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16 UNITED STATES DISTRICT COURT
17 SOUTHERN DISTRICT OF CALIFORNIA

18 APPLE INC.,
19 Plaintiff,
20 v.
21 WI-LAN, INC.,
22 Defendant.

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

25 AND RELATED
26 COUNTERCLAIMS

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1 **I. INTRODUCTION**

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

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

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

23 The Court should deny Wi-LAN's motion because Apple disclosed each of
24 the challenged invalidity theories in June 2017 in its original invalidity contentions.
25 Dkt. No. 306-1; *see also Fujifilm Corp. v. Motorola Mobility LLC*, No. 12-CV-
26 03587-WHO, 2015 WL 757575, at *28-32 (N.D. Cal. Feb. 20, 2015) (threshold
27 question in determining whether expert reports are properly within the scope of
28 contentions is "whether the expert has permissibly specified the application of a

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