lineman contention for one specifying a tackle.
14 Because the time for challenging the generality of the earlier contention has passed, the present
15 challenges are largely a matter of too little, too late.
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17 **II. LEGAL STANDARDS**

18 Our district’s Local Patent Rules require that parties lay out their infringement and validity
19 contentions early enough to give their opponents a fair shot at rebuttal. The rule “exists to further
20 the goal of full, timely discovery and provide all parties with adequate notice of and information
21 with which to litigate their cases.”¹ The rules replace the “series of interrogatories that [parties]
22 would likely have propounded” without them.² They are “designed to require parties to crystallize
23 theories of the case early in the litigation and to adhere to those theories once they have been
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26 ¹ *XYX Corp v. Advanced Power Tech*, Case No. 02-3942, 2004 WL 1368860, at *3 (N.D. Cal. June
27 16, 2004).

28 ² *Network Coaching Tech L.L.C., v. Novell, Inc.*, Case No. 01-2079, 2002 WL 3216128, at *4
(N.D. Cal. Aug.. 13, 2002).

1 disclosed.”³ They are also designed to “provide structure to discovery and enable the parties to
2 move efficiently toward claim construction and the eventual resolution of their dispute.”⁴

3 Expert reports may not introduce theories not set forth in contentions.⁵ “The scope of
4 contentions and expert reports are not, however, coextensive.”⁶ Contentions need not disclose
5 specific evidence,⁷ whereas expert reports must include a complete statement of the expert’s
6 opinions, the basis and reasons for them, and any data or other information considered when
7 forming them.⁸ When considering a challenge such as those now before the court, the question thus
8 becomes, has the expert permissibly specified the application of a disclosed theory, or has the
9 expert impermissibly substituted a new theory altogether?
10

11 With this framework and these standards in mind, the court turns to the unresolved issues in
12 the four motions before it.⁹

13 III. DISCUSSION

14 A. Apple’s Motion to Strike Arguments from Samsung’s Infringement Expert Reports 15 Regarding Samsung Patents (Docket No. 877)

16 First, Apple moves to strike Parulski’s opinion that the “imaging device” limitation of the
17 ‘449 patent is met by a specific component found within the CMOS image sensor rather than the
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19 ³ *Nova Measuring Inst., Ltd. v. Nanometrics, Inc.*, 417 F.Supp.2d 1121, 1123 (N.D. Cal. Mar. 6, 2006).

20 ⁴ *Creagri, Inc. v. Pinnacle, Inc., L.L.C.*, Case No. 11-6635, 2012 WL 5389975, at *2 (N.D. Cal. Nov. 2, 2012).

21 ⁵ *See Fenner Investments, Ltd., v. Hewlett-Packard Co.*, Case No. 08-0273, 2010 WL 786606, at *2 (E.D. Tex. Feb. 26, 2010).

22 ⁶ *See id.*

23 ⁷ *See Creagri*, 2012 WL 5389775, at *2.

24 ⁸ *See* Fed. R. Civ. P. 26(a)(2)(B).

25 ⁹ The court regrets that the press of time precludes a complete rehashing of the parties’ respective
26 positions here. The parties may presume that in ruling on any particular expert opinion, the court
27 has adopted the proposed factual findings and legal conclusions of the party urging the ruling and
28 rejected those in opposition.

1 CMOS image sensor as a whole.¹⁰ Apple argues that this court’s order of June 26, 2013 precluded
2 theories based on these components.¹¹ Apple is mistaken. That order only precluded doctrine of
3 equivalence arguments regarding those components, which are not relevant to the literal
4 infringement here.¹² Parulski is simply pointing to a specific example of the sensor that was
5 disclosed in Samsung’s infringement contentions.¹³ That is entirely appropriate. Apple’s motion is
6 DENIED.

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8 Second, Apple moves to strike Parulski’s opinion that the “recording circuit” limitation of
9 the ‘449 patent is met by an interface circuit and other components not previously identified.¹⁴
10 Samsung does not contest that the last sentence of paragraph 202 of Parulski’s report discussing the
11 interface circuit propounds a new theory,¹⁵ so Apple’s motion is GRANTED as to that sentence.
12 However, it is DENIED as to the remainder of Parulski’s opinion regarding the recording circuit,
13 as the memory and “controller” in question are specific examples of the NAND flash module
14 previously disclosed in Samsung’s contentions.

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16 Third, Apple moves to strike Parulski’s opinion that the “reproducing circuit” limitation of
17 the ‘449 patent is met by a “display pipeline” and an “audio subsystem,” which were not
18 previously specifically identified.¹⁶ Here, but for some artful drafting by Samsung, Apple might
19 have a point. Unlike with the “imaging device limitation, Samsung’s contentions disclosed the
20 graphical processing unit, a specific subpart of the larger chip in question (the system-on-chip), and
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22 ¹⁰ See Docket No. 877-4 at 10.

23 ¹¹ See *id.* at 9.

24 ¹² See Docket No. 636 at 25.

25 ¹³ See Docket No. 963-3 at 23.

26 ¹⁴ See Docket No. 877-4 at 11.

27 ¹⁵ See Docket No. 963-3 at 23.

28 ¹⁶ See Docket No. 877-4 at 11-12.

1 now its expert is specifying a different component. However, the graphical processing unit was
2 explicitly disclosed as an “example” of a subpart of the system-on-chip that might infringe the
3 patent. The contention itself was directed at the whole chip. Accordingly, Apple’s motion must be
4 DENIED.

5 Fourth, Apple moves to strike Schonfeld’s opinion that Mac OS or iOS devices may satisfy
6 the “zone specific storage and interface” limitation of the ‘757 patent if those devices are confined
7 to a residence or connected to a Wifi network. This challenge is perplexing, given that Apple’s
8 own brief cites language from the contention indicating that an Apple product “may reside in a
9 room or similar location” to satisfy this limitation, and the contention cited specifically lists both
10 iOS devices and Mac OS devices.¹⁷ Apple’s motion is DENIED.

11 Fifth, Apple moves to strike Schonfeld’s opinion that Mac OS devices can satisfy the “zone
12 specific storage and interface” limitation of the ‘757 patent when used for the Photo Stream
13 feature.¹⁸ Apple argues that the contentions only disclose Mac OS devices as
14 “central devices,” and disclose iOS devices alone as “Zone Devices.” By referencing Mac OS
15 devices explicitly as “Zone Devices”, the actual contentions belie this charge.¹⁹ Apple’s motion is
16 DENIED.
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22 ¹⁷ See Docket No. 660-3 at 5:

and at least one zone, each zone having at least one zone specific storage and	Apple's iPhone, iPod Touch, iPad, iPad Mini, iMac, MacBook Air, MacBook Pro, Mac Mini, Mac Pro and Apple TV devices, and PCs with iTunes (collectively the “Zone Devices”) are storage and interface devices that reside in a specific location and are capable of storing or interfacing with information stored in a central storage and interface device. For example, each of these devices may reside in a room or similar location, or be coupled to devices residing in a room or similar location, such as a dock, including docks sold on Apple’s website. For
interface device capable of storing or interfacing	example, Apple markets and sells docks such as the Bose SoundDock Series II Digital Music System for the iPhone and iPod, or the XtremeMac InCharge X2 Charging Station for iPod, iPhone, or iPad.

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27 ¹⁸ See Docket No. 877-4 at 15-17.

28 ¹⁹ See *supra*, n. 17.

1 Sixth, Apple moves to strike Schonfeld’s opinion that the “automatic transfer” feature of
2 Home Sharing is a functionality accused of infringing the ‘757 patent.²⁰ Samsung’s contentions,
3 however, specifically reference the automatic transfer feature in Apple’s lingo,²¹ and it prominently
4 cited to a website discussing the feature in its Third Amended Infringement Contentions.²² Apple’s
5 motion is DENIED.

6 Seventh, Apple moves to strike Schonfeld’s opinion that the “shared photo stream” feature
7 is a functionality accused of infringing the ‘757 patent, arguing that it introduces a new
8 infringement theory.²³ Once again, the actual contentions tell a different story; Samsung’s
9 contentions disclose the ability to share photos manually selected with friends and family.²⁴
10 Apple’s motion is DENIED.

11 Eighth, Apple moves to strike Schonfeld’s opinion that PCs with iTunes are products
12 accused of infringing the ‘757 patent, as it argues that PCs with iTunes were specifically dropped
13 as an accused product earlier in the case.²⁵ However, “iTunes” more broadly remains as an
14 accused product, which Apple’s own expert defined as including both the server and the client for
15 both Mac and Windows computers.²⁶ Samsung can hardly be faulted for using doing the same.
16 Apple’s motion is DENIED.

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19 Ninth, Apple moves to strike Schonfeld’s opinion that the “central storage and interface
20 device” limitation of the ‘757 patent can be satisfied by groups of servers or by servers containing

21 ²⁰ See Docket No. 877-4 at 14-15.

22 ²¹ See Docket No. 304-4 at 11-12.

23 ²² See Docket No. 660-3.

24 ²³ See Docket No. 877-4 at 13.

25 ²⁴ See Docket No. 660-3 at 21 (“Photo Stream lets you share select photos with friends and family,
26 directly to their devices or on the web”).

27 ²⁵ See Docket No. 877-4 at 15.

28 ²⁶ See Docket No. 963-3 at 15.

1 only one of “content information” or “content management information.”²⁷ Apple’s primary
2 complaint here is that Samsung’s expert urges that multi-server configurations owned by and in the
3 control of third parties may fulfill these roles, when Samsung’s contentions focused only on the
4 iCloud server and computers owned and produced by Apple.²⁸ In this instance, Apple
5 appropriately points out the substitution of a theory, rather than just increased specificity; the
6 contentions told Apple to look for evidence in one place (its iCloud servers); now the expert is
7 relying on evidence gathered from somewhere else (third party servers, such as Amazon’s cloud
8 storage). Apple’s motion is GRANTED.
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10 Tenth, Apple moves to strike Schonfeld’s opinion that the “audio capture card” and “video
11 capture card having a video capture module” limitations of claim 1 and “video capture module”
12 limitation of claim 15 of the ‘239 patent are met by certain previously unidentified components.²⁹
13 Samsung argues that it disclosed each of the components individually in its contentions, such that
14 Apple was on notice and had the opportunity to take discovery on each.³⁰ Apple fails to identify
15 any prejudice it has suffered, or any actions it would have/could have taken differently had this
16 particular articulation of the contention come forth earlier. Apple’s motion is therefore DENIED.
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18 Eleventh, Apple moves to strike Schonfeld’s opinion that the “means for exchanging”
19 limitation of claim 1 of the ‘239 patent is met by newly disclosed components.³¹ However,
20 Samsung’s contentions did disclose a general “circuit” to perform that function.³² Apple’s
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22 ²⁷ See Docket No. 877-4 at 15-17.

23 ²⁸ See *id.*

24 ²⁹ See Docket No. 877-4 at 18-19.

25 ³⁰ See Docket No. 963-3 at 19-19.

26 ³¹ See Docket No. 877-4 at 19.

27 ³² See Docket No. 660-6 at 17:

28 a.) means for exchanging data with said host unit;

On information and belief, the iPod touch (5th generation), iPad 4, iPad mini, Apple’s computers and non-Apple PCs, as well as previously charted Accused Devices, each have a circuit for exchanging the data received by the host computer’s interface with the playback unit. Apple’s software, such as Quicktime and FaceTime, works in conjunction with that computer interface(s) and the circuit to allow a host unit to receive data from a Mobile Remote Unit and transmit it to playback unit for playback unit.

1 complaint is that the expert now specifies what that circuit entailed. This is fully proper.³³ Apple's
2 motion is DENIED.

3 Twelfth, Apple moves to strike Schonfeld's opinion that the "host unit" and "playback unit"
4 limitations of claim 1 of the '239 patent are met by previously unaccused Mac computers.³⁴
5 Samsung's opposition presents no arguments to defend them with respect to the "host unit"
6 limitation, so the motion is GRANTED as to that limitation.³⁵ However, Samsung points out that
7 Schonfeld specifically excluded laptop computers from his analysis of playback, mobile remote
8 units in the infringement analysis, and Apple appears to be concerned only about laptop and not
9 desktops in its briefs.³⁶ The motion is DENIED as to the playback unit opinions.

10 Thirteenth and finally, Apple moves to strike Parulski's opinion that the "compressor" and
11 "decompressor" limitations of the '449 patent are met by certain previously unidentified
12 components of a system-on-chip.³⁷ However, the actual contentions accused certain portions of the
13 system-on-chip, and the portions identified were simply provided as examples.³⁸ These are, then,
14 further examples of a broad contention being properly narrowed by an expert. Apple's motion is
15 DENIED.

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18 **B. Samsung's Motion to Strike Expert Testimony Based on Undisclosed Theories and
19 Claim Constructions Inconsistent with the Court's *Markman* Order (Docket No. 878)**

20 Samsung moves to strike Apple's expert reports in general, and Storer's opinion
21 specifically, because they rely on claim constructions that were not disclosed in respond to a

22 ³³ This provides an excellent example of an instance where Apple might legitimately have
23 complained of an overly broad contention earlier in the case. But the time for that has long since
24 passed.

25 ³⁴ See Docket No. 877-4 at 19-20.

26 ³⁵ See Docket No. 963-3 at 20.

27 ³⁶ See *id.*

28 ³⁷ See Docket No. 877-4 at 21-22.

³⁸ See Docket 660-5 at 3.

1 contention interrogatory.³⁹ Interrogatory 46 requested the following: “For each asserted claim for
2 each Samsung Patent, and each Apple Patents-in-Suit identify: (1) a list of all claim terms that
3 YOU contend has [sic] a meaning other than plain meaning and should be construed by the Court
4 and identify any claim term which YOU contend should be governed by 35 USC Section 112(6);
5 (2) YOUR construction of each term identified for claim construction . . . and (3) for each
6 identified term, all references from the specification or prosecution history that supports [sic]
7 YOUR construction.”⁴⁰ Apple did not fully respond to this interrogatory, instead commenting that
8 the parties could address claim construction at a later time. Apple now maintains that it is simply
9 applying the plain and ordinary meaning of the terms at issue, whereas Samsung believes that it is
10 further interpreting the claims.
11

12 In order to rule on this motion’s merits, the undersigned would need to construe more terms
13 than the presiding judge elected to consider. This would be an inappropriate exercise for the
14 referral judge. The motion therefore is DENIED, but Samsung is free to seek relief from Judge
15 Koh if its concerns persist.
16

17 **C. Samsung’s Motion to Strike Expert Testimony Based on Previously Undisclosed**
18 **Theories (Docket No. 880)**

19 Apple moves to strike Mowry’s theories regarding Apple’s practice of the ‘647 patent based
20 on his discussions with engineers not disclosed by Samsung.⁴¹ Apple argues that Samsung’s
21 failure to disclose these witnesses denied them the opportunity to depose witnesses who may have
22 helped to impeach the expert.⁴² Samsung’s primary response is that Mowry did not rely on the
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25 ³⁹ See Docket No. 878-4 at 12-18.

26 ⁴⁰ See Docket No. 965-4 at 2.

27 ⁴¹ See Docket No. 880-5 at 22.

28 ⁴² See Docket No. 964-25 at 18.

1 reports of these engineers, but Mowry’s own testimony is to the contrary.⁴³ Apple's motion is
2 GRANTED.

3 **D. Apple’s Motion to Strike Arguments from Samsung’s Expert Reports Regarding**
4 **Apple Patents (Docket No. 882)**

5 Apple moves to strike portions of Jeffay’s opinions that the ‘647 patent is invalid based on
6 the Sidekick Handbook, the “MHonArc System/Mosaic System,” and Jeffay’s alleged “systems.”⁴⁴
7 Apple argues that although Samsung disclosed the Sidekick “System” and each of the “MHonArc”
8 and “Mosaic” systems independently as prior art, it did not disclose the Sidekick Handbook or the
9 use of the MHonArc and Mosaic systems together.⁴⁵ The documentation provided in Samsung’s
10 opposition refutes those allegations, at least in part,⁴⁶ such that Apple's motion is DENIED with
11 respect to the Sidekick Handbook and MHonArc/Mosaic System. It is GRANTED, however, with
12 respect to opinions based on Jeffay’s undisclosed systems of his own creation.
13

14 Apple also moves to strike Jeffay’s opinions regarding an alleged non-infringing alternative
15 discussed in the *Apple v. Motorola* litigation.⁴⁷ Samsung argues that although this alternative was
16 not disclosed in its contentions, Apple was on notice of the alternative based on its appearance in
17 unrelated litigation.⁴⁸ Given the breadth and volume of litigation that these parties are involved in,
18 it would be manifestly unreasonable to impute constructive notice of each and every contention
19 from every case. Apple's motion is GRANTED.
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23 ⁴³ See Docket No. 1018-4 at 14-15.

24 ⁴⁴ See Docket No. 882-3 at 7-9.

25 ⁴⁵ See *id.*

26 ⁴⁶ See Docket No. 962-4, at 7-10.

27 ⁴⁷ See Docket No. 882-3 at 17-18.

28 ⁴⁸ See Docket No. 962-4 at 20-21.

IV. SEALING

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2 The sealing requests for all four motions before the court continue the parties' unfortunate
3 course of redacting plainly non-confidential information. For example, both Apple and Samsung
4 redact sections in which a witness provides the startling revelation that he has no information.⁴⁹
5 While embarrassing, perhaps, this is not confidential information worthy of the time and money
6 required to request sealing from the court. In light of the overreach that both parties continue to
7 demonstrate in keeping information from the public, the court DENIES the sealing motions.
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9 **IT IS SO ORDERED.**

10 Dated: January 9, 2014

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12 PAUL S. GREWAL
13 United States Magistrate Judge
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28 ⁴⁹ See Docket Nos. 877-4 at 23, 882-3 at 20.