IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

WI-LAN INC.,

         Plaintiff,

v.

ALCATEL–LUCENT USA INC., *et al*.,

         Defendants.

CIVIL ACTION NO. 6:10–CV–521–LED

REPLY IN SUPPORT OF ALCATEL-LUCENT USA INC. AND THE ERICSSON DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT THAT PATENT CLAIMS ARE INDEFINITE

Wi-LAN's Response fails to identify any passages in the specification that disclose an algorithm for the claimed channelization means, applies the wrong standard, and fails to distinguish case law that expressly contradicts its arguments.

A.   The specification does not disclose an algorithm corresponding to the claimed channelization means.

Wi-LAN originally proposed that the structures corresponding to the claimed channelization means at issue were algorithms "based on one or two inputs" received by a DA engine. Now, for the first time in its response brief, Wi-LAN proposes that those structures are actually multi-step processes. Wi-LAN has also revised one of its constructions that it says contained certain misstatements.[1] These last-minute revisions to its claim constructions are untimely. They are also futile because the newly proposed processes: (1) still fail to explain how the channelization means performs its "determining" functions; and (2) are not disclosed in the specification. Further, the declaration of Dr. Jonathan Wells, which Wi-LAN now — again for the first time — offers to support its contentions is not helpful. As the Federal Circuit has consistently held, "the testimony of one of ordinary skill in the art cannot supplant the total absence of structure from the specification." *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007).

1.   The specification does not disclose an algorithm that explains *how* the channelization means performs the required functions.

The specification does not state that the channelization means determines anything "based on one or both of two inputs," as Wi-LAN first proposed. Nor does it describe any of the step-by-step processes Wi-LAN now contends are structures that correspond to the claimed channelization means. If the specification contained an algorithm, Wi-LAN would certainly point to it rather than submit an expert declaration trying to create something that isn't there.

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[1]   *See* Response Br. at 11 n.8.

Indeed, at most, the specification states that the channelization means *is able* to determine certain things. For instance, it says that "certain orthogonal channels *can . . . be* designated as being reserved for communications with STs [subscriber terminals] that do not incorporate the features necessary to support TDM techniques."[2] Likewise, it describes what *can* happen if an orthogonal channel operates at 160 kb/s — four time slots can be provided at 40 kb/s or two time slots can be provided at 80 kb/s.[3] It does not, however, explain *how* it is determined whether to provide four or two time slots. The other passages Wi-LAN cites are no different; the specification never states how the required determining functions are carried out.[4]

Wi-LAN relies primarily on the *Typhoon Touch* case, where the Federal Circuit allowed an algorithm to be disclosed "in prose." But that court recently clarified its holding in *Typhoon Touch* to explain that "[e]ven described 'in prose,' an algorithm is still 'a **step-by-step procedure for accomplishing** a given result.'" *Ergo Licensing, LLC v. Carefusion 303, Inc.*, – F.3d –, 2012 WL 987833, at *4 (Fed. Cir. Mar. 26, 2012) (emphasis added) (citations omitted) (finding no disclosed algorithm). The specification here does not provide such a procedure — saying that something *can* be done does not disclose *how* it is done (*i.e.*, the procedure).

In *Typhoon Touch*, the patent claimed a "means for cross referencing said responses with one of said libraries of said possible responses." *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1383 (Fed. Cir. 2011). The patent described in detail how the claimed cross referencing was accomplished: "Cross-referencing entails the matching of entered responses with a library of possible responses and, if a match is encountered, displaying the fact of the match,

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2   '326 Patent at 3:50–53 (emphasis added).

3   '326 Patent at 3:63–4:12.

4   *See id.* at 12:12–14; 18:64–67; 19:12–17. *See also* **Ex. 1**: Declaration of James Olivier, Ph.D. (April 19, 2012) ¶¶ 12–20 (explaining that Wi-LAN's supposed algorithms: (1) are not disclosed in the patents; and (2) do not explain how to perform the required determining functions).

otherwise alerting the user, or displaying information stored in memory fields associated with that library entry." *Id.* at 1385 (quoting the patent). Thus, the specification in *Typhoon Touch* explained *how* the claimed function was performed. In contrast, the patents here are like *Ergo*; they disclose the functions but not how the channelization means performs those functions.

2. It is irrelevant that a person skilled in the art may be able to program a DA engine to perform the required functions.

Again, Wi-LAN has not cited — because it cannot — any language from the specification that describes how the "determining" functions are performed. Rather, it contends its proposed algorithms are disclosed because the specification purportedly describes information the DA engine considers to make the claimed determinations. According to Wi-LAN, "[b]ased on this disclosure and the knowledge existing in the field at the time, one of skill could readily program a DA engine to perform the recited determining functions."[5] Wi-LAN's argument fails for at least the following two reasons.

First, Wi-LAN applies an incorrect standard. "The inquiry is whether one of skill in the art would understand the specification itself to disclose a structure, not simply whether a person would be capable of implementing a structure." *Biomedino*, 490 F.3d at 953. And while the question of "whether a claim is indefinite is based on how the claim limitation would be understood by one of ordinary skill in the art, '**the testimony of one of ordinary skill in the art cannot supplant the total absence of structure from the specification**.'" *Id.* at 950 (quoting *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1302 (Fed. Cir. 2005)). It is therefore irrelevant that a person of ordinary skill may be able to program a DA engine to perform the claimed function in this case. *Biomedino*, 490 F.3d at 953 ("[A] bare statement that known techniques or methods can be used does not disclose structure."). Since the

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    5   Response Br. at 8.

specification does not describe how those functions are performed, the claims are indefinite.

Second, as Wi-LAN acknowledges, "[f]or all the determining functions, the specification emphasizes that the exact thresholds and mathematical logic for making the determinations based on the identified types of information is **purposefully 'flexible.'**"[6] Therefore, according to Wi-LAN, "[o]ne of skill in the art would understand that they could tailor the precise thresholds and logic to meet their needs."[7] The undisputed "flexibility" of Wi-LAN's proposed algorithm and the fact that it allows the channelization means to be "tailored" to meet different needs belie any argument that the patents disclose a structure with enough specificity to satisfy section 112, paragraph 6. As the Federal Circuit held in *Blackboard*: "That ordinarily skilled artisans could carry out the recited function in a variety of ways **is precisely why** claims written in 'means-plus-function' form **must disclose** the **particular structure** that is used to perform the recited function." *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009) (emphasis added). By failing to describe how the channelization means perform their functions, Wi-LAN is improperly attempting to capture any possible means for performing those functions. "Section 112, paragraph 6, is intended to prevent such pure functional claiming." *Id.*

B.   The channelization means must be a single structure.

Wi-LAN also contends the claimed channelization means does not have to be a single structure. Judge Ward's ruling in *Arbitron* contradicts Wi-LAN on this point. *Arbitron, Inc. v. Int'l Demographics Inc.*, No. 2:06-cv-434, 2009 WL 68875, at *15 (E.D. Tex. Jan. 8, 2009). That case, like this one, involved a means-plus-function term where two "for" function phrases were joined by the conjunction "and"; the claim there recited a means "for generating reward signals" and "for transmitting the reward signals." *Id.* In construing that term, Judge Ward held "there can

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6   Response Br. at 12 (emphasis added).
7   *Id.*

be only a single means that supports both these functions." *Id.* (relying on *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1115 (Fed. Cir. 2002). Wi-LAN does not argue Judge Ward was wrong, but it attempts to distinguish the holding by stating that the "specification-at-issue clearly linked both functions to a single structure."[8] This is a false distinction, however, because in this case the claims, themselves, clearly link the functions to a single means.

Claim 6 of the '326 Patent claims a "*channelisation means for determining* which of the orthogonal channels will be subject to TDM techniques, *and for transmitting* that information to a plurality of subscriber terminals within the wireless telecommunications system" (emphasis added). Claim 7, which is dependent from claim 6, makes it clear that the means for determining and the means for transmitting are the same. Claim 7 claims: "A central terminal as claimed in claim 6, wherein **the** channelisation means also determines, for those orthogonal channels subject to TDM techniques, how many time slots will be provided within each orthogonal channel" (emphasis added). Claim 7 does not refer to "a" channelization means or "one of the" channelization means of claim 6. It refers to "the" — singular — channelization means of claim 6. Construing claim 6 to require separate channelization means, as Wi-LAN proposes, would improperly render claim 7 ambiguous. *E.g.*, *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (constructions that render claim terms ambiguous are improper).

Accordingly, the Court should reject Wi-LAN's argument that the claimed means "for determining" and "for transmitting" are two separate structures.

C.   **Conclusion**

For the reasons stated, Wi-LAN has failed to rebut the arguments in Defendants' Motion. Defendants therefore respectfully renew their request that the Court grant summary judgment that claims 6, 7, and 8 of the '326 Patent and claim 10 of the '819 Patent are invalid as indefinite.

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8   Response Br. at 4 n.3.

Dated: April 19, 2012   Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that the foregoing document was served electronically on all counsel of record

on April 19, 2012.

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