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

9 INTEL CORPORATION,
10
11 Petitioner

12 v.

13 PROCOPIO, CORY, HARGREAVES &
SAVITCH LLP,
14 Respondent.

) CASE NO. 3:10-CV-00264-JLS-BLM
)
) [WI-LAN INC. V. ACER, INC., ET AL., CIVIL
) ACTION NO. 2:07-CV-473 (U.S. DISTRICT
) COURT FOR THE EASTERN DISTRICT OF
) TEXAS, MARSHALL DIVISION)]

) **MEMORANDUM OF POINTS AND**
) **AUTHORITIES IN SUPPORT OF MOTION**
) **TO COMPEL PROCOPIO, CORY,**
) **HARGREAVES & SAVITCH LLP TO**
) **PRODUCE WITHHELD DOCUMENTS**
) **RESPONSIVE TO THE SUBPOENA OF**
) **INTEL CORPORATION**

) **REDACTED VERSION**

)
)
)
)
) Date: June 14, 2010
) Time: 9:00 am
)
) Judge: Hon. Barbara Lynn Major

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RELIEF REQUESTED

Intel Corporation (“Intel”) seeks an Order compelling Procopio, Cory, Hargreaves & Savitch LLP (“Procopio”) to produce withheld documents responsive to Requests for Production Nos. 1-21 set forth in Intel’s July 30, 2009 subpoena (“Subpoena”).

I. INTRODUCTION

This motion to compel relates to an underlying patent infringement lawsuit brought by Wi-LAN, Inc., a Canadian patent holding company, against Intel and 27 other defendants in the Eastern District of Texas (the “Texas Action”). Procopio – the responding party to this motion – is a law firm located in San Diego, California. Procopio attorneys were responsible for the prosecution of a portfolio of patents – including the ‘759 patent, one of the patents-in-suit in the Texas Action – that originated from a local company called Ensemble Communications. Procopio was also heavily involved in the valuation, licensing, and sale of those patents from Ensemble to Wi-LAN. Procopio continues to perform work for Wi-LAN to this day, in terms of prosecution and other matters. Patent prosecutors and licensing counsel are routinely the subject of discovery in patent cases, and given the central roles Procopio had with respect to the prosecution, valuation, licensing and sale of the Ensemble Patents, Intel served Procopio with a subpoena *duces tecum* to obtain evidence relating to a number of important claims and defenses in the Texas Action, such as patent validity, inequitable conduct, Wi-LAN’s claim for damages and the appropriate measure of a reasonable royalty, to name just a few.

This motion focuses on two disputes between Intel and Procopio with respect to Procopio’s response to the subpoena. First, in response to Intel’s subpoena, Procopio limited its search for responsive materials to only the ‘759 patent, and excluded from its search any files relating to any of the other Ensemble Patents. However, the ‘759 patent and the other Ensemble Patents share common origins, have overlapping alleged inventors, and overlapping fields of invention. As such, prior art and other materials residing in files relating to the other Ensemble Patents may be highly relevant to the ‘759 patent’s invalidity. More importantly, Intel’s allegations in the Texas Action

1 include a claim that the applicants for the '759 patent and their attorneys committed inequitable
2 conduct by withholding material prior art during the '759 patent's prosecution. Documents in those
3 other files could reveal that those attorneys, one of whom is now at Procopio, were aware of prior art
4 material to the '759 patent, and yet withheld it from the '759 patent's prosecution. In fact, Intel has
5 already uncovered publically available evidence from the USPTO of precisely that – in connection
6 with three of the other Ensemble Patents – where Procopio possessed prior art material to the '759
7 patent in those files and yet failed to disclose it in connection with the '759 patent. Although Intel
8 need not prove its underlying claims and defenses to obtain the requested discovery, strong evidence
9 already exists in the other Ensemble Patent files that Procopio attorneys were involved in the
10 commission of inequitable conduct, justifying a thorough search of those files for evidence
11 confirming those claims and defenses.

12 Moreover, in addition to invalidity and inequitable conduct, many other grounds for
13 relevance exist with respect to the other Ensemble Patents, including valuations of the Ensemble
14 portfolio and licensing discussions, which relate directly to Wi-LAN's damages claims with respect
15 to the '759 patent. Procopio should search all of the files for these other Ensemble Patents for
16 evidence relating to these claims and defenses, and has no reason to arbitrarily exclude the files for
17 these other Ensemble Patents from its review.

18 Second, Procopio refuses to search the files of Patricia Newton, a Procopio employee who
19 has been centrally involved with substantive aspects of the '759 and other Procopio patents,
20 including the sale of the '759 patent itself. Procopio's refusal to even search these files prejudices
21 Intel's ability to discover and rely on relevant documents to prove up its defenses and damages
22 theories.

23 During the meet and confer process, Procopio did not dispute the relevance of the requested
24 materials. Moreover, Procopio has not alleged facts demonstrating an undue burden associated with
25 the requested searches. In fact, although Procopio refuses to say one way or the other, Wi-LAN is
26 likely paying for some or all of Procopio's response to Intel's subpoena, in connection with
27 Procopio's ongoing role as counsel to Wi-LAN. Given the importance of the requested documents

1 to the parties' claims and defenses in the Texas Action, Procopio should be compelled to perform the
2 requested searches.¹

3 **II. BACKGROUND**

4 **A. Overview Of The Underlying Texas Action**

5 Wi-LAN Inc. ("Wi-LAN") is a Canadian company that focuses on patent licensing. Intel
6 Corporation ("Intel") is a supplier of technology products such as semiconductor chips. On October
7 31, 2007, Wi-LAN filed suit against Intel and 27 other defendants in the Texas Action. *See* Exh. 1
8 (Complaints in the Texas Action). In the Texas Action, Wi-LAN alleged infringement of four
9 patents, including a patent prosecuted by Procopio, U.S. Patent No. 6,549,759 (the "'759 patent").²

10 **B. Procopio Attorneys Prosecuted The '759 Patent As Well As At Least Thirteen 11 Other Patents Having The Same Assignee, Overlapping Inventors, And 12 Overlapping Fields Of Invention (The "Other Ensemble Patents")**

13 Before Wi-LAN had an interest in the '759 patent, it was allegedly owned by Ensemble
14 Communications, Inc. ("Ensemble"), a wireless products company. Richard Campbell, a lawyer
15 now employed by Procopio³, represented the Ensemble employees who applied for the '759 patent
16 during the application process at the USPTO. Mr. Campbell and Procopio were also involved in the
17 prosecution of other Ensemble patent applications that were pending at the time of the '759 patent
18 application. As demonstrated by the chart below, Richard Campbell and/or Procopio attorneys have
19 prosecuted at least thirteen other patent applications for Ensemble (the "Other Ensemble Patents").⁴
20 Many of these applications involve overlapping alleged inventors with the '759 patent, and share
21 similar technical fields. Additionally, as shown in the chart, nearly all of the applications were

22 ¹ Over the past eight months, Intel has made extensive efforts to resolve the parties' differences, including more than
23 25 letters and emails and 5 meet and confers.

24 ² The other patents-in-suit are U.S. Patent Nos. 5,282,222 (the "'222 patent"), RE37,802 (the "'802 patent"), and
25 5,956,323 (the "'323 patent").

26 ³ Mr. Campbell was employed by the law firm Knobbe Martens Olson & Bear, LLP ("Knobbe Martens") when the
27 '759 patent application was filed. James Herkenhoff, another attorney at Knobbe Martens, also worked on several
Ensemble patents with Mr. Campbell.

⁴ The chart only contains patents that Intel currently has knowledge of, and does not include applications that did not
issue as patents, which may exist in Procopio's possession.

1 prosecuted by attorneys currently at Procopio.

2	3	4	5	6
Pat. No.	Title	Inventors in Common With '759 Patent	Prosecuted by Procopio Attorney(s)?	Co-pending?
7,197,022	Framing for an adaptive modulation communication system	Kenneth L. Stanwood	Yes	Yes
7,177,598	Method and system for reducing channel interference in a frame-synchronized wireless communication system	Kenneth L. Stanwood, David Gazelle	Yes	Yes
7,023,798	Adaptive call admission control for use in a wireless communication system	Kenneth L. Stanwood, Brian Spinar	Yes	Yes
7,006,530	Method and system for adaptively obtaining bandwidth allocation requests	Brian Spinar, Kenneth L. Stanwood	Yes	Yes
6,956,834	Method and apparatus for allocating bandwidth in a wireless communication system	Kenneth L. Stanwood	Yes	Yes
6,944,188	Synchronizing clocks across a communication link	Eli Arviv	Yes	Yes
6,925,068	Method and apparatus for allocating bandwidth in a wireless communication system	Kenneth L. Stanwood	Yes	Yes
6,804,211	Frame structure for an adaptive modulation wireless communication system	Kenneth L. Stanwood, Eli Arviv, David Gazelle	Yes	Yes
6,693,887	Method for allocating fractional bandwidth in a fixed-frame communication system	Kenneth L. Stanwood	Yes	Yes
6,577,863	Failure redundancy between modem interface cards and outdoor units in a wireless communication system	N/A	Yes	Yes

Pat. No.	Title	Inventors in Common With '759 Patent	Prosecuted by Procopio Attorney(s)?	Co-pending?
6,459,687	Method and apparatus for implementing a MAC coprocessor in a communication system	Kenneth L. Stanwood	Yes	Yes
7,177,275	Scheduling method and system for communication systems that offer multiple classes of service	Kenneth Stanwood	No, but James Herkenhoff prosecuted	Yes
7,577,100	System and method for measuring signal to noise values in an adaptive wireless communication system	Kenneth Stanwood, David Gazelle	No, but James Herkenhoff prosecuted	Yes
7,379,441	Framing for an adaptive modulation communication system	Kenneth L. Stanwood	Yes	No, division of 7,197,022, which was co-pending
7,289,467	Adaptive call control for use in a wireless communication system	Brian Spinar, Kenneth L. Stanwood	Yes	No, division of 7,023,798, which was co-pending

In addition to prosecution work, Procopio attorneys also handled the assignment of the '759 patent to Wi-LAN. To this day, Wi-LAN continues to use Procopio as its counsel, including in efforts to sell the patents-in-suit. *See* Exh. 2 (USPTO Correspondence Information from www.uspto.gov); [REDACTED]

C. Evidence Supporting Intel's Claims And Defenses In The Texas Action May Be Found In Files Relating To The "Other Ensemble Patents"

Given their long history with the '759 patent, Ensemble, Wi-LAN and the Other Ensemble Patents, Procopio likely possesses documents highly relevant to Intel's claims and defenses in the Texas Action, including whether applicants fulfilled their duty to disclose to the USPTO all information known to be material to patentability during prosecution. Mr. Campbell, in addition to the Ensemble employees who applied for the '759 patent, had a duty to disclose to the USPTO *all* information known to be material to patentability, including information related to co-pending

1 applications, *see* 37 C.F.R. § 1.56. As discussed in Section IV.A.2 *infra*, the failure of the ‘759
 2 patent applicants and attorneys to satisfy that duty renders the ‘759 patent unenforceable for
 3 inequitable conduct. Further, as discussed in Section IV.A.1 *infra*, Procopio’s files for the Other
 4 Ensemble Patents contain prior art references that could invalidate the ‘759 patent.

5 **D. In Connection With The Texas Action, Intel Served Procopio With A Subpoena**
 6 **To Obtain Highly Relevant Documents**

7 Intel served a subpoena on Procopio with 21 requests for production of documents. *See* Exh.
 8 5 (July 30, 2009 Subpoena of Procopio). Procopio then hired McKool Smith, the same law firm that
 9 represents Wi-LAN, and responded to the subpoena stating that it would produce documents, subject
 10 to objections. *See* Exh. 6 (August 18, 2009 Objections to Procopio).

11 The documents at issue in this motion are relevant to at least the topics set out below:

- 12 • Request No. 12: “[a]ll documents and materials that refer or relate to the inventorship,
 13 patentability, validity or invalidity, enforceability or unenforceability... of the patents-
 14 in-suit.”
- 15 • Request No. 13 calls for the production of “[a]ll documents and materials comprising,
 16 referring or relating to potential or actual prior art to the patents-in-suit.”
- 17 • Request No. 16 calls for the production of “[a]ll documents and materials referring or
 18 relating to when the listed inventors, the assignees, their counsel or anyone subject to
 19 the duty of candor before the USPTO learned of any potential or actual prior art to the
 20 patents-in-suit.”

21 Exh. 5.

22 Since service of the Subpoena in July 2009, Procopio has neither disputed its possession of
 23 the requested documents nor contested their relevance. On several occasions, Procopio has written
 24 that documents would be provided in a few weeks (including in September 2009, November 2009,
 25 and January 2010)⁵ only to simply refuse to provide any information at all, necessitating another

26 _____
 27 ⁵ *See* Exh. 7 (September 15, 2009 letter from M. Raskin to G. Cutri); Exh. 8 (December 4, 2009 e-mail from H. Batts
 to M. Raskin); Exh. 9 (December 23, 2009 letter from M. Raskin to H. Batts).

1 round of letters and promises to produce. Indeed, it was only after Intel filed the petition for this
2 case that Procopio finally started to produce documents.

3 **E. Procopio Refuses To Search Highly Relevant Files In Response To Intel’s**
4 **Subpoena**

5 **1. Procopio Refuses To Search Files Relating To The “Other Ensemble**
6 **Patents”**

7 Although Procopio previously represented that it had already searched for and produced (or
8 logged) all documents relevant to Intel’s Request Nos. 12, 13, and 16, *see* Exh. 10 (April 22, 2010
9 Letter from L. Martin to H. Batts), Procopio has since confirmed that it has not done so. *See* Exh. 11
10 (April 30, 2010 Letter from G. Cutri to L. Martin). Instead, Procopio admitted that it only collected
11 and produced documents for the ‘759 patent and the other patents-in-suit in the underlying action.⁶
12 *See id.* However, the parties confirmed that Procopio has not searched the files related to the Other
13 Ensemble Patents. *See id.* Procopio’s lawyers have confirmed that Procopio will not perform these
14 searches absent a court Order. *See id.*

15 **2. Procopio Refuses To Search The Files Of Patricia Newton**

16 Additionally, Procopio has refused to search the files of employee Patricia Newton. *See* Exh.
17 11; Exh. 12 (April 21, 2010 Letter from H. Batts to L. Martin). As explained below, Ms. Newton
18 was substantively involved with Ensemble’s efforts to sell its patents, including the patents-in-suit,
19 to numerous parties.

20 **III. LEGAL STANDARDS**

21 Under Rule 45, any party may serve a subpoena commanding a nonparty to “produce
22 designated documents.” Fed. R. Civ. P. 45(a)(1)(A)(iii). The non-party witness is subject to the
23 same scope of discovery under Rule 45 as that person would be as a party to whom a request is
24 addressed pursuant to Rule 34. *See Kona Spring Water Distrib., Ltd. v. World Triathlon Corp.*, No.
25 8:05-cv-119-T-23TBM, 2006 WL 905517, at *2 (M.D. Fla. Apr. 7, 2006) (“[T]he scope of

26
27 ⁶ Those patents include U.S. Patent Nos. 5,282,222 and RE37,802. Procopio has also stated that it has searched the related foreign patents for any U.S. patents-in-suit. *See* Exh. 11.

1 discovery under a [Rule 45] subpoena is the same as the scope of discovery under Rule 26(b) and
 2 Rule 34.”); *Hallett v. Morgan*, 296 F.3d 732, 736 (9th Cir. 2002) (quoting *Goehring v. Brophy*, 94
 3 F.3d 1294, 1305 (9th Cir. 1996)) (“Broad discretion is vested in the trial court to permit or deny
 4 discovery...”). Should a subpoenaed non-party fail to comply with its discovery obligations, “the
 5 serving party may move the issuing court for an order compelling production or inspection.” Fed. R.
 6 Civ. P. 45(c)(2)(B)(i).

7 **IV. ARGUMENT**

8 **A. Files Relating To The “Other Ensemble Patents” Are Highly Relevant To The** 9 **Parties’ Claims And Defenses And Should Be Searched**

10 As explained in the following subsections, the files relating to the Other Ensemble Patents
 11 are likely to contain materials that are highly relevant to numerous claims and defenses in the Texas
 12 Action, and should be searched.

13 **1. The Files Relating To The “Other Ensemble Patents” Contain Prior Art** **Proving That The ‘759 Patent-In-Suit Is Invalid**

14 First, the files relating to the Other Ensemble Patents contain prior art proving that the ‘759
 15 patent is invalid and unenforceable. As discussed in Section II.B above, the Other Ensemble Patents
 16 share common origins with the ‘759 patent. Specifically, like the ‘759 patent, many of the Other
 17 Ensemble Patents concern aspects of wireless communication systems, share at least one inventor
 18 with the inventors named on the ‘759 patent, and/or were prosecuted by the same attorneys who
 19 prosecuted the ‘759 patent. As such, prior art and other materials residing in files relating to the
 20 Other Ensemble Patents—even if not cited in those patents—may be highly relevant to the ‘759
 21 patent’s invalidity. *See, e.g., Info-Hold, Inc. v. Trusonic, Inc.*, No. 1:06-cv-543, 2008 WL 2949399,
 22 at *7 (S.D. Ohio July 30, 2008) (ordering production of information in patent prosecution files for
 23 patents other than those asserted by plaintiff); *Regal Elec., Inc. v. Pulse Engineering, Inc.*, No. 03-
 24 cv-1296, 2005 WL 3078983, at *4 (N.D. Cal. Nov. 16, 2005) (ordering production of foreign patent
 25 prosecution files related to patent-in-suit). In light of the overlap between the ‘759 patent and the
 26 Other Ensemble Patents, it is likely that Procopio’s files for the Other Ensemble Patents will contain
 27 prior art references that could be relevant to the validity of the ‘759 patent under 35 U.S.C. §§ 102

1 and/or 103.

2 **2. The Files Relating To The “Other Ensemble Patents” Contain Evidence**
3 **That The Applicants For The ‘759 Patent Intended To Defraud The**
4 **USPTO Rendering The ‘759 Patent Unenforceable**

5 As discussed above, Intel alleges that the ‘759 patent is invalid under 35 U.S.C. §102 et seq.
6 in view of certain prior art, including various IEEE standards submissions (the “IEEE standards prior
7 art”) known to the patent applicants while prosecuting the ‘759 patent. *See* Exh. 13 (Intel’s First
8 Amended Answer to Wi-LAN’s First Amended Complaint) at Count 9. For example, Intel alleges
9 that the ‘759 patent is unenforceable because the applicants intentionally withheld the IEEE
10 standards prior art from the USPTO during prosecution of the ‘759 patent with the intent to deceive
11 the USPTO concerning the validity of the patent. *See id.* Specifically, Intel alleges that the
12 applicants knew that the IEEE standards prior art was material to the patentability of the ‘759 patent,
13 and yet intentionally withheld it from the USPTO. *See id.* An important fact establishing the
14 applicants’ knowledge of the materiality of the references and intent to deceive the USPTO is that
15 Procopio attorneys possessed copies of the IEEE standards prior art and in fact *cited it in connection*
16 *with three of the Other Ensemble Patents.* *See id.* (explaining that the prosecuting attorneys
17 identified the IEEE prior art during prosecution of U.S. Patent Nos. 7,197,022, 7,177,275, and
18 7,577,100). The applications for those Other Ensemble Patents and the ‘759 patent were co-pending
19 before the USPTO, and all four applications shared at least inventor Kenneth Stanwood and were
20 prosecuted by the same attorneys. Moreover, as alleged by Intel, the IEEE standards prior art is
21 highly material to the ‘759 patent, invalidating every claim. *See id.* Nevertheless, Procopio failed to
22 disclose the IEEE standards prior art in connection with the ‘759 patent prosecution. Courts
23 routinely rely on evidence such as this to find inequitable conduct, rendering an asserted patent
24 unenforceable. *See McKesson Info. Solutions, Inc. v. Bridge Medical, Inc.*, 487 F.3d 897, 913-19,
25 923 (Fed. Cir. 2007) (“The MPEP also makes clear that the above explanations [regarding the duty
26 to disclose] apply with full force to information obtained with respect to co-pending applications.”);
27 *see also Onstar, LLC v. Micral, Inc.*, No. 08-cv-2047, 2010 WL 1433431, at *8, n.6 (N.D. Ohio
28 April 7, 2010) (citing *McKesson*, 487 F.3d at 911) (“[Inventors and prosecuting attorneys] cannot

1 assume that the examiner of a particular application is necessarily aware of other applications which
 2 are ‘material to the patentability’ of the application in question, but must instead bring such other
 3 applications to the attention of the examiner.”); *Bruno Independent Living Aids, Inc. v. Acorn*
 4 *Mobility Services, Ltd.*, 394 F.3d 1348, 1350-1355 (Fed. Cir. 2005) (upholding district court finding
 5 of inequitable conduct based on patentee’s failure to disclose prior art that patentee had submitted in
 6 co-pending application to the Food and Drug Administration).

7 At bottom, the Other Ensemble Patent files would allow Intel to establish when the inventors
 8 and their counsel became aware of potential and actual prior art to the ‘759 patent and whether they
 9 failed to disclose that art in the prosecution of the ‘759 patent. Procopio does not dispute the critical
 10 relevance of this evidence, nor that it can be found by reviewing files relating to the Other Ensemble
 11 Patents. Moreover, Procopio does not deny that additional evidence of fraud may exist in files
 12 relating to the Other Ensemble Patents beyond that already identified by Intel – such as other prior
 13 art references that should have been disclosed to the USPTO in connection with the ‘759 patent’s
 14 prosecution. Nevertheless, Procopio offers no excuse for its refusal to search those files for that
 15 evidence.

16 **3. The Files Relating To The “Other Ensemble Patents” Contain Evidence**
 17 **Concerning The Alleged Value Of The ‘759 Patent Potentially Relevant**
 18 **To Wi-LAN’s Claim For A Reasonable Royalty**

19 The files relating to the Other Ensemble Patents may contain information regarding attempts
 20 to sell or license the patents. For example, Procopio attorneys handled the assignment of the ‘759
 21 patent to Wi-LAN. Further, Wi-LAN continues to use Procopio in efforts to sell the patents-in-suit.
 22 See Exh. 2 (USPTO Correspondence Information from www.uspto.gov); [REDACTED]

23 [REDACTED] Procopio’s files, therefore, may contain information relevant to one or more of the factors set
 24 out in *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) for
 25 calculating a reasonable royalty:

26 These factors include: (2) rates paid by the licensee for the use of *comparable*
 27 *patents*...

1 *i4i Ltd. Partnership v. Microsoft Corp.*, 598 F.3d 831, 853, n.3 (Fed. Cir. 2010) (emphasis added)
 2 (reciting the *Georgia-Pacific* factors). Despite the potential relevance of such sales or licensing
 3 information to the reasonable royalty analysis, Procopio refuses to even look through the case files to
 4 determine whether they contain this information.

5 **4. The Files Relating To The “Other Ensemble Patents” Contain Evidence**
 6 **Concerning The Inventorship Of The ‘759 Patent**

7 As demonstrated by the chart in Section II.B above, there is significant overlap between the
 8 inventors listed on the ‘759 patent and on the Other Ensemble Patents. For example, Kenneth
 9 Stanwood is named as an inventor of the ‘759 patent and on nearly every one of the Other Ensemble
 10 Patents. It is possible that files relating to the Other Ensemble Patents could contain non-privileged
 11 evidence establishing that someone other than those named on the ‘759 patent should have been
 12 named as an inventor. Such a failure, absent bona fide mistake, invalidates the patent under 35
 13 U.S.C. § 102(f). *See Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349-50 (Fed. Cir. 1998) (“[T]he
 14 naming of the correct inventor or inventors [is] a condition of patentability; failure to name them
 15 renders a patent invalid.”).

16 **B. The Requested Search Will Not Be Unduly Burdensome To Procopio**

17 While Procopio may suggest that it would be burdensome for it to search and log the files for
 18 the Other Ensemble Patents, the reality is that there appears to be no burden on Procopio at all. First,
 19 the requested searches relate to files within Procopio’s possession, and likely are of limited volume.
 20 Additionally, Wi-LAN appears to be paying for Procopio’s counsel.⁷ As such, Procopio’s only
 21 burden would likely be to make files available to its attorneys, on its own premises.

22 **C. Intel Will Be Greatly Prejudiced If Procopio Is Not Ordered To Perform The**
 23 **Requested Search**

24 Intel will be greatly prejudiced in its defenses if this motion is not granted. For example, the
 25 named inventor of the ‘759 patent (Ken Stanwood) as well as his attorneys (including Richard
 26 Campbell at Procopio) failed to disclose a highly material IEEE standards contribution to the

27 ⁷ Procopio refuses to confirm or deny whether Wi-LAN is paying for Procopio’s representation by Wi-LAN’s law
 28 firm (McKool Smith). *See* Exh. 11.

1 USPTO during prosecution of the '759 patent that he disclosed during *three* co-pending patent
2 prosecutions. *See* Exh. 13. Intel should be permitted to discover additional evidence showing
3 inequitable conduct.

4 **D. Procopio Has Failed To Collect Responsive Documents From Procopio**
5 **Employee Patricia Newton**

6 In addition to refusing to provide the Other Ensemble Patent files, Procopio also refuses to
7 collect responsive documents from relevant custodians, including Procopio employee Patricia
8 Newton.⁸ Both Wi-LAN and Procopio have identified Ms. Newton as having responsive documents,
9 based upon her inclusion in multiple privilege log entries as well as during discussions between the
10 parties. [REDACTED] Contrary to
11 Procopio's assertions, Ms. Newton's alleged title of "docketing clerk" does not in itself immunize
12 her files from a search. *See* Exh. 11; Exh. 12. [REDACTED]

13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED] This

20 document and others like it establish that Patricia Newton possesses materials highly relevant to
21 numerous important issues, such as the potential sale of the patents-in-suit and their value.

22 Procopio is unable to explain why it cannot collect and produce documents for this additional

23 _____
24 ⁸ Procopio's initial search for responsive documents was limited to a single Procopio employee, Richard Campbell. It
25 was only after Intel identified additional custodians and threatened motion practice that Procopio reluctantly agreed
26 to collect documents from Procopio employees other than Richard Campbell. *See* Exh. 12. Procopio, however,
27 refused to collect documents from Patricia Newton, an employee who worked directly with Richard Campbell on
28 many aspects of the Ensemble Patent Portfolio. *See id.*; *see also* Exh. 11.

26 [REDACTED]
27 [REDACTED]

1 custodian or establish any burdens justifying its refusal to do so. With respect to prejudice, relevant
2 documents appear to be uniquely in Ms. Newton's possession. If Intel is denied access to that
3 information, it will be prejudiced in its ability to prove up the arguments outlined in Sections
4 IV.A.1-4 *supra*.

5 **V. CONCLUSION**

6 As established above, the discovery sought is both relevant and necessary, does not impose
7 any undue burden or expense, and was preceded by Intel's reasonable efforts over the past 8 months
8 to obtain the requested documents without Court intervention. Because Intel is prejudiced by
9 Procopio's failure to collect and produce all responsive documents, Intel respectfully requests that
10 this Court grant Intel's motion to compel discovery relevant to the July 30, 2009 Subpoena of
11 Procopio, and order that Procopio immediately:

12 a) produce all non-privileged documents responsive to Requests 1-21 of the Subpoena,
13 including prosecution files for the Other Ensemble Patents, including but not limited to those
14 identified in the chart in Section II.B *supra*, in addition to any other files for patents prosecuted by
15 Richard Campbell or Procopio for Ensemble or Wi-LAN, and any Ensemble or Wi-LAN-related
16 documents provided to third parties;

17 b) search the emails, hard drives, hard and electronic copy files of any individuals likely to
18 have responsive documents, including Patricia Newton.

19 DATED: May 12, 2010

KIRKLAND & ELLIS LLP

21 By: s/ Amy R. Schofield

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