1   QUINN EMANUEL URQUHART &
    SULLIVAN, LLP
2   Charles K. Verhoeven (Bar No. 170151)
    charlesverhoeven@quinnemanuel.com
3   Kevin A. Smith (Bar No. 250814)
    kevinsmith@quinnemanuel.com
4   50 California Street, 22nd Floor
    San Francisco, California 94111
5   Telephone: (415) 875-6600
    Facsimile: (415) 875-6700
6
    Kevin P.B. Johnson (Bar No. 177129 (CA);
7   2542082 (NY))
    kevinjohnson@quinnemanuel.com
8   Victoria F. Maroulis (Bar No. 202603)
    victoriamaroulis@quinnemanuel.com
9   555 Twin Dolphin Drive, 5th Floor
    Redwood Shores, California 94065
10 Telephone: (650) 801-5000
    Facsimile: (650) 801-5100
11
    William C. Price (Bar No. 108542)
12 williamprice@quinnemanuel.com
    Patrick M. Shields (Bar No. 204739)
13 patrickshields@quinnemanuel.com
    865 South Figueroa Street, 10th Floor
14 Los Angeles, California 90017-2543
    Telephone: (213) 443-3000
15 Facsimile: (213) 443-3100

16 Attorneys for SAMSUNG ELECTRONICS CO.,
    LTD., SAMSUNG ELECTRONICS AMERICA,
17 INC. and SAMSUNG
    TELECOMMUNICATIONS AMERICA, LLC

STEPTOE & JOHNSON, LLP
John Caracappa (*pro hac vice*)
jcaracappa@steptoe.com
1330 Connecticut Avenue, NW
Washington, D.C. 20036
Telephone: (202) 429-6267
Facsimile: (202) 429-3902

18

19   UNITED STATES DISTRICT COURT

20   NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

21 APPLE INC., a California corporation,   CASE NO. 12-CV-00630-LHK

22   Plaintiff,

23   vs.   **SAMSUNG'S PATENT LOCAL RULE
                                                     3-3 AND 3-4 DISCLOSURES**
24 SAMSUNG ELECTRONICS CO., LTD., a
    Korean business entity; SAMSUNG
25 ELECTRONICS AMERICA, INC., a New
    York corporation; SAMSUNG
26 TELECOMMUNICATIONS AMERICA,
    LLC, a Delaware limited liability company,

27   Defendants.

28

1   Pursuant to the Court's Minute Order and Case Management Order, and Patent Local Rules

2 3-3 and 3-4, Defendants Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and

3 Samsung Telecommunications America, LLC (collectively, "Samsung") submit invalidity

4 contentions and document productions for U.S. Patent Numbers 5,666,502 ("the '502 Patent");

5 5,946,647 ("the '647 patent"); 6,847,959 ("the '959 patent"); 7,761,414 ("the '414 patent);

6 8,014,760 ("the '760 patent); 8,046,721 ("the '721 patent"); 8,074,172 ("the '172 patent"); and

7 8,086,604 ("the '604 patent") (collectively, "Apple Asserted Patents"). Apple Inc. is referred to

8 herein as "Apple" or "Plaintiff."

9   **PATENT LOCAL RULE 3-3 DISCLOSURES**

10   1.   This disclosure is directed to preliminary invalidity and unenforceability issues

11 only and does not address claim construction or non-infringement. Samsung reserves all rights

12 with respect to such issues, including but not limited to its position that claims of the Apple

13 Asserted Patents are to be construed in a particular manner and are not infringed.

14   2.   These invalidity contentions are preliminary and are based on Samsung's current

15 knowledge, understanding, and belief as to the facts and information available as of the date of

16 these contentions. Samsung has not yet completed its investigation, discovery, or analysis of

17 information related to this action, and additional discovery may require Samsung to supplement or

18 amend its invalidity contentions. While Samsung has made a good-faith effort to provide a

19 comprehensive list of prior art relevant to this case, Samsung reserves the right to modify or

20 supplement its prior art list and invalidity contentions at a later time with or based upon pertinent

21 information that may be subsequently discovered from Apple or third-parties. Moreover,

22 discovery is ongoing and Samsung reserves the right to pursue all other defenses that may be

23 available to it, including but not limited to defenses that the Apple Asserted Patents are

24 unenforceable based on laches, estoppel, waiver acquiescence, inequitable conduct, patent misuse,

25 patent exhaustion, express or implied license, or any other grounds.

26   3.   Any invalidity analysis depends, ultimately, upon claim construction, which is a

27 question of law reserved for the Court. The asserted claims have not yet been construed by the

28 Court in this case and, thus, Samsung has not yet had the opportunity to compare the asserted

1   claims of the Apple Asserted Patents (as construed by the Court) with the prior art. Samsung

2   reserves the right to amend, supplement, or materially modify its invalidity contentions after the

3   claims have been construed by the Court. Samsung also reserves the right to amend, supplement,

4   or materially modify its invalidity contentions based on any claim construction positions that

5   Apple may take in this case. Samsung also reserves the right to assert that a claim is indefinite,

6   not enabled, or fails to meet the written description requirement based on any claim construction

7   position Plaintiff may take in this case or based on any claim construction the Court may adopt in

8   this case.

9   4.   Samsung's invalidity contentions are directed to the claims asserted by Plaintiff that

10   are identified in Plaintiff's June 15, 2012 Disclosure of Asserted Claims and Infringement

11   Contentions. In its Infringement Contentions, however, Plaintiff states that it "reserves the right to

12   supplement or amend these disclosures as further facts are revealed during the course of this

13   litigation." Samsung therefore reserves the right to modify, amend, supplement or otherwise alter

14   its invalidity contentions in the event that Plaintiff supplements or amends its infringement

15   contentions or takes a claim construction position that is different than or in addition to those set

16   forth in its infringement contentions, or for any other reason constituting good cause to modify,

17   amend, supplement or otherwise alter these invalidity contentions.

18   5.   Samsung further contends that Plaintiff appears to be pursuing overly broad

19   constructions of the asserted claims of the Apple Asserted Patents in an effort to piece together an

20   infringement claim where none exists and to accuse products that do not practice the claims as

21   properly construed. At the same time, Plaintiff's infringement contentions are in many places too

22   general and vague to discern exactly how Plaintiff contends each accused product practices each

23   element of the asserted claims. These invalidity contentions are not intended to be, and are not, an

24   admission that the asserted claims are infringed by any of Samsung's products or technology, that

25   any particular feature or aspect of any of the accused products practices any elements of the

26   asserted claims, or that any of Plaintiff's apparent constructions are supportable or proper. To the

27   extent that any of the prior art discloses the same functionality or feature of any of the accused

28   products, Samsung reserves the right to argue that said feature or functionality does not practice

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   any element of any of the asserted claims, and to argue, in the alternative, that if said feature or

2   functionality is found to practice any element of any of the asserted claims of the Apple Asserted

3   Patents, then the prior art reference demonstrates that that element is not novel to the invention

4   and that the claim is not patentable.

5   6.   Attached hereto as Exhibits A through H are representative claim charts that

6   demonstrate how the asserted claims of the Apple Asserted Patents are invalid in view of certain

7   prior art. The references cited in Exhibits A through H may disclose the limitations of the asserted

8   claims of the Apple Asserted Patents either expressly and/or inherently. Moreover, the suggested

9   obviousness combinations are in the alternative to Samsung's anticipation contentions. The

10 obviousness combinations set forth in these contentions should not be construed to suggest that

11 any reference included in any combination is not anticipatory in its own right.

12   7.   In this action, Plaintiff asserts that Samsung infringes certain claims of the Apple

13 Asserted Patents. Although Plaintiff asserts that these claims are either literally infringed or

14 infringed under the doctrine of equivalents, Plaintiff has failed to provide any analysis or

15 explanation regarding alleged infringement of the asserted claims of the patents-in-suit under the

16 doctrine of equivalents. Samsung reserves its rights to modify, amend, supplement or otherwise

17 alter its preliminary infringement contentions in the event Plaintiff is permitted to modify, amend,

18 supplement, or clarify their infringement contentions with respect to direct infringement (literal

19 and under the doctrine of equivalents).

20   8.   Samsung is providing invalidity contentions only for the claims asserted by

21 Plaintiff, but hereby reserves the right to seek invalidation of all claims in each of the Apple

22 Asserted Patents.

23   9.   Samsung reserves the right to modify, amend, or supplement these disclosures as

24 additional information becomes available, and as its discovery and investigation proceed.

25

26

27

28

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   I.   THE '502 PATENT

2   A.   Local Patent Rule 3-3(a): Identification of Prior Art[1]

3   At this time, Samsung contends that at least the following prior art references anticipate or

4   render obvious, either alone or in combination, the asserted claims of the '502 Patent:

5   1.   Patent References[2]

Country of Origin	Patent Number	Date of Issue	Priority Date
US	4,330,845	May 18, 1982	Dec. 31, 1979
US	4,559,598	Dec. 17, 1985	Feb. 22, 1983
US	4,737,980	Apr. 12, 1988	July 19, 1985
US	4,862,498	Aug. 29, 1989	Nov. 28, 1986
US	4,896,291	Jan. 23, 1990	May 20, 1988
US	5,007,019	Apr. 9, 1991	Jan. 5, 1989
US	5,041,967	Aug. 20, 1991	Oct. 13, 1987
US	5,103,498	Apr. 7, 1992	Aug. 2, 1990
US	5,265,014	Nov. 23, 1993	Apr. 10, 1990
US	5,317,646	May 31, 1994	Mar. 24, 1992
US	5,357,431	Oct. 18, 1994	Jan. 25, 1993
US	5,386,298	Jan. 31, 1995	Apr. 26, 1993
US	5,396,419	Mar. 7, 1995	Sep. 8, 1992
US	5,455,901	Oct. 3, 1995	Sep. 12, 1994
US	5,459,488	Oct. 17, 1995	Jan. 19, 1993
US	5,479,536	Dec. 26, 1995	Nov. 27, 1991
US	5,495,565	Feb. 27, 1996	June 21, 1994
US	5,513,308	Apr. 30, 1996	Sep. 1, 1993
US	5,537,618	July 16, 1996	Dec. 23, 1993
US	5,555,496	Sep. 10, 1996	May 6, 1994
US	5,557,515	Sep. 17, 1996	Aug. 11, 1989
US	5,574,482	Nov. 12, 1996	May 17, 1994
US	5,608,898	Mar. 4, 1997	Nov. 12, 1992
US	5,619,708	Apr. 8, 1997	Oct. 25, 1994
US	5,623,681	Apr. 22, 1997	Nov. 19, 1993
US	5,632,022	May 20, 1997	Nov. 13, 1991
US	5,644,735	July 1, 1997	May 27, 1992
US	5,675,362	Oct. 7, 1997	Nov. 14, 1988
US	5,682,510	Oct. 28, 1997	Mar. 30, 1995
US	5,682,538	Oct. 28, 1997	Aug. 12, 1994
US	5,704,029	Dec. 30, 1997	May 23, 1994
US	5,724,449	Mar. 3, 1998	Nov. 27, 1991
US	5,748,512	May 5, 1998	Feb. 28, 1995

---

[1]   To the extent one or more prior art patents, publications, or systems are identified in the claim charts attached as Exhibits A-H to this document, but are not included in the tables and lists below for each patent, those prior art patents, publications, or systems should also be considered as prior art to the asserted patents.

[2]   Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	5,752,054	May 12, 1998	June 6, 1995
US	5,799,107	Aug. 25, 1998	Oct. 15, 1997
US	5,805,676	Sep. 8, 1998	May 19, 1995
US	5,818,437	Oct. 6, 1998	July 26, 1995
US	5,835,635	Nov. 10, 1998	June 27, 1995
US	6,008,799	Dec. 28, 1999	May 24, 1994
US	6,018,342	Jan. 25, 2000	July 3, 1995
US	7,136,710	Nov. 14, 2006	Dec. 23, 1991

2.   **Publications[3]**

Title	Date of Publication	Author	Publisher
A Modular and Flexible Architecture for an Integrated Corpus Query System	July 1994	Oliver Christ	Cornell University
A Pen-Based Database Interface for Mobile Computers	1994	Rafael Alonso and V.S. Mani	Institute of Electrical and Electronics Engineers
Adaptive and Predictive Techniques in a Communication Prosthesis	1987	Andrew L. Swiffin, John L. Arnott, J. Adrian Pickering, and Alan F. Newell	Informa Healthcare
Adaptive predictive text generation and the reactive keyboard	1989	John Darragh, John Joseph	University of Calgary
A Stylus-Based User Interface for Text: Entry and Editing	June 1991	Aaron Goodisman	Massachusetts Institute of Technology
Adaptive predictive text generation and the reactive keyboard	1991	John J. Darragh and Ian H. Witten	Elsevier
Context and Orientation in Hypermedia Networks	1989	Kenneth Utting and Nicole Yankelovich	Association for Computing Machinery
Designing the User Interface	1992	Ben Schneiderman	Addison-Wesley
Enhancing the Usability of an Office Information System Through Direct Manipulation	Dec. 1983	Alison Lee and F.H. Lochovsky	Association for Computing Machinery
Facilitating the Development of Representations in Hypertext with IDE	Nov. 1989	Daniel S. Jordan, Daniel M. Russell, Anne-Marie S.	Association for Computing Machinery

---

[3]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
		Jensen, and Russell A. Rogers	
IBM Simon User's Manual	1994		IBM
Investigations into History Tools for User Support	Apr. 1992	Alison Lee	University of Toronto
Marquise: Creating Complete User Interfaces by Demonstration	Apr. 1993	Brad A. Myers, Richard G. McDaniel, and David S. Kosbie	Association for Computing Machinery
Microsoft Foundation Class Primer	1993	Jim Conger	Waite Group Press
Pen Computing: A Technology Overview and a Vision	July 1995	Andre Meyer	Association for Computing Machinery
Predictive interfaces: What will they think of next?	Nov. 1991	Saul Greenberg, John Darragh, David Maulsby, and Ian H. Witten	University of Calgary
Predictive interfaces: What will they think of next?	1995	Saul Greenberg, John Darragh, David Maulsby, and Ian H. Witten	Association for Computing Machinery
Reducing Keystroke Counts with a Predictive Computer Interface	1982	Ian H. Witten, John G. Cleary, John J. Darragh, and David R. Hill	Institute of Electrical and Electronics Engineers
Software Interface for the Touch-Sensitive Menu of the Technician's Assister System	Dec. 20, 1990	Joseph A. Molnar and Sonia Faletti	Defense Technical Information Center
Split Menus: Effectively Using Selection Frequency to Organize Menus	Mar. 1994	Andrew Sears and Ben Schneiderman	Association for Computing Machinery
Supporting command reuse: empirical foundations and principles	Feb. 1993	Saul Greenberg and Ian H. Witten	Academic Press
Supporting Command Reuse: Mechanisms for Reuse	Feb. 1993	Saul Greenberg and Ian H. Witten	Academic Press
The Computer User as Toolsmith: The Use, Reuse, and Organization of Computer-based Tools	1993	Saul Greenberg	Cambridge University Press
The Design of a Graphical Browsing Interface for a Hypertext System	Feb. 25, 1994	Joslyn A.A. Smith	University of New Brunswick
The Human Factors of Graphic Interaction: Tasks	Dec. 1980	James D. Foley and Peggy Chan	Defense Technical

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
and Techniques			Information Center
The Information Grid: A Framework for Information Retrieval and Retrieval-Centered Applications	Nov. 1992	Ramana Rao, Stuart K. Card, Herbert D. Jellinek, Jock D. Mackinlay, and George G. Robertson	Association for Computing Machinery
The XKWIC User Manual	Aug. 2, 1995	Oliver Christ	Institut für maschinelle Sprachverarbeitung, Universität Stuttgart
Tools for Supporting the Collaborative Process	Nov. 1992	James R. Rhyne and Catherine G. Wolf	Association for Computing Machinery
Touch-sensitive screens: the technologies and their application	1986	J.A. Pickering	Elsevier
User modeling in interactive computer systems	1984	Saul Greenberg and Ian H. Witten	University of Calgary
Using a touchscreen for simple tasks	1990	John D. Gould, Sharon L. Greene, Stephen J. Boies, Antonia Meluson and Manvan Rasamny	IBM T.J. Watson Research Center
Using Graphic History in Browsing the World Wide Web	May 1995	Eric Z. Ayers and John T. Stasko	Georgia Institute of Technology

3. Systems

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '502 Patent, including documents and source code describing the same:

- Windows 95 Preview Program Builds

Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other

1   references to render the claims of the '502 Patent obvious in the event Apple takes the position that

2   certain claim limitations are missing from the references charted in Exhibit A.

3   **B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders
           Obvious the Asserted Claims**

4

5   Plaintiff asserts claims 1-2, 4-5, 8, 11, 13-17, 20, 22-24 and 26 of the '502 Patent against

6   Samsung in this lawsuit. All of those claims are invalid because the '502 Patent fails to meet one

7   or more of the requirements for patentability. The individual bases for invalidity are provided

8   below and in the claim charts attached as Exhibit A. Each of the foregoing listed prior art

9   documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art

10 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

11 Although Samsung has identified at least one citation per limitation for each reference,

12 each and every disclosure of the same limitation in the same reference is not necessarily identified.

13 Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

14 identified references, even where a reference may contain additional support for a particular claim

15 element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

16 whole and in the context of other publications and literature. Thus, to understand and interpret any

17 specific statement or disclosure within a prior art reference, such persons would rely on other

18 information within the reference, along with other publications and their general scientific

19 knowledge. Samsung may rely upon uncited portions of the prior art references and on other

20 publications and expert testimony to provide context, and as aids to understanding and interpreting

21 the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

22 other disclosed publications, and the testimony of experts to establish that a person of ordinary

23 skill in the art would have been motivated to modify or combine certain of the cited references so

24 as to render the claims obvious.

25 **1.   Anticipation**

26 Some or all of the asserted claims of the '502 Patent are invalid as anticipated under 35

27 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

28 included in Exhibit A, which identify specific examples of where each limitation of the asserted

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   claims is found in the prior art references. As explained above, the cited portions of prior art

2   references identified in the attached claim charts are exemplary only and representative of the

3   content and teaching of the prior art references, and should be understood in the context of the

4   reference as a whole and as they would be understood by a person of ordinary skill in the art.

5   2.   **Obviousness**

6   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

7   above and in Exhibit A, then any purported differences are such that the claimed subject matter as

8   a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

9   view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

10   therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

11   In addition, the references identified above render one or more asserted claims of the '502

12   Patent obvious when the references are read in combination with each other, and/or when read in

13   view of the state of the art and knowledge of those skilled in the art. Each and every reference

14   identified is also relevant to the state of the art at the time of the alleged invention. Any of the

15   references disclosed above may be combined to render obvious (and therefore invalid) each of

16   Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

17   all of the references identified above, including all references in Exhibit A, for purposes of

18   obviousness depending on the Court's claim construction, positions taken by Apple during this

19   litigation, and further investigation and discovery.

20   Moreover, to the extent the foregoing references are found not to anticipate the asserted

21   claims, the foregoing references render the asserted claims obvious either alone or in combination

22   with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

23   herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

24   at the time of the alleged invention of the asserted claims of the '502 Patent to combine the various

25   references cited herein so as to practice the asserted claims of the '502 Patent.

26   Motivations to combine the above items of prior art are present in the references

27   themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

28   the nature of the problems allegedly addressed by the '502 Patent. Combining the references

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   disclosed in Exhibit A would have been obvious, as the references identify and address the same

2   technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

3   amend or supplement these invalidity contentions to identify additional reasons that combining the

4   references would be obvious to one of ordinary skill in the art.

5   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

6   alone or in combination with other references, including identification of combinations showing

7   obviousness, are identified in Exhibits A-1 to A-6, which includes exemplary claim charts for the

8   asserted claims of the '502 Patent showing specifically where in each reference or combinations of

9   references each asserted claim is found, and an explanation of why the prior art renders the

10 asserted claim obvious.

11

12   In addition to the specific combinations of prior art and the specific combinations of

13 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

14 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

15 disclosed within the prosecution history of the references cited herein.

16   The obviousness combinations set forth in these contentions reflect Samsung's present

17 understanding of the potential scope of the claims that Plaintiff appears to be advocating and

18 should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

19 Samsung reserves the right to amend or supplement these contentions regarding anticipation or

20 obviousness of the asserted claims, in view of further information from Plaintiff, information

21 discovered during discovery, or a claim construction ruling by the Court. Plaintiff has not

22 identified what elements or combinations it alleges were not known to one of ordinary skill in the

23 art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

24 particular prior art reference, Samsung reserves the right to assert that any such limitation is either

25 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

26 of the same, or that the limitation is disclosed in another of the references disclosed above and in

27 combination would have rendered the asserted claim obvious.

28

1

2

C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each Alleged item of Prior Art each Asserted Claim is Found

Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function is attached in Exhibits A-1 to A-6.

D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity

Samsung identifies the following grounds for invalidity of the asserted claims of the '502 Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to supplement these disclosures based on further investigation and discovery.

1.   Invalidity Based on 35 U.S.C. § 101

The asserted claims of the '502 Patent are invalid under 35 U.S.C. § 101 because they only claim abstract ideas. Many limitations in the asserted claims are common abstractions in computer systems and programming languages. For example, "a list of choices is produced", "stores historical information", "the select choice is input into said computer system and displayed", "determining whether the user has selected an item", "assigning a data value", "determining whether the data value already exists", "adding the data value", "data values within the history table correspond directly or indirectly or input values", "updating the usage information" each refer only to programming abstractions or the manipulation of information; these are concepts, not physical objects or tangible matter.

2.   Invalidity Based on Enablement or Written Description Under 35 U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35 U.S.C. § 112(2)

Samsung asserts that each asserted claim of the '502 Patent is invalid in that the '502 specification fails to particularly point out and distinctly claim the alleged invention of the '502 Patent. Samsung further asserts that each asserted claim of the '502 Patent is invalid as not containing a written description of the invention, and of the manner and process of making and

28

-12-   Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

2   which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

3   Based on Samsung's present understanding of Plaintiff's infringement contentions,

4   Samsung asserts that claims 1, 2, 5, 8, 11, 15-17, 20, 23-24, 26 of the '502 Patent are invalid for

5   reciting the following claim terms/phrases:

6   - "input tablet"

7   - "field of a form" / "field of the form" / "a form having at least one field" / "a form"

8   - "a list of choices is produced from said history table"

9   - "historical information concerning usage of data values" / "usage information"

10

11   - "history table for the field class corresponding to the field is updated" / "updating the history list" / "updating the history table" / "updating the usage information corresponding to the data value to reflect its recent usage"

12

13   - "requiring data input" / "requiring data entry"

14   - "field class corresponding to the field" / "the field being associated with one of the field classes"

15

16   - "selecting the history list for the field based on the field class associated with the field"

17   - "a history list associated with the field class"

18

19   - "determining whether the user has selected an item from the displayed history list" / "assigning a data value for the field to that of a data value associated with the selected item"

20

21   - "identifying the history table for the field class associated with the field"

22   - "for the field class"

23   These claim terms/phrases as apparently construed by Apple violate the written description,

24   enablement, and/or definiteness requirements of 35 U.S.C. § 112.

25   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

26   one or more of these claim terms/phrases are indefinite because they are inconsistent with and

27   broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

28   constructions of the claims, any person of ordinary skill in the art at the time of the invention

1   would not understand what is claimed, even when the claims are read in light of the specification.

2   Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

3   of the asserted claims in which these claim terms/phrases appear lack written description because

4   the specification of the '502 Patent demonstrates that the patentee neither conceived of nor

5   demonstrated possession of all that Apple now contends the claims cover.

6   Samsung further asserts that claim 26 is invalid for reciting at least the following claim

7   terms/phrases:

8   • "computer readable code devices for displaying . . ."

9   • "computer readable code devices for determining . . ."

10   • "computer readable code devices for assigning . . ."

11   • "computer readable code devices for updating . . ."

12   Each of these claims is governed by 35 U.S.C. § 112, paragraph 6. The '502 patent

13   specification, however, fails to set forth the structure, material or acts for accomplishing the

14   claimed computer readable code devices. Each of these claims is therefore invalid as indefinite

15   under 35 U.S.C. § 112(2).

16   In addition, based on Samsung's present understanding of Plaintiff's infringement

17   contentions, each of the asserted claims in which these claim terms/phrases appear are invalid

18   because the specification fails to provide sufficient disclosure to enable any person of ordinary

19   skill in the art to which it pertains, or with which it is most nearly connected, to implement the

20   invention without undue experimentation.

21   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

22   ¶¶ 1 and 2.

23   **II.   THE '647 PATENT**

24   **A.   Local Patent Rule 3-3(a): Identification of Prior Art**

25   At this time, Samsung contends that at least the following prior art references anticipate or

26   render obvious, either alone or in combination, the asserted claims of the '647 Patent:

27

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1.   **Patent References**[4]

Country of Origin	Patent Number	Date of Issue	Priority Date
JP	H6-342426	Dec. 13, 1994	May 31, 1993
JP	H2-184155	July 18, 1990	Jan. 11, 1989
JP	H2-158875	June 19, 1990	Dec. 13, 1988
KP	1995-0007892B1	Sep. 15, 1994	Feb 1, 1993
EP	0 458 563	May 20, 1991	May 21, 1990
EP	369013A1	Feb. 15, 1995	Jul. 31, 1987
EP	458563A2	Nov. 27, 1991	May 21, 1990
EP	635808A2	Jan. 25, 1995	Jul., 21, 1993
USA	4,227,245	Oct. 7, 1980	Jun. 1, 1972
USA	4,818,131	Apr. 4, 1989	Dec. 29, 1985
JP	5027962A	Feb. 5, 1993	July 22, 1991
USA	5,101,424	Mar. 31, 1193	Sep. 8, 1990
USA	5,212,792	May 18, 1993	June 1, 1989
USA	5,261,042	Nov. 9, 1993	Nov. 20, 1989
USA	5,301,350	Apr. 5, 1994	Oct. 10, 1989
USA	5,359,317	Oct. 25, 1994	Oct. 9, 1992
USA	5,369,778	Nov. 29, 1994	Aug. 21, 1987
USA	5,375,200	Dec. 20, 1994	Nov. 13, 1992
USA	5,375,201	Dec. 20, 1994	Dec. 18, 1992
USA	5,398,336	Mar. 14, 1995	Oct. 16, 1990
USA	5,418,717	May 23, 1995	Aug. 27, 1990
USA	5,437,036	Jul. 25, 1995	Sep. 3, 1992
USA	5,463,772	Oct. 31, 1995	Apr. 23, 1993
USA	5,483,352	Jan. 9, 1996	Aug. 27, 1992
USA	5,572,643	Nov. 5, 1996	Oct. 19, 1995
USA	5,604,897	Feb. 18, 1997	May 18, 1990
USA	5,606,712	Feb. 25, 1997	July 19, 1993
USA	5,634,124	May 27, 1997	Aug. 21, 1987
USA	5,649,222	Jul. 15, 1997	May 8, 1995
USA	5,671,427	Sep. 23, 1997	Oct. 12, 1994
USA	5,737,734	Apr. 7, 1998	Sep. 15, 1995
USA	5,774,729	June 30, 1998	Dec. 19, 1991
USA	5,787,432	Jul. 28, 1998	Dec. 6, 1990
USA	5,790,793	Aug. 4, 1998	Apr. 4, 1995
USA	5,799,268	Aug. 25, 1998	Sep. 28, 1994
USA	5,859,636	Jan. 12, 1995	Dec. 27, 1995
USA	5,905,890	May 18,1999	Oct. 27, 1993
USA	5,995,106	Nov. 30, 1999	May 24, 1993
USA	6,115,710	Sep. 5, 2000	Sep. 28, 1989
USA	6,259,446	July 10, 2001	Dec. 23, 1992
USA	6,678,706	Jan. 13, 2004	Apr. 18, 1991
USA	7,006,881	Feb. 28, 2006	Dec. 23, 1991

---

[4]   Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

2.   **Publications**[5]

Title	Date of Publication	Author	Publisher
A Fast Algorithm for Multi-Pattern Searching	May 1994	Sun Wu	N/A
A Methodology for the Automatic Construction of a Hypertext for Information Retrieval.	1993	Maristella Agosti; Fabio Crestani	N/A
A Relaxation Method for Understanding Speech Utterances.	1992	Stephanie Seneff	N/A
A System For Discovering Relationships by Feature Extraction from Text Databases	Aug 1994	Jack G. Conrad and Mary Hunter Utt	N/A
A Taxonomy of See-Through Tools.	Apr. 24-28, 1994	Eric A. Bier; Maureen C. Stone; Ken Fishkin; William Buxton; Thomas Baudel	N/A
A Template Matcher for Robust NL Interpretation.	1991	Eric Jackson; Douglas Appelt; John Bear; Robert Moore; Ann Podlozny	N/A
Actions (scripts) - Actions are AppleScript scripts which perform tasks using the detected text.	1997	Apple Computer	N/A
Actions (scripts) - Tips and Tricks	1997	Apple Computer	N/A
Actions (scripts) - Writing AppleScript Actions for Detectors	1997	Apple Computer	N/A
Actions (scripts) - Writing AppleScript Actions for Detectors (extracting the detected text)	1997	Apple Computer	N/A
Actions (scripts) - Writing AppleScript Actions for Detectors (Running the Script)	1997	Apple Computer	N/A
Actions (scripts) - Writing AppleScript Actions for Detectors (Script Body)	1997	Apple Computer	N/A
Actions (scripts) - Writing AppleScript Actions for Detectors (USCityState Detector)	1997	Apple Computer	N/A
Agents of Alienation.	Jul. 1995	Jaron Lanier	N/A

[5]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Agents that Reduce work and Information Overload.	Jul. 1994	Patti Maes	N/A
An Efficient Context-Free Parsing Algorithm.	Apr. 1969	Jay Earley	N/A
An Open Agent Architecture.	1994	Philip R. Cohen; Adam Cheyer; Michelle Wang; Soon Cheol Baeg	N/A
Anaphora in a Wider Context: Tracking Discourse Referents.	1996	Christopher Kennedy; Branimir Boguraev	N/A
Apple Developer CD Series	Including but not limited to Nov. 1992, Dec. 1993, Mar. 1994, Jun. 1994, Sep. 1994, Dec. 1994, Jun. 1995, Aug. 1995, Sep. 1995, Nov. 1995, Dec. 1995, Feb. 1996, Mar. 1996, Jun. 1996, Aug. 1996, and Nov. 1996	Apple Developer Group	N/A
Apple Human Interface Guidelines	1992		N/A
Apple Newton – Backing up pre-installed software packages using a storage card	1995	N/A	N/A
Apple Newton – Features of the Newton 2.0 Operating System	Undated	N/A	N/A
Apple Newton – Flow Charts	Undated	N/A	N/A
Apple Newton – Hardware Guide	Undated	Joe Tate	N/A
Apple Newton – Internal Serial Slot Designer's Guide	Undated	N/A	N/A
Apple Newton – Message Pad Accessories	Undated	N/A	N/A
Apple Newton – Message Pad Handbook	1995	N/A	N/A
Apple Newton – Message Pad Specifications	Undated	N/A	N/A
Apple Newton – Programmer's Guide	Undated	Don Mills	N/A

Title	Date of Publication	Author	Publisher
Apple Newton – Programmer's Reference	Undated	N/A	N/A
Apple Newton – ROM Board Designer's Guide	Undated	N/A	N/A
Apple Newton – Solutions Guide vol. 1 & 2	1995	David Nagel	N/A
Apple Newton – System Update 1.3	1995	N/A	N/A
Applescript – The Easy Way is the Right Way	1998	Apple Computer, Inc.	N/A
At Macworld, Apple failed to regain believers among the once faithful	Jan. 13, 1997	Denise Caruso	N/A
Automatic Authoring and Construction of Hypermedia for Information Retrieval.	Feb. 1995	Maristella Agosti; Massimo Melucci; Fabio Crestani	N/A
Automatic Hypertext Construction.	Jan. 1995	James Allan	N/A
Automatic Structuring and Retrieval of Large Text Files	Feb. 1994	Gerard Salton, James Allan, and Chris Buckley	Association for Computing Machinery
Automatic Text Processing: The Transformation, Analysis, and Retrieval of Information by Computer	1989	Gerard Salton	N/A
Automatic Text Structuring and Retrieval – Experiments in Automatic Encyclopedia Searching.	1991	Gerard Salton; Chris Buckley	N/A
Byte cover story entitled "The Point of the Pen"	Feb. 1991	Robert Carr	McGraw-Hill
Cambridge Journals, "National Language Engineering"	Mar. 1995	N/A	N/A
Collaborative Programmable Intelligent Agents.	1998	Bonnie A. Nardi; James R. Miller; David J. Wright	N/A
Complete Guide to the NextStep User Environment.	1993	Michael B. Shebanek	N/A
Connecting – With Your EO Cellular Module	1992	Ann Cullen	EO Publications
Converting a Textbook to Hypertext	July 1992	Roy Rada	Association for Computing Machinery
Creating Highly-Interactive and Graphical User Interfaces by Demonstration.	Aug. 1986	Brad A. Myers; William Buxton	N/A
Creating User Interfaces Using Programming by Example,	Apr. 1990	Brad A. Myers	N/A

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Visual Programming, and Constraints.			
Currency Detectors	1997	Apple Computer	N/A
CyberDesk: A Framework for Providing Self-Integrating Context-Aware Services.	1998	Anind K. Dey; Gregory D. Abowd Andrew Wood	N/A
Data Detectors – summary	1997	Apple Computer	N/A
Demonstrational Techniques for Instructible Interface Agents.	Mar. 1994	Henry Lieberman	N/A
Detectors - definition	1997	Apple Computer	N/A
Developing Adaptive Systems To Fit Individual Aptitudes.	1992	David Benyon; Dianne Murray	N/A
Developing for the User	May 19, 1988	Robert Carr	M&T Publishing
"Dexter With Open Eyes,"	February 1994	John L. Leggett and John L. Schnase	Communications of the Association for Computing Machinery.
Documents as User Interfaces.	1991	Eric A. Bier; Ken Pier	N/A
Downloading the Apple Data Detectors SDK for developers.	1997	Apple Computer	N/A
Dr. Dobb's Journal Article entitled, "A Conversation with Robert Carr Part II"	Dec. 1991	Michael Swaine	M&T Publishing
Dr. Dobb's Journal of Software Tools for the Professional Programmer – Avoiding Software Pitfalls	May 19, 1988	N/A	M&T Publishing
Dr. Dobb's Journal of Software Tools for the Professional Programmer – Operating System Platforms	Nov. 1991	N/A	M&T Publishing
Drop Zones: An Extension to LiveDoc.	Apr. 1998	Thomas Bonura; James R. Miller	N/A
Eager Demonstration Video	1991	Allen Cypher	N/A
Eager: Programming Repetitive Tasks By Example.	Apr 28-May 2, 1991	Allen Cypher	N/A
Effective Video Screen Displays: Cognitive Style and Cuing Effectiveness	Jan. 1994	Kenneth A. Cory	SIGCHI Bulletin
Embedded Menus: Selecting Items in Context	1986	Larry Koved; Ben Shneiderman	N/A
Embedded Menus: Selecting Items In Context	Apr. 1986	Larry Koved and Ben Schneiderman	Association for Computing Machinery
Embedded Menus: Selecting Items in Context, ACM Vol. 29 No. 4	Apr. 1986	Larry Koved; Ben Schneiderman	N/A

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
EmbeddedButtons: Documents as User Interfaces	Nov. 1991	Eric A. Bier	Association for Computing Machinery
Entering the World-Wide Web: A Guide to Cyberspace.	Mar. 1994	Kevin Hughes	N/A
Experiments with Oval: A Radically Tailorable Tool for Cooperative Work.	Apr. 1995	Thomas W. Malone; Kum-Yew Lai; Christopher Fry	N/A
Exploring EXPECT: A Tcl-based Toolkit for Automating Interactive Programs.	Dec. 1, 1994	Don Libes	N/A
Finding and Reminding File Organization from the Desktop.	Jul. 1995	Deborah Barreau; Bonnie A. Nardi	N/A
Formal Languages and Their Relation to Automata	1969	John Hopcroft and Jeffrey Ullman	Addison-Wesley
Fortune article entitled "Hot New PCs That Read Your Writing"	Feb. 11, 1991	Brenton R. Schlender	The Time Inc Magazine Company
From documents to objects: An overview of LiveDoc.	Apr. 1998	Jim Miller; Thomas Bonura	N/A
FYI, revised draft URL document	Aug. 5, 1994	Tim Berners-Lee, Larry Masinter, Mark McCahill	N/A
Getting Results with Microsoft Office.	1995	Microsoft	N/A
Getting Started – With Your EO Personal Communicator	1992	Ann Cullen	EO Publications
Getting Started with PenPoint [Version 1.0]	1992	N/A	N/A
GNU Emacs: UNIX Text Editing and Programming.	1992	Michael A. Schoonover; John S. Bowie; William R. Arnold	N/A
GNU Emacs: goto-addr.el extension	Aug. 15, 1995	Eric Ding	N/A
GO Corporation – At Last, Technology Harnesses One of The Most Powerful Forces Known to Man	1991	N/A	N/A
Go Corporation Business Plan	June 23, 1988	N/A	N/A
GO Corporation Current Status & Future Goals	Undated	N/A	N/A
Graphical Search and Replace.	Aug. 1988	David Kurlander	N/A
Handwritten Notes – Dr. Dobbs - "Designing Apps"	Undated	N/A	N/A
Handwritten Notes – Software Development "Tips"	Undated	N/A	N/A

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Handwritten Notes – "Key Philosophies of FW"	Undated	N/A	N/A
HieNet: A User-Centered Approach for Automatic Link Generation.	Nov. 1993	Daniel T. Chang	N/A
http://graphcomp.com/info/specs/nets/ddeapi.html, April 1995 ("DDE")	Apr. 1995	N/A	N/A
Hypertext: Concepts, Systems and Applications.	Nov. 1990	N. Streitz; A. Rizk; J. Andre	N/A
Incorporating String Search in a Hypertext System: User Interface and Signature File Design Issues	1990	Faloutsos, Raymond Lee, Catherine Plaisant and Ben Shneiderman	HyperMedia
Incremental maintenance of semantic links in dynamically changing hypertext systems	1990	Simon M. Kaplan and Yoelle S. Maarek	Butterworth–Heinemann
Information For Developers" sheet	Undated	N/A	N/A
Intelligent Agents: What We Learned At The Library.	1996	Bonnie A. Nardi; Vicki O'Day	N/A
Interactive Constraint-Based Search And Replace.	May 3-7, 1992	David Kurlander; Steven Feiner	N/A
Internet Address Detectors	1997	Apple Computer	N/A
Learning Perl	1993	Randall L. Schwartz	O'Reilly & Associates
Letter, The Indsiders Guide to The Personal Computer Industry, article entitled "Operating Systems GO's Got The Most Modern OS Around"	Jan. 28, 1991	N/A	Industry Publishing Company
Looking for the Bright Side of User Interface Agents.	Jan. 1995	Ben Schneiderman	N/A
Lookup Guide to the EO Personal Communicator	1993	Ann Cullen	EO Publications
Lotus Notes Application Development Handbook.	May 1995	Erica Kerwien	N/A
The Lynx_users_guide.html file ("Lynx User Guide") entitled "Lynx User Guide Version 2.3"	May, 20, 1994	N/A	N/A
Mac OS Discussion Forum – Apple Script	1998	Apple Computer	N/A
Managing Internet Information Services	1994	Cricket Liu	O'Reilly & Associates
Microsoft Foundation Class Primer	1993	Jim Conger	Waite Group Press
Multi-media RISSC Informatics Receiving Information with	1986	Daniela Rus; Devika	N/A

Title	Date of Publication	Author	Publisher
Structural Structural Components.		Subramanian	
N2 Newton – Overview	Jul. 22, 1996	N/A	N/A
N2 Newton – Power Adaptor Designer's Guide	Undated	N/A	N/A
N2 Newton – Power System Architecture	Undated	N/A	N/A
Newton Programmers Guide	1994		Addison-Wesley
Parsing Techniques – a Practical Guide	1990	Dick Grune and Ceriel Jacobs	Ellis Horwood, Chichester
PC Magazine article entitled "First Looks, Hands-on Reviews of the Latest Products"	June 30, 1992	Bruce Brown	N/A
PC Magazine article entitled "Power Programming, An Introduction to Pen-Based Computing"	Jan. 14, 1992	Ray Duncan	N/A
PC Week article entitled "PenPoint Makes Its Debut with Support from 40 ISVs"	Apr. 20, 1992	Erica Schroeder	N/A
PenApps Developer's Release – Software Development Kit	Undated	N/A	N/A
PenPoint - A Catalog of Products and Services	1992	N/A	N/A
PenPoint 1.01 SDK Installation and Release Notes	Sep. 27, 1992	N/A	N/A
PenPoint API Reference Volume I	1990	N/A	Addison-Wesley
PenPoint Architectural Reference Volume I	1991	N/A	Addison-Wesley
PenPoint Architectural Reference Volume II	1991	N/A	Addison-Wesley
PenPoint Development Tools	1991	N/A	Addison-Wesley
PenPoint Getting Started	1991	N/A	N/A
PenPoint Introduction letter re Software Development Kit	Undated	N/A	N/A
PenPoint News Release "GO Announces PenPoint Operating System For Mobile Pen-based Computing"	Jan. 22, 1991	N/A	N/A
PenPoint Notebook User Interface	1991	N/A	N/A
Penpoint Programming	1992	Andy Novobilski	Addison-Wesley
PenPoint User Interface Design Reference	1991	N/A	Addison-Wesley
Perspective Handbook	Nov. 1992	N/A	
Pocket Guides – Eleven Basic PenPoint Gestures	1991	N/A	
POSIX Programmer's Guide	1994	Donald Lewine	O'Reilly &

Title	Date of Publication	Author	Publisher
Writing Portable UNIX Programs			Associates
Programming Perl	1991	Larry Wall and Randall L. Schwartz	O'Reilly & Associates
Programming Windows: the Microsoft guide to writing applications for Windows 3	1990	Charles Petzold	Microsoft Press
Release 1.0 – A Monthly Report	Jan. 22, 1991	Esther Dyson	
Remote Interfaces and File System, Text and Handwriting Classes, Application Classes, Installation Classes, Miscellaneous Classes, and Windows & UI Toolkit Control Classes	Undated	N/A	N/A
Searching for the Missing Link: Discovering Implicit Structure in Spatial Hypertext	Nov. 1993	Catherine C. Marshall and Frank M. Shipman III	Association for Computing Machinery
sed & awk	1991	Dale Dougherty	O'Reilly & Associates
Sidekick – The Desktop Organizer Just a Keystroke Away	1985	N/A	Borland International
Sidekick – The Desktop Organizer Just a Keystroke Away (Special Edition for AST Research Inc.)	Mar. 1985	N/A	Borland International
Sidekick 2.0 Getting Started	1991	N/A	Borland International
Sidekick 2.0 User's Guide	1991	N/A	Borland International
Sidekick software and screenshots, version 1.52A	1985	N/A	N/A
Sidekick Version 1.5 Owner's Handbook	Mar. 1995	N/A	Borland International Inc.
The Simon User Manual1	1994	N/A	IBM
The AT&T EO Travel Guide	1993	Ken Maki	John Wiley & Sons, Inc.
The Computing Strategy Report	Mar. 1991	William M. Bluestein and John C. McCarthy	Forrester Research Inc
The file mhonarc (the mail MHonArc Perl script) from the top level of the MHonArc distribution	Oct. 1, 1994	N/A	N/A
The file mhonarc.txt from the doc directory of the MHonArc distribution	Oct. 1, 1994	N/A	N/A

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
The Mosaic Handbook for Microsoft Windows	1994	Dale Dougherty and Richard Koman	O'Reilly & Associates
The UNIX Programming Environment	1984	Brian W. Kernighan and Rob Pike	Prentice-Hall Inc.
The Windows Interface Guidelines — A Guide for Designing Software	Feb. 13, 1995	N/A	N/A
The World of Messaging – An Introduction to Personal Communications	1992	Randy Stock	EO Publications
UNIX Applications Programming Mastering the Shell	1990	Ray Swartz	SAMS
UNIX in a Nutshell	1994	Daniel Gilly and the staff of O'Reilly & Associates, Inc.	O'Reilly & Associates
UNIX System V/386 Programmer's Reference Manual	1988	N/A	Prentice Hall
User interface design for the Hyperties electronic encyclopedia	Nov. 1987	Ben Schneiderman	N/A
Using PenPoint [Version 1.0]	1992	N/A	N/A
Using Sidekick: The Desktop Organizer	1988	Phillp R. Robinson	McGraw-Hill
Visual Basic 4 Unleashed	1995	Conrad Scott et al.	Sams Publishing

3.   **Systems**

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '647 Patent, including documents and source code describing the same:

- Apple Message Pad

- Apple Newton

- AppleScript and/or Open Scripting Architecture

- Eager

- EO Personal Communicator 448 and 880

1

2

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

- Eudora

- GNU Emacs

- GriD Systems

- Homer

- Hypertext

- IBM ThinkPad 700T

- Internet Explorer

- Lotus Notes

- Lynx System

- mIRC

- Mosaic

- NCR 3125 and 3130

- NCSA Mosaic for X Window System Version 2.4

- Netscape Navigator

- Newton Operating System

- NeXTSTEP, NeXTStep, and/or OpenSTEP, including NXSpellChecker and NXSpellServer

- PenPoint Operating System

- Perspective

- Selection Recognition Agent

- Sidekick

- Simon

- SNOBAL

- Third-party software for Newton Operating System

- Third-party software for PenPoint Operating System, including but not limited to all editions of PenSoft Perspective

- Visual Basic

1   •   Visual CE

2   •   Windows 95 Beta

3   •   WordPerfect

4   •   X Window System

5   Samsung reserves the right to amend these invalidity contentions to assert these references

6   depending on the claim construction and infringement positions Apple may take as the case

7   proceeds. Moreover, Samsung reserves the right to use these references in combination with other

8   references identified above to render the claims of the '647 Patent obvious in the event Apple takes

9   the position that certain claim limitations are missing from the references charted in Exhibit B.

10   **B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders**

11   **Obvious the Asserted Claims**

12   Plaintiff asserts claims 1-2, 4, 6 and 8-9 of the '647 Patent against Samsung in this lawsuit.

13   All of those claims are invalid because the '647 Patent fails to meet one or more of the

14   requirements for patentability. The individual bases for invalidity are provided below and in the

15   claim charts attached as Exhibit B. Each of the foregoing listed prior art documents, the

16   underlying work, and/or the underlying apparatus or method qualifies as prior art under one or

17   more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

18   Although Samsung has identified at least one citation per limitation for each reference,

19   each and every disclosure of the same limitation in the same reference is not necessarily identified.

20   Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

21   identified references, even where a reference may contain additional support for a particular claim

22   element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

23   whole and in the context of other publications and literature. Thus, to understand and interpret any

24   specific statement or disclosure within a prior art reference, such persons would rely on other

25   information within the reference, along with other publications and their general scientific

26   knowledge. Samsung may rely upon uncited portions of the prior art references and on other

27   publications and expert testimony to provide context, and as aids to understanding and interpreting

28   the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

1   other disclosed publications, and the testimony of experts to establish that a person of ordinary

2   skill in the art would have been motivated to modify or combine certain of the cited references so

3   as to render the claims obvious.

1.   **Anticipation**

5   Some or all of the asserted claims of the '647 Patent are invalid as anticipated under 35

6   U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

7   included in Exhibit B, which identify specific examples of where each limitation of the asserted

8   claims is found in the prior art references. As explained above, the cited portions of prior art

9   references identified in the attached claim charts are exemplary only and representative of the

10   content and teaching of the prior art references, and should be understood in the context of the

11   reference as a whole and as they would be understood by a person of ordinary skill in the art.

2.   **Obviousness**

13   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

14   above and in Exhibit B, then any purported differences are such that the claimed subject matter as

15   a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

16   view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

17   therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

18   In addition, the references identified above render one or more asserted claims of the '647

19   Patent obvious when the references are read in combination with each other, and/or when read in

20   view of the state of the art and knowledge of those skilled in the art. Each and every reference

21   identified is also relevant to the state of the art at the time of the alleged invention. In general, the

22   references disclosed above may be combined to render obvious (and therefore invalid) each of

23   Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

24   all of the references identified above, including all references in Exhibit B, for purposes of

25   obviousness depending on the Court's claim construction, positions taken by Apple during this

26   litigation, and further investigation and discovery.

27   Moreover, to the extent the foregoing references are found not to anticipate the asserted

28   claims, the foregoing references render the asserted claims obvious either alone or in combination

1   with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

2   herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

3   at the time of the alleged invention of the asserted claims of the '647 Patent to combine the various

4   references cited herein so as to practice the asserted claims of the '647 Patent.

5   Motivations to combine the above items of prior art are present in the references

6   themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

7   the nature of the problems allegedly addressed by the '647 Patent. Combining the references

8   disclosed in Exhibit B would have been obvious, as the references identify and address the same

9   technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

10 amend or supplement these invalidity contentions to identify additional reasons that combining the

11 references would be obvious to one of ordinary skill in the art.

12   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

13 alone or in combination with other references, including identification of combinations showing

14

15 obviousness, are identified in Exhibits B-1 through B-14, which includes exemplary claim charts

16 for the asserted claims of the '647 Patent showing specifically where in each reference or

17 combinations of references each asserted claim is found, and an explanation of why the prior art

18 renders the asserted claim obvious.

19   In particular, Samsung contends that the asserted claims of the '647 Patent would have

20 been obvious in view of the prior art references identified above. For example, Exhibit B includes

21

22 exemplary claim charts that describe how the asserted claims of the '647 Patent would have been

23 obvious in view of all references identified in Exhibit B, which, if found not to anticipate the

24 claims of the '647 Patent, render the claims of the '647 Patent obvious alone.

25   In addition to the specific combinations of prior art and the specific combinations of

26

27 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

28

Case No. 12-cv-00630-LHK
                                    SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

2   disclosed within the prosecution history of the references cited herein.

3   The obviousness combinations set forth in these contentions reflect Samsung's present

4   understanding of the potential scope of the claims that Plaintiff appears to be advocating and

5   should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

6   Samsung reserves the right to amend or supplement these contentions regarding

7   anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

8   information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

9   not identified what elements or combinations it alleges were not known to one of ordinary skill in

10   the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

11   particular prior art reference, Samsung reserves the right to assert that any such limitation is either

12   inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

13   of the same, or that the limitation is disclosed in another of the references disclosed above and in

14   combination would have rendered the asserted claim obvious.

15   **C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each
                      Alleged item of Prior Art each Asserted Claim is Found**
16

17   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

18   item of prior art each limitation of each asserted claim is found, including for each limitation that

19   Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

20   material(s) in each item of prior art that performs the claimed function is attached in Exhibits B-1

21   through B-14.

22   **D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity**

23   Samsung identifies the following grounds for invalidity of the asserted claims of the '647

24   Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

25   supplement these disclosures based on further investigation and discovery.

26   1.   **Invalidity Based on 35 U.S.C. § 101**

27   The asserted claims of the '647 Patent are also invalid under 35 U.S.C. § 101 because they

28   only claim abstract ideas. Many limitations in the asserted claims are common abstractions in

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   computer systems and programming languages. For example, "detecting structures in data and

2   performing actions on detected structures," "an analyzer server for detecting structures in the data,

3   and for linking actions to the detected structures," "a user interface enabling the selection of a

4   detected structure and a linked action," "an action processor for performing the selected action

5   linked to the detected structure," "grammars and a parser for detecting structures in the data," "a

6   string library and a fast string search function for detecting string structures in the data," each refer

7   only to programming abstractions or the manipulation of information; these are concepts, not

8   physical objects or tangible matter.

9   2.   **Invalidity Based on Enablement or Written Description Under 35**
                       U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35
10   **U.S.C. § 112(2)**

11   Samsung asserts that each asserted claim of the '647 Patent is invalid in that the '647

12   specification fails to particularly point out and distinctly claim the alleged invention of the '647

13   Patent. Samsung further asserts that each asserted claim of the '647 Patent is invalid as not

14   containing a written description of the invention, and of the manner and process of making and

15   using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

16   which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

17   Based on Samsung's present understanding of Apple's infringement contentions, Samsung

18   asserts that claims 1, 2, 4, 6, 8, and 9 of the '647 Patent are invalid for reciting at least the

19   following claim terms/phrases:

20   • "input device"

21   • "output device"

22   • "program routines"

23   • "detecting structures in the data"

24   • "analyzer server"

25   • "linking actions to the detected structures"

26   • "user interface enabling the selection of a detected structure and a linked action;"

27

28

1

- "action processor"

2

- "a fast string search function for detecting string structures in the data"

3

- "highlights"

4

- "the user interface enables selection of an action by causing the output device to

5

display a pop-up menu of the linked actions."

6

7   These claim terms/phrases as apparently construed by Apple violate the written description,

8   enablement, and/or definiteness requirements of 35 U.S.C. § 112. For instance, the term "fast

9   string search" either fails to quantify how "fast" a string search must be in order to infringe claim

10   6, or refers to a particular algorithm that is not disclosed anywhere in the claims or specification.

11   Based on Samsung's present understanding of Apple's infringement contentions, at least

12   one or more of these claim terms/phrases are indefinite because they are inconsistent with and

13   broader than the alleged invention disclosed in the specification and given Apple's apparent

14   constructions of the claims, any person of ordinary skill in the art at the time of the invention

15   would not understand what is claimed, even when the claims are read in light of the specification.

16   Moreover, based on Samsung's present understanding of Apple's infringement contentions, each of

17   the asserted claims in which these claim terms/phrases appear lack written description because the

18   specification of the '647 Patent demonstrates that the patentee neither conceived of nor

19   demonstrated possession of all that Apple now contends the claims cover. In addition, based on

20   Samsung's present understanding of Apple's infringement contentions, each of the asserted claims

21   in which these claim terms/phrases appear are invalid because the specification fails to provide

22   sufficient disclosure to enable any person of ordinary skill in the art to which it pertains, or with

23   which it is most nearly connected, to implement the invention without undue experimentation.

24   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

25   ¶¶ 1 and 2.

26

27

28

1 III.   THE '959 PATENT

2   A.   Local Patent Rule 3-3(a): Identification of Prior Art

3   At this time, Samsung contends that at least the following prior art references anticipate or

4 render obvious, either alone or in combination, the asserted claims of the '959 Patent:

5   1.   Patent References[6]

Country of Origin	Patent Number	Date of Issue	Priority Date
US	3,496,299	Feb. 17, 1970	Nov. 14, 1966
US	4,260,854	Apr. 7, 1981	May 20, 1975
US	5,577,241	Nov. 19, 1996	Dec. 7,1994
US	5,634,053	May 27, 1997	Aug. 29, 1995
US	5,659,732	Aug. 19, 1997	May 17, 1995
US	5,671,426	Sep. 23, 1997	June 22, 1993
US	5,742,816	Apr. 21, 1998	Sep. 15, 1995
US	5,748,512	May 5, 1998	Feb. 28, 1995
US	5,845,278	Dec. 1, 1998	Sep. 12, 1997
US	5,855,015	Dec. 29, 1998	May 12, 1995
US	5,913,205	June 15, 1999	Mar. 28, 1996
US	5,913,215	June 15, 1999	Feb. 19, 1997
US	5,937,406	Aug. 10, 1999	Jan. 31, 1997
US	5,987,446	Nov. 16, 1999	Nov. 12, 1996
US	6,000,020	Dec. 7, 1999	Apr. 1, 1997
US	6,005,565	Dec. 21, 1999	Mar. 25, 1997
US	6,008,799	Dec. 28, 1999	May 24, 1994
US	6,018,342	Jan. 25, 2000	July 3, 1995
US	6,026,429	Feb. 15, 2000	Nov. 10, 1997
US	6,065,003	May 16, 2000	Aug. 19, 1997
US	6,070,158	May 30, 2000	Aug. 14, 1996
US	6,078,914	June 20, 2000	Dec. 9, 1996
US	6,098,065	Aug. 1, 2000	Feb. 13, 1997
US	6,266,094	July 24, 2001	June 14, 1999
US	6,311,182	Oct. 30, 2001	Nov. 17, 1997
US	6,324,534	Nov. 27, 2001	Sep. 10, 1999
US	6,345,269	Feb. 2, 2002	Mar. 26, 1999
US	6,366,915	Apr. 2, 2002	Nov. 4, 1998
US	6,370,543	Apr. 9, 2002	May 24, 1996
US	6,415,285	July 2, 2002	Dec. 8, 1999
US	6,424,968	July 23, 2002	Oct. 15, 1998
US	6,445,834	Sep. 3, 2002	Oct. 19, 1998
US	6,574,632	June 3, 2003	Nov. 18, 1998
US	6,578,048	June 10, 2003	June 5, 1995
US	6,615,172	Sep. 2, 2003	Nov. 12, 1999
US	6,665,640	Dec. 16, 2003	Nov. 12, 1999
US	6,697,835	Feb. 24, 2004	Oct. 28, 1999
US	6,842,758	Jan. 11, 2005	July 30, 1999

[6] Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	6,845,370	Jan. 18, 2005	Nov. 19, 1998
US	6,862,713	Mar. 1, 2005	Aug. 31, 1999
US	6,901,366	May 31, 2005	Aug. 26, 1999
US	7,653,614	Jan. 26, 2010	July 15, 1999
US	7,873,995	Jan. 18, 2011	Sep. 29,2003
EP	0706139	Published Apr. 10, 1996	Sep. 9, 1994
WO	98/32289	Published July 23, 1998	Jan. 17, 1997

2. **Publications**[7]

An Information System Based on Distributed Objects	1987	Michael Caplinger	Computing Machinery
An Information System for Corporate Users: Wide Area Information Servers	Sep. 1991	Brewster Kahle and Art Medler	Online
Annotating the World Wide Web using Natural Language	1997	Boris Katz	
ARIADNE: A System for Constructing Mediators for Internet Sources	1998	Jose Luis Ambite, Naveen Ashish, Greg Barish, Craig A. Knoblock, Steven Minton, Pragnesh J. Modi, Ion Muslea, Andrew Philpot and Sheila Tejada	SIGMOD
Browsing Local and Global Information	1995	Masum Hasan, Gene Golovchinsky, Emanuel Noik, Nipon Charoenkitkarn, Mark Chignell, Alberto Mendelzon and David Modjeska	Proceedings of the 1995 conference of the Centre for Advanced Studies on Collaborative Research
Building the infrastructure of resource sharing: union catalogs, distributed search, and	Jan. 1, 1997	Lynch, Clifford	Library Trends

---

[7]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

cross-database linkage			
The Computer User as Toolsmith	1993	Saul Greenberg	
CyberDesk: A Framework for Providing Self-Integrating Ubiquitous Software Services	1997	Anind K. Dey, Gregory Abowd, Mike Pinkerton and Andrew Wood	
Dataware Technologies Introduces Dataware II Knowledge Query Server	Sep. 21, 1998		PR Newswire
Discover: A Resource Discovery System based on Content Routing		Mark A. Sheldon, Andrzej Duda, Ron Weiss, David K. Gifford	
The Distributed Information Search Component (Disco) and the World Wide Web	1997	Anthony Tomasic, Remy Amouroux, Philippe Bonnet, Olga Kapitskaia, Hubert Naacke, Louiqa Raschid	SIGMOD
Doctor Linux – 5th Edition	1997	John Purcell, ed.	Linux Systems
Dragon Systems® Demonstrates First PDA Speech Recognition Technology on the Digital StrongARM Processor in Apple Newton MessagePad 2000	March 25, 1997		Dragon Systems
The Effectiveness of GlOSS for the Text Database Discovery Problem		Luis Gravano, Hector Garcia-Molina and Anthony Tomasic	
Experience the Internet's most powerful search tool			The WebTools Company
Exploring Computer Science with Scheme	1998		Spinger-Verlag New York, Inc.
FreeWAIS-sf: A Wide Area Information Server for Structured Documents and Retrieval Functionality			
FreeWAIS-sf	Mar. 30, 1995	Ulrich Pfeifer Tung Huynh	University of Dortmund
freeWAIS-sf – UNIDO Edition	Oct. 1995	Ulrich Pfeifer	University of

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

0.5			Dortmund
Hemlock – An Internet Search Tool for the Newton	1999	Sean Luke	
Hemlock An Internet Search Tool for the Newton			
Heuristics – Intelligent Search Strategies for Computer Problem Solving	1984	Judea Pearl	Addison-Wesley
How to Create a WAIS Query			
Implementation of the SMART Information Retrieval System	May 1985	Chris Bucley	
The Info Agent: An Interface for Supporting Users in Intelligent Retrieval	1995	Daniela D' Aloisi and Vittorio Giannini	
Infoharness: Managing Distributed, Heterogeneous Information	1999	Kshitij Shah and Amit Sheth	IEEE Internet Computing
Information Retrieval Algorithms and Heuristics	1998	David A. Grossman and Ophir Frieder	Kluwer Academic
Information Retrieval (Z39.50): Application Service Definition and Protocol Specification	1995		NISO Press
Information Retrieval on the World Wide Web	1997	Venkat N. Gudivada, Vijay V. Raghavan, William I. Grosky and Rajesh Kasanagottu	IEEE Internet Computing
INQUERY System Overview	Undated	John Broglio, James P. Callan and W. Bruce Croft	
Internet Fish	May 1996	Brian A. LaMacchia	
An Introduction to Multisensor Data Fusion	1997	David L. Hall and James Llinas	IEEE
Macworld Mac OS 8.5 Bible	1999	Lon Poole	IDG Books Worldwide
Mac OS 8.5 – Black Book	1999	Mark R. Bell and Debrah D. Suggs	The Coriolis Group,
Mac OS 8.5: GO FOR IT! Part I	Oct. 29 1998	Michael Lambert	The Mac Observer
Mac OS 8.5: GO FOR IT! Part II	Oct. 29 1998	Michael Lambert	The Mac Observer
Mac OS 8.5 Special Report	1998		MacInTouch
MAC OS 9: The Missing Manual – Finding Files and Web Sites with Sherlock 2			

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

MacWAIS Software Version 1.28	Feb. 23, 1994		EINet
The MetaCrawler Architecture for Resource Aggregation on the Web	Nov. 8, 1996	Erik Selberg and Oren Etzioni	
Microsoft Universal Data Access Platform	1998	Jose A. Blakeley, Michael J. Pizzo	SIGMOD
Microsoft Windows 98 Companion	1998	Martin Matthews	Microsoft Press
Modern Heuristic Search Methods	1996	V.J. Rayward-Smith, I.H. Osman, C.R. Reeves and G.D. Smith	John Wiley and Sons
Multiobjective Heuristic Search	1999	Pallab Dasgupta, P.P. Chakrabarti and S.C. Desarkar	Vieweg
NetHopper Version 3.0 – User's Manual	1997		AllPen
Newton Apple MessagePad Handbook	1995		Apple
Newton Solutions Guide			Apple
Newton Programmer's Guide	1996		Addison-Wesley
Northern Light: New Search Engine for the Web and Full-Text Articles	Feb. 1998	Greg Notess	Online
Overview of Wide Area Information Servers	Apr. 1991	Brewster Kahle	
Pen Pals	Oct. 12, 1993	Christopher Barr and Michael Neubarth	PC Magazine
Peter Rand's Review of Hemlock	1999	Peter Rand	
Rama: An Architecture for Internet Information Filtering	May 1, 1991	Jim Binkley and Leslie Young	Kluwer
Search Algorithms Under Different Kinds of Heuristics – A Comparative Study	1983	A. Bagchi and A. Mahanti	Indian Institute of Management Calcutta
Sigerson, A Sherlock Power Booster	Dec. 2, 1998	James Sentman	the Mac Observer
Sherlock Holmes am Newton	Dec. 1999		
Softscape's QuickFind Search and Retrieval Software	Nov. 1997	Robert J. Boeri	EMedia Professional
Software Quality Engineering – A Total Technical and	1988	Michael S. Deutsch and	Prentice-Hall

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Management Approach		Ronald R. Willis	
Surviving the Storm: Using Metasearch Engines Effectively	May 1999	Randal D. Carlson and Judi Repman	Computers in Libraries
Toward more comprehensive Web searching: single searching versus megasearching	1998	Greg R. Notess	Online
Unix for the Impatient	1996	Paul W. Abrahams and Bruce A. Larson	Addison-Wesley
User's Guide to the Macintosh version of the WAIS interface	1991		Thinking Machines
WAIS, A Sketch Of An Overview	Sep. 23, 1991	Jeff Kellem	
WAIS Search Help			
What is freeWAIS-sf?			
Wide Area Information Servers (WAIS)	June 1994	M. St. Pierre, J. Fullton, K. Gamiel, J. Goldman, B. Kahle, J. Kunze, H. Morris and F. Schiettecatte	
Windows 98 Annoyances	Oct. 1998	David A. Karp	O'Reilly
Windows 98 for Dummies	1999	Andy Rathbone	Wiley
WordPerfect for Windows V 5.2	1992		WordPerfect
Xerox Delivers Global Competitive Advantage to Manufacturing Customers Through Solutions Portfolio	Apr. 27, 1999		Business Wire
Xerox Introduces Two Products to Expand Knowledge Sharing Software Portfolio	Nov. 9, 1999		Business Wire
Xerox unveils "askOnce", which brings a new search dimension to end-users by giving universal access to multiple information sources through one simple query	1999		Xerox
The Z39.50 Information Retrieval Standard – Part I: A Strategic View of Its Past, Present and Future	Apr. 1997	Clifford A. Lynch	D-Lib Magazine

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1

3. Systems

2

All versions of the following prior art systems commercially sold, publicly known or used

3

before the priority date of the '959 Patent, including documents and source code describing the

4

same:

5

- Dragon Systems Speech Recognition

6

- Hemlock

7

- Linux

8

- Mac OS 8.5

9

- Newton 2.0

10

- NetHopper

11

- Sherlock Utility

12

- Unix

13

- WAIS protocol and WAIStation client

14

- Windows 98

15

Samsung reserves the right to amend these invalidity contentions to assert these references

16

depending on the claim construction and infringement positions Apple may take as the case

17

proceeds. Moreover, Samsung reserves the right to use these references in combination with other

18

references to render the claims of the '959 Patent obvious in the event Apple takes the position that

19

certain claim limitations are missing from the references charted in Exhibit C.

20

B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims

21

22

Plaintiff asserts claims 1-5, 9-12, 14-17, 19-20, 22-25, 27-30 and 32-33 of the '959 Patent

23

against Samsung in this lawsuit. All of those claims are invalid because the '959 Patent fails to

24

meet one or more of the requirements for patentability. The individual bases for invalidity are

25

provided below and in the claim charts attached as Exhibit C. Each of the foregoing listed prior

26

art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior

27

art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

28

1   Although Samsung has identified at least one citation per limitation for each reference,

2 each and every disclosure of the same limitation in the same reference is not necessarily identified.

3 Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

4 identified references, even where a reference may contain additional support for a particular claim

5 element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

6 whole and in the context of other publications and literature. Thus, to understand and interpret any

7 specific statement or disclosure within a prior art reference, such persons would rely on other

8 information within the reference, along with other publications and their general scientific

9 knowledge. Samsung may rely upon uncited portions of the prior art references and on other

10 publications and expert testimony to provide context, and as aids to understanding and interpreting

11 the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

12 other disclosed publications, and the testimony of experts to establish that a person of ordinary

13 skill in the art would have been motivated to modify or combine certain of the cited references so

14 as to render the claims obvious.

15   1.   **Anticipation**

16   Some or all of the asserted claims of the '959 Patent are invalid as anticipated under 35

17 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

18 included in Exhibit C, which identify specific examples of where each limitation of the asserted

19 claims is found in the prior art references. As explained above, the cited portions of prior art

20 references identified in the attached claim charts are exemplary only and representative of the

21 content and teaching of the prior art references, and should be understood in the context of the

22 reference as a whole and as they would be understood by a person of ordinary skill in the art.

23   2.   **Obviousness**

24   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

25 above and in Exhibit C, then any purported differences are such that the claimed subject matter as

26 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

27 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

28 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

1   In addition, the references identified above and in Exhibit C render one or more asserted

2 claims of the '959 Patent obvious when the references are read in combination with each other,

3 and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and

4 every reference identified is also relevant to the state of the art at the time of the alleged invention.

5 Any of the references disclosed above may be combined to render obvious (and therefore invalid)

6 each of Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified

7 references or all of the references identified above, including all references in Exhibit C, for

8 purposes of obviousness depending on the Court's claim construction, positions taken by Apple

9 during this litigation, and further investigation and discovery.

10   Moreover, to the extent the foregoing references are found not to anticipate the asserted

11 claims, the foregoing references render the asserted claims obvious either alone or in combination

12 with one or more of the other references identified above pursuant to P.R. 3-3(a). It would have

13 been obvious to a person of skill in the art at the time of the alleged invention of the asserted

14 claims of the '959 Patent to combine the various references cited herein so as to practice the

15 asserted claims of the '959 Patent.

16

17   Motivations to combine the above items of prior art are present in the references

18 themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

19 the nature of the problems allegedly addressed by the '959 Patent. Combining the references

20 disclosed in Exhibit C would have been obvious, as the references identify and address the same

21 technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

22 amend or supplement these invalidity contentions to identify additional reasons that combining the

23 references would be obvious to one of ordinary skill in the art.

24

25   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

26 alone or in combination with other references, including identification of combinations showing

27 obviousness, are identified in Exhibits C-1 to C-9, which includes exemplary claim charts for the

28

1   asserted claims of the '959 Patent showing specifically where in each reference or combinations of

2   references each asserted claim is found, and an explanation of why the prior art renders the

3   asserted claim obvious.

4   In particular, Samsung contends that the asserted claims of the '959 Patent would have

5   been obvious in view of the prior art references identified above and in Exhibit C. For example,

6   Exhibit C includes claim charts that describe how the asserted claims of the '959 Patent would

7   have been obvious in view of all references identified in Exhibit C, which, if found not to

8   anticipate the claims of the '959 Patent, render the claims of the '959 Patent obvious alone.

9   In addition to the specific combinations of prior art and the specific combinations of

10 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

11 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

12 disclosed within the prosecution history of the references cited herein.

13   The obviousness combinations set forth in these contentions reflect Samsung's present

14 understanding of the potential scope of the claims that Plaintiff appears to be advocating and

15 should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

16   Samsung reserves the right to amend or supplement these contentions regarding

17 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

18 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

19 not identified what elements or combinations it alleges were not known to one of ordinary skill in

20 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

21 particular prior art reference, Samsung reserves the right to assert that any such limitation is either

22 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

23 of the same, or that the limitation is disclosed in another of the references disclosed above and in

24 combination would have rendered the asserted claim obvious.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1

2

C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each Alleged item of Prior Art each Asserted Claim is Found

3   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

4   item of prior art each limitation of each asserted claim is found, including for each limitation that

5   Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

6   material(s) in each item of prior art that performs the claimed function are attached in Exhibits C-1

7   through C-9.

8

D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity

9   Samsung identifies the following grounds for invalidity of the asserted claims of the '959

10   Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

11   supplement these disclosures based on further investigation and discovery.

12

1.   Invalidity Based on 35 U.S.C. § 101

13   The asserted claims of the '959 Patent are invalid under 35 U.S.C. § 101 because they

14   claim only abstract ideas. For example, "using a different heuristic to locate information,"

15   "heuristic(s) locates items of information," "providing said information identifier to a plurality of

16   heuristics to locate information in a plurality of locations," and "determining at least one candidate

17   item of information," each refer only to programming abstractions or the manipulation of

18   information; these are concepts, not physical objects or tangible matter.

19

20

2.   Invalidity Based on Enablement or Written Description Under 35 U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35 U.S.C. § 112(2)

21   Samsung asserts that each asserted claim of the '959 Patent is invalid in that the '959

22   specification fails to particularly point out and distinctly claim the alleged invention of the '959

23   Patent. Samsung further asserts that each asserted claim of the '959 Patent is invalid as not

24   containing a written description of the invention, and of the manner and process of making and

25   using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

26   which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

27   Based on Samsung's present understanding of Plaintiff's infringement contentions,

28   Samsung asserts that claims 1-5, 9-12, 14-17, 19-20, 22-25, 27-30 and 32-33 of the '959 Patent are

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   invalid for reciting at least the claim terms "heuristic" and/or "heuristics." Based on Samsung's

2   present understanding of Plaintiff's infringement contentions, Samsung further asserts that claims

3   9-12, 14-16, 22, 23, 27, 28, 32 and 33 are invalid for reciting at least the claim term/phrase

4   "heuristics locates" and one or more of the following phrases:

- "one of said heuristics locates information on the basis of names of files"
- "another of said heuristics locates items of information on the basis contents of files"
- "another of said heuristics locates items of information on the basis of most recently accessed items"
- "one of said heuristics locates items of information that are stored locally on a computer system"
- "another of said heuristics locates items of information that are stored on remote computer systems"
- "said other heuristic locates Internet web pages"
- "said other heuristic locates items of information that are stored on a wide-area network"

17   Also based on Samsung's present understanding of Plaintiff's infringement contentions,

18   Samsung further asserts that claims 20, 25, and 30 are invalid for reciting at least the claim

19   term/phrase "the information identifier is applied separately to each heuristic." Samsung also

20   asserts that claim 24 is invalid for reciting "program instructions." Claims 24, 25, 27-30, 32 and

21   33 are invalid for reciting "determin[ing] at least one candidate item of information based upon the

22   plurality of heuristics." These claim terms/phrases as apparently construed by Apple violate the

23   written description, enablement and/or definiteness requirements of 35 U.S.C. § 112.

24   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

25   one or more of these claim terms/phrases are indefinite because they are inconsistent with and

26   broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

27   constructions of the claims, any person of ordinary skill in the art at the time of the invention

28   would not understand what is claimed, even when the claims are read in light of the specification.

1   Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

2   of the asserted claims in which these claim terms/phrases appear lack written description because

3   the specification of the '959 Patent demonstrates that the patentee neither conceived of nor

4   demonstrated possession of all that Plaintiff now contends the claims cover.

5   Samsung further asserts that claims 29, 20, 32 and 33 are invalid for reciting at least the

6   following claim terms/phrases:

7   • "means for inputting an information identifier"

8   • "means for providing said information identifier to a plurality of heuristics . . ."

9   • "means for determining at least one candidate item of information based upon the

10   plurality of heuristics,"

11   • "means for displaying a representation of said candidate item of information."

12 Each of these claim limitations is governed by 35 U.S.C. § 112, paragraph 6. The '959 patent

13 specification, however, fails to set forth the structure, material or acts for accomplishing the

14 recited function. Each of these claims is therefore invalid as indefinite under 35 U.S.C. § 112(2).

15   In addition, based on Samsung's present understanding of Plaintiff's infringement

16 contentions, each of the asserted claims in which the terms identified above appear are invalid

17 because the specification fails to provide sufficient disclosure to enable any person of ordinary

18 skill in the art to which it pertains, or with which it is most nearly connected, to implement the

19 invention without undue experimentation. The '959 patent specification fails to describe the

20 manner and process of making and using the claimed invention in such full, clear concise and

21 exact terms as to enable a person of ordinary skill in the art to which it pertains to make and use

22 the claimed invention.

23   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

24 ¶¶ 1 and 2.

25 **IV.   THE '414 PATENT**

26   **A.   Local Patent Rule 3-3(a): Identification of Prior Art**

27   At this time, Samsung contends that at least the following prior art references anticipate or

28 render obvious, either alone or in combination, the asserted claims of the '414 Patent:

1.   **Patent References**[8]

Country of Origin	Patent Number	Date of Issue	Priority Date
US	5,255,388	Oct. 19, 1993	Sep. 26, 1990
US	5,473,776	Dec. 5, 1995	Feb. 16, 1993
US	5,515,502	May 7, 1996	Sep. 30, 1993
US	5,729,710	Mar. 17, 1998	June 22, 1994
US	5,734,910	Mar. 31, 1998	Dec. 22, 1995
US	5,937,414	Aug. 10, 1999	Feb. 28, 1997
US	6,012,081	Jan. 4, 2000	July 3, 1996
US	6,014,681	Jan. 11, 2000	July 15, 1997
US	6,021,414	Feb. 1, 2000	Sep. 11, 1995
US	6,260,075	July 10, 2001	June 19, 1995
US	6,643,669	Nov. 4, 2003	Mar. 14, 2000
US	6,662,212	Dec. 9, 2003	Aug. 31, 1999
US	6,662,212	Dec. 9, 2003	Aug. 31, 1999
US	6,671,700	Dec. 30, 2003	May 23, 2000
US	6,983,247	Jan. 3, 2006	June 26, 2002
US	7,024,491	Apr. 4, 2006	May 23, 2001
US	7,024,491	Apr. 4, 2006	May 23, 2001
US	7,158,998	Jan. 2, 2007	July 31, 2002
US	7,158,998	Jan. 2, 2007	July 31, 2002
US	7,290,034	Oct. 30, 2007	May 7, 2004
US	7,290,034	Oct. 30, 2007	May 7, 2004
US	7,366,743	Apr. 29, 2008	Mar. 6, 2002
US	7,370,025	May 6, 2008	Dec. 17, 2002
US	7,403,958	July 22, 2008	Jan. 19, 2005
US	7,412,460	Aug. 12, 2008	June 19, 2003
US	7,430,426	Sep. 30, 2008	Jan. 24, 2005
US	7,457,846	Nov. 25, 2008	Oct. 5, 2001
US	7,477,890	Jan. 13, 2009	June 30, 2000
US	7,503,052	Mar. 10, 2009	Apr. 14, 2004
US	7,506,006	Mar. 17,2009	Sep. 3, 2004
US	7,506,006	Mar. 17, 2009	Sep. 3, 2004
US	7,506,006	Mar. 17, 2009	Apr. 13, 2006
US	7,523,344	Apr. 21, 2009	June 19, 2006
US	7,546,364	June 9, 2009	May 16, 2002
US	7,752,166	July 6, 2010	Nov. 15, 2001
US	7,752,166	July 6, 2010	Nov. 15, 2001
US	7,788,225	Aug. 31, 2010	Mar. 18, 2005
US	7,849,140	Dec. 7, 2010	Aug. 29, 2002
US	7,877,797	Jan. 25, 2011	Feb. 23, 2006
US	7,877,797	Jan. 25, 2011	Feb. 23, 2006
US	8,005,889	Aug. 23, 2011	Nov. 16, 2005
US	8,005,889	Aug. 23, 2011	Nov. 16, 2005
US	8,121,978	Feb. 21, 2012	Sep. 11, 2003
US	2006/0026198	Feb. 2, 2006	July 30, 2004
US	2002/0059299	May 16, 2002	Jan. 23, 2001
US	2003/0149762	August 7, 2003	Oct. 5, 2001

[8] Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	2005/0278458	Dec. 15, 2005	June 9, 2004
US	2007/0180447	Aug. 2, 2007	Nov. 14, 2006
US	2008/0066148	Mar. 13, 2008	Oct. 30, 2007
US	2008/0256547	Feb. 23, 2005	Oct. 16, 2008

2. **Publications[9]**

Title	Date of Publication	Author	Publisher
A New Service from Notify Technology The NotifyLink Hosted Edition	Dec. 31, 2005		Notify Technology
Advanced Windows The Developer's Guide to the Win32® API for Windows NT™ 3.5 and Windows 95	1995	Jeffrey Richter	Microsoft
Bayou: Replicated Database Services for World-wide Applications	1996	Karin Petersen, Mike Spreitzer, Douglas Terry, Marvin Theimer	Association for Computing Machinery
BlackBerry Application Developer Guide Volume 1: Fundamentals	Oct. 13, 2005		RIM
BlackBerry Application Developer Guide Volume 2: Advanced Topics	Oct. 13, 2005		RIM
BlackBerry Enterprise Server for Microsoft Exchange Version 4.0 Feature and Technical Overview	Nov. 10, 2004		RIM
BlackBerry Enterprise Software v4.0 for Microsoft Exchange: Feature Enhancement Overview	2004		RIM
BlackBerry Wireless Handheld Version 4.1 User Guide: BlackBerry 7520	Sep. 7, 2005		RIM
DataViz - RoadSync Series 80 Manual			DataViz
Developing Multithreaded Applications for the .NET Compact Framework	June 2005	Maarten Struys	Microsoft
EasyStreet: A location management and data synchronization application for mobile computing	July 19, 2000	Steven J. Mastrianni	
Eliminating duplication and ensuring file integrity in	Dec. 2005	Muaz Niazi, Umar Manzoor,	IEEE

---

[9]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

Title	Date of Publication	Author	Publisher
Multisync: A multiagent system for ubiquitous file synchronization		Kiran Ijaz, Summiya and Hina Saleem	
Effective Java	2001	Joshua Bloch	Addison-Wesley
Exchange ActiveSync and Exchange 2003	July 6, 2005		Microsoft
Exchange Information Store Service Architecture	May 23, 2005		Microsoft
Flexible and safe resolution of file conflicts	1994	Puneet Kumar and M. Satyanarayanan	DTIC
Flexible Update Propagation for Weakly Consistent Replication	1997	Karin Petersen, M.J. Spreitzer, D.B. Terry, M.M. Theimer, A.J. Demers	Association for Computing Machinery
Getting Started Guide: BlackBerry 8700c Wireless Handheld^{TM} from Cingular	2005		RIM
IETF RFC 2251: Lightweight Directory Access Protocol v3	Dec. 1997	M. Wahl, T. Howes and S. Kille	IETF
IETF RFC 3377: Lightweight Directory Access Protocol v3: Technical Specification	Sep. 2002	J. Hodges and R. Morgan	IETF
IETF RFC 3501: Internet Message Access Protocol – Version 4rev1	March 2003	M. Crispin	IETF
Introduction to Microsoft Exchange Server 2003	July 2004		Microsoft
Introduction to Multi-Threaded Programming	May 1, 1999	Brian Masney	Linux Journal
iPod nano Features Guide	Sep. 7, 2005		Apple
Jabber Based Protocol for Collaborative Mobile Work	Sep. 16, 2006	Martin Klima and Pavel Slavik	Springer-Verlag Berlin Heidelberg
Java in a Nutshell 2nd Edition	May 1997	David Flanagan	O'Reilly
Mail Anywhere Studio	2002		iAnywhere Solutions
Towards the Ubiquitous Office Vision With focus on Mobile Data Synchronization	Mar. 2002	Fredrik Hacklin	
Managing Update Conflicts in Bayou, a Weakly Connected Replicated Storage System	1995	D.B. Terry, M.M. Theimer, Karin Petersen, A.J. Demers, M.J. Spreitzer, C.H. Hauser	Association for Computing Machinery

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Microsoft Exchange Server 2003 ActiveSync Architecture	Jan. 5, 2003	Steven D. Bramson and Marc Gallucci	Microsoft
Microsoft Improves Access to Customer Data with New Smart Client Solution	Dec. 2005		Microsoft
Microsoft Smart Client Architecture and Design Guide	Sept. 4, 2004	David Hill, Brenton Webster, Edward A. Jezierski, Srinath Vasireddy, Mo Al-Sabt, Blaine Wastell, Jonathan Rasmusson, Paul Gale and Paul Slater	Microsoft
Modern Operating Systems Second Edition	2001	Andrew Tanenbaum	Prentice Hall
NotifyLink Hosted Edition White Paper	Nov. 13, 2006		Notify Technology
Novell Evolution 2.4 User Guide	Sep. 7, 2005		Novell
Object Based Concurrency for Data Parallel Applications: Programmability and Effectiveness	2002	Roxana Diaconescu	Norwegian University of Science and Technology
OneBridge Mobile Groupware Product Datasheet	2006		iAnywhere Solutions
Palm Pilot The Ultimate Guide	1999	David Pogue	O'Reilly
Primarily Disconnected Operation: Experiences with Ficus	Nov. 1992	J. S. Heidemann, T. W. Page, R. G. Guy and G. J. Popek	IEEE
Pylon Anywhere Client User's Guide	2003		iAnywhere Solutions
RCal: An Autonomous Agent for Intelligent Distributed Meeting Scheduling	Nov. 2003	Rahul Singh	Carnegie Mellon University
Resolving file conflicts in the Ficus file system	1994	Peter Reiher, John Heidemann, David Ratner, Greg Skinner, and Gerald	Association for Computing Machinery

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
		Popek	
SemanticLIFE - Outlook Datafeed Module Software Architecture Document Version 2.0	Apr. 20, 2005	Hoang Huu Hanh	
SunOS Multi-thread architecture	1991	M. L. Powell , S. R. Kleiman , S. Barton , D. Shah , D. Stein , M. Weeks	
The Bayou Architecture: Support for Data Sharing among Mobile Users	1994	K. Petersen, M. Spreitzer, D. Ferry, M. Theimer, B. Welch	IEEE
The Case for Non-transparent Replication: Examples from Bayou	1998	Douglas B. Terry, Karin Petersen, Mike J. Spreitzer, Marvin M. Theimer	IEEE
The Open Group Base Specifications Issue 6	2004		IEEE
Unix Applications Programming Mastering the Shell	1990	Ray Swartz	Sams Publishing
Using Your Palm® Treo™ 700w Smartphone	2006		Palm
Visto Mobile™ Personal Edition for Professionals	2005		Visto
Windows CE handheld systems for the corporate mobile work force	Mar. 30, 2005	Steven J. Mastrianni	
SCH-i830 Series Global Pocket PC Phone User Manual	2005		Samsung
Windows Mobile Software for Pocket PC: Pocket Outlook	July 1, 2005		Microsoft
Windows Mobile Software for Pocket PC Phone Edition	Sep. 19, 2003		Microsoft

3.   **Systems**

All versions of the following prior art systems commercially sold, publicly known or used

before the priority date of the '414 Patent, including documents and source code describing the

same:

- Novell Evolution (at least 2.4)

- Ficus

- Coda

- Bayou

- Mozilla Thunderbird

- SyncKolab

- Mozilla Lightning Project

- Coldsync

- iTunes (at least version 6.0.1), and, for example, Apple Macintosh OS X 10.3.9 / iPod nano / Mac Address Book

- iSync (at least version 1.4), and, for example, Apple Macintosh OS X 10.3.9 / iPod nano / Mac Address Book

- Microsoft Exchange ActiveSync / SCH-i830 Series Global Pocket PC Phone / Palm® Treo™ 700w Smartphone / Pocket Outlook

- Blackberry / BlackBerry Wireless Handheld Version 4.1

- NotifyLink Hosted Edition

Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other references to render the claims of the '414 Patent obvious in the event Apple takes the position that certain claim limitations are missing from the references charted in Exhibit D.

B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims

Plaintiff asserts claims 1-2, 4, 6-7, 10-12, 14, 16-17, 20-24, 26-28 and 30-32 of the '414 Patent against Samsung in this lawsuit. All of those claims are invalid because the '414 Patent fails to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the claim charts attached as Exhibit D. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

1   Although Samsung has identified at least one citation per limitation for each reference,

2   each and every disclosure of the same limitation in the same reference is not necessarily identified.

3   Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

4   identified references, even where a reference may contain additional support for a particular claim

5   element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

6   whole and in the context of other publications and literature. Thus, to understand and interpret any

7   specific statement or disclosure within a prior art reference, such persons would rely on other

8   information within the reference, along with other publications and their general scientific

9   knowledge. Samsung may rely upon uncited portions of the prior art references and on other

10 publications and expert testimony to provide context, and as aids to understanding and interpreting

11 the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

12 other disclosed publications, and the testimony of experts to establish that a person of ordinary

13 skill in the art would have been motivated to modify or combine certain of the cited references so

14 as to render the claims obvious.

15   1.   **Anticipation**

16   Some or all of the asserted claims of the '414 Patent are invalid as anticipated under 35

17 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

18 included in Exhibit D, which identify specific examples of where each limitation of the asserted

19 claims is found in the prior art references. As explained above, the cited portions of prior art

20 references identified in the attached claim charts are exemplary only and representative of the

21 content and teaching of the prior art references, and should be understood in the context of the

22 reference as a whole and as they would be understood by a person of ordinary skill in the art.

23   2.   **Obviousness**

24   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

25 above and in Exhibit D, then any purported differences are such that the claimed subject matter as

26 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

27 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

28 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

1   In addition, the references identified above render one or more asserted claims of the '414

2 Patent obvious when the references are read in combination with each other, and/or when read in

3 view of the state of the art and knowledge of those skilled in the art. Each and every reference

4 identified is also relevant to the state of the art at the time of the alleged invention. Any of the

5 references disclosed above may be combined to render obvious (and therefore invalid) each of

6 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

7 all of the references identified above, including all references in Exhibit D, for purposes of

8 obviousness depending on the Court's claim construction, positions taken by Apple during this

9 litigation, and further investigation and discovery.

10   Moreover, to the extent the foregoing references are found not to anticipate the asserted

11 claims, the foregoing references render the asserted claims obvious either alone or in combination

12 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

13 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

14 at the time of the alleged invention of the asserted claims of the '414 Patent to combine the various

15 references cited herein so as to practice the asserted claims of the '414 Patent.

16

17   Motivations to combine the above items of prior art are present in the references

18 themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

19 the nature of the problems allegedly addressed by the '414 Patent. Combining the references

20 disclosed in Exhibit D would have been obvious, as the references identify and address the same

21 technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

22 amend or supplement these invalidity contentions to identify additional reasons that combining the

23 references would be obvious to one of ordinary skill in the art.

24

25   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

26 alone or in combination with other references, including identification of combinations showing

27 obviousness, are identified in Exhibits D 1-14, which includes exemplary claim charts for the

28

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

asserted claims of the '414 Patent showing specifically where in each reference or combinations of references each asserted claim is found, and an explanation of why the prior art renders the asserted claim obvious.

In particular, Samsung contends that the asserted claims of the '414 Patent would have been obvious in view of the prior art references identified above. For example, Exhibit D includes exemplary claim charts that describe how the asserted claims of the '414 Patent would have been obvious in view of all references identified in Exhibit D, which, if found not to anticipate the claims of the '414 Patent, render the claims of the '414 Patent obvious alone.

In addition to the specific combinations of prior art and the specific combinations of groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any prior art references disclosed herein. Samsung further reserves the right to rely upon combinations disclosed within the prosecution history of the references cited herein.

The obviousness combinations set forth in these contentions reflect Samsung's present understanding of the potential scope of the claims that Plaintiff appears to be advocating and should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

Samsung reserves the right to amend or supplement these contentions regarding anticipation or obviousness of the asserted claims, in view of further information from Plaintiff, information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has not identified what elements or combinations it alleges were not known to one of ordinary skill in the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a particular prior art reference, Samsung reserves the right to assert that any such limitation is either inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light of the same, or that the limitation is disclosed in another of the references disclosed above and in combination would have rendered the asserted claim obvious.

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1

2

C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each Alleged item of Prior Art each Asserted Claim is Found

3

Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

4

item of prior art each limitation of each asserted claim is found, including for each limitation that

5

Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

6

material(s) in each item of prior art that performs the claimed function is attached in Exhibits D-1

7

through D-14.

8

D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity

9

Samsung identifies the following grounds for invalidity of the asserted claims of the '414

10

Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

11

supplement these disclosures based on further investigation and discovery.

12

1.   Invalidity Based on 35 U.S.C. § 101

13

The asserted claims of the '414 Patent are invalid under 35 U.S.C. § 101 because they only

14

claim abstract ideas. Many limitations in the asserted claims are common abstractions in

15

computer systems and programming languages. For example, the limitations "one user-level non-

16

synchronization processing thread," "one synchronization processing thread," "a lock on the first

17

store," "releases the lock after synchronization for a first data class is completed," and

18

"synchronized in a peer-to-peer manner," each refer only to programming abstractions or the

19

manipulation of information; these are concepts, not physical objects or tangible matter.

20

2.   Invalidity Based on Enablement or Written Description Under 35 U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35 U.S.C. § 112(2)

21

22

Samsung asserts that each asserted claim of the '414 Patent is invalid in that the '414

23

specification fails to particularly point out and distinctly claim the alleged invention of the '414

24

Patent. Samsung further asserts that each asserted claim of the '414 Patent is invalid as not

25

containing a written description of the invention, and of the manner and process of making and

26

using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

27

which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

28

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   Based on Samsung's present understanding of Plaintiff's infringement contentions,

2   Samsung asserts that the asserted claims of the '414 Patent are invalid under 35 U.S.C. § 112 ¶ 1 at

3   least because they include the following claim terms/phrases:

4   • "one user-level non-synchronization processing thread,"

5   • "one user-level non-synchronization processing thread,"

6   • "concurrently,"

7   • "user interface to allow a user to access and edit structured data in a first store
8   associated with a first database,"

9   • "one synchronization processing thread,"

10   • "synchronization software component which is configured to synchronize the
           structured data from the first database with the structured data from a second
11   database,"

12   • "a lock on the first store,"

13   • "releases the lock after synchronization for a first data class is completed,"
14

15   • "synchronized in a peer-to-peer manner," and

16   • "synchronize structured data of a first data class and other synchronization software
           components are configured to synchronize structured data of other corresponding
17   data classes."

18 These claim terms/phrases as apparently construed by Apple violate the written description and/or

19 enablement requirements of 35 U.S.C. § 112 ¶ 1. For instance, the term "peer-to-peer" is broader

20 than and inconsistent with the alleged invention disclosed in the specification, and given Apple's

21 infringement contentions, one of ordinary skill in the art would not understand what Apple has

22 claimed. Additionally, claims 7 and 17 of the '414 patent are invalid because they lack a proper

23 antecedent basis for at least the term "first and second data processing systems."

24   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

25 one or more of these claim terms/phrases are indefinite because they are inconsistent with and

26 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

27 constructions of the claims, any person of ordinary skill in the art at the time of the invention

28 would not understand what is claimed, even when the claims are read in light of the specification.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

2   of the asserted claims in which these claim terms/phrases appear lack written description because

3   the specification of the '414 Patent demonstrates that the patentee neither conceived of nor

4   demonstrated possession of all that Apple now contends the claims cover. In addition, based on

5   Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted

6   claims in which these claim terms/phrases appear are invalid because the specification fails to

7   provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,

8   or with which it is most nearly connected, to implement the invention without undue

9   experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

10   Samsung further asserts that claims 21, 22, 31, and 32 are invalid for reciting at least the

11   following claim limitations:

12   • "means for executing at least one user-level non-synchronization processing thread

13   that includes means for accessing structured data in a first store associated with a

14   first database;"

15   • "means for executing at least one synchronization processing thread concurrently

16   with the executing of the at least one user-level non-synchronization processing

17   thread that includes means for synchronizing the structured data from the first

18   database with the structured data from a second database;"

19

20   • "means for executing at least one non-synchronization processing thread;"

21   • "means for accessing structured data in a first store associated with a first

22   database;"

23   • "means for executing at least one synchronization processing thread concurrently

24   with the executing of the at least one non-synchronization processing thread that

25   includes means for synchronizing the structured data from the first database with

26   the structured data from a second database."

27

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   Each of those claim limitations is governed by 35 U.S.C. section 112, paragraph 6. The

2   '414 patent specification, however, fails to set forth the structure, material or acts for

3   accomplishing the recited function. Each of these claims is therefore invalid as indefinite under 35

4   U.S.C. § 112(2).

5   **V.   THE '760 PATENT**

6   **A.   Local Patent Rule 3-3(a): Identification of Prior Art**

7   At this time, Samsung contends that at least the following prior art references anticipate or

8   render obvious, either alone or in combination, the asserted claims of the '760 Patent:

9   1.   **Patent References**[10]

Country of Origin	Patent Number	Date of Issue	Priority Date
US	6,430,405	Aug. 6, 2002	Dec. 7, 1998
US	6,448,988	Sep. 10, 2002	Jan. 29, 1997
US	6,526,274	Feb. 25, 2003	Oct. 25, 1999
US	6,542,591	Apr. 1, 2003	July 27, 2000
US	6,549,612	Apr. 15, 2003	May 6, 1998
US	6,738,461	May 18, 2004	Nov. 1, 2001
US	6,772,188	Aug. 3, 2004	July 14, 2000
US	6,792,082	Sep. 14, 2004	Sep. 11, 1998
US	6,879,691	Apr. 12, 2005	May 12, 2000
US	6,961,420	Nov. 1, 2005	Nov. 13, 2001
US	7,007,239	Feb. 28, 2006	Sep. 21, 2000
US	7,117,445	Oct. 3, 2006	June 30, 2003
US	7,212,808	May 1, 2007	Oct. 15, 2002
US	7,221,748	May 22, 2007	Nov. 12, 2002
US	7,225,409	May 29, 2007	Aug. 25, 1999
US	7,231,229	June 12, 2007	Mar. 16, 2003
US	7,280,652	Oct. 9, 2007	Sep. 13, 2004
US	7,280,850	Oct. 9, 2007	Sep. 27, 2001
US	7,289,614	Oct. 30, 2007	Sep. 29, 2000
US	7,403,767	July 22, 2008	Apr. 29, 2005
US	7,409,050	Aug. 5, 2008	Apr. 21, 2005
US	7,493,567	Feb. 17, 2009	Jan. 28, 2004
US	7,502,633	Mar. 10, 2009	Oct. 15, 2002
US	7,526,306	Apr. 28, 2009	Dec. 8, 2003
US	7,606,598	Oct. 20, 2009	Mar. 31, 2006
US	7,680,513	Mar. 16, 2010	Aug. 8, 2005
US	7,623,643	Nov. 24, 2009	July 26, 2005
US	7,680,513	Mar. 16, 2010	Aug. 8, 2005
US	7,685,530	Mar. 23, 2010	June 10, 2005
US	7,715,535	May 11, 2010	Sep. 27, 2005

---

[10]   Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	7,724,887	May 25, 2010	July 21, 2005
US	7,778,399	Aug. 17, 2010	July 2, 2004
US	7,778,671	Aug. 17, 2010	Oct. 8, 2004
US	7,779,630	Sep. 14, 2010	June 24, 2004
US	7,783,283	Aug. 24, 2010	Sep. 8, 2004
US	7,839,987	Nov. 23, 2010	Nov. 1, 2001
US	7,894,597	Feb. 22, 2011	Oct. 12, 2005
US	7,920,886	Apr. 5, 2011	Jan. 24, 2006
US	7,991,432	Aug. 2, 2011	Apr. 2, 2004
US	8,001,120	Aug. 16, 2011	Feb. 12, 2004
US	8,019,388	Sep. 13, 2011	Feb. 6, 2003
US	8,064,886	Nov. 22, 2011	Feb. 14, 2006
US	8,095,879	Jan. 10, 2012	Dec. 10, 2002
US	8,175,656	May 8, 2012	Feb. 24, 2006
US	2002/0076015	June 20, 2002	Dec. 15, 2000
US	2002/0111991	Aug. 15, 2002	Nov. 1, 1999
US	2002/0116464	Aug. 22, 2002	Feb. 20, 2001
US	2004/0137955	July 15, 2004	Oct. 15, 2002
US	2004/0235520	Nov. 25, 2004	May 20, 2003
US	2005/0047562	Mar. 3, 2005	Aug. 28, 2003
US	2005/0250483	Nov. 10, 2005	May 7, 2004
US	2004/0267887	Dec. 30, 2004	June 30, 2003
US	2003/0032527	Feb. 10, 2005	Aug. 8, 2003
US	2005/0074109	Apr. 7, 2005	Sep. 24, 2004
US	2005/0141686	June 30, 2005	June 7, 2004
US	2006/0010395	Jan. 12, 2006	July 9, 2004
US	2006/0140189	June 29, 2006	Dec. 23, 2004
US	2006/0281449	Dec. 14, 2006	June 14, 2005
US	2007/0071186	Mar. 29, 2007	Sep. 21, 2005
US	2007/0083600	Apr. 12,2007	Oct. 6, 2005
US	2007/0092072	Apr. 26, 2007	Sep. 30, 2005
US	2007/0133771	June 14, 2007	Dec. 12, 2005
US	2007/0243858	Oct. 18, 2007	Apr. 18, 2006
US	2007/0280457	Dec. 6, 2007	June 2, 2006
US	2008/0295017	Nov. 27, 2008	Sep. 5, 2006
EP	1 069 791	Jan. 17, 2001	July 13, 1999
EP	1 365 564	Nov. 26, 2003	Apr. 30, 2003

2.   **Publications**[11]

Title	Date of Publication	Author	Publisher
Exploring PC-Telephone Convergence with the Enhanced Telephony Prototype	Apr. 2004	JJ Cadiz, Attila Narin, Gavin Jancke, Anoop Gupta, and Michael Boyle	Association for Computing Machinery
Finger Instead of Mouse:	2003	Andreas	Springer-Verlag

---

[11]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Touch Screens as a Means of Enhancing Universal Success		Holzinger	
Ming User Manual	2006		Motorola
Model 8690 Inter-Tel Protocol Mode User Guide	Mar. 2006		Inter-Tel
Motorola A1000 User Guide	2002		Motorola
Nokia 9000i User's Manual	1997		Nokia
Nokia 9110 User's Manual	1998		
P900/P908 White Paper	Dec. 2003		Motorola
pdQ^{TM} Applications Handbook	1999		Sony Ericsson
TAKEphONE User Manual	June 15, 2006		Iambic
TealPhone User's Manual	Jan. 24, 2006		TealPoint Software
The Kyocera 7135 Smartphone: Reference Guide	2002		Kyocera
User's Guide Agendus for Symbian OS UIQ Edition	Apr. 1, 2004		Iambic
Using Your Palm® Treo^{TM} 700w Smartphone	2006		Palm
using your Treo^{TM} 650 smartphone	2004		Palm
XPlore M98 User Manual	July 14, 2005		Group Sense PDA

3.   **Systems**

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '760 Patent, including documents and source code describing the same:

- Agenda Fusion

- Agendus Professional

- Motorola A1200

- TealPhone

- Windows Mobile 5

Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other

1   references to render the claims of the '760 Patent obvious in the event Apple takes the position that

2   certain claim limitations are missing from the references charted in Exhibit E.

3   **B.**   **Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims**

4

5   Plaintiff asserts claims 1-5 and 7-22 of the '760 Patent against Samsung in this lawsuit. All

6   of those claims are invalid because the '760 Patent fails to meet one or more of the requirements

7   for patentability. The individual bases for invalidity are provided below and in the claim charts

8   attached as Exhibit E. Each of the foregoing listed prior art documents, the underlying work,

9   and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35

10   U.S.C. § 102 and/or 35 U.S.C. § 103.

11   Although Samsung has identified at least one citation per limitation for each reference,

12   each and every disclosure of the same limitation in the same reference is not necessarily identified.

13   Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

14   identified references, even where a reference may contain additional support for a particular claim

15   element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

16   whole and in the context of other publications and literature. Thus, to understand and interpret any

17   specific statement or disclosure within a prior art reference, such persons would rely on other

18   information within the reference, along with other publications and their general scientific

19   knowledge. Samsung may rely upon uncited portions of the prior art references and on other

20   publications and expert testimony to provide context, and as aids to understanding and interpreting

21   the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

22   other disclosed publications, and the testimony of experts to establish that a person of ordinary

23   skill in the art would have been motivated to modify or combine certain of the cited references so

24   as to render the claims obvious.

25   1.   **Anticipation**

26   Some or all of the asserted claims of the '760 Patent are invalid as anticipated under 35

27   U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

28   included in Exhibit E, which identify specific examples of where each limitation of the asserted

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   claims is found in the prior art references. As explained above, the cited portions of prior art

2   references identified in the attached claim charts are exemplary only and representative of the

3   content and teaching of the prior art references, and should be understood in the context of the

4   reference as a whole and as they would be understood by a person of ordinary skill in the art.

5   2.   **Obviousness**

6   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

7   above and in Exhibit E, then any purported differences are such that the claimed subject matter as

8   a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

9   view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

10   therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

11   In addition, the references identified above render one or more asserted claims of the '760

12   Patent obvious when the references are read in combination with each other, and/or when read in

13   view of the state of the art and knowledge of those skilled in the art. Each and every reference

14   identified is also relevant to the state of the art at the time of the alleged invention. Any of the

15   references disclosed above may be combined to render obvious (and therefore invalid) each of

16   Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

17   all of the references identified above, including all references in Exhibit E, for purposes of

18   obviousness depending on the Court's claim construction, positions taken by Apple during this

19   litigation, and further investigation and discovery.

20   Moreover, to the extent the foregoing references are found not to anticipate the asserted

21   claims, the foregoing references render the asserted claims obvious either alone or in combination

22   with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

23   herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

24   at the time of the alleged invention of the asserted claims of the '760 Patent to combine the various

25   references cited herein so as to practice the asserted claims of the '760 Patent.

26

27   Motivations to combine the above items of prior art are present in the references

28   themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

1   the nature of the problems allegedly addressed by the '760 Patent. Combining the references

2   disclosed in Exhibit E would have been obvious, as the references identify and address the same

3   technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

4   amend or supplement these invalidity contentions to identify additional reasons that combining the

5   references would be obvious to one of ordinary skill in the art.

6

7   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

8   alone or in combination with other references, including identification of combinations showing

9   obviousness, are identified in Exhibits E-1 to E-8, which includes exemplary claim charts for the

10 asserted claims of the '760 Patent showing specifically where in each reference or combinations of

11 references each asserted claim is found, and an explanation of why the prior art renders the

12 asserted claim obvious.

13

14   In particular, Samsung contends that the asserted claims of the '760 Patent would have

15 been obvious in view of the prior art references identified above. For example, Exhibit E includes

16 exemplary claim charts that describe how the asserted claims of the '760 Patent would have been

17 obvious in view of all references identified in Exhibit E, which, if found not to anticipate the

18 claims of the '760 Patent, render the claims of the '760 Patent obvious alone.

19

20   In addition to the specific combinations of prior art and the specific combinations of

21 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

22 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

23 disclosed within the prosecution history of the references cited herein.

24   The obviousness combinations set forth in these contentions reflect Samsung's present

25 understanding of the potential scope of the claims that Plaintiff appears to be advocating and

26 should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

27   Samsung reserves the right to amend or supplement these contentions regarding

28 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

2   not identified what elements or combinations it alleges were not known to one of ordinary skill in

3   the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

4   particular prior art reference, Samsung reserves the right to assert that any such limitation is either

5   inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

6   of the same, or that the limitation is disclosed in another of the references disclosed above and in

7   combination would have rendered the asserted claim obvious.

8   **C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each
                       Alleged item of Prior Art each Asserted Claim is Found**

9

10   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

11   item of prior art each limitation of each asserted claim is found, including for each limitation that

12   Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

13   material(s) in each item of prior art that performs the claimed function is attached in Exhibits E-1

14   to E-8.

15   **D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity**

16   Samsung identifies the following grounds for invalidity of the asserted claims of the '760

17   Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

18   supplement these disclosures based on further investigation and discovery.

19   1.   **Invalidity Based on Enablement or Written Description Under 35
                    U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35
20   U.S.C. § 112(2)**

21   Samsung asserts that each asserted claim of the '760 Patent is invalid in that the '760

22   specification fails to particularly point out and distinctly claim the alleged invention of the '760

23   Patent. Samsung further asserts that each asserted claim of the '760 Patent is invalid as not

24   containing a written description of the invention, and of the manner and process of making and

25   using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

26   which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

27   Based on Samsung's present understanding of Apple's infringement contentions, Samsung

28   asserts that claims 8, 10, 14, 18, 19, 21 of the '760 Patent are invalid as indefinite because they

1 combine method and apparatus limitations. Samsung further asserts that claims 1, 3, 7, 8, 10, 12-

2 22 of the '760 Patent are invalid as indefinite for reciting at least the following claim

3 terms/phrases:

- "interactive displayed portion"

- "immediately in response to detecting" / "detecting a user tap input . . . and immediately in response to that input"

- "initiating a return telephone call"

- "finger gesture" / "finger tap input" / "user tap input"

- "detecting user selection"

- "completely substituting display of the list of interactive items with display of contact information"

- "a first contact object comprising a telephone number object having the return telephone number" / "a first contact object comprising a telephone number associated with the caller"

- "non-telephonic communication modality"

- "a second contact object associated with a non-telephonic communication modality"

- "initiating a communication "

- "instant messaging" / "instant message"

- "the second interactive displayed portion of the respective user selected item is identified by an icon displayed within the respective user selected item"

- "associated with a missed call" / "associated with contact information"

- "associated with sending an email" / "associated with sending an instant message"

- "that input"

- "the finger tap input"

- "that interactive displayed item"

- "the selected interactive displayed item"

-64-

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   These claim terms/phrases as apparently construed by Apple violate the written description,

2   enablement and/or definiteness requirements of 35 U.S.C. § 112.

3   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

4   one or more of these claim terms/phrases are indefinite because they are inconsistent with and

5   broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

6   constructions of the claims, any person of ordinary skill in the art at the time of the invention

7   would not understand what is claimed, even when the claims are read in light of the specification.

8   Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

9   of the asserted claims in which these claim terms/phrases appear lack written description because

10 the specification of the '760 Patent demonstrates that the patentee neither conceived of nor

11 demonstrated possession of all that Apple now contends the claims cover.

12   Samsung further asserts that claims 8-11, 14, 18-19, 21 are invalid for reciting at least the

13 following claim terms/phrases:

14   • "instructions, which . . . cause the device to: display . . ." / "instructions for . . .
          displaying . . ." / "instructions to display . . ."
15

16   • "instructions, which . . . cause the device to: . . . completely substituting display
          . . ." / "instructions for . . . completely substituting display . . ." / "instructions to . . .
17   completely substituting display . . ."

18   • "instructions, which . . . cause the device to: . . . initiate a return telephone call . . ."
          / "instructions for . . . initiating a telephone call . . ." / "instructions to . . . initiate a
19   telephone call . . ."

20   • "instructions, which . . . cause the device to: . . . initiate a communication . . ." /
          "instructions for . . . initiating a communication . . ." / "instructions to . . . initiate a
21   communication . . ."

22   • "instructions to receive a finger tap input . . ." / "the portable electronic device is
23   configured to: receive a finger tap input . . ." / "instructions, which . . . receive a
          finger tap input . . ."
24

25   • "instructions to detect a finger tap input . . ." / "instructions for . . . detecting . . ." /
          "instructions that . . . cause the device to . . . detect . . ."
26

    Each of these claim limitations is governed by 35 U.S.C. § 112, paragraph 6. The '760 patent
27
    specification, however, fails to set forth the structure, material or acts for accomplishing the
28

1 claimed instructions. Each of these claims is therefore invalid as indefinite under 35 U.S.C. §

2 112(2).

3   In addition, based on Samsung's present understanding of Plaintiff's infringement

4 contentions, each of the asserted claims in which these claim terms/phrases appear are invalid

5 because the specification fails to provide sufficient disclosure to enable any person of ordinary

6 skill in the art to which it pertains, or with which it is most nearly connected, to implement the

7 invention without undue experimentation.

8   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

9 ¶¶ 1 and 2.

10 **VI.   THE '721 PATENT**

11   **A.   Local Patent Rule 3-3(a): Identification of Prior Art**

12   At this time, Samsung contends that at least the following prior art references anticipate or

13 render obvious, either alone or in combination, the asserted claims of the '721 Patent:

14   1.   **Patent References[12]**

Country of Origin	Patent Number	Date of Issue	Priority Date
US	6,421,453	July 16, 2002	May 15, 1998
US	6,545,669	Apr. 8, 2003	Mar. 26, 1999
US	7,084,859	Aug. 1, 2006	Sep. 18, 1992
US	7,113,177	Sep. 26, 2006	Apr. 4, 2002
US	7,216,116	May 8, 2007	May 2, 1997
US	7,365,736	Apr. 29, 2008	Mar. 23, 2004
US	7,425,944	Sep. 16, 2008	July 1, 2005
US	7,546,548	June 9, 2009	June 28, 2002
US	7,653,818	Jan. 26, 2010	July 21, 2005
US	7,800,587	Sep. 21, 2010	Aug. 11, 2005
US	8,117,701	Feb. 21, 2012	July 7, 2006
US	8,127,141	Feb. 28, 2012	Oct. 29, 2002
US	2002/0029341	Mar. 7, 2002	Feb. 10, 2000
US	2002/0104005	Aug. 1, 2002	Jan. 31, 2001
US	2006/0012577	Jan. 19, 2006	July 16, 2004
US	2006/0064004	Mar. 23, 2006	Sep. 15, 2005
US	2006/0075250	Apr. 6, 2006	Sep. 24, 2004
US	2006/0092177	May 4, 2006	Oct. 30, 2004
US	2006/0209014	Sep. 21, 2006	Mar. 16, 2005
US	2007/0135091	June 14, 2007	Dec. 8, 2005

---

[12] Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	8,095,87	Jan. 10, 2012	Dec. 10, 2002
WO	01/77792	Oct. 18, 2001	Apr. 7, 2000
WO	03/038569	May 8, 2003	Oct. 30, 2001
EP	1 964 022	Mar. 10, 2010	Dec. 23, 2005
US	5,293,908	Mar. 15, 1994	Feb. 24, 1993
US	5,465,084	Nov. 7, 1995	Mar. 27, 1990
US	5,559,961	Sep. 24, 1996	Aug. 30, 1995
US	5,677,710	Oct. 14, 1997	May 10, 1993
US	5,821,933	Oct. 13, 1998	Sep. 14, 1995
US	5,907,327	May 25, 1999	Aug. 15, 1997
US	5,923,908	July 13, 1999	Oct. 30, 1997
US	6,151,208	Nov. 21, 2000	June 24, 1998
US	6,160,555	Dec. 12, 2000	Nov. 17, 1997
US	6,192,478	Feb. 20, 2001	Mar. 2,1998
US	6,249,606	June 19, 2001	Feb. 19, 1998
US	6,323,846	Nov. 27, 2001	Jan. 25, 1999
US	6,347,290	Feb. 12, 2002	June 24, 1998
US	6,421,453	July 16, 2002	May 15, 1998
US	6,570,557	May 27, 2003	Feb. 10, 2001
US	6,573,883	June 3, 2003	June 24, 1998
US	6,633,310	Oct. 14, 2003	May 31, 2000
US	6,677,932	Jan. 13, 2004	Jan. 28, 2001
US	6,720,860	Apr. 13, 2004	June 30, 2000
US	6,735,695	May 11, 2004	Dec. 20, 1999
US	7,124,433	Oct. 17, 2006	Dec. 10, 2002
US	7,151,843	Dec. 19, 2006	Jan. 25, 2005
US	7,174,462	Feb. 6, 2007	Nov. 12, 2002
US	7,245,293	July 17, 2007	July 28, 2005
US	7,263,670	Aug. 28, 2007	June 10, 2004
US	7,302,642	Nov. 27, 2007	June 3, 2003
US	8,095,879	Jan. 10,2012	Dec. 10, 2002
US	2001/0011308	Aug. 2, 2001	May 20, 1997
US	2001/0012022	Aug. 9, 2001	Dec. 10, 1998
US	2002/0015024	Feb. 7, 2002	Jan. 25, 1999
US	2002/0191029	Dec. 19, 2002	May 16, 2001
US	2002/0196274	Dec. 26, 2002	June 8, 2001
US	2003/0142138	July 31, 2003	Jan. 28, 2002
US	2004/0030934	Feb. 12, 2004	Oct. 19, 2000
US	2004/0034801	Feb. 19, 2004	Aug. 5, 2003
US	2004/0085351	May 6, 2004	Sep. 19, 2003
US	2004/0088568	May 6, 2004	Sep. 29, 2003
US	2004/0230843	Nov. 18, 2004	July 8, 2004
US	2004/0250138	Dec. 9, 2004	Apr. 18, 2003
US	2004/0260955	Dec. 23, 2004	June 18,2004
US	2004/0268267	Dec. 30, 2004	June 25, 2003
US	2005/0050477	Mar. 3, 2005	July 19, 2000
US	2005/0060554	Mar. 17, 2005	Aug. 30, 2004
US	2005/0079896	Apr. 14, 2005	Oct. 14, 2003
US	2005/0134578	June 23, 2005	July 13, 2001
US	2005/0212760	Sep. 29, 2005	Mar. 23, 2004
US	2005/0216862	Sep. 29, 2005	Mar. 18, 2005

Country of Origin	Patent Number	Date of Issue	Priority Date
US	2005/0248542	Nov. 10, 2005	Apr. 29, 2005
US	2005/0253817	Nov. 17, 2005	June 16,2 003
US	2005/0264833	Dec. 1, 2005	Mar. 7, 2005
US	2005/0289476	Dec. 29, 2005	June 28, 2004
US	2006/0174339	Aug. 3, 2006	Oct. 5, 2005
US	2006/0267955	Nov. 30, 2006	Mar. 6, 2006
US	2008/0034292	Feb. 7, 2008	Aug. 4, 2006
US	2008/0072172	Mar. 20, 2008	Mar. 18, 2005
US	5,923,908	July 13, 1999	Oct. 30, 1997
US	5,943,052	Aug. 24, 1999	Aug. 12, 1997
US	6,298,146	Oct. 2, 2001	June 19, 1997
US	6,313,853	Nov. 6, 2001	Apr. 16, 1998
US	6,351,634	Feb. 26, 2002	June 1, 1999
US	6,639,584	Oct. 28, 2003	July 6, 1999
US	6,985,137	Jan. 10, 2006	Aug. 13, 2001
US	7,031,756	Apr. 18, 2006	Mar. 20, 2000
US	7,453,443	Nov. 18, 2008	June 16, 2003
US	2004/0010722	Jan. 15, 2004	Dec. 23, 2002
US	2005/0134578	June 23, 2005	Nov. 6, 2002
US	2006/0103633	May 18, 2006	Feb. 14, 2005
US	5,821,933	Oct. 13, 1998	Sep. 14, 1995
US	2002/0191029	Dec. 19, 2002	May 16, 2001
US	2002/0104005	Aug. 1, 2002	Jan. 31, 2001
US	2005/0253817	Nov. 17, 2005	June 16, 2003
WO	2004/001560	Dec. 31, 2003	June 19, 2002
WO	2004/111816	Dec. 23, 2004	June 13, 2003

2.   **Publications[13]**

Title	Date of Publication	Author	Publisher
IBM Research Report – A Wristwatch-Computer Based Password-Vault	Mar. 10, 2005	Gabor Blasko	IBM
Passdoodles; a Lightweight Authentication Method	July 27, 2004	Christopher Varenhorst	
Neonode announces WLAN Mobile Phone	Apr. 12, 2005	Luigi Lugmayr	14U News
Neonode N1 sells for $620	Nov. 1, 2004	Luigi Lugmayr	14U News
Neonode N1 Sells now Europe-Wide	Nov. 16, 2004	Luigi Lugmayr	14U News
Neonode N1 Smartphone starts selling	Oct. 29, 2004	Luigi Lugmayr	14U News
Neonode Smartphone goes Skateboardering	Sep. 3, 2004	Luigi Lugmayr	14U News
New Neonode N1m	Apr. 7, 2005	Luigi Lugmayr	14U News
New Ultra-Mobile Smartphone Neonode N1	Dec. 21, 2002	Luigi Lugmayr	14U News

---

[13]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Sharp will manufacture the new Danger HipTop	July 25, 2004	Luigi Lugmayr	14U News
The Neonode Nl Smart Phone is Shipping, kinda	June 25, 2004	Luigi Lugmayr	14U News
Top 10 Future Technology Stories On I4U	Mar. 19, 2003	Luigi Lugmayr	14U News
Neonode launches the N1 in Sweden	Oct. 10, 2004		Neonode
Neonode Newsletter #3	Undated	The Crew	Neonode
Neonode Nl Handset Development Description	Feb. 19, 2003		Neonode
Neonode Existence – N1 Factsheet V1.1	2003		Neonode
RedNeo Forum	Feb. 3, 2005		RedNeo
Neonode launches The N1 In Sweden	Oct. 29, 2004		Neonode
Neonode User Guide	Undated		Neonode
N1 Quick Start Guide V 0.5	Undated		Neonode
NeoNode N1 - Can a unique interface put this compelling smart phone on the map?	Undated	Conrad H. Blickenstorfer	Pen Computing Magazine
RedNeo Forum	Jan. 22, 2005		RedNeo
RedNeo Forum	Sep. 23, 2004		RedNeo
The Lemur Owner's Manual	Aug. 1, 2005		JazzMutant
Lemur Owner's Manual Version 1.2	2005		JazzMutant
Soft Machines: A Philosophy of User-Computer Interface Design	Dec. 1983	Lloyd H. Nakatani and John A. Rohrlich	
Touchscreen Toggle Switches: Push or Slide? Design issues and usability study	Nov. 1990	Catherine Plaisant & Daniel Wallace	University of Maryland
TOUCHSCREEN TOGGLE DESIGN	May 1992	Catherine Plaisant & Daniel Wallace	
Specification of Interface Interaction Objects	Sep. 1993	David A. Carr	University of Maryland
Kenwood - KVT-911DVD Instruction Manual	2000		Kenwood
Kenwood's High-End Triumph	July 22, 2002	Amy Gilroy	TWICE
VAIO pocket for Windows	Undated		Sony
Sony Plans HOD Music Portables In U.S.	May 17, 2004	Joseph Palenchar	TWICE
Apple-Samsung Dutch Decision	Aug. 24, 2011		
Digital Photo Browsing with Souvenirs	2003	Elise van den Hoven & Berry	IOS Press

Title	Date of Publication	Author	Publisher
		Eggen	
IBM - Access/Control Icons (Icon Keys)	Apr. 4, 1995	J. McLean, C. A. Pickover and D. Winarski	IBM
The design and Analysis of Graphical Passwords	Aug. 1999	Ian Jermyn, Alain Mayer, Fabian Monrose, Michael K. Reiter, and Aviel D. Rubin	USENIX
Motion Gestures	2005		Apple
Motion Getting Started Manual	2004		Apple
Contact Area Interaction with Sliding Widgets	Undated	Tomer Moscovich	
Scheduling home control devices: design issues and usability evaluation of four touchscreen interfaces	1992	Catherine Plaisant and Ben Shneiderman	University of Maryland
SMART Board Software Version 8.1.3 Introduces Touch Gestures	Aug. 10, 2004		Smart Technologies
Touch-Sensing Input Devices	1999	Ken Hinckley and Mike Sinclair	
Layered Touch Panel: The Input Device with Two Touch Panel Layers	Apr. 2002		

3.   Systems

All versions of the following prior art systems commercially sold, publicly known or used

before the priority date of the '721 Patent, including documents and source code describing the

same:

- Plaisant

- Gridlock

- Neonode.

Samsung reserves the right to amend these invalidity contentions to assert these references

depending on the claim construction and infringement positions Apple may take as the case

proceeds. Moreover, Samsung reserves the right to use these references in combination with other

1   references to render the claims of the '721 Patent obvious in the event Apple takes the position that

2   certain claim limitations are missing from the references charted in Exhibit F.

3   **B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders
                  Obvious the Asserted Claims**

4

5   Plaintiff asserts claims 1-15 of the '721 Patent against Samsung in this lawsuit. All of

6   those claims are invalid because the '721 Patent fails to meet one or more of the requirements for

7   patentability. The individual bases for invalidity are provided below and in the claim charts

8   attached as Exhibit F. Each of the foregoing listed prior art documents, the underlying work,

9   and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35

10 U.S.C. § 102 and/or 35 U.S.C. § 103.

11   Although Samsung has identified at least one citation per limitation for each reference,

12 each and every disclosure of the same limitation in the same reference is not necessarily identified.

13 Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

14 identified references, even where a reference may contain additional support for a particular claim

15 element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

16 whole and in the context of other publications and literature. Thus, to understand and interpret any

17 specific statement or disclosure within a prior art reference, such persons would rely on other

18 information within the reference, along with other publications and their general scientific

19 knowledge. Samsung may rely upon uncited portions of the prior art references and on other

20 publications and expert testimony to provide context, and as aids to understanding and interpreting

21 the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

22 other disclosed publications, and the testimony of experts to establish that a person of ordinary

23 skill in the art would have been motivated to modify or combine certain of the cited references so

24 as to render the claims obvious.

25   1.   **Anticipation**

26   Some or all of the asserted claims of the '721 Patent are invalid as anticipated under 35

27 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

28 included in Exhibit F, which identify specific examples of where each limitation of the asserted

1   claims is found in the prior art references. As explained above, the cited portions of prior art

2   references identified in the attached claim charts are exemplary only and representative of the

3   content and teaching of the prior art references, and should be understood in the context of the

4   reference as a whole and as they would be understood by a person of ordinary skill in the art.

5   2.   **Obviousness**

6   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

7   above and in Exhibit F, then any purported differences are such that the claimed subject matter as

8   a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

9   view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

10   therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

11   In addition, the references identified above render one or more asserted claims of the '721

12   Patent obvious when the references are read in combination with each other, and/or when read in

13   view of the state of the art and knowledge of those skilled in the art. Each and every reference

14   identified is also relevant to the state of the art at the time of the alleged invention. Any of the

15   references disclosed above may be combined to render obvious (and therefore invalid) each of

16   Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

17   all of the references identified above, including all references in Exhibit F, for purposes of

18   obviousness depending on the Court's claim construction, positions taken by Apple during this

19   litigation, and further investigation and discovery.

20   Moreover, to the extent the foregoing references are found not to anticipate the asserted

21   claims, the foregoing references render the asserted claims obvious either alone or in combination

22   with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

23   herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

24   at the time of the alleged invention of the asserted claims of the '721 Patent to combine the various

25   references cited herein so as to practice the asserted claims of the '721 Patent.

26

27   Motivations to combine the above items of prior art are present in the references

28   themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

the nature of the problems allegedly addressed by the '721 Patent. Combining the references

disclosed in Exhibit F would have been obvious, as the references identify and address the same

technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

amend or supplement these invalidity contentions to identify additional reasons that combining the

references would be obvious to one of ordinary skill in the art.

In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

alone or in combination with other references, including identification of combinations showing

obviousness, are identified in Exhibits F 1-6, which includes exemplary claim charts for the

asserted claims of the '721 Patent showing specifically where in each reference or combinations of

references each asserted claim is found, and an explanation of why the prior art renders the

asserted claim obvious.

In particular, Samsung contends that the asserted claims of the '721 Patent would have

been obvious in view of the prior art references identified above. For example, Exhibit F includes

exemplary claim charts that describe how the asserted claims of the '721 Patent would have been

obvious in view of all references identified in Exhibit F, which, if found not to anticipate the

claims of the '721 Patent, render the claims of the '721 Patent obvious alone.

In addition to the specific combinations of prior art and the specific combinations of

groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

disclosed within the prosecution history of the references cited herein.

The obviousness combinations set forth in these contentions reflect Samsung's present

understanding of the potential scope of the claims that Plaintiff appears to be advocating and

should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

Samsung reserves the right to amend or supplement these contentions regarding

anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

2   not identified what elements or combinations it alleges were not known to one of ordinary skill in

3   the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

4   particular prior art reference, Samsung reserves the right to assert that any such limitation is either

5   inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

6   of the same, or that the limitation is disclosed in another of the references disclosed above and in

7   combination would have rendered the asserted claim obvious.

8   **C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each
                    Alleged item of Prior Art each Asserted Claim is Found**
9

10   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

11   item of prior art each limitation of each asserted claim is found, including for each limitation that

     Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or
12
     material(s) in each item of prior art that performs the claimed function is attached in Exhibits F 1-
13
     6.
14

15   **D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity**

16   Samsung identifies the following grounds for invalidity of the asserted claims of the '721

17   Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

18   supplement these disclosures based on further investigation and discovery.

19   1.   **Invalidity Based on 35 U.S.C. § 101**

20   The asserted claims of the '721 Patent are invalid under 35 U.S.C. § 101 because they only

21   claim abstract ideas. Many limitations in the asserted claims are common abstractions in

22   computer systems and programming languages. For example, "detecting a contact with the touch-

23   sensitive display at a first predefined location corresponding to an unlock image," "continuously

24   moving the unlock image on the touch-sensitive display in accordance with movement of the

25   contact while continuous contact with the touch screen is maintained," "unlocking the hand-held

26   electronic device if the moving the unlock image on the touch-sensitive display results in

27   movement of the unlock image from the first predefined location to a predefined unlock region on

28   the touch-sensitive display," "moving comprises movement along any desired path," "moving

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1 comprises movement along any desired path," "displaying visual cues to communicate a direction

2 of movement of the unlock image required to unlock the device," "an arrow indicating a general

3 direction of movement," each refer only to programming abstractions, the manipulation of

4 information, or abstract ideas regarding user interaction; these are concepts, not physical objects or

5 tangible matter.

6   2.   **Invalidity Based on Enablement or Written Description Under 35**
           U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35

7   **U.S.C. § 112(2)**

8   Samsung asserts that each asserted claim of the '721 Patent is invalid in that the '721

9 specification fails to particularly point out and distinctly claim the alleged invention of the '721

10 Patent. Samsung further asserts that each asserted claim of the '721 Patent is invalid as not

11 containing a written description of the invention, and of the manner and process of making and

12 using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

13 which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

14   Based on Samsung's present understanding of Plaintiff's infringement contentions,

15 Samsung asserts that claim 1-15 of the '721 Patent are invalid under 35 U.S.C. § 112 ¶ 1 at least

16 because they include the following claim terms/phrases:

17   • "A method for unlocking a handheld device,"

18   • "continuously moving the unlock image on the touch-sensitive display in

19   accordance with movement of the contact while continuous contact with the touch

20   screen is maintained, wherein the unlock image is a graphical, interactive user-

21   interface object with which a user interacts in order to unlock the device,"

22

23   • "unlocking the hand-held electronic device if the moving the unlock image on the

24   touch-sensitive display results in movement of the unlock image from the first

25   predefined location to a predefined unlock region on the touch-sensitive display,"

26   • "moving comprises movement along any desired path,"

27   • "moving comprises movement along any desired path,"

28

1

2

- • "displaying visual cues to communicate a direction of movement of the unlock image required to unlock the device,"

3

- • "an arrow indicating a general direction of movement."

4

These claim terms/phrases as apparently construed by Apple violate the written description and/or

5

enablement requirements of 35 U.S.C. § 112 ¶ 1.

6

Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

7

one or more of these claim terms/phrases are indefinite because they are inconsistent with and

8

broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

9

constructions of the claims, any person of ordinary skill in the art at the time of the invention

10

would not understand what is claimed, even when the claims are read in light of the specification.

11

Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

12

of the asserted claims in which these claim terms/phrases appear lack written description because

13

the specification of the '721 Patent demonstrates that the patentee neither conceived of nor

14

demonstrated possession of all that Apple now contends the claims cover. In addition, based on

15

Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted

16

claims in which these claim terms/phrases appear are invalid because the specification fails to

17

provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,

18

or with which it is most nearly connected, to implement the invention without undue

19

experimentation. Therefore, the claims fail to satisfy the requirements of § 112 ¶¶ 1 and 2.

20

Samsung further asserts that claims 11, 7, 8, 9, 10, 12, 14, 15 of the '721 Patent are invalid

21

for reciting at least the following claim limitations:

22

- • "means for displaying an unlock image at a first predefined location on the touch-sensitive display while the device is in a user-interface lock state";

23

24

- • "means for continuously moving the unlock image on the touch-sensitive display in response to detecting the contact in accordance with movement of the contact while continuous contact with the touch screen is maintained, wherein the unlock image

25

26

27

28

Case No. 12-cv-00630-LHK

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

is a graphical, interactive user-interface object with which a user interacts in order

to unlock the device";

- "means for transitioning the device to a user-interface unlock state if the moving

the unlock image on the touch-sensitive display results in movement of the unlock

image from the first predefined location to a predefined unlock region on the touch-

sensitive display";

- "including instructions… to detect a contact with the touch-sensitive display at a

first predefined location corresponding to an unlock image";

- "including instructions…. to continuously move the unlock image on the touch-

sensitive display in accordance with movement of the detected contact while

continuous contact with the touch-sensitive display is maintained, wherein the

unlock image is a graphical, interactive user-interface object with which a user

interacts in order to unlock the device"; and

- "including instructions… to unlock the hand-held electronic device if the unlock

image is moved from the first predefined location on the touch screen to a

predefined unlock region on the touch-sensitive display";

- "A computer readable storage medium storing one or more programs, the one or

more programs comprising instructions…. comprising… detecting… continuously

moving…. and unlocking."

Each of those claim limitations is or may be governed by 35 U.S.C. section 112, paragraph 6. The

'721 patent specification, however, fails to set forth the structure, material or acts for

accomplishing the recited function. Each of these claims is therefore invalid as indefinite under 35

U.S.C. § 112(2).

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1

VII.   **THE '172 PATENT**

2

A.   **Local Patent Rule 3-3(a): Identification of Prior Art**

3

At this time, Samsung contends that at least the following prior art references anticipate or

4

render obvious, either alone or in combination, the asserted claims of the '172 Patent:

5

1.   **Patent References[14]**

6

7

Country of Origin	Patent Number	Date of Issue	Priority Date
US	5,367,453	Nov. 22, 1994	Aug. 2, 1993
US	5,437,036	July 25, 1995	Sep. 3, 1992
US	5,487,616	Jan. 30, 1996	June 1, 1995
US	5,594,640	July 25, 1995	Aug. 2, 1993
US	5,623,406	Apr. 22, 1997	Mar. 6, 1995
US	5,682,439	Oct. 28, 1997	Aug. 7, 1995
US	5,818,437	Oct. 6, 1998	July 26, 1995
US	5,953,541	Sep. 14, 1999	Jan. 24, 1997
US	6,002,390	Dec. 14, 1999	Nov. 21, 1997
US	6,085,206	July 4, 2000	June 20, 1996
US	6,204,848	Mar. 20, 2001	Apr. 14, 1999
US	6,307,548	Oct. 23, 2001	Sep. 25, 1997
US	6,377,965	Apr. 23, 2002	Nov. 7, 1997
US	6,405,060	June 11, 2002	Dec. 19, 1997
US	6,556,841	Apr. 29, 2003	May 3, 1999
US	6,583,798	June 24, 2003	July 21, 2000
US	6,724,370	Apr. 20, 2004	Apr. 12, 2001
US	6,801,190	Oct. 5, 2004	May 27, 1999
US	6,801,659	Oct. 5, 2004	Jan. 4, 1999
US	6,822,585	Nov. 23, 2004	Sep. 15, 2000
US	6,836,759	Dec. 28, 2004	Aug. 22, 2000
US	6,920,452	July 19, 2005	Apr. 26, 2001
US	7,030,863	Apr. 18, 2006	July 16, 2003
US	7,088,345	Aug. 8, 2006	May 27, 1999
US	7,091,885	Aug. 15, 2006	June 2, 2004
US	7,098,896	Aug. 29, 2006	Jan. 16, 2003
US	7,119,794	Oct. 10, 2006	Apr. 30, 2003
US	7,130,798	Oct. 31, 2006	Aug. 22, 2000
US	7,202,853	Apr. 10, 2007	Mar. 4, 2003
US	7,277,088	Oct. 2, 2007	Feb. 4, 2004
US	7,293,231	Nov. 6, 2007	Mar. 18, 1999
US	7,296,019	Nov. 13, 2007	Oct. 23, 2001
US	7,403,888	July 22, 2008	June 28, 2000
US	7,443,316	Oct. 28, 2008	Sep. 1, 2005
US	7,486,277	Feb. 3, 2009	Apr. 30, 2003
US	7,581,180	Aug. 25, 2009	May 10, 2001
US	7,584,093	Sep. 1, 2009	Apr. 25, 2005
US	7,584,426	Sep. 1, 2009	Mar. 31, 2004

27

---

[14]   Samsung incorporates by reference all prior art references cited in the patents listed herein

28

and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	7,599,828	Oct. 6, 2009	Mar. 1, 2005
US	7,636,083	Dec. 22, 2009	Feb. 20, 2004
US	7,698,123	Apr. 13, 2010	Aug. 31, 2004
US	7,716,579	May 11, 2010	May 19, 2005
US	7,725,419	May 25, 2010	Sep. 3, 2003
US	7,880,730	Feb. 1, 2011	Feb. 9, 2004
US	7,886,233	Feb. 8, 2011	May 23, 2005
US	7,920,132	Apr. 5, 2011	May 27, 1999
US	7,996,589	Aug. 9, 2011	Apr. 22, 2005
US	8,036,878	Oct. 11, 2011	May 18, 2005
US	8,136,050	Mar. 13, 2012	Nov. 21, 2003
US	8,185,841	May 22, 2012	May 23, 2005
US	2003/0033288	Feb. 13, 2003	Aug. 13, 2001
US	2004/0021691	Feb. 5, 2004	May 21, 2001
US	2004/0140956	July 22, 2004	Jan. 16, 2003
US	2004/0183833	Sep. 23, 2004	Mar. 19, 2003
US	2005/0188330	Aug. 25, 2005	Feb. 20, 2004
US	2005/0192802	Sep. 1, 2005	Feb. 11, 2004
US	2005/0283358	Dec. 22, 2005	Aug. 26, 2005
US	2006/0063558	Mar. 23, 2006	Sep. 21, 2004
US	2006/0142997	June 29, 2006	Dec. 27, 2002
US	2006/0149551	July 6, 2006	Dec. 22, 2004
US	2006/0167676	July 27, 2006	Jan. 26, 2005
US	2006/0176283	Aug. 10, 2006	Aug. 6, 2004
US	2006/0190447	Aug. 24, 2006	Feb. 22, 2005
US	2006/0206815	Sep. 14, 2006	Mar. 8, 2005
US	2006/0206816	Sep. 14, 2006	Mar. 11, 2005
US	2006/0274051	Dec. 7, 2006	Jan. 12, 2004
US	2006/0269138	Nov. 30, 2006	Aug. 22, 2000
US	2007/0016862	Jan. 18, 2007	July 15, 2005
US	2007/0061753	Mar. 15, 2007	June 30, 2004
US	2007/0074131	Mar. 29, 2007	May 18, 2005
US	2008/0266263	Oct. 30, 2008	Mar. 23, 2006
US	2009/0019395	Jan. 15, 2009	Nov. 22, 2004
US	2011/0010655	Jan. 13, 2011	May 21, 2001
JP	2001-325062	Nov. 22, 2001	May 17, 2000

2. **Publications**[15]

Title	Date of Publication	Author	Publisher
A Minimal Device-Independent Text Input Method	Nov. 10, 1999	Poika Isokoski	University of Tampere
A Stylus-Based User Interface for Text: Entry and Editing	June 1991	Aaron Goodisman	Massachusetts Institute of Technology
Adaptive Forms: An	1998	Martin Frank	Association for

---

[15]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

Title	Date of Publication	Author	Publisher
Interaction Paradigm for Entering Structured Data		and Pedro Szekely	Computing Machinery
An Efficient Text Input Method for Pen-based Computers	Apr. 1998	Toshiyuki Masui	Association for Computing Machinery
Embedded Menus: Selecting Items In Context	Apr. 1986	Larry Koved and Ben Schneiderman	Association for Computing Machinery
Empirically-based Re-design of a Hypertext Encyclopedia	Apr. 1993	Keith Instone, Barbee Mynatt Teasley, and Laura Leventhal	Association for Computing Machinery
FitalyStamp User's Manual	Aug. 12, 2004		TextWare Solutions
FitalyVirtual User's Manual	Jan. 4, 2005		TextWare Solutions
From Letters to Words: Efficient Stroke-based Word Completion for Trackball Text Entry	Oct. 2006	Jacob Wobbrock and Brad Myers	Association for Computing Machinery
Handbook for Palm^{TM} Tungsten^{TM} T Handhelds	2002		Palm
Instant Text Mobile User's Manual	May 13, 2005		TextWare Solutions
Instant Text Mobile Options and Advanced Features	Aug. 16, 2005		TextWare Solutions
Integrating Pen Operations for Composition by Example	1998	Toshiyuki Masui	Association for Computing Machinery
Mobile Text Entry	Nov. 8, 2002	Amal Sirisena	University of Canterbury
Model-based and Empirical Evaluation of Multimodal Interactive Error Correction	1999	Bernhard Suhm, Brad Myers, and Alex Waibel	Association for Computing Machinery
Motorola V3 GSM User Guide	2005		Motorola
Natural Language Interfaces: Specifying and Using Conceptual Constraints	1993	Elisabeth Godbert, Robert Pasero, and Paul Sabatier	Elsevier
POBox: An Efficient Text Input Method for Handheld and Ubiquitous Computers	1999	Toshiyuki Masui	Springer-Verlag
Read This First – Welcome to Instant Text Mobile	Apr. 9, 2005		TextWare Solutions
Read This First – Welcome to FitalyStamp	Aug. 5, 2004		TextWare Solutions
Read This First – Welcome to FitalyVirtual	July 29, 2005		TextWare Solutions
Syntax PAL: A System to Improve the Written Syntax of Language-Impaired Users	1992	Corinne Morris, Alan Newell, Lynda Booth,	Rehabilitation Engineering and Assistive

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
		Ian Ricketts and John Arnott	Technology Society
Text Entry for Mobile Computing: Models and Methods, Theory and Practice	2002	I. Scott MacKenzie and R. William Soukoreff	Lawrence Erlbaum Associates
Text prediction systems: a survey	2006	Nestor Garay-Vitoria and Julio Abascal	Springer-Verlag
Toshiba Pocket PC e570 Instruction Manual	Sep. 2001		Toshiba
TextPlus^{TM} for the Palm OS Version 5.5 Users Guide	Aug. 31, 2004		TextWare Solutions
The Fitaly Keyboard for the Palm Organizer: Reference Manual	Jan. 20, 2000		TextWare Solutions
Treo^{TM} 90 Handheld User Guide	2002		Handspring
WiViK On-screen Keyboard	2003		Prentke Romich Company

3.   **Systems**

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '172 Patent, including documents and source code describing the same:

- eZiTap, eZiText, and eZiType

- Fitaly 3 for the Pocket PC

- FitalyStamp 3

- FitalyVirtual 3

- Interkey Professional

- Instant Text Mobile for the Palm OS5

- LookDA 3.5

- Mac OS X Autocomplete

- Spell Catcher X

- T-Mobile Dash

- TenGO 2.0

- TenGO Palm 1.0

1 • TenGO Thumb 1.04

2 • TextPlus 3.0

3 • TextPlus for the Palm OS Version 5.5

4 • The Fitaly Keyboard for the Palm Organizer 2.0

5 • WiViK 3 On-Screen Keyboard

6 • WordComplete 2.0

7 Samsung reserves the right to amend these invalidity contentions to assert these references

8 depending on the claim construction and infringement positions Apple may take as the case

9 proceeds. Moreover, Samsung reserves the right to use these references in combination with other

10 references to render the claims of the '172 Patent obvious in the event Apple takes the position that

11 certain claim limitations are missing from the references charted in Exhibit G.

12 **B.   Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders
Obvious the Asserted Claims**
13

14 Plaintiff asserts claims 2-6, 9-12, 17-21, 23-25 and 27-37 of the '172 Patent against

15 Samsung in this lawsuit. All of those claims are invalid because the '172 Patent fails to meet one

16 or more of the requirements for patentability. The individual bases for invalidity are provided

17 below and in the claim charts attached as Exhibit G. Each of the foregoing listed prior art

18 documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art

19 under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

20 Although Samsung has identified at least one citation per limitation for each reference,

21 each and every disclosure of the same limitation in the same reference is not necessarily identified.

22 Rather, in an effort to focus the issues, Samsung has generally cited representative portions of

23 identified references, even where a reference may contain additional support for a particular claim

24 element. In addition, persons of ordinary skill in the art generally read a prior art reference as a

25 whole and in the context of other publications and literature. Thus, to understand and interpret any

26 specific statement or disclosure within a prior art reference, such persons would rely on other

27 information within the reference, along with other publications and their general scientific

28 knowledge. Samsung may rely upon uncited portions of the prior art references and on other

1 publications and expert testimony to provide context, and as aids to understanding and interpreting

2 the portions that are cited. Samsung may also rely on uncited portions of the prior art references,

3 other disclosed publications, and the testimony of experts to establish that a person of ordinary

4 skill in the art would have been motivated to modify or combine certain of the cited references so

5 as to render the claims obvious.

1.   **Anticipation**

7   Some or all of the asserted claims of the '172 Patent are invalid as anticipated under 35

8 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts

9 included in Exhibit G, which identify specific examples of where each limitation of the asserted

10 claims is found in the prior art references. As explained above, the cited portions of prior art

11 references identified in the attached claim charts are exemplary only and representative of the

12 content and teaching of the prior art references, and should be understood in the context of the

13 reference as a whole and as they would be understood by a person of ordinary skill in the art.

2.   **Obviousness**

15   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

16 above and in Exhibit G, then any purported differences are such that the claimed subject matter as

17 a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

18 view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

19 therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

20   In addition, the references identified above render one or more asserted claims of the '172

21 Patent obvious when the references are read in combination with each other, and/or when read in

22 view of the state of the art and knowledge of those skilled in the art. Each and every reference

23 identified is also relevant to the state of the art at the time of the alleged invention. Any of the

24 references disclosed above may be combined to render obvious (and therefore invalid) each of

25 Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

26 all of the references identified above, including all references in Exhibit G, for purposes of

27 obviousness depending on the Court's claim construction, positions taken by Apple during this

28 litigation, and further investigation and discovery.

1   Moreover, to the extent the foregoing references are found not to anticipate the asserted

2 claims, the foregoing references render the asserted claims obvious either alone or in combination

3 with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

4 herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

5 at the time of the alleged invention of the asserted claims of the '172 Patent to combine the various

6 references cited herein so as to practice the asserted claims of the '172 Patent.

7

8   Motivations to combine the above items of prior art are present in the references

9 themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

10 the nature of the problems allegedly addressed by the '172 Patent. Combining the references

11 disclosed in Exhibit G would have been obvious, as the references identify and address the same

12 technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

13 amend or supplement these invalidity contentions to identify additional reasons that combining the

14 references would be obvious to one of ordinary skill in the art.

15

16   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

17 alone or in combination with other references, including identification of combinations showing

18 obviousness, are identified in Exhibits G-1 to G-11, which includes exemplary claim charts for the

19 asserted claims of the '172 Patent showing specifically where in each reference or combinations of

20 references each asserted claim is found, and an explanation of why the prior art renders the

21 asserted claim obvious.

22

23   In particular, Samsung contends that the asserted claims of the '172 Patent would have

24 been obvious in view of the prior art references identified above. For example, Exhibit G includes

25 exemplary claim charts that describe how the asserted claims of the '172 Patent would have been

26 obvious in view of all references identified in Exhibit G, which, if found not to anticipate the

27 claims of the '172 Patent, render the claims of the '172 Patent obvious alone.

28

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   In addition to the specific combinations of prior art and the specific combinations of

2 groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

3 prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

4 disclosed within the prosecution history of the references cited herein.

5   The obviousness combinations set forth in these contentions reflect Samsung's present

6 understanding of the potential scope of the claims that Plaintiff appears to be advocating and

7 should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

8   Samsung reserves the right to amend or supplement these contentions regarding

9 anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

10 information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

11 not identified what elements or combinations it alleges were not known to one of ordinary skill in

12 the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

13 particular prior art reference, Samsung reserves the right to assert that any such limitation is either

14 inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

15 of the same, or that the limitation is disclosed in another of the references disclosed above and in

16 combination would have rendered the asserted claim obvious.

17   **C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each**
     Alleged item of Prior Art each Asserted Claim is Found

18

19   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

20 item of prior art each limitation of each asserted claim is found, including for each limitation that

21 Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

22 material(s) in each item of prior art that performs the claimed function is attached in Exhibits G-1

23 to G-11.

24   **D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity**

25   Samsung identifies the following grounds for invalidity of the asserted claims of the '172

26 Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

27 supplement these disclosures based on further investigation and discovery.

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   1.   **Invalidity Based on 35 U.S.C. § 101**

2   The asserted claims of the '172 Patent are invalid under 35 U.S.C. § 101 because they only

3   claim abstract ideas. Many limitations in the asserted claims are common abstractions in

4   computer systems and programming languages. For example, "displaying a current character

5   string", "displaying the current character string or a portion thereof and a suggested replacement

6   character string", "displaying a suggested replacement character string", "displaying an alternative

7   suggested replacement character string", "replacing the current character string", "replacing the

8   current character set", "keeping the current character string", "the current character string in the

9   first area is replaced", "the current character string in the first area is kept", "appending a

10   punctuation mark", "the suggested replacement character string in combination with a punctuation

11   a first punctuation mark", "the suggested replacement character string in combination with a

12   second punctuation mark", "adding at the end of said character set a punctuation mark" each refer

13   only to programming abstractions or the manipulation of information; these are concepts, not

14   physical objects or tangible matter.

15   2.   **Invalidity Based on Enablement or Written Description Under 35**
         U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35
16   **U.S.C. § 112(2)**

17   Samsung asserts that each asserted claim of the '172 Patent is invalid in that the '172

18   specification fails to particularly point out and distinctly claim the alleged invention of the '172

19   Patent. Samsung further asserts that each asserted claim of the '172 Patent is invalid as not

20   containing a written description of the invention, and of the manner and process of making and

21   using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

22   which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

23   Based on Samsung's present understanding of Apple's infringement contentions, Samsung

24   asserts that claims 18, 19, 20, 27, 28, 32, 33 of the '172 Patent are invalid as indefinite because

25   they combine method and apparatus limitations. Samsung further asserts that claims 2-3, 6, 9, 18-

26   21, 23-25 and 27-37 of the '172 Patent are invalid as indefinite for reciting at least the following

27   claim terms/phrases:

28   • "current character string" / "current character set"

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1

- "being input by a user with a keyboard"

2

- "replacing the current character string" / "the current character string in the first area is replaced"

3

4

- "key on the keyboard associated with a delimiter"

5

- "keeping the current character string" / "the current character string in the first area is kept"

6

7

- "performs a first gesture on the suggested replacement character string"

8

- "performs a second gesture in the second area on the current character string or the portion thereof"

9

10

- "soft keyboard" / "virtual keyboard" / "virtual key" / "virtual . . . key"

11

- "performs a predefined gesture on the alternative suggested replacement character string in the second area"

12

- "performs a gesture on the suggested replacement character string"

13

- "performs a gesture in the second area on the current character string or the portion thereof"

14

15

- "user input of a single touch" / "single touch input" / "single touch user selection input"

16

17

- "single user input at a first location / single user input at a second location / single user input at a third location"

18

- "in response to . . . user input" / "in response to the single touch user selection input"

19

20

- "accepting the current character string"

21   These claim terms/phrases as apparently construed by Apple violate the written description,

22   enablement, and/or definiteness requirements of 35 U.S.C. § 112.

23   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

24   one or more of these claim terms/phrases are indefinite because they are inconsistent with and

25   broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

26   constructions of the claims, any person of ordinary skill in the art at the time of the invention

27   would not understand what is claimed, even when the claims are read in light of the specification.

28   Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

1 of the asserted claims in which these claim terms/phrases appear lack written description because

2 the specification of the '172 Patent demonstrates that the patentee neither conceived of nor

3 demonstrated possession of all that Apple now contends the claims cover.

4   Samsung further asserts that claims 2, 19-21, 27-28, 32-33 are invalid for reciting at least

5 the following claim terms/phrases:

- "displaying a current character string . . ."

- "replacing the current character string . . ."

- "keeping the current character string . . ."

- "instructions for displaying . . ." / "instructions, which . . . display . . ." / "instructions, which . . . perform . . . displaying . . ." / "instructions that . . . perform . . . displaying . . ."

- "instructions for replacing" / "instructions, which . . . replace . . ." / "instructions, which . . . perform . . . replacing . . ." / "instructions that . . . perform . . . replacing . . ."

- "instructions for keeping . . ." / "instructions, which . . . keep . . ."

- "instructions that . . . perform . . . appending . . ."

- "instructions that . . . perform . . . accepting . . ."

17 Each of these claims is governed by 35 U.S.C. § 112, paragraph 6. The '172 patent specification,

18 however, fails to set forth the structure, material or acts for accomplishing the claimed steps and

19 instructions. Each of these claims is therefore invalid as indefinite under 35 U.S.C. § 112(2).

20   In addition, based on Samsung's present understanding of Plaintiff's infringement

21 contentions, each of the asserted claims in which these claim terms/phrases appear are invalid

22 because the specification fails to provide sufficient disclosure to enable any person of ordinary

23 skill in the art to which it pertains, or with which it is most nearly connected, to implement the

24 invention without undue experimentation.

25   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

26 ¶¶ 1 and 2.

27

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

VIII.   THE '604 PATENT

A.   Local Patent Rule 3-3(a): Identification of Prior Art

At this time, Samsung contends that at least the following prior art references anticipate or render obvious, either alone or in combination, the asserted claims of the '604 Patent:

1.   Patent References[16]

Country of Origin	Patent Number	Date of Issue	Priority Date
US	3,496,299	Feb. 17, 1970	Nov. 14, 1966
US	4,260,854	Apr. 7, 1981	May 20, 1975
US	5,019,806	May 28, 1991	Apr. 30, 1984
US	5,337,347	Aug. 9, 1994	June 25, 1992
US	5,577,241	Nov. 19, 1996	Dec. 7,1994
US	5,634,053	May 27, 1997	Aug. 29, 1995
US	5,659,732	Aug. 19, 1997	May 17, 1995
US	5,671,426	Sep. 23, 1997	June 22, 1993
US	5,742,816	Apr. 21, 1998	Sep. 15, 1995
US	5,845,278	Dec. 1, 1998	Sep. 12, 1997
US	5,855,015	Dec. 29, 1998	May 12, 1995
US	5,913,205	June 15, 1999	Mar. 28, 1996
US	5,913,215	June 15, 1999	Feb. 19, 1997
US	5,937,406	Aug. 10, 1999	Jan. 31, 1997
US	5,987,446	Nov. 16, 1999	Nov. 12, 1996
US	6,000,020	Dec. 7, 1999	Apr. 1, 1997
US	6,005,565	Dec. 21, 1999	Mar. 25, 1997
US	6,026,429	Feb. 15, 2000	Nov. 10, 1997
US	6,049,796	Apr. 11, 2000	Feb. 24, 1997
US	6,065,003	May 16, 2000	Aug. 19, 1997
US	6,070,158	May 30, 2000	Aug. 14, 1996
US	6,078,914	June 20, 2000	Dec. 9, 1996
US	6,098,065	Aug. 1, 2000	Feb. 13, 1997
US	6,266,094	July 24, 2001	June 14, 1999
US	6,311,182	Oct. 30, 2001	Nov. 17, 1997
US	6,324,534	Nov. 27, 2001	Sep. 10, 1999
US	6,345,269	Feb. 2, 2002	Mar. 26, 1999
US	6,366,915	Apr. 2, 2002	Nov. 4, 1998
US	6,370,543	Apr. 9, 2002	May 24, 1996
US	6,415,285	July 2, 2002	Dec. 8, 1999
US	6,424,968	July 23, 2002	Oct. 15, 1998
US	6,445,834	Sep. 3, 2002	Oct. 19, 1998
US	6,574,632	June 3, 2003	Nov. 18, 1998
US	6,578,048	June 10, 2003	June 5, 1995
US	6,615,172	Sep. 2, 2003	Nov. 12, 1999
US	6,665,640	Dec. 16, 2003	Nov. 12, 1999
US	6,697,835	Feb. 24, 2004	Oct. 28, 1999
US	6,842,758	Jan. 11, 2005	July 30, 1999

---

[16]   Samsung incorporates by reference all prior art references cited in the patents listed herein and/or their file histories.

Country of Origin	Patent Number	Date of Issue	Priority Date
US	6,845,370	Jan. 18, 2005	Nov. 19, 1998
US	6,862,713	Mar. 1, 2005	Aug. 31, 1999
US	6,901,366	May 31, 2005	Aug. 26, 1999
US	7,653,614	Jan. 26, 2010	July 15, 1999
US	7,873,995	Jan. 18, 2011	Sep. 29,2 003
EP	0706139	Published Apr. 10, 1996	Sep. 9, 1994
WO	98/32289	Published July 23, 1998	Jan. 17, 1997

2.   **Publications**[17]

Title	Date of Publication	Author	Publisher
An Information System Based on Distributed Objects	1987	Michael Caplinger	Computing Machinery
An Information System for Corporate Users: Wide Area Information Servers	Sep. 1991	Brewster Kahle and Art Medler	Online
Annotating the World Wide Web using Natural Language	1997	Boris Katz	
ARIADNE: A System for Constructing Mediators for Internet Sources	1998	Jose Luis Ambite, Naveen Ashish, Greg Barish, Craig A. Knoblock, Steven Minton, Pragnesh J. Modi, Ion Muslea, Andrew Philpot and Sheila Tejada	SIGMOD
Browsing Local and Global Information	1995	Masum Hasan, Gene Golovchinsky, Emanuel Noik, Nipon Charoenkitkarn, Mark Chignell, Alberto Mendelzon and David Modjeska	Proceedings of the 1995 conference of the Centre for Advanced Studies on Collaborative Research
Building the infrastructure of	Jan. 1, 1997	Lynch,	Library Trends

---

[17]   Samsung incorporates by reference all prior art references identified in the publications listed herein.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
resource sharing: union catalogs, distributed search, and cross-database linkage		Clifford	
The Computer User as Toolsmith	1993	Saul Greenberg	
CyberDesk: A Framework for Providing Self-Integrating Ubiquitous Software Services	1997	Anind K. Dey, Gregory Abowd, Mike Pinkerton and Andrew Wood	
Dataware Technologies Introduces Dataware II Knowledge Query Server	Sep. 21, 1998		PR Newswire
Discover: A Resource Discovery System based on Content Routing		Mark A. Sheldon, Andrzej Duda, Ron Weiss, David K. Gifford	
The Distributed Information Search Component (Disco) and the World Wide Web	1997	Anthony Tomasic, Remy Amouroux, Philippe Bonnet, Olga Kapitskaia, Hubert Naacke, Louiqa Raschid	SIGMOD
Doctor Linux – 5th Edition	1997	John Purcell, ed.	Linux Systems
The Effectiveness of GlOSS for the Text Database Discovery Problem		Luis Gravano, Hector Garcia-Molina and Anthony Tomasic	
Emacs tutorial	1985		Free Software Foundation
Experience the Internet's most powerful search tool			The WebTools Company
Exploring Computer Science with Scheme	1998		Spinger-Verlag New York, Inc.
FreeWAIS-sf: A Wide Area Information Server for Structured Documents and Retrieval Functionality			
FreeWAIS-sf	Mar. 30, 1995	Ulrich Pfeifer Tung Huynh	University of Dortmund
freeWAIS-sf – UNIDO Edition	Oct. 1995	Ulrich Pfeifer	University of

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
0.5			Dortmund
GNU Emacs Manual – Searching and Replacement	Undated		
GNU Readline Library	1988		Free Software Foundation
Hemlock – An Internet Search Tool for the Newton	1999	Sean Luke	
Hemlock An Internet Search Tool for the Newton	Undated		
Heuristics – Intelligent Search Strategies for Computer Problem Solving	1984	Judea Pearl	Addison-Wesley
How to Create a WAIS Query			
Implementation of the SMART Information Retrieval System	May 1985	Chris Bucley	
Incremental Searching in FoxPro	Oct. 1993		PC Magazine
The Info Agent: An Interface for Supporting Users in Intelligent Retrieval	1995	Daniela D' Aloisi and Vittorio Giannini	
Infoharness: Managing Distributed, Heterogeneous Information	1999	Kshitij Shah and Amit Sheth	IEEE Internet Computing
Information Retrieval Algorithms and Heuristics	1998	David A. Grossman and Ophir Frieder	Kluwer Academic
Information Retrieval (Z39.50): Application Service Definition and Protocol Specification	1995		NISO Press
Information Retrieval on the World Wide Web	1997	Venkat N. Gudivada, Vijay V. Raghavan, William I. Grosky and Rajesh Kasanagottu	IEEE Internet Computing
INQUERY System Overview	Undated	John Broglio, James P. Callan and W. Bruce Croft	
Internet Fish	May 1996	Brian A. LaMacchia	
An Introduction to the EMACS Editor	Jan. 1978	Eugene Ciccarelli	MIT
An Introduction to Multisensor Data Fusion	1997	David L. Hall and James Llinas	IEEE
Macworld Mac OS 8.5 Bible	1999	Lon Poole	IDG Books Worldwide
Mac OS 8.5 – Black Book	1999	Mark R. Bell	The Coriolis

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
		and Debrah D. Suggs	Group,
Mac OS 8.5: GO FOR IT! Part I	Oct. 29 1998	Michael Lambert	The Mac Observer
Mac OS 8.5: GO FOR IT! Part II	Oct. 29 1998	Michael Lambert	The Mac Observer
Mac OS 8.5 Special Report	1998		MacInTouch
MAC OS 9: The Missing Manual – Finding Files and Web Sites with Sherlock 2			
MacWAIS Software Version 1.28	Feb. 23, 1994		EINet
The MetaCrawler Architecture for Resource Aggregation on the Web	Nov. 8, 1996	Erik Selberg and Oren Etzioni	
Microsoft Universal Data Access Platform	1998	Jose A. Blakeley, Michael J. Pizzo	SIGMOD
Microsoft Windows 98 Companion	1998	Martin Matthews	Microsoft Press
Modern Heuristic Search Methods	1996	V.J. Rayward-Smith, I.H. Osman, C.R. Reeves and G.D. Smith	John Wiley and Sons
Multiobjective Heuristic Search	1999	Pallab Dasgupta, P.P. Chakrabarti and S.C. Desarkar	Vieweg
NetHopper Version 3.0 – User's Manual	1997		AllPen
Newton Apple MessagePad Handbook	1995		Apple
Newton Solutions Guide			Apple
Newton Programmer's Guide	1996		Addison-Wesley
Northern Light: New Search Engine for the Web and Full-Text Articles	Feb. 1998	Greg Notess	Online
Overview of Wide Area Information Servers	Apr. 1991	Brewster Kahle	
Pen Pals	Oct. 12, 1993	Christopher Barr and Michael Neubarth	PC Magazine
Peter Rand's Review of Hemlock	1999	Peter Rand	
Rama: An Architecture for	May 1, 1991	Jim Binkley	Kluwer

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
Internet Information Filtering		and Leslie Young	
Search Algorithms Under Different Kinds of Heuristics – A Comparative Study	1983	A. Bagchi and A. Mahanti	Indian Institute of Management Calcutta
Sigerson, A Sherlock Power Booster	Dec. 2, 1998	James Sentman	the Mac Observer
Sherlock Holmes am Newton	Dec. 1999		
Softscape's QuickFind Search and Retrieval Software	Nov. 1997	Robert J. Boeri	EMedia Professional
Software Quality Engineering – A Total Technical and Management Approach	1988	Michael S. Deutsch and Ronald R. Willis	Prentice-Hall
Special Edition – Using Visual C++6	1998	Kate Gregory	Que
Surviving the Storm: Using Metasearch Engines Effectively	May 1999	Randal D. Carlson and Judi Repman	Computers in Libraries
Toward more comprehensive Web searching: single searching versus megasearching	1998	Greg R. Notess	Online
Unix for the Impatient	1996	Paul W. Abrahams and Bruce A. Larson	Addison-Wesley
User's Guide to the Macintosh version of the WAIS interface	1991		Thinking Machines
WAIS, A Sketch Of An Overview	Sep. 23, 1991	Jeff Kellem	
WAIS Search Help			
What is freeWAIS-sf?			
Wide Area Information Servers (WAIS)	June 1994	M. St. Pierre, J. Fullton, K. Gamiel, J. Goldman, B. Kahle, J. Kunze, H. Morris and F. Schiettecatte	
Windows 98 Annoyances	Oct. 1998	David A. Karp	O'Reilly
Windows 98 for Dummies	1999	Andy Rathbone	Wiley
WordPerfect for Windows V 5.2	1992		WordPerfect
Xerox Delivers Global Competitive Advantage to Manufacturing Customers Through Solutions Portfolio	Apr. 27, 1999		Business Wire
Xerox Introduces Two Products	Nov. 9, 1999		Business Wire

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

Title	Date of Publication	Author	Publisher
to Expand Knowledge Sharing Software Portfolio			
Xerox unveils "askOnce", which brings a new search dimension to end-users by giving universal access to multiple information sources through one simple query	1999		Xerox
The Z39.50 Information Retrieval Standard – Part I: A Strategic View of Its Past, Present and Future	Apr. 1997	Clifford A. Lynch	D-Lib Magazine

3.   **Systems**

All versions of the following prior art systems commercially sold, publicly known or used before the priority date of the '604 Patent, including documents and source code describing the same:

- Emacs

- GNU

- Hemlock

- Linux

- Mac OS 8.5

- Newton 2.0

- NetHopper

- Sherlock Utility

- WAIS protocol and WAIStation client

- Windows 98

Samsung reserves the right to amend these invalidity contentions to assert these references depending on the claim construction and infringement positions Apple may take as the case proceeds. Moreover, Samsung reserves the right to use these references in combination with other references to render the claims of the '604 Patent obvious in the event Apple takes the position that certain claim limitations are missing from the references charted in Exhibit H.

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

B. **Local Patent Rule 3-3(b): Whether Each Item Anticipates or Renders Obvious the Asserted Claims**

Plaintiff asserts claims 1, 6, 11 and 16-21 of the '604 Patent against Samsung in this lawsuit. All of those claims are invalid because the '604 Patent fails to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the claim charts attached as Exhibit H-1 through H-9. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Samsung has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Samsung has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Samsung may rely upon uncited portions of the prior art references and on other publications and expert testimony to provide context, and as aids to understanding and interpreting the portions that are cited. Samsung may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. **Anticipation**

Some or all of the asserted claims of the '604 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of each of the prior art references identified above and in the claim charts included in Exhibit H, which identify specific examples of where each limitation of the asserted claims is found in the prior art references. As explained above, the cited portions of prior art references identified in the attached claim charts are exemplary only and representative of the

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   content and teaching of the prior art references, and should be understood in the context of the

2   reference as a whole and as they would be understood by a person of ordinary skill in the art.

3   2.   **Obviousness**

4   To the extent any limitation is deemed not to be exactly met by an item of prior art listed

5   above and in Exhibit H, then any purported differences are such that the claimed subject matter as

6   a whole would have been obvious to one skilled in the art at the time of the alleged invention, in

7   view of the state of the art and knowledge of those skilled in the art. The item of prior art would,

8   therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103(a).

9   In addition, the references identified above render one or more asserted claims of the '604

10   Patent obvious when the references are read in combination with each other, and/or when read in

11   view of the state of the art and knowledge of those skilled in the art. Each and every reference

12   identified is also relevant to the state of the art at the time of the alleged invention. Any of the

13   references disclosed above may be combined to render obvious (and therefore invalid) each of

14   Plaintiff's asserted claims. Samsung may rely upon a subset of the above identified references or

15   all of the references identified above, including all references in Exhibit H, for purposes of

16   obviousness depending on the Court's claim construction, positions taken by Apple during this

17   litigation, and further investigation and discovery.

18   Moreover, to the extent the foregoing references are found not to anticipate the asserted

19   claims, the foregoing references render the asserted claims obvious either alone or in combination

20   with one or more of the other references identified above pursuant to P.R. 3-3(a). As explained

21   herein and/or in the accompanying charts, it would have been obvious to a person of skill in the art

22   at the time of the alleged invention of the asserted claims of the '604 Patent to combine the various

23   references cited herein so as to practice the asserted claims of the '604 Patent.

24

25   Motivations to combine the above items of prior art are present in the references

26   themselves, the common knowledge of one of ordinary skill in the art, the prior art as a whole, or

27   the nature of the problems allegedly addressed by the '604 Patent. Combining the references

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   disclosed in Exhibit G would have been obvious, as the references identify and address the same

2   technical issues and suggest very similar solutions to those issues. Samsung reserves the right to

3   amend or supplement these invalidity contentions to identify additional reasons that combining the

4   references would be obvious to one of ordinary skill in the art.

5   In accordance with P.R. 3-3(b), prior art references rendering the asserted claims obvious,

6   alone or in combination with other references, including identification of combinations showing

7   obviousness, are identified in Exhibits H-1 through H-9, which includes exemplary claim charts

8   for the asserted claims of the '604 Patent showing specifically where in each reference or

9   combinations of references each asserted claim is found, and an explanation of why the prior art

10   renders the asserted claim obvious.

11   In particular, Samsung contends that the asserted claims of the '604 Patent would have

12   been obvious in view of the prior art references identified above. For example, Exhibit H includes

13   exemplary claim charts that describe how the asserted claims of the '604 Patent would have been

14

15   obvious in view of all references identified in Exhibit H, which, if found not to anticipate the

16   claims of the '604 Patent, render the claims of the '604 Patent obvious alone.

17   In addition to the specific combinations of prior art and the specific combinations of

18   groups of prior art disclosed, Samsung reserves the right to rely on any other combination of any

19   prior art references disclosed herein. Samsung further reserves the right to rely upon combinations

20   disclosed within the prosecution history of the references cited herein.

21   The obviousness combinations set forth in these contentions reflect Samsung's present

22   understanding of the potential scope of the claims that Plaintiff appears to be advocating and

23   should not be seen as Samsung's acquiescence to Plaintiff's interpretation of the patent claims.

24   Samsung also reserves the right to amend or supplement these contentions regarding

25   anticipation or obviousness of the asserted claims, in view of further information from Plaintiff,

26   information discovered during discovery, or a claim construction ruling by the Court. Plaintiff has

27

28

1   not identified what elements or combinations it alleges were not known to one of ordinary skill in

2   the art at the time. Therefore, for any claim limitation that Plaintiff alleges is not disclosed in a

3   particular prior art reference, Samsung reserves the right to assert that any such limitation is either

4   inherent in the disclosed reference or obvious to one of ordinary skill in the art at the time in light

5   of the same, or that the limitation is disclosed in another of the references disclosed above and in

6   combination would have rendered the asserted claim obvious.

7   **C.   Local Patent Rule 3-3(c): Charts Identifying where Specifically in each
        Alleged item of Prior Art each Asserted Claim is Found**

8

9   Pursuant to Local Patent Rule 3-3(c), charts identifying where specifically in each alleged

10 item of prior art each limitation of each asserted claim is found, including for each limitation that

11 Samsung contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or

12 material(s) in each item of prior art that performs the claimed function are attached in Exhibits H-1

13 through H-9.

14 **D.   Local Patent Rule 3-3(d): Other Grounds for Invalidity**

15 Samsung identifies the following grounds for invalidity of the asserted claims of the '604

16 Patent based on 35 U.S.C. §§ 101 and/or 112 ¶¶ 1 and 2. Samsung reserves the right to

17 supplement these disclosures based on further investigation and discovery.

18 **1.   Invalidity Based on 35 U.S.C. § 101**

19 The asserted claims of the '604 Patent are invalid under 35 U.S.C. § 101 because they

20 claim only abstract ideas. For example, "providing said information received from the user-input

21 device to a plurality of heuristic modules," and "determining at least one candidate item of

22 information," "searching by the heuristic modules," and "providing at least one candidate item of

23 information" each refer only to programming abstractions or the manipulation of information;

24 these are concepts, not physical objects or tangible matter.

25 **2.   Invalidity Based on Enablement or Written Description Under 35
        U.S.C. § 112(1) and/or Invalidity Based on Indefiniteness Under 35
        U.S.C. § 112(2)**

26

27 Samsung asserts that each asserted claim of the '604 Patent is invalid in that the '604

28 specification fails to particularly point out and distinctly claim the alleged invention of the '604

1 Patent. Samsung further asserts that each asserted claim of the '604 Patent is invalid as not

2 containing a written description of the invention and of the manner and process of making and

3 using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to

4 which it pertains, or with which it is most nearly connected, to make and use the alleged invention.

5   Based on Samsung's present understanding of Plaintiff's infringement contentions,

6 Samsung asserts that claims 1, 6, 11 and 16-21 of the '604 Patent are invalid for reciting at least

7 the claim terms "heuristic," "heuristic module," "heuristic algorithm" "respective area of search,"

8 and/or "configured to search." Claims 16, 18 and 20 of the '604 patent are invalid for reciting at

9 least the claim term "particularized to its associated relevant area of search." Claims 17, 19 and 21

10 of the '604 patent are invalid for reciting at least "receiving portions of the information descriptor

11 as the portions are being inputted," "providing the portions of the information descriptor to the

12 plurality of heuristic modules as the portions are being received," and "received portion of the

13 information descriptor." These claim terms/phrases as apparently construed by Apple violate the

14 written description, enablement and/or definiteness requirements of 35 U.S.C. § 112.

15   Based on Samsung's present understanding of Plaintiff's infringement contentions, at least

16 one or more of these claim terms/phrases are indefinite because they are inconsistent with and

17 broader than the alleged invention disclosed in the specification and given Plaintiff's apparent

18 constructions of the claims, any person of ordinary skill in the art at the time of the invention

19 would not understand what is claimed, even when the claims are read in light of the specification.

20 Moreover, based on Samsung's present understanding of Plaintiff's infringement contentions, each

21 of the asserted claims in which these claim terms/phrases appear lack written description because

22 the specification of the '604 Patent demonstrates that the patentee neither conceived of nor

23 demonstrated possession of all that Plaintiff now contends the claims cover. In addition, based on

24 Samsung's present understanding of Plaintiff's infringement contentions, each of the asserted

25 claims in which these claim terms/phrases appear are invalid because the specification fails to

26 provide sufficient disclosure to enable any person of ordinary skill in the art to which it pertains,

27 or with which it is most nearly connected, to implement the invention without undue

28 experimentation.   The '604 patent specification fails to describe the manner and process of

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1   making and using the claimed invention in such full, clear concise and exact terms as to enable a

2   person of ordinary skill in the art to which it pertains to make and use the claimed invention.

3   For at least the reasons set forth above, the claims fail to satisfy the requirements of § 112

4   ¶¶ 1 and 2.

5   ## PATENT LOCAL RULE 3-4 DISCLOSURES

6   Pursuant to Patent Rule 3-4(a), Defendants will produce, make available for inspection, or

7   identify publicly available information sufficient to show the operation of any specifically

8   identified aspects or elements of an Accused Instrumentality identified by Plaintiff in its Patent

9   L.R. 3-1(c) chart to the extent such information is in Defendants' possession, custody or control.

10 If such information comprises source code, Defendants will make such source code available for

11 inspection pursuant to the protective order in this action. Documents produced pursuant to Patent

12 Local Rule 3-4(a) include the following: SAMNDCA630-00920054 - SAMNDCA630-00926298.

13   Pursuant to Patent Rule 3-4(b), Defendants are producing or making available for

14 inspection copies of each item of prior art identified pursuant to Patent Rule 3-3(a) which does not

15 appear in the file history of the Asserted Patent to the extent such prior art is in Samsung's

16 possession, custody or control. Documents produced pursuant to Patent Local Rule 3-4(a) include

17 the following: SAMNDCA630-00000616 - SAMNDCA630-00003856; SAMNDCA630-

18 00093416 - SAMNDCA630-00095124; SAMNDCA630-00805769 - SAMNDCA630-00809748;

19 SAMNDCA630-00817832 - SAMNDCA630-00826455; and SAMNDCA630-00926299 -

20 SAMNDCA630-00946068. In addition, devices, systems and /or software are available for

21 inspection upon reasonable notice.

22   Defendants reserve the right to identify and produce additional documents pursuant to the

23 Patent Rules and the orders of the Court.

24

25

26

27

28

Case No. 12-cv-00630-LHK
SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

1 DATED: August 10, 2012   QUINN EMANUEL URQUHART & SULLIVAN LLP

2

3   By /s/ Patrick M. Shields
                                            Patrick M. Shields
4   Attorneys for Defendants
                                            SAMSUNG ELECTRONICS CO., LTD.,
5   SAMSUNG ELECTRONICS AMERICA, INC. and
                                            SAMSUNG TELECOMMUNICATIONS
6   AMERICA, LLC

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES

QUINN EMANUEL URQUHART & SULLIVAN, LLP Charles K. Verhoeven (Bar No. 170151) charlesverhoeven@quinnemanuel.com Kevin A. Smith (Bar No. 250814) kevinsmith@quinnemanuel.com 50 California Street, 22nd Floor San Francisco, California 94111 Telephone: (415) 875-6600 Facsimile: (415) 875-6700	STEPTOE & JOHNSON, LLP John Caracappa (*pro hac vice*) jcaracappa@steptoe.com 1330 Connecticut Avenue, NW Washington, D.C. 20036 Telephone: (202) 429-6267 Facsimile: (202) 429-3902

Kevin P.B. Johnson (Bar No. 177129 (CA); 2542082 (NY))
kevinjohnson@quinnemanuel.com
Victoria F. Maroulis (Bar No. 202603)
victoriamaroulis@quinnemanuel.com
555 Twin Dolphin Drive, 5th Floor
Redwood Shores, California 94065
Telephone: (650) 801-5000
Facsimile: (650) 801-5100

William C. Price (Bar No. 108542)
williamprice@quinnemanuel.com
Patrick M. Shields (Bar No. 204739)
patrickshields@quinnemanuel.com
865 South Figueroa Street, 10th Floor
Los Angeles, California 90017-2543
Telephone: (213) 443-3000
Facsimile: (213) 443-3100

Attorneys for SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC. and SAMSUNG TELECOMMUNICATIONS AMERICA, LLC

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

APPLE INC., a California corporation,
 	
                    Plaintiff,
 	
          vs.
 	
SAMSUNG ELECTRONICS CO., LTD., a Korean corporation; SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation; SAMSUNG TELECOMMUNICATIONS AMERICA, LLC, a Delaware limited liability company,
 	
                    Defendants.
	CASE NO. 12-CV-00630-LHK
	
	CERTIFICATE OF SERVICE

02198.51981/4903820.1

1

CERTIFICATE OF SERVICE

2   I am employed in the County of Los Angeles, State of California.   I am over the age of eighteen years and not a party to the within action; my business address is 865 South Figueroa

3   Street, 10th Floor, Los Angeles, California 90017.

4   On August 10, 2012, I served true copies of the following document(s), described as:

5   **SAMSUNG'S PATENT LOCAL RULE 3-3 AND 3-4 DISCLOSURES**

6   on the interested parties in this action addressed as follows:

ATTORNEYS FOR APPLE INC.	**ATTORNEYS FOR APPLE INC**.
HAROLD J. MCELHINNY hmcelhinny@mofo.com MICHAEL A. JACOBS mjacobs@mofo.com RICHARD S. J. HUNG rhung@mofo.com MORRISON & FOERSTER LLP 425 Market Street San Francisco, CA 94105-2482 Telephone (415) 268-7000 Facsimile (415) 268-7522	JOSH A. KREVITT jkrevitt@gibsondunn.com H. MARK LYON mlyon@gibsondunn.com MARK REITER mreiter@gibsondunn.com GIBSON, DUNN & CRUTCHER LLP 1881 Page Mill Road Palo Alto, CA 94302-1211 Telephone: (650) 849-5300 Facsimile: (650) 849-5333 Apple/Samsung@gibsondunn.com
ATTORNEYS FOR APPLE INC. MARK D. SELWYN mark.selwyn@wilmerhale.com WILMER CUTLER PICKERING HALE AND DORR LLP 950 Page Mill Road Palo Alto, CA 94304 Telephone: (650) 858-6000 Facsimile: (650) 858-6100	

7
8
9
10
11
12
13
14
15
16
17
18
19
20

21   **BY ELECTRONIC MAIL TRANSMISSION** from scottflorance@quinnemanuel.com, by transmitting PDF format copies of such documents to each such person identified above, at the e-mail address listed in their address(es). The documents were transmitted by electronic

22   transmission and such transmission was reported as complete and without error.

23   I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

24   Executed on August 10, 2012, at Los Angeles, California.

25

26   */s/ Scott Florance*

27

28