

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN ELECTRONIC DEVICES,
INCLUDING HANDHELD WIRELESS
COMMUNICATIONS DEVICES**

**Inv. Nos. 337-TA-673
337-TA-667**

2009 JUL 22 PM 1:19

OFFICE OF THE
SECRETARY
U.S. INTERNATIONAL TRADE COMMISSION

**ORDER NO. 24C: GRANTING-IN-PART & DENYING-IN-PART SAMSUNG
RESPONDENTS' MOTION FOR LEAVE TO SUBMIT A
SUPPLEMENTAL NOTICE OF PRIOR ART**

(July 22, 2009)

On July 9, 2009, respondents Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLP (collectively "Samsung") moved for leave to file a supplemental notice of prior art. (Motion Docket No. 673-016.) Specifically, Samsung seeks to add eight prior art references related to U.S. Patent No. 5,530,597 ("the '597 patent") and two prior art reference related to U.S. Patent No. 5,608,873 ("the '873 patent"). On July 16, 2009, the Commission Investigative Staff ("Staff") filed a response supporting the motion in part. Complainant Saxon Innovations, LLC ("Saxon") did not file a response.

Ground Rule 5 addresses the notice of prior art. It requires that a party demonstrate good cause to supplement its notice of prior art after the deadline:

Parties must file on or before the date set in the procedural schedule, notices of any prior art consisting of the following information: country, number, date, and name of the patentee of any patent; the title, date and page numbers of any publication to be relied upon as anticipation of the patent in suit; or as showing the state of the art, and the name and address of any person who may be relied

upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit.

If a trademark is involved, the parties must file, on or before the date set in the procedural schedule, notices of any art on which a party will rely at the hearing regarding the functionality or non-functionality of any trademarks at issue.

In the absence of such notice, proof of said matters may not be introduced into evidence at the trial except upon a timely written motion showing good cause.

The procedural schedule set June 26, 2009 as the deadline to file a notice of prior art.

Samsung states that it timely served a notice of prior art on June 26 that identified approximately 270 prior art references. (Mem. at 5.) Samsung explains that on June 10, 2009, Saxon served its responses to Samsung's contention interrogatories. (*Id.*) These responses included Saxon's infringement contentions. Saxon then supplemented its infringement contentions on June 17, 2009 and June 23, 2009. (*Id.*)

Samsung alleges that there is good cause to allow the supplemental notice of prior art. Samsung claims that in light of Saxon's new infringement theories – disclosed for the first time in the contention interrogatory responses – Samsung has discovered ten new pieces of prior art. (*Id.* at 6.) Samsung asserts that it acted promptly by providing notice to the parties, supplementing its own invalidity contention interrogatory responses, and filing the current motion. (*Id.*)

Samsung argues that there is no risk of undue prejudice to Saxon or Staff. Samsung notes that it only seeks to add ten references to a list of approximately 270 references. (*Id.*) Six of the eight references for the '597 patent relate to the same microcontroller product made by Intel Corporation. (*Id.*) Both references for the '873 patent describe the same Convex supercomputer system. (*Id.*) Samsung states that it has already provided Saxon and Staff with copies of the prior art references and detailed claim charts for each reference. Thus, according to

Samsung, “[g]iven the limited nature of the requested supplementation, no party can claim undue prejudice.” (*Id.*)

Staff supports Samsung’s motion in part. Staff explains that Saxon’s June 17, 2009 supplemental contention interrogatory responses did not make any substantive changes, but only revised citations to documents that Saxon relied upon. (Staff Resp. at 2.) Staff states that Saxon’s June 23, 2009 supplemental contention interrogatory responses included substantive changes related to the ‘873 patent based on discovery received by Saxon after the June 10, 2009 deadline. (*Id.* at 3.)

Staff supports Samsung’s motion with regard to the ‘873 patent. Staff states that because Samsung received Saxon’s new infringement contentions relating to the ‘873 patent on June 23, 2009, it was unreasonable to expect Samsung to be able to locate all relevant prior art in time for the June 26, 2009 deadline to file the notice of prior art. (*Id.* at 4.) In light of Samsung’s prompt response in notifying the parties and filing the current motion, Staff argues that Samsung has demonstrated the necessary good cause. (*Id.* at 4-5.)

Staff does not support Samsung’s motion with regard to the ‘597 patent. Staff states that the only changes to Saxon’s ‘597 patent infringement contentions after they were originally served on June 10, 2009 were changes related to citations. (*Id.* at 5.) Staff does not view this as a substantive change, and thus argues that it cannot serve as the basis for allowing Samsung to supplement its notice of prior art. (*Id.*) Staff states that Samsung failed to explain why it could not have uncovered the eight new references prior to the June 26 deadline. (*Id.* at 6.)

Saxon’s June 23, 2009 supplemental contention interrogatory responses included substantive changes regarding Saxon’s infringement positions, and it is reasonable that Samsung would seek to alter its invalidity contentions in light of such changes. Further, Samsung was


diligent in locating the new prior art references, disclosing them to Saxon and Staff, and updating its own invalidity contentions. I find that Samsung has demonstrated the necessary good cause to file a supplemental notice of prior art with regard to the '873 patent.

With regard to the '597 patent, Samsung has not demonstrated the good cause necessary to file a supplemental notice of prior art. Saxon served supplemental infringement contentions relating to the '597 patent on June 17, 2009, but those supplemental contentions only revised the citations to the documents that Saxon relied upon. (See Exs. 1-2 to Staff Resp.) Specifically, Saxon amended citations to reflect Bates numbers assigned to documents produced by Samsung in the investigation. Such a change does not justify allowing Samsung to amend its notice of prior art. Samsung has not demonstrated why it could not have uncovered the new '597 patent prior art references prior to the June 26, 2009 deadline.

ORDER

Motion No. 673-016 is hereby GRANTED-IN-PART & DENIED-IN-PART. Within seven (7) days from the date of this Order, Samsung may file a supplemental notice of prior art. The supplemental notice of prior art shall be limited to the '873 patent and shall include only the two Convex Reference Manuals identified in Samsung's motion. Samsung's motion is otherwise DENIED.

SO ORDERED.



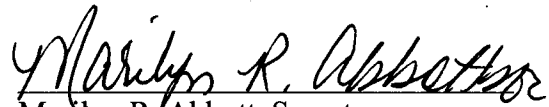
Robert K. Rogers, Jr.
Administrative Law Judge

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PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Lisa A. Murray, Esq.**, Commission Investigative Attorney, and the following parties via first class mail and air mail where necessary on **JUL 22 2009**



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PUBLIC CERTIFICATE OF SERVICE PAGE 2

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PUBLIC CERTIFICATE OF SERVICE - PAGE 3

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