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9 *Wi-LAN Inc.*

10 **UNITED STATES DISTRICT COURT**
11 **SOUTHERN DISTRICT OF CALIFORNIA**

12 APPLE INC.,

13 *Plaintiff,*

14 vs.

15 WI-LAN INC.,

16 *Defendant.*

17 _____
18 WI-LAN INC.,

19 *Plaintiff,*

20 vs.

21 APPLE INC.,

22 *Defendant.*

23) No. 3:14-cv-2235-DMS-BLM (Lead
24) Case); Consolidated with 3:14-cv-01507-
25) DMS-BLM
26) DEMAND FOR JURY TRIAL

27) **MEMORANDUM OF POINTS AND**
28) **AUTHORITIES IN SUPPORT OF**
29) **DEFENDANT WI-LAN INC.’S**
30) **MOTION TO STRIKE APPLE INC.’S**
31) **AMENDED INVALIDITY**
32) **CONTENTIONS**

33) **Department: 13A**
34) **Judge: Hon. Dana M. Sabraw**
35) **Magistrate: Hon. Barbara L. Major**

36) **Hearing Date: February 9, 2018**
37) **Time: 10:00 a.m.**

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1 **I. INTRODUCTION**

2 Wi-LAN respectfully requests that the Court strike Apple's Amended
3 Invalidation Contentions Pursuant to Patent Local Rules 3.3, 3.4, and 3.6, served
4 January 2, 2018. Apple's amended contentions, served ten days prior to the close of
5 fact discovery and barely a month before expert reports must be completed, would
6 cause undue prejudice to Wi-LAN because they contain dozens of new alleged prior
7 art references and numerous new claim charts. Further, these invalidity contentions
8 do not meet Patent Local Rule 3.6's requirements for serving amended contentions
9 because they were not served in response to amended infringement contentions, an
10 unanticipated claim construction, or a motion granted by the Court.

11 **II. STATEMENT OF RELEVANT FACTS**

12 On June 19, 2014, Apple filed this declaratory judgment action against Wi-
13 LAN. On January 12, 2015, Wi-LAN served its original infringement contentions,
14 followed by amended infringement contentions on May 15, 2017, and
15 August 10, 2017. On June 29, 2017, Apple served its Invalidation Contentions on Wi-
16 LAN. On November 13, 2017, the Court issued its claim construction order, in
17 which Apple prevailed on one issue and in which the Court otherwise largely
18 adopted the same constructions already adopted in prior litigation between Apple
19 and Wi-LAN.

20 On January 2, 2018, barely a month before expert reports are due on
21 February 8, 2018, Apple served its Amended Invalidation Contentions on Wi-LAN,
22 adding indefiniteness charts and 29 new alleged prior art references not disclosed in
23 Apple's original invalidity contentions.

24 Pursuant to the Court's May 15, 2017 Amended Case Management Order,
25 expert disclosures were required to be served by November 10, 2017, expert reports
26 are due by February 8, 2018, and expert discovery must be completed by
27
28

1 April 9, 2018. The deadline for dispositive motions in this matter is April 23, 2018,
2 and trial is set for July 23, 2018.

3 Apple's amended invalidity contentions add a significant number of new
4 alleged prior art references disclosed for the first time. These include seven new
5 patent references (*compare* Ex. A 4–5 with Ex. B 4–6 (adding the Chuah '675
6 Application, the Tiedemann patent, and the five patents that follow the Tiedemann
7 patent)) and twenty-two new non-patent references (*compare* Ex. A 5–7 with Ex. B
8 6–10 (adding the Karn reference on page 8 of Exhibit B and all 21 references
9 thereafter)). Moreover, eight new claim charts are included. McNett Decl. ¶ 4, Exs.
10 C–J. At least eleven other claim charts have been modified, most of them adding
11 over ten pages of new material each and referencing newly cited alleged prior art.
12 McNett Decl. ¶¶ 5–6, Ex. K. In total, Apple's amendments add 29 new references
13 and eight new claim charts, and extensively modify at least eleven other charts.

14 **III. ARGUMENT**

15 In the Southern District of California, amendments to a party's invalidity
16 contentions are governed by Patent Local Rule 3.6(b). That rule provides: "As a
17 matter of right, a party opposing a claim of patent infringement may serve "Amended
18 Invalidity Contentions" no later than the completion of claim construction
19 discovery." P.L.R. 3.6(b). "Thereafter, absent undue prejudice to the opposing
20 party, a party opposing infringement may only amend its validity contentions" under
21 three specific circumstances. *Id.* Apple's amended contentions should be stricken
22 both because they are unduly prejudicial to Wi-LAN and because none of those three
23 circumstances are met.

24 **A. Allowing Amendment at This Late Stage Would Cause Wi-LAN 25 Undue Prejudice.**

26 A party may only amend its invalidity contentions "absent undue prejudice to
27 the opposing party." P.L.R. 3.6(b); *Zest IP Holdings, LLC v. Implant Direct Mfg.*

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