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8 Attorneys for specially appearing defendant
9 Wi-LAN, Inc.

10 UNITED STATES DISTRICT COURT
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION

13 ACER AMERICA CORP., APPLE INC.,
14 DELL INC., and GATEWAY, INC.,

15 Plaintiffs,

16 v.

17 WI-LAN, INC.,

18 Defendant.

Case No. C 08-CV-5624 SI

**NOTICE OF PENDENCY OF RELATED
PROCEEDINGS AND RULING**

19 Defendant Wi-LAN, Inc. (“Wi-LAN”) hereby provides notice under Local Rule 3-13 of a
20 ruling in a related proceeding, *Wi-LAN, Inc. v. Acer, Inc. et al.*, Case No. 2:07-cv-473 (TJW)
21 (E.D. Tex.).¹ That case is a first-filed proceeding between the same parties in which Wi-LAN's
22 motion to add the patent in this California action, U.S. Patent 6,549,759 (“the ‘759 patent”) (for
23

24 ¹ There are four pending declaratory judgment actions that concern the ‘759 patent and one declaratory
25 judgment action, *Intel Corp., v. Wi-LAN, Inc. et al.*, Case No. 5:08-cv-4555 (JW), that concerns both the
26 ‘759 patent and seventeen (17) other patents. Declaratory judgment actions concerning only the ‘759
27 patent are as follows: *Acer America Corp. et al v. Wi-LAN, Inc.*, Case No. 3:08-cv-5624 (SI); *Broadcom
28 Corp., et al. v. Wi-LAN, Inc.*, Case No 08-cv-5543 (JW); *Marvell Semiconductor Inc et al v. Wi-LAN, Inc.*,
Case No. 5:08-cv-5544 (JW); and *Sony Computer Entertainment America Inc. et al v. Wi-LAN, Inc.*, Case
No. 3:08-cv-05742 (MHP).

1 Wi-MAX wireless technology), to the patent infringement allegations already in the complaint
2 (for Wi-Fi and Wi-MAX wireless technology) was granted on February 3, 2009. *See* Order
3 granting leave to file supplemental complaint to add '759 patent, attached hereto as Exhibit A at
4 p. 2 ("the technologies [Wi-Fi and Wi-MAX], while different, are related in such a way that
5 compels trying the patents together. Indeed, the accused products include both the Wi-Fi and
6 Wi-MAX technologies. The parties are the same, and discovery will substantially overlap.")

7
8 The Texas case is a patent infringement action that was originally filed on October 31,
9 2007. As filed, it concerned two wireless communications patents not at issue here directed to
10 Wi-Fi and Wi-MAX technologies. On December 5, 2008, Wi-LAN informed all Texas
11 defendants (including Plaintiffs in this action) of its intent to move for leave to supplement the
12 Texas complaint so as to add allegations concerning infringement of the '759 patent. In
13 response, Plaintiffs filed the instant action. *See* Letter from Broadcom counsel Michael W.
14 DeVries dated December 10, 2008, attached hereto as Exhibit B (noting that the declaratory
15 judgment actions were filed in response to Wi-LAN's efforts to meet and confer). On February
16 3, 2009, Wi-LAN's motion to add the '759 patent to the Texas litigation was granted.

17
18 In view of the Texas court's ruling, dismissal or transfer to the Eastern District of Texas
19 of this action is warranted.²

20
21 Accordingly, on February 5, 2009, defendant Wi-LAN requested that plaintiffs in this
22 *Acer et al.* action dismiss their action without prejudice to including the non-infringement,
23 invalidity, and other allegations in their declaratory judgment complaint as counterclaims to the

24
25 ² Transfer pursuant to 28 U.S.C. § 1407 (Multi District Litigation Procedures), however, is not
26 appropriate as such procedure entails remand of the actions to the district of filing for trial,
27 resulting in two trials of the same '759 patent against the same parties because plaintiffs are also
28 parties to the Texas action. This would require duplication of effort and may give rise to
inconsistent determinations.

1 assertions of infringement of the '759 patent that have been included in the Texas action.
2 Plaintiffs have not yet responded to such request.
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6 Dated: February 6, 2009

MCKOOL SMITH, P.C.

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8 By: /s/ Gayle Rosenstein Klein

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14 Attorneys for specially appearing defendant
Wi-LAN, Inc.

EXHIBIT A

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

WI-LAN INC.,
Plaintiff,

v.

ACER INC., ET. AL.,
Defendants.

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CIVIL ACTION NO. 2:07-CV-473 (TJW)

ORDER

Before the court is Wi-LAN’s Motion for Leave to File a Supplemental First Amended Complaint (Dkt. No. 191). For the reasons below, the court GRANTS the Motion.

On October 31, 2007, Wi-LAN filed the instant action asserting infringement of U.S. Patent Nos. 5,282,222 (“the ’222 patent”) and RE37,802 (“the ’802 patent”). Wi-LAN alleged (and continues to allege) that defendants infringe those patents by making, using, and selling laptop computers and/or other products capable of practicing one or more of the IEEE 802.11 wireless communication standards (also known as the “Wi-Fi standards”) (hereinafter the “accused Wi-Fi products”). On September 30, 2008, Defendant Intel filed an action in the Northern District of California for declaratory judgment of non-infringement and invalidity of eighteen other Wi-LAN patents, including U.S. Patent No. 6,549,759 (“the ’759 patent”) (“the California action”). The California action centered around Wi-LAN’s patents covering the newer “Wi-MAX standard.” On October 8, 2008, Intel announced its launch of its first Wi-MAX/Wi-Fi module. Shortly thereafter, Wi-LAN amended its original complaint, within the time frame allowed by the court’s Docket Control Order (Dkt. No. 172), to allege that defendants’ infringe Wi-LAN’s patents by making, using

or selling laptops and other wireless products that practice one or more of the Wi-Fi/Wi-MAX wireless communication standards. Wi-LAN contends it has included the basis for its Wi-MAX infringement allegations in its P.R. 3.1 and 3.2 infringement disclosures for the '222 and '802 patents. Wi-LAN did not, however, supplement its complaint at that time with any additional patents.

Wi-LAN now seeks to supplement its complaint to add an additional patent that covers its Wi-MAX technology; the '759 patent. Intel opposes this supplement, arguing that it is improper under the first-to-file rule because '759 patent is already part of the California action. Wi-LAN argues, however, that this is actually the first-filed action. The parties disagree as to how much the two technologies overlap. While the two technologies do share some overlap, that is not the only consideration for the court.

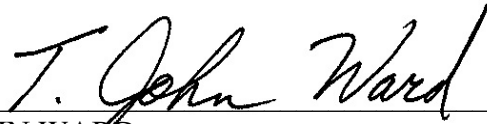
The first to file rule applies when the two pending actions are so duplicative that one court should decide the subject matter of both actions. *Tex. Instruments v. Micron Semiconductor*, 815 F.Supp. 994, 997 (E.D.Tex.1993). This is true when both actions involve closely related questions or common subject matter, or the core issues substantially overlap. *Id.* The issues need not be identical, however. *Id.* Here, the technologies, while different, are related in such a way that compels trying the patents together. Indeed, the accused products include both the Wi-fi and Wi-MAX technologies. The parties are the same, and discovery will substantially overlap.

The court also notes that Wi-LAN did in fact amend its original complaint to allege infringement of Wi-MAX standard very soon after IBM announced the launch of its combination Wi-Fi/Wi-MAX product. Intel made no objections to that supplement. The fact that Wi-LAN did not include the '759 patent in its supplemental complaint is not dispositive on the issue of whether

that technology should be included as part of the case or controversy giving rise to this action for purposes of applying the first to file rule. Indeed, Wi-LAN included bases for its Wi-MAX infringement in its infringement contentions disclosed on October 30, 2008.

The Motion is, therefore, GRANTED. Wi-LAN may supplement its complaint to add the '759 patent.

SIGNED this 3rd day of February, 2009.



T. JOHN WARD
UNITED STATES DISTRICT JUDGE

EXHIBIT B

LATHAM & WATKINS LLP

FIRM / AFFILIATE OFFICES

Abu Dhabi	Munich
Barcelona	New Jersey
Brussels	New York
Chicago	Northern Virginia
Doha	Orange County
Dubai	Paris
Frankfurt	Rome
Hamburg	San Diego
Hong Kong	San Francisco
London	Shanghai
Los Angeles	Silicon Valley
Madrid	Singapore
Milan	Tokyo
Moscow	Washington, D.C.

December 10, 2008

VIA EMAIL

Michael G. McManus, Esq.
McKool Smith, P.C.
1700 K Street, N.W.
Suite 740
Washington, D.C. 20006

File No. 035342-0046

Re: Wi-LAN v. Acer et al. (E.D. Tex. Case No. 2:07-CV-473)

Dear Mr. McManus:

I am writing on behalf of Broadcom Corporation ("Broadcom") in response to your email yesterday to Bob Steinberg and other counsel for defendants in the above-referenced action. Atheros Communications, Inc. ("Atheros") and Marvell Semiconductor, Inc. ("Marvell"), through their respective counsel, join in the content of this letter.

Your email indicated that Wi-LAN, Inc. ("Wi-LAN") intends to move to amend its complaint and infringement contentions in the above-referenced '473 action to assert a new patent, U.S. Patent No. 6,549,759 (the "'759 patent"), against all defendants in that action. However, as Wi-LAN is aware, the '759 patent is already at issue in another pending action filed well over two months ago in the United States District Court for the Northern District of California, captioned *Intel Corporation v. Wi-LAN, Inc., et al.*, Case No. 08-cv-4555-JW. This case was filed on September 30, 2008, and is currently pending before the Honorable James Ware. It involves eighteen patents which purport to be related. By contrast, the '759 patent is unrelated to any of the patents at issue in the '473 action. In view of these and other facts, Wi-LAN's proposal to insert into the '473 action a patent that has been at issue in another pending action for several months now evidences an improper disregard for the earlier-filed action currently pending before Judge Ware. Wi-LAN's proposed claims regarding the '759 patent should not be litigated in the '473 action, but should be resolved by Judge Ware, before whom the first-filed pending action on the '759 patent is pending. For these reasons, Broadcom, Atheros, and Marvell (the "Companies") have filed declaratory judgment actions concerning the '759 patent, which they believe will be related, under the Northern District's Civil Local Rules, to the action currently pending before Judge Ware also involving the '759 patent.

Additionally, the Companies request that Wi-LAN not carry through with filing a motion to amend its complaint and infringement contentions in the '473 action seeking to add the '759

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patent to that action. As discussed above, it does not make sense to inject the '759 patent into the '473 action in view of the first-filed case before Judge Ware. Additionally, Wi-LAN's proposal to inject the '759 patent into the '473 action creates substantial prejudice to the Companies, given that it has been well over a year since that action was filed and over a month since Wi-LAN's infringement contentions on three unrelated patents were served. Moreover, it is mere days before the defendants' invalidity contentions are due, a little more than a month before the defendants' document productions are due to begin, and months after a schedule was set by the Court. Accordingly, Wi-LAN's proposed amendments would substantially expand the scope of the '473 action, causing severe burden and undue prejudice to the defendants in that action. See, e.g., *Vonage Holdings Corp. v. SBC Internet Servs., Inc., et al.*, U.S. Dist. LEXIS 80405 (N.D. Tex., Oct. 30, 2007) (denying leave to amend to add new patents, citing undue delay and disruption of discovery efforts). For these and other reasons, if Wi-LAN nevertheless follows through with filing a motion to amend its complaint and infringement contentions to add the '759 patent to the '473 action, the Companies intend to oppose Wi-LAN's motion.

We note that you suggest a meet and confer to discuss Wi-LAN's proposed motion on Thursday, December 11 at 11:00 a.m. Pacific/1:00 p.m. Central/2:00 p.m. Eastern. If Wi-LAN wishes to proceed with a call, please let me know and we will plan to participate on the call you propose at that time. Additionally, if Wi-LAN still wishes to pursue its contemplated motion, we once again repeat the request that Wi-LAN please provide a copy of its proposed amended infringement contentions encompassing the '759 patent, preferably in advance of this call in order to facilitate a meaningful discussion.

Best regards,



Michael Woodrow De Vries
of LATHAM & WATKINS LLP

cc: Bob Steinberg, Esq.
Sean Pak, Esq.
Jonah Mitchell, Esq. (counsel for Atheros)
Roger Taylor, Esq. (counsel for Marvell)
Larry O'Rourke, Esq. (counsel for Marvell)