

EXHIBIT 1

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February 11, 2010

The Honorable T. John Ward
United States District Court
Eastern District of Texas - Marshall Division
100 East Houston Street
Marshall, Texas 75670

RE: *Wi-LAN Inc. v. Research in Motion Corp. et al.*, C.A. No. 2:08-cv-247 (TJW)

Dear Judge Ward:

We represent Plaintiff Wi-LAN Inc. in the above-captioned action. Pursuant to the Court's Docket Control Order (Dkt. No. 54), we respectfully submit this answering letter brief to Defendant LG Electronics Mobilecomm U.S.A., Inc.'s ("LGEMU") letter brief requesting permission to file a motion for summary judgment that 18 of the 24 asserted claims of U.S. Patent No. RE 37,802 ("the '802 patent") are invalid based on the "first computing means" claim term. *See* Dkt. No. 105-2. LGEMU argues that the claims are "invalid because the '802 patent fails to disclose an algorithm as corresponding structure for the 'first computing means.'" *Id.* at 3. Even assuming LGEMU is correct that the '802 patent fails to disclose an algorithm,¹ none of the '802 claims could be found invalid because the parties all agree that there are alternative corresponding structures (fig. 1 (item 12), fig. 4 (item 12), and cols. 2:6-10, 2:36-40, 2:58-62, 4:2-12, 4:35-44). (*See, e.g.*, Defendant LGEMU stating in letter that "[t]he parties agree that Figures 1 and 4 are corresponding structure"). Accordingly, LGEMU's motion would only serve

¹ Wi-LAN disagrees that the '802 patent fails to disclose an algorithm as further explained below.

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to waste the Court's resources, and any dispute between the parties regarding the identification of additional corresponding structure can be addressed as part of the claim construction process.

LGEMU's Motion Cannot be Sufficient to Invalidate Any Claims

On December 4, 2009, Defendants served their Disclosure of Preliminary Claim Constructions and Extrinsic Evidence Pursuant to P.R. 4-2. Defendants' proposed construction for the "first computing means" claim terms identified the corresponding structure as "fig. 1 (item 12), fig. 4 (item 12), and cols. 2:6-10, 2:36-40, 2:58-62, 4:2-12, 4:35-44," and Defendant LGE cited additional structure as "fig. 3 and cols. 2:54-57, 4:29-39, 4:66-5:7." Wi-LAN's proposed construction identified the corresponding structure as "i) element 12 in FIG. 1 including corresponding descriptions in the specification; ii) element 12 in FIG. 4 including corresponding descriptions in the specification; iii) a computing device programmed to perform the algorithms disclosed by the foregoing; and equivalents thereof."

On January 11, 2010, the parties filed the Joint Claim Construction and Prehearing Statement Pursuant to Patent Rule 4-3. *See* Dkt. No. 100-1. Defendants' proposed construction was the same as their 4-2 construction quoted above. *See* Dkt. No. 100-2 at 8-10. Wi-LAN amended its construction to "i) element 12 in FIG. 1 including corresponding descriptions in the specification (col. 2:6-10, 2:36-40, 4:2-4:12 and 4:35-38); ii) element 12 in FIG. 4 including corresponding descriptions in the specification (col. 2:6-10, 2:58-62, 4:39-44, and 4:66-5:12); iii) a computing device programmed to perform the algorithms disclosed by the foregoing; and equivalents thereof." Dkt. No. 100-3 at 9-12.

All of the parties agree that "fig. 1 (item 12), fig. 4 (item 12), and cols. 2:6-10, 2:36-40, 2:58-62, 4:2-12, 4:35-44" is corresponding structure for the "first computing means" claim terms. Thus, there can be no dispute that the '802 patent discloses corresponding structure for the "first computing means" claim terms, and none of the asserted claims can be found invalid

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for failing to disclose additional corresponding structure as LGEMU argues. *See Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999) (“When multiple embodiments in the specification correspond to the claimed function, proper application of § 112, P 6 generally reads the claim element to embrace each of those embodiments.”).

LGEMU argues that “[h]aving chosen to cast the patent claims at issue in means-plus-function form, Wi-LAN was obligated to disclose an algorithm for carrying out the claim’s recited function.” Dkt. No. 105-2 at 2. This is incorrect. A patentee is obligated to disclose an algorithm only when the sole disclosed structure is a general purpose computer. *See Aristocrat Techs. Austl. PTY Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1334 (Fed. Cir. 2008) (holding that an algorithm must be disclosed where the specification “goes no farther than saying that the claimed functions are performed by a general purpose computer”); *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1383 (Fed. Cir. 2009) (holding that an algorithm must be disclosed where the patentee argued that the corresponding structure was “any computer-related device or program that performs the function”); *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1366-1367 (Fed. Cir. 2008) (holding that an algorithm must be disclosed where the identified corresponding structure was a “general purpose bank computer”); *Finisar Corp. v. DirectTV Group, Inc.*, 523 F.3d 1323, 1340-1341 (Fed. Cir. 2008) (holding that an algorithm must be disclosed where the specification simply recited “software”). Because the parties in this case agree that the ’802 patent discloses several alternative corresponding structures other than a general purpose computer, the ’802 patent need not disclose an algorithm.

Furthermore, the ’802 patent does disclose an algorithm to a person of ordinary skill in the art. *See* Dkt. No. 104-23 at ¶ 19. Wi-LAN’s expert declaration in support of its Opening Claim Construction Brief explains how Figures 1 and 4 of the ’802 patent disclose an algorithm for the “first computing means” claim terms. *Id.*

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A Motion for Summary Judgment is Inappropriate

Because the parties agree that the '802 patent discloses corresponding structure for the "first computing means," LGEMU's arguments are relevant only to claim construction and not to validity of the '802 patent. LGEMU's arguments are relevant only to whether the corresponding structure for the "first computing means" includes "a computing device programmed to perform the algorithms disclosed by the foregoing," as Wi-LAN proposes. Accordingly, LGEMU's arguments should be addressed in the claim construction process, and a motion for summary judgment is an inappropriate means to resolve this issue. The parties are currently engaged in the claim construction process for a March 11 hearing, and LGEMU provides no reason that this issue cannot be addressed as part of that process.

LGEMU Should be Precluded from Arguing Invalidity Under 35 U.S.C. §112(2)

On October 16, 2009, Defendants in the above captioned action (including LGEMU) served their invalidity contentions. In Section (D)(2), Defendants stated that:

The '802 patent's specification fails to disclose support for [the first computing means] as applied by Wi-LAN's assertions of infringement against the accused products. Claims 1, 17, 23, 33 and any claims dependent thereon are invalid for failing to comply with the enablement and/or written description requirements, or to particularly point out and distinctly claim the subject matter regarded as an invention as applied by Wi-LAN's assertions of infringement against the accused products.

However, Defendants have failed to provide any more specificity regarding the basis for their proposed invalidity arguments with respect to the "first computing means." (*See e.g.*, Jan. 7, 2010 letter from J. Taylor to J. Petrsoric failing to provide basis for invalidity arguments).

Defendants failed to provide any basis for their invalidity arguments with respect to the "first computing means" in their invalidity contentions. Instead, Defendants merely provided a stock paragraph alleging that numerous claim terms in the '802 patent are "invalid for failing to comply with the enablement and/or written description requirements, or to particularly point out

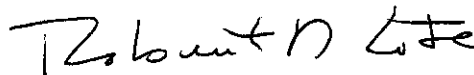
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and distinctly claim the subject matter regarded as an invention as applied by Wi-LAN's assertions of infringement against the accused products." Defendants' stock paragraph has failed to put Wi-LAN on notice as to Defendants' invalidity contentions and has resulted in prejudice to Wi-LAN. Moreover, Defendants' proposed claim constructions for the "first computing means" did not allege that the terms were invalid or that the specification failed to disclose corresponding structure. LGEMU should not now be heard to argue that the "first computing means" is invalid under 35 U.S.C. §112(2) when it has not previously put Wi-LAN on notice of this contention. See *Saffran v. Johnson & Johnson*, No. 2:07-CV-0451, 2009 U.S. Dist. LEXIS 19615, at *3 (E.D. Tex. Feb. 24, 2009) ("The patent rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed."). LGEMU should also not be allowed to unveil its invalidity contentions for the first time in a summary judgment motion when it has also refused to provide a substantive response to Wi-LAN's interrogatory regarding the bases for LGEMU's contention that the '802 patent is invalid for failure to comply with 35 U.S.C. §112.²

Accordingly, Wi-LAN respectfully requests that the Court deny permission for LGEMU to file a motion for summary judgment.

Respectfully submitted,



Robert A. Cote

Cc: Clerk of the Court
Counsel of Record

² LGEMU answered Wi-LAN's interrogatory requesting in detail all factual and legal bases for LGEMU's contentions that the claims of the '802 patent are invalid for failure to comply with the requirements of § 112 merely by incorporating its invalidity contentions.