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APPLE INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

FIRSTFACE CO., LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 3:18-cv-02245-JD

DEFENDANT APPLE'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

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I. INTRODUCTION

Firstface's opposition confirms that summary judgment in Apple's favor is proper.

On written description, Firstface does not dispute its expert's concession that "the specification does not explicitly state that fingerprint authentication is performed without additional user input." (D.I. 221-8 ("Almeroth Reb. Rpt."), ¶ 1154.) Although Firstface offers a hodge-podge of citations to try to avoid invalidity, only one discusses fingerprint authentication at all. None discloses activating the display and performing fingerprint authentication in response to a single button press without additional user input. At its core, Firstface's position is that the skilled artisan would have found that functionality to be obvious—but that is legally insufficient.

On infringement of the "power button" limitation, Firstface's concessions also doom its infringement positions. Firstface openly admits that pressing the "top," "side," or "sleep/wake" button will not, in fact, power off the accused devices. Instead, the user must "press[] and hold[] the button and then slide a slider on the device touchscreen" to do so. (D.I. 255 ("Opp.") at 3.) Apple thus does not literally infringe. Firstface's belated attempt to construe "on/off" during expert discovery and its failure to conduct a hypothetical claim analysis also defeat its infringement position. Firstface's construction for "on/off" as "on or off" further is wrong on the merits. As for equivalents, Firstface does not dispute its expert's admission that pressing a button alone is "simpler and less cumbersome" than pressing and sliding. (*Id.* at 7.) Nor does Firstface dispute that pressing and sliding is a "substantially different way" of turning off a device.

On infringement of the "without additional user input" limitation, Firstface's expert's concessions again are fatal. Although Firstface contends that it would be "nonsensical" to characterize a button press using a finger as two separate inputs, its source code expert Nigel Jones has admitted that the Accused Products operate in exactly this way: "Upon detection of a finger on the sensor *following a button press, . . .* an unlock sequence starts to ensure the fingerprint is properly matched." (D.I. 221-6, ¶ 91 (emphasis added).) Because there are no genuine disputed facts as to how the Accused Products operate, Apple is entitled to summary judgment of non-infringement for this reason as well.

Finally, on indirect infringement, Firstface effectively concedes that Apple lacked pre-suit

knowledge of the patents, as it has agreed to forego claims for pre-suit damages. Apple therefore requests summary judgment of no indirect infringement as to at least pre-suit inducement.

II. ARGUMENT

A. The Asserted Claims Lack Written Description Support

Firstface overcame Apple's IPR challenges to the few surviving claims based on the "without additional user input" limitation. But Firstface first added that limitation in 2015, three years after the alleged priority date. It therefore struggles to identify specification support for this limitation. That lack of support renders the patents invalid.

1. Firstface's Citations Do Not Support Performing Fingerprint Authentication Without "Additional User Input"

Both experts agree that the specification does not expressly refer to performing any function—whether fingerprint authentication or otherwise—"without additional user input." (D.I. 221-28 ("Cockburn Op. Rpt."), ¶¶ 3003, 3004; D.I. 221-8, ¶ 1152.) Lacking such an express disclosure, Firstface offers a mish-mash of citations to try to save its claims. (Opp. at 13-14.)

None of those citations helps Firstface. Only one refers to "fingerprint recognition"—as part of a long list of authentication methods. (D.I. 221-22 ("'373 patent"), 8:13-20). As for its other citations (4:36-40; 4:51-53; 4:61-65; 4:65-5:2; 5:52-55; 7:16-17; 8:7-12), all at most describe pressing a button to perform a function. (Opp. at 13-14.). None discusses performing a function, much less fingerprint authentication, without additional user input.

To evade summary judgment, Firstface newly argues that the specification describes "benefits of performing the functions in response to a one-time press of the activation button." (Opp. at 14 (citing '373 patent, 1:34-41; 9:29-33; 11:61-65; 12:4-7).) As an initial matter, Firstface did not disclose this argument or the allegedly supportive citations in related interrogatory responses or in its expert's report. Firstface therefore has waived this argument. *See Apple, Inc. v. Samsung Elecs. Co.*, No. 11-cv-1846, 2012 WL 3155574, at *7 (N.D. Cal. Aug. 2, 2012) (barring reliance on theories not disclosed in interrogatory responses).

But even if otherwise, the referenced "benefits" are agnostic as to whether fingerprint authentication is performed with additional user input. For example, whether a manufacturer

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