

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.: 12-CV-00630-LHK
	)	
Plaintiff and Counterdefendant,	)	ORDER ON PRETRIAL FILINGS
	)	
v.	)	
	)	
SAMSUNG ELECTRONICS CO., LTD., a	)	
Korean corporation; SAMSUNG	)	
ELECTRONICS AMERICA, INC., a New York	)	
corporation; and SAMSUNG	)	
TELECOMMUNICATIONS AMERICA, LLC,	)	
a Delaware limited liability company,	)	
	)	
Defendants and Counterclaimants.	)	
	)	

The Court notes that the parties' submissions following the March 5, 2014 pretrial conference have substantially narrowed the issues and claims for trial (*see* ECF Nos. 1414, 1418, 1419). In particular, in the parties' stipulation regarding dismissal of claims and counterclaims (ECF No. 1419), Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Samsung") agreed not to assert at trial claim 10 of the '087 patent, claim 13 of the '596 patent, or claim 1 of the '239 patent, thereby withdrawing all previously asserted claims of the '087 and '596 patents. Apple, Inc. ("Apple") in turn agreed not to assert at trial multiple defenses and claims, including:

- 1 a. Causes of action arising from its First Counterclaim for Declaratory Judgment of Non-  
2 Infringement of the '087 Patent
- 3 b. Causes of action arising from its Second Counterclaim for Declaratory Judgment of  
4 Invalidity of the '087 Patent
- 5 c. Causes of action arising from its Third Counterclaim for Declaratory Judgment of Non-  
6 Infringement of the '596 Patent
- 7 d. Causes of action arising from its Fourth Counterclaim for Declaratory Judgment of  
8 Invalidity of the '596 Patent
- 9 e. Causes of action arising from its Fifteenth Counterclaim for Declaratory Judgment of  
10 Non-Infringement as they relate to Claim 1 of the '239 Patent.
- 11 f. Causes of action arising from its Sixteenth Counterclaim for Declaratory Judgment of  
12 Invalidity as they relate to Claim 1 of the '239 Patent.
- 13 g. Causes of action arising from its Seventeenth Counterclaim for Breach of Contract –  
14 FRAND and Other Standard-Related Misconduct
- 15 h. Causes of action arising from its Eighteenth Counterclaim for Declaratory Judgment  
16 that Apple is Entitled to a License to Samsung's Declared-Essential Patents
- 17 i. Causes of action arising from its Twenty First Counterclaim for Inequitable Conduct  
18 Before the United States Patent and Trademark Office During Prosecution of the '596  
19 Patent
- 20 j. All affirmative claims for relief or defenses that Samsung's rights in the '087 and '596  
21 patents are exhausted or unenforceable under the doctrines of waiver, equitable  
22 estoppel, and/or unclean hands (Fourth Affirmative Defense)
- 23 k. All affirmative claims for relief or defenses that Apple has an irrevocable right to be  
24 licensed on FRAND terms under the '087 and '596 patents (Fifth Affirmative Defense)
- 25 l. All affirmative claims for relief or defenses that Samsung is prevented from seeking  
26 injunctive relief for infringement of the '087 and '596 patents (Sixth Affirmative  
27 Defense)
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1 m. All affirmative claims for relief or defenses that the jury's verdict in Case No. 11-1846  
2 creates an issue preclusion regarding two elements of Apple's affirmative defense of  
3 patent exhaustion with respect to accused products containing Intel baseband chips  
4 (Seventh Affirmative Defense)

5 n. All affirmative claims for relief or defenses that the '596 patent is invalid and  
6 unenforceable under the doctrine of inequitable conduct (Eighth Affirmative Defense)  
7 (ECF No. 1419 at 1-3.)

8 Accordingly, in light of this narrowing of claims for trial, the Court hereby ORDERS that  
9 the parties will be allowed to present 25 hours of evidence per side at trial. The Court further  
10 ORDERS that the parties shall file by 6:00 p.m., Thursday, March 13, 2014, revised versions  
11 (clean and redlined) of their relevant pretrial filings indicating any issues, evidence, and witnesses  
12 that are no longer necessary for presentation at trial, including:

- 13 • Joint pretrial statement;
- 14 • Trial exhibit lists;
- 15 • Witness lists;
- 16 • Notices pursuant to 35 U.S.C. § 282

17 The parties shall not add any new issues, exhibits, or witnesses to these documents.

18 **IT IS SO ORDERED.**

19 Dated: March 10, 2014

  
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LUCY H. KOH  
United States District Judge

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