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15 INC. and SAMSUNG  
TELECOMMUNICATIONS AMERICA, LLC

16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

18  
19 APPLE INC., a California corporation,

20 Plaintiff,

21 vs.

22 SAMSUNG ELECTRONICS CO., LTD., a  
23 Korean business entity; SAMSUNG  
ELECTRONICS AMERICA, INC., a New  
24 York corporation; SAMSUNG  
TELECOMMUNICATIONS AMERICA,  
25 LLC, a Delaware limited liability company,

26 Defendant.

CASE NO. 11-cv-01846-LHK

**NOTICE OF MOTION AND MOTION  
FOR NEW TRIAL REGARDING '381  
PATENT PURSUANT TO FED. R. CIV. P.  
59 BASED ON NEWLY DISCOVERED  
EVIDENCE OR, ALTERNATIVELY, FOR  
ENTRY OF JUDGMENT ON LIABILITY**

Date: August 15, 2013

Time: 1:30 p.m.

Place: Courtroom 8, 4th Floor

Judge: Hon. Lucy H. Koh

**[PUBLIC REDACTED VERSION]**

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1 that could materially affect the necessity for and scope and contours of the partial new trial that the  
2 Court has ordered. To ensure that such direction is received before any new trial takes place, the  
3 Court should stay the balance of this action pending appeal(s) of the liability judgment.

4 This motion is based on the memorandum of points and authorities below, the trial record,  
5 the accompanying declarations of Robert J. Becher and Andries van Dam, Ph.D., all pleadings and  
6 papers on file in this action, such matters as are subject to judicial notice, and all other matters or  
7 arguments that may be presented in connection with this motion.

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1 requires that the visual effect of edge alignment be present **and** the specific purpose or cause of  
2 the computer instructions performing the snap back be to perform edge alignment. For example, if  
3 edge alignment occurs due to computer instructions that cause centering of an electronic  
4 document, as in *Lira*, Claim 19 is not infringed. As stated in the declaration of Samsung's expert,  
5 Andries van Dam, Ph.D., under this new construction, the Court or jury would have necessarily  
6 found that the New Trial Products do not infringe the '381 patent.

7 In the event the Court declines to order a new trial, it should enter judgment on liability as  
8 to all of Apple's claims and Samsung's counterclaims in light of the Federal Circuit's recent *en*  
9 *banc* decision *Robert Bosch, LLC v. Pylon Manufacturing Corp.*, \_\_\_ F.3d \_\_\_, 2013 WL 2664281  
10 (Fed. Cir. June 14, 2013), which held that that 28 U.S.C. § 1292(c)(2) provides appellate  
11 jurisdiction over a judgment in a patent case entered only on liability. Were the Court to enter  
12 such a judgment, it also should stay further proceedings in this case since a decision by the Federal  
13 Circuit may materially affect the necessity for and scope and contours of the partial new trial that  
14 the Court has ordered.

### 15 STATEMENT OF FACTS

16 The Verdict. Apple accused each of the New Trial Products of infringing the '381 patent  
17 and based its infringement case on some combination of the Browser, Gallery and Contacts  
18 applications on each accused phone.<sup>1</sup> Based on the evidence presented at trial, on August 24,  
19 2012, the jury found that the New Trial Products infringed the '381 patent and awarded damages  
20 for each of the New Trial Products.<sup>2</sup>

21 The Reexamination. An anonymous third-party filed a reexamination request for the '381  
22 patent on May 23, 2012.<sup>3</sup> On October 13, 2012, the PTO issued a first office action rejecting  
23

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24 <sup>1</sup> Dkt. 1931; Trial Tr. at 1751:15-1755:5 (Declaration of Robert J. Becher, dated June 26,  
25 2013 ("Becher Decl."), Exh. 1). A chart reflecting which applications Apple accused for each  
26 New Trial Product is attached as Exhibit 2 to the Becher Declaration. Importantly, Apple refused  
to break out the accused phones by application as proposed on a verdict form which Samsung  
advocated. Dkt. 2286, at 8.

27 <sup>2</sup> Dkt. 1931.

28 <sup>3</sup> Notice of Intent to Issue Ex Parte Reexamination Certificate, at 2-3 (Becher Decl., Exh. 3).



1 Claim 19, the only claim at issue in this action, as anticipated by the *Lira* reference.<sup>4</sup> On March  
 2 29, 2013, the Examiner issued a final office action rejecting Claim 19 of the '381 patent over the  
 3 *Lira* reference.<sup>5</sup> On April 29, 2013, this Court informed Apple that if the PTO confirmed its  
 4 rejection, the Court would likely stay the new damages trial as to the '381 Patent pending PTO  
 5 appeals.<sup>6</sup>

6 Apple's Statements to the Examiner Limiting Claim 19. In response to the final office  
 7 action and the news regarding a likely stay of the trial on '381 patent, Apple presented a brand  
 8 new interpretation of Claim 19 to the PTO during two interviews, on May 9 and May 13, 2013,  
 9 and in a supplemental response filed May 13, 2013.<sup>7</sup> As reflected in the Notice of Intent to Issue  
 10 Ex Parte Reexamination Certificate, Apple proffered its new construction in response to the  
 11 Examiner's probing questions about the *Lira* reference:

12 The Patent Owner's Representatives noted that claim 19, specifically  
 13 teaches "instructions for" translating "until the area beyond the edge  
 14 of the electronic document is no longer displayed," where the Office  
 15 asked for further clarification as to whether there is support for  
 16 actual coded instructions that effect this process, and noted that if  
 17 there where [sic] this would be a good area to focus. The Office  
 18 noted that though *corrective traversal* in *Lira* appears to stop when  
 19 the area beyond the edge of the document is no longer displayed, it  
 20 is not specifically responsive to instructions requiring said *stop*  
 21 *condition* (area beyond the edge of the electronic document is no  
 22 longer displayed) but rather a result of instructions to center (same  
 23 effect, different cause).<sup>8</sup>

24 In its supplemental response to the PTO, Apple conceded that *Lira* "achieves the visual  
 25 result" called for by Claim 19, but argued that it still did not invalidate Claim 19 because the  
 26 computer instructions that caused the snap back function to occur had the purpose of causing the  
 27 web page to "center" on the screen rather than explicitly seeking to perform edge alignment.<sup>9</sup>

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24 <sup>4</sup> Dkt. 2079. In addition to claim 19, the PTO rejected all other claims in this office action.

25 <sup>5</sup> Dkt. 2291.

26 <sup>6</sup> April 29, 2013 Hearing Transcript, at 12:9-13 (Becher Decl., Exh. 4).

27 <sup>7</sup> Notice of Intent to Issue Ex Parte Reexamination Certificate, at 2-3 (Becher Decl., Exh. 3).

28 <sup>8</sup> Notice of Intent to Issue Ex Parte Reexamination Certificate, at 3 (Becher Decl., Exh. 3)  
 (emphases in original).

<sup>9</sup> van Dam Decl., ¶24.

1 Under the header "STATEMENT OF REASONS FOR PATENTABILITY AND/OR  
2 CONFIRMATION," the Examiner explained:

3 **The '381 Patent Specification defines these "instructions" as**  
4 **(from column 3, lines 33-37) (paragraph [0012]):**

5 "The one or more programs further include instructions for  
6 translating the document in a second direction until the area beyond  
7 the edge of the document is no longer displayed, after the object is  
8 no longer detected on or near the touch screen display."

9 \* \* \*

10 In the supplemental response filed 5/13/2013, Patent Owner  
11 concedes that:

12 **"While Lira's snap-to-column function incidentally**  
13 **achieves the visual result of translating in the second direction**  
14 **"until the area beyond the edge of the electronic document is no**  
15 **longer displayed" (only when the width of the column**  
16 **corresponds to the width of the display), Lira's function clearly**  
17 **does so through the use of executable program instructions**  
18 **having a different stop condition based on centering of the**  
19 **column." (see page 7).<sup>10</sup>**

20 The Examiner then confirmed Claim 19, finding that *Lira* was not invalidating prior art:

21 In summary, Claim 19 is Confirmed, as there is no prior art disclosure of a similar  
22 device with "*programs including . . . instructions for translating the electronic*  
23 *document in a second direction until the area beyond the edge of the electronic*  
24 *document is no longer displayed to display a fourth portion of the electronic*  
25 *document, wherein the fourth portion is different from the first portion, in response*  
26 *to detecting that the object is no longer on or near the touch screen display.*"<sup>11</sup>

27 Through its statements during reexamination, Apple disclaimed all subject matter with  
28 respect to Claim 19 in which the specific **purpose** or **cause** of the computer code that generates  
the snap back effect is anything other than edge alignment.<sup>12</sup> Edge alignment occurs when the  
area beyond the edge of a document is shown visually, but then the edge alignment code causes  
that area beyond the edge to disappear so that the edge of the electronic document aligns to the

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25 <sup>10</sup> Notice of Intent to Issue Ex Parte Reexamination Certificate, at 5 (emphasis  
26 original)(Becher Decl., Exh. 3) (bolding in original).

27 <sup>11</sup> Notice of Intent to Issue Ex Parte Reexamination Certificate, at 6 (Becher Decl. Exh. 3)  
(emphasis and bolding in original).

28 <sup>12</sup> van Dam Decl., ¶25.

1 edge of the screen or window.<sup>13</sup> In other words, Apple argued to the PTO that the **purpose** or  
 2 **cause** of the snap back in claim 19 must be edge alignment.<sup>14</sup>

3 At Trial, Apple Did Not Present Evidence of Infringement Under the Construction of  
 4 Claim 19 it Presented to the PTO. In order to infringe under the construction argued by Apple and  
 5 accepted by the PTO, both the visual effect of edge alignment must be present **and** the specific  
 6 purpose or cause of the computer instructions performing the snap back must be to perform edge  
 7 alignment.<sup>15</sup> By way of example, Claim 19 does not cover subject matter where the visual effect –  
 8 incidentally or otherwise – is edge alignment if the cause or purpose of the code was something  
 9 other than edge alignment.<sup>16</sup> If edge alignment occurs due to computer instructions that cause  
 10 centering of an electronic document, as in *Lira*, Claim 19 is not infringed.<sup>17</sup> But Apple's expert,  
 11 Dr. Ravin Balakrishnan, did not present evidence regarding the purpose of any code during his  
 12 trial testimony, did not analyze any code at all for the Contacts application and did not seek to  
 13 prove infringement by the Browser, Gallery or Contacts applications under this construction.<sup>18</sup> A  
 14 review of the evidence Dr. Balakrishnan presented at trial by Samsung's expert, Andries van Dam,  
 15 Ph.D., reveals that the New Trial Products do not infringe Claim 19 of the '381 patent under the  
 16 interpretation Apple presented to the PTO.<sup>19</sup>

## 17 **ARGUMENT**

### 18 **I. THE COURT SHOULD ORDER A NEW TRIAL UNDER RULE 59 BASED ON** 19 **THE REEXAMINATION OF APPLE'S '381 PATENT**

20 A court can grant a new trial under Federal Rule of Civil Procedure 59(a)(1)(A) "after a  
 21 jury trial, for any reason for which a new trial has been granted in an action at law in federal  
 22 court." Courts have held that "newly discovered evidence" is a proper basis for granting a new  
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24 <sup>13</sup> *Id.*

25 <sup>14</sup> *Id.*

26 <sup>15</sup> van Dam Decl., ¶26.

27 <sup>16</sup> *Id.*

28 <sup>17</sup> *Id.*

<sup>18</sup> van Dam Decl., ¶29.

<sup>19</sup> van Dam Decl., ¶30.

1 trial after a jury trial. *Jones v. Aero/Chem Corp.*, 921 F.2d 875, 878 (9th Cir. 1990); *SK hynix Inc.*  
 2 *v. Rambus Inc.*, 2013 WL 1915865, \*13 (N.D. Cal. 2013). A new trial is warranted based on  
 3 "newly discovered evidence" if: "(1) the evidence was discovered after trial; (2) the exercise of  
 4 due diligence would not have resulted in the evidence being discovered at an earlier stage; and (3)  
 5 the newly discovered evidence is of such magnitude that production of it earlier would likely have  
 6 changed the outcome of the case." *Defenders of Wildlife v. Bernal*, 204 F.3d 920, 929 (9th Cir.  
 7 2000). Here, each of these factors is readily satisfied based on the new claim interpretation that  
 8 Apple presented to the PTO to avoid having Claim 19 of the '381 patent invalidated based on the  
 9 prior art reference *Lira*. As a result, Samsung is entitled to a new liability trial with respect to the  
 10 New Trial Products.<sup>20</sup>

11 **A. THE EVIDENCE RELATED TO THE REEXAMINATION IS NEWLY**  
 12 **DISCOVERED**

13 In determining whether evidence is newly discovered, courts evaluate whether it existed at  
 14 the time of trial or judgment and was discovered after the trial or judgment. *Jones v. Aero/Chem*  
 15 *Corp.*, 921 F.2d 875 (9th Cir. 1990). Reexamination proceedings that take place after a trial but  
 16 are based on facts that were available at the time of the trial constitute "newly discovered  
 17 evidence." *TDM America LLC v. U.S.*, 100 Fed.Cl. 485, 491 (Fed.Cl. 2011); *Standard Havens*  
 18 *Products, Inc. v. Gencor Industries, Inc.*, 897 F.2d 511, 514-515 (Fed. Cir. 1990); *SK hynix Inc. v.*  
 19 *Rambus Inc.*, 2013 WL 1915865, \*13 (N.D. Cal. 2013). The Federal Circuit's decision in  
 20 *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 897 F.2d 511, 515 (Fed. Cir. 1990), is  
 21 instructive. In *Standard Havens*, the Deputy Assistant Commissioner of Patents and Trademarks  
 22 withdrew a certificate of correction and ordered reexamination of a patent, finding that a specific  
 23 item of prior art raised "a substantial new question of patentability." *Id.* at 514. The defendant

24 \_\_\_\_\_  
 25 <sup>20</sup> If the Court orders a new trial on liability, the Court should also vacate the damages awards  
 26 for the Fascinate, Galaxy S 4G, Galaxy S II (AT&T), Galaxy Tab 10.1 (WiFi), Mesmerize and  
 27 Vibrant. *See Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1310 (Fed. Cir.  
 28 2007) (recognizing need for new trial on damages in case involving multiple patents where the  
 jury's verdict does not break down damages by patent and a finding of liability as to one patent is  
 reversed). Samsung proposes to brief this issue on a schedule set by the Court.

1 Gencor argued that the PTO's withdrawal of the certificate of correction and decision to order  
2 reexamination constituted newly discovered evidence under Federal Rule of Civil Procedure 60(b)  
3 – which is governed by the same general standard as Federal Rule of Civil Procedure 59(d) – and  
4 demanded a new trial.<sup>21</sup> *Id.* at 515. The court accepted without question that the PTO's actions  
5 constituted newly discovered evidence and found that Gencor "raise[d] serious questions of law  
6 which could necessitate a new trial." *Id.* at 515.

7 *TDM America LLC v. U.S.*, 100 Fed.Cl. 485 at 487, 488 (Fed.Cl. 2011), also found  
8 developments during a reexamination to be new evidence. In *TDM America LLC*, an anonymous  
9 third party initiated a reexamination proceeding related to the two patents-in-suit and asserted that  
10 the prior art presented questions of patentability. *Id.* at 488. The court subsequently granted  
11 summary judgment of noninfringement to the defendant. *Id.* at 487. Upon completion of the  
12 reexamination which found the claims valid, plaintiff TDM moved for relief under Federal Rule of  
13 Civil Procedure 60(b)(2) and argued the reexamination constituted new evidence. *Id.* at 490-491.  
14 The court held that the motion was based on newly discovered evidence and held that "the facts to  
15 which the reexamination pertained were in existence before the Court's decision." *Id.* at 491  
16 (*citing Chilson v. Metropolitan Transit Authority*, 796 F.2d 69 (5th Cir. 1986)).

17 In *SK hynix Inc. v. Rambus Inc.*, 2013 WL 1915865, \*2, \*13 (N.D. Cal. 2013), Judge  
18 Whyte of the Northern District of California also recognized that developments in a reexamination  
19 that take place after a trial can constitute "newly discovered evidence." The plaintiff SK hynix  
20 filed a Rule 59 motion based on the fact the PTO found several claims invalid due to obviousness  
21 and anticipation during reexamination proceedings. Referring to *Standard Havens Products*, the  
22 court stated: "However, the Federal Circuit has suggested that the Patent and Trademark Office's  
23 decisions to withdraw approval of a certificate of correction and order reexamination might

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27 <sup>21</sup> The standard for granting new trials under Rule 60 and Rule 59 are "essentially the same"  
28 although a Rule 59 motion may require a slightly lower showing than a motion under Rule 60.  
*Wharf v. Burlington N. R.R. Co.*, 60 F.3d 631, 637 (9th Cir. 1995).

1 warrant a new trial. *See Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 897 F.2d 511,  
2 515 (Fed. Cir. 1990)." *SK hynix Inc. v. Rambus Inc.*, 2013 WL 1915865, \*13 (N.D. Cal. 2013).

3 In this case, the reexamination commenced months before the trial started but was not  
4 completed until after trial. Moreover, the reexamination was based on facts, such as the *Lira* prior  
5 art reference and the patent, that were in existence at the time of trial. As a result, evidence  
6 regarding the reexamination proceedings is newly discovered evidence under Federal Rule of Civil  
7 Procedure 59 and the authorities cited above.

8 **B. THE EXERCISE OF DILIGENCE WOULD NOT HAVE RESULTED IN**  
9 **THE EVIDENCE BEING DISCOVERED AT AN EARLIER STAGE**

10 Moreover, the exercise of diligence would not have caused the evidence to be discovered  
11 earlier. Samsung's expert's report identified the *Lira* reference, the expert report of Dr.  
12 Balakrishnan distinguished the *Lira* reference and Dr. Balakrishnan subsequently offered an  
13 analysis of infringement of the '381 patent at trial.<sup>22</sup> Given the *Lira* reference was extensively  
14 litigated in this Court, Samsung could not have predicted that Apple would seek to overcome *Lira*  
15 at the PTO by proffering an interpretation of Claim 19 that was drastically narrower than the  
16 interpretation it offered in the trial. As a result, no matter how diligently Samsung investigated, it  
17 could have never discovered Apple's new position regarding Claim 19 sooner.<sup>23</sup> And Samsung  
18 was diligently monitoring the reexamination and discovered that Apple had been successful in  
19 asserting a new interpretation on June 12, 2013, the day the PTO affirmed Claim 19.<sup>24</sup>

21 <sup>22</sup> Expert Report of Andries van Dam, Ph.D. Regarding Invalidity of U.S. Patent No.  
22 7,469,381 (Becher Decl., Exh. 5); Rebuttal Expert Report of Ravin Balakrishnan, Ph.D. Regarding  
23 Validity of U.S. Patent 7,469,381 (Becher Decl., Exh. 6).

24 <sup>23</sup> Further, the timing of the reexamination proceedings initiated by an anonymous third party  
25 on May 23, 2012 is consistent with a finding of diligence too. The third party filed the request  
26 months in advance of the trial in this action and slightly over a year after April 15, 2011 – the date  
27 Apple initiated its lawsuit against Samsung. Moreover, the reexamination request was filed  
28 shortly after the Court's April 4, 2012 claim construction order. The request cited to – and relied  
on in part – the Court's April 4, 2012 Order Construing Disputed Claim Terms to support its  
argument that *Lira* was invalidating prior art. Request for *Ex Parte* Reexamination, at 33, n.2  
(Becher Decl., Exh. 7).

<sup>24</sup> Dkts. 2304, 2308, 2323.



1 Office are admissible under the public records exception set forth in Federal Rule of Evidence  
2 803(8). *Id.* at \*2-4.

3 Through its statements during reexamination, Apple disclaimed all subject matter with  
4 respect to Claim 19 in which the specific **purpose** or **cause** of the computer code that generates  
5 the snap back effect is anything other than edge alignment.<sup>26</sup> Edge alignment occurs when the  
6 area beyond the edge of a document is shown visually, but then the edge alignment code causes  
7 that area beyond the edge to disappear so that the edge of the electronic document aligns to the  
8 edge of the screen or window.<sup>27</sup> In order to infringe under the construction argued by Apple and  
9 accepted by the PTO, both the visual effect of edge alignment must be present **and** the specific  
10 purpose or cause of the computer instructions performing the snap back must be to perform edge  
11 alignment.<sup>28</sup> By way of example, Claim 19 does not cover subject matter where the visual effect –  
12 incidentally or otherwise – is edge alignment if the cause or purpose of the code was something  
13 other than edge alignment.<sup>29</sup> If edge alignment occurs due to computer instructions that cause  
14 centering of an electronic document, as in *Lira*, Claim 19 is not infringed.<sup>30</sup>

15 **D. UNDER THE NEW CLAIM CONSTRUCTION ADVOCATED BY APPLE**  
16 **AND ADOPTED BY THE EXAMINER, THE JURY WOULD NOT HAVE**  
17 **FOUND INFRINGEMENT OF THE '381 PATENT**

18 New information about the construction of the '381 patent from the reexamination would  
19 have changed the outcome of the case as it would have resulted in a finding of noninfringement  
20 with respect to the '381 patent. As shown by the declaration of Samsung's expert Andries van  
21 Dam, Ph.D. who evaluated the evidence Apple proffered at trial to support its claim that Samsung  
22 infringed the '381 patent, the Browser, Gallery and Contacts applications – the applications Apple  
23 accused at trial – do not infringe under the construction Apple proffered during reexamination.

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25 <sup>26</sup> van Dam Decl., ¶25.

26 <sup>27</sup> *Id.*

27 <sup>28</sup> *Id.* at ¶26.

28 <sup>29</sup> *Id.*

<sup>30</sup> *Id.*



1 Apple's expert, Dr. Ravin Balakrishnan, did not present evidence regarding the purpose of the  
 2 code when he testified concerning infringement at trial, did not even present code for the Contacts  
 3 application, and a review of the evidence he did present reveals that the New Trial Products do not  
 4 infringe under the interpretation Apple used to convince the PTO to confirm Claim 19.<sup>31</sup> As a  
 5 consequence, Samsung would have prevailed at trial and defeated Apple's claim that the New Trial  
 6 Products infringe the '381 patent and is therefore entitled to a new trial as to liability.<sup>32</sup>

7 **Gallery.** The code for Gallery that Dr. Balakrishnan relied on at trial does not perform  
 8 edge alignment.<sup>33</sup> Instead, it performs centering, which is precisely what Apple argued was not  
 9 covered by Claim 19 when it distinguished *Lira* during reexamination.<sup>34</sup> [REDACTED]

10 [REDACTED]  
 11 [REDACTED]<sup>35</sup> [REDACTED]  
 12 [REDACTED]<sup>36</sup> In landscape mode, the image is  
 13 bordered on its left and right edges by background rectangles and is clearly not edge aligned when  
 14 it comes to rest after snapping back.<sup>37</sup> In portrait mode, the image appears to be both edge aligned  
 15 and centered, but the same centering logic as used in landscape mode is providing this visual

16  
 17 <sup>31</sup> van Dam Decl., ¶29.

18 <sup>32</sup> Samsung does not infringe under the doctrine of equivalents either. The doctrine of  
 19 prosecution history estoppel provides that a patentee who relinquishes subject matter during  
 20 prosecution, either by amendment or argument, cannot subsequently claim the relinquished subject  
 21 matter is covered by its patent under the doctrine of equivalents. *Eagle Comtronics, Inc. v. Arrow*  
 22 *Communication Laboratories Inc.*, 305 F.3d 1303, 1315-1316 (Fed. Cir. 2002); *Aquatex*  
 23 *Industries, Inc. v. Techniche Solutions*, 419 F.3d 1374, 1382 (Fed. Cir. 2005). Based on its  
 24 statements to the examiner, Apple surrendered all subject matter in which the purpose of the  
 25 computer instructions that cause the snap back effect is anything other than strict edge alignment.  
 26 van Dam Decl., ¶25. Thus, Apple cannot argue that computer instructions whose purpose or cause  
 27 is something other than edge alignment – but that is in some way equivalent to such code –  
 28 infringes Claim 19. van Dam Decl., ¶27. Moreover, even if Apple could argue infringement  
 under the doctrine of equivalents, there would be no infringement of Claim 19 because there are  
 substantial differences between the Gallery and Browser code and Claim 19. van Dam Decl.,  
 ¶¶37-38, 46-47.

<sup>33</sup> Moreover, a review of related code confirms this same conclusion. van Dam Decl., ¶36.

<sup>34</sup> *Id.* at ¶33.

<sup>35</sup> *Id.* at ¶34.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

1 effect.<sup>38</sup> As a consequence, the Gallery application does not infringe Claim 19 under Apple's  
2 interpretation.<sup>39</sup>

3 **Browser.** With respect to Browser, Apple based its infringement case [REDACTED]  
4 [REDACTED]<sup>40</sup> [REDACTED]

5 [REDACTED].<sup>41</sup> However, the cause of the snap back effect is not edge alignment  
6 code, as now required by Claim 19.<sup>42</sup>

7 [REDACTED]  
8 [REDACTED]<sup>43</sup> [REDACTED]

9 [REDACTED]  
10 [REDACTED]

11 [REDACTED]<sup>44</sup> [REDACTED]  
12 [REDACTED]

13 [REDACTED]  
14 [REDACTED]<sup>45</sup> [REDACTED]

15 [REDACTED]  
16 [REDACTED]

17 [REDACTED]<sup>46</sup>  
18 [REDACTED]

19 [REDACTED]<sup>47</sup> [REDACTED]  
20

21 \_\_\_\_\_  
22 <sup>38</sup> van Dam Decl., ¶34.

23 <sup>39</sup> *Id.* at ¶37.

24 <sup>40</sup> *Id.* at ¶40.

25 <sup>41</sup> *Id.* at ¶41.

26 <sup>42</sup> *Id.*

27 <sup>43</sup> *Id.* at ¶43.

28 <sup>44</sup> *Id.* If it is determined that the user has not moved his finger with sufficient velocity,  
doFling() exits, and an alternative event handler begins operation. *Id.* at ¶43, n.1.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

<sup>47</sup> *Id.* at ¶44.

1 [REDACTED]<sup>48</sup> [REDACTED]

2 [REDACTED]

3 [REDACTED]

4 [REDACTED]<sup>49</sup> [REDACTED]

5 [REDACTED]<sup>50</sup>

6 **Contacts.** The evidence Apple presented at trial does not show infringement by the  
 7 Contacts application under the new construction of Claim 19 either.<sup>51</sup> Dr. Balakrishnan did not  
 8 discuss any computer instructions for the Contacts application at trial or in his expert report.<sup>52</sup>  
 9 Instead, he relied solely on images of the application to support his conclusion that the application  
 10 infringed.<sup>53</sup> But, with respect to Contacts, it is impossible to tell what the purpose of the snap  
 11 back code is from simply looking at images of the application in action.<sup>54</sup> Thus, there is no  
 12 evidence in the record that supports a finding of infringement of the Contacts application under the  
 13 new meaning of Claim 19.<sup>55</sup>

14 **II. ALTERNATIVELY, THE COURT SHOULD ENTER JUDGMENT ON**  
 15 **LIABILITY**

16 If the Court declines to order a new trial, then Samsung respectfully requests that, in light  
 17 of the Federal Circuit’s recent *en banc* decision in *Robert Bosch, LLC v. Pylon Manufacturing*  
 18 *Corp.*, \_\_ F.3d \_\_, 2013 WL 2664281 (Fed. Cir. June 14, 2013), the Court enter judgment as to  
 19 liability on all claims and counterclaims so that the parties may pursue immediate, interlocutory  
 20 appeals pursuant to 28 U.S.C. § 1292(c). That provision states that an appeal may be made “from  
 21 a judgment in a civil action for patent infringement which would otherwise be appealable to the  
 22 United States Court of Appeals for the Federal Circuit and *is final except for an accounting.*” 28

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23 <sup>48</sup> van Dam Decl., ¶44.  
 24 <sup>49</sup> *Id.*  
 25 <sup>50</sup> *Id.*  
 26 <sup>51</sup> *Id.* at ¶48.  
 27 <sup>52</sup> *Id.*  
 28 <sup>53</sup> *Id.*  
<sup>54</sup> *Id.*  
<sup>55</sup> *Id.*

1 U.S.C. § 1292(c) (emphasis added). In *Robert Bosch*, the Federal Circuit interpreted an  
2 “accounting” to include “the determination of damages,” 2013 WL 2664281, \*6, thus clarifying  
3 that appellate jurisdiction exists over a judgment in a patent case entered on liability alone.

4 In so holding, the Federal Circuit emphasized that, in enacting the predecessor to Section  
5 1292(c)(2), Congress was motivated by the “high cost of an ‘accounting.’” 2013 WL 2664281, at  
6 \*8 (citing H.R. REP. NO. 1890, 69th Cong., 2d Sess. 1 (1927); S. REP. NO. 1319, 69th Cong. 2d  
7 Sess. (1927)). Indeed, the Federal Circuit noted that “[g]iven the substantial reversal rate of  
8 liability determinations on appeal, the whole expense of a damages trial is often wasted,” and thus  
9 the “policy concerns that motivated Congress to grant jurisdiction over cases that are final except  
10 for an accounting” remain true today. *Id.*

11 The Court has already resolved liability for all of Apple’s claims, as well as Samsung’s  
12 counterclaims, and thus it should enter judgment on those liability determinations now so that the  
13 Federal Circuit may provide the Court and the parties with immediate direction that will apply to  
14 all further proceedings in this case. While this Court correctly determined that the March 1 Order  
15 granting a new damages trial is not presently appealable (Becher Decl., Exh. 4, April 29, 2013  
16 Hearing Tr. at 26-37), were the Court to enter judgment on liability, the parties would be able to  
17 appeal as of right under 28 U.S.C. § 1292(c)(2), and such an appeal would afford the Federal  
18 Circuit the opportunity to review all liability issues involving Apple’s claims and Samsung’s  
19 counterclaims.

20 As Samsung has previously explained in seeking entry of a partial final judgment pursuant  
21 to Fed. R. Civ. P. 54(b), obtaining the benefit of the Federal Circuit’s holdings *before* proceeding  
22 with any new damages trial would promote judicial economy and efficiency by resolving which  
23 patents and products should properly be the subject of any new trial, the proper standards and  
24 instructions to be applied in such a new trial, and ultimately whether there need be any new trial at  
25 all. It would be wasteful to conduct a new trial on damages only later to obtain Circuit guidance  
26 that necessitates yet a third trial. By contrast, entering a liability judgment now and staying the  
27 partial re-trial on damages until that direction can be obtained would help avoid the risk that the  
28

1 ordered new trial will, in the future, itself need to be supplemented with still more trials addressing  
 2 other claims and issues.<sup>56</sup>

3 To be sure, *Robert Bosch* arose in circumstances where, unlike here, the district court had  
 4 bifurcated the issues of damages (and willfulness) from liability. *See* 2013 WL 2664281, at \*1.  
 5 But *Robert Bosch* did not turn on that procedural wrinkle, as the Federal Circuit unambiguously  
 6 held that an “‘accounting’ in the context of § 1292(c)(2) includes the determination of damages.”  
 7 *Id.* at \*6. Thus, here, a judgment would be “final except for an accounting,” as required by  
 8 Section 1292(c)(2), were it to address liability but not the portion of the jury’s damages verdict  
 9 that the Court upheld against post-trial challenge. But even were Section 1292(c)(2) limited to  
 10 circumstances in which a district court bifurcates liability from damages, the Court did essentially  
 11 that here in ordering a new trial on damages but not liability (notwithstanding Samsung’s Seventh  
 12 Amendment argument). Indeed, the substantial potential efficiencies that prompted the enactment  
 13 of what is now Section 1292(c)(2) and that supported the Federal Circuit’s decision in *Robert*  
 14 *Bosch* (*see supra*, at 1) are achievable here, as an immediate appellate determination of liability  
 15 could affect the scope--or even necessity--of the scheduled partial retrial on damages.

### 16 CONCLUSION

17 Because Apple has adopted an entirely new and significantly narrower claim construction  
 18 in connection with reexamination proceedings and it cannot prove infringement of the '381 patent  
 19 under this construction, the Court should grant Samsung's motion for a new trial on liability under

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20  
 21 <sup>56</sup> While a district court is not obligated to stay a damages trial pending an appeal pursuant to  
 22 Section 1292(c)(2), the Federal Circuit has recognized that “the policy underlying § 1292(c)(2)  
 23 was to allow a district court to stay a damages trial pending appeal.” *In re Calmar, Inc.*, 854 F.2d  
 24 461, 463-64 (Fed. Cir. 1988); *see also id.* (“[I]t is clear that the purpose of the legislation, §  
 25 1292(c)(2), allowing interlocutory appeals in patent cases was to *permit* a stay of a damages  
 26 trial.”). As Samsung has previously explained, a stay of the damages re-trial pending appeal is  
 27 appropriate here under the standard set forth in *Landis v. North American Co.*, 299 U.S. 248, 254-  
 28 55 (1936), and its progeny because (1) Apple will suffer no prejudice from a stay that postpones  
 any new trial until the Federal Circuit rules on important legal issues that are likely to affect the  
 necessity for and scope of any new trial; (2) both parties will be prejudiced if they must go  
 forward with a new trial without the benefit of a decision from the Federal Circuit, for this may  
 well lead to waste and inequity and multiple retrials; and (3) a stay is in the interest of judicial  
 economy and efficiency for the same reasons. *See* Dkt. 2281, at 17-18; Dkt. 2290, at 14-16.

1 the '381 patent as to all the New Trial Products. In the event the Court does not order a new trial,  
2 however, the Court should enter judgment on liability as to all of Apple's claims and Samsung's  
3 counterclaims, and should stay further proceedings in this case pending the resolution of appeal(s)  
4 from that judgment.

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Respectfully submitted,

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