

1 JOHN ALLCOCK (Bar No. 98895)
john.allcock@dlapiper.com
2 SEAN C. CUNNINGHAM (Bar No.
174931)
3 sean.cunningham@dlapiper.com
4 ERIN GIBSON (Bar No. 229305)
erin.gibson@dlapiper.com
5 ROBERT WILLIAMS (Bar No. 246990)
robert.williams@dlapiper.com
6 TIFFANY MILLER (Bar No. 246987)
tiffany.miller@dlapiper.com
7 JACOB ANDERSON (Bar No. 265768)
jacob.anderson@dlapiper.com
8 DLA PIPER LLP (US)
401 B Street, Suite 1700
San Diego, California 92101-4297
9 Tel: 619.699.2700
Fax: 619.699.2701

10 ROBERT BUERGI (Bar No. 242910)
robert.buergi@dlapiper.com
11 AMY WALTERS (Bar No. 286022)
amy.walters@dlapiper.com
12 DLA PIPER LLP (US)
2000 University Avenue
13 East Palo Alto, CA 94303-2215
14 Telephone: 650.833.2000
Facsimile: 650.833.2001

15 Attorneys for Plaintiff
16 APPLE INC.

17 UNITED STATES DISTRICT COURT
18 SOUTHERN DISTRICT OF CALIFORNIA

19 APPLE INC.,
20 Plaintiff,
21 v.
22 WI-LAN, INC.,
23 Defendant.

MARK C. SCARSI (Bar No.
183926)
mscarsi@milbank.com
ASHLEE N. LIN (Bar No.
275267)
anlin@milbank.com
MILBANK, TWEED, HADLEY
& MCCLOY LLP
2029 Century Park East, 33rd Floor
Los Angeles, CA 90067
Tel: 424.386.4000
Fax: 213.629.5063

CHRISTOPHER J. GASPAR
(admitted pro hac vice)
cgaspar@milbank.com
MILBANK, TWEED, HADLEY
& MCCLOY LLP
28 Liberty Street
New York, NY 10005
Tel: 212.530.5000
Fax: 212.822.5019

CASE NO. 3:14-cv-02235-DMS-BLM
(lead case);
CASE NO. 3:14-cv-1507-DMS-BLM
(consolidated)

**PLAINTIFF APPLE INC.'S
RESPONSIVE CLAIM
CONSTRUCTION BRIEF**

Dept: 13A
Judge: Hon. Dana M. Sabraw
Magistrate Judge: Hon. Barbara L. Major

26 AND RELATED
27 COUNTERCLAIMS

28 WEST\278478978.2

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS

Page

I. COLLATERAL ESTOPPEL DOES NOT APPLY 1

II. THE COURT SHOULD ADOPT APPLE’S CONSTRUCTIONS..... 3

 A. Subscriber Station Terms (’145, ’723, ’761, ’020, ’757 Patents)..... 3

 B. Connection Terms (’145, ’723, ’761, ’020 and ’757 Patents) 6

 C. “QoS” (’145 and ’723 Patents) 9

 D. “queue(s)” (’145, ’723, ’761, ’020 Patents)..... 10

 E. “packing sub-header” (’040 Patent)..... 10

 F. “frame map” / “sub-frame map” (’020, ’723, ’757 Patents)..... 12

 G. “poll-me bit” / “poll-me message” (’020 Patent) 13

 H. The Preamble of Claim 26 of the ’145 Patent Is Limiting 14

 I. “fairness algorithm” (’145 Patent) 15

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES

Page

CASES

Abbott Labs. v. Sandoz, Inc.,
544 F.3d 1341 (Fed. Cir. 2008) 10, 11, 15

Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.,
289 F.3d 801 (Fed. Cir. 2002) 14

Davis & Cox v. Summa Corp.,
751 F.2d 1507 (9th Cir. 1985), *superseded by statute on other
grounds as stated in Northrop Corp. v. Triad Int’l Mktg. S.A.*, 842
F.2d 1154 (9th Cir. 1988) 1

e.Digital Corp. v. Futurewei Techs. Inc.,
772 F.3d 723 (Fed. Cir. 2014) 1, 6, 9

e.Digital Corp. v. Huawei Tech.,
No. 3:13-cv-783-DMS (S.D. Cal. Aug. 21, 2013) 3

Elektta Instrument S.A. v. O.U.R. Sci. Int’l, Inc.,
214 F.3d 1302 (Fed. Cir. 2000) 14

Eli Lilly & Co. v. Barr Labs., Inc.,
251 F.3d 955 (Fed. Cir. 2001) 11

Elkay Mfg. Co. v. Ebco Mfg. Co.,
192 F.3d 973 (Fed. Cir. 1999) 4, 5

G.D. Searle LLC v. Lupin Pharms. Inc.,
790 F.3d 1349 (Fed. Cir. 2015) 11

Gen. Elec. Co. v. Nintendo Co., Ltd.,
179 F.3d 1350 (Fed. Cir. 1999) 15

Gilead Scis. Inc. v. Natco Pharma Ltd.,
753 F.3d 1208 (Fed. Cir. 2014) 11

Hydranautics v. FilmTec Corp.,
204 F.3d 880 (9th Cir. 2000) 1, 2

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF AUTHORITIES
(Cont.)

Page

Int'l Gamco Inc., v. Multimedia Games Inc.,
732 F. Supp. 2d 1082, 1089-92 (S.D. Cal. Aug. 11, 2010)..... 2

Mallinckrodt, Inc. v. Masimo Corp.,
254 F.Supp.2d 1140 (C.D. Cal. 2003)..... 7

Offshore Sportswear, Inc. v. Vuarnet Int'l, B.V.,
114 F.3d 848 (9th Cir. 1997) 1

Palmchip Corp. v. Ralink Tech. Corp.,
No. 13-cv-1567, 2014 WL 12585805 (C.D. Cal. Dec. 29, 2014)..... 14

Wang Labs., Inc. v. Am. Online, Inc.,
197 F.3d 1377 (Fed. Cir. 1999) 9

Wi-LAN USA, Inc. v. Apple Inc.,
830 F.3d 1374 (Fed. Cir. 2016) 5



1 Ensemble, not Wi-LAN, purportedly invented elements of a fixed/portable
2 wireless communication system embodied in the circa-2001 IEEE 802.16 (“Wi-
3 MAX”) standard. That is the extent of the patents-in-suit. The patents-in-suit do
4 not relate to the similarly named, much later-developed “4G Wi-MAX,” embodied
5 in IEEE 802.16m, or to any other mobile communication system or standard.

6 **I. COLLATERAL ESTOPPEL DOES NOT APPLY.**

7 Apple’s claim construction positions are not estopped by this Court’s
8 decisions in 13-cv-798 (“the -798 case”) decided in 2013. Contrary to Wi-LAN’s
9 claim, this Court previously construed only one of the nine disputed terms
10 (“packing sub-header”), but collateral estoppel does not apply to that term either.
11 “Collateral estoppel applies if: (1) the issue necessarily decided in the previous
12 proceeding is identical to the one which is sought to be relitigated; (2) the first
13 proceeding ended with a final judgment on the merits; and (3) the party against
14 which collateral estoppel is asserted was a party or in privity with a party at the first
15 proceeding.” *e.Digital Corp. v. Futurewei Techs. Inc.*, 772 F.3d 723, 726 (Fed. Cir.
16 2014) (citing *Hydranautics v. FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000).
17 “The party asserting preclusion bears the burden of showing with clarity and
18 certainty what was determined by the prior judgment.” *Offshore Sportswear, Inc. v.*
19 *Vuarnet Int’l, B.V.*, 114 F.3d 848, 850 (9th Cir. 1997). “If there is doubt, however,
20 collateral estoppel will not be applied.” *Davis & Cox v. Summa Corp.*, 751 F.2d
21 1507, 1518 (9th Cir. 1985), *superseded by statute on other grounds as stated in*
22 *Northrop Corp. v. Triad Int’l Mktg. S.A.*, 842 F.2d 1154 (9th Cir. 1988). Even
23 where the requirements for collateral estoppel are met, the Court has discretion not
24 to apply the doctrine. *Id.* at 1519.

25 Here, Wi-LAN cannot meet the requirements of collateral estoppel because
26 none of the claim construction issues before the court are “identical” issues that
27 were “necessarily decided” in the -798 case. The -798 case involved the ’040 and
28 ’640 Patents, which the Court found were not infringed. *See -798 case, Dkt. Nos.*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.