

1 HAROLD J. MCELHINNY (CA SBN 66781)  
hmcclhinny@mofo.com  
2 MICHAEL A. JACOBS (CA SBN 111664)  
mjacobs@mofo.com  
3 RACHEL KREVANS (CA SBN 116421)  
rkrevans@mofo.com  
4 JENNIFER LEE TAYLOR (CA SBN 161368)  
jtaylor@mofo.com  
5 MORRISON & FOERSTER LLP  
425 Market Street  
6 San Francisco, California 94105-2482  
Telephone: (415) 268-7000  
7 Facsimile: (415) 268-7522

8  
9 Attorneys for Plaintiff and  
Counterclaim-Defendant APPLE INC.

WILLIAM F. LEE  
william.lee@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
60 State Street  
Boston, MA 02109  
Telephone: (617) 526-6000  
Facsimile: (617) 526-5000

MARK D. SELWYN (SBN 244180)  
mark.selwyn@wilmerhale.com  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
950 Page Mill Road  
Palo Alto, California 94304  
Telephone: (650) 858-6000  
Facsimile: (650) 858-6100

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12 UNITED STATES DISTRICT COURT  
13 NORTHERN DISTRICT OF CALIFORNIA  
14 SAN JOSE DIVISION  
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16 APPLE INC., a California corporation,

17 Plaintiff,

18 v.

19 SAMSUNG ELECTRONICS CO., LTD., a  
20 Korean corporation; SAMSUNG  
ELECTRONICS AMERICA, INC., a New  
21 York corporation; and SAMSUNG  
TELECOMMUNICATIONS AMERICA,  
22 LLC, a Delaware limited liability company,

23 Defendants.  
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Case No. 11-cv-01846-LHK

**APPLE'S NOTICE OF FILING OF  
TERMINAL DISCLAIMER FOR  
U.S. PATENT NO. D618,677**

1 Apple hereby notifies the Court that it has executed and filed with the U.S. Patent and  
2 Trademark Office a Terminal Disclaimer for the D'677 patent, a copy of which is attached hereto  
3 as Exhibit A.

4 This disclaimer moots Samsung's Motion for Judgment as a Matter of Law, as set forth in  
5 Samsung's reply brief, that Apple's U.S. Patent No. D618,677 is invalid for obviousness-type  
6 double patenting over U.S. Patent No. D593,087. (Dkt. No. 2131 at 7 (citing *Eli Lilly and Co. v.*  
7 *Teva Parenteral Meds., Inc.*, 689 F.3d 1368, 1376 (Fed. Cir. 2012) for "patentably distinct"  
8 standard for obviousness-type double patenting).) *See Eli Lilly & Co. v. Barr Lab., Inc.*, 222 F.3d  
9 973, 985 n.4 (Fed. Cir. 2000) (obviousness-type double patenting is cured by terminal  
10 disclaimer); *Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1378 (Fed. Cir.  
11 2003) (same).

12 This is so notwithstanding that the disclaimer has been filed during litigation. *See*  
13 *Boehringer Ingelheim Intern. GmbH v. Barr Labs., Inc.*, 592 F.3d 1340, 1347 (Fed. Cir. 2010);  
14 *Syngenta Seeds, Inc. v. Monsanto Co.*, No. Civ. 02-1331-SLR, 2004 WL 2790499, at \*2-3 (D.  
15 Del. Nov. 19, 2004) (denying summary judgment of invalidity for double patenting in view of  
16 terminal disclaimer filed during litigation).

17 The filing of a terminal disclaimer cannot be treated as an admission that the later patent is  
18 invalid for double patenting. *See Ortho Pharmaceutical Corp. v. Smith*, 959 F.2d 936, 941 (Fed.  
19 Cir. 1992) ("It is improper to convert this simple expedient of 'obviation' into an admission or  
20 acquiescence or estoppel on the merits."); *Ventana Med. Sys. v. Biogenex Labs., Inc.*, 473 F.3d  
21 1173, 1184 n.4 (Fed. Cir. 2006) (same).

22 Dated: November 27, 2012

MORRISON & FOERSTER LLP

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25 By: /s/ Michael A. Jacobs

Michael A. Jacobs

26 Attorneys for Plaintiff  
27 APPLE INC.  
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