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17 UNITED STATES DISTRICT COURT
18 SOUTHERN DISTRICT OF CALIFORNIA

19 APPLE INC.,
20 Plaintiff,
21 v.
22 WI-LAN, INC.,
23 Defendant.
24
25 AND RELATED
26 COUNTERCLAIMS

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

**PLAINTIFF APPLE INC.'S
SUPPLEMENTAL BRIEF
REGARDING DEFENDANT
WI-LAN, INC.'S MOTION TO STRIKE
APPLE'S AMENDED INVALIDITY
CONTENTIONS**

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

1 Pursuant to the Court’s February 13, 2018 order (Dkt. No. 290), Plaintiff
2 Apple Inc. (“Apple”) submits this supplemental brief regarding Defendant Wi-
3 LAN, Inc.’s (“Wi-LAN”) motion to strike Apple’s amended invalidity contentions.

4 **I. ARGUMENT**

5 Even if the recently revised Patent Local Rule 3.6(b)(2) were applied
6 retroactively, Apple’s amendments to its invalidity contentions were necessitated
7 by the Court’s Claim Construction ruling, as demonstrated below.

8 **A. Apple’s Further Citations To The Chuah Prior Art Reference And**
9 **Its Combination With Sau (’145, ’723, ’761 and ’020 Patents).**

10 Apple disclosed both the Chuah and Sau prior art references and provided
11 claim charts for the Chuah prior art reference in its original invalidity contentions.
12 In its amended invalidity contentions, Apple provided further citations to Chuah
13 and Chuah combined with Sau. Apple’s further citations to Chuah and its
14 combination with Sau were necessitated by the Court’s claim constructions.

15 The Court’s construction of the “subscriber” terms differed from Apple’s
16 proposed construction by allowing the subscriber station/unit to be a “module”
17 rather than limiting it to customer premises equipment, and the Court’s construction
18 of the “connections” terms differed from Apple’s proposed construction by
19 allowing connections to things other than user devices. Dkt. No. 203 at 5-8. The
20 Court’s constructions resulted in Chuah disclosing these claim terms in ways that it
21 had not under Apple’s proposed constructions. For example, Chuah’s “remote
22 node” by itself, without attached user devices, now discloses the “subscriber”
23 terms. Thus, Apple added further citations to its Chuah claim charts to show how
24 Chuah further discloses these claim terms and related limitations, as required by
25 Patent L.R. 3.3(c) (requiring “identifying where specifically in each alleged item of
26 prior art each element of each asserted claim is found”).¹

27 _____
28 ¹ Almost every limitation of the Bandwidth Patents includes one of the “subscriber”
terms.

1 Also, the Court’s construction of “queue(s)” differed from Apple’s proposed
2 construction by not including the requirement that each queue be “associated with a
3 unique QoS.” Dkt. No. 203 at 8-9. The Court’s construction made each of Sau’s
4 disclosed queues a “queue” of the asserted claims where previously Sau’s “deadline
5 queue” would have not been a “queue” under Apple’s proposed construction
6 because it is not associated with a unique QoS. Thus, Apple amended its invalidity
7 contentions to identify how this combination of prior art now discloses the “queue”
8 limitations, as required by Patent L.R. 3.3(b) and (c).

9 **B. Apple’s Additions Of Background Prior Art.**

10 In its amended invalidity contentions, Apple added certain references to its
11 cover pleading to show, for example, the state of the prior art. These additions
12 were necessitated by the Court’s claim constructions. The Court’s constructions of
13 the “subscriber” terms and the “connections” terms expanded the scope of relevant
14 prior art by rejecting Apple’s position that the claims require three devices. Dkt.
15 No. 203 at 5-8. The additional background art shows that different prior art
16 inventors had already solved, in two-device systems, the purported problems
17 addressed by the asserted patents. Although the Patent Local Rules do not require
18 disclosing background art in invalidity contentions, Apple did so as a courtesy to
19 Wi-LAN, and the inclusion of the new background references was necessary to
20 show the state of the relevant art in light of the Court’s claim constructions.

21 **C. Apple’s Further Citations To The Klayman And Ericsson Prior**
22 **Art References And The Combination Of Ericsson With The**
23 **Ericsson IP Traffic Prior Art Reference (’757 Patent).**

24 Apple disclosed the Klayman and Ericsson prior art references and included
25 claim charts for these references in its original invalidity contentions. Apple’s
26 original claim chart for the Ericsson reference also included excerpts from the
27 Ericsson “IP Traffic” prior art reference. In its amended invalidity contentions,
28 Apple provided further citations to the Klayman, Ericsson and Ericsson IP Traffic

1 references, as well as Ericsson combined with Ericsson IP Traffic. Apple's further
2 citations were necessitated by the Court's claim constructions.

3 The Court's construction of the "subscriber station" term differed from
4 Apple's proposed construction by allowing the subscriber station to be a "module"
5 rather than limiting it to customer premises equipment, and by allowing
6 "connections" to things other than user devices. Dkt. No. 203 at 5-7. The Court's
7 constructions resulted in Klayman, Ericsson, and Ericsson IP Traffic disclosing
8 these claim terms in ways that they had not under Apple's proposed constructions.
9 For example, Ericsson's "mobile station" by itself, without attached user devices,
10 now discloses the "subscriber" terms. Similarly, Klayman's "secondary station"
11 and Ericsson IP Traffic's "mobile station," by themselves, without attached user
12 devices now disclose these limitations. Thus, Apple added further citations to its
13 Klayman and Ericsson claim charts to show how Klayman, Ericsson and Ericsson
14 IP Traffic further disclose these claim terms and related limitations.

15 **D. Apple's Further Citations To The Doshi, Calvignac And GSM**
16 **Prior Art References And The Combination Of Doshi With The**
17 **Calvignac Prior Art Reference ('040 Patent).**

18 Apple disclosed the GSM, Doshi and Calvignac prior art references and
19 included claim charts for each of these references in its original invalidity
20 contentions. In its amended invalidity contentions, Apple provided further citations
21 to each of these references and the combination of Doshi and Calvignac. Apple's
22 further citations were necessitated by the Court's claim constructions.

23 The Court's construction of "packing subheader" differed from Apple's
24 proposed construction by allowing the packing subheader to be located anywhere in
25 the PDU, rather than being located only in the PDU payload. Dkt. No. 203 at 9.
26 The Court's constructions resulted in GSM, Doshi and Calvignac disclosing these
27 claim terms in ways that they had not under Apple's proposed constructions. For
28 example, components of Doshi's "ADAPT VL PDU" header now disclose the

1 claimed packing subheader, because the packing subheader was no longer required
 2 to reside in the PDU payload. Similarly, components of Calvignac’s “cell header”
 3 or GSM’s “RLC PDU header” now disclose the packing subheader. Thus, Apple
 4 added further citations to its GSM, Doshi and Calvignac charts to show how these
 5 references and the combination of Doshi and Calvignac disclose these claim terms
 6 and related limitations, as required by Patent L.R. 3.3(c).

7 **E. Apple’s Additional Claim Chart For The UMTS Prior Art**
 8 **Reference (’040 Patent).**

9 Apple’s new claim chart for the UMTS prior art reference was necessitated
 10 by the Court’s claim construction order. As discussed above, the Court’s
 11 construction of “packing subheader” was broader than the construction proposed by
 12 Apple. Dkt. No. 203 at 9. Following the claim construction order, Apple
 13 conducted additional prior art searching and analysis to identify prior art that
 14 disclosed a “packing subheader” under the Court’s broader construction.

15 As a result of this further prior art searching and analysis, Apple identified
 16 the UMTS reference, which discloses a “packing subheader” under the Court’s
 17 construction, but not under Apple’s construction. Specifically, UMTS discloses an
 18 “RLC PDU” comprising a header and a payload, where packing subheader(s) may
 19 be located in the RLC PDU header (as opposed to the payload). Thus, Apple added
 20 a new claim chart to show how this reference anticipates and/or renders obvious the
 21 asserted claims, as contemplated by Patent Local Rule 3.6(b).²

22 ////

23 ////

24 _____
 25 ² Notably, courts have routinely found good cause to amend invalidity contentions
 26 adding new prior art references when the court issues a construction different from
 27 that proposed by a party and the newly discovered prior art references satisfy the
 28 court’s claim construction but not the one advanced by the party. *See, e.g., Network
 Prot. Sci., LLC v. Fortinet, Inc.*, No. C 12-01106 WHA, 2013 WL 1949051 at *2-4
 (N.D. Cal. May 9, 2013); *Positive Tech., Inc. v. Sony Elec., Inc.*, No. C 11-2226 SI,
 2013 WL 322556 at *2-4 (N.D. Cal. Jan. 28, 2013).

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