

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

NOKIA CORPORATION,

Plaintiff,

v.

APPLE INC.,

Defendant.

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APPLE INC.

Counterclaim-Plaintiff,

v.

NOKIA CORPORATION and NOKIA INC.

Counterclaim-Defendants.

C.A. No. 09-791-GMS

**JURY TRIAL DEMANDED**

**APPLE INC.'S MOTION FOR LEAVE TO SUPPLEMENT ITS  
FIRST AMENDED ANSWER AND COUNTERCLAIMS TO  
INCLUDE A CERTIFICATE OF CORRECTION**

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## **INTRODUCTION**

Pursuant to Federal Rule of Civil Procedure 15(d), Apple moves for leave to supplement its thirty-fourth counterclaim to include a recently-issued Certificate of Correction (“CoC”) for U.S. Patent No. 7,383,453 (the “‘453 patent”). In compliance with Local Rule 15.1, Apple has attached a copy of the proposed supplemental pleading as Exh. 1 and a black-lined version as Exh. 2 (attached hereto).

Apple’s motion is timely and narrowly targeted. The inclusion of the CoC does not change Apple’s contention that Nokia infringes the ‘453 patent. It simply clarifies that the ‘453 patent now has two sets of claims, each directed to separate infringement activities.<sup>1</sup> Under the Federal Circuit’s decision in *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280 (Fed. Cir. 2000), the post-CoC claims are applicable to Nokia’s acts of infringement on and after June 8, 2010, the issuance date of the CoC; whereas the pre-CoC claims are applicable to Nokia’s acts of infringement before June 8, 2010. The narrow supplementation, which introduces no new product, or technology to the case, causes no prejudice to Nokia, and will not upset the existing case schedule in any way.

## **NATURE AND STAGE OF THE PROCEEDINGS**

Nokia filed its Complaint against Apple on October 22, 2009, in response to which Apple filed its Answer and Counterclaims on December 11, 2009. Apple’s responsive pleading included a counterclaim for infringement of the ‘453 patent. Apple subsequently amended its pleading on February 19, 2010 for reasons unrelated to the ‘453 patent. On March 11, 2010, Nokia filed a motion to dismiss Apple’s non-patent counterclaims pursuant to Fed. R. Civ. P.

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<sup>1</sup> Both the post-CoC claims and pre-CoC claims are valid and infringed. As shown herein below, the PTO never rejected the pre-CoC claims.

12(b)(6). On June 3, 2010, this Court denied Nokia's motion. On July 1, 2010, Nokia filed its Answer to Apple's First Amended Counterclaims. Under the Court's May 3, 2010 scheduling order, the deadline by which to amend or supplement the pleadings is August 30, 2010. Fact discovery is scheduled to close on July 15, 2011, and the trial on the parties' patent claims is scheduled to begin May 21, 2012.

### **SUMMARY OF ARGUMENT**

The Court should grant Apple's targeted request for at least three reasons. First, the rules favor granting leave to supplement pleadings. Second, Apple has good cause for the supplementation, and courts have commonly allowed parties to supplement their claims to add a Certificate of Correction. Third, Apple's supplementation causes no prejudice to Nokia, and will not upset the existing case schedule.

### **STATEMENT OF FACTS**

On June 8, 2010, the United States Patent and Trademark Office (the "PTO") issued a CoC for the '453 patent. (Exh. J, '453 CoC.) The CoC addresses a PTO omission that Apple did not cause. The omission occurred when the PTO issued the '453 claims on June 3, 2008 without incorporating certain claim amendments that arose out of a March 20, 2008 examiner interview. As shown in the PTO's summary of the March 20, 2008 interview, the examiner suggested the omitted claim amendments, which Apple promptly put in writing in the form of a March 26, 2008 facsimile. (See Exh. 3, April 8, 2008 interview summary; Exh. 4, July 17, 2008 request for CoC, including the March 26, 2008 amendment.) The claims that issued on June 3, 2008 lacked the March 26, 2008 amendment. (See Exh. 5, originally-issued '453 patent.)

On July 17, 2008, Apple filed a request for a CoC seeking to correct the PTO omission. (See Exh. 4, July 17, 2008 request for CoC.) On August 21, 2008, the PTO approved the request in part, but indicated that the deletion of a single word on one line of claim 15 was not expressly

spelled out, even though Apple already attached the entire March 26, 2008 amendment showing the deletion in the customary strike-through format. (See Exh. 6, August 21, 2008 response for CoC; Exh. 4, July 17, 2008 request for CoC, including the March 26, 2008 amendment.) On May 7, 2010, Apple filed a renewed request for a Certification of Correction, incorporating its previous request and also expressly spelling out the deletion of the one word on one line of claim 15. (See Exh. 7, May 7, 2010 request for CoC.) On June 8, 2010, the PTO issued the CoC, adopting the March 26, 2008 facsimile in its entirety. (Exh. J, '453 CoC.)

Notably, the PTO did not reject the pre-CoC claims, which issued on June 3, 2008. The pre-CoC claims were added in a Request for Continued Examination (“RCE”) filed on February 26, 2008. (Exh. 8, February 26, 2008 RCE.) There are no subsequent office actions rejecting any of the claims.

## ARGUMENT

### **I. The Rules Favor Granting Leave To Supplement Pleadings.**

Under Federal Rule of Civil Procedure 15(d), a party may move for leave to supplement its pleading “upon reasonable notice and upon such terms as are just” in order to “set[] forth transactions or occurrences or events which have happened since the date of the pleading sought to be supplemented.” “The standard applicable to motions to amend under Fed. R. Civ. P. 15(d) is essentially the same standard that applies to Fed. R. Civ. P. 15(a).” *Medeva Pharma Ltd. v. Am. Home Prods. Corp.*, 201 F.R.D. 103, 104 n.3 (D. Del. 2001).

Federal Rule of Civil Procedure 15(a) provides that courts should grant motions for leave to amend pleadings “when justice so requires.” Fed. R. Civ. P. 15(a); *Foman v. Davis*, 371 U.S. 178, 182 (1962). This standard applies equally to answers, defenses, and counterclaims. See, e.g., *Justofin v. Metropolitan Life Ins. Co.*, 372 F.3d 517, 525-526 (3d Cir. 2004) (affirming grant of leave to add a counterclaim under Rule 15(a)). “In the absence of any apparent or

declared reason – such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowing the amendment, futility of amendment, etc. – leave sought should, as the rules require, be ‘freely given.’” *Foman*, 371 U.S. at 182; *see also Medeva*, 201 F.R.D. at 104. The Third Circuit has “interpreted these factors to mean that ‘prejudice to the non-moving party is the touchstone for the denial of an amendment.’” *Lorenz v. CSX Corp.*, 1 F.3d 1406, 1413-14 (3d Cir. 1993). None of these reasons for potentially denying a request to supplement exists here.

## **II. Courts Have Recognized The Propriety Of Maintaining Both Post-CoC Claims And Pre-CoC Claims In The Same Case.**

In *Southwest*, the Federal Circuit held that a CoC issued under 35 U.S.C. § 254 is only applicable to causes of action, i.e., infringing acts, arising after the issuance of the CoC. *See Southwest*, 226 F.3d 1280, 1298 (Fed. Cir. 2000). Observing that “Southwest’s cause of action against Harlequin and ECRM arose before the certificate of correction was issued,” the Federal Circuit performed its review on the pre-CoC claims. *Id.* at 1297. Numerous Federal Circuit opinions since *Southwest* have made clear that post-CoC claims and pre-CoC claims apply to separate infringing acts because each act of infringement gives rise to a separate cause of action. *See, e.g., E.I. Du Pont De Nemours v. Macdermid*, 525 F.3d 1353, 1362 (Fed. Cir. 2007) (internal citation omitted); *Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Solutions, P.C.*, 482 F.3d 1347, 1358 (Fed. Cir. 2007) (remanding pre-CoC claims for trial due to an invalid CoC). Consistent with this precedent, Apple seeks leave to supplement its pleading to maintain both the post-CoC and pre-CoC claims, covering two distinct sets of infringement activities, demarcated by the issuance of the ‘453 CoC.

Courts have commonly allowed the same type of supplementation that Apple seeks here. For example, in *Lamoureux v. AnazaoHealth Corp.*, 669 F. Supp. 2d 227, 234-37 (D. Conn. 2009), Lamoureux filed suit on an issued patent and sought leave to amend its complaint three months later when a CoC issued. Acknowledging the holdings in *Southwest* and other cases, the *Lamoureux* court held that “the critical date for purposes of determining whether the [CoC] applies is the date the cause of action arose, i.e., the date the infringing conduct occurred, and not the date the complaint was filed,” and granted leave to amend. *Id.* at 236. The court observed that unlike *Southwest Software*, *Lamoureux* was “suing for acts of infringement taking place both before and after the CoC issued.” *Id.*

A similar situation is found in *Quintec Films, Corp. v. Pinnacle Films, Inc.*, No. 4:06-cv-78, 2009 WL 3065044, at \*1 (E.D. Tenn. Sept. 18, 2009). There, *Quintec* moved under Federal Rules of Civil Procedure 15(a) and 15(d) for leave to file an amended complaint in order to add additional counts of infringement based upon patent claims amended by two CoCs issued after the suit was filed. Recognizing that “each act of infringement gives rise to a separate cause of action,” the court held that *Quintec* was entitled to assert these distinct counts of infringement and granted *Quintec’s* motion for leave to amend. *Id.* The court rejected Pinnacle’s argument that the corrected claims could not be asserted in the same lawsuit because the CoC issued after the suit was filed. *Id.*

As yet another example, a 2009 Delaware decision held that a post-filing CoC can give rise to both pre-CoC and post-CoC claims in the same case. *Cordance v. Amazon*, C.A. No. 06-491-MPT, 2009 WL 2252556, at \*3 (D. Del. July 28, 2009) (“For causes of action that arise before the correction becomes effective, the patent must be considered without the benefit of the certificate of correction. One reason for this division is because ‘each act of patent infringement

gives rise to a separate cause of action.”). The *Cordance* court ultimately elected to proceed with only the post-CoC claims because *Cordance* had not presented any expert opinion on the pre-CoC claims by the pre-trial conference. *Id.* at \*3 n.10.

Consistent with these decisions from the Federal Circuit and lower courts, Apple seeks to maintain both the pre-CoC claims and post-CoC claims of the ‘453 patent. This motion does not present the same circumstances that this Court faced when it denied a conditional motion to amend a complaint in *ISCO Int’l, Inc. v. Conductus, Inc.*, C.A. No. 01-487-GMS, 2002 WL 31498989 (D. Del. Nov. 8, 2002). In that case, *ISCO* sought to amend its complaint to include a Certificate of Correction by arguing that “the amended pleading then would ‘relate back’ to the date of the issuance of the Certificate of Correction.” *Id.* at \*2. The Court rejected *ISCO*’s “relate back” argument based on Federal Rule of Civil Procedure Rule 15(c), which states in part that “[a]n amendment of a pleading relates back to the date of the original pleading.” *Id.* In rejecting the argument, the Court correctly stated that the *Southwest* court held that a Certificate of Correction issued pursuant to 35 U.S.C. § 254 “is only effective for causes of action arising after it was issued.” *Id.* Unlike *ISCO*, Apple is not arguing that this Court should relate Apple’s supplementation to a date different from that of the original pleading. Further, when Apple’s proposed supplemental pleading is related back to the date of the original pleading under Rule 15(c), the supplementation still comports with *Southwest* because the Apple’s supplementation faithfully follows *Southwest*’s division of infringing acts for the post-CoC and pre-CoC claims. Under Apple’s supplementation, the post-CoC claims are expressly asserted under a new counterclaim and are applicable to Nokia’s infringement activities on or after June 8, 2010; whereas the pre-CoC claims remain asserted under the existing thirty-fourth counterclaim and are applicable to Nokia’s infringement activities before June 8, 2010.

**III. The Addition Of A Set Of Similar Claims Of The Same Patent Will Not Prejudice Nokia.**

The supplementation requested by Apple will in no way prejudice Nokia, much less rise to the level of “undue prejudice” that might present a basis to deny the motion. Nokia only recently answered Apple’s ‘453 counterclaim on July 1, 2010. Further, the supplementation that Apple seeks is only a set of similar claims of a patent that is already in the case. Indeed, the supplementation introduces no new product, or technology to the case. Because undue prejudice to the non-moving party is the touchstone for a denial of leave to supplement and there is no such undue prejudice to Nokia in the present matter, the Court should allow Apple to supplement.

**CONCLUSION**

For all the foregoing reasons, the Court should grant Apple’s motion to supplement its first amended answers and counterclaims with the CoC for the ‘453 patent-in-suit.

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**RULE 7.1.1 CERTIFICATION**

Pursuant to LR 7.1.1, I certify that counsel for the parties discussed the relief sought by the motion and Nokia's counsel could not determine whether it would oppose the motion as of the filing thereof.

This 30th of July, 2010.

/s/ David E. Moore  
David E. Moore

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

**CERTIFICATE OF SERVICE**

I, David E. Moore, hereby certify that on July 30, 2010, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

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