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11 Attorneys for Plaintiff INTEL CORPORATION

12 UNITED STATES DISTRICT COURT  
13 NORTHERN DISTRICT OF CALIFORNIA  
14 SAN JOSE DIVISION  
15

16 INTEL CORPORATION,  
17 Plaintiff,  
18 v.  
19 WI-LAN, INC.,  
20 Defendant.  
21

Case No. 5:08-cv-4555 JW (HRL)

**MOTION FOR SUMMARY JUDGMENT  
OF NONINFRINGEMENT**

Date: October 25, 2010  
Time: 9:00 a.m.  
Courtroom: 8, 4th Floor  
Judge: Hon. James Ware

1 **NOTICE OF MOTION AND MOTION**

2 TO DEFENDANT AND ITS ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE that on October 25, 2010 at 9:00 a.m. in the courtroom of the  
4 Honorable Judge James Ware, United States District Court for the Northern District of California,  
5 280 South 1st Street, Courtroom 8, 4th Floor, San Jose, California, 95113, Plaintiff Intel Corporation  
6 (“Intel”) will and hereby does move for partial summary judgment in the above-captioned action for  
7 noninfringement pursuant to Federal Rules of Civil Procedure Rule 56.

8 **MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT**

9 **I. STATEMENT OF ISSUE TO BE DECIDED**

10 Intel filed this action to resolve Wi-LAN’s ongoing assertions of alleged “WiMAX” patents  
11 against Intel’s WiMAX products. On March 16, 2010, Wi-LAN informed Intel that it would not be  
12 providing infringement contentions for ten of the patents-in-suit in this matter, U.S. Patent Nos.  
13 6,693,887; 6,925,068; 6,956,834; 7,006,530; 7,023,798; 7,289,467; 7,317,704; 6,804,211;  
14 7,197,022; and 7,379,441 (“patents-at-issue”). As there is no dispute that Intel’s WiMAX products  
15 do not infringe the patents-at-issue, Intel files this summary judgment motion of noninfringement to  
16 resolve the cloud created by Wi-LAN’s assertions precipitating the filing of this action.

17 Wi-LAN has filed a motion to dismiss Intel’s declaratory judgment claims on the patents-at-  
18 issue based on a covenant not to sue that Wi-LAN offered on those patents. (See Dkt. No. 258.)  
19 However, as will be explained in the briefing on that motion, Intel disputes that Wi-LAN’s proposed  
20 covenant is sufficient to resolve the controversy over the patents-at-issue. In view of that dispute,  
21 Intel files this motion to ensure that, should Wi-LAN’s motion to dismiss be denied, judgment is  
22 entered on the patents-at-issue and the controversy concerning those patents is nevertheless  
23 resolved.<sup>1</sup>

24 **II. STATEMENT OF FACTS AND PROCEDURAL OVERVIEW**

25 **A. Intel Filed This Action To Settle Its Rights Over Its WiMAX Products**

26 <sup>1</sup> Intel has attempted to meet and confer with Wi-LAN over the scope of its proposed covenant to avoid further  
27 briefing on this issue, and has provided proposed revisions to Wi-LAN’s proposed covenant. However, the parties have  
28 been unable to reach agreement over the covenant.

1 On September 30, 2008, Intel filed this action to resolve Wi-LAN's ongoing assertions of its  
2 patents against Intel's WiMAX products. Intel, together with other companies involved in  
3 communications and wireless technologies, worked for years to develop and deploy a new fourth  
4 generation ("4G") cellular technology called "WiMAX," which is currently being introduced by  
5 certain cellular companies. For years prior to the filing of this case, Wi-LAN had threatened Intel's  
6 and others' WiMAX products with the patents-in-suit – Wi-LAN's alleged "WiMAX patents."  
7 (Dkt. No. 195 at 6–7.) To resolve Wi-LAN's threats, Intel exercised its rights under the Declaratory  
8 Judgment Act by filing this action. (Dkt. No. 1.) Intel's complaint sought declaratory judgments of  
9 noninfringement, invalidity and unenforceability relating to eighteen patents-in-suit.

10 **B. Wi-LAN's Motion To Dismiss/Transfer And The Court's Denial Of That Motion**

11 Wi-LAN initially moved to (1) dismiss this case for lack of personal jurisdiction, improper  
12 venue and lack of subject matter jurisdiction; and (2) transfer the present action to the Eastern  
13 District of Texas where the parties are engaged in co-pending litigation brought by Wi-LAN against  
14 20 defendants involving multiple technical standards. (Dkt. No. 31.) On June 4, 2009, the Court  
15 denied Wi-LAN's motion, finding that Wi-LAN had created a "substantial controversy" as to the  
16 patents-in-suit.<sup>2</sup> (Dkt. No. 195 at 8.) Specifically, the Court found that Intel had "expended  
17 considerable resources developing WiMAX technology," and that "beginning in 2006, [Wi-LAN]  
18 began waving the spectre of its WiMAX patent portfolio." (*Id.*) As such, the Court found that Wi-  
19 LAN had created a cloud over Intel's WiMAX products that Intel was entitled to resolve. (*Id.*)

20 On June 22, 2009, Wi-LAN filed a motion to certify the Court's denial of its motion to  
21 dismiss/transfer for interlocutory appeal, along with a request that this action be stayed. (Dkt.  
22 No. 203.) The Court denied these requests. (Dkt. No. 231.) On October 21, 2009, Wi-LAN  
23 petitioned the Federal Circuit for a writ of mandamus to direct this Court to vacate its order denying  
24 Wi-LAN's motion to dismiss, arguing that there was no case or controversy. (*See* Dkt. No. 245.)  
25 The Federal Circuit disagreed and denied Wi-LAN's petition for a writ of mandamus. (Dkt. No.

26 \_\_\_\_\_  
27 <sup>2</sup> While Wi-LAN's motion was pending, Wi-LAN withdrew its motions concerning personal jurisdiction and improper  
28 venue. (Dkt. No. 72.)

1 249.)

2 **C. The Court Orders Wi-LAN To Provide The Bases For Its Infringement**  
3 **Allegations**

4 After the Court denied Wi-LAN's motion to dismiss/transfer, the Court set February 1, 2010  
5 as the deadline for Wi-LAN to provide its infringement contentions with respect to seven of the  
6 patents-in-suit, U.S. Patent Nos. 6,693,887; 6,925,068; 6,956,834; 7,006,530; 7,023,798; 7,289,467;  
7 and 7,317,704.<sup>3</sup> (Dkt. No. 226.) The parties subsequently agreed by joint stipulation that Wi-LAN  
8 would identify substantially all of the claims it would assert on March 16, 2010, and provide  
9 infringement contentions on March 22, 2010. (Dkt. No. 254.)

10 **D. Wi-LAN States That It Would No Longer Assert Any Of The Claims Of The**  
11 **Patents-At-Issue And Files A Motion To Dismiss**

12 Prior to the deadline for Wi-LAN to provide infringement contentions, Wi-LAN pursued and  
13 was provided substantial discovery on the accused products by Intel.<sup>4</sup> On March 16, 2010, Wi-LAN  
14 wrote Intel a letter stating that it would not assert any of the claims of U.S. Patent Nos. 6,693,887;  
15 6,925,068; 6,956,834; 7,006,530; 7,023,798; 7,289,467; and 7,317,704 against Intel in answer to  
16 Intel's declaratory judgment complaint:

17 Wi-LAN has completed its discovery analysis regarding the Adaptive  
18 Allocation patents and the WiMAX products identified by Intel as at  
19 issue. Based on that discovery Wi-LAN has determined that it will not  
20 assert any of the claims of the Adaptive Allocation patents against  
21 Intel in answer to Intel's declaratory judgment complaint.

22 (Exh. 1 (3/16/2010 Letter from Berger to Alper).)

23 <sup>3</sup> Prior to the September 1 CMC, at a June 23 Case Management Conference, the Court ordered Wi-LAN to provide,  
24 by August 24, 2009, the bases for any alleged infringement. (See Dkt. No. 207 at 1:25-2:3.) Leading up to that  
25 conference, Intel produced technical documents concerning its WiMAX products to assist Wi-LAN in providing its bases  
26 for alleged infringement, and asked Wi-LAN if there was any other discovery that Wi-LAN needed to complete its  
27 portion of the chart. (See Exh. 2 (7/10/2009 Email from Alper to McManus).) Wi-LAN failed to request any additional  
28 discovery and further refused to provide any bases for alleged infringement at that time as ordered. (See Dkt. No. 219-  
1.)

<sup>4</sup> For example, Intel produced thousands of documents for its WiMAX products, source code for its WiMAX products,  
including microcode, firmware, and drivers, charts categorizing the produced materials, and written information  
concerning its WiMAX products. (See, e.g., Exh. 2 (10/22/2009 Letter from Schofield to Berger and exemplary excerpts  
from the thereto enclosed 896-page breakdown, by category, using Wi-LAN's categories, of Intel's WiMAX documents;  
10/22/2009 Letter from Schofield to Berger regarding WiMAX source code; 9/25/2009 Letter from Schofield to  
Blackstone enclosing documents; 6/22/2009 Letter from Schofield to McManus enclosing technical documents).)

1 Later that day without any notice or discussion with Intel, Wi-LAN filed its now-pending  
2 motion to dismiss the patents-at-issue, which included the alleged Adaptive Allocation patents and  
3 also three other patents that Wi-LAN had concluded were not infringed. (Dkt. No. 258 at 2:16–22  
4 (stating that “because of overlap in discovery with the Adaptive Allocation patents, Wi-LAN was  
5 also able to reach a conclusion for these other patents”).) In its motion, Wi-LAN offered a covenant  
6 not to sue that Wi-LAN asserted resolved the case or controversy over the patents-at-issue. (*Id.* at  
7 2:1–5.) However, as Intel explained to Wi-LAN in later meet and confers over this issue, and will  
8 explain in its opposition to the motion to dismiss, Wi-LAN’s proposed covenant does not resolve the  
9 case or controversy. As such, Intel filed this motion to ensure that, should Wi-LAN’s motion to  
10 dismiss be denied, judgment is entered on the patents-at-issue and the controversy concerning those  
11 patents is nevertheless resolved.

### 12 **III. ARGUMENT**

#### 13 **A. Legal Standard For Summary Judgment**

14 Summary judgment is proper when the movant demonstrates that no genuine issues of  
15 material fact exist and that the moving party is entitled to judgment as a matter of law. *See, e.g.,*  
16 Fed. R. Civ. P. 56. The purpose of summary judgment “is to isolate and dispose of factually  
17 unsupported claims or defenses.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). A movant  
18 may prevail on summary judgment by pointing out the “absence of evidence to support the  
19 nonmoving party’s case” with respect to an issue on which the nonmovant bears the burden of proof  
20 at trial. *Id.* at 325.

#### 21 **B. Summary Judgment Should Be Granted Because There Is No Evidence That 22 Intel Infringes The Patents-At-Issue**

23 Summary judgment is proper because there is no evidence that Intel’s WiMAX products  
24 infringe the patents-at-issue. (*See, e.g.,* Dkt. No. 6 (Amended Complaint) at ¶¶ 70, 86, 94, 114, 130,  
25 138, 154, 162, 170, 178; Exh. 3 (Response to Interrogatory No. 10) at 11:20-23.) After nine months  
26 of discovery, Wi-LAN did not present any evidence of infringement when Wi-LAN’s infringement  
27 contentions were due. As such, there is no dispute of material fact that Intel’s products do not  
28 infringe, and summary judgment should be granted. *See Celotex*, 477 U.S. at 325.

