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15

16   UNITED STATES DISTRICT COURT

17   SOUTHERN DISTRICT OF CALIFORNIA

18 APPLE INC.,

19   Plaintiff,

20   v.

21 WI-LAN, INC.,

22   Defendant.

23

24

25 AND RELATED
COUNTERCLAIMS

26

27

28

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

APPLE INC.'S OPPOSITION TO WI-LAN INC.'S MOTION TO STRIKE CERTAIN INVALIDITY EXPERT OPINIONS [DOCKET NUMBER 304]

Date: April 27, 2018
Time: 1:30 p.m.
Dept.:   13A
Judge: Hon. Dana M. Sabraw
Magistrate Judge: Hon. Barbara L. Major

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I. INTRODUCTION

The Court should not prevent Apple's experts from relying on prior art references and invalidity theories that were properly disclosed in Apple's initial invalidity contentions and not subject to the Court's order striking Apple's amended invalidity contentions (Dkt. No. 297, hereafter the "Order"). Apple already has moved for reconsideration and clarification of that Order (Dkt. No. 306), which the Court should consider (and grant) before ruling on Wi-LAN's duplicative motion. As demonstrated in Apple's motion for reconsideration and below, Apple's original invalidity contentions disclosed all of the invalidity theories challenged in Wi-LAN's motion.

In addition, Apple's experts should be permitted to rely on the UMTS and Carvalho references, which were not at issue in Wi-LAN's opening brief but are at issue in Apple's co-pending motion for partial reconsideration and clarification. Apple served its UMTS and Carvalho contentions on the 50-day "hard and fast" deadline under the Patent Local Rules, and both new claim charts were necessitated by the claim construction order, as demonstrated in Apple's co-pending motion. Therefore, Apple's experts' reliance on these references is proper under the Court's reasoning in its recent opinion in *In re: Ameranth Cases* (Dkt. No. 306-3, hereafter "*Ameranth* Order") that the 50-day deadline is a "hard and fast" deadline for amendments necessitated by the Court's claim construction order.

II. APPLE DISCLOSED EACH OF THE CHALLENGED INVALIDITY THEORIES IN ITS ORIGINAL INVALIDITY CONTENTIONS.

The Court should deny Wi-LAN's motion because Apple disclosed each of the challenged invalidity theories in June 2017 in its original invalidity contentions. Dkt. No. 306-1; *see also Fujifilm Corp. v. Motorola Mobility LLC*, No. 12-CV-03587-WHO, 2015 WL 757575, at *28-32 (N.D. Cal. Feb. 20, 2015) (threshold question in determining whether expert reports are properly within the scope of contentions is "whether the expert has permissibly specified the application of a

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