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

APPLE INC.,

Plaintiff,

vs.

WI-LAN INC.,

Defendant.

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

**DEFENDANT WI-LAN INC.'S
OPPOSITION TO APPLE INC.'S
MOTION FOR LEAVE TO AMEND
APPLE'S INVALIDITY
CONTENTIONS**

WI-LAN INC.,

Plaintiff,

vs.

APPLE INC.,

Defendant.

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

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11
12
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14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS

I. INTRODUCTION.....1

II. BACKGROUND.....1

III. ARGUMENT.....3

 A. Wi-LAN’s Patents Are Entitled to a Priority Date of 1999.3

 1. Overview of Priority Claims3

 2. The ’518 Application’s Amended Specification Did Not Break the Chain
of Priority6

 B. The ’561 Application Was A “Continuation” of the ’518 Application.....8

 C. Wi-LAN Complied With Patent L.R. 3.2(a) and 3.1(f).9

 D. Apple Should Not Be Granted Leave To Amend At This Late Date.....10

IV. CONCLUSION.....12

TABLE OF AUTHORITIES

Page(s)

Cases

Biax Corp. v. NVIDIA Corp.,
 No. 09-cv-01257-PAB-MEH, 2011 U.S. Dist. LEXIS 34744 (D.
 Colo. Mar. 30, 2011).....6

Endo Pharms., Inc. v. Actavis, Inc.,
 746 F.3d 1371 (Fed. Cir. 2014)4

Lemelson v. TRW, Inc.,
 760 F.2d 1254 (Fed. Cir. 1985)*passim*

Lockwood v. Am. Airlines,
 107 F.3d 1565 (Fed. Cir. 1997)5

O2 Micro Int’l, Ltd. v. Monolithic Power Sys.,
 467 F.3d 1355 (Fed. Cir. 2006)10, 11

PowerOasis, Inc. v. T-Mobile USA, Inc.,
 522 F.3d 1299 (Fed. Cir. 2008)4

Sampson v. Ampex Corp.,
 335 F. Supp. 242 (S.D.N.Y. 1971)6

Synopsys Inc. v. Mentor Graphics Corp.,
 No. C-12-06467-MMC (DMR), 2014 U.S. Dist. LEXIS 51445
 (N.D. Cal. Apr. 14, 2014)11

Tech. Props. Ltd. LLC v. Canon Inc.,
 No. 14-cv-03640-CW (DMR), 2016 U.S. Dist. LEXIS 52416
 (N.D. Cal. Apr. 19, 2016)1, 11

Transco Products Inc. v. Performance Contracting, Inc.,
 38 F.3d 551 (Fed. Cir. 1994)4

Wi-LAN USA, Inc. v. Apple Inc.,
 No. 3:13-cv-00798-DMS-BLM (S.D. Cal.)10

Statutes

1

2 35 U.S.C. § 112.....5

3 35 U.S.C. § 120.....4, 5, 9

Other Authorities

4

5 37 C.F.R. § 1.53(d)(2).....7

6 37 C.F.R. § 1.76(b)(5).....5

7

8 37 C.F.R. § 1.784, 5

9 37 C.F.R. § 1.1212, 7, 8, 9

10 37 C.F.R. § 1.1256, 7, 8, 9

11 L.R. 3.1(f).....9, 10

12 L.R. 3.2(a)9

13 M.P.E.P. § 608.01(q).....6

14 M.P.E.P. § 201.074, 9

15 M.P.E.P. § 201.084

16 M.P.E.P. § 211.059

17

18

19

20

21

22

23

24

25

26

27

28

I. INTRODUCTION

The Court should deny Apple's request for leave to amend its invalidity contentions. When Wi-LAN's predecessor, Ensemble, amended the specification in its parent patent application, it did not cause a break in the priority chain. Tellingly, Apple provides no case law to support its proposition that an amended specification causes a previously filed continuation application (or its children) to lose priority claims. And Apple's theory is contrary to statutes and regulations stating that priority is claimed to an *application* and that application's *filing date*, not to the patent that ultimately issues from that application. Indeed, the Federal Circuit rejected Apple's theory in *Lemelson v. TRW, Inc.*, 760 F.2d 1254 (Fed. Cir. 1985). Thus, Apple's proposed amendment, which adds only references that are not in fact prior art because they postdate Wi-LAN's priority date, is futile and should be denied. *See Tech. Props. Ltd. LLC v. Canon Inc.*, No. 14-cv-03640-CW (DMR), 2016 U.S. Dist. LEXIS 52416, at *10 (N.D. Cal. Apr. 19, 2016) (considering relevance of new prior art when denying motion for leave to amend invalidity contentions). Further, Wi-LAN's representations have been accurate, and allowing amendments to Apple's invalidity contentions at this late stage would unduly prejudice Wi-LAN.¹

II. BACKGROUND

On May 21, 1999, Wi-LAN's predecessor, Ensemble Communications, filed Application No. 09/316,518 ("the '518 Application"). On May 16, 2001,

¹ This maneuver is Apple's second attempt to add invalidity contentions it should have added long ago. *See Mot. to Strike Am. Invalidity Contentions*, ECF No. 258.

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