ARTURO J. GONZALEZ (CA SBN 121490)
agonzalez@mofo.com
RICHARD S.J. HUNG (CA SBN 197425)
rhung@mofo.com
SHAELYN K. DAWSON (CA SBN 288278)
shaelyndawson@mofo.com
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-7000
Facsimile: (415) 268-7522

BITA RAHEBI (CA SBN 209351)
brahebi@mofo.com
ALEX S. YAP (CA SBN 241400)
ayap@mofo.com
NICHOLAS R. FUNG (CA SBN 312400)
nfung@mofo.com
MORRISON & FOERSTER LLP
707 Wilshire Boulevard
Los Angeles, California 90017-3543
Telephone: (213) 892-5200
Facsimile: (213) 892-5454

Attorneys for Defendant
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 INC.'S TRIAL BRIEF

Trial Date: July 10, 2023
Courtroom: 11

Hon. James Donato

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

		Page
I.	CASE BACKGROUND	1
II.	PENDING MOTIONS FOR SUMMARY JUDGMENT AND *DAUBERT* MOTIONS	2
III.	REMAINING CAUSES OF ACTION AND DEFENSES	3
A.	Apple Does Not Directly Infringe the Asserted Claims	3
1.	Apple Does Not Literally "Provid[e] . . . a Power Button for Pressing to Turn On/Off the Terminal"	3
2.	Apple Does Not "Provid[e] . . . a Power Button for Pressing to Turn On/Off the Terminal" Under the Doctrine of Equivalents	4
3.	The Accused Products Do Not Perform the Fingerprint Authentication Feature "Without Additional User Input" or in Response to "One-Time Pressing"	5
4.	The Accused Products with a Solid-State Home Button Do Not Perform Additional Limitations of the '373 Patent Asserted Claims	6
B.	Firstface Cannot Prove Induced Infringement	6
C.	The Asserted Claims Are Invalid	6
1.	Apple's Own Prior Invention Anticipates the Asserted Claims	6
2.	Prior Art Renders Obvious the Asserted Claims	7
3.	The Asserted Claims Lack Sufficient Written Description	7
4.	The Asserted Claims Are Not Enabled	9
D.	Firstface Overstates Any Damages	9

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF AUTHORITIES

Page(s)

Cases

Amgen Inc. et al. v. Sanofi et al.,
598 U.S. __, 143 S. Ct. 1243 (2023) 9

Apotex USA, Inc. v. Merck & Co.,
254 F.3d 1031 (Fed. Cir. 2001) 7

Apple Inc. v. Firstface Co.,
2021 WL 4156323 (Fed. Cir. Sept. 13, 2021) 8

Ariad Pharms., Inc. v. Eli Lilly & Co.,
598 F.3d 1336 (Fed. Cir. 2010) (en banc) 7, 8

Cardiac Pacemakers, Inc. v. St. Jude Med. Inc.,
576 F.3d 1348 (Fed. Cir. 2009) 9

Cirba Inc. et al. v. VMware, Inc.,
C.A. 1:19-cv-742-GBW (Apr. 18, 2023), Dkt. No. 1724 10

Commil USA, LLC v. Cisco Sys., Inc.,
575 U.S. 632 (2015) 6

Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.,
424 F.3d 1293 (Fed. Cir. 2005) 3

Droplets, Inc. v. Yahoo! Inc.,
No. 12-cv-03733, 2022 WL 2670163 (N.D. Cal., Jan. 12, 2022) 10

Franks Casing Crew & Rental Tools, Inc. v. Weatherford Int'l, Inc.,
389 F.3d 1370 (Fed. Cir. 2004) 3

G. David Jang, M.D. v. Bos. Sci. Corp.,
872 F.3d 1275 (Fed. Cir. 2017) 4, 5

KSR Int'l Co. v. Teleflex Inc.,
550 U.S. 398 (2007) 7

LaserDynamics, Inc. v. Quanta Comput., Inc.,
694 F.3d 51 (Fed. Cir. 2012) 10

Packet Intel. LLC v. NetScout Sys., Inc.,
965 F.3d 1299 (Fed. Cir. 2020) 9

PIN/NIP, Inc. v. Platte Chem. Co.,
304 F.3d 1235 (Fed. Cir. 2002) 8

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Synthes USA, LLC v. Spinal Kinetics, Inc.,
734 F.3d 1332 (Fed. Cir. 2013) 8

Tokyo Ohka Kogyo, Ltd. v. Fujifilm Elec. Materials USA, Inc.,
PGR2022-00010, Paper 28 8

Tyco Healthcare Grp. LP v. Ethicon Endo-Surgery, Inc.,
774 F.3d 968 (Fed. Cir. 2014) 7

Virtnetx, Inc. v. Cisco Sys.,
767 F.3d 1308 (Fed. Cir. 2014) 10

In re Wands,
858 F.2d 731 (Fed. Cir. 1988) 9

Warner-Jenkinson Co. v. Hilton Davis Chem. Co.,
520 U.S. 17 (1997) 3

Whitserve, LLC v. Computer Packages, Inc.,
694 F.3d 10 (Fed. Cir. 2012) 10

Statutes

35 U.S.C. § 101 2

35 U.S.C. § 112 ..... 2, 7, 9

35 U.S.C. § 271(b) 6

35 U.S.C. § 102(g) 6

35 U.S.C. § 103 7

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Pursuant to the Standing Order for Civil Trial Before James Donato, Defendant Apple Inc. respectfully submits this Trial Brief, specifying each cause of action and defense remaining to be tried along with the applicable legal standard.

I. CASE BACKGROUND

Apple is the world's leading innovator of personal computing products. It introduced the first multi-touch smartphone, iPhone, to widespread acclaim in 2007. Apple has continued to add groundbreaking features to iPhone with each subsequent generation. And this case relates to one of those features, Touch ID, which Apple brought first to iPhone 5s in September 2013. Touch ID allows a user to unlock certain iPhones (and iPads) by pressing the Home button with their finger. Apple began developing Touch ID in 2009. Its engineers worked alongside those from AuthenTec, a cutting-edge fingerprint sensor company, to develop a fingerprint sensor invention that would eventually become Touch ID in iPhone 5s. Apple acquired AuthenTec in 2012, before Apple released iPhone 5s.

Firstface is a non-practicing entity from Korea. Firstface asserts U.S. Patent Nos. 9,633,373 (the "'373 patent") and 9,779,419 (the "'419 patent") (together, the "Asserted Patents") against Apple. Both claim priority to an October 2011 Korean application and U.S. Patent Application No. 14/538,880. Both relate to activating a mobile terminal's display and performing a function (*e.g.*, fingerprint authentication) "with one-time user input." Firstface has no current employees other than its three co-CEOs. Its sole business is monetizing its patent portfolio with litigation funding support. It has never attempted to develop or release a product that practices the Asserted Patents.

Firstface asserts that Apple directly infringes claims 11-14 and 18 of the '373 patent and claims 10, 12, 13, and 15-17 of the '419 patent by using certain features of the accused iPhone and iPad products (the "Accused Products")—namely, by using Touch ID and Siri (the accused processes). These claims are all method claims. Firstface also asserts that Apple actively induces its customers' infringement of the same claims when those customers use the accused features. Firstface no longer alleges contributory infringement or pre-suit damages for induced infringement. It has not asserted willful infringement.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.