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

**DECLARATION OF ALLAN M. SOOBERT IN SUPPORT OF
SAMSUNG'S OPPOSITION TO ELM'S MOTION TO COMPEL**

OF COUNSEL:

Allan M. Soobert
Naveen Modi
Phillip W. Citroën
PAUL HASTINGS LLP
875 15th Street, N.W.
Washington, D.C. 20005
(202) 551-1700
(202) 551-1705 (fax)
allansoobert@paulhastings.com
naveenmodi@paulhastings.com
phillipcitroen@paulhastings.com

YOUNG CONAWAY STARGATT &
TAYLOR, LLP

Adam W. Poff (No. 3990)
Pilar G. Kraman (No. 5199)
Rodney Square
1000 North King Street
Wilmington, DE 19801
(302) 571-6600
apoff@ycst.com
pkraman@ycst.com

*Attorneys for Defendants Samsung Electronics
Co., Ltd., Samsung Semiconductor, Inc.,
Samsung Electronics America, Inc., and
Samsung Austin Semiconductor, LLC*

Dated: November 25, 2020

Redacted Version: December 4, 2020

27390444.1

I, Allan M. Soobert, hereby declare the following:

1.   I am a partner with the law firm Paul Hastings LLP and am admitted to practice *pro hac vice* before this Court. I submit this declaration in support of Samsung's November 25, 2020 response to Elm's November 19, 2020 letter, seeking to compel discovery from Samsung.

2.   The facts set forth in this declaration are known to me personally. If called as a witness, I could and would testify competently concerning these matters.

3.   On March 14, 2019, Samsung served SAMSUNG-ELM-000058543. **Ex. 1**. This document listed ▮ products by "Part #" and included, *inter alia*, "CHIP THICK," ranging from ▮▮▮▮ microns. **Ex. 2** at 1-15.

4.   That same day, Samsung served its second supplemental response to Elm's Interrogatory No. 4, which asked Samsung to "[i]dentify by part number all Stacked Integrated Circuit Products that (A) are not included in the Second Amended Accused Product List served on June 3, 2016, and (B) that you (1) sell directly to an affiliate or third party, and/or (2) incorporate in products that you subsequently sell to an affiliate or a third party." **Ex. 3** at 3. Samsung's response referred "Elm to the documents bearing bates numbers SAMSUNG-ELM-000058542 – SAMSUNG-ELM-000058543," and explained that "[t]hese documents provide a revised list of all stacked silicon die packages having two or more vertically stacked die that have been sold in the United States in the period between 2007 to present and that are not included in the Second Amended Accused Product List served on June 3, 2016." **Ex. 4** at 7-8. Samsung further responded that "[t]hese documents include certain information regarding the identified packages, including the number of stacked chips . . . and die thickness," and that "[d]ie thickness

is provided separately for each die in SAMSUNG-ELM-000058543 except where otherwise indicated." *Id.* at 8.

5.   On March 19, 2019, I participated in a meet and confer with Elm, during which the parties discussed SAMSUNG-ELM-000058543 and Samsung's supplemental response to Elm's Interrogatory No. 4. Afterwards, Elm's counsel sent an email summarizing the meet and confer and acknowledged that SAMSUNG-ELM-000058543 provides "chip thickness" (or "die thickness") data for every listed product. **Ex. 5** at 1.

6.   On June 12, 2019, the Federal Circuit issued its opinion addressing Defendants' appeals of the Patent Trial and Appeal Board (PTAB)'s final written decisions in Defendants' IPRs. *See Samsung Elecs. Co., Ltd. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373 (Fed. Cir. 2019). In its opinion, the Federal Circuit construed the "substantially flexible" claim terms. *Id.* at 1376-1380 (**Ex. 6** at 4-11). The Federal Circuit's construction differed depending on whether the term "substantially flexible" modified (i) "semiconductor substrate" or (ii) "circuit layer" or other similar terms (e.g., "die," "integrated circuit layer," and "integrated circuits"):

> [W]e interpret a substantially flexible semiconductor substrate as a semiconductor substrate that is thinned to 50 μm and subsequently polished or smoothed such that it is largely able to bend without breaking. Likewise, we interpret a substantially flexible circuit layer as a circuit layer that is largely able to bend without breaking and contains a substantially flexible semiconductor substrate and a sufficiently low tensile stress dielectric material.

Id. at 1380 (**Ex. 6** at 11); *see also id.* at 1377 ("All [but two] challenged claims . . . use 'substantially flexible' in at least one of two ways. The first is to modify the term 'semiconductor substrate.' . . . 'Substantially flexible' is also used to modify 'circuit layers,' and other similar terms," including "die," "integrated circuits," and "integrated circuit layer.") **Ex. 6** at 5-6.

7.   On June 20, 2019, Elm's counsel emailed Samsung's counsel and stated the following: "In light of the Federal Circuit's recent decision, Elm currently intends to accuse of infringement all Samsung semiconductor products that contain more than one circuit layer, where at least one circuit layer is stacked above or below another circuit layer, and where at least one of the layers has a thickness of 50 microns or less." **Ex. 7** at 1.

8.   On June 25, 2019, Elm's counsel sent a followed-up email to Samsung's counsel with "some additional details about the information [it was] seeking from Samsung." **Ex. 8** at 1. The email attached a spreadsheet (**Ex. 9**) that listed, in Column D, only the products listed in SAMSUNG-ELM-000058543 that have a "CHIP THICK" of 50 μm or less. Elm's counsel explained that Column D contains "[p]ost-stay products that contain one die at 50μm or less: This lists the 50 Samsung products identified in the '42 and '43 spreadsheets as including at least one die that is 50μm or less." **Ex. 8** at 1. Elm's counsel further stated that it "would like Samsung to let us know, this week, whether Column D in the attached spreadsheet lists every Samsung semiconductor product sold from 2008 to the present that Samsung knows to contain more than one circuit layer, where at least one circuit layer is stacked above or below another circuit layer, and where at least one of the layers has a thickness of 50μm or less." *Id.*

9.   On June 25, 2019, Samsung's counsel emailed Elm's counsel that it would "forward this spreadsheet on for Samsung to review." **Ex. 10** at 1.

10.   That same day, Elm's counsel emailed Samsung's counsel and again asked for "a complete list of all stacked semiconductor products sold from 2008 to the present that Samsung knows to contain more than one circuit layer, where at least one circuit layer is stacked above or below another circuit layer, and where at least one of the layers has a thickness of 50μm or less." **Ex. 11** at 1.

11.   On July 15, 2019, Elm's counsel emailed Samsung's counsel and stated that it "fear[ed] that [it] is simply not true" that "Samsung has already provided a complete list of all stacked semiconductor products sold from 2008 to the present that Samsung knows to contain more than one circuit layer, where at least one circuit layer is stacked above or below another circuit layer, and where at least one of the layers has a thickness of 50µm or less." **Ex. 12** at 1. Elm's counsel then stated that "[w]e understand that, at least as of 2016, Samsung's phones have included an image sensor chip stacked, via TSVs, with a DRAM memory chip," and that "it is highly likely that at least one of the chips in these products has a thickness of 50µm or less." *Id.*

12.   On July 29, 2019, Elm's counsel sent an email to Samsung's counsel stating, "I sent you a list of the Samsung products we're aware of that contain at least one die at 50µm or less more than a month ago. We asked you to confirm that this list was complete or to provide a complete list, but you have failed to do so." **Ex. 56**. The next day, on July 30, 2019, Elm's counsel sent an email to Samsung's counsel that attached the same spreadsheet (**Ex. 9**) attached to Elm's June 25, 2019 email (**Ex. 8**). **Ex. 13**. In the email, Elm stated that, "[b]y the end of this week, Samsung will commit to providing US sales data for products in columns B or D in the attached spreadsheet. Samsung will produce that data within two weeks." *Id.* at 1. Elm further stated the following: "At the same time, Samsung will continue to investigate the die thickness issues. Samsung expects to provide to Elm a complete list of all multi-layer semiconductor products that contain a layer that is 50 microns or less within the next two to three weeks. Once that list is completed, Elm will promptly produce US sales data for any such products that are not listed in columns B or D in the attached spreadsheet." *Id.*

13.   On August 14, 2019, and in light of Elm's intent to broaden the case to include image sensor and V-NAND products, Samsung's counsel responded to Elm's July 15, 2019,

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