

DEPARTMENT: MICRO LAW

A Review of *Wisconsin Alumni Research Foundation v. Apple*—Part III

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Part I of this series introduced the *Wisconsin Alumni Research Foundation v. Apple* cases and described the asserted patent. That article also summarized some recent large verdicts for patents asserted by academic institutions and provided several reasons why this series may be of interest to the readership of *IEEE Micro*, most notably because the inventors are well known and several well-known computer architects worked as experts on this case. Part II described the complaints, namely, it described the plaintiff, Wisconsin Alumni Research Foundation (“WARF”), the inventors, and WARF’s allegations as to how Apple’s products infringed WARF’s patent.

IN ADDITION TO ADMITTING OR DENYING THE ALLEGATIONS IN WARF’S COMPLAINT, APPLE’S ANSWER INCLUDES A FEW AFFIRMATIVE DEFENSES AND A FEW COUNTERCLAIMS.

APPLE’S ANSWER TO WARF’S COMPLAINT

On 26 March 2014, 54 days after WARF filed the lawsuit, Apple filed its answer to WARF’s complaint. Apple denied most of the allegations in WARF’s complaint. For example, Apple denied that its A7 processor incorporated the technology of WARF’s patent, U.S. Patent Number 5,781,752 (see Paragraph 5 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). As second example, Apple denied that it was directly infringing, inducing infringement of, or contributorily infringing the ‘752 Patent (see Paragraphs 21, 22, and 23 of *Wis. Alumni Rsch. Found. v.*

*Apple, Inc.*¹). On other hand, Apple occasionally admitted, i.e., agreed with, some of the allegations in WARF’s complaint. For example, Apple admitted that “Apple is one of the largest makers of smart phones and tablet computers in the world” and that Apple is “a California corporation which has its principal place of business at 1 Infinite Loop, Cupertino, CA 95014.” On occasion, Apple asserted that it “lacks knowledge or information sufficient to admit or deny the allegations contained in Paragraph 12” (see Paragraph 12 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). In Paragraph 12 of WARF’s complaint, WARF asserted that it “is the owner of all rights, title, and interest in the ‘752 patent by assignment and thereby is authorized and has standing to bring legal action to enforce all rights arising under the ‘752 patent” (see Paragraph 12 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*²). Apple’s particular assertion that it does not have sufficient information to admit or deny that WARF was the owner of the ‘752 Patent is interesting for reasons described below.

In addition to admitting or denying the allegations in WARF’s complaint, Apple’s answer includes a few affirmative defenses and a few counterclaims. With respect to the former, Apple specifically asserts seven affirmative defenses, while also reserving the right to assert additional defenses (see Paragraph 1 on pages 4 and 5 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). For the most part, all of Apple’s affirmative defenses are generally asserted by a defendant. Apple’s first affirmative defense is that it has not infringed “either directly, contributorily, or by inducement ... either literally or under doctrine of equivalents, willfully or otherwise” (see Paragraph 13 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). But Apple does not provide any reasons why the accused products do not infringe.

Apple’s second affirmative defense is that the asserted patent “is invalid and/or unenforceable for failing to meet one or more of the requisite conditions for patentability under Title 35 of the United States Code” (see Paragraph 2 on page 5 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Apple asserted that that two U.S. patents—U.S. Patent Number 5,615,350 and U.S.

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Patent Number 5,619,662—individually and/or together disclose the limitations of one or more claims of WARF's patent. The '350 Patent is titled "Apparatus to Dynamically Control the Out-of-Order Execution of Load-Store Instructions in a Processor Capable of Dispatching, Issuing and Executing Multiple Instructions in a Single Processor Cycle." The inventors of that patent were James H. Hesson, Jay LeBlanc, and Stephen J. Ciavaglia, and the patent was assigned to IBM. The '662 Patent is titled "Memory Reference Tagging." The inventors of that patent were Simon C. Steely Jr., David J. Sager, and David B. Fite Jr., and the patent was originally assigned to Digital Equipment Corporation.

A defendant in a patent lawsuit generally does not list specific pieces of prior art that may invalidate the asserted patent in their answer, so the fact that Apple did so in its answer in this case is unusual. One reason why a defendant typically does not is because it may take several weeks to identify prior art that discloses the limitations of the asserted patent, but the answer may be due weeks beforehand. But here, Apple used the same law firm that Intel used in WARF's earlier lawsuit against Intel. In the *Intel* lawsuit, Intel appears to have asserted both the Hesson '350 Patent and Steely Jr. '662 Patent as prior art that invalidated WARF's Patent (see, e.g., the ECF number on page 143 of *Wis. Alumni Rsch. Found. v. Intel Corp.*³). Therefore, Apple's lawyers already knew of these two prior art references from the *Intel* case, which was filed six years before the *Apple* cases. That said, it is not necessary to identify prior art in an answer and, arguably, a defendant may decline to do so to "hide the ball" from the plaintiff until later in the case.

Apple's third affirmative defense is that WARF is "es-topped to construe the claims of the '752 patent in any way to cover any product, method, or service of Apple under the Doctrine of Equivalents" (see Paragraph 8 on pages 5 and 6 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). The doctrine of equivalents ("DOE") is a legal doctrine that allows for a finding of infringement even though the accused product does not literally infringe if the accused product does not literally infringe as the accused product still operates with the same function, way, and result. The purpose of the DOE is to prevent a defendant from escaping infringement due to minor or insubstantial differences between the patent and the accused product. But the doctrine of prosecution history estoppel prevents the patentee from asserting the DOE to recover claim scope surrendered during the prosecution of the patent, i.e., during the patent application.

Apple's fourth affirmative defense is that this case "is not an 'exceptional' case within the meaning of 35

U.S.C. § 285" (see Paragraph 9 on page 6 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Section 285 authorizes a court to award attorney's fees to the prevailing party of a patent lawsuit if the court decides the case is "exceptional."⁴ The Supreme Court of the United States held that "[a]n 'exceptional' case, then, is simply one that stands out from others with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated" [see *Octane Fitness, LLC v. Icon Health & Fitness, Inc.*, 572 U.S. 545, 554 (2014)]. Attorney's fees in hard-fought patent cases can easily be several million dollars.

Apple's fifth affirmative defense is that "WARF is not entitled to injunctive relief because any alleged injury to WARF is neither immediate nor irreparable, and Plaintiff has an adequate remedy at law" (see Paragraph 10 on page 6 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Generally, courts will not grant an injunction to a nonpracticing entity such as WARF as an injunction is unnecessary, for example, to prevent a loss of market share.

THE PURPOSE OF THE DOE IS TO PREVENT A DEFENDANT FROM ESCAPING INFRINGEMENT DUE TO MINOR OR INSUBSTANTIAL DIFFERENCES BETWEEN THE PATENT AND THE ACCUSED PRODUCT.

Apple's sixth affirmative defense is that "[t]o the extent that any claim of the '752 patent is held to be invalid, WARF must be precluded from recovering costs related to this action pursuant to 35 U.S.C. § 288" (see Paragraph 11 on page 6 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Costs include fees for transcripts, printing, and copies, and compensation of experts and interpreters.⁵ Section 288 recites, in part, "[t]he patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent and Trademark Office before the commencement of the suit." There does not appear to be any claim that was previously invalidated, so it is unclear why Apple asserted this affirmative defense.

Apple's seventh affirmative defense is "[t]o the extent that any accused product has been used or manufactured by or for the United States government, WARF's purported claims for damages are limited by 28 U.S.C. § 1498" (see Paragraph 12 on page 6 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Section 1498 describes

that if the U.S. government infringes on the patent, then WARF's "remedy shall be by action against the United States in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for such use and manufacture."⁶ In other words, Apple's argument here is that, to the extent that the U.S. government infringes the patent, e.g., by using one of the accused products, WARF should sue the U.S. government in the Court of Federal Claims for those damages rather than recover them from Apple in the District Court for the Western District of Wisconsin.

In addition to these affirmative defenses, Apple asserted two counterclaims. Counterclaims are claims the defendant makes against the plaintiff, and those counterclaims mean that the parties effectively switch sides. As such, when a defendant asserts counterclaims, it is also known as the *counter-plaintiff*, while the plaintiff in the original action is also known as the *counter-defendant*.

Apple's first counterclaim is that it is entitled to a judgment that "it has not infringed and is not infringing, directly or indirectly, any valid or enforceable claim of the '752 patent, either literally or under the doctrine of equivalents, willfully or otherwise" (see Paragraph 11 on page 8 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Apple's second counterclaim is that "[e]ach claim of the '752 patent is invalid for failing to meet one or more of the requisite statutory and decisional requirements and/or conditions for patentability" under one or more sections of the U.S. code (see Paragraph 13 on page 8 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). More specifically, Apple again asserts that the Hesson '350 Patent and Steely Jr. '662 Patent individually and/or together invalidate WARF's Patent (see Paragraph 14 on page 8 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹).

One reason why a defendant may want to assert parallel affirmative defenses and counterclaims, e.g., assert noninfringement as both an affirmative defense and a counterclaim, is because the latter effectively exists as a separate lawsuit; the dismissal of the original lawsuit (with its allegations of infringement and affirmative defense of noninfringement) does not mean that the noninfringement counterclaims are also dismissed. Rather, they may continue to exist, which could potentially give the defendant/counter-plaintiff some additional leverage before and after settlement.

Finally, Apple's counterclaims section concludes with several requests. Apple's first and second request are that WARF's complaint be dismissed, in its entirety, with prejudice, and that judgment be entered in Apple's favor, respectively, (see page 9 of *Wis. Alumni Rsch.*

*Found. v. Apple, Inc.*¹). If a complaint, or a claim, is dismissed "with prejudice," that means that that claim cannot be asserted in court again. Apple's third and fourth requests are that the court enter judgment that Apple does not infringe the '752 Patent and that the '752 Patent is invalid, respectively (see Paragraph 14 on page 9 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). Apple's fifth and sixth requests are that the Court "[a]ward to Apple its costs, expenses, and reasonable attorneys' fees, pursuant to 35 U.S.C. § 285" and "[g]rant to Apple any such other relief that this Court deems proper," respectively (see Paragraph 14 on page 9 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹). All of these requests are typical.

WARF'S ANSWER TO APPLE'S COUNTERCLAIMS

On 16 April 2014, 21 days after Apple filed its answer, WARF filed its answer to Apple's counterclaims; namely, WARF responded to Apple's counterclaims of declarations for noninfringement and invalidity. WARF, for both of those counterclaims, asserted that both allegations are conclusions of law that do not require an answer, or it denied the allegations (see Paragraphs 11 and 15 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*⁷). WARF concluded that, to the extent that an answer to Apple's requests is required, WARF "denies that Apple is entitled to the requested relief or to any relief whatsoever" (see Paragraph 20 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*⁷).

WARF'S STANDING TO SUE

As described earlier, in its answer, Apple asserted that it does not have sufficient information to admit or deny that WARF was the owner of the '752 Patent. On 21 April 2014, a magistrate judge assigned to this case entered an order requiring WARF to provide proof of standing to sue on the claimed patents by 8 May 2014.⁸ In other words, the magistrate judge ordered that WARF provide proof that it owned the patents. This order is interesting as many, if not most courts, do not require that the plaintiff require such proof. Rather, if there is a potential dispute about whether the plaintiff owns the patents, the defendant will file a motion to dismiss that the plaintiff does not actually own the patents.

Here, however, Apple did not file a motion to dismiss based on lack of standing. Rather, the magistrate judge *sua sponte* ordered WARF to provide proof of ownership. This is somewhat unusual, but this seemed to be this magistrate judge's usual procedure for patent cases.⁹

In its Proof of Standing filing, WARF provided evidence that all four inventors—Andreas I. Moshovos, Scott E. Breach, Terani N. Vijaykumar, and Gurindar S. Sohi—assigned “their entire right, title, and interest to the ‘752 Patent to WARF (pages 1 and 2 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹⁰). WARF further provided evidence that these assignments were recorded in the U.S. Patent and Trademark Office’s (“PTO’s”) assignment record (page 2 of *Wis. Alumni Rsch. Found. v. Apple, Inc.*¹⁰). The PTO’s assignment record is the patent equivalent of property titles recorded in a county’s database.

The next article in this series will continue to examine what occurred after the filing of the answer in these two cases, including a motion for inequitable conduct, which would have rendered the ‘752 Patent to be unenforceable, and two motions to compel.

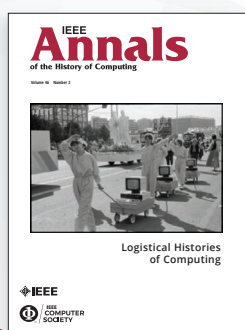
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4. U.S. Code § 285, Title 35, Attorney Fees.
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