

**PUBLIC VERSION**

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN PORTABLE ELECTRONIC  
DEVICES AND RELATED SOFTWARE**

**Inv. No. 337-TA-797**

**ORDER NO. 47: GRANTING RESPONDENTS' MOTION FOR LEAVE TO FILE AN  
AMENDED NOTICE OF PRIOR ART**

(April 3, 2012)

On February 8, 2012, pursuant to Commission Rule 210.15 and Ground Rules 2 and 4, Respondents HTC Corporation, HTC America, Inc., and Exedea, Inc. (collectively, "HTC") moved for leave to file an Amended Notice of Prior Art. (Motion Docket No. 797-029.) Specifically, HTC seeks to remove hundreds of reference from its original Notice of Prior Art and also seeks to supplement its Notice to add references to two prior art systems: the Cirque Corporation ("Cirque") GlidePoint touchpad system and the Apple AppKit system. (Mot. at 1.)

HTC says that Complainant Apple Inc. ("Apple") objected to the number of references in the original Notice of Prior art and after meeting and conferring, HTC provided Apple with an Amended Notice on November 7, 2011 that removed over two thirds of the references from the original Notice. (Mot. Mem. at 4.) HTC argues that the Administrative Law Judge should grant HTC leave to narrow the scope of its original Notice by filing the Amended Notice because the Amended Notice was submitted in an effort to resolve Apple's objections, the references included in the Amended Notice are those that HTC believes are necessary for its invalidity defense, and HTC has limited its invalidity contentions to the references contained in the Amended Notice. (*Id.*)

Regarding HTC's request to supplement its Notice of Prior Art with Cirque's GlidePoint,

## PUBLIC VERSION

HTC says that it identified Cirque patents and touchpad systems related to the technology in asserted U.S. Patent No. 7,920,129 (“the ‘129 patent”) early in the Investigation and included in its original Notice of Prior Art “a placeholder directed to ‘Cirque Touch Panel Systems,’ including design files, engineering drawings, hardware, and software related thereto.” (*Id.* at 5.) HTC asserts that it served a subpoena on Cirque on October 18, 2011 and diligently pursued discovery from Cirque regarding this technology. (*Id.* at 5-8.) HTC also asserts that it could not have discovered the confidential design specifications for the systems it now seeks to add to its Notice of Prior Art without the additional discovery provided by Cirque because the design files were not publicly available information. (*Id.* at 8.) HTC also argues that not only has Apple been on notice of HTC’s intent to rely on Cirque technology since its original Notice was filed, but Apple also knew about the GlidePoint prior art before this Investigation and Apple should have provided information concerning GlidePoint in response to HTC’s early discovery requests. (*Id.* at 8-9.)

Regarding HTC’s request to add information related to Apple AppKit, HTC says that AppKit renders at least asserted claim 15 of U.S. Patent No. 7,844,915 (“the ‘915 patent”) invalid and Apple failed to timely produce information regarding AppKit that prevented HTC from identifying it as a prior art reference earlier in the Investigation. (*Id.* at 10.) HTC says that it first learned of the relevance of AppKit during the deposition of {

} . (*Id.* at 10-11.) HTC asserts that {

}, Apple should have produced information regarding AppKit in response to HTC’s discovery requests regarding prior art in Apple’s possession. (*Id.* at 11-12.) HTC argues that because it just learned about the relevancy of AppKit during the { }, HTC should be granted leave to supplement the Notice of Prior Art to include the AppKit system. (*Id.* at 12.)

## PUBLIC VERSION

On February 22, 2012, Apple opposed the motion. Apple asserts that HTC's significant delay in seeking to add two prior art systems and related evidence precludes a finding of good cause. (Opp. at 2.) Apple also asserts that HTC failed to conduct reasonable searches for these references in a timely manner even though HTC was aware of the reference before filing its original Notice. (*Id.*) With respect to HTC's request to add the Cirque GlidePoint system, Apple argues that HTC delayed in seeking discovery from Cirque until one week before its original Notice was due, which ensured that HTC would not receive relevant information before the Notice was due. (*Id.*) Apple says that HTC also failed to diligently enforce the subpoena on Cirque, which caused further delay resulting in the production of the alleged prior art references long after HTC served its invalidity contentions. (*Id.*) Regarding the AppKit reference, Apple asserts that HTC was aware of AppKit and its potential relevance long before it conducted its deposition of { }, as shown by references to AppKit in HTC's document production on October 19, 2011. (*Id.*) Apple asserts that HTC's document production identifies AppKit such that HTC could have and should have included AppKit in the original Notice of Prior Art. (*Id.*) Apple also asserts that AppKit was publicly available and could have been identified, evaluated, and included in HTC's original Notice. (*Id.* at 5.)

On March 9, 2012, HTC filed a motion for leave (Motion Docket No. 797-046) to file a reply to its motion to file an Amended Notice of Prior Art, which is hereby DENIED.

No other responses to the motion were received.

Based on a review of the motion papers and responses thereto, the Administrative Law Judge finds as follows.

The Administrative Law Judge's Ground Rules require a party to file a notice of prior art on or before the date set forth in the procedural schedule. (Ground Rule 4.) "Prior art, as well as

**PUBLIC VERSION**

related evidence, that is not disclosed in the Notice of Prior Art on or before the date set forth in the procedural schedule will not be admitted at the hearing absent a timely written motion showing good cause.” (*Id.*) Thus, HTC must demonstrate good cause for its proposed amendments to its Notice of Prior Art.

Regarding HTC’s request to reduce the number of references in its Notice of Prior Art, the Administrative Law Judge notes that Apple does not appear to address this request in its response to the motion. Because does not appear to oppose the Amended Notice, the Administrative Law Judge finds that this portion of HTC’s motion should be GRANTED. However, it should also be noted that the Administrative Law Judge looks unfavorably on the practice of submitting a Notice of Prior Art with hundreds or thousands of references that fails to give fair notice to the other parties in an Investigation. *See Certain Wireless Communications System Server Software, Wireless Handheld Devices and Battery Packs*, Inv. No. 337-TA-706, Order No. 10 (U.S.I.T.C. June 10, 2010).

Regarding HTC’s request to supplement its Notice with additional information regarding the Cirque GlidePoint system, the Administrative Law Judge finds that HTC has demonstrated good cause with respect to this addition. The purpose of the prior art notice is to ensure that the complainant has adequate notice of asserted prior art such that it is able to conduct appropriate discovery. In its original Notice, HTC listed “Cirque Touch Panel Systems” as a reference and indicated that the information regarding these systems was likely to be included in Cirque’s response to a subpoena dated October 17, 2011. (Mot. Mem., Ex. 1 at 107.) HTC also listed Cirque as a person who may have knowledge regarding prior art to certain asserted patents. (*Id.*, Ex. 1 at 139.) Further, with respect to the subpoena served on Cirque, the Administrative Law Judge finds that HTC diligently pursued Cirque’s response to the subpoena and promptly kept



**PUBLIC VERSION**

finds that this portion of HTC's motion should be GRANTED.

Based on the foregoing, the Administrative Law Judge finds that HTC's motion to amend its Notice of Prior Art (Motion Docket No. 797-029) should be GRANTED.

Within seven days of the date of this document, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions may be made by facsimile and/or hard copy by the aforementioned date.

Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets clearly indicating any portion asserted to contain confidential business information. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

**SO ORDERED.**

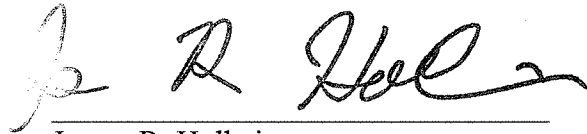


---

E. James Gildea  
Administrative Law Judge

**PUBLIC CERTIFICATE OF SERVICE**

I, James R. Holbein, hereby certify that the attached **ORDER** has been served by hand upon the Commission Investigative Attorney, **Lisa M. Kattan, Esq.**, and the following parties as indicated on April 19, 2012.



James R. Holbein  
Secretary to the Commission  
U.S. International Trade Commission  
500 E Street, SW, Room 112A  
Washington, D.C. 20436

**ON BEHALF OF COMPLAINANT APPLE INC., F/K/A APPLE COMPUTER, INC.:**

Mark D. Fowler, Esq.  
**DLA PIPER LLP**  
2000 University Avenue  
East Palo Alto, CA 94303  
P: 650-833-2000

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: \_\_\_\_\_

**ON BEHALF OF RESPONDENTS HTC CORPORATION, HTC AMERICA, INC., AND  
EXEDEA, INC.:**

Amy H. Candido, Esq.  
**QUINN EMANUEL URQUHART  
& SULLIVAN, LLP**  
50 California St., 22<sup>nd</sup> Floor  
San Francisco, CA 94111  
P: 415-875-6600

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other:

**CERTAIN PORTABLE ELECTRONIC  
DEVICES AND RELATED SOFTWARE**

**337-TA-797**

**PUBLIC MAILING LIST**

Heather Hall  
**LEXIS - NEXIS**  
9443 Springboro Pike  
Miamisburg, OH 45342

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: \_\_\_\_\_

Kenneth Clair  
**THOMSON WEST**  
1100 13th Street, NW, Suite 200  
Washington, DC 20005

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: \_\_\_\_\_