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**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE DIVISION**

CORE WIRELESS LICENSING, S.A.R.L.,
 Plaintiff,

vs.

APPLE INC.,
 Defendant.

Case No. 5:15-cv-05008-NC

Assigned to The Honorable Nathanael M. Cousins

**[CORRECTED] FIRST AMENDED
 JOINT PRETRIAL CONFERENCE
 STATEMENT AND PROPOSED ORDER**

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Pursuant to the Court’s Trial Preparation Standing Order, the Case Management Scheduling Order (Dkt. No. 238), and the Court’s directive at the November 16, 2016 Pretrial Hearing, Plaintiff Core Wireless Licensing, S.A.R.L. (“Core Wireless”) and Defendant Apple Inc. (“Apple”) submit the following First Amended Joint Pretrial Conference Statement.

I. BRIEF DESCRIPTION OF THE ISSUES TO BE DECIDED

1. Whether Core Wireless can prove by a preponderance of the evidence that Apple directly infringed claim 19 of U.S. Patent No. 6,633,536 under 35 U.S.C. § 271(a).

2. Whether Core Wireless can prove by a preponderance of the evidence that Apple directly infringed claim 14 of U.S. Patent No. 6,477,151 under 35 U.S.C. § 271(a).

3. Whether Apple can prove by clear and convincing evidence that one or more asserted claims of the ‘536 and/or ‘151 patents are invalid under 35 U.S.C. § 102 (pre-AIA).

4. Whether Apple can prove by clear and convincing evidence that one or more asserted claims of the ‘536 and/or ‘151 patents are invalid under 35 U.S.C. § 103 (pre-AIA).

5. If infringement of one or more valid claim is found, the amount of damages proven by Core Wireless, if any.

6. Whether Apple can prove by clear and convincing evidence that the ‘151 and/or ‘536 patents is unenforceable due to unclean hands, waiver, and/or equitable estoppel¹;

7. Whether Core Wireless is entitled to its attorney fees, costs and disbursements under 35 U.S.C. § 285;

8. Whether Apple is entitled to its costs, disbursements and reasonable attorneys’ fees under 35 U.S.C. § 285.

II. DESCRIPTION OF THE RELIEF SOUGHT AND THE EVIDENTIARY MATERIAL TO BE PRESENTED IN SUPPORT OF SUCH RELIEF

A. Plaintiff’s Statement

¹ The Court has “bifurcate[d] the equitable issues and will hear them during a break in trial.” Dkt 362.

1 1. Core Wireless seeks a finding that Apple has directly infringed a) claim 19
2 of the '536 patent, and b) claim 14 of the '151 patent. Core Wireless intends to present evidence
3 including, but not limited to, testimony and accompanying exhibits from: Core Wireless's
4 technical expert, Dr. Richard Wesel and the inventors of the asserted patents. Core Wireless also
5 may call the witnesses identified on its "may call" list, live or by deposition, as necessary and
6 appropriate, including technical personnel of Apple, personnel from third parties AT&T,
7 Qualcomm and Cetecom.

8 2. Core Wireless seeks damages pursuant to 35 U.S.C. § 284 for Apple's
9 infringement and induced infringement to compensate Core Wireless for past and any continuing
10 and future infringement of the patents-in-suit. Core Wireless intends to present evidence
11 including, but not limited to, testimony and exhibits to accompany testimony from Stephen Dell,
12 John Lindgren, Core Wireless's technical experts and the inventors of the patents in suit. Core
13 Wireless also may call the witnesses identified on its "may call" list, live or by deposition, as
14 necessary and appropriate, including licensing and business personnel of Apple, personnel of
15 Nokia, and personnel of Microsoft.

16 3. Core Wireless will seek an award of prejudgment and post-judgment
17 interest.

18 4. Core Wireless will seek an award of attorney fees pursuant to 35 U.S.C. §
19 285, and interests, costs, and disbursements as justified under 35 U.S.C. § 284 and/or Fed. R.
20 Civ. P. 54.

21 **B. Apple's Separate Statement**

22 Apple seeks the following relief:

23 1. That the Court find and declare, and enter judgment, in favor of Apple and
24 against Core Wireless that Apple does not infringe and has not infringed any of the asserted
25 patents. Apple intends to present evidence on non-infringement including, but not limited to,
26 testimony and exhibits to accompany testimony from its experts, Dr. Buehrer, Dr. Knightly, and
27 Dr. Walker. Apple also may call the witnesses identified on its "may call" list, live or by
28 deposition, including Apple's Bernd Adler, employees of Qualcomm, Microsoft, Sterling

1 Partners, Core Wireless / Conversant, the inventors of the asserted patents, and cross examine
2 Core Wireless's technical expert, Dr. Richard Wesel, and the inventors of the asserted patents, if
3 they are called to testify at trial;

4 2. That the Court find and declare, and enter judgment, in favor of Apple and
5 against Core Wireless that each and every asserted patent claim is invalid. Apple intends to
6 present evidence on invalidity including, but not limited to, testimony and exhibits to accompany
7 testimony from its experts, Dr. Buehrer and Dr. Knightly. Apple also may call the witnesses
8 identified on its "may call" list, live or by deposition, as necessary and appropriate, including
9 employees of Qualcomm, Microsoft, Sterling Partners, Core Wireless / Conversant, the inventors
10 of the asserted patents, and cross examine Core Wireless's technical expert, Dr. Richard Wesel,
11 and the inventors of the asserted patents, if they are called to testify at trial;

12 3. That the Court find and declare, and enter judgment, in favor of Apple and
13 against Core Wireless that the asserted patents are unenforceable under the principles of waiver,
14 equitable estoppel, and unclean hands. This includes a finding that Nokia breached its obligation
15 to disclose the patents in suit as relevant intellectual property rights (IPRs) during the standardization
16 of the relevant cellular standards at ETSI and 3GPP, while advocating for the adoption of
17 technologies into those standards that it apparently believed were covered by the patents now
18 asserted against Apple. This also includes a finding that Core Wireless is equitably estopped from
19 enforcing the patents based on Nokia's statements and misleading omissions during Nokia's
20 licensing negotiations with Apple. Apple intends to present evidence on its waiver, equitable
21 estoppel, and unclean hands defense including, but not limited to, testimony and exhibits to
22 accompany testimony from Apple's experts, Dr. Michael Walker and/or Dr. Michael Buehrer.
23 Apple also may call the witnesses identified on its "may call" list, live or by deposition,
24 including employees of Core Wireless / Conversant and the named inventors of the patents-in-
25 suit, and cross examine Core Wireless's technical expert, Dr. Richard Wesel, and the inventors
26 of the asserted patents, if they are called to testify at trial;

27 4. That the Court find and declare, and enter judgment, in favor of Apple and
28 against Core Wireless that if any of the asserted patents is infringed, valid, and enforceable—which

1 Apple disputes—then Core Wireless’s remedies would be limited to FRAND royalties. Apple
 2 intends to present evidence on FRAND royalties from Apple’s expert Mr. Paul Meyer. Apple
 3 also may call the witnesses identified on its “may call” list, live or by deposition, including
 4 employees of Core Wireless / Conversant and the named inventors of the patents-in-suit.

5 5. That this case be declared “exceptional” under 35 U.S.C. § 285 and that
 6 Apple be awarded its attorneys’ fees, expenses, and costs incurred in this action; and

7 6. That Core Wireless be ordered to pay all costs associated with this action.

8 **III. CONCISE STATEMENT OF ALL UNDISPUTED AND STIPULATED**
 9 **FACTS**

10 1. Core Wireless Licensing S.A.R.L. is a Luxembourg entity, wholly owned
 11 by Conversant Intellectual Property Management (Conversant). Conversant is based in Ottawa,
 12 Canada.

13 2. Apple is a company based in Cupertino, California.

14 3. The ‘151 patent, which is titled “Packet Radio Telephone Services,”
 15 issued on November 5, 2002.

16 4. The U.S. patent application that led to the ‘151 patent was filed November
 17 10, 1998. The foreign applications that led to the ‘151 patent were filed on November 11, 1997
 18 and November 22, 1997.

19 5. The named inventor of the ‘151 patent is Jarkko Oksala

20 6. Core Wireless is asserting claim 14 of the ‘151 patent.

21 7. The products accused of infringing the ‘151 patent are Apple’s iPhone 4S,
 22 5, 5S, 5C, 6, 6 Plus, models and Apple’s iPad 3, iPad with Retina display, iPad4, iPad Mini, iPad
 23 Mini Retina 2, iPad Mini 3, iPad Mini 4, iPad Air, iPad Air 2, models.

24 8. The ‘536 patent, titled “Signaling in a Digital Mobile Communications
 25 System,” issued on October 14, 2003.

26 9. The U.S. patent application that led to the ’536 patent was filed April 8,
 27 1999. The PCT application that led to the ‘536 patent was filed September 16, 1997. The
 28 foreign application that led to the ‘536 patent was filed September 17, 1996.

- 1 10. The named inventor of the '536 patent is Jyri Suvanen.
- 2 11. Core Wireless is asserting claim 19 of the '536 patent.
- 3 12. The products accused of infringing the '536 patent are Apple's iPhone 4S,
- 4 5, 5S, 5C, 6, 6 Plus, 6S, models.

5 **IV. THE FACTUAL ISSUES TO BE TRIED**

6 **A. Plaintiff's List**

- 7 1. To the extent Core Wireless's statement of legal issues to be tried contains
- 8 issues of fact, Core Wireless incorporates them herein by reference.
- 9 2. Whether Apple has literally infringed claim 19 of the '536 patent.
- 10 3. Whether Apple has literally infringed claim 14 of the '151 patent.
- 11 4. The amount of damages caused by Apple's infringement that would
- 12 compensate Core Wireless.
- 13 5. Underlying factual issues bearing on the validity of the asserted claims of
- 14 the patents-in-suit, including secondary considerations of nonobviousness (commercial success,
- 15 industry praise, copying, failure of others, skepticism, teaching away by others, long felt but
- 16 unmet need) and whether Apple has met its burden of proof to establish that asserted references
- 17 qualify as prior art and the disclosure to one of skill in the art of any such prior art, including
- 18 whether any such prior art is sufficiently enabled.

19 **B. Apple's List**

20 The following disputed factual issues remain to be resolved:

- 21 1. Whether Apple, through selling certain accused instrumentalities, literally
- 22 infringes under 35 U.S.C. §271(a):
 - 23 a. Claim 19 of the '536 patent;
 - 24 b. Claims 14 of the '151 patent;
- 25 2. Whether Core Wireless's asserted patent claims are invalid under 35
- 26 U.S.C. §§ 102(a), (b), (e), (f) or 103.
- 27 3. Whether the '536 and/or '151 patents are enforceable;
- 28

1 4. To the extent that Apple is found to infringe any valid asserted claim of
2 the '536 patent, the amount of damages, if any, to which Core Wireless is entitled;

3 5. To the extent that Apple is found to infringe any valid asserted claim of
4 the '151 patent, the amount of damages, if any, to which Core Wireless is entitled;

5 6. Whether Core Wireless is entitled to a “reasonable royalty” or a “lump
6 sum payment” under 35 U.S.C. § 284 for Apple’s alleged infringement of the '536 and/or '151
7 patents, if proven.

8 7. Whether Nokia marked its products with the asserted patents.

9 **V. LIST OF PROPOSED STIPULATIONS**

10 Pursuant to the Court’s Pretrial Preparation Order, the parties will separately file
11 and submit proposed stipulations to the Court with the parties’ other Joint Trial Readiness
12 materials.

13 **VI. CONCISE STATEMENT OF DISPUTED POINTS OF LAW**
14 **CONCERNING LIABILITY OR RELIEF**

15 **A. Plaintiff’s List**

16 1. To the extent Core Wireless’s statement of factual issues to be tried
17 contains issues of law, Core Wireless incorporates them herein by reference.

18 2. Whether Apple has sufficiently proven by clear and convincing evidence
19 that alleged prior art was publicly-available before the critical date of the '151 patent.

20 3. Whether the holding in *Ericsson, Inc. v. D-Link Systems, Inc.* 773 F.3d
21 1201, 1235 (Fed. Cir. 2014) regarding “royalty stacking” and “patent hold-up” precludes
22 instruction on and/or Apple’s mention of “royalty stacking” and/or “patent hold-up” without
23 “provid[ing] evidence on the record of patent hold-up and royalty stacking in relation to both the
24 RAND commitment at issue and the specific technology referenced therein.”

25 4. Whether the asserted claim of the patents-in-suit would have been obvious
26 in view of prior art under 35 U.S.C. § 103.

27 **B. Apple’s List**

1 1. Whether Core Wireless can prove that it is entitled to pre-suit damages
2 where (a) Core Wireless has failed to show that Nokia marked its products in compliance with 35
3 U.S.C. § 287, and (b) Core Wireless has failed to identify evidence sufficient to show that Apple
4 was on notice of alleged infringement of the asserted patents before this litigation.

5 2. Whether the Asserted Patent Claims are invalid as anticipated under 35
6 U.S.C. § 102.

7 3. Whether the Asserted Patent Claims are invalid as obvious under 35
8 U.S.C. § 103.

9 4. Whether the ETSI IPR policy imposed a duty on Nokia to disclose the
10 asserted patents before those standards were adopted, as set forth in *Apple Inc., v. Motorola*
11 *Mobility Inc.*, 886 F.Supp.2d 1061, 1085-88 (W.D. Wisc. 2012) (finding that the ETSI IPR
12 policy “clearly requires members to make efforts to disclose intellectual property rights before a
13 standard is adopted”);

14 5. Whether Core Wireless is entitled to the reasonable royalty damages it
15 seeks from Apple, as well as prejudgment interest and costs, and if so, how much.

16 6. Whether Core Wireless is entitled to claim damages that use a royalty base
17 other than the smallest saleable patent practicing unit, which, in this case, would be the baseband
18 processor.

19 **VII. WITNESS LISTS**

20 Pursuant to the Court’s Pretrial Preparation Order, the parties will separately file and
21 submit witness lists to the Court with the parties’ other Joint Trial Readiness materials.

22 **VIII. EXHIBIT LISTS**

23 Pursuant to the Court’s Pretrial Preparation Order, the parties will separately file and
24 submit exhibit lists to the Court with the parties’ other Joint Trial Readiness materials

25 **IX. ESTIMATED NUMBER OF COURT DAYS**

26 The Court has ordered each side has 12 hours to present its case. This includes all
27 aspects of trial (e.g. objections, examinations) except jury selection. See Dkt. 266 (Pretrial
28 Preparation Order, IX). The parties expect to use the full time allotted.

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X. LIST OF OUTSTANDING MOTIONS

- 1. Core Wireless’s *Daubert* Motion (Dkt. 292, Ex. 3)
- 2. Apple’s *Daubert* Motion (Dkt. 294, Ex. 4)

XI. STATUS OF SETTLEMENT NEGOTIATIONS

The parties have mediated three times, most recently on June 16, 2015. The parties have engaged in direct communications after the mediations and have been unable to reach resolution.

XII. STATEMENTS CONCERNING BIFURCATION

The Court has “bifurcate[d] the equitable issues and will hear them during a break in trial.” Dkt 362.

DATED: November 23, 2016

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*Attorneys for Defendant and Counterclaim-
Plaintiff Apple Inc.*

IT IS SO ORDERED

Dated _____

The Honorable Nathanael Cousins
United States Magistrate Judge