IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ELM 3DS INNOVATIONS, LLC, Plaintiff, v. SAMSUNG ELECTRONICS CO., LTD., et al. Defendants.	C.A. No. 14-1430-LPS JURY TRIAL DEMANDED
ELM 3DS INNOVATIONS, LLC, Plaintiff, v. MICRON TECHNOLOGY, INC., et al., Defendants.	C.A. No. 14-1431-LPS JURY TRIAL DEMANDED
ELM 3DS INNOVATIONS LLC, Plaintiff, v. SK HYNIX INC., et al., Defendants.	C.A. No. 14-1432-LPS-CJB JURY TRIAL DEMANDED

DEFENDANTS' REPLY IN SUPPORT OF ITS MOTION FOR AN EXPEDITED SCHEDULE AND LEAVE TO FILE ITS SUMMARY JUDGMENT MOTION ON INDEFINITENESS OF THE "LOW STRESS" TERMS

Stripped of its histrionic rhetoric, Elm's Opposition boils down to its argument that Defendants ask Elm to do too much too soon for a case that has been pending for nearly six years. But in reaching that conclusion, Elm conflates indefiniteness with infringement in arguing that Defendant depositions are required. Indefiniteness focuses on the understanding of the claims by

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a person of ordinary skill at the time of the alleged invention. Indefiniteness is not related to Defendants' actions or an infringement inquiry. Indeed, had Elm never brought an infringement claim, the claims could still be adjudged indefinite.

Contrary to Elm's attorney argument, indefiniteness and infringement are not "intertwined."[1] D.I. 276 in C.A. 14-1432[2] ("Opp.") at 5. "Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable to determining whether allegedly indefinite claim language is subject to construction." *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008); *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1340-41 (Fed. Cir. 2005) ("[t]he test for indefiniteness does not depend on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention[,]"); *Confluent Surgical, Inc. v. HyperBranch Med. Tech., Inc.*, 2019 WL 2897701, at *8 n.10 (D. Del. July 5, 2019) (Burke, M.J.) (rejecting consideration of defendant's own accused product for indefiniteness analysis based on *SmithKline*). A claim is indefinite if it fails to inform ***those skilled in the art*** "***as of the time of the patent application*** [i.e., the filing date]" about the scope of the claimed subject matter with reasonable certainty. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014).

Infringement, conversely, focuses on whether Defendants' products meet the limitations of

[1] Defendants never "recognized" that indefiniteness and infringement are "intertwined" as Plaintiff alleges. Opp. at 5. Rather, Defendant's expert, Dr. Fair, rightly criticized Plaintiff's expert for failing to explain how a person of ordinary skill in the art could distinguish with reasonable certainty between infringing and non-infringing stress values, which would demonstrate indefiniteness. D.I. 237, Ex. B at ¶41. In other words, indefiniteness asks whether one of ordinary skill could understand the scope of the claims, not whether Defendants' products actually fall within that scope, which is the infringement question.

[2] All docket citations are to C.A. 14-1432.

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the claims as construed, after the patent issues. Elm's sudden demand for discovery is a red herring because it focuses on the latter (infringement), not the former (indefiniteness). Elm now argues that it needs discovery concerning Defendants' products including: (1) depositions of Defendants' fact witnesses to understand "what they do generally to manage stress," and (2) expert testing of Defendants' products using "established methods" to demonstrate that "stress values can be measured experimentally."[3] Opp. at 4-5. This proposed discovery has nothing to do with indefiniteness, and indeed Elm never sought any of this discovery during the claim construction process. There is no reason why Elm could not have conducted the product testing (per its Rule 11 obligations) it purports to now need, or why it cannot do so within Defendants' proposed schedule.

Here, indefiniteness is determined based on how one of ordinary skill in the art would have understood the claims ***in 1997***, when the priority application was filed. D.I. 1 at ¶12. "[D]efiniteness is measured from the viewpoint of a person skilled in [the] art ***at the time the patent was filed***." *Nautilus*, 572 U.S. at 908 (emphasis in original). But Defendants did not manufacture, sell, or offer to sell a stacked memory product with a substrate thinned to 50 µm or less (a requirement of the asserted claims) until many years later. D.I. 258 at 6-7.[4] Thus,

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[3] Elm does ***not*** complain that Defendants' proposed schedule prevents it from obtaining ***documents*** it purportedly needs. Indeed, Elm's Opposition cites Samsung documents, and admits that discovery has "proceeded in earnest." Opp. at 3. Defendants' proposed close of fact discovery for the "low stress" terms is several weeks after the current date for substantial completion.

[4] Elm admits that the "time frames for infringement and validity" in this case are "different," but tries to run from this legal truth by incorrectly and misleadingly citing an out of context statement by Dr. Murray—that "typical commercial equipment" at "the time of the inventions in the Asserted Patents…all measure curvature or shape." Opp. at 4. Elm ignores Defendants' argument stated in the very next sentence of Dr. Murray's declaration, which Elm does not cite. Dr. Murray explains that he is quoting from a 2001 article and that the equipment and method referred to was "***only applicable*** to films applied to smooth wafers which are measured for curvature before and after film deposition, ***not to dielectric layers incorporated into a three dimensional structure***." D.I. 237, Ex. C at ¶39 (emphasis added). Dr. Murray goes on to cite the several other stress

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Defendants' products, let alone test structures that ***are not accused*** (which is what Elm cites), cannot be relevant to how one of ordinary skill in the art would have understood the patent claims years earlier, in 1997. Moreover, indefiniteness focuses on the knowledge of those of ordinary skill, not Defendants' knowledge. *See SmithKline*, 403 F.3d at 1340-41.

As the Court recognized during claim construction, indefiniteness turns on whether a person of ordinary skill in the art would know what type of stress to measure, where to measure stress, how to measure stress, and when to measure stress. D.I. 258 at 14-17. Discovery into Defendants' products does nothing to answer these questions. Tellingly, Plaintiff fails to explain how its proposed discovery is relevant at all to indefiniteness.

Elm argues it would be more efficient to question Defendants witnesses about indefiniteness and infringement issues at the same time (Opp. at 4-5), but there is no need to depose Defendants' engineers as to products and test structures built years after the alleged inventions as that is wholly irrelevant to the indefiniteness issue.[5]

When Elm's purported need for discovery into Defendants' products is disregarded, the parallel schedule proposed by Defendants is workable. Because indefiniteness focuses on how one of ordinary skill would understand the claims, it is fundamentally an expert issue, not an issue

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measurement techniques available at the time, a fact that is undisputed by Defendants. By taking a quote out of context, Elm tries to argue that Dr. Murray's testimony somehow prevents Defendants from noting that these different timelines matter. Opp. at 4. Despite Elm's misleading citation, this does nothing to answer the question of whether one of ordinary skill in the art as of 1997 would know what type of stress to measure, where to measure stress, how to measure stress, and when to measure stress.

[5] Indeed, at the *Markman* hearing, the Court appeared skeptical that evidence concerning ***Defendants'*** purported understanding of stress made the claims definite: "You're saying don't tell the jury anything about any of this. And your argument seems to be because ***manufacturers understand how to do this***, but you don't even want me to tell the jury that that is fair game to look at. ***So I guess I'm a little lost on how this term could be definite***." D.I. 241, Hearing Tr. 53:3-8.

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concerning Defendants' products. Defendants' proposed schedule provides ample time for exchange of expert reports, depositions of those experts, and any relevant third-party discovery.

The parallel schedule is designed so that issues relating to the "low stress" terms can be resolved around the time fact discovery for all issues closes. That way, even if the proposed motion is denied, the parties can enter expert discovery for all remaining issues with knowledge of what the "low stress" terms mean, avoiding expert reports and summary judgment motions with alternative interpretations and the possibility of requests for post-summary judgment discovery. Defendants are not necessarily wed to the specific dates outlined in their proposal. If the current schedule is ultimately extended by a few months because of the COVID-19 situation, Defendants are open to a commensurate extension to the early summary judgment schedule such that the indefiniteness issues are still resolved around the end of fact discovery.[6]

Plaintiff's claims of prejudice ring hollow. Although Plaintiff now asserts that discovery "into indefiniteness and infringement cannot be bifurcated because the evidence establishing that the claims are both definite and infringed overlap extensively" (Opp. at 3), Plaintiff never mentioned this purported need for discovery into Defendants' products when it briefed these same indefiniteness issues during claim construction. Plaintiff also never sought such discovery in the many months leading up to the *Markman* hearing. Had Elm really believed that it needed to depose any of Defendants' witnesses for indefiniteness purposes, it could have and should have done so already. Plaintiff's sudden, professed need for this discovery should be seen for what it is—a

[6] Contrary to Plaintiff's assertions, Defendants are not trying to use the "worldwide pandemic as a reason to cram fact and expert discovery into four months" and do not "oppose resolving indefiniteness under the current case schedule because of the 'uncertainty' the pandemic poses to a 2021 trial date." Opp. at 7. Defendants mentioned the "uncertainty" of the pandemic simply to explain why they believe a trial date in 2021 is impractical, not to "justify" their proposed indefiniteness schedule. D.I. 270 at 5 n.5.

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