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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

WI-LAN INC.; WI-LAN USA, INC.; and  
WI-LAN LABS, INC.,  
  
Plaintiffs,  
  
v.  
  
LG ELECTRONICS, INC.; LG  
ELECTRONICS U.S.A., INC; and LG  
ELECTRONICS MOBILECOMM  
U.S.A., INC.,  
  
Defendants.

Case No.: 18-cv-01577-H-AGS

**ORDER:**

**(1) GRANTING PLAINTIFFS’  
MOTION FOR PARTIAL  
SUMMARY JUDGMENT OF  
OBVIOUSNESS BASED ON IPR  
ESTOPPEL;**

[Doc. No. 187.]

**(2) DENYING DEFENDANTS’  
MOTION FOR SUMMARY  
JUDGMENT ON PRIORITY DATE  
AND INVALIDITY UNDER 35 U.S.C.  
§ 102;**

[Doc. No. 188.]

**(3) DENYING AS MOOT  
DEFENDANTS’ MOTION TO  
STRIKE THE ITO DECLARATION;  
AND**

[Doc. No. 238.]

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**(4) DENYING AS MOOT  
PLAINTIFFS' MOTION FOR  
LEAVE TO CONDUCT LIMITED  
DISCOVERY**

[Doc. No. 268.]

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On September 27, 2019, Plaintiffs Wi-LAN Inc., Wi-LAN USA, Inc., and Wi-LAN Labs, Inc. filed a motion for partial summary judgment of Defendants LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics Mobilecomm U.S.A., Inc.'s obviousness defense based on *inter partes* review estoppel under 35 U.S.C. § 315(e)(2). (Doc. No. 187.) On September 27, 2019, LG filed a motion for summary judgment that the patents-in-suit are not entitled to their claimed priority dates and for summary judgment of invalidity under 35 U.S.C. § 102. (Doc. No. 188.) On October 11, 2019, the parties filed their respective responses in opposition to the motions for summary judgment. (Doc. Nos. 239, 240.) On October 18, 2019, the parties filed their respective replies. (Doc. No. 265, 266.)

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In addition, on October 11, 2019, LG filed a motion to strike the declaration of Richard Ito that was filed as an exhibit to Wi-LAN's motion for partial summary judgment of IPR estoppel. (Doc. No. 238.) On October 14, 2019, Wi-LAN filed a response in opposition to LG's motion to strike. (Doc. No. 251.) On October 18, 2019, Wi-LAN filed a motion for leave to conduct limited discovery. (Doc. No. 268.) On October 23, 2019, LG filed a response in opposition to Wi-LAN's motion for leave. (Doc. No. 277.)

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The Court held a hearing on the matters on November 1, 2019. Leslie V. Payne, Eric J. Enger, and Christopher M. First appeared for Wi-LAN. Richard D. Harris, James J. Lukas, and Matthew J. Levinstein appeared for LG. For the reasons below, the Court: (1) grants Wi-LAN's motion for partial summary judgment of LG's obviousness defense based on IPR estoppel; (2) denies LG's motion for summary judgment of priority date and

1 for summary judgment of invalidity under 35 U.S.C. § 102; (3) denies as moot LG’s motion  
2 to strike the Ito declaration; and (4) denies as moot Wi-LAN’s motion for leave to conduct  
3 additional discovery.

## 4 Background

### 5 **I. Procedural History**

6 On July 11, 2018, Wi-LAN filed a complaint for patent infringement against LG,  
7 alleging infringement of U.S. Patent Nos. 8,787,924, 8,867,351, 9,226,320, and 9,497,743.  
8 (Doc. No. 1, Compl.) Specifically, Wi-LAN alleges that LG’s wireless communication  
9 products that are compliant with the 3rd Generation Partnership Project 4G LTE standard  
10 directly infringe the patents-in-suit. (*Id.* ¶¶ 37, 40, 53, 66, 79.)

11 On October 10, 2018, LG filed an answer to Wi-LAN’s complaint along with  
12 counterclaims for: (1) declaratory judgments of non-infringement and invalidity of the  
13 patents-in-suit; (2) declaratory judgment of unenforceability for failure to disclose to  
14 standard setting organizations; (3) declaratory judgment of unenforceability of the ’351  
15 patent due to infectious unenforceability; (4) declaratory judgment that LG is entitled to  
16 license the patents-in-suit on FRAND/RAND terms and conditions; (5) breach of contract;  
17 (6) monopolization and attempted monopolization in violation of section 2 of the Sherman  
18 Act; and (7) unfair business practices under California Business and Profession Code §  
19 17200 *et seq.* (Doc. No. 17.)

20 On April 12, 2019, the Court granted in part and denied in part Wi-LAN’s motions  
21 to dismiss LG’s counterclaims, and the Court dismissed with prejudice LG’s counterclaim  
22 for declaratory judgment of unenforceability of the ’351 patent due to infectious  
23 unenforceability. (Doc. No. 79.) On May 28, 2019, the Court issued a claim construction  
24 order in the action. (Doc. No. 112.) On September 3, 2019, the Court issued an amended  
25 scheduling order. (Doc. No. 143.)

26 On October 24, 2019, the Court issued an order on the parties’ first set of motions  
27 for summary judgment. (Doc. No. 278.) Specifically, the Court: (1) denied LG’s two  
28 motions for summary judgment of non-infringement of the patents-in-suit; (3) granted

1 LG's motion for summary judgment of no willful infringement; (4) granted in part and  
2 denied in part LG's motion for summary judgment of its patent exhaustion defense; (5)  
3 denied Wi-LAN's cross-motion for summary judgment of no patent exhaustion based on  
4 the Qualcomm-SOMA agreements; and (6) granted Wi-LAN's motion for summary  
5 judgment of LG's standard development organization defenses and counterclaims. (*Id.* at  
6 79.) In so doing, the Court granted summary judgment in favor of LG on: (1) Wi-LAN's  
7 claim for willful infringement of the patents-in-suit; and (2) LG's patent exhaustion  
8 defense as to the '351 patent based on the 2000 Qualcomm-SOMA agreement. (*Id.*) And  
9 the Court granted summary judgment in favor of Wi-LAN on: (1) LG's defense and  
10 counterclaim of unenforceability for failure to disclose to standard setting organizations;  
11 (2) LG's defense and counterclaim that LG is entitled to license the patents-in-suit on  
12 FRAND/RAND terms and conditions; (3) LG's counterclaim for monopolization; (4) LG's  
13 counterclaim for attempted monopolization; and (5) LG's counterclaim for unfair business  
14 practices under California's UCL. (*Id.*)

15 By the present remaining motions for summary judgment: (1) Wi-LAN moves for  
16 partial summary judgment of LG's obviousness defense as to the '743 patent based on IPR  
17 estoppel under 35 U.S.C. § 315(e)(2); and (2) LG moves for summary judgment that the  
18 asserted claims of the patents-in-suit are not entitled to their claimed priority dates, and,  
19 therefore, are invalid under 35 U.S.C. § 102. (Doc. No. 187-1 at 1; Doc. No. 188-1 at 1.)

## 20 **II. The Patents-in-Suit**

21 In the present action, Wi-LAN asserts infringement of claims 1, 2, 5, 6, 17, and 19  
22 of the '924 patent, claims 6-9 of the '743 patent, and claims 7 and 10-12 of the '351 patent.<sup>1</sup>  
23 (Doc No. 207, Ex. 2 Lomp Expert Report ¶¶ 78, 86, 100, 114, 184, 256.)  
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26 <sup>1</sup> Although Wi-LAN alleges infringement of the '320 patent in the complaint, Wi-LAN does not  
27 currently assert infringement of any of the claims from that patent in this action. (See generally Doc No.  
28 207, Ex. 2 Lomp Expert Report.) On July 22, 2019, the Patent Trial and Appeal Board issued a final  
written decision in the *inter partes* review proceedings for the '320 patent, concluding that claims 1, 3, 4,  
8-10, 12, 15-17, 20, 21, 25, 27, and 30 of the '320 patent are unpatentable on obviousness grounds. See

1           A.     The '924 Patent and the '743 Patent

2           The '924 patent and the '743 patent are both entitled “Method and Systems for  
3 Transmission of Multiple Modulated Signals Over Wireless Networks” and share a  
4 common specification. U.S. Patent No. 8,787,924, at (54) (filed Jul. 22, 2014); U.S. Patent  
5 No. 9,497,743, at (54) (filed Nov. 15, 2016). The invention disclosed in the '924 patent  
6 and the '743 patent “relates to wireless communication systems, and more particularly to  
7 a method and apparatus for efficiently allocating bandwidth between base stations and  
8 customer premises equipment in a broadband wireless communication system.” '924  
9 Patent at 1:23-27. Independent Claim 1 and independent claim 17 of the '924 patent are  
10 the only asserted independent claims from that patent, and independent claim 6 of the '743  
11 patent is the only asserted independent claim from that patent.

12           Independent claim 1 of the '924 Patent provides:

13           1. A method of operating a wireless cellular mobile unit registered with a base  
14 station in a bandwidth on demand wireless cellular communication system,  
15 the method comprising:

16           transmitting from the wireless cellular mobile unit a one bit message  
17 requesting to be provided an allocation of uplink (UL) bandwidth in which to  
18 transmit a bandwidth request for at least one connection served by the wireless  
19 cellular mobile unit;

20           receiving at the wireless cellular mobile unit the allocation of UL bandwidth  
21 in which to transmit the bandwidth request, the allocation of UL bandwidth  
22 received pursuant to the one bit message;

23           transmitting from the wireless cellular mobile unit the bandwidth request  
24 within the allocation of UL bandwidth, the bandwidth request being indicative  
25 of a pending amount of UL data associated with the at least one connection;

26           receiving at the wireless cellular mobile unit an UL bandwidth grant for the  
27 wireless cellular mobile unit, the UL bandwidth grant received pursuant to the  
28 bandwidth request; and

          allocating the received UL bandwidth grant to at least two UL connections  
          served by the wireless cellular mobile unit, based on a QoS parameter of the

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28     LG Electronics, Inc. v. Wi-LAN Inc., Case No. IPR 2018-00705, Paper No. 36 at 55 (P.T.A.B. Jul. 22, 2019).

1 at least two UL connections.

2 Id. at 22:42-67.

3 Independent claim 17 of the '924 Patent provides:

4 A method of allocating uplink (UL) bandwidth on demand in a wireless  
5 communication network, wherein a wireless cellular mobile unit is registered  
6 with, and communicating with a base station, the method comprising:

7 transmitting from the wireless cellular mobile unit a one bit message to the  
8 base station to request an allocation of UL bandwidth in which to transmit a  
9 bandwidth request;

10 receiving at the wireless cellular mobile unit the allocation of UL bandwidth  
11 in which to transmit the bandwidth request;

12 transmitting to the base station, within the allocation of UL bandwidth, the  
13 bandwidth request indicative of an amount of pending UL data;

14 receiving from the base station an UL bandwidth grant for the wireless cellular  
15 mobile unit; and

16 transmitting to the base station UL data of the pending UL data pursuant to  
17 the UL bandwidth grant;

18 wherein the transmitted UL data is transmitted for at least two UL services  
19 and wherein the UL data is transmitted for the at least two UL services based  
20 on a QoS parameter of a respective service from the at least two UL services.

21 Id. at 24:19-40.

22 Independent claim 6 of the '743 Patent provides:

23 A cellular telephone operable to communicate with a base station in a wireless  
24 communication system, the cellular telephone comprising:

25 one or more processors having a Media Access Controller (MAC) operable to  
26 queue data pertaining to a first uplink (UL) connection between the cellular  
27 telephone and the base station, the data associated with a respective priority;  
28 and

a transceiver operable to

transmit a message requesting the base station to poll the cellular telephone,  
in response to the message, receive an indication of a first UL transmission  
resource,

transmit information to the base station within the first UL transmission  
resource, the information indicative of an amount of data awaiting

1 transmission to the base station over the first UL connection between the  
2 cellular telephone and the base station, and

3 receive, in downlink control information, an allocation of a second UL  
4 transmission resource for the cellular telephone in response to the information  
5 indicative of an amount of data awaiting transmission to the base station over  
6 the first UL connection between the cellular telephone and the base station.

’743 Patent at 24:53-25:9.

7 B. The ’351 Patent

8 The ’351 Patent is entitled “apparatus, system and method for the transmission of  
9 data with different QoS attributes.” U.S. Patent No. 8,867,351, at (54) (filed Oct. 21, 2014).

10 The invention disclosed in the ’351 patent “relates to an apparatus, system and method for  
11 providing and managing QoS for data flows transmitted over at least one link in a data  
12 network capable of transmitting data with different [quality of service] QoS requirements  
13 and/or attributes.” Id. at 1:21-26. Independent claim 7 of the ’351 patent is the only  
14 asserted independent claim from that patent.

15 Claim 7 of the ’351 patent claims:

16 1. A mobile device for transmitting data using a data transmission capacity,  
17 comprising:

18 a link controller operable to:

19 operate a plurality of logical channel queues for transmitting data, each of the  
20 logical channel queues is capable of being associated with a priority and a  
21 traffic shaping rate,

22 select, from the plurality of logical channel queues, a highest priority logical  
23 channel queue having data available for transmission and whose traffic  
24 shaping rate is not reached,

25 allocate a portion of the data transmission capacity to the selected logical  
26 channel queue, wherein the allocated portion is limited by the traffic shaping  
27 rate associated with the selected logical channel queue, by the data available  
28 for transmission in the selected logical channel queue, and by the data  
transmission capacity,

repeatedly consider a next highest priority logical channel queue to select and  
allocate, until at least one of: the data transmission capacity is exhausted, and  
each one of the plurality of logical channel queues is considered, and

1 thereafter

2 allocate a remaining portion, if any, of the data transmission capacity to one  
3 or more of the logical channel queues having data for transmission, selected  
4 in priority order; and

5 a radio transceiver for transmitting and receiving data, wherein the radio  
6 transceiver transmits the data according to the link controller allocation.

’351 Patent at 14:31-59.

## 7 Discussion

### 8 **I. Legal Standards for a Motion for Summary Judgment**

9 Summary judgment is appropriate under Rule 56 of the Federal Rules of Civil  
10 Procedure if the moving party demonstrates that there is no genuine issue of material fact  
11 and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); Celotex Corp.  
12 v. Catrett, 477 U.S. 317, 322 (1986). A fact is material when, under the governing  
13 substantive law, it could affect the outcome of the case. Anderson v. Liberty Lobby, Inc.,  
14 477 U.S. 242, 248 (1986); Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt.,  
15 Inc., 618 F.3d 1025, 1031 (9th Cir. 2010). “A genuine issue of material fact exists when  
16 the evidence is such that a reasonable jury could return a verdict for the nonmoving party.”  
17 Fortune Dynamic, 618 F.3d at 1031 (internal quotation marks and citations omitted);  
18 accord Anderson, 477 U.S. at 248. “Disputes over irrelevant or unnecessary facts will not  
19 preclude a grant of summary judgment.” T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors  
20 Ass’n, 809 F.2d 626, 630 (9th Cir. 1987).

21 A party seeking summary judgment always bears the initial burden of establishing  
22 the absence of a genuine issue of material fact. Celotex, 477 U.S. at 323. The moving  
23 party can satisfy this burden in two ways: (1) by presenting evidence that negates an  
24 essential element of the nonmoving party’s case; or (2) by demonstrating that the  
25 nonmoving party failed to establish an essential element of the nonmoving party’s case that  
26 the nonmoving party bears the burden of proving at trial. Id. at 322-23; Jones v. Williams,  
27 791 F.3d 1023, 1030 (9th Cir. 2015). Once the moving party establishes the absence of a  
28 genuine issue of material fact, the burden shifts to the nonmoving party to “set forth, by



1 affidavit or as otherwise provided in Rule 56, ‘specific facts showing that there is a genuine  
2 issue for trial.’” T.W. Elec. Serv., 809 F.2d at 630 (quoting former Fed. R. Civ. P. 56(e));  
3 accord Horphag Research Ltd. v. Garcia, 475 F.3d 1029, 1035 (9th Cir. 2007). To carry  
4 this burden, the non-moving party “may not rest upon mere allegation or denials of his  
5 pleadings.” Anderson, 477 U.S. at 256; see also Behrens v. Pelletier, 516 U.S. 299, 309  
6 (1996) (“On summary judgment, . . . the plaintiff can no longer rest on the pleadings.”).  
7 Rather, the nonmoving party “must present affirmative evidence . . . from which a jury  
8 might return a verdict in his favor.” Anderson, 477 U.S. at 256.

9 When ruling on a summary judgment motion, the court must view the facts and draw  
10 all reasonable inferences in the light most favorable to the non-moving party. Scott v.  
11 Harris, 550 U.S. 372, 378 (2007). The court should not weigh the evidence or make  
12 credibility determinations. See Anderson, 477 U.S. at 255. “The evidence of the non-  
13 movant is to be believed.” Id. Further, the Court may consider other materials in the record  
14 not cited to by the parties, but it is not required to do so. See Fed. R. Civ. P. 56(c)(3);  
15 Simmons v. Navajo Cnty., 609 F.3d 1011, 1017 (9th Cir. 2010).

## 16 **II. Wi-LAN’s Motion for Partial Summary Judgment of IPR Estoppel**

17 Wi-LAN moves for partial summary judgment of LG’s obviousness defense as to  
18 the ’743 patent. (Doc. No. 187-1 at 12.) Specifically, Wi-LAN argues that 35 U.S.C. §  
19 315(e)(2) estops LG from asserting invalidity of the ’743 patent based on all of its asserted  
20 obviousness combinations because LG reasonably could have raised them in the *inter*  
21 *partes* review proceedings for that patent. (Id. at 1.) In response, LG argues that Wi-  
22 LAN’s motion should be denied because invalidity grounds that are not instituted as part  
23 of an IPR are not estopped under § 315(e)(2). (Doc. No. 239 at 1.)

### 24 **A. Relevant Background**

25 On February 22, 2018, LG filed a petition for *inter partes* review of the ’743 patent  
26 with the Patent Trial and Appeals Board, arguing that claims 1-4 and 6-9 of the ’743 patent  
27 should be cancelled as unpatentable. (Doc. No. 187-3, Ex. 1.) On September 6, 2018, the  
28 PTAB issued a decision granting institution of *inter partes* review “as to all of the

1 challenged claims of the '743 patent" on the sole ground asserted in the petition: whether  
2 the challenged claims "are unpatentable as obvious over the combination of Hulyalkar and  
3 Agrawal." (Doc. No. 187-4, Ex. 2 at 2, 29-30.) On October 1, 2018, Wi-LAN filed a  
4 disclaimer of claims 1-5 of the '743 patent with the PTO, leaving claims 6-9 as the  
5 remaining claims in the IPR. (Doc. No. 239-2, Ex. A.) On September 5, 2019, the PTAB  
6 issued a final written decision in the IPR finding that LG "ha[d] not demonstrated by a  
7 preponderance of the evidence that claims 6-9 of U.S. Patent No. 9,497,743 are  
8 unpatentable." (Doc. No. 187-5, Ex. 3 at 29.)

9 On September 20, 2019, pursuant to the Court's July 1, 2019 order granting the  
10 parties' joint motion to limit the number of asserted claims and prior art in this action, LG  
11 reduced its number of invalidity references down to five specific obviousness combinations  
12 as to the '743 patent. (Doc. No. 187-11, Ex. 9; see also Doc. No. 119.) Consistent with  
13 this, LG's invalidity expert asserted invalidity of the '743 patent under § 103 based on only  
14 those five obviousness combinations. (Doc. No. 188-5, Ex. 2 Proctor Expert Report ¶¶  
15 118, 288-378.)

16 LG's five obviousness combinations as to the '743 patent are summarized in Table  
17 I below:

18 **Table I**

19 <b>Combination #</b>	20 <b>Combination</b>
21 1	22 Chuah and Kari
23 2	24 DOCSIS and Eng
25 3	26 Fischer and Sigle
27 4	28 Karol and Sigle
5	Fischer and Karol and Sigle

1 Each of the above obviousness grounds is based on a combination of various patents and/or  
2 printed publications.<sup>2</sup> (See Doc. No. 187-8 at 5-32 (LG’s invalidity contentions listing  
3 these prior art references under the header “Patents/Published Patent  
4 Applications/Publications”).) The first two obviousness combinations – “Chuah and Kari”  
5 and “DOCSIS and Eng” – were first asserted on October 20, 2017 and January 16, 2018,  
6 respectively, when LG served Wi-LAN with its infringement contentions in the prior  
7 action. (See Doc. No. 187-6, Ex. 4 at 17, 18, 19; Doc. No. 187-7, Ex. 5 at 27-28.) The last  
8 three obviousness combinations – “Fischer and Sigle,” “Karol and Sigle,” and “Fischer and  
9 Karol and Sigle” – were first asserted on January 25, 2019, when LG served Wi-LAN with  
10 its infringement contentions in this action. (Doc. No. 187-8, Ex. 6 at 15, 17, 18.)

11 **B. Legal Standards for IPR Estoppel**

12 Section 315(e)(2) of the Patent Act states:

13 The petitioner in an *inter partes* review of a claim in a patent under this  
14 chapter that results in a final written decision . . . may not assert . . . in a civil  
15 action arising in whole or in part under section 1338 of title 28 . . . that the  
16 claim is invalid on any ground that the petitioner raised or reasonably could  
17 have raised during that *inter partes* review.

18 35 U.S.C. § 315(e)(2). In an IPR, a petitioner is limited to challenging patent claims as  
19 invalid only on grounds “that could be raised under section 102 or 103 and only on the  
20 basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Thus,  
21 section 315(e)(2) estoppel applies when: (1) a final written decision is issued in an IPR; (2)  
22 the contention at issue asserts invalidity under §§ 102 or 103 based only on prior art

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23 <sup>2</sup> “Chuah” refers to U.S. Patent No. 6,115,390. “Kari” refers to U.S. Patent No. 6,603,738.  
24 “DOCSIS” refers to DOCSIS Data-Over-Cable Service Interface Specifications, SP-RFIV1.1-I04-980724  
25 (“DOCSIS 1998”) and DOCSIS Data-Over-Cable Service Interface Specifications, SPRFIV.1.1-101-  
26 990311 (“DOCSIS 1999”). “Eng” refers to U.S. Patent No. 5,751,708 issued to Kai Yin Eng and Mark  
27 Karol Fischer refers to Fischer et al., “MAC Protocol for a CDMA Based Wireless ATM LAN,”  
28 Proceedings of ICC ’97—International Conference on Communications. “Sigle” refers to Sigle et al.,  
“Impact of Wireless Access on Traffic Management in ATM Networks,” Computer Networks: The  
International Journal of Computer and Telecommunications Networking, Vol. 31, Issue 9-10. “Karol”  
refers to Karol et al., “Distributed-Queuing Request Update Multiple Access (DQRUMA) for Wireless  
Packet (ATM) Networks,” Proceedings of ICC ’95—International Conference on Communications. (Doc.  
No. 187-8, Ex. 6 at 15, 17, 18, 20-21, 22, 32; Doc. No. 239 at 2-3.)

1 consisting of patents or printed publications; and (3) the contention at issue either was  
2 raised or reasonably could have been raised during the IPR.

3 As an initial matter, the parties dispute the proper interpretation of the phrase “could  
4 have raised during that *inter partes* review.” LG argues that the Federal Circuit’s decision  
5 in Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc. 817 F.3d 1293, 1300 (Fed. Cir.  
6 2016), prevents the application of estoppel under § 315(e)(2) on grounds not raised in the  
7 IPR. (Doc. No. 239 at 4-5.) The Court disagrees.

8 Shaw involved an appeal from a PTAB decision to only partially institute an IPR.  
9 The PTAB had partially denied institution of an IPR on the basis that certain prior art  
10 grounds in the IPR petition were “redundant.” Id. at 1297. In the decision, the Federal  
11 Circuit first concluded that the PTAB’s decision to partially grant IPR institution as to only  
12 certain grounds and deny institution of other grounds in a petition was unappealable. Id.  
13 at 1299 (“We have no authority . . . to review the Board’s decision to institute IPR on some  
14 but not all grounds.”). The Federal Circuit then commented that, as to the “redundant”  
15 invalidity grounds where the PTAB denied IPR institution (*i.e.*, the unappealable portion  
16 of the decision with no resulting final written decision), IPR estoppel would not attach. Id.  
17 at 1300. Relying on an interpretation of the plain language of § 315(e)(2), the Federal  
18 Circuit reasoned that the non-instituted ground was not a ground raised or that reasonably  
19 could have been raised “during that *inter partes* review” because “[t]he IPR does not begin  
20 until it is instituted.” Id.; see also HP Inc. v. MPHJ Tech. Inv., LLC, 817 F.3d 1339, 1347  
21 (Fed. Cir. 2016) (interpreting the analogous estoppel provision that applies to Patent Office  
22 proceedings, Section 315(e)(1), and concluding that the estoppel provision of § 315(e)(1)  
23 “do not apply” to non-instituted grounds).

24 LG argues that under Shaw, IPR estoppel only applies to the grounds that were  
25 actually considered during the IPR. (Doc. No. 239 at 4.) LG further argues, therefore, IPR  
26 estoppel does not apply to non-petitioned grounds. (Id.) In response, Wi-LAN argues that  
27 multiple courts have rejected LG’s interpretation of § 315(e)(2) in light of the Supreme  
28 Court’s recent decision in SAS Inst., Inc. v. Iancu, 138 S. Ct. 1348 (2018). (Doc. No. 265

1 at 1-2.)

2 In SAS, the Supreme Court interpreted 35 U.S.C. § 318(a) and held that if an IPR is  
3 instituted, the PTAB “must address every claim the petitioner has challenged.” 138 S. Ct.  
4 at 1354. In so holding, the Court explained that § 318(a) forbids the PTAB’s partial  
5 institution practice of instituting review as to only certain claims challenged in an IPR  
6 petition. See id. at 1355-59. As a result, if the PTAB grants an IPR petition, the PTAB  
7 must now institute review on all claims and all grounds. See id.; BioDelivery Sci. Int’l,  
8 Inc. v. Aquestive Therapeutics, Inc., 898 F.3d 1205, 1209-10 (Fed. Cir. 2018) (“We agree  
9 that SAS requires institution on all challenged claims and all challenged grounds.”); PGS  
10 Geophysical AS v. Iancu, 891 F.3d 1354, 1360 (Fed. Cir. 2018). Indeed, “[i]n the wake of  
11 the SAS decision, the Patent and Trademark Office issued a ‘guidance’ in April 2018  
12 announcing that any petition instituted would be instituted on all claims and all grounds  
13 raised.” Palomar Techs., Inc. v. MRSI Sys., LLC, 373 F. Supp. 3d 322, 328 (D. Mass.  
14 2019) (citing U.S. Patent & Trademark Office, Guidance on the Impact of SAS on AIA  
15 Trial Proceedings (Apr. 26, 2018), [https://www.uspto.gov/patents-application-](https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial)  
16 [process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial](https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial)).

17 In light of the Supreme Court’s clarification of § 318(a), LG’s argument that IPR  
18 estoppel does not apply to non-petitioned grounds is untenable. SAS rendered the  
19 circumstances addressed by the Federal Circuit in Shaw a nullity. There can no longer be  
20 such a thing as a non-instituted ground, *i.e.*, a ground raised in an IPR petition that the  
21 PTAB declines to review when granting institution of the IPR. As such, for the phrase  
22 “reasonably could have been raised during that *inter partes* review” in 35 U.S.C. §  
23 315(e)(2) to have any meaning, it must refer to grounds that were not actually in the IPR  
24 petition, *i.e.*, non-petitioned grounds, but “reasonably could have been” included in the  
25 petition. See Palomar Techs., 373 F. Supp. 3d at 331. As a result, the Court rejects LG’s  
26 contention that IPR estoppel does not apply to non-petitioned grounds. See, e.g., Nielsen  
27 v. Preap, 139 S. Ct. 954, 969 (2019) (rejecting an interpretation of a statute that “flouts the  
28 interpretive canon against surplusage—the idea that ‘every word and every provision is to

1 be given effect”).

2 Indeed, every post-SAS district court decision the Court has found addressing IPR  
3 estoppel and Shaw has rejected the contention that IPR estoppel does not apply to non-  
4 petitioned grounds. See, e.g., Palomar Tech., 373 F. Supp. 3d at 328-29, 331; Am. Tech.  
5 Ceramics Corp. v. Presidio Components, Inc., No. 14CV6544KAMGRB, 2019 WL  
6 365709, at \*3–5 (E.D.N.Y. Jan. 30, 2019); California Inst. of Tech. v. Broadcom Ltd., No.  
7 CV 16-3714 GW (AGRX), 2018 WL 7456042, at \*4–8 (C.D. Cal. Dec. 28, 2018); Trustees  
8 of Columbia Univ. v. Symantec Corp., 390 F. Supp.3d 665, 676-81 (E.D. Va. 2019);  
9 SiOnyx, LLC v. Hamamatsu Photonics K.K., 330 F. Supp. 3d 574, 599–601 (D. Mass.  
10 2018). In particular, the Court finds the analysis presented in the Cal. Inst. of Tech. v.  
11 Broadcom Ltd. and Trustees of Columbia Univ. v. Symantec Corp. decisions well-reasoned  
12 and persuasive. See 2018 WL 7456042, at \*4–8; 390 F. Supp. 3d at 676-81. And LG has  
13 not provided the Court with any post-SAS case law to the contrary.<sup>3</sup>

14 As such, under § 315(e)(2), LG is estopped from claiming invalidity on any non-  
15 petitioned ground that it “reasonably could have raised” in its IPR petition. Courts have  
16 interpreted the phrase “reasonably could have raised” to mean “any patent or printed  
17 publication that a petitioner actually knew about or that ‘a skilled searcher conducting a  
18 diligent search reasonably could have been expected to discover.’” Palomar Techs., 373  
19

20  
21 <sup>3</sup> LG argues that it is unfair to apply the Supreme Court’s decision in SAS against it because SAS  
22 was issued after the deadline passed for LG to amend its IPR petition or file additional IPR petitions  
23 against the ’743 patent. (Doc. No. 239 at 6-7.) The Court rejects this argument. Even if the Supreme  
24 Court never issued SAS, LG would still be unable to rely on Shaw.

25 Here, unlike in Shaw, LG’s IPR petition was granted as to all claims and on all grounds raised in  
26 the petition. (See Doc. No. 187-4, Ex. 2 at 2, 29-30.) As such, there were no non-instituted grounds in  
27 LG’s IPR proceedings. Thus, Shaw’s holding is inapplicable to LG’s circumstances. See Douglas  
28 Dynamics, LLC v. Meyer Prod. LLC, No. 14-CV-886-JDP, 2017 WL 1382556, at \*5 (W.D. Wis. Apr.  
18, 2017) (Following Shaw, “this court will not apply § 315(e)(2) estoppel to non-instituted grounds, but  
it will apply § 315(e)(2) estoppel to grounds not asserted in the IPR petition, so long as they are based on  
prior art that could have been found by a skilled searcher’s diligent search.); Oil-Dri Corp. of Am. v.  
Nestle Purina Petcare Co., No. 15-CV-1067, 2017 WL 3278915, at \*6–9 (N.D. Ill. Aug. 2, 2017); Biscotti  
Inc. v. Microsoft Corp., No. 213CV01015JRGRSP, 2017 WL 2526231, at \*4–7 (E.D. Tex. May 11, 2017).

1 F. Supp. 3d at 331; California Inst. of Tech., 2018 WL 7456042, at \*8; Tinnus Enterprises,  
2 LLC v. Telebrands Corp., No. 6:17-CV-00170-RWS, 2018 WL 3993468, at \*3 (E.D. Tex.  
3 Aug. 21, 2018); Parallel Networks Licensing, LLC v. Int’l Bus. Machines Corp., No. CV  
4 13-2072 (KAJ), 2017 WL 1045912, at \*11 (D. Del. Feb. 22, 2017); Douglas Dynamics,  
5 2017 WL 1382556, at \*5; see also, e.g., Apotex Inc., v. Wyeth LLC, No. IPR2015-00873,  
6 2015 WL 5523393, at \*4 (P.T.A.B. Sept. 16, 2015). The party asserting estoppel bears the  
7 burden to show that estoppel applies. Oil-Dri Corp. of Am. v. Nestlé Purina Petcare Co.,  
8 No. 15 C 1067, 2019 WL 861394, at \*10 (N.D. Ill. Feb. 22, 2019); see Palomar Techs.,  
9 373 F. Supp. 3d at 332; f’real! Foods, LLC v. Hamilton Beach Brands, Inc., No. CV 16-  
10 41-CFC, 2019 WL 1558486, at \*1 (D. Del. Apr. 10, 2019).

11 C. Analysis of Combinations One and Two

12 Wi-LAN argues that LG should be estopped from asserting its first two obviousness  
13 combinations –“Chuah and Kari” and “DOCSIS and Eng” – as to the ’743 patent because  
14 LG knew of these grounds before it filed its IPR petition. (Doc. No. 187-1 at 6.) To support  
15 this argument, Wi-LAN points to LG’s invalidity contentions in the prior action. (Id.)

16 LG’s invalidity contentions in the prior action identified Chuah, Kari, DOCSIS, and  
17 Eng as prior art references and identified these two specific obviousness combinations.  
18 (See Doc. No. 187-6, Ex. 4 at 17, 18, 19, chart at 46; Doc. No. 187-7, Ex. 5 at 27-28, chart  
19 at 87.) These invalidity contentions were served on October 20, 2017 and January 16,  
20 2018, respectively, prior to the filing of LG’s IPR petition on February 22, 2018. (Id.)  
21 Several district courts have held that the identification of prior art in invalidity contentions  
22 generated prior to the filing of the IPR petition is sufficient to establish as matter of law  
23 that the accused infringer knew of those prior art references, and, thus, that the references  
24 “reasonably could have [been] raised” in the IPR. See, e.g., Trustees of Columbia Univ.,  
25 390 F. Supp. 3d at 678 (granting motion for summary judgment of IPR estoppel based on  
26 the invalidity grounds at issue being previously identified in invalidity contentions); Polaris  
27 Indus., Inc. v. Arctic Cat Inc., No. CV 15-4475 (JRT/TNL), 2019 WL 3824255, at \*3 (D.  
28 Minn. Aug. 15, 2019) (same); Parallel Networks Licensing, 2017 WL 1045912, at \*11-12

1 (same); Douglas Dynamics, 2017 WL 1382556, at \*5. LG offers no argument in response  
2 on this issue. (See generally Doc. No. 239.) As such, LG is estopped under § 315(e)(2)  
3 from asserting that the ‘743 patent is invalid based on obviousness in light of the “Chuah  
4 and Kari” and the “DOCSIS and Eng” combinations.

5 D. Analysis of Combinations Three, Four, and Five

6 Wi-LAN also contends that LG should be estopped from asserting its last three  
7 obviousness combinations – “Fischer and Sigle,” “Karol and Sigle,” and “Fischer and  
8 Karol and Sigle” – because LG would have found these prior art references through a  
9 diligent search. (Doc. No. 187-1 at 7-12.) In response, LG argues that there is at least  
10 triable issue of fact as to whether it could have raised the references at issue during the IPR.  
11 (Doc. No. 239 at 7-12.)

12 Under the skilled searcher standard, in order to establish that these obviousness  
13 combinations could have been raised in the IPR, Wi-LAN must show “that a skilled  
14 searcher conducting a diligent search reasonably could have been expected to discover”  
15 the references at issue. Palomar Techs., 373 F. Supp. 3d at 331; California Inst. of Tech.,  
16 2018 WL 7456042, at \*8. Here, Wi-LAN argues that the fact that LG eventually found the  
17 three references at issue through a prior art search is compelling evidence itself that LG  
18 reasonably could have discovered these references through a diligent search. (Doc. No.  
19 265 at 3.) The Court agrees.

20 LG’s own evidence, a declaration from LG’s counsel, states that LG discovered  
21 Fischer, Karol and Sigle after it conducted a search for potential prior art. (Doc. No. 239-  
22 1, Lukas Decl. ¶ 7.) Evidence that LG discovered these references through a prior art  
23 search is clear evidence that LG reasonably could have discovered these references through  
24 a diligent search. This is evidence, even when viewed in the light most favorable to LG,  
25 is sufficient to establish that LG “reasonable could have raised” its obviousness contentions  
26 based on those references in the IPR.

27 The Court acknowledges that the declaration states that LG’s counsel did not come  
28 into possession of these references until January 17, 2019. (Id.) And the Court notes the



1 declaration does not state when this prior art search was performed, and when LG itself  
2 came into possession of the references. (See id.) But even assuming the search was  
3 performed in January 2019, LG has not identified any barriers or difficulties that would  
4 cause the prior art search at issue to produce different results had it been ran a year earlier,  
5 prior to the filing of its IPR petition.

6 In addition, there is evidence in the record showing that Karol, Fischer, and Sigle  
7 could have been found through a reasonable search via the IEEE Xplore tool. (See Doc.  
8 No. 187-19, Ex. 17; Doc. No. 187-23, Ex. 21.) And there is further evidence in the record  
9 showing that the IEEE Xplore Digital Library was a tool utilized by LG to discover prior  
10 art used in its IPR. (See Doc. No. 187-20, Ex. 18 Hsieh-Yee Decl. ¶¶ 3-10.)

11 Further, with respect to Karol, Karol is cited in four prior art references that were  
12 contained in LG’s invalidity contentions in the prior action, which were served prior to the  
13 filing of LG’s IPR petition. (Doc. No. 187-2, First Decl. Exs. 11, 12, 13, 14; see id. Ex. 5  
14 at 10, 18-19, Chart at 37-68.) One of those references is “Chuah,” a reference that LG’s  
15 invalidity expert opined on and that LG selected as one of its final 20 references in this  
16 case. (Doc. No. 188-5, Ex. 2 Proctor Expert Report ¶¶ 118, 288-307; Doc. No. 187-11,  
17 Ex. 9.) In addition, Karol is a co-inventor on the “Eng” reference. U.S Patent No.  
18 5,751,706 (filed May 12, 1998). “Eng” is also a reference that LG’s invalidity expert  
19 opined on and that LG selected as one of its final 20 references in this case. (Doc. No. 188-  
20 5, Ex. 2 Proctor Expert Report ¶¶ 118, 308-318; Doc. No. 187-11, Ex. 9.) Further, there is  
21 un rebutted expert testimony in the record opining that the relevant disclosures in Karol are  
22 identical to the relevant disclosures in Eng. (Doc. No. 255, Gitlin Expert Report ¶ 383.)  
23 Finally, both Fischer and Sigle cite to Karol. (Doc. No. 187-2, First Decl. Exs. 19, 20.)  
24 This additional evidence provides further support for the conclusion that LG could have  
25 found these references though a reasonably diligent search.

26 In sum, Wi-LAN has proven as a matter of law that Fischer, Sigle, and Karol could  
27 have been discovered through a reasonably diligent search and could have been raised in  
28 LG’s IPR petition. As such, LG is estopped under § 315(e)(2) from asserting that the ’743

1 patent is invalid based on obviousness in light of the “Fischer and Sigle,” the “Karol and  
2 Sigle,” and the “Fischer and Karol and Sigle” obviousness combinations.

3 E. Conclusion

4 In sum, the Court grants Wi-LAN’s motion for partial summary judgment of LG’s  
5 obviousness defense based on IPR estoppel under 35 U.S.C. § 315(e)(2). Specifically, the  
6 Court grants summary judgment in favor of Wi-LAN on LG’s defense and counterclaim  
7 of invalidity of the ’743 patent based on obviousness under the “Chuah and Kari,”  
8 “DOCSIS and Eng,” “Fischer and Sigle,” “Karol and Sigle,” and “Fischer and Karol and  
9 Sigle” obviousness combinations.<sup>4</sup>

10 **III. LG’s Motion for Summary Judgment that the Claims of the Patents-in-Suit are**  
11 **Not Entitled to Their Claimed Priority Dates and that the Claims are Invalid Under**  
12 **35 U.S.C. § 102**

13 LG moves for summary judgment that all of the asserted claims of the patents-in-  
14 suit are invalid under 35 U.S.C. § 102 as anticipated by Release 8 of the 3GPP LTE  
15 Standard. (Doc. No. 188-1 at 1.) To support this contention, LG also moves for summary  
16 judgment that the asserted claims of the patents-in-suit are not entitled to their claimed  
17 priority dates and are instead entitled to priority dates no earlier than the respective filing  
18 dates of the applications for the patents-in-suit: October 11, 2012, June 12, 2015, and May  
19 30, 2014, respectively. (*Id.* at 1, 18.) LG explains that once the asserted claims are given  
20 their filing dates as their priority dates, it is clear that all of the claims are anticipated by

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21  
22 <sup>4</sup> On October 11, 2019, LG filed a motion to strike the declaration of Richard Ito that was filed as  
23 an exhibit to Wi-LAN’s motion for partial summary judgment of IPR estoppel. (Doc. No. 238.) The  
24 Court’s analysis and resolution of Wi-LAN’s motion for summary judgment does not reference or rely on  
25 the Ito declaration. *See supra*. As such, the Court denies LG’s motion to strike the Ito declaration as  
26 moot.

27 In addition, On October 18, 2019, Wi-LAN filed a motion for leave to conduct certain discovery  
28 on subject matter purportedly placed into issue by the Lukas declaration and LG’s arguments relying on  
the Lukas declaration that were presented in LG’s opposition to Wi-LAN’s motion for summary judgment  
of IPR. (Doc. No. 268.) The Court has granted Wi-LAN’s motion for partial summary judgment of IPR  
estoppel. As such, the Court denies Wi-LAN’s motion for leave to conduct additional discovery on this  
issue as moot.

1 the 3GPP LTE Standard, which was publicly released in December 2008. (Id. at 18.)

2 A. Legal Standards Governing Priority Date

3 “To obtain the benefit of the filing date of a parent application, the claims of the  
4 later-filed application must be supported by the written description in the parent.”  
5 Anascape, Ltd. v. Nintendo of Am. Inc., 601 F.3d 1333, 1335 (Fed. Cir. 2010); see  
6 Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1571 (Fed. Cir. 1997). Under 35 U.S.C.  
7 § 112, the “specification shall contain a written description of the invention . . . .” To  
8 satisfy the written description requirement of § 112, “the description must ‘clearly allow  
9 persons of ordinary skill in the art to recognize that [the inventor] invented what is  
10 claimed.’” Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010)  
11 (en banc). Thus, “‘the test for sufficiency’ of a patent’s written description ‘is whether the  
12 disclosure of the application relied upon reasonably conveys to those skilled in the art that  
13 the inventor had possession of the claimed subject matter as of the filing date.’” Centrak,  
14 Inc. v. Sonitor Techs., Inc., 915 F.3d 1360, 1365 (Fed. Cir. 2019) (quoting Ariad Pharms.,  
15 598 F.3d at 1351).

16 The Federal Circuit has explained that “the test requires an objective inquiry into the  
17 four corners of the specification from the perspective of a person of ordinary skill in the  
18 art. Based on that inquiry, the specification must describe an invention understandable to  
19 that skilled artisan and show that the inventor actually invented the invention claimed.”  
20 Ariad, 598 F.3d at 1351. The Federal Circuit has further explained that “determining  
21 whether a patent complies with the written description requirement will necessarily vary  
22 depending on the context. Specifically, the level of detail required to satisfy the written  
23 description requirement varies depending on the nature and scope of the claims and on the  
24 complexity and predictability of the relevant technology.” Id. (citation omitted).

25 “Compliance with the written description requirement is a question of fact, but is  
26 amenable to summary judgment in cases where no reasonable fact finder could return a  
27 verdict for the non-moving party.” ScriptPro LLC v. Innovation Assocs., Inc., 833 F.3d  
28 1336, 1340 (Fed. Cir. 2016) (quoting PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d

1 1299, 1307 (Fed. Cir. 2008)); see also Ariad Pharms., 598 F.3d at 1351 (The written  
2 description “inquiry, as we have long held, is a question of fact.”); Amgen Inc. v. Hoechst  
3 Marion Roussel, Inc., 314 F.3d 1313, 1330 (Fed. Cir. 2003) (characterizing the written  
4 description inquiry as “fact intensive”).

#### 5 B. Legal Standards Governing Anticipation

6 A patent claim is invalid if the claimed invention was “patented, described in a  
7 printed publication, or in public use, on sale, or otherwise available to the public before the  
8 effective filing date of the claimed invention.” 35 U.S.C. § 102(a). “For a claim to be  
9 anticipated, each claim element must be disclosed, either expressly or inherently, in a single  
10 prior art reference.” Therasense, Inc. v. Becton, Dickinson & Co., 593 F.3d 1325, 1332  
11 (Fed. Cir. 2010); see Schering Corp. v. Geneva Pharm., 339 F.3d 1373, 1379 (Fed. Cir.  
12 2003).

13 “Anticipation, though a question of fact, may be resolved on summary judgment if  
14 no genuine issue of material fact exists.” OSRAM Sylvania, Inc. v. Am. Induction Techs.,  
15 Inc., 701 F.3d 698, 704 (Fed. Cir. 2012). “Summary judgment is proper if no reasonable  
16 jury could find that the patent is not anticipated.” Zenith Elecs. Corp. v. PDI Commc’n  
17 Sys., Inc., 522 F.3d 1348, 1357 (Fed. Cir. 2008). At summary judgment, the Court “must  
18 also take into account that invalidity of a patent must be shown by clear and convincing  
19 evidence.” Ivera Med. Corp. v. Hospira, Inc., 801 F.3d 1336, 1343 (Fed. Cir. 2015); see  
20 Microsoft Corp. v. i4i Ltd. P’ship, 564 U.S. 91, 95 (2011).

#### 21 C. The ’743 Patent

22 As an initial matter, Wi-LAN argues that the Court should deny LG’s motion as to  
23 the ’743 patent because LG’s contention that the ’743 patent is anticipated under § 102 by  
24 Release 8 of the 3GPP LTE standard is barred by IPR estoppel under 35 U.S.C. § 315(e)(2).  
25 (Doc. No. 240 at 13-14.) Wi-LAN argues that because LG knew about the 3GPP LTE  
26 standard prior to filing its IPR petition as to the ’743 patent, LG’s anticipation contention  
27 based on the 3GPP LTE standard “reasonably could have [been] raised” in LG’s IPR  
28 petition. (Id.)

1 LG's initial invalidity contentions in the prior action identified the 3GPP LTE  
2 standard as a prior art reference, and the contentions were served on October 20, 2017, well  
3 before the filing of LG's IPR petition on February 22, 2018. (See Doc. No. 187-6, Ex. 4  
4 at 26.) Indeed, in the prior action, on February 2, 2018, also prior to the filing of LG's IPR  
5 petition, LG filed a similar motion for summary judgment arguing that the asserted claims  
6 of the '743 patent are anticipated by the 4G LTE standard because the claims are not  
7 entitled to their claimed priority date. See Wi-LAN Inc. v. LG Electronics, Inc., No. 3:17-  
8 cv-00358-BEN-MDD, Docket No. 90 at 1722, 24-25 (S.D. Cal., Feb. 2, 2018) (citing  
9 "3GPP TS 36.300 V8.12.0 (2010-03); 3GPP TS 36.331 V8.21.0 (2014-06); 3GPP TS  
10 36.321 V8.12.0 (2012-03); 3GPP TS 36.213 V8.8.0 (2009-09); 3GPP TS 23.203 V8.14.0  
11 (2012-06);" and Wi-LAN's infringement contentions asserting "that products complying  
12 with the 3GPP LTE Standards (release 8+) infringe the patents-in-suit"). Further,  
13 anticipation under § 102 based on an intervening prior reference and a challenged priority  
14 date is a ground that can be raised in an IPR petition. See Thermo Fisher Scientific Inc. v.  
15 Regents of University of Cal., No. IPR2018-01347, 2019 WL 318641, at \*8 (P.T.A.B. Jan.  
16 22, 2019) (rejecting the patentee's argument that the PTAB cannot make a priority  
17 determination during an IPR even in circumstances where that determination "effectively  
18 coalesces with a written description analysis of the challenged claims' own specification").

19 In light of the above, it is clear that LG's contention that Release 8 of the 3GPP LTE  
20 standard anticipates the asserted claims of the '743 patent is a ground that LG "reasonably  
21 could have raised" in its IPR petition. LG offers no argument to the contrary. (See  
22 generally Doc. No. 266.) As such, LG is estopped under § 315(e)(2) from asserting that  
23 the '743 patent is invalid based on anticipation by Release 8 of the 3GPP LTE standard.  
24 See Trustees of Columbia Univ., 390 F. Supp. 3d at 678 (granting motion for summary  
25 judgment of IPR estoppel based on the invalidity grounds at issue being previously  
26 identified in invalidity contentions); Polaris, 2019 WL 3824255, at \*3 (same); Parallel  
27 Networks Licensing, 2017 WL 1045912, at \*11-12 (same); Douglas Dynamics, 2017 WL  
28 1382556, at \*5. As a result, the Court denies LG's motion for summary judgment that the

1 '743 patent is invalid under § 102 because it is not entitled to its claimed priority date.

2 D. Burden of Proof

3 As a second initial matter, the parties dispute who bears the burden of proving  
4 priority date here. LG argues that the patentee bears the burden of proving that it is entitled  
5 to its claimed priority date. (Doc. No. 188-1 at 5-6, 12.) In response, Wi-LAN argues that  
6 LG must first establish a *prima facie* case of invalidity, and only then does it shift the  
7 burden of production to Wi-LAN. (Doc. No. 240 at 2.) Wi-LAN further argues that even  
8 if the burden of production shifts, the ultimate burden of persuasion to prove invalidity by  
9 clear and convincing evidence remains with LG. (Id. at 3.)

10 In PowerOasis, Inc. v. T-Mobile USA, Inc., the Federal Circuit explained that the  
11 party asserting invalidity under an intervening prior art reference must “show by clear and  
12 convincing evidence that the asserted patent is invalid” under that reference. 522 F.3d at  
13 1305. Once the accused infringer “has established a *prima facie* case of invalidity and its  
14 burden is met,” the burden shifts to the patentee “to come forward with evidence to prove  
15 entitlement to claim priority to an earlier filing date.” Id. at 1305–06; accord Tech.  
16 Licensing Corp. v. Videotek, Inc., 545 F.3d 1316, 1329 (Fed. Cir. 2008).<sup>5</sup> The Federal  
17 Circuit has subsequently clarified that this burden shifting shifts only the burden of  
18

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19 <sup>5</sup> The Court notes that PowerOasis involved a dispute concerning whether a continuation-in-part  
20 patent was entitled to claim priority to the date of the original parent application. See 522 F.3d at 1303–  
21 05. In adopting this burden shifting approach, the Federal Circuit in PowerOasis noted:

22 Determining the effective filing date each claim in a CIP application is entitled to can be  
23 quite complex. Since CIPs generally add new matter, the claims may be fully supported  
24 by the parent application or they may rely on the new matter for support. In fact, a CIP  
25 could contain different claims entitled to receive different effective filing dates in the same  
patent. There would be no reason for the PTO to undertake what could be a very time  
consuming written description analysis simply to pronounce the effective filing date of  
each claim, absent some dispute over it during prosecution.

26 Id. at 1305 n.4. The Court notes that the '924 patent is a continuation, not a continuation-in-part, of U.S.  
27 Application No. 09/316,518. '924 Patent at (63); cf. Transco Prod. Inc. v. Performance Contracting, Inc.,  
28 38 F.3d 551, 555–56 (Fed. Cir. 1994) (explaining the difference between a continuation, a divisional, and  
a continuation-in-part). Nevertheless, Wi-LAN does not argue that PowerOasis's burden shifting  
approach does not apply in these circumstances.

1 production from the accused infringer to the patentee. See Tech. Licensing, 545 F.3d at  
2 1329; Dynamic Drinkware, LLC v. Nat’l Graphics, Inc., 800 F.3d 1375, 1378–79 (Fed.  
3 Cir. 2015) (“[T]he burden of production, or the burden of going forward with evidence, is  
4 a shifting burden.”). The burden of persuasion to prove invalidity by clear and convincing  
5 evidence never shifts and remains with the accused infringer. See Tech. Licensing, 545  
6 F.3d at 1329 (“[B]ecause an issued patent is by statute presumed valid, a challenger has  
7 the burden of persuasion to show by clear and convincing evidence that the contrary is true.  
8 That ultimate burden never shifts . . . .”); Dynamic Drinkware, 800 F.3d at 1378 (“The  
9 burden of persuasion . . . never shifts to the patentee.”); see, e.g., Titan Tire Corp. v. Case  
10 New Holland, Inc., 566 F.3d 1372, 137677 (Fed. Cir. 2009); see also Microsoft, 564 U.S.  
11 at 95.

12 Here, LG contends that the asserted claims of the ’924 patent and the ’351 patent are  
13 all invalid as anticipated under 35 U.S.C. § 102 by Release 8 of the 3GPP LTE standard.  
14 (Doc. No. 188-1 at 18.) LG explains that because the asserted claims are entitled to a  
15 priority date of no earlier than their actual filing dates – October 11, 2012 and May 30,  
16 2014, respectively – the claims are anticipated by Release 8 of the 3GPP LTE standard,  
17 which was publicly released in December of 2008. (Id.) LG’s anticipation argument is  
18 based on Wi-LAN’s assertion that mobile devices that are compliant with the 3GPP LTE  
19 standard infringe the patents-in-suit. (See Doc. No. 240-1 at 25-26 ¶¶ 50 (“Wi-LAN has  
20 asserted that the fact LG’s Accused Products comply with Release 8 of the 3GPP LTE  
21 standard is evidence they infringe the patents-in-suit.”); Doc. No. 254 at 19 (“Dr. Lomp  
22 provides extensive analysis showing that the accused devices’ compliance with the LTE  
23 Standards means infringement.”); Doc. No. 253 at 10 (“all LTE standards infringe”); Doc.  
24 No. 207, Ex. 2 Lomp Expert Report ¶¶ 102-111, 114, 256; Doc. No. 1, Compl ¶¶ 13, 27-  
25 29, 37, 41, 67.) This is sufficient to establish a *prima facie* case of invalidity under § 102  
26 as to the asserted claims of the ’924 patent and the ’351 patent. See Bristol-Myers Squibb  
27 Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1378 (Fed. Cir. 2001) (“[I]t is axiomatic that  
28 that which would literally infringe if later anticipates if earlier.”); Los Angeles Biomedical

1 Research Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co., 849 F.3d 1049, 1069 (Fed.  
2 Cir. 2017).

3 Wi-LAN argues that LG should not be permitted to contend that the 3GPP LTE  
4 standard anticipates the patents-in-suit because LG did not assert anticipation under  
5 Release 8 of 3GPP LTE standard in its invalidity contentions. (Doc. No. 240 at 13, 20.)  
6 In response, LG argues that it is not required to chart intervening prior art references under  
7 the Court’s Patent Local Rules. (Doc. No. 266 at 6 n.12.)

8 Under the Court’s Patent Local Rules, an accused infringer’s invalidity contentions  
9 must contain, among other things: (1) “The identity of each item of prior art that allegedly  
10 anticipates each asserted claim or renders it obvious;” and (2) “A chart identifying where  
11 specifically in each alleged item of prior art each element of each asserted claim is found.”  
12 S.D. Cal. Patent L.R. 3.3 (a), (c). In its April 5, 2019 amended invalidity contentions and  
13 its July 17, 2019 second amended invalidity contentions in this action, LG identified “[t]he  
14 3GPP LTE Standard” as a §§ 102, 103 prior art reference to the patents-in-suit. (Doc. No.  
15 187-9, Ex. 7 at 33; Doc. No. 187-10, Ex. 8 at 34.) Further, in the contentions, LG  
16 specifically contended that the asserted claims of the patents-in-suit are anticipated by the  
17 4G LTE standard, and LG cited to Wi-LAN’s amended infringement contentions and LG’s  
18 motion for summary judgment that was filed in the prior action, which contained the same  
19 invalidity and priority date arguments as the present motion. (Doc. No. 187-9 at 5 n.3;  
20 Doc. No. 187-10, Ex. 8 at 6 n.4.) Under these particular circumstances, where the  
21 anticipation contention is based on an intervening prior art reference and the patentee’s  
22 own infringement allegations and contentions, and the specific theory of invalidity was  
23 already disclosed in a previously filed motion for summary judgment that is cited in the  
24 invalidity contentions, LG’s July 17, 2019 amended invalidity contentions were sufficient  
25 to disclose Release 8 of the 3GPP LTE Standard as an anticipatory reference in compliance  
26 with the Court’s Patent Local Rules. As such, the Court rejects Wi-LAN’s argument.

27 Wi-LAN also argues that LG has failed to establish a *prima facie* case of anticipation  
28 because LG has not satisfied the Vanmoor exception. (Doc. No. 240 at 14, 20.) In support



1 of this argument, Wi-LAN cites to a district court case holding that: “The Vanmoor  
2 exception requires an identity between the accused product and the asserted prior art, at  
3 least with respect to the aspects of the product that are accused of infringement.”  
4 Metaswitch Networks Ltd. v. Genband US LLC, No. 2:14-CV-744-JRG-RSP, 2016 WL  
5 3618831, at \*7 (E.D. Tex. Mar. 1, 2016) (citing Vanmoor v. Wal-Mart Stores, Inc., 201  
6 F.3d 1363, 1366 (Fed. Cir. 2000)). Wi-LAN further argues that LG has failed to present  
7 any admissible evidence showing that any accused products were sold before the filing  
8 dates of the ’924 patent or the ’351 patent. (Doc. No. 240 at 14.) Wi-LAN’s reliance on  
9 the Vanmoor exception is misplaced. Here, LG’s intervening anticipatory prior art  
10 reference is not one of its own accused products, but the 3GPP LTE standard itself. (Doc.  
11 No. 188-1 at 18.) Wi-LAN does not dispute that the 3GPP LTE standard was publicly  
12 released in 2008. (Doc. No. 240-1 at 26-27 ¶ 51; Doc. No. 207, Ex. 2 Lomp Expert Report  
13 ¶ 108.)

14 In sum, because LG has established a *prima facie* case of invalidity based on Release  
15 8 of the 3GPP LTE standard, Wi-LAN bears the burden “to come forward with evidence  
16 to prove entitlement to claim priority to an earlier filing date.” PowerOasis, 522 F.3d at  
17 1305–06. Nevertheless, LG still retains the ultimate burden of persuasion to prove  
18 invalidity of the ’924 patent and the ’351 patent by clear and convincing evidence. See  
19 Tech. Licensing, 545 F.3d at 1329; Dynamic Drinkware, 800 F.3d at 1378.

#### 20 E. The ’924 Patent

21 LG argues that Wi-LAN cannot establish that the asserted claims of ’924 patent are  
22 entitled to their claimed priority date because the application to which they claim priority,  
23 U.S. Application No. 09/316,518 (“the ’518 App.”), describes only a fixed, single-cell  
24 system with fixed customer premises equipment. (Doc. No. 188-1 at 6-11.) LG argues  
25 that the ’518 App. does not disclose “wireless cellular mobile unit[s]” or a “bandwidth on  
26 demand wireless cellular communication system.” (Id. at 9-11.) In response, Wi-LAN  
27 argues that the disclosures in ’518 App. are sufficient to support the claims. (Doc. No. 240  
28 at 4-6.)

1 Independent claim 1 of the '924 patent claims: "A method of operating a wireless  
2 cellular mobile unit registered with a base station in a bandwidth on demand wireless  
3 cellular communication system." '924 Patent at 22:42-44. Independent claim 17 of the  
4 '924 patent claims: "A method of allocating uplink (UL) bandwidth on demand in a  
5 wireless communication network, wherein a wireless cellular mobile unit is registered with,  
6 and communicating with a base station." Id. at 24:19-22.

7 LG argues that the '518 App. does not disclose a "wireless cellular mobile unit" or  
8 a multi-cell wireless cellular communication system. (Doc. No. 188-1 at 9-11.) LG argues  
9 that the '518 App. does not describe cellular telephones, wireless cellular mobile units, or  
10 any other non-fixed equipment that communicates with a base station. (Id. at 9.) LG notes  
11 that the '518 App. never uses the specific term "wireless cellular mobile unit." (Id.) But  
12 "the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the  
13 description requirement of § 112." Union Oil Co. of Cal. v. Atl. Richfield Co., 208 F.3d  
14 989, 1000 (Fed. Cir. 2000).

15 In his report, Wi-LAN's validity expert, Dr. Gitlin, opines that the '518 App.  
16 contains sufficient disclosures such that a person of ordinary skill would recognize that the  
17 inventors possessed the claimed "wireless cellular mobile unit." (Doc. No. 255, Dr. Gitlin  
18 Expert Report ¶¶ 1141-45.) In support of this opinion, Dr. Gitlin cites to the following two  
19 passages in the '518 App: "1. Field of the Invention [¶] This invention relates to wireless  
20 communication systems." (Doc. No. 188-4, Ex. 1 at 1:13-14.) "[A] wireless  
21 communication system facilitates two-way communication between a plurality of  
22 subscriber radio stations or wireless subscriber radio units (fixed and portable) and a fixed  
23 network infrastructure. Exemplary communication systems include mobile cellular  
24 telephone systems, personal communication systems (PCS), and cordless telephones." (Id.  
25 at 1:19-23.) Dr. Gitlin opines that the '518 App.'s disclosure that the claimed "wireless  
26 communication system" can include "portable" subscriber units, including specifically  
27 "mobile cellular telephone systems" and "personal communication systems" is sufficient  
28 to convey to a person of ordinary skill that the claimed invention could include mobile

1 cellular phones and personal communication phones. (Doc. No. 255, Dr. Gitlin Expert  
2 Report ¶ 1142.) This is sufficient to raise a genuine issue of material fact as to whether the  
3 '518 App. discloses a “wireless cellular mobile unit.” See Vasudevan Software, Inc. v.  
4 MicroStrategy, Inc., 782 F.3d 671, 683 (Fed. Cir. 2015) (““As a general rule, summary  
5 judgment is inappropriate where an expert’s testimony supports the nonmoving party’s  
6 case.” (quoting Provenz v. Miller, 102 F.3d 1478, 1490 (9th Cir. 1996))).

7 LG argues that Dr. Gitlin’s reliance on the above passages in the '518 App. are  
8 flawed because the second passage comes a portion of the application entitled “Description  
9 of Related Art.” LG notes that the Court stated in the claim construction order that this  
10 “portion of the specification ‘is not describing the claimed invention. Rather, the  
11 specification is describing prior art.’” (Doc. No. 188-1 at 10 (citing Doc. No. 112 at 10;  
12 see also id. at 16 (“Rather, the specification is describing certain prior art systems.”)); Doc.  
13 No. 266 at 3.) But LG’s reliance on this part of the Court’s claim construction order is  
14 misplaced and fails to appreciate the differing legal standards that are at issue. First, in the  
15 cited portion of the claim construction order, the Court was not addressing the passage at  
16 issue; rather, the Court addressed a different passage that was contained in the “Description  
17 of Related Art” section. (See Doc. No. 112 at 10.)

18 Second, in that part of the claim construction order, the Court was addressing a  
19 proposed claim construction that sought to import a limitation from the passage at issue  
20 into the claims. (See Doc. No. 112 at 10.) The Federal Circuit has “warned against  
21 importing limitations from the specification into the claims absent a clear disclaimer of  
22 claim scope.” Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1373 (Fed. Cir.  
23 2007); see Digital-Vending Servs. Int’l, LLC v. Univ. of Phoenix, Inc., 672 F.3d 1270,  
24 1276 (Fed. Cir. 2012); Dealertrack, Inc. v. Huber, 674 F.3d 1315, 1327 (Fed. Cir. 2012).  
25 The Court explained that a description of an exemplary broadband wireless communication  
26 system when describing prior art systems does not constitute a clear disclaimer of claim  
27 scope. (See Doc. No. 112 at 10.)

28 In contrast, here, the standard for determining the sufficiency of the '518 App.’s

1 written description is whether the '518 App.'s disclosure “‘reasonably conveys to those  
2 skilled in the art that the inventor had possession of the claimed subject matter as of the  
3 filing date.’” Centrak, 915 F.3d at 1365 (quoting Ariad, 598 F.3d at 1351). In this context,  
4 a description of various exemplary prior art wireless communication systems could satisfy  
5 this standard by conveying to one skilled in the art what could potentially be included  
6 within the claimed wireless communication system/network.

7 LG also argues that the '518 App.'s disclosure of a CPE within a fixed single cell  
8 wireless communication system is insufficient to support the asserted claims' wireless  
9 cellular mobile units for use with multiple base stations in a mobile multi-cell wireless  
10 communication system. (Doc. No. 188-1 at 11.) In response, Wi-LAN argues that LG's  
11 argument is based on its flawed premise that the '518 App is limited to a fixed, single-cell  
12 system.” (Doc. No. 240 at 9.)

13 Dr. Gitlin opines that a person of ordinary skill would recognize that the '518 App.'s  
14 disclosure of a “Customer Premise Equipment” or “CPE” is a non-limiting preferred  
15 embodiment of the invention. (Doc. No. 255, Gitlin Expert Report ¶ 1147.) In support of  
16 this, Dr. Gitlin cites to a passage in the '518 App. describing its disclosure of a broadband  
17 wireless communication system containing a plurality of CPEs as an “exemplary  
18 broadband wireless communication system.”<sup>6</sup> (Id. (citing Doc. No. 188-4, Ex. 1 at 2:13-  
19 14).) Dr. Gitlin further opines that a person of ordinary skill would recognize that a CPE  
20 can be a “wireless cellular mobile unit” and supports this opinion with citations to two  
21

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22  
23 <sup>6</sup> In response, Wi-LAN argues that a fixed CPE within a fixed single cell wireless communication  
24 system is the only embodiment disclosed in the '518 App. (Doc. No. 266 at 4.) But the Federal Circuit  
25 has explained that absent a clear disclaimer, a claimed invention is not limited to a specific preferred  
26 embodiment disclosed in the specification even if it is the only embodiment described. See Dealertrack,  
27 674 F.3d at 1327 (“[I]t is improper to read limitations from a preferred embodiment described in the  
28 specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic  
record that the patentee intended the claims to be so limited.”); accord GE Lighting Sols., LLC v.  
AgiLight, Inc., 750 F.3d 1304, 1309 (Fed. Cir. 2014); see also Saunders Grp., Inc. v. Comfortrac, Inc.,  
492 F.3d 1326, 1332 (Fed. Cir. 2007) (“A patent that describes only a single embodiment is not necessarily  
limited to that embodiment.”); Thorner v. Sony Computer Entm't Am. LLC, 669 F.3d 1362, 1366 (Fed.  
Cir. 2012).

1 patents from the relevant time period. (Id. ¶ 1148.)

2 In addition, Dr. Gitlin notes the '518 App.'s disclosure that subscriber units can be  
3 "portable" and within a "mobile cellular telephone system." (Id. at Doc. No. 188-4, Ex. 1  
4 at 21-22.) Dr. Gitlin further explains that in this passage the '518 App. states that it  
5 incorporates by reference a co-pending application that eventually issued as U.S. Patent  
6 No. 6,016,311, and that co-pending application expressly discloses multi-cell wireless  
7 communication systems. (Id. ¶ 1149.)

8 In response, LG argues that a wireless cellular mobile unit is not a CPE and cites to  
9 the opinions of its own technical expert. (Doc. No. 188-1 at 11 n.8 (citing Doc. No. 188-  
10 5, Ex. 2 Proctor Invalidity Report ¶ 411); see also Doc. No. 188-5, Ex. 2 Proctor Invalidity  
11 Report ¶¶ 400-12.) But these competing expert opinions at best only create a genuine issue  
12 of material fact as to whether the '518 App. discloses a "wireless cellular mobile unit."  
13 See Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp., 635 F.3d 1373,  
14 1384 (Fed. Cir. 2011) ("Where there is a material dispute as to the credibility and weight  
15 that should be afforded to conflicting expert reports, summary judgment is usually  
16 inappropriate."); Leggett & Platt, Inc. v. Hickory Springs Mfg. Co., 285 F.3d 1353, 1362  
17 (Fed. Cir. 2002) (finding summary judgment inappropriate because "the conflicting  
18 allegations of the experts here leave unresolved factual disputes").

19 Finally, Wi-LAN notes that it was the PTO examiner that amended the claims of the  
20 '924 patent to include the specific term "wireless cellular mobile unit." (Doc. No. 240-25,  
21 Ex. X at 359-63.) This provides further support for the notion that there is at least a genuine  
22 issue of material fact as to whether the '518 App. discloses a "wireless cellular mobile  
23 unit."<sup>7</sup> See Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1574–75  
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26 <sup>7</sup> LG argues that the examiner's amendments are not relevant because PTO "examiners do not make  
27 priority determinations except where necessary." (Doc. No. 266 at 3-4 n.7 (quoting PowerOasis, 522  
28 F.3d at 1305).) LG is correct that PTO examiners generally do not make priority determinations during  
prosecution, see PowerOasis, 522 F.3d at 1305, but examiners do evaluate whether proposed claims satisfy  
the written description requirement of § 112. See MPEP § 2163; see, e.g., Hyatt v. Dudas, 492 F.3d 1365,

1 (Fed. Cir. 1992). As such, the Court denies LG’s motion for summary judgment that the  
2 asserted claims of the ’924 patent are not entitled to their claimed priority date and,  
3 therefore, are invalid under § 102.<sup>8</sup>

4 F. The ’351 Patent

5 LG argues that Wi-LAN cannot establish that the asserted claims of the ’351 patent  
6 are entitled to their claimed priority date because the application to which they claim  
7 priority, Canadian Application No. 2,393,373 (“the ’373 App.”), does not disclose a “traffic  
8 shaping rate” as that term is used by the limitations of the asserted claims of the ’351 patent.  
9 (Doc. No. 188-1 at 12-18.) In response, Wi-LAN argues that LG’s priority date arguments  
10 as to the ’351 patent have already been rejected by the PTAB in the related IPR  
11 proceedings. (Doc. No. 240 at 14-16.) Wi-LAN further argues that its validity expert, Dr.  
12 Gitlin, has provided a sufficient analysis showing that there is ample support for every  
13 limitation in the ’351 patent in the ’373 App. (Id. at 14, 16-20.)

14 Independent claim 7 of the ’351 patent recites: “A mobile device . . . comprising: a  
15 link controller operable to: operate a plurality of logical channel queues for transmitting  
16 data, each of the logical channel queues is capable of being associated with a priority and  
17 a traffic shaping rate.” ’351 Patent at 14:31-37. In the Court’s claim construction order,  
18 the Court construed the term “traffic shaping rate” as “a limitation on the amount of data  
19 transmission capacity allocated to a particular logical channel queue, where the rate is used  
20 to regulate traffic flow on the network.” (Doc. No. 112 at 32.)

21 First, LG argues that the ’373 App. does not disclose a “traffic shaping rate.” (Doc.  
22

23  
24 1369–71 (Fed. Cir. 2007). At the hearing on the parties’ motions for summary judgment, LG asserted that  
the disclosures in the ’924 patent’s specification are equivalent to the disclosures in the ’518 App.

25 <sup>8</sup> In addition, the Court notes even if LG was not estopped under § 315(e)(2) from arguing that the  
26 ’743 patent is invalid under § 102 in light of the 3GPP LTE standard, LG would still not be entitled to  
27 summary judgment on this issue with respect to the ’743 patent. LG’s arguments regarding the priority  
28 date and validity of the ’743 patent are coextensive with its arguments regarding the priority date and  
validity of the ’924 patent. (See Doc. No. 188-1 at 6-12.) As such, even assuming estoppel did not apply,  
LG’s motion for summary judgment as to the ’743 patent would still be denied for the same reasons that  
the Court denies LG’s motion for summary judgment as to the ’924 patent.

1 No. 188-1 at 12-13.) LG notes that the specific term “traffic shaping rate” does not appear  
2 anywhere in the ’373 App. (Id. at 12.) But ““the invention claimed does not have to be  
3 described in *ipsis verbis* in order to satisfy the description requirement of § 112.”” Union  
4 Oil, 208 F.3d at 1000.

5 In his report, Wi-LAN’s validity expert, Dr. Gitlin, opines that the ’373 App.  
6 explicitly teaches traffic shaping by limiting the data rate (*i.e.*, a “traffic shaping rate”).  
7 (Doc. No. 255, Gitlin Expert Report ¶ 1172.) In support of this opinion, Dr. Gitlin cites to  
8 the follow portion of the ’351 patent’s specification:

9 Further, traffic shapers can be implemented and configured on a per logical  
10 channel basis. This allows, for example, voice telephony data to be  
11 transferred over link 40 as necessary, while other data types can be data rate  
12 limited according to parameters defined by the network operator. Thus, a  
13 telephony call can be conducted unimpeded while a file transfer or other large  
14 data transfer can be subject to a leaky bucket, or other traffic shaping process.

15 (Doc. No. 188-7, Ex. 7 at 17:3-7.) Dr. Gitlin opines that a person of ordinary skill in the  
16 art would understand the term “traffic shaping rate” from this disclosure even though the  
17 specification never expressly uses the exact term “traffic shaping rate.” (Doc. No. 255,  
18 Gitlin Expert Report ¶ 1172). In addition, there is testimony in the record from Wi-LAN’s  
19 technical expert, Dr. Lomp, stating that traffic shaping was known to those of ordinary skill  
20 in the art in July 2002, and citing to a textbook stating that the leaky bucket traffic shaping  
21 algorithm, referred to in the above passage, was known since at least 1986. (Doc. No. 240-  
22 22, Ex. U at 13.) This evidence is sufficient to raise a genuine issue of material fact as to  
23 whether the ’373 App. discloses a “traffic shaping rate.” See Vasudevan, 782 F.3d at 683;  
24 Provenz, 102 F.3d at 1490.

25 Second, LG argues that the ’373 App. does not disclose a link controller operating a  
26 plurality of logical channel queues, where “each of the logical channel queues is capable  
27 of being associated with . . . a traffic shaping rate.” (Doc. No. 188-1 at 14.) In his report,  
28 Dr. Gitlin notes that the ’351 patent’s specification expressly discloses that “RLC 140  
performs the prioritization, segmentation and, if desired, traffic shaping of data packets for  
transmission over the available radio resources.” (Doc. No. 255, Gitlin Expert Report ¶

1 1173 (quoting '351 Patent at 9:11-13); see also Doc. No. 188-7, Ex. 7 at 11:17-18.) “RLC”  
2 stands for “Radio Link Controller.” (Doc. No. 188-7, Ex. 7 at 10:5-6.) Dr. Gitlin further  
3 explains that the '373 App. expressly discloses that “traffic shapers can be implemented  
4 and configured on a per logical channel basis.” (Doc. No. 255, Gitlin Expert Report ¶ 1173  
5 (citing Doc. No. 188-7, Ex. 7 at 17:3-4).). This is sufficient to raise a genuine issue of  
6 material fact as to whether the '373 App. discloses the limitation at issue. See Vasudevan,  
7 782 F.3d at 683; Provenz, 102 F.3d at 1490.

8 Third, LG argues that the '373 App. does not disclose a link controller performing  
9 the claimed steps of “select[ing],” “allocate[ing],” and “repeatedly consider[ing]” using a  
10 “traffic shaping rate.” (Doc. No. 188-1 at 14-18.) In his report, Dr. Gitlin, consistent with  
11 the PTAB’s analysis, opines that the method recited in claim 1 of the '351 patent “‘is  
12 merely the method of Figure 5 in which the disclosed ‘optional’ traffic shaping is  
13 performed in the first iteration.” (Doc. No. 255, Gitlin Expert Report ¶ 1174-76 (quoting  
14 Doc. No. 240-22, Ex. U at 20); see Doc. No. 188-7, Ex. 7 at fig. 5). Dr. Gitlin opines,  
15 “[t]hus, Figure 5 read in conjunction with the other disclosures of the '373 App. and '351  
16 Patent shows a flow chart that performs traffic shaping as per the claims of the '351 Patent.”  
17 (Doc. No. 255, Gitlin Expert Report ¶¶ 1174.) This is sufficient to raise a genuine issue of  
18 material fact as to whether the '373 App. discloses the “select[ing],” “allocate[ing],” and  
19 “repeatedly consider[ing]” limitations. See Vasudevan, 782 F.3d at 683; Provenz, 102 F.3d  
20 at 1490.

21 Fourth, LG argues that Dr. Gitlin incorrectly assumed that LG bears the burden of  
22 proving that the claims are not entitled to the claimed priority date, and, therefore, his  
23 analysis is flawed because he fails to address every limitation in the asserted claims. (Doc.  
24 No. 188-1 at 12.) Here, Wi-LAN bears the burden to come forward with evidence to prove  
25 entitlement to claim priority to an earlier filing date. See supra. Nevertheless, Wi-LAN’s  
26 expert, Dr. Gitlin, does opine that the '373 App. discloses every limitation in the asserted  
27 claims. In his report, Dr. Gitlin, consistent with the PTAB’s analysis, affirmatively opines  
28 that the method recited in claim 1 of the '351 patent “‘is merely the method of Figure 5 in



1 which the disclosed ‘optional’ traffic shaping is performed in the first iteration.’” (Doc.  
2 No. 255, Gitlin Expert Report ¶¶ 1174-76 (quoting Doc. No. 240-22, Ex. U at 20). Dr.  
3 Gitlin supports this opinion with citations to the ’373 App. itself and citations to the  
4 PTAB’s detailed analysis of the disclosures contained in ’373 App. (See id. ¶¶ 1168-76.)  
5 In addition, Dr. Gitlin incorporates by reference into his analysis 15 pages of claim charts  
6 showing written description support for the ’351 patent’s claims. (See id. ¶ 1171, Ex. C.)  
7 As such, the Court rejects LG’s argument.

8 Finally, the Court notes that in the denying LG’s IPR petition, the PTAB rejected  
9 LG’s argument that the asserted claims of ’351 patent are not entitled to their claimed  
10 priority date because the ’373 App. does not disclose a “traffic shaping rate” or any method  
11 using a “traffic shaping rate.” (Doc. No. 240-22, Ex. U at 9-20.) The Court recognizes  
12 that the PTAB utilizes a different standard of review in deciding whether to grant IPR  
13 petitions than district courts utilize in deciding motions for summary judgment.<sup>9</sup>  
14 Nevertheless, the Court find the PTAB’s analysis of this issue well-reasoned, persuasive,  
15 and consistent with the Court’s conclusion that LG is not entitled to summary judgment on  
16 this issue. As such, the Court denies LG’s motion for summary judgment that the asserted  
17 claims of the ’351 patent are not entitled to their claimed priority date and, therefore, are  
18 invalid under § 102.

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26 <sup>9</sup> The PTAB may only institute an IPR if the petition and the response to the petition “shows that  
27 there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims  
28 challenged in the petition.” 35 U.S.C. § 314(a). The Court notes that this is a more lenient standard than  
the standard for establishing entitlement to summary judgment. Compare 35 U.S.C. § 314(a) with Fed.  
R. Civ. P. 56(a); Celotex, 477 U.S. at 322.

1 Conclusion

2 For the reasons above, the Court:

3 1. Grants Wi-LAN’s motion for partial summary judgment of LG’s obviousness  
4 defense based on IPR estoppel under 35 U.S.C. § 315(e)(2);

5 2. Denies LG’s motion for summary judgment of priority date and for summary  
6 judgment of invalidity under 35 U.S.C. § 102;

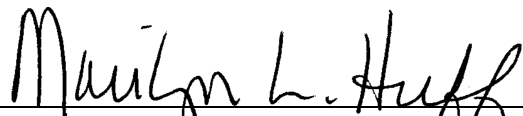
7 3. Denies as moot LG’s motion to strike the Ito declaration; and

8 4. Denies as moot Wi-LAN’s motion for leave to conduct additional discovery.

9 Specifically, the Court grants summary judgment in favor of Wi-LAN on LG’s defense  
10 and counterclaim of invalidity of the ’743 patent on the grounds of obviousness under the  
11 “Chuah and Kari,” “DOCSIS and Eng,” “Fischer and Sigle,” “Karol and Sigle,” and  
12 “Fischer and Karol and Sigle” obviousness combinations and anticipation by Release 8 of  
13 the 3GPP LTE standard.

14 **IT IS SO ORDERED.**

15 DATED: November 4, 2019

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18 MARILYN L. HUFF, District Judge  
19 UNITED STATES DISTRICT COURT  
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