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APPLE INC.

17
18 UNITED STATES DISTRICT COURT
19 FOR THE NORTHERN DISTRICT OF CALIFORNIA
20 SAN FRANCISCO DIVISION

21 LS CABLE & SYSTEM LTD.,

22 Plaintiff,

23 v.

24 APPLE INC.,

25 Defendant.

Case No. 3:24-cv-09194-JD

**APPLE INC.'S NOTICE OF MOTION
AND MOTION TO DISMISS**

Date: April 17, 2025

Time: 10:00 a.m.

Courtroom: 11, 19th Floor

Judge: Hon. James Donato

Action Filed: December 18, 2024

Trial Date: None Yet Set

NOTICE OF MOTION

PLEASE TAKE NOTICE that on April 17, 2025, at 10:00 a.m., or as soon as the matter may be heard, in Courtroom 11, of the United States District Court of the Northern District of California, located at 450 Golden Gate Avenue, San Francisco, California 94102, Defendant Apple Inc. (“Apple”) moves to dismiss this action, in whole or in part, with prejudice under Rule 12(b)(6) of the Federal Rules of Civil Procedure.

Apple bases this Motion on this Notice of Motion, Apple’s Memorandum of Points and Authorities, the pleadings, records, and files in this action, and all other written or oral arguments or evidence that the parties may present to the Court relating to this Motion. Apple asks that the Court dismiss this action with prejudice because the sole asserted patent is invalid under 35 U.S.C. § 305, or in the alternative to dismiss Plaintiff LS Cable & System Ltd.’s (“LS Cable”) claims of induced infringement, willful infringement, and pre-suit damages.

Dated: March 10, 2025

MORRISON & FOERSTER LLP

By: /s/ Richard S.J. Hung
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MEMORANDUM OF POINTS AND AUTHORITIES**I. INTRODUCTION, BACKGROUND, AND STATEMENT OF ISSUES**

Congress did not intend for patentees to use the reexamination process to resuscitate claims *after* accused infringers reveal their patent’s non-infringed or invalid nature. The plain language of 35 U.S.C. § 305 makes this clear, explaining that “[n]o proposed amended or new claim enlarging the scope of a claim of the patent [is] permitted in a reexamination proceeding.”

But that is what happened here. LS Cable first approached Apple about U.S. Patent No. 8,013,568 (“the ’568 patent”) six years ago, in 2019. As LS Cable did not explain why it believed Apple infringed, Apple promptly requested detailed claim charts. LS Cable then delayed a year before providing a claim chart. (*See* Dkt. No. 1-3.) In response, Apple explained why that chart was wrong and provided its own chart showing how the prior art invalidated LS Cable’s patent. LS Cable then fell silent, waiting four years to contact Apple again—by filing suit.

During the intervening period, LS Cable impermissibly expanded the scope of the ’568 patent’s claims in a reexamination proceeding before the U.S. Patent Office. None of the claims that existed when LS Cable was still in contact with Apple survived the reexamination. Instead, what emerged were claims broadened in violation of Section 305. Claim 7, the only claim that the Complaint specifically identifies, exemplifies this broadening: LS Cable removed the phrase “overvoltage monitoring unit”—which encapsulates a fundamental aspect of the purported invention—and replaced it with the more generic “microprocessor.” As this impermissible broadening renders the reexamined claims invalid, LS Cable cannot state a plausible claim of infringement, and the Court should dismiss this action in its entirety under Rule 12(b)(6).

Invalidity is not the Complaint’s only defect; it also fails to sufficiently plead indirect infringement, willful infringement, and pre-suit damages. LS Cable does not plead facts establishing (1) Apple’s awareness of the amended or new claims issuing from the reexamination or (2) LS Cable’s compliance with its marking and notice obligations under 35 U.S.C. § 287(a). Accordingly, should the Court decline to dismiss LS Cable’s entire case based on its improper claim broadening, it should still dismiss LS Cable’s claims of indirect infringement, willful infringement and pre-suit damages with prejudice.

II. LEGAL STANDARD

A. Rule 12(b)(6)

“Under Rule 12(b)(6), the Court will dismiss a complaint that does not plausibly allege a claim upon which relief can be granted. The plaintiff must allege ‘enough facts to state a claim to relief that is plausible on its face.’” *BWB Co. v. Alibaba Grp. (US) Inc.*, No. 3:23-cv-05917, 2024 WL 3748340, at *2 (N.D. Cal. Aug. 8, 2024) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A claim is plausible on its face “when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

B. 35 U.S.C. § 305

“[A] violation of 35 U.S.C. § 305 is an invalidity defense in a patent infringement action.” *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584 (Fed. Cir. 1995). Section 305 provides that “[n]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding.” 35 U.S.C. § 305. A claim is broader than an original claim “if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231, 1237-38 (Fed. Cir. 2023) (cleaned up). “[W]hether claims have been enlarged is a matter of claim construction.” *Id.* at 1238. No rule bars resolving claim construction issues on a Rule 12(b)(6) motion, as the issues “may be so clear on the only point that is ultimately material to deciding the dismissal motion that no additional process is needed.” *UTTO Inc. v. Metrotech Corp.*, 119 F.4th 984, 994 (Fed. Cir. 2024).

III. ARGUMENT

A. The Complaint Does Not Plausibly Plead Infringement of a Valid Claim.

LS Cable’s Complaint alleges infringement only of claim 7. (*See* Dkt. Nos. 1, 1-4.) But claim 7 was impermissibly broadened during reexamination in violation of Section 305, rendering it invalid. The Complaint thus does not plausibly plead infringement and should be dismissed.

LS Cable’s reexamination amendments are shown below, with deletions and additions shown in red and green, respectively:

1 7. A contact-less charging circuit module electrically connected to a
 2 battery cell and used for charging an electric energy to the battery
 3 cell in a contact-less method, the contact-less charging circuit
 4 module comprising:

5 a high frequency AC current inducing unit to which a high
 6 frequency AC current is induced by ~~means of~~ a magnetic field
 7 generated from an external contact-less charging device;

8 a rectifier for receiving the induced high frequency AC current and
 9 converting the induced high frequency AC current into a DC
 10 current;

11 a constant voltage/constant current supplier ~~for~~ receiving the DC
 12 current from the rectifier and supplying a charging power to the
 13 battery cell in a constant voltage/constant current mode; and

14 ~~an overvoltage monitoring unit for~~ a *microprocessor* monitoring
 15 voltages at both ends of the constant voltage/constant current
 16 supplier and *wirelessly* transmitting a monitoring result to the
 17 external contact-less charging device ~~by means of wireless~~
 18 ~~communication~~ so as to induce a change of intensity of the
 19 magnetic field,

20 *wherein the change of intensity of the magnetic field is based on*
 21 *relative positions of the contact-less charging circuit module and*
 22 *the external contact-less charging device.*

23 (See Dkt. No. 1-1, 18.) Notably, LS Cable replaced the term “an overvoltage monitoring unit for”
 24 with “a microprocessor.” As amended, claim 7 omits any reference to “overvoltages.”

25 That original claim 7 referred to “*over*voltage monitoring,” as opposed to mere “voltage
 26 monitoring,” was not by happenstance. The ’568 patent is aimed at detecting and correcting
 27 “overvoltages,” not “voltages.” Its “Technical Field” section, for example, explains that the
 28 alleged invention “relates . . . particularly to a contact-less chargeable battery capable of solving
 an overvoltage state by means of a wireless feedback control though an overvoltage is applied to
 both ends of a circuit part that supplies a constant voltage or a constant current.” (*Id.*, 1:19-28.)
 The patent further describes its “Technical Problem” as providing a charging system “capable of
 preventing any damage of an internal battery circuit.” (*Id.*, 3:27-39.) It does so after warning that
 battery and charger misalignment can result in an “overvoltage exceeding” a standard value,
 “thereby possibly causing a damage on parts.” (*Id.*, 2:42-48.)

As part of its proposed solution to that problem, the patent describes:

- a “first voltage detector 350 and a second voltage detector 360 respectively provided

1 to front and rear ends of the constant voltage/constant current supplier 290 to *monitor*
 2 *whether an overvoltage is applied* to both ends” (*id.*, 8:32-38 (emphasis added));

- 3 • calculating “a difference value of the first and second voltages, or a state of voltages
 4 at both ends, which indicates *whether an overvoltage is applied*” (*id.*, 8:38-47); and
- 5 • using “the wireless transmitting unit 320 to transfer an adjustment request signal” if
 6 “it is *determined that an overvoltage is applied*” (*id.*, 8:48-53).

7 Removing the requirement of an “overvoltage monitoring unit” and replacing it with a
 8 “microprocessor” broadened claim 7. A hypothetical accused module illustrates this. In view of
 9 LS Cable’s amendment, a contact-less charging circuit module would infringe claim 7 even if its
 10 microprocessor were programmed to monitor exclusively *undervoltages* and to wirelessly
 11 transmit a monitoring result to the external contact-less charging device only upon detecting
 12 *undervoltages*. But that same module would not have infringed the original claims requiring an
 13 “*overvoltage* monitoring unit,” including claim 7. (*See id.*, claims 1-12, 14-16, and 21-22.)

14 Nor would this hypothetical contact-less charging circuit module have infringed any other
 15 original claim. Original claims 13-20 were directed to a “contact-less charging device,” *i.e.*, a
 16 wireless *charger*, and its components. For example, original claim 13 required a “contact-less
 17 charging device comprising” components like “a magnetic field generating unit” for “forming a
 18 magnetic field in an outer space.” (*Id.* at 15.) This “contact-less charging device” is the charger
 19 in a wireless charging system, whereas the “contact-less charging circuit module” of amended
 20 claim 7 (and the hypothetical module described above) are part of the device being charged. A
 21 module of a device being charged wirelessly does not include the charger.

22 Similarly, claims 23 and 24 recite method steps performed in the charger, such as
 23 “intermittently applying a high frequency AC current to a primary coil provided to the charging
 24 device” (*i.e.*, charger). (*Id.*) As part of the device being charged (not the charger), the
 25 hypothetical module would not satisfy these *charger-side* claim limitations.

26 Thus, because claim 7 “contains within its scope [a] conceivable apparatus . . . [that]
 27 would not have infringed the original patent,” it was broadened during reexamination and is
 28 invalid. *Sisvel*, 81 F.4th at 1237-38; *Quantum Corp.*, 65 F.3d at 1584. The situation here

parallels that in *Advanced Media Networks, LLC v. AT&T Mobility LLC*. There, the district court invalidated the asserted patent under Section 305 based on the patentee’s replacement of “ethernet packet switching protocol” with “internet protocol.” 748 F. App’x 308, 316 (Fed. Cir. 2018). Affirming, the Federal Circuit agreed that substitution of “internet protocol” for “ethernet packet switching protocol” deleted requirements (*e.g.*, the use of the IEEE 802.3 or draft 802.11 standard) and thus impermissibly broadened the scope of the claims. *Id.* Similarly, here the substitution of “microprocessor” for “overvoltage monitoring unit” deletes requirements (*e.g.*, overvoltage monitoring). The Court should invalidate claim 7, the only identified claim in the Complaint, and dismiss this action in its entirety.

B. The Complaint Does Not Plausibly Plead Induced Infringement.

Separately and independently, LS Cable has failed to plead its induced infringement claim with plausibility. Induced infringement requires “[k]nowledge of the patent in question and knowledge that the induced acts infringe the patent.” *Caterpillar Prodotti Stradali S.R.L. v. Int’l Trade Comm’n*, 847 F. App’x 893, 898 (Fed. Cir. 2021) (citing *Commil USA, LLC v. Cisco Systems, Inc.*, 575 U.S. 632, 639 (2015)). But LS Cable does not plead facts supporting an inference that Apple even knew the amended claims of the ’568 patent existed, let alone that it was inducing acts infringing any of those claims.

All of LS Cable’s alleged facts concerning Apple’s knowledge of the ’568 patent predate the reexamination proceedings. Specifically, LS Cable alleges that (1) “[o]n or about March 2019,” it “sent Apple a letter notifying Apple that Apple’s products with wireless charging capabilities infringed LS Cable’s intellectual property, citing specific LS Cable patents (including the ’568 Patent)” (Dkt. No. 1 ¶ 33); and (2) LS Cable “continued to communicate directly with Apple about” its “potential infringing activity” and “provided Apple a claim chart outlining Apple’s infringement in early 2020” (*id.* ¶ 34).

Those alleged discussions—and any knowledge Apple could have gleaned from them—involved claims of the ’568 patent that no longer exist. The new or amended claims that emerged from the 2023 reexamination are substantially different from those LS Cable identified to Apple in 2019 or 2020. For example, every claim now requires adjusting a magnetic field based on the

1 relative positions of two devices, which no original claim required.¹ (*See* Dkt. 1-1, 18-22.)

2 The Complaint’s allegations as to Apple’s pre-reexamination knowledge thus fail to
3 support an inference that Apple knew it was inducing infringement of the present ’568 patent
4 claims. *See Sentius Int’l, LLC v. Microsoft Corp.*, 78 F. Supp. 3d 967, 975 (N.D. Cal. 2015)
5 (defendant’s knowledge of predecessor to reissue patent insufficient for knowledge of reissue
6 patent); *MONEC Holding AG v. Motorola Mobility, Inc.*, 897 F. Supp. 2d 225, 233 (D. Del. 2012)
7 (dismissing indirect infringement claim where plaintiff attempted to “equat[e] knowledge of the
8 ’678 patent with actual knowledge of the patent-in-suit, the reexamined ’678 patent”). As the
9 Complaint is silent on Apple’s knowledge of the *post-reexamination* patent, the Court should
10 dismiss LS Cable’s induced infringement claim.

11 C. The Complaint Does Not Plausibly Plead Willful Infringement.

12 For similar reasons, Apple asks that the Court dismiss LS Cable’s willful infringement
13 claim. “Since *Halo*, courts in this District have required willful infringement claims to show both
14 knowledge of the patents and egregious conduct in order to survive a motion to dismiss.” *Google*
15 *LLC v. Princeps Interface Techs. LLC*, No. 19-cv-06566, 2020 WL 1478352, at *2 (N.D. Cal.
16 Mar. 26, 2020) (cleaned up). Willfulness claims must be based on *pre-suit* knowledge of the
17 patent and its infringement. *VLSI Tech. LLC v. Intel Corp.*, 706 F. Supp. 3d 953, 996 (N.D. Cal.
18 2023) (granting summary judgment of no willful infringement due to lack of pre-suit knowledge);
19 *CAP Co. v. McAfee, Inc.*, No. 14-cv-05068, 2015 WL 3945875, at *3 (N.D. Cal. June 26, 2015)
20 (Donato, J.) (dismissing willfulness claims where pre-suit knowledge was not alleged).

21 In view of its complete silence as to Apple’s knowledge of the reexamination proceedings
22 or the resulting changes to the ’568 patent, the Complaint does not allow a plausible inference
23 that Apple even knew of any alleged infringement of the post-reexamination claims, let alone
24 behaved egregiously. Dismissal thus is warranted. *See CAO Lighting, Inc. v. Gen. Elec. Co.*, No.
25 20-cv-681, 2023 WL 387585, at *2 (D. Del. Jan. 25, 2023) (emphasis added) (willfulness was
26

27 ¹ To be clear, that some of LS Cable’s amendments may have narrowed the claims does not
28 indicate compliance with Section 305. *See Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183
F.3d 1369, 1374 (Fed. Cir. 1999) (a claim “that is broader in any respect is considered to be
broader than the original claims even though it may be narrower in other respects”).

1 inadequately pled where complaint did not “plausibly allege the defendants knew or should have
 2 known they infringed the patent *as it existed after the reexamination* or why the patent
 3 changed”); *see also Fortinet, Inc. v. Forescout Techs., Inc.*, 543 F. Supp. 3d 814, 842-43 (N.D.
 4 Cal. 2021) (dismissing willfulness where complaint alleged “run-of-the-mill patent dispute” facts
 5 about how patentee had engaged accused infringer in pre-suit licensing discussions); *Google*,
 6 2020 WL 1478352, at *3 (dismissing willfulness where patentee “allege[d] no particular facts
 7 establishing egregious conduct”).

8 **D. The Complaint Does Not Plausibly Plead Entitlement to Pre-Suit Damages.**

9 Under Section 287(a), if a patentee who “mak[es], offer[s] for sale, or sell[s] within the
 10 United States any patented article” fails to mark the patented article with the number of the
 11 patent, “damages may be recovered only for infringement occurring after” the patentee gave
 12 actual notice of infringement to the accused infringer. 35 U.S.C. § 287(a). “The patentee bears
 13 the burden of pleading” compliance with Section 287(a). *Arctic Cat Inc. v. Bombardier*
 14 *Recreational Prods. Inc.*, 876 F.3d 1350, 1366 (Fed. Cir. 2017). That is true even where the
 15 patentee contends that there were no products to mark. *See Express Mobile, Inc. v. Liquid Web,*
 16 *LLC*, No. 1:18-cv-01177, 2019 WL 1596999, at *2 (D. Del. Apr. 15, 2019) (dismissing past
 17 damages claim because “[a] claim for past damages requires pleading compliance with the
 18 marking statute—even when compliance is achieved, factually, by doing nothing at all”).

19 Section 287(a) applies because LS Cable alleges that, by selling products that infringe
 20 apparatus claim 7, Apple “unfairly competes with LS Cable . . . throughout the United States.”
 21 (Dkt. No. 1 ¶ 21.) But the Complaint makes no mention of Section 287(a) or marking.
 22 LS Cable’s allegations that it notified Apple of infringement in 2019 or 2020 cannot carry its
 23 burden, as that notice was *pre-reexamination* and pertained to claims that no longer exist. *CAO*
 24 *Lighting* is instructive. In *CAO Lighting*, the complaint alleged that the defendant had
 25 (1) previously been sued on the same patent and (2) was aware of the subsequent reexamination
 26 proceeding that resulted in the asserted claims. *See* 2023 WL 387585, at *2. But these
 27 allegations at most suggested that the defendant had notice “that new claims had been added”—
 28 and not that it “infringed the patent as it existed after the reexamination.” *Id.* The court therefore

1 held that the plaintiff failed to plead compliance with Section 287(a). *Id.* at *3-4. Here,
2 LS Cable's pleading is even weaker: It does not even allege that Apple was aware of the
3 reexamination proceeding, let alone establish notice to Apple that it infringed the resulting claims.
4 The Court therefore also should dismiss LS Cable's pre-suit damages claim.

5 **IV. CONCLUSION**

6 LS Cable's improper broadening of asserted claim 7 during reexamination renders that
7 claim invalid and warrants dismissing this action with prejudice. But if the Court does not
8 dismiss the action outright, it should at minimum dismiss LS Cable's inducement, willfulness,
9 and pre-suit damages claims with prejudice because LS Cable has not pled Apple's pre-suit
10 knowledge of the reexamined claims or LS Cable's compliance with the marking statute.

11 Dated: March 10, 2025

MORRISON & FOERSTER LLP

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16 APPLE INC.