UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

APPLE INC.,

Plaintiff,

vs.

WI-LAN, INC.,

Defendant.

AND ALL RELATED COUNTERCLAIMS.

CASE NO. 14cv2235 DMS (BLM)

ORDER (1) GRANTING APPLE'S MOTION FOR PARTIAL RECONSIDERATION AND CLARIFICATION AND (2) GRANTING IN PART AND DENYING IN PART WI-LAN'S MOTION TO STRIKE EXPERT OPINIONS

On March 2, 2018, this Court issued an Order granting Wi-LAN's motion to strike Apple's amended invalidity contentions for failure to comply with Patent Local Rule 3.6.b.2.a. (Docket No. 297.) Specifically, the Court found Apple had failed to establish it had a good faith belief that those amendments were necessitated by the Court's claim construction, and that even if that standard was met, Wi-LAN would be unduly prejudiced by the amendments. (*Id.*)

After that Order issued, the Court issued an Order on a similar motion in another case, *In re Ameranth Cases*, Case No. 11cv1810 DMS (WVG). (*See* 11cv1810, Docket No. 999.) In that Order, the Court denied the plaintiff's motion to strike the defendant's amended invalidity contentions pursuant to Patent Local Rule 3.6.b.2.a.. After

reviewing the Order in the *Ameranth* case, Apple filed the present motion for partial reconsideration and clarification of the Court's decision in this case. Wi-LAN filed an opposition to the motion, and Apple filed a reply. Also pending before the Court is Wi-LAN's related motion to strike expert opinions regarding stricken prior art references and undisclosed invalidity theories.

On the request for reconsideration, generally the Court agrees with Apple that the Court's interpretation of Patent Local Rule 3.6.b.2.in this case is different from the interpretation put forth in *Ameranth*. The Court stands by the reasoning set out in the *Ameranth* Order, and will apply that reasoning to the present case.

Under that reasoning, the Court grants Apple's motion for reconsideration as to the UMTS and Carvalho references, the combination of Ericsson and Ericsson IP Traffic, the section 112 defenses on the "establish a length" limitation, and the background prior art references. Apple has shown the addition of the UMTS and Carvalho references was necessitated by the Court's construction of "packing sub-header," which construction was different from Apple's proposed construction. That amendment was timely, and Wi-LAN has not shown it would suffer undue prejudice from this amendment.

As to the Ericsson and Ericsson IP Traffic combination, the briefing on the motion for reconsideration reflects this combination was included in Apple's original invalidity contentions. Although Apple may not have called out the two separate references in every instance of its invalidity contentions, the combination was disclosed and charted, and each individual reference was provided to Wi-LAN.

Similarly, although Apple failed to assert a section 112 defense to the "establish a length" limitation in claim 1 of the '040 Patent, it did assert that defense to nearly identical language found in claim 14 of the '040 Patent. Under these circumstances, there is no undue prejudice to Wi-LAN in allowing this amendment.

The Court also agrees with Apple that any prior art used solely as background references need not have been disclosed, and should not have been stricken.

For the other combinations, namely Ericsson and Klayman, Doshi and Calvignac and Chuah and Sau, Apple requests clarification that these combinations were adequately disclosed in Apple's original invalidity contentions. There is no dispute these individual references were disclosed in Apple's original invalidity contentions and produced to Wi-LAN. The dispute surrounds the combinations, and there, the Court agrees with Wi-LAN that the combinations were not sufficiently disclosed. The general reservation included in Apple's contentions was not sufficient to give notice to Wi-LAN that these specific combinations would be asserted against it, and at this point, Wi-LAN would suffer undue prejudice if these combinations were allowed.

Turning to Wi-LAN's motion to strike, that motion is granted in part and denied in part, consistent with the Court's rulings above.

IT IS SO ORDERED.

DATED: May 24, 2018

HON. DANA M. SABRAW
United States District Judge