

Apple, Broadcom Say Caltech Withheld Info In Patent Row

By **Y. Peter Kang**

Law360, Los Angeles (August 3, 2016, 9:25 PM ET) -- Apple Inc. and Broadcom Corp. on Monday rebutted the California Institute of Technology's claims that the tech companies infringed on the school's coding systems patents, saying the patents should be invalidated since Caltech withheld certain information in order to gain approval from federal regulators.

Apple and Broadcom, a unit of co-defendant Avago Technologies Ltd., denied the allegations outlined in Caltech's May complaint lodged in California federal court and filed counterclaims against the Pasadena, California-based private research institution. These counterclaims asserted that Caltech knowingly withheld relevant prior art information from the U.S. Patent and Trademark Office when seeking approval of four patents covering technology that allows for faster data transmission over Wi-Fi networks through the use of irregular repeat-accumulate codes and therefore the patents should be invalidated.

"The asserted patents are unenforceable as a result of inequitable conduct arising from Caltech's . . . intentional choice to withhold from the U.S. Patent and Trademark Office prior art references disclosing irregular error correction codes that the inventors knew to be material, leaving the patent office with no prior art reference that disclosed irregular codes at all, so that Caltech could present the misleading and deceptive argument that irregularity made its claims patentable," the companies wrote in a 39-page filing.

Apple and Broadcom contend that two technical research papers authored by Michael Luby and one paper penned by Tom Richardson were integral to Caltech's patents yet the school and the patents' named inventors chose not to disclose this information to the Patent Office for fear their patent applications would be rejected.

One of the Caltech inventors, Aamod Khandekar, wrote in his 2002 thesis that the work done by Luby was a "major breakthrough" yet failed to mention the work in the patent applications, according to Monday's filing. The companies also said Caltech had an advance copy of Richardson's work in 1999 but when it filed its patent application it included the 2001 version since the 1999 version would have constituted prior art while the 2001 version would not.

The companies assert that since Caltech submitted the 2001 version instead of 1999 version, it was a tacit admission that the 1999 version was key to their patents.

"Had they disclosed Richardson99, the Patent Office would have been informed that irregular error

correction codes were known in the prior art," the filing said. "By choosing not to disclose Richardson99, Caltech, the named inventors, and those involved in prosecution were able to keep this prior art hidden from the Patent Office."

Apple and Broadcom are seeking a ruling of noninfringement in connection with the four patents and asked the court to invalidate the patents.

A spokeswoman for Caltech declined to comment. Representatives for the other parties did not immediately respond to requests for comment on Wednesday.

According to Caltech's complaint filed in May, Broadcom, a semiconductor company that makes wireless chips purportedly incorporating the irregular repeat-accumulate code technology, has sold the allegedly infringing devices to Apple — one of its largest customers — for use in such products as the iPhone, iPad, MacBook and Apple Watch.

From 2012 to 2014, "Broadcom's Wi-Fi products that incorporate [irregular repeat-accumulate/low-density parity check] encoders and decoders and infringe the asserted patents were incorporated into Apple's key products including iPhones, iPads and Mac computers," the complaint said. "On information and belief, sales from these Apple products generated hundreds of billions of dollars in revenue."

The patents-in-suit are U.S. Patent Numbers 7,116,710; 7,421,032; 7,916,781 and 8,284,833.

Caltech is represented by James R. Asperger, Kevin P.B. Johnson, Edward J. DeFranco, Todd M. Briggs and Heather Belville McCarthy of Quinn Emanuel Urquhart & Sullivan LLP.

Apple and Broadcom are represented by Duane-David Hough, Brian W. Nolan, Cliff A. Maier, Elspeth V. Hansen and Andrew S. DeCarlow of Mayer Brown LLP.

The case is California Institute of Technology v. Broadcom Limited et al., case number 2:16-cv-03714, in the U.S. District Court for the Central District of California.

--Additional reporting by Suevon Lee. Editing by Marjorie Backman.