

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA**

Case No. 1:10cv023580-Civ-UU

MOTOROLA MOBILITY, INC.,

Plaintiff,

v.

APPLE INC.,

Defendant.

JURY TRIAL DEMANDED

APPLE INC.,

Counterclaim Plaintiff,

v.

MOTOROLA, INC. and
MOTOROLA MOBILITY, INC.,

Counterclaim Defendants.

**MOTOROLA MOBILITY'S NOTICE
CONCERNING OCTOBER 28, 2011 INFRINGEMENT CONTENTIONS**

PUBLIC REDACTED VERSION

I. MOTOROLA'S SUPPLEMENTAL INFRINGEMENT CONTENTIONS .

Motorola files this Notice and the attached infringement contentions in accordance with the Court's October 25, 2011 Order. (D.E. 157). These infringement contentions, attached hereto as Exhibit 1, have been supplemented from the preliminary infringement contentions Motorola served on June 1, 2011. These infringement contentions add, for example, citations to Apple confidential documents that were not available to Motorola when it served its preliminary infringement contentions based on public information. Also, Motorola has added reference to and evidence of accused products, such as the Apple iPhone 4S and iCloud, that were released after the June 1 infringement contentions.

The attached infringement contentions are not meant to be "final" contentions, and Motorola respectfully suggests that they should not be. Not only has the Court not issued a claim construction ruling yet, but Apple and Motorola are still in the midst of fact discovery. Apple has not yet provided a full production of documents responsive to Motorola's Requests for Production concerning the accused products. Nor has Apple provided any witness(es) responsive to Motorola's Rule 30(b)(6) Notice concerning the accused Apple systems and products. Apple too will almost certainly seek additional discovery from Motorola. Indeed, fact discovery does not end until January 16, 2012.

II. THE PARTIES' JUNE 1 INFRINGEMENT CONTENTIONS WERE NOT "FINAL CONTENTIONS."

During the third day of the Markman hearing, October 19, 2011, Apple stated the parties could not supplement their June 1 2011 infringement contentions due to the Court's prior order concerning the date for exchanging infringement contentions. Specifically, Apple stated: "[t]his Court set a deadline for infringement contentions that has passed, and there was nothing in that Order about them being preliminary or about anyone being able to supplement them. So there was a court-ordered deadline that has already passed." (10/19/11 Markman Tr. at 747:17-21.)

As further detailed below, this representation was incorrect.¹ The June 1 infringement contentions were intended to be “preliminary,” not final contentions. The parties’ intent to provide “preliminary” infringement contentions is consistent with the concept that each side was to be provided preliminary guidance as to what the opposing party generally was contending on infringement for purposes of the *Markman* hearing. And, each party did so.

A. Nothing in the Parties’ Submissions or The Court’s Orders Indicate Infringement Contentions, Would Be “Final” Infringement Contentions.

On December 29, 2010, the parties jointly filed a Rule 26(f) Scheduling Report in which Apple and Motorola each submitted a proposed deadline for “Initial Infringement Contentions And Asserted Claims”; Motorola’s proposal was February 25, 2011, and Apple’s was March 18, 2011. (D.E. 27). There were no proposed dates for “Final Contentions.” (*See id.*). On February 2, the Court entered the Scheduling Order, which did not contain any date or deadline for infringement or invalidity contentions. (*See* D.E. 45).

On April 25, the parties jointly filed a motion regarding procedure for claim construction related deadlines. (D.E. 77). This motion proposed a deadline of June 1 for “infringement contentions.” (*See id.*). Again, there was no mention that those infringement contentions would be final in the proposed order, nor was there any discussion to that effect between the parties in connection with the joint motion. On May 18, the parties exchanged infringement contentions even though the Court had not signed an Order agreeing to the proposed schedule in the Joint Motion. On June 1, the Court entered the Joint Order submitted on April 25, with no change to the parties’ proposals. (*See* D.E. 88).

¹ On October 24, 2011 Motorola requested that Apple agree to jointly approach the Court to correct the record on this issue. Apple did not respond to Defendants’ request.

B. Both Apple and Motorola Indicate Their June 1, 2011 Infringement Contentions Were “Preliminary,” Not “Final” Contentions.

Apple, like Motorola, indicated in its June 1 infringement contentions that they were “preliminary” and could be supplemented, like any other interrogatory response. Apple specifically raised its need for further discovery and the lack of a claim construction ruling as a basis why it reserved its right to supplement:

Apple also objects to this contention interrogatory as premature because, among other things, Counterclaim-Defendants have not yet produced documents or information about its products used to infringe the Apple Asserted Patents. Apple expressly reserves the right to amend, supplement, and/or correct its response to this interrogatory as additional information becomes available to Apple during the course of its discovery and investigation, in response to any claim construction by the Court, or in response to Counterclaim-Defendants’ responses to Apple’s interrogatories (or any supplement thereto).

(See Ex. 2 Apple’s 5/18 Supplemental Response at 3 (emphasis added)). Apple also stated that, due to this lack of discovery and claim construction ruling, its infringement contentions were “preliminary”:

These contentions are preliminary and based at least in part on publicly available information. Counterclaim-Defendants have not yet provided any discovery in this case and Apple’s investigation of Defendants’ infringement is ongoing. Accordingly, Apple may identify additional claims that are infringed and additional accused products, including products that Defendants may introduce in the future. Apple expressly reserves the right to amend its response to this Interrogatory to include such products. Also, these contentions are made based on information ascertained to date, and Apple expressly reserves the right to modify or amend the contentions contained herein based on the Court’s claim constructions or to reflect additional information that becomes available to Apple as discovery proceeds.

(See *id.* at 5 (emphasis added)).

Similarly, Motorola’s May 18 infringement contentions were titled “Preliminary Infringement Contentions.” Like Apple, Motorola reserved its right to supplement because discovery was ongoing and claim construction was not complete:

Motorola's investigation is ongoing, and discovery and claim construction are not yet complete. Motorola reserves the right to amend or supplement the asserted claims, accused Apple products, and/or preliminary infringement contentions set forth below as additional information becomes available.

(See Ex. 3, Motorola's 5/18 Preliminary Infringement Contentions at 1 (emphasis added)).

Apple raised no issue as to these statements, which were consistent with the parties' intent and Apple's own "preliminary" infringement contentions.

It is also clear that both parties intended and believed that their respective infringement contentions satisfied the Court's June 1 infringement contention deadline. As June 1 approached, neither Motorola nor Apple supplemented its infringement contentions, but instead, both parties continued to rely on their prior submissions which each had labeled "preliminary."

Given the above, it is untenable for Apple to assert that the parties understood that the prior infringement contentions were final and that no further supplementation would be appropriate.² Rather, Apple's interrogatory response correctly stated that supplementation to account for discovery and claim construction is appropriate and necessary in patent cases.

Dated: October 28, 2011

Respectfully submitted,

MOTOROLA SOLUTIONS, INC. (f/k/a
MOTOROLA, INC.) AND MOTOROLA
MOBILITY, INC.

By: /s/ Anthony Pastor

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² During the Markman hearing, Apple's counsel also represented that Motorola only accuses Apple's Enterprise Application Delivery System of infringing the '737 patent. (*See id.*). This too was incorrect. Claim 9 of the '737 patent claims a "a portable communication device," and thus Motorola accused Apple products such as iPhones, iPads, and laptop computers. (*See Ex. 3 at 2*). While Motorola did cite to public documents referencing how the accused functionality of the iPhone, iPad, etc., interacts with Apple's Enterprise Application system, Motorola's Infringement Contentions were in no way limited to that system.

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on October 28, 2011, I served the foregoing document via electronic mail on all counsel of record identified on the attached Service List.

/s/ Matthew O. Korhonen

Matthew O. Korhonen

SERVICE LIST
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Case No. 1:10cv023580-Civ-UU
United States District Court, Southern District of Florida

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