

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

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

14 Attorneys for Plaintiff
15 APPLE INC.

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

16 UNITED STATES DISTRICT COURT
17 SOUTHERN DISTRICT OF CALIFORNIA

18 APPLE INC.,
19 Plaintiff,

20 v.

21 WI-LAN, INC.,
22 Defendant.

23 AND RELATED
24 COUNTERCLAIMS

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

**APPLE INC.'S MEMORANDUM OF
POINTS AND AUTHORITIES IN
SUPPORT OF ITS MOTION FOR
PARTIAL RECONSIDERATION AND
CLARIFICATION OF ORDER
STRIKING APPLE'S AMENDED
INVALIDITY CONTENTIONS
[DOCKET NO. 297]**

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

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1 **I. INTRODUCTION**

2 Apple moves for partial reconsideration of the Court’s Order striking Apple’s
3 amended invalidity contentions (Dkt. No. 297, hereafter “the Order”) as to the
4 UMTS and Carvalho references, because the Court’s decision in *In Re: Ameranth*
5 *Cases* yesterday (“the *Ameranth* Order”) compels a different decision on Wi-LAN’s
6 motion to strike. In the *Ameranth* Order, the Court correctly held that: (1) Patent
7 Local Rule 3.6.b.2 “does not set out ... a requirement” that limits amendments to
8 invalidity contentions only to those based on “unexpected” claim constructions;
9 (2) the Rule does not impose a diligence requirement, but rather “sets a hard and
10 fast deadline for amendments in light of claim construction rulings: 50 days after
11 the order issues”; and (3) alleged “complications” to rebuttal expert reports based
12 on timely amended contentions “do not demonstrate undue prejudice.” These are
13 correct statements of the law in this District and are contrary to the findings of the
14 Order in this case, where Apple served claim construction-based invalidity
15 contentions on the 50-day deadline. It would be manifestly unjust to preclude
16 Apple from amending its invalidity contentions based on the law of this district as
17 correctly articulated in the intervening *Ameranth* Order.

18 Apple also seeks clarification that the Order does not preclude Apple or its
19 experts from: (1) continuing to rely and opine on any portion of Apple’s originally
20 disclosed invalidity contentions, or (2) discussing prior art references for purposes
21 of describing the background of the art or the understanding of a person of ordinary
22 skill in the art, which is expressly permitted under the law of this Circuit, regardless
23 of whether such a background reference is disclosed in invalidity contentions. The
24 parties dispute the scope of the Order, with Wi-LAN taking the most expansive
25 view of the Order possible, as demonstrated by its motion to strike (Dkt. No. 304),
26 which seeks to exclude as much of Apple’s invalidity case as possible. If the Order
27 did intend to preclude Apple from offering expert opinions on either topic, Apple
28 respectfully requests reconsideration. The Order did not address the sufficiency of

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