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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

APPLE INC.,

Plaintiff,

v.

WI-LAN, INC.,

Defendant.

AND RELATED 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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I. INTRODUCTION

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

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

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