IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ELM 3DS INNOVATIONS, LLC, a Delaware limited liability company, Plaintiff, v. SAMSUNG ELECTRONICS CO., LTD., a Korean business entity, SAMSUNG SEMICONDUCTOR, INC., a California corporation, SAMSUNG ELECTRONICS AMERICA, INC., a New York corporation, and SAMSUNG AUSTIN SEMICONDUCTOR, LLC, a Delaware limited liability company, Defendants.	C.A. No. 14-1430-LPS **REDACTED - PUBLIC VERSION**

LETTER TO THE HONORABLE JENNIFER L. HALL FROM ADAM W. POFF REGARDING SAMSUNG DEFENDANTS' RESPONSE TO PLAINTIFF'S NOVEMBER 19, 2020 DISCOVERY LETTER (D.I. 374)

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Dated: November 25, 2020

Redacted Version: December 4, 2020

Dear Magistrate Judge Hall:

Elm's entire motion is based on a false premise that Samsung unilaterally decided to exclude products from this case. That is not true. It was ***Elm***—not Samsung—that defined and selected the accused products at issue here, as the record clearly demonstrates. Samsung does not possess "substrate" thickness data—and has no way to provide it. Samsung thus produced "chip"/ "die" thickness data ***with Elm's approval***—and from that data, ***Elm*** itself chose the accused products and excluded other products it now seeks to add.

There are over 1400 products at issue, and the parties have worked for months toward a representative products list, which now stands at 155 products—an unwieldy number placing a disproportionate burden on Samsung. Elm's request to add even more products with just over a month left in discovery is untenable, untimely and disingenuous on this record. It is time to reduce the number of products, not increase them. Elm's motion should respectfully be denied.

I. Elm Hand-Picked the Products At Issue Based on "Die"/"Chip" Thickness

Elm incorrectly states that Samsung "unilaterally" limited this case to "products where both the substrate and *other material* on top of the substrate together were 50 microns or less." D.I. 374 at 1. Not so. The record unequivocally demonstrates that ***Elm*** itself selected Samsung's products to accuse of infringement, and continued to accuse those products for over sixteen [redacted]

A. *Elm* Accused Stacked Products with "Die/Chip" Thickness ≤ 50 Microns

On June 12, 2019, the Federal Circuit issued its decision construing the "substantially flexible" terms. Ex. 6. The constructions differed depending on whether the "substantially flexible" terms modified (i) "semiconductor substrate," or (ii) "'circuit layers,' and other similar terms," such as "die," integrated circuits," and "integrated circuit layer." *Id*. at 5-6. It cannot be disputed that these latter terms are used interchangeably, including by the Federal Circuit and this Court, and that their construction require more than just a substrate. *Id*.; D.I. 266 at 7.

On June 20, 2019, Elm informed Samsung that, specifically in light of the Federal Circuit's constructions, it is only "accus[ing] of infringement" products having a "circuit layer"—not a "semiconductor substrate"—with a thickness of 50 microns or less. Ex. 7 at 1.

Subsequently, on June 25, 2019, ***Elm*** hand-picked the products it believed satisfied its own definition, based on a spreadsheet that Samsung produced on March 14, 2019. Ex. 8-9. Samsung had broadly listed its products with their "***chip***" or "***die***" thicknesses, ranging from less than 50 microns to over 700 microns—not their "substrate" thicknesses, which do not exist at Samsung. Ex. 2; D.I. 286, Ex. M, ¶¶ 9-10. ***Elm selected*** only those products with a chip/die thickness of 50 microns or less, and ***Elm excluded*** the very products with chip or die thicknesses over 50 microns that it now incredibly and incorrectly claims that Samsung excluded. Ex. 8-9.

In the ***sixteen months*** that followed, Elm repeatedly confirmed that it was accusing only products with a "circuit layer" with 50 microns or less thickness, interchanging the terms "circuit layer," "die" and "chip." Only a small sampling of Elm's statements is highlighted below:

- 7/29/2019: Elm explaining that the list provided on 6/25/2019 includes Samsung products "that contain at least one ***die*** at 50µm or less." Ex. 56 (emphasis added).
- 8/16/2019: Elm reiterating that it accuses stacked products that have a "***circuit layer***" with "a thickness of 50 microns or less." Ex. 15 at 1 (emphasis added).
- 9/13/2019: Elm asking Samsung to identify every stacked product "where at least one of the ***die*** has a thickness of 50 microns or less." Ex. 22 at 1 (emphasis added).
- 12/15/2019: Elm memorializing that Samsung will produce worldwide sales for stacked products "that include one ***die*** that is 50 microns or less." Ex. 29 at 1 (emphasis added).
- 5/19/2020: Elm's declaration to the Court requesting that Samsung complete the products chart using "***die***"/"***chip***" thickness. D.I. 281 ¶ 51 (emphasis added).
- 7/8/2020: Elm asking Samsung about representative products, referring to "processes for the ***chips*** that are thicker than 50 microns." Ex. 40 (emphasis added).

See Ex. 1 at ¶¶ 10-51. Against this record, Elm cannot credibly maintain that "Samsung relies primarily on one statement" regarding the scope of the case. D.I. 374 at 3. Nor can Elm contend that Samsung intentionally or inadvertently misinterpreted Elm's requests in Samsung's favor.

[redacted] D.I. 286, Ex. M, ¶¶ 6-23. There was no interpretation by Samsung involved; ***Elm*** embraced the approach, and selected and continued to accuse products from the die/chip thickness data that it asked Samsung to provide. *See* Ex. 1 at ¶¶ 46-51. It is disingenuous, and indeed, not possible to refocus on unknown "substrate" thickness data now.

B. Elm Seeks to Impermissibly Contradict the Established Meaning of "Circuit Layer"

Elm incorrectly contends that its August 30, 2019 letter informed Samsung that the term "circuit layer" covers a substrate because it purportedly used that term broadly to mean "any semiconductor layer on which circuits are formed." D.I. 374 at 1. To the contrary, the letter does not explain that "circuit layer" can be a silicon substrate. Ex. 20 at 2. And a semiconductor layer with circuits formed on it is no longer a silicon substrate; it is a die or chip. Elm's letter further states that "circuit layer" covers "layers of ***memory cells***" (not a silicon substrate) and "image sensor ***chips*** which comprise circuits formed on a semiconductor" (also not a silicon substrate). *Id*. (emphasis added). Elm later reconfirmed that, consistent with its August letter, a "circuit layer" is a chip (not a substrate within the chip) when it served a claim chart that pointed to the ***chips*** in Samsung's image sensor products as the "circuit layer." Ex. 1 at ¶ 26; Ex. 25.

Elm's new assertion that "circuit layer" is broader contradicts the record in this case, and the related IPR and Federal Circuit proceedings. As noted above, the Federal Circuit equated "circuit layer" with other terms for a chip. *Supra* at I.A. This Court did the same. D.I. 266 at 7 (construing "integrated circuit/integrated circuit layer/circuit layer/circuit structure/circuit/structure"); D.I. 299 at 2 (clarifying, over Elm's objection, that "dice," "die," "integrated circuit," and similar terms are construed the same). Elm's submissions and infringement contentions consistently use the "circuit layer" term for the entire integrated chip/die, not the substrate. Ex. 1 at ¶¶ 52-58. Elm cannot feign surprise that Samsung produced thicknesses for chips/dies, as Elm itself asked and agreed. Nor can Elm claim surprise that those chips/dies include a substrate ***and*** an "active layer" and a "polyimide layer," as Elm has

conceded that active and passivation (polyimide) layers are included in chips/dies. *See* Ex. 1 at ¶¶ 53-58.

C. Elm Mischaracterizes its Prior Discovery Dispute with Samsung

Elm justifies its revisionist position by citing discovery requests and motions to compel discovery on "all relevant products." D.I. 374, 1-2. But those requests did not define the accused products, and Samsung objected to them as "not reasonably tied to Elm's infringement allegations" or unrelated to products "properly accused in this case." Ex. 51 at 3, 7-10; Ex. 53 at 8; Ex. 55 at 7-18. While Samsung was required to complete Elm's chart, that chart asked for the "minimum thickness of the ***die***"—not a semiconductor layer or a substrate. D.I. 281 at ¶ 51(B) and Ex. 30. Elm even acknowledged that "die" referred to a ***processed*** die or "chip." D.I. 281 at ¶ 51(D) ("Where more than one process node is used to make the die, each relevant process node should be listed."); *id.* at ¶ 51(E) ("This column identifies the number of die or 'chips' that are stacked in the product."). Samsung provided die/chip thickness data, as Elm requested.

II. Elm's Request to Expand the Case Is Untimely and Impracticable

Elm incorrectly alleges that it raised this issue "immediately." But the record shows Elm knew that Samsung produced die thickness data at least ***sixteen months ago***, and indisputably ***six months ago***, upon the filing of the May 22, 2020 declaration of Ms. Hyung, [redacted]. *Supra* at I.A. Elm has no excuse for its delay, and with just over one month left in discovery, Elm's request is untimely. *EON Corp. IP Holdings, LLC v. FLO TV Inc.*, No. 10-812, 2013 WL 5890571, *2 (D. Del. Aug. 28, 2013) (disallowing new products four months before close of discovery as untimely).

Elm's request should also be denied [redacted]s. *Invensas Corp. v. Renesas Elecs. Corp.*, No. 11-448, 2013 U.S. Dist. LEXIS 199894, *7 (D. Del. May 8, 2013) ("the Court cannot compel a party to produce documents regarding a 'family' or 'category' that does not itself exist"). [redacted] Ex. 1, ¶ 65. The burden on Samsung of expanding an already-unwieldy number of products is disproportionate and prejudicial. *Invensas Corp. v. Samsung Elecs. Co.*, No. 2:17-cv-00670, 2018 U.S. Dist. LEXIS 189260, *13 (E.D. Tex. Nov. 6, 2018) (discovery on new chips was untimely and "unwarranted in light of the burden that would be imposed upon the Defendants at this late stage of the case").

If anything, the number of products should be reduced at this time, not expanded. *See* Ex.1 at ¶ 66 (Judge Stark's standing order contemplating "reasonable proposals to reduce" the number of accused products); *Fenster Fam. Pat. Holdings, Inc., Elscint Ltd.*, No. 04-0038, 2005 WL 2304190, *3 (D. Del. Sept. 20, 2005) (requiring a reduction in accused products where plaintiff expanded the case five weeks before close of discovery); *Voip-Pal.com, Inc. v. Apple Inc.*, No. 18-CV-06217, D.I. 73 (N.D. Cal. Jan. 16, 2019) (Ex. 57) (ordering reductions in the number of accused products in several stages, from claim construction order to pre-trial).

For at least the foregoing, Samsung respectfully requests that Elm's motion be denied, and instead, that Elm be required to reduce the total number of accused products.

Respectfully submitted,

/s/ *Adam W. Poff*

Adam W. Poff (No. 3990)

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