
Nos. 2020-1041, -1043 (consolidated)

United States Court of Appeals for the Federal Circuit

WI-LAN,
Plaintiff-Appellant

v.

SHARP ELECTRONICS CORPORATION,
Defendant-Appellee

Appeal from the U.S. District Court of the District of Delaware,
No. 1:15-cv-00379 LPS, Chief Judge Leonard P. Stark

WI-LAN,
Plaintiff-Appellant

v.

VIZIO, INC.,
Defendant-Appellee

Appeal from the U.S. District Court of the District of Delaware,
No. 1:15-cv-00788 LPS, Chief Judge Leonard P. Stark

**APPELLEES' RESPONSE TO REHEARING PETITION
(CORRECTED)**

Mark S. Davies
ORRICK, HERRINGTON & SUTCLIFFE LLP
1152 Fifteenth St., NW
Washington, D.C. 20005
(202) 339-8400

John C. O'Quinn
William H. Burgess
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave, NW
Washington, D.C. 20004
(202) 389-5000

Elizabeth Moulton
ORRICK, HERRINGTON & SUTCLIFFE LLP
1000 Marsh Road
Menlo Park, CA 94025
(650) 614-7400

Gianni Cutri
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
(312) 862-2000

Counsel for VIZIO, Inc.

Counsel for Sharp Electronics Corp.

June 30, 2021

**CERTIFICATE OF INTEREST
(Sharp Electronics Corp.)**

Counsel for Appellee Sharp Electronics Corporation certify the following:

1. The full name of all entities represented by us: Sharp Electronics Corporation

2. The full name of all real parties in interest not identified in response to Question 3: None.

3. Parent corporations and publicly held companies that own 10% or more of the stock in the parties represented by us: Sharp Corporation

4. The names of all law firms and the partners or associates who appeared for the party now represented by us in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:

Kirkland & Ellis LLP: Joel Merkin, (withdrawn), Rajat Khanna (withdrawn), James Beard (withdrawn), Jared Barcenas (withdrawn)

Morris, Nichols, Arsht & Tunnell LLP: Jack Blumenfeld, Stephen Kraftschik (withdrawn)

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:

Wi-LAN Inc. v. Sharp Electronics Corporation, Case No. 1:15-cv-00379-LPS (D. Del.); *Wi-LAN Inc. v. VIZIO, Inc.*, Case No. 1:15-cv-00788-LPS (D. Del.); *Wi-LAN Inc. v. VIZIO, Inc.*, Case No. 2020-1043 (Fed. Cir.)

6. Any information required under Fed.R.App.P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

N/A.

**CERTIFICATE OF INTEREST
(VIZIO, INC.)**

Counsel for Appellee VIZIO, Inc. certify the following:

- 1. The full name of all entities represented by us: VIZIO, Inc.**
- 2. The full name of all real parties in interest not identified in response to Question 3: None**
- 3. Parent corporations and publicly held companies that own 10% or more of the stock in the parties represented by us: None**
- 4. The names of all law firms and the partners or associates who appeared for the party now represented by us in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:**

Jessica Newman of Jeffer Mangels Butler & Mitchell, LLP; Pilar G. Kraman of Young, Conaway, Stargatt & Taylor LLP

Steven P. Basileo, Charles C. Koole, Sheng-Wen D. Jui, Dan Liu, Adrian M. Pruetz of Glaser Weil Fink Howard Avchen & Shapiro LLP (former counsel)

- 5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:**

Wi-LAN v. Sharp Electronics Corp., Fed. Cir. No. 2020-1042 (both appeals have now been consolidated)

- 6. Any information required under Fed.R.App.P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).**

N/A.

TABLE OF CONTENTS

INTRODUCTION	1
RELEVANT BACKGROUND	2
A. Wi-LAN Sues for Infringement, But Fails to Obtain Necessary Evidence From Foreign Third Parties.	2
B. The District Court Grants Summary Judgment of Noninfringement.	4
C. This Court Affirms.	8
ARGUMENT	10
I. The Panel Decision is Correct.	11
II. The Panel Decision is Consistent With Third Circuit Precedent.	14
III. The Panel Decision is Consistent with Rule 703’s Purposes.	17
IV. The Panel Decision Resolves A Unique Case.	19
CONCLUSION	22

TABLE OF AUTHORITIES

Cases

<i>Advo, Inc. v. Phila. Newspapers, Inc.</i> , 51 F.3d 1191 (3d Cir. 1995)	17
<i>Brooke Grp. v. Brown & Williamson Tobacco Corp.</i> , 509 U.S. 209 (1993)	17
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986)	11
<i>Dow Chem. Co. v. Nova Chems. Corp.</i> , 809 F.3d 1223 (Fed. Cir. 2015)	2
<i>Ferring B.V. v. Barr Labs., Inc.</i> , 437 F.3d 1181 (Fed. Cir. 2006)	5
<i>Gen. Elec. Co. v. Joiner</i> , 522 U.S. 136 (1997)	5
<i>Golden Door Jewelry Creations, Inc. v. Lloyds Underwriters Non-Marine Ass’n</i> , 865 F.Supp. 1516 (S.D. Fla. 1994)	20
<i>GS Cleantech Corp. v. Adkins Energy LLC</i> , 951 F.3d 1310 (Fed. Cir. 2020)	20
<i>Hamilton v. Emerson Elec. Co.</i> , 133 F.Supp.2d 360 (M.D. Pa. 2001)	16
<i>Henry v. St. Croix Alumina, LLC</i> , 572 F. App’x 114 (3d Cir. 2014)	16
<i>In re Japanese Electronic Prods.</i> , 723 F.2d 238 (3d Cir. 1983)	14, 15
<i>In re Paoli R.R. Yard PCB Litig.</i> , 916 F.2d 829 (3d Cir. 1990) (<i>Paoli I</i>)	14, 15
<i>In re Paoli R.R. Yard PCB Litig.</i> , 35 F.3d 717 (3d Cir. 1994) (<i>Paoli II</i>)	10, 15, 16

Kerrigan v. Maxon Ind.,
 223 F.Supp.2d 626 (E.D. Pa. 2002) 16

L&W, Inc. v. Shertech, Inc.,
 471 F.3d 1311 (Fed. Cir. 2006) 11

LaserDynamics, Inc. v. Quanta Comput., Inc.,
 694 F.3d 51 (Fed. Cir. 2012) 17

Medtronic, Inc. v. Mirowski Family Ventures, LLC,
 571 U.S. 191 (2014) 11

New York v. Solvent Chem. Co.,
 166 F.R.D. 284 (N.D.N.Y. 1996) 20

Oddi v. Ford Motor Co.,
 234 F.3d 136 (3d Cir. 2000) 15, 16

Padillas v. Stork-Gamco, Inc.,
 186 F.3d 412 (3d Cir. 1999) 16

Schaffer v. Weast,
 546 U.S. 49 (2005) 21

Solorio v. United States,
 85 F. App'x 705 (10th Cir. 2004) 16

Syngenta Crop Prot. LLC v. Willowood, LLC,
 944 F.3d 1344 (Fed. Cir. 2019) 21

View Eng'g v. Robotic Vision Systems., Inc.,
 208 F.3d 981 (Fed. Cir. 2000) 19

Williams v. Illinois,
 567 U.S. 50 (2012) 18

Statute

35 U.S.C. §295 21

Rules

Fed. R. Civ. P. 11(b)(3) 19

Fed. R. Civ. P. 56 11

Fed. R. Civ. P. 56(c) 11

Fed. R. Civ. P. 56(c)(2) 5

Fed. R. Evid. 703.....1, 7-9, 14-18, 20

Fed. R. Evid. 801(d)(2)(B).....6, 7

Fed. R. Evid. 803(6) 6

Fed. R. Evid. 807.....6, 7

Fed. R. Evid. 901..... 6

Fed. R. Evid. 902..... 6

Note: All quoted emphasis is added unless otherwise indicated.

INTRODUCTION

Wi-LAN's petition relies on a misleading narrative and misreading superseded Third Circuit cases. Wi-LAN's main premise—that Defendants relied on the same evidence as Wi-LAN and conceded reliability, Pet.2, 4, 6-7, 7-8, 12—is one the district court correctly called “wildly inaccurate.” Appx31. Wi-LAN's petition omits *how* Wi-LAN obtained disputed declarations and source code material, *why* that evidence and its provenance were critical, and *why* summary judgment was granted. Regardless of what conclusions Wi-LAN's expert could draw about *a* chip hypothetically made with certain source code, Wi-LAN had only “not trustworthy,” coercively-obtained evidence to indicate that any accused product's chip was actually made with that code. Appx30. Wi-LAN did not carry its burden of showing an expert would reasonably rely on such evidence, and the district court did not abuse its discretion in excluding it. Thus, Wi-LAN could not prove infringement.

There is no basis for further proceedings. Third Circuit precedent and the panel decision fully answer Wi-LAN's arguments. Rule 703 is not a way to admit evidence for substantive purposes. There is nothing “common” about Wi-LAN's tactics that led to summary judgment. Pet.15.

A losing party's case-specific disagreement with the result is no basis for rehearing en banc. *Dow Chem. Co. v. Nova Chems. Corp.*, 809 F.3d 1223, 1227-28 (Fed. Cir. 2015) (Moore, J., joined by Newman, O'Malley, Tarranto, and Chen, JJ., concurring in denial). The petition should be denied.

RELEVANT BACKGROUND

A. Wi-LAN Sues for Infringement, But Fails to Obtain Necessary Evidence From Foreign Third Parties.

Wi-LAN's 6,359,654 patent claims recite video "deinterlacing" methods. SlipOp.3. Wi-LAN contended that the "system-on-chip" on each of Defendants' accused televisions practiced Wi-LAN's method claims. SlipOp.4. Whether any chip practiced Wi-LAN's claims could only be shown with source code. But foreign nonparties designed and made the chips; Defendants had no source code. Wi-LAN was "on notice since the very beginning of the case," Appx26, that it needed the foreign chipmakers' source code to prove its claims. Appx26; *see also* Appx1300; Appx87-88; RedBr.8-9.

Indeed, Wi-LAN accused *hundreds of models* of televisions, made from 2009 to 2017, and thus needed eight years of source code for various chips. Wi-LAN never obtained that evidence, so devised a shortcut. Wi-

LAN initially asked the chipmakers for 2009-2017 code, or a current version with either change logs or a statement that it was representative of all prior code. The chipmakers resisted, RedBr.10-11; Appx12811-12813, explaining there was not “a single person, or even multiple, who could state under oath that there are ‘no material differences’” across eight years of code. Appx12813; Appx26 (quoting *id.*). The chipmakers’ response was consistent with Wi-LAN’s experts’ contentions that chips’ designs would change significantly every year. Appx10690-10691 (quoting Appx9250 ¶289, Dkt.422(Ex. 5 ¶72), and Dkt. 423(Ex.22 pp.144-45)), and with Wi-LAN’s acknowledgment “clearly there have been revisions to the source code.” Appx27 n.4 (quoting Appx15398). As the district court noted, a “no material differences” representation would make little sense without reference to a claim construction order. *Id.*

Wi-LAN sued the chipmakers and demanded they sign “no material differences” declarations anyway. Wi-LAN promised to dismiss its lawsuits, and not seek damages, if the chipmakers produced a then-current (2017) set of Register Transfer Level code (used to manufacture chips), and signed declarations that Wi-LAN drafted, baldly asserting there were “no material differences” between the 2017 code and eight prior

years of code. Appx27; Appx15580-15581; see Appx12907; Dkt.423(Exh.56, settlement with fill-in-the-blanks declaration). The chipmakers agreed. Wi-LAN drafted the declarations to state that each declarant “underst[oo]d” the chipmakers had created printed excerpts of the 2017 code at Wi-LAN’s request. *E.g.*, Appx13601(¶2). The referenced printouts contained visible inconsistencies, however, Appx29 n.6, and included *alterations Wi-LAN ordered*—including comments purporting to link excerpts to chips and files. Appx29 (citing Appx15580-15581 (citing Appx15588; Appx15627)). These printouts were the form any code evidence would take at trial, as native code was only available for 90 days on a secure computer. Dkt.423(Exh.56, WILAN_002138).

Wi-LAN’s expert reviewed the 2017 code and opined that a chip made using that code would infringe. But no evidence existed to authenticate the code or link it to *any chip in any actual product*—except the declarations Wi-LAN drafted and induced chipmakers to sign. No chipmaker-declarants would appear at trial. Appx27; see RedBr.43-45

B. The District Court Grants Summary Judgment of Noninfringement.

Defendants moved for summary judgment on multiple grounds, including that Wi-LAN could not meet its burden to show infringement.

Appx10683-10692; Appx15198-15202. Defendants explained that Wi-LAN's out-of-court, "no material differences" declarations were "*not admissible evidence*," Appx10688-10689, "*highly unreliable*," Appx10690-10692, and without them Wi-LAN could not show "that the code its expert did analyze does in fact apply to the [chips] actually used in the accused televisions." Appx10692. Admissibility was discussed at the hearing, Appx15377-15378; Appx15383-15401; Appx15410-15411; Appx15432-15433, and in court-ordered supplemental briefing. Appx15353-15355 (order); Appx15570-15584, Appx15706-15715 (Defendants' briefs); Appx15446-15460; Appx15645-15651 (Wi-LAN's briefs).

Under Fed.R.Civ.P. 56(c)(2), the proponent of challenged evidence has the "burden" to "show that the material is admissible as presented or explain the admissible form that is anticipated." *Id.* (2010 advisory committee notes). Evidentiary disputes work much the same at summary judgment as at trial—they are committed to the court's discretion, with no requirement to view facts (for admissibility purposes) in the light most favorable to the nonmoving party. *Id.*; *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 143 (1997); *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181, 1195 & n.17 (Fed. Cir. 2006); RedBr. 26-29.

To contend its declarations and source-code printouts were admissible, Wi-LAN cited Rules 801(d)(2)(B) (adoptive-admission exception), 901 (authentication-by-testimony), 902 (self-authentication), 803(6) (business-record hearsay exception), 807 (residual exception), Appx15450-15454 & n.5, and 703. Appx15455.

The district court disagreed. Appx26-33. The declarations were too vague to authenticate the code (Rules 803 and 902), Appx28, and prepared for litigation, not business (Rule 803(6)). Appx29. Further, Defendants “*demonstrated a lack of trustworthiness in the materials.*” Appx29. “The circumstances surrounding the production, including” the chipmakers’ initial claims that they could not produce one set of code and sign a no-material-differences declaration, “raises further concern as to the credibility of both the source code and the [declarations].” *Id.*

The code also could not be authenticated (Rule 901) because the “declarations are *not trustworthy* and neither the declarants nor anyone else with knowledge of the source code has been deposed or will be coming to trial.” Appx30; *see id.* (reiterating “*highly dubious circumstances* surrounding the production and the lack of indicia of *trustworthiness in the source code.*”); Appx29 & n.6.

Rule 807 was inapplicable because “the source code and declarations lack” required “circumstantial guarantees of *trustworthiness*.” Appx30.

Rule 801(d)(2)(B) was inapplicable because *Defendants did not rely on the same evidence or concede its reliability*. Appx31. The court called Wi-LAN’s characterization—which its rehearing petition repeats¹—“*wildly inaccurate*,” because “Defendants’ primary—and vehement—position has always been that all the [chipmakers’] declarations are inadmissible; any reliance on them in Defendants’ papers has been argued in the alternative...” *Id.*

Finally, under Rule 703, if an expert relies on the kinds of facts or data “experts in the field would reasonably rely on,” the expert’s opinion can be admitted even if the facts or data are inadmissible. The facts or data can be “disclose[d] ... to the jury only if their probative value in helping the jury evaluate the opinion substantially outweighs their prejudicial effect.” Fed.R.Evid. 703. Wi-LAN argued that because its expert “relied” on the declarations and source-code excerpts, that information

¹ See Pet.4, 6-7, 7-8, 12.

could be “disclosed” to “help[] the jury evaluate the opinion.” Appx15454-15455. The district court disagreed, explaining Rule 703 is not “a ‘back-door’ to allow the admission into evidence of otherwise inadmissible declarations and other materials simply because they might assist the jury’s evaluation of an expert’s opinions.” Appx30-31.

The source code and declarations were thus inadmissible, Appx32, and summary judgment followed because “[w]ithout source code from the [chipmakers], no reasonable juror could find that Defendants’ accused televisions practice the limitations of the asserted claims.” Appx33.

C. This Court Affirms.

Wi-LAN appealed, re-raising its evidentiary arguments and numerous others, including a single-paragraph Rule 703 argument that referred alternatively to “the source code” and “the source code and declarations.” BlueBr.55. Defendants responded. RedBr.38-42. The panel affirmed, rejecting Wi-LAN’s arguments, and finding the district court’s untrustworthiness findings within its discretion. SlipOp.11-12.

Under Rule 703, the panel considered first whether Wi-LAN’s code excerpts were admissible because the expert relied on them, and second,

whether the expert's testimony relying on the code excerpts was admissible to establish infringement. SlipOp.13-14. The answer to both was no. Citing caselaw and leading treatises, the panel explained "Rule 703 does not make admissible otherwise inadmissible evidence," nor authorize experts to repeat hearsay to the jury on the pretext of having relied on it. SlipOp.14 (quoting treatises). When facts or data are disclosed under Rule 703 to "help" the jury evaluate an expert's opinion, "the trial judge *must* give a limiting instruction ... that the underlying information *must not be used for substantive purposes.*" *Id.* (quoting advisory committee notes). The panel discussed five appellate decisions rejecting arguments like Wi-LAN's, and agreed with the district court that "Wi-LAN attempt[ed] to do exactly what is impermissible under Rule 703 by using its expert as a substitute for a fact witness to circumvent the rules of evidence to admit otherwise inadmissible evidence." SlipOp.14-16.

Second, the panel explained that although it was "obviously correct" that experts may rely on "source code" opine about infringement, that did not resolve whether experts could reasonably rely on the unauthenticated materials here. SlipOp.17. Again, nothing linked any source code with any actual product except for the declarations (which the district

court found untrustworthy) and printouts parroting the linkage asserted in those declarations (which also reflected unexplained inconsistencies making authentication impossible). Appx29-31 & n.6. Under Third Circuit precedent, the proponent of challenged evidence has the burden to establish reasonable reliance. SlipOp.17 (citing *In re Paoli R.R. Yard PCB Litig.*, 35 F.3d 717, 748 (3d Cir. 1994) (“*Paoli II*”). Wi-LAN’s conclusory argument below failed to satisfy that requirement, and provided no basis for the district court to inquire further than it already had. SlipOp.17-18.

ARGUMENT

What Wi-LAN contends are “precedent-setting questions of exceptional importance,” Pet.1, and “an increasingly common scenario,” Pet.15, are the district court and panel’s case-specific applications of familiar rules to reject Wi-LAN’s unusual attempt to manufacture evidence. The lack of admissible evidence to suggest that any accused product was actually made using the code Wi-LAN’s expert reviewed properly led the district court to grant summary judgment and the panel to affirm.

I. The Panel Decision is Correct.

The panel and district court decisions are straightforward applications of familiar rules. Wi-LAN had the burden to prove infringement, product-by-product. *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 571 U.S. 191, 198-99 (2014); *L&W, Inc. v. Shertech, Inc.*, 471 F.3d 1311, 1317-18 (Fed. Cir. 2006). Rule 56 “mandates” summary judgment “against a party who fails to make a showing sufficient to establish the existence of an element essential to that party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The proponent of challenged evidence bears the burden “to show” that it is “admissible as presented or to explain the admissible form that is contemplated.” Fed.R.Civ.P. 56(c) (2010 advisory committee notes).

Infringement could be proved, if at all, only by obtaining foreign third parties’ source code for chips in hundreds of accused products over eight years. Wi-LAN only obtained one set of code from each chipmaker, post-dating the accused products, and had its expert opine that a chip made using that code would infringe. Critically, Wi-LAN had no admissible evidence that that code was used to make any chip in *any actual accused product*. Wi-LAN agreed it needed to close the gap. “To map

each version of the code to particular chips in the accused products, [Wi-LAN's expert] relied on sworn declarations of employees from Defendants' chip suppliers." BlueBr.22.

But in rulings Wi-LAN no longer challenges, the district court found—and the panel affirmed—that Wi-LAN's declarations and source code evidence were inadmissible hearsay, “not trustworthy,” and procured under “highly dubious circumstances.” Appx26-33. Without any evidence to link one unauthenticated set of code with any of hundreds of accused products over eight years, no reasonable jury could find infringement. Appx33.

Wi-LAN contends the panel's reference to “unauthenticated source code printouts,” SlipOp.17, overlooked Wi-LAN's expert's reliance on “native” source code. Pet.5. The panel did not misapprehend the record. Wi-LAN quotes the reference to “unauthenticated source code printouts” out of context and reframed within Wi-LAN's misleading narrative. “Printouts” are the form the 2017 code (the only code Wi-LAN obtained) would have taken at trial. The reasons the code could not be authenticated—in “native” or “printout” form—are the same. As the district court explained, the declarations purporting to authenticate the code were “*not*

trustworthy and neither the declarants nor anyone else with knowledge of the source code has been deposed or will be coming to trial.” Appx30. The code (in native or printout form) was not self-authenticating “given the highly dubious circumstances surrounding the production and the lack of indicia of trustworthiness in the source code.” *Id.*; Appx29 (describing inconsistency in the code itself, “as well as added commentary on the printed excerpts”).

Thus, regardless of which locution is used to refer to Wi-LAN’s unauthenticated source code, the panel’s point is obviously correct: it is not enough to say that experts may base infringement opinions on “source code.” SlipOp.17. Wi-LAN needed to show that *its* evidence—untrustworthy 2017 code connected to eight years of accused products only by untrustworthy declarations and Wi-LAN’s annotations on printouts—are the kind experts *reasonably* rely upon on to form opinions about infringement by actual products. Wi-LAN tries to dodge that point by repeating a generic, sanitized description of its evidence. *E.g.*, Pet.6 (“sworn statements from engineers with firsthand knowledge of the code”). The panel correctly rejected that tactic of shifting levels of generality. Wi-LAN bore

the burden with respect to *its* evidence, and the district court permissibly concluded it was not met here. SlipOp.16-18.

II. The Panel Decision is Consistent With Third Circuit Precedent.

Wi-LAN contends the panel misapplied Third Circuit precedent concerning Rule 703. This Court's application of regional-circuit precedent is like any federal court's application of state law under diversity or supplemental jurisdiction. Alleged errors applying another court's precedent are no basis for rehearing en banc. And the panel did not err. Third Circuit precedent does not require further inquiry into reasonable reliance than the district court made.

Wi-LAN's reliance on outdated cases such as *In re Paoli R.R. Yard PCB Litig.*, 916 F.2d 829 (3d Cir. 1990) ("*Paoli I*") and *In re Japanese Electronic Prods.*, 723 F.2d 238 (3d Cir. 1983), *rev'd Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986) is unsound. *Paoli I* and *Japanese Electronic* dealt with motions to exclude expert testimony. *Japanese Electronic*, 723 F.2d at 279; *Paoli I*, 916 F.2d at 846. Only the code and declarations were excluded, not Wi-LAN's expert. Appx32 *Japanese Electronic* held that the *unintelligibility* of a handwritten document

was not germane to determining *trustworthiness*. 723 F.2d at 291. Nothing similar was at issue here.

Wi-LAN does not dispute the panel's explanation that *Wi-LAN bore the burden* under Third Circuit precedent to demonstrate reasonable reliance. SlipOp.17 (citing *Paoli II*, 35 F.3d at 748). Nor does Wi-LAN challenge the district court's findings that the declarations and source code are fundamentally "not trustworthy." *E.g.*, Appx29-30 & n.6. None of Wi-LAN's citations suggest an expert can *reasonably* rely on unauthenticated, let alone untrustworthy, materials in the manner Wi-LAN proposed.

Moreover, *Paoli I*, *Japanese Electronic*, and most of Wi-LAN's citations predate *Daubert* and the 2000 amendments to Rule 703. In 1994, the Third Circuit specifically disavowed certain of *Paoli I* and *Japanese Electronics'* statements about Rule 703 as "no longer tenable in light of *Daubert*." *Paoli II*, 35 F.3d at 747-748; *id.* at 733 ("does not survive *Daubert*"). The district court must still consider *reasonable* reliance, but without deference to the expert, and with the burden of persuasion on the proponent. *Id.* at 747-48; SlipOp.17. Cases like *Oddi v. Ford Motor Co.*, 234 F.3d 136, 154 (3d Cir. 2000) confirm that the Third Circuit rejects

“mandatory procedures” in this area, and “trial courts retain significant discretion.” The court may “take into account” any “factors [it] deems relevant.” *Paoli II*, 35 F.3d at 748. Such relevant factors surely include the substantive deficiencies and untrustworthiness the district court considered here.

Wi-LAN’s argument that Third Circuit precedent entitled it to an *in limine* hearing is unsound and forfeited. Courts in the Third Circuit and elsewhere have already answered and rejected Wi-LAN’s argument that *Padillas v. Stork-Gamco, Inc.*, 186 F.3d 412 (3d Cir. 1999) broadly requires *in limine* hearings to resolve Rule 703 disputes. *E.g.*, *Henry v. St. Croix Alumina, LLC*, 572 F. App’x 114, 118-19 (3d Cir. 2014); *Solorio v. United States*, 85 F. App’x 705, 709-10 (10th Cir. 2004); *Oddi*, 234 F.3d at 151-55; *Kerrigan v. Maxon Ind.*, 223 F.Supp.2d 626, 632-34 (E.D. Pa. 2002); *Hamilton v. Emerson Elec. Co.*, 133 F.Supp.2d 360, 374 (M.D. Pa. 2001). Here, as in *Oddi*, there was no question of *how* the expert formed its opinion. 234 F.3d at 154. The district court found the critical evidence purporting to link the code to accused products was fundamentally untrustworthy and inadmissible, and did so after ample process (summary judgment briefing, hearing, and two rounds of supplemental briefs). Wi-

LAN never asked for an *in limine* hearing then, *or even on appeal*. A rehearing petition is far too late to request one for the first time.

III. The Panel Decision is Consistent with Rule 703's Purposes.

Wi-LAN's "purpose" arguments, Pet.13-14, mistake the role of experts, Rule 703, the district court opinion, and the record.

"Expert testimony is useful as *a guide to interpreting ... facts*, but it is *not a substitute for them*." *Brooke Grp. v. Brown & Williamson Tobacco Corp.*, 509 U.S. 209, 242 (1993). Expert opinion could not cure the lack of admissible *factual evidence* linking the code to any accused product. *See LaserDynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 81 (Fed. Cir. 2012) (citing *Brooke*, vacating jury verdict); *Advo, Inc. v. Phila. Newspapers, Inc.*, 51 F.3d 1191, 1198-99 (3d Cir. 1995) (quoting *Brooke*, affirming summary judgment).

Rule 703 does not help Wi-LAN. Its limited purpose is explicit in the text: relied-upon information can be "disclose[d] ..." only for its "probative value in *helping the jury evaluate the opinion*." Fed.R.Evid. 703. Advisory Committee notes, which the panel quoted, confirm that information so disclosed "*must not be used for substantive purposes*,"

SlipOp.14, and “the underlying information is not admissible simply because the opinion or inference is admitted.” Supreme Court precedent reiterates that Rule 703 “permits an expert to explain the facts about which his or her opinion is based *without testifying to the truth of those facts.*” *Williams v. Illinois*, 567 U.S. 50, 57 (2012) (plurality). “It is then up to the party who calls the expert *to introduce other evidence* establishing the facts assumed by the expert.” *Id.*

Wi-LAN ignores that Rule 703 is fundamentally not a way to admit otherwise-inadmissible substantive evidence. *See* SlipOp.14. Wi-LAN’s contention that the district court failed to “balance[]” the probative value in assisting the jury versus “the risk of prejudice resulting from the jury’s potential misuse of information *for substantive purposes,*” Pet.14, is answered by the district court’s opinion, Appx31, and Wi-LAN’s argument below. Appx15454-15455. Wi-LAN offered the code and declarations *entirely* for substantive purposes: Rule 703 was Wi-LAN’s fallback for its hearsay-exception arguments to admit that information *as substantive evidence.* Appx15454-15455. The district court thus properly rejected Wi-LAN’s attempt to use Rule 703 as a “backdoor,” so there was nothing more to “balance.” Appx31; *see* SlipOp.16 (Rule 703 did not permit Wi-

LAN to “us[e] its expert as a substitute for a fact witness to circumvent the rules of evidence.”).

But the district court also considered Wi-LAN’s “prejudice” argument. That was Wi-LAN’s contention that Defendants relied on the same evidence as Wi-LAN and conceded reliability. Appx15455. The court rejected that argument in the next paragraph of its opinion, as “wildly inaccurate.” Appx31.

IV. The Panel Decision Resolves A Unique Case.

Wi-LAN contends “[t]his case presents an increasingly common scenario.” Pet.15. It does not. Wi-LAN’s grievances are specific to this case and to ill-advised decisions Wi-LAN made.

Wi-LAN never explains how or why it sued Defendants in good faith when it had no source code, no plan for obtaining it, and no other way to know whether Defendants’ products practice its claims. That scenario should not be common. *See* Fed.R.Civ.P. 11(b)(3); *View Eng’g v. Robotic Vision Systems., Inc.*, 208 F.3d 981, 986-87 (Fed. Cir. 2000).

Wi-LAN was on notice since the case’s inception that it needed third-party source code, and was given years and repeated extensions to obtain it. RedBr.7-10; Appx32. Wi-LAN’s choice to sue third parties to

pressure or pay them for evidence should not be a common scenario, as attorney-conduct rules exist to prevent it. *See GS Cleantech Corp. v. Adkins Energy LLC*, 951 F.3d 1310, 1329-30 (Fed. Cir. 2020) (inequitable conduct affirmed where patentee “threatened” third party “to coerce its support” by exchanging “release of liability” for cooperation); *New York v. Solvent Chem. Co.*, 166 F.R.D. 284, 289 (N.D.N.Y. 1996) (settlement in exchange for testimony violates prohibition against compensating fact witnesses (collecting cases)); *Golden Door Jewelry Creations, Inc. v. Lloyds Underwriters Non-Marine Ass’n*, 865 F.Supp. 1516, 1524-26 (S.D. Fla. 1994) (payments rendered witness incompetent to testify), *aff’d in relevant part*, 117 F.3d 1238, 1235 n.2 (11th Cir. 1997).

Wi-LAN’s attempt to “admit” evidence under Rule 703—an undeveloped fallback argument below and on appeal, Appx15454-15455; BlueBr.55—should also not be common because it is clearly wrong. As the panel noted, courts have “reaffirmed repeatedly” that Rule 703 is not a hearsay exception or a way to admit evidence for substantive purposes. SlipOp.14; §III, *supra*.

At best for Wi-LAN, its difficulties were a case-specific function of its claims, Defendants' products and supply chain, and the territorial limits of subpoena power. Wi-LAN's claims depended on proof of technical facts about internal functions of components made and designed by foreign nonparties outside the subpoena power and outside Defendants' control. Wi-LAN complains of "incentives" for defendants to "hide the ball ... and claim that their core technical documents can be obtained only from third-party suppliers," and for foreign suppliers not to cooperate. Pet.16. Defendants have "hidden" nothing; they "claimed" that only foreign third parties have the necessary source code because that is the truth. Through no fault of Defendants, this may be (at best for Wi-LAN) a rare case where the parties lack access to critical evidence.

In such cases, the "ordinary default rule" of American litigation confirms that "plaintiffs bear the risk of failing to prove their claims." *Schaffer v. Weast*, 546 U.S. 49, 56 (2005). If Wi-LAN thinks that rule may produce harsh results, Wi-LAN may petition its elected representatives. Congress has adjusted burdens of proof before, as in 35 U.S.C. §295 to address "great difficulties a patentee may have" proving infringement of process patents under §271(g) for products made abroad. *Syngenta Crop*

Prot. LLC v. Willowood, LLC, 944 F.3d 1344, 1363 (Fed. Cir. 2019). But Congress has enacted no similar provision for Wi-LAN's circumstances, and the solution to Wi-LAN's complaints is not to ignore burdens of proof or rules of evidence.

CONCLUSION

Wi-LAN's petition should be denied.

June 30, 2021

Respectfully submitted,

/s/ Mark S. Davies
(signed with consent)

/s/ John C. O'Quinn

Mark S. Davies
ORRICK, HERRINGTON
& SUTCLIFFE LLP
1152 Fifteenth St., N.W.
Washington, D.C. 20005
(202) 339-8400

John C. O'Quinn
William H. Burgess
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave, N.W.
Washington, D.C. 20004
(202) 389-5000

Elizabeth Moulton
ORRICK, HERRINGTON
& SUTCLIFFE LLP
1000 Marsh Road
Menlo Park, CA 94025
(650) 614-7400

Gianni Cutri
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
(312) 862-2000

Counsel for VIZIO, Inc.

*Counsel for
Sharp Electronics Corp.*

CERTIFICATE OF COMPLIANCE WITH
TYPE-VOLUME LIMITATION

This response complies with the type-volume limitations of the Federal Rules of Appellate Procedure and the Rules of this Court. According to the word-processing system used to prepare this document, the response contains 3,900 words.

/s/ John C. O'Quinn
