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9 Attorneys for Plaintiff and
Counterclaim-Defendant APPLE INC.

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11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN JOSE DIVISION

14
15 APPLE INC., a California corporation,

16 Plaintiff,

17 v.

18 SAMSUNG ELECTRONICS CO., LTD., a
Korean corporation; SAMSUNG
19 ELECTRONICS AMERICA, INC., a New
York corporation; and SAMSUNG
20 TELECOMMUNICATIONS AMERICA,
LLC, a Delaware limited liability company,

21 Defendants.

Case No. 11-cv-01846-LHK

**APPLE'S RESPONSE TO
SAMSUNG'S STATEMENT OF
RECENT DECISION**

1 On March 29, 2013, the USPTO issued what it terms a Final Office Action on the *Ex*
2 *Parte* Reexamination of U.S. Patent. No. 7,469,381. On April 1, Samsung submitted a Statement
3 of Recent Decision attaching a copy of that Office Action. (ECF No. 2291.) Samsung states that
4 the Office Action “finally” rejects multiple claims of the ’381 patent, but the suggestion that the
5 reexamination is finished and the USPTO has rendered a dispositive decision is incorrect.

6 A “final” office action does not signal the end of reexamination at the USPTO, much less
7 the end of consideration of the patentability of the claims under reexamination. Rather, “finality”
8 is primarily a procedural construct that limits the right to amend claims and introduce evidence as
9 a matter of right in reexamination. See 37 C.F.R. § 1.116. In *ex parte* reexaminations, a USPTO
10 examiner may designate an Office Action “final” when a rejection is presented more than once
11 (*i.e.*, a second or subsequent rejection on the merits). See 37 C.F.R. § 1.113. Apple is entitled to
12 file a response to a “final” rejection, which may result in a withdrawal of the rejection or
13 allowance/certification of the claims under reexamination. See 37 C.F.R. § 1.116. In fact, the
14 Office Action states on its face that Apple may respond within two months. (ECF No. 2291-1 at
15 4.)

16 Moreover, once the *ex parte* reexamination proceeding is concluded, Apple is entitled to
17 several appeal options. A patent owner is entitled to appeal to the Patent Trial and Appeal Board
18 (PTAB). See 35 U.S.C. § 306. Even if appeal to the PTAB is unsuccessful, Apple may seek
19 judicial review in the United States Court of Appeals for the Federal Circuit or the United States
20 District Court for the District of Columbia. See 35 U.S.C. §§ 141, 145.

21 In short, reexamination of the ’381 patent is far from conclusion.

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23 Dated: April 2, 2013

MORRISON & FOERSTER LLP

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25 By: /s/ Michael A. Jacobs
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26 Attorneys for Plaintiff
27 APPLE INC.
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