

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

WI-LAN, INC.	)	
	)	
Plaintiff,	)	CIVIL ACTION NO. 2:07-CV-473
v.	)	
	)	
ACER, INC., <i>et al.</i>	)	<b>CONSOLIDATED THROUGH</b>
	)	<b>MARKMAN WITH:</b>
Defendant;	)	
	)	
	)	CIVIL ACTION NO. 2:07-CV-474
WI-LAN, INC.	)	
	)	HON. T. JOHN WARD
Plaintiff,	)	
v.	)	JURY
	)	
WESTELL TECHNOLOGIES, INC., <i>et al.</i>	)	
	)	
Defendant.	)	

**DEFENDANTS' MOTION FOR LEAVE TO AMEND INVALIDITY CONTENTIONS**

## I. INTRODUCTION

The Defendants in this action respectfully move to amend their Patent Rule 3-3 Invalidity Contentions to narrow the number of prior art references and provide additional details concerning their anticipation, obviousness, and § 112 contentions.

Months ago, Defendants served interrogatories seeking the factual bases for Wi-LAN's contentions that the patents-in-suit are valid over the prior art cited in Defendants' Invalidity Contentions. In response, Wi-LAN refused to provide substantive responses to the interrogatories. Instead, Wi-LAN requested that Defendants revise their Invalidity Contentions to reduce the number of asserted references and provide more detailed disclosures. In the parties' subsequent meet and confer, counsel reached the following agreement: Defendants would narrow the scope of their Invalidity Contentions and provide more detailed citations, and, in return, Wi-LAN would consent to amendment of the Contentions and provide substantive responses to Defendants' invalidity interrogatories.

Defendants satisfied their side of this agreement months ago, serving revised Invalidity Contentions that reduced the number of prior art references and § 112 contentions and also provided the additional specificity requested by Wi-LAN. Although Wi-LAN initially conceded that Defendants had sufficiently reduced the number of prior art references, it refused to supplement its interrogatory responses. Wi-LAN later agreed again to provide the supplementation in exchange for additional unrelated concessions from Defendants, but subsequently reneged for a second time, and to date has not provided any substantive answers with respect to patent validity.<sup>1</sup>

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<sup>1</sup> To address Wi-LAN's failure to provide substantive responses to Defendants' interrogatories on patent invalidity, in addition to filing this motion, Defendants prepared a separate motion to compel responses to those

(Continued...)

Defendants' revised Invalidity Contentions satisfy the Patent Rule requirements and the parties' agreement. Granting Defendants leave to amend will substantially narrow the issues in dispute between the parties and will cause no prejudice to Wi-LAN. Moreover, Wi-LAN has been in possession of Defendants' revised contentions for months, and yet Wi-LAN has used this dispute to avoid providing any substantive information responsive to Defendants' interrogatories concerning patent invalidity, depriving Defendants of highly-relevant information in this case. Accordingly, Defendants respectfully request that the Court grant Defendants' Motion for Leave to Amend their Invalidity Contentions.<sup>2</sup>

## **II. STATEMENT OF FACTS**

### **A. Defendants Serve Invalidity Contentions And Interrogatories**

On December 18, 2008, in accordance with the Court's Docket Control Order, Defendants served Invalidity Contentions for the patents-then-in-suit: U.S. Patent Nos. 5,282,222 ("222 patent"), RE 37,802 ("802 patent"), and 5,956,323 ("323 patent").<sup>3</sup> On February 6, 2009, Defendants served Joint Interrogatory Nos. 3 and 5 seeking the factual bases for Wi-LAN's contentions that the patents-in-suit are valid over the prior art cited in their Invalidity

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interrogatories. However, on the day Defendants planned to file that motion, Wi-LAN agreed to provide full and complete responses to the invalidity interrogatories by early February. In reliance on that agreement, Defendants did not file their motion to compel. Despite agreeing to provide complete responses to Defendants' invalidity interrogatories, Wi-LAN maintained its refusal to consent to this motion.

<sup>2</sup> Wi-LAN recently indicated an intent to file a Motion to Strike Defendants' original 12/18/2008 Invalidity Contentions. *See* Exh. O (correspondence between Bunt and Burke). However, Wi-LAN's proposed Motion to Strike Defendants' original Invalidity Contentions was mooted by the parties' prior agreement and Defendants' presentation of revised Invalidity Contentions pursuant to that agreement. As the parties' current disputes revolve around Defendants' revised Invalidity Contentions, this motion, which is directed to entry of those contentions, more appropriately presents the parties' disputes to the Court, rather than a motion to strike directed at Defendants' original invalidity contentions.

<sup>3</sup> On May 29, 2009, Defendants served Invalidity Contentions for later-added U.S. Patent No. 6,549,759 ("759 patent").

Contentions.<sup>4</sup>

**B. Wi-LAN Refuses To Answer Defendants' Interrogatories And Requests Revisions To Defendants' Invalidity Contentions**

On April 24, 2009, Wi-LAN objected to Defendants' interrogatories concerning invalidity but provided no substantive responses. Shortly thereafter, Wi-LAN requested that Defendants revise their Invalidity Contentions in four ways: (1) limit the number of prior art references and potential combinations; (2) provide the specific bases for each anticipatory reference; (3) provide the specific bases for each obviousness combination; and (4) limit the number of claim terms and provide the specific bases for indefiniteness and enablement. *See* Exh. A (5/21/09 Letter from Blackstone to All Counsel) at 5–6. Wi-LAN refused to respond to Defendants' invalidity interrogatories unless Defendants made these revisions. *See* Exh. B (6/26/09 Letter from Schofield to Petrsoric et al.) at 3.

**C. The Parties Meet And Confer And Reach An Agreement**

On June 10, 2009, the parties met and conferred regarding these issues and reached agreement. *See* Exh. C (6/10/09 Email from Blackstone to Alper). Specifically, as memorialized in writing by Wi-LAN's counsel that same day, counsel for the parties agreed that Defendants would revise their Invalidity Contentions as follows:

1. The Defendants will limit the number of anticipatory references and obviousness combinations on which they will rely. For anticipatory references,

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<sup>4</sup> For example, Joint Interrogatory No. 5 requests that Wi-LAN:

Describe with particularity the basis for Wi-LAN's contention that the asserted claims of the patents-in-suit are novel and/or non-obvious in light of the prior art cited in the Invalidity Contentions including without limitation by identifying each element of each asserted claim of the patents-in-suit that is missing in the cited prior art and why Wi-LAN contends such element is not satisfied, describing the basis of any contentions that a person of skill in the art would not combine the cited prior art including a description of any secondary factors and the ordinary level of skill in the art, describing the basis of any contentions that the cited prior art is not enabled, describing the basis of any contentions that the cited prior art is not invalidating prior art to the patents-in-suit or does not constitute prior art to the patents-in-suit, and identifying the persons most knowledgeable about the basis for such contentions.

the Defendants goal is to reduce the number of references to ten (10) per asserted patent as we suggested in the May 21st letter. In addition, the footnotes setting forth obviousness combinations will be eliminated in favor of separate obviousness charts (discussed below with respect to category no. 3).

2. The Defendants will provide more specificity for each of the references, including further detailed citations, quotations of relevant passages for articles/publications, and specific citations within cited figures.

3. The Defendants will provide more specific bases for the obviousness combinations on which they rely. These combinations will be "relatively focused" and result in separate charts for separate combinations, with the number of obviousness charts exceeding the number of anticipation charts. However, the Defendants do not expect the number of obviousness charts to greatly exceed the number of anticipation charts.

4. The Defendants will provide more specific bases for the claim terms that Defendants contend render the asserted patents invalid. The Defendants will attempt to limit the number of claim terms that Defendants contend render the asserted patents invalid to five (5) per asserted patent as we suggested in the May 21st letter.

*Id.* In return, Wi-LAN agreed that it would not oppose Defendants' motion to amend their Invalidity Contentions to incorporate these revisions and would also provide substantive responses to Defendants' invalidity interrogatories. *See id.*; Exh. D (7/3/2009 Letter from Alper to Blackstone); Exh. E (8/14/2009 Letter from Alper to Blackstone).

**D. Defendants Revise Their Invalidity Contentions To Satisfy Wi-LAN's Requests**

As agreed, on July 3, 2009, Defendants provided revised Invalidity Contentions meeting each of Wi-LAN's requests. *See* Exh. D (7/3/09 Letter from Alper to Blackstone enclosing revised Invalidity Contentions). In correspondence accompanying these revisions, Defendants asked Wi-LAN to confirm that, pursuant to the parties' agreement, it would not oppose Defendants' motion for leave to amend the Invalidity Contentions as set forth in the revised Contentions. *See id.* In later correspondence, Defendants asked Wi-LAN to confirm that, pursuant to the parties' agreement, it would provide substantive responses to Defendants'

Interrogatory Nos. 3 and 5. *See* Exh. F (7/17/2009 Letter from Alper to Blackstone) at 5.

**E. Wi-LAN Refuses To Consent To Defendants' Revised Invalidity Contentions Or To Provide Answers To Interrogatories As Agreed**

Wi-LAN refused to provide the confirmation requested by Defendants or to provide substantive interrogatory responses, instead demanding that Defendants further revise their Contentions. *See* Exh. G (7/10/09 Letter from Blackstone to All Counsel). The parties subsequently met and conferred regarding this issue on numerous occasions over a period of weeks.<sup>5</sup> During this process, Wi-LAN did not dispute that Defendants had satisfied the criteria set forth in counsel's meet and confer summary, but requested the following additional revisions:

- A narrative description of how each element of each asserted claims is met by each cited reference;
- Shorter invalidity charts; and
- Fewer § 112 defenses.

*See* Exh. G (7/10/09 Letter from Blackstone to All Counsel).

**F. Wi-LAN Finally Agrees To Provide Substantive Answers But Then Insists That Defendants First Make Further Revisions To Their Invalidity Contentions**

Subsequently, Wi-LAN finally agreed to provide substantive responses to Defendants' invalidity interrogatories, in exchange for additional, unrelated concessions from Defendants. *See* Exh. J (11/13/09 Written Agreement). Yet, less than two weeks after making that agreement, Wi-LAN reneged again, informing Defendants that it would not be able to provide meaningful supplementation unless Defendants further reduced the number of prior art

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<sup>5</sup> For six weeks, Wi-LAN ignored Defendants' repeated requests to meet and confer regarding these issues entirely. *See* Exh. F (7/17/2009 Letter from Alper to Blackstone); Exh. H (7/30/2009 Letter from Alper to Blackstone); 8/4/2009 Telephone Call from Alper to Blackstone; Exh. E (8/14/2009 Letter from Alper to Blackstone); Exh. I (8/26/2009 Letter from Blackstone to Alper)

references and provided the additional detail regarding those references that it had previously requested. *See* 11/24/09 Meet and Confer.

**G. Defendants Provide Revised Invalidity Contentions That Further Reduce The Number Of Prior Art References But Wi-LAN Maintains Its Refusal**

On December 14, 2009, Defendants provided revised Invalidity Contentions that further reduced the number of prior art references, as requested by Wi-LAN. *See* Exh. K (12/14/2009 Letter from Alper to Blackstone); Exhs. L-N (Defendants' 12/14/2009 Revised Invalidity Contentions). Despite these further reductions and additional meet and confers, Wi-LAN continues to refuse to consent to Defendants' revised Invalidity Contentions. *See* Exh. O (correspondence regarding Defendants' further revisions). The parties have, therefore, reached an impasse.

**III. ARGUMENT**

**A. Defendants' Motion to Amend Their Invalidity Contentions Should Be Granted**

The Patent Rules permit amendment of invalidity contentions by order of the Court upon a showing of good cause. *See* P.R. 3-6(b); *Arbitron v. Int'l Demographics*, No. 2:06-CV-00434 (TJW), 2008 WL 4755761, at \*3 (E.D. Tex. Oct. 29, 2008); *Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-00196, 2009 WL 763926, at \*2 (E.D. Tex. Mar. 19, 2009). When no prejudice is found, courts generally grant leave to amend. *See, e.g., Arbitron*, 2008 WL 4755761, at \*3.

**1. Defendants' Revised Invalidity Contentions Comply With Both The Patent Rules And The Parties' Agreement**

The Patent Rules require a party claiming invalidity to (1) identify each item of prior art that allegedly anticipates each asserted claim or renders it obvious; (2) identify whether each item of prior art anticipates each asserted claim or renders it obvious and the motivation to

combine obviousness references; (3) provide charts identifying where specifically in each alleged item of prior art each element of each asserted claim is found; and (4) identify any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1). *See* P.R. 3-3. Defendants' revised Invalidity Contentions fully comply with these requirements.

Moreover, Defendants' revised Contentions meet each of the four criteria the parties agreed to during their meet and confers. The additional revisions Wi-LAN now seeks go beyond both the requirements of the Patent Rules and the scope of the parties' agreements.<sup>6</sup>

## **2. Defendants Sufficiently Reduced The Number Of Invalidity References In Their Contentions**

During the June 10, 2009 meet and confer, the parties agreed that Defendants would limit the number of references cited in their Invalidity Contentions. Although Wi-LAN initially agreed that Defendants' July 3, 2009 Invalidity Contentions sufficiently reduced the number of references (*see* Exh. Q (9/13/09 email from Schofield to Handley)),<sup>7</sup> it subsequently requested further reductions. In an effort to avoid motion practice, Defendants further reduced the number of cited references. Nevertheless, despite previously stating that the number of references was sufficiently reduced, Wi-LAN now contends that further reductions are necessary.

Contrary to Wi-LAN's current assertions, no further reductions are necessary. As an initial matter, the number of references is low: 12 references for the '222 patent, 18 references for

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<sup>6</sup> Although Defendants believed their initial Invalidity Contentions complied with Patent Rules 3-3 and 3-4, they agreed to revise those Contentions as set forth above in an effort to cooperate with Wi-LAN and to narrow the issues in dispute between the parties. *See, e.g.*, Exh. P (6/3/09 Letter from Alper to Blackstone); Exh. C (6/10/09 Email from Blackstone to Alper).

<sup>7</sup> Defendants' July 3, 2009 Invalidity Contentions reduced the number of cited references for the four patents-in-suit from 256 to 64 — 12 for the '222 patent, 22 for the '802 patent (some overlap with the '222), 17 for the '759 patent, and 15 for the '323 patent.

the '802 patent (2 of which overlap with those for the '222 patent), 12 for the '759 patent, and 14 for the '323 patent,<sup>8</sup> even though Wi-LAN has asserted many claims (69 in total, including, for example, 22 claims of the '802 patent) and the contentions are provided on behalf of many (18) defendants. Additionally, as shown in Exhibit R, each of the patents is asserted against at least two accused technologies, justifying additional references to cover Wi-LAN's multiple applications of the claims. *See* Exh. R (chart of Wi-LAN's patent assertions). The numbers of references in Defendants' revised contentions would not be burdensome for Wi-LAN to evaluate, and Wi-LAN has not made such a contention.

Despite the low numbers of references, Wi-LAN, to date, has not provided any information as to why it contends the patents are valid in view of any of the references. Given these circumstances, Defendants should not be required at this stage to further reduce the references, only to find that Wi-LAN believes that some of the references are missing elements that are present in other of the references. *See, e.g., Accolade Systems LLC v. Citrix Systems, Inc.*, No. 6:07cv00048, slip op. at 2–3 (E.D. Tex. May 11, 2009) (rejecting motion to restrict the number of prior art references in order entered approximately one month before trial, finding that 26 invalidity references for a single patent with 14 asserted claims was "reasonable" and stating that "the Court does not usually impose a limit on the number of claims and references").

### **3. Defendants' Revised Contentions Specifically Identify Where In Each Prior Art Reference Each Element Of Each Claim Is Found**

During the June meet and confer, the parties agreed that Defendants would provide

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<sup>8</sup> In addition to reducing the number of prior art references for the '323 patent from 36 to 14, the defendants accused of infringing the '323 patent ("323 patent Defendants") have replaced two of the prior art references with two recently-discovered references. Charts providing detailed citations and quotations indicating how each of the disclosed references invalidates the '323 patent have been provided in '323 Patent Defendants' Fourth Amended Invalidity Contentions Pursuant to Patent Rules 3-3 and 3-4 ('323 Patent), served December 17, 2009.

additional information concerning their contentions for each cited reference. In particular, Wi-LAN requested "further detailed citations, quotations or relevant passages for articles/publications, and specific citations within cited figures." Exh. C (6/10/2009 Email from Blackstone to Alper). Wi-LAN does not dispute that Defendants' revised Invalidity Contentions provide the requested information. For example, Defendants' charts cite to the specific column and line numbers in the patent references, as well as to specific items in the figures:

<b>U.S. Patent No. 4,438,511 ("Baran '511")</b>
<i>See, e.g.</i> , abstract; figs. 1, 3, 9 (items 14, 16, 22, 14', 16', 22'); cols. 1:6–8; 3:65–68; 7:45–51; 8:53–58; 15:45–51; 16:38–43; 19:28–35.

*See* Exh. S (excerpt of Defendants' revised Invalidity Contentions). In cases where columns or line numbers are not present, Defendants quoted the portions of the reference they plan to rely upon for each element:

<b>Bingham Article</b>
<i>See, e.g.</i> , fig. 7;  "Now, however, interest is increasing because modems based on the principle are being used—or being considered for use—for transmission of data and facsimile on the following: <ul style="list-style-type: none"> <li>• General Switched Telephone Network (GSTN)</li> <li>• 60–108 kHz Frequency-Division Multiplexed (FDM) group-band</li> <li>• Cellular radio</li> </ul> In addition, high-speed data is being considered for transmission on the High-rate Digital Subscriber Line (HDSL)." p. 5;

*See* Exh. T (excerpt of Defendants' revised Invalidity Contentions).

Despite acknowledging that Defendants satisfied their part of the agreement on this issue, Wi-LAN now contends that Defendants must provide an additional narrative description of how each element of each asserted claim is met by the prior art disclosure. Such narrative descriptions are not required by the Patent Rules, which unambiguously require a defendant to

provide "charts identifying where specifically in each alleged item of prior art each element of each asserted claim is found." P.R. 3-3. Wi-LAN has provided no authority to support its request for narrative descriptions. Moreover, Wi-LAN's request for narrative description exceeds the terms of the parties' initial agreement, as confirmed by Wi-LAN after the meet and confer. *See* Exh. C (6/10/2009 Email from Blackstone to Alper).

Paradoxically, at one point in the parties' meet and confer, Wi-LAN also suggested that Defendants' revised Invalidity Contentions are too long. *See* Exh. G (7/10/2009 Letter from Blackstone to All Counsel) at 1–2. However, the length of Defendants' revised Contentions is a direct result of Wi-LAN's request that the charts include verbatim quotations of each prior art passage relied upon by Defendants for each element of the asserted claims. *See* Exh. C (6/10/2009 Email from Blackstone to Alper). Moreover, many of the relevant passages quoted in the invalidity charts are only a few lines long. Longer passages are included only as necessary to encompass the pertinent disclosure from a particular reference. If Defendants were to shorten those citations, they would not fully disclose the relevant functionality on which they intend to rely and, in so doing, make the charts less informative.<sup>9</sup>

#### **4. Defendants' Revised Contentions Provide Detailed Motivations To Combine Obviousness References**

During the June 10, 2009 meet and confer, the parties agreed that Defendants' revised Contentions would reduce the number of obviousness combinations and provide more information with respect to the motivations to combine. *See* Exh. C (6/10/2009 Email from Blackstone to Alper). Wi-LAN admits that Defendants' revised Invalidity Contentions

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<sup>9</sup> For example, the passage from the Sasaki 1989 IEICE Article referenced in Wi-LAN's July 10, 2009 letter is a translated document that includes multiple examples of functionality disclosing the claimed elements. *See* Exh. G (Continued...)

sufficiently reduced the number of obviousness combinations.

With respect to the motivations to combine, Wi-LAN contends that Defendants provided only "boilerplate, generic motivations" for the proposed combinations. *See* Exh. G (7/10/09 Letter from Blackstone to All Counsel) at 2. However, that is incorrect – Defendants' contentions provide facts particular to each combination. In researching these facts, Defendants considered factors such as the backgrounds of the inventors/authors, employers of the inventors/authors, the relationship between the assignees of the references, and cross-references between the cited art. Defendants' disclosures are specific to each combination and vary from combination to combination depending on these factors.

By way of example, Defendants' obviousness chart for U.S. Patent No. 4,438,511 ("Baran '511"), the Bingham article, and U.S. Patent No. 5,311,550 ("Fouche '550 patent") discloses, among other things, that listed inventors on the Baran '511 and the author of the Bingham article worked together at the same institution, Telebit Corporation:

**U.S. Patent No. 4,438,511 ("Baran '511") in Combination with the Bingham Article and U.S. Patent No. 5,311,550 ("Fouche '550"):** A person of ordinary skill in the art would have been motivated to combine these references, including because these references were authored by or assigned to individuals or organizations involved in common technical organizations such as the IEEE, explicitly reference each other and instrumentalities disclosed in the other references, share common subject matter and approaches, discuss related products, were developed during the same time period and by listed authors/inventors at the same organization, Telebit Corporation. Additionally, a person of ordinary skill in the art would have been motivated to use the methods and instrumentalities disclosed in the Bingham Article and/or Fouche '550 in practicing or creating the methods and instrumentalities disclosed in Baran '511.

*See* Exh. U (excerpt of Defendants' revised Invalidity Contentions). As another example,

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(7/10/09 Letter from Blackstone to All Counsel) at 2; Exh. F (7/17/2009 Letter from Alper to Blackstone) at 3. Defendants may rely on all three embodiments as prior art for this element.

Defendants' obviousness chart for the Fouche '550 patent and the Casas Thesis discloses, among other things, that Eduardo Casas and multiple listed inventors of the Fouche '550 patent were involved with the same technical organization (the IEEE), and relate to common subject matter. *See* Exh. V (excerpt of Defendants' revised Invalidity Contentions).

As yet another example, Defendants' obviousness chart for U.S. Patent No. 5,353,352 ("Dent '352"), U.S. Patent No. 5,511,073 ("Padovani '073"), the Ishigaki Patent Publication, U.S. Patent No. 5,276,703 ("Budin '703"), and U.S. Patent No. 5,046,066 ("Messenger '066") discloses, among other things, that the references cite to other references having common listed inventors and/or assignees. *See* Exh. W (excerpt of Defendants' revised Invalidity Contentions).

During the meet and confer process, Defendants presented specific examples of these disclosures to Wi-LAN. Wi-LAN maintains that Defendants' descriptions are "boilerplate," but to date has not explained this objection.<sup>10</sup>

**5. Defendants' Revised Contentions Include A Reasonable Number Of Grounds For Invalidity Under 35 U.S.C. § 112**

During the June meet and confer, the parties agreed that Defendants' revised Invalidity Contentions would limit the number of claim terms Defendants contend render the asserted patents invalid under 35 U.S.C. § 112. *See* Exh. C (6/10/2009 Email from Blackstone to Alper). In accordance with the parties' agreement, Defendants' revised Contentions limit the number of such claim elements to ten or fewer per patent.

Contrary to Wi-LAN's assertions during the meet and confer, the number of claim

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<sup>10</sup> Although Wi-LAN previously contended that Defendants accused of infringing the '323 patent failed to provide motivations to combine for their cited obviousness references (*see* Exh. G (7/10/09 Letter from Blackstone to All Counsel) at 2), those Defendants provided these motivations on August 7, 2009. *See* Exh. F (7/17/09 Letter from Alper to Blackstone) at 4; Exh. X (8/7/09 letter from Tung to Blackstone). Wi-LAN has not raised this issue since then.

elements relied upon by Defendants in their § 112 defenses is reasonable. Although Wi-LAN contends that Defendants are relying on 65 claim elements, Wi-LAN arrives at that number by improperly counting each appearance of any particular element throughout the numerous asserted claims. *See* Exh. G (7/10/09 Letter from Blackstone to All Counsel) at 2. This is unfair because Wi-LAN has asserted numerous claims (69 in all) containing similar claim elements which are subject to common § 112 defenses.

For example, similar elements involving the claimed "converter" appear in four claims of the '802 patent. Claims 1 and 17 use the phrase "a converter for converting the first stream of data symbols into plural sets of N data symbols each;" claim 23 uses the phrase "converting a first stream of data symbols into plural sets of N data symbols each;" and claim 33 uses the phrase "a converter for converting the first stream of data symbols into plural sets of data symbols each." Defendants contend that the "converter" element is invalid for failure to meet the requirements of § 112. Under Wi-LAN's approach, Defendants' § 112 objection on the "converter" element would count as four independent grounds for invalidity under 35 U.S.C. § 112. However, that is only because Wi-LAN has asserted four claims having similar "converter" elements. Wi-LAN should not be permitted to avoid legitimate § 112 defenses simply by asserting many different claims that repeat the same elements. Such an approach would be contrary to the spirit of the Patent Rules and effectively punish Defendants for their good faith efforts to narrow the issues in dispute between the parties.<sup>11</sup>

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<sup>11</sup> Wi-LAN has also stated that Defendants' identification of the final element of claim 7 of the '222 patent is insufficient because that element has 90 words. *See* Exh. G (7/10/09 Letter from Blackstone to All Counsel) at 2. However, that element includes lengthy mathematical formulas which, in context with the other words of that element and in view of Wi-LAN's application of that element, render claim 7 invalid under § 112.

#### IV. CONCLUSION

Defendants have revised their Invalidity Contentions in accordance with Wi-LAN's requests, the parties' June and November agreements, and the Patent Rules. Defendants now seek leave to amend their Invalidity Contentions to include these revisions. Granting Defendants leave to amend will substantially narrow the issues in dispute between the parties and will cause no prejudice to Wi-LAN. Accordingly, Defendants respectfully request that the Court grant their motion.

Dated: January 7, 2010

Respectfully submitted,

/s/ Robert M. Parker

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**INTEL CORPORATION**

**AND ON BEHALF OF DEFENDANTS**

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that counsel of record who are deemed to have consented to electronic service are being served on January 7, 2010 with a copy of **DEFENDANTS' MOTION FOR LEAVE TO AMEND INVALIDITY CONTENTIONS** via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Robert M. Parker  
Robert M. Parker

**CERTIFICATE OF CONFERENCE**

The undersigned hereby certifies that counsel for Intel has complied with the meet and confer requirement in Local Rule CV-7(h). This motion is opposed. The personal conference required by Local Rule CV-7(h) was conducted via several telephone conferences during the months of June, September, November, and December 2009. The undersigned, Christopher Bunt, and Adam Alper (for Intel), Sam Baxter, Robert Cote and Darryl Burke (for Wi-LAN), and other counsel for the parties participated in the conferences. During the conference, counsel for Intel and Wi-LAN attempted to resolve all disputes before filing of this motion. However, no agreement could be reached. Darryl Burke and Chris Bunt had a final meet and confer on January 7, 2010 and acknowledged that the parties were at an impasse, leaving an open issue for the Court to resolve.

/s/ Robert M. Parker  
Robert M. Parker