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12
 13 UNITED STATES DISTRICT COURT
 14 NORTHERN DISTRICT OF CALIFORNIA
 15 SAN JOSE DIVISION

16 BROADCOM CORPORATION ET AL.,

17 Plaintiffs,

18 v.

19 WI-LAN, INC.,

20 Defendant.

Case No. 5:08-cv-5543
 Case No. 5:08-cv-5544
 Case No. 5:08-cv-5624

**WI-LAN'S MOTION TO
 TRANSFER REMAINING
 DECLARATORY JUDGMENT
 CLAIMS**

Date: Sept. 28, 2009
 Time: 9:00 a.m.
 Courtroom: 8, 4th Floor
 Judge: Hon. James Ware

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25 AND RELATED ACTIONS
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STATUTES

28 U.S.C. § 1404.....1

NOTICE OF MOTION AND MOTION

1
2 PLEASE TAKE NOTICE that on September 28, 2009, at 9:00 a.m., or as soon thereafter
3 as the matter may be heard, before the Honorable James Ware, Judge of the United States
4 District Court, 280 South First Street, San Jose 95113 in Courtroom 8, 4th Floor, Defendant Wi-
5 LAN, Inc. (“Wi-LAN”) will and hereby does move this Court to transfer these actions to the
6 first-filed forum in the Eastern District of Texas pursuant to 28 U.S.C. § 1404.

7 The Motion will be based on this Notice of Motion and Motion, the Memorandum of
8 Points and Authorities in Support, the [Proposed] Order filed herewith, all of the files and
9 records of this action, and on any additional material that may be elicited at the hearing of this
10 Motion.
11

MEMORANDUM OF POINTS AND AUTHORITIES**I. INTRODUCTION**

12
13
14 The declaratory judgment actions that have not yet been dismissed, including those
15 brought by Broadcom, Atheros, Marvell, and Apple, should be transferred under the first-to-file
16 rule to the forum of the first filed action pertaining to the subject matter at issue — the Eastern
17 District of Texas (the “Texas court”). The present actions overlap, in their entirety, with *Wi-*
18 *LAN, Inc. v. Acer, Inc., et al.*, No. 2:07-CV-473 (E.D. Tex.) (hereafter, “the Texas Action”) filed
19 Oct. 31, 2007.
20

21 The Texas Action concerns the *same* patent at issue in the present declaratory actions:
22 United States Patent No. 6,549,759 (“the ‘759 patent”). McManus ¶ 4. The Texas Action also
23 concerns the *same* parties, the *same* products (wireless chipsets, laptop computers, and other
24 wireless-enabled products using the Bluetooth standard) and the *same* infringement contentions
25 against all declaratory judgment plaintiffs. See McManus Decl. Ex. A (Wi-LAN’s Disclosure Of
26 Asserted Claims and Infringement Contentions in the Texas Action) at pages 2-6 (setting forth
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28

1 Bluetooth infringement allegations for the '759 patent for all declaratory judgment plaintiffs,
2 including the remaining declaratory judgment plaintiffs in this California Action), pages 7-83
3 (providing Wi-LAN's detailed infringement allegations for the '759 patent in claim chart form,
4 detailing how each claim element of each asserted claim is present in products practicing the
5 Bluetooth standard (the "Accused Bluetooth Products")); and pages 559 (Apple), 569
6 (Broadcom), 571 (Atheros) and 573 (Marvell) listing the Accused Bluetooth Products in the first-
7 filed Texas Action); *see also* McManus Decl. Ex. B (Stipulation Regarding Wi-Lan's Motion to
8 Compel dated August 9, 2009). The Texas Action further concerns the *same* issues of claim
9 construction, non-infringement, invalidity, and unenforceability that all declaratory judgment
10 Plaintiffs have raised, including the remaining declaratory judgment plaintiffs. McManus Decl.
11 ¶ 4; *see, e.g.*, McManus Ex. C (Broadcom's Answer and Counterclaims). In addition, discovery
12 regarding the '759 patent and the Accused Bluetooth Products is well underway in the Texas
13 Action. McManus ¶ 6; McManus Exs. D, E, and F (Scheduling Orders).

14
15
16 In December of 2008, all of the parties to the Texas Action filed the present declaratory
17 actions based on Wi-LAN's motion to add infringement allegations to the Texas Action
18 regarding the '759 patent. That motion was granted by the Texas court on February 3, 2009,
19 finding the Texas Action *first-filed* as of Wi-LAN's October 2007 filing date of its original
20 complaint. *See* McManus Ex. G. Subsequently, in a June 4, 2009 Order, in response to Wi-
21 LAN's motion to transfer the '759 patent in the related Intel declaratory judgment action, this
22 Court also found the Texas Action to be first-filed and transferred Intel's '759 declaratory
23 judgment claims to the Texas court. *See* Dkt. No. 195. In deference to this Court's June 4
24 decision, and to avoid further unnecessary motion practice, the majority of the declaratory
25 judgment Plaintiffs (Acer, Dell, Gateway, Hewlett-Packard, Lenovo, Sony and Toshiba) have
26 voluntarily dismissed their '759 patent declaratory judgment actions and will proceed with such
27

1 claims in the Texas Action along with the previously-transferred Intel declaratory judgment
 2 action. (Case No. 5:08-cv-05624-JW, Dkt. No. 43; Case No. 5:08-cv-05742-JW, Dkt. Nos. 61,
 3 65, 67, and 69). Several Plaintiffs, however, (Apple, Atheros, Broadcom, and Marvell, (the
 4 “remaining declaratory judgment plaintiffs”)) have maintained their actions regarding the ‘759
 5 patent, forcing Wi-LAN to file this formal motion to transfer.

6 **II. THE FIRST-TO-FILE RULE REQUIRES TRANSFER TO TEXAS**

7 “There is a generally recognized doctrine of federal comity which permits a district court
 8 to decline jurisdiction over an action when a complaint involving the same parties and issues has
 9 already been filed in another district.” *Pacesetter Systems, Inc. v. Medtronic, Inc.*, 678 F.2d 93,
 10 94-5 (9th Cir. 1982). This doctrine, known as the first-to-file rule, “gives priority, for purposes
 11 of choosing among possible venues when parallel litigation has been instituted in separate courts,
 12 to the party who first establishes jurisdiction.” *StemCells, Inc. v. Neuralstem, Inc.*, No. C 08-
 13 2364, 2008 WL 2622831, at *2 (N.D. Cal. July 1, 2008) (citation omitted). The rule “serves the
 14 purpose of promoting efficiency well and should not be disregarded lightly.” *Church of*
 15 *Scientology of California v. United States Dep’t of Army*, 611 F.2d 738, 750 (9th Cir. 1979).
 16

17
 18 In applying the first-to-file rule, a court looks to three threshold factors: “(1) the
 19 chronology of the two actions; (2) the similarity of the parties, and (3) the similarity of the
 20 issues.” *Z-Line Designs, Inc. v. Bell’O Int’l LLC*, 218 F.R.D. 663, 665 (N.D. Cal. 2003).

21 **A. The California Court and the Texas Court Have Both Determined that the** 22 **Texas Action is First-Filed and Substantially Similar**

23 With regard to the first factor, chronology, there is no dispute that the Texas Action,
 24 which was filed October 31, 2007, was filed first in time. Likewise, with regard to the second
 25 factor, similarity of parties, there is no dispute that the declaratory judgment Plaintiffs¹ and Wi-
 26

27 ¹ Plaintiff Marvell Asia Pte. Ltd. is not a party to the Texas action, however, it is a subsidiary of Texas Defendant
 28 Marvell Semiconductor Inc.

1 LAN are both parties to the Texas litigation. Indeed, every party to the Texas action is (or was) a
2 declaratory plaintiff. The third factor, similarity of the issues, is equally present. In a recent case
3 from this district, the test of “similarity” was set forth as follows:

4 (1) are the two pending actions so duplicative or involve
5 substantially similar issues that one court should decide the issues;
6 and (2) which of the two courts should resolve the case? The issues
7 need not be identical to allow one court to decide the action, but
8 there must be “substantial overlap between the two suits.”

9 *Intersearch Worldwide, Ltd. v. Intersearch Group, Inc.*, 544 F.Supp.2d 949, 959-60 (N.D. Cal.
10 2008) (citations omitted). Thus, the test for similarity has been phrased as “substantially similar”
11 and “substantial overlap.”

12 The Texas Action and the instant actions both concern the same patent (the ‘759 patent),
13 the same parties, the same products (wireless products that practice the Bluetooth standards) and
14 overlapping identical questions of fact and law regarding claim construction, infringement,
15 validity, and enforceability of the ‘759 patent. In recognition of these facts, this California court
16 and the Texas court have already held that the Texas Action is first-filed. (Dkt. Number 195;
17 McManus Decl. Ex. G). Where actions concern the same parties, the same accused products, the
18 same patent, and this Court and the first-filed court have already held the first-to-file rule
19 applicable, unquestionably both lawsuits involve “substantially similar issues” and have
20 “substantial overlap” making transfer appropriate.

21 Indeed, the remaining declaratory judgment plaintiffs (i.e., the few who have not
22 voluntarily dismissed their declaratory judgment actions in view of this Court’s June 4 Order
23 transferring Intel’s declaratory judgment claims concerning the ‘759 patent to Texas), do so
24 notwithstanding their own representations to this Court that their declaratory judgment actions
25 and the transferred Intel action involve “identical questions of law and fact”:

1 This Administrative Motion [which is to relate this Broadcom/Atheros Action
 2 with the Intel Action and is unopposed by Wi-LAN] is made on the grounds that
 3 the Broadcom/Atheros Action and the Intel Action involve an identical defendant,
 4 Wi-LAN, Inc., and the Broadcom/Atheros Action requires determination of a
 5 question of fact and law that is the same as one of the questions of fact and law
 6 necessarily to be resolved in the earlier-filed Intel Action. In particular, the
 7 plaintiffs in *both actions seek declarations of invalidity, unenforceability, and*
 8 *non-infringement of the same United States Patent—namely, United States*
 9 *Patent Number 6,549,759* (“the ‘759 patent”). (*Compare* Declaration of Michael
 10 W. De Vries filed concurrently herewith (“De Vries Decl.”), Ex. B
 11 [Broadcom/Atheros Complaint] ¶¶ 11-25, *with* De Vries Decl., Ex. A [Intel
 12 Complaint] ¶¶ 38-52.) The identical defendant in both cases, Wi-LAN, Inc.,
 13 purports to be the owner of all rights, title, and interest in and to the ‘759 patent.
 14 (*Id.*) *Both cases therefore involve overlapping parties and concern and require*
determination of the same subject matter—the validity, enforceability, and non-
infringement of the ‘759 patent and the factual and legal issues related thereto.
 (*Id.*) Hence, both cases concern “substantially the same parties, property,
 transaction or event” within the meaning of Civil Local Rule 3-12(a)(1). *Given*
 the closely related nature of these cases, each involving an identical defendant
 and overlapping identical questions of law and fact, it “appears likely that there
 will be an unduly burdensome duplication of labor and expense or conflicting
 results if the cases are conducted before different Judges” under Civil Local
 Rule 3-12(a)(2).

15 See Broadcom Corporation and Atheros Communications, Inc.’s Administrative Motion to
 16 Consider Whether Cases Should Be Related [Civ. L.R. 3-12], Case 5:08-cv-04555-JW, Dkt. No.
 17 23 at 2-3 (emphasis added). The same or similar successful motion to relate, also unopposed by
 18 Wi-LAN, was brought by all other declaratory judgment plaintiffs, including the two other
 19 remaining declaratory judgment plaintiffs, Marvell and Apple. See Marvell Semiconductor, Inc.
 20 and Marvell Asia Pte. Ltd.’s Administrative Motion to Consider Whether Cases Should Be
 21 Related [Civ. L.R. 3-12], Case 5:08-cv-04555-JW, Dkt. No. 25 at 2-3 (same); see also Acer
 22 America Corp., Apple Inc., Dell Inc., and Gateway Inc.’s Administrative Motion To Consider
 23 Whether Cases Should be Related [Civ. L.R. 3-12], Case 5:08-cv-04555-JW, Dkt. No. 41 at 1-2.

24 Because the remaining declaratory judgment plaintiffs were successful in relating their
 25 ‘759 patent actions with the Intel patent action (now transferred to Texas), they are judicially
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1 estopped from taking a contrary position and, like all other declaratory judgment plaintiffs have
2 done, should voluntarily dismiss their '759 patent actions in view of this Court's June 4 Order.
3 *United Nat'l Ins. Co. v. Spectrum Worldwide, Inc.*, 555 F.3d 772, 778 (9th Cir.2009) (“[J]udicial
4 estoppel is an equitable doctrine [that] bars inconsistent positions taken in the same
5 litigation....”).

6 **B. The First-Filed Texas Court Has The Responsibility To Determine Which**
7 **Action Should Proceed**

8 Even if the first-filed status of the Texas Action had not already been determined by both
9 this Court and the Texas court, it is well-established that the first-to-file rule gives the first-filed
10 [Texas] court the responsibility to determine which case should proceed. *Pacesetter Systems,*
11 *Inc. v. Medtronic, Inc.*, 678 F.2d 93, 96 (9th Cir. 1982); *Texas Instruments Inc. v. Micron*
12 *Semiconductor, Inc.* 815 F.Supp. 994, 26 U.S.P.Q.2d 1863 (E.D.Tex. 1993) (“the Court cannot
13 grant the relief TI requests for the reason that the first-to-file rule gives the **first-filed court** the
14 **responsibility** to determine which case should proceed”) (citing *Pacesetter Systems*);
15 *StemCells*, 2008 WL 2622831, at *4 (“Moreover, as noted above, the court in the first-filed
16 action should decide whether there is an exception to the first-to-file rule”); *see also Girafa.com,*
17 *Inc. v. Alexa Internet, Inc.*, No. C-08-02745, 2008 WL 4500858, at * 8 (N.D. Cal. Oct. 6, 2008)
18 (“If California is the most convenient forum, it is for the Texas court to transfer its case here”);
19 *see also Cadle Co. v. Whataburger of Alice, Inc.*, 174 F.3d 599, 605 (5th Cir. 1999) (“Once the
20 likelihood of a substantial overlap between the two suits has been demonstrated, it is ... no longer
21 up to the second filed court to resolve the question of whether both should be allowed to
22 proceed.”) (internal brackets and quotation omitted); *Huntsman Corp. v. Int'l Risk Ins. Co.*, No.
23 1:08-CV-029, 2008 U.S. Dist. LEXIS 33242, at *14-15 (E.D. Tex. Apr. 22, 2008) (“The Fifth
24 Circuit adheres to the general rule that the court in which an action is first filed is the appropriate
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1 court to determine whether subsequently filed cases involving substantially similar issues should
2 proceed. Therefore, the first-to-file rule not only determines which court may decide the merits
3 of substantially similar issues, but also establishes which court may decide whether the second
4 suit filed must be dismissed, stayed or transferred and consolidated.”) (citations and internal
5 quotations omitted). Thus, because this Court and the Texas court have determined that the
6 Texas court is the first-filed action between the parties, the California court may either transfer,
7 dismiss, or stay this action as it is the Texas court that must decide which action proceeds. For
8 the California court to do otherwise, would invade the province of the Texas court and exceed
9 the proper bounds of a transferor court.
10

11 Accordingly, if the declaratory plaintiffs believe that the Eastern District of Texas is not
12 the best forum to hear this dispute regarding the ‘759 patent, they should have sought relief from
13 the Texas court. They have had over six months since the Texas court’s February 3, 2009 order
14 adding the ‘759 patent (both Bluetooth and WiMAX allegations) to the Texas action. The
15 plaintiffs should not be rewarded for their failure to seek relief in the venue of the first-filed
16 Texas action.
17

18 **C. Wi-LAN’s Most Recent Texas Complaint Is the Point of Comparison**
19 **in Determining “Substantial Similarity”**

20 While the remaining declaratory judgment plaintiffs may attempt to argue that their
21 actions are first-filed because Wi-LAN’s motion to add the ‘759 patent to the Texas action was
22 not granted until after their declaratory judgment complaints were filed, precedent from this
23 district provides that “[t]he Court need not examine defendant’s initial complaint... for
24 determining similarity a court should examine the most recent complaint, as long as any
25 amendments could have been included in an initial complaint.” *Intersearch Worldwide*, 544
26 F.Supp.2d at 959 n.7 (internal citation omitted). Similarly, in *SAES Getters S.p.A. v. Aeronex*,

1 *Inc.*, a court in the Southern District of California followed the clear rule established by the
 2 Second Circuit in *Mattel, Inc. v. Louis Marx & Co., Inc.*² in determining that priority is
 3 established by the first claim filed notwithstanding the subsequent claim for patent infringement:

4
 5 In *Mattel*, this was the sequence of events: 1) in the District of
 6 New Jersey, Marx sued Mattel for a declaratory judgment of non-
 7 infringement and invalidity of trademark; 2) in the Southern
 8 District of New York, Mattel sued Marx for trademark
 9 infringement and patent infringement; 3) in the District of New
 10 Jersey action, Marx amended its complaint as of right to add a
 11 count for declaratory relief of non-infringement of the patent. *Id.*
 12 at 422-423. The court held that the New Jersey suit was the prior
 13 action even as to the patent infringement claim ***because it “was the
 14 first to bring both parties into court, and the Marx complaint, as
 15 amended ..., included identical issues....”*** *Id.* at 424.

16 *SAES Getters S.p.A. v. Aeronex, Inc.*, 219 F.Supp.2d 1081, 1090 (S.D. Cal. August 15, 2002)
 17 (emphasis added) (citing *Mattel, Inc. v. Louis Marx & Co.*, 353 F.2d 421 (2d Cir.1965)). In other
 18 words, in determining *priority*, one looks to the complaint filed first in time; when determining
 19 *substantial similarity*, one looks to the most recent complaint.

20 Here, Wi-LAN has owned the ‘759 patent since 2004. *See* Related Case 5:08-cv-04555-
 21 JW, Dkt. No. 32-2 at 2-5. Further, each declaratory judgment Plaintiff’s first sale of an accused
 22 Bluetooth product predates the October 31, 2007 filing of the original Texas complaint and the
 23 October 30, 2008 filing of the First Amended Complaint. Indeed, the accused products include
 24 those practicing the Bluetooth standards released in November 2004. *See* Ex. H to McManus
 25 Decl.

26 Accordingly, in determining substantial similarity, this Court should look to the
 27 Supplemental First Amended Complaint (attached as Exhibit A to Ex. 1 (Wi-LAN’s Motion to
 28 Supplement) to Ferrari Dec., Case No. 5:08-cv-4555, Dkt. No. 34) which includes allegations
 concerning the ‘759 patent as to all wireless products, including Bluetooth products. *See also*

² 353 F.2d 421 (2d Cir. 1965).

1 McManus Decl. Ex. A (Wi-LAN's December 2008 Infringement Contentions), as discussed at
2 1, *supra*.

3 **D. The Declaratory Judgment Plaintiffs Filed this California Action in Response**
4 **to Wi-LAN's Motion to Add the '759 Patent To The Texas Action**

5 Wi-LAN informed the declaratory judgment plaintiffs on December 5, 2008 that it would
6 seek to add the '759 patent to the Texas Action, as required by the Texas local rules concerning
7 meeting and conferring prior to the filing of motions. On December 9, 2008, counsel to several
8 declaratory plaintiffs requested that Wi-LAN defer its filing so that they could consult with their
9 clients regarding the Wi-LAN motion. McManus Decl. at ¶ 13. On December 10, 2008,
10 Broadcom, Atheros and Marvell filed the instant declaratory actions. *Id.* at 15; McManus Decl.
11 Ex. I (correspondence from Broadcom, Atheros and Marvell indicating that the present actions
12 were premised on the belief that the Intel '759 action was first-filed: "Wi-LAN's proposed
13 claims regarding the '759 patent should not be litigated in the '473 action, but should be resolved
14 by Judge Ware, before whom the first-filed pending [Intel] action on the '759 patent is pending.
15 For these reasons, Broadcom, Atheros and Marvell (the "Companies") have filed declaratory
16 judgment actions concerning the '759 patent...."). On December 12, 2008 Wi-LAN filed a
17 motion for leave to file a supplemental first amended complaint. *Id.* at ¶16.
18

19 Knowing that Wi-LAN desired to add the '759 patent to the Texas Action, the remaining
20 declaratory judgment plaintiffs proceeded to bring the instant suits. Thus, Plaintiffs' suits are the
21 very definition of anticipatory suits: "one made under the apparent threat of a presumed
22 adversary filing the mirror image of that suit in a different federal district (or state court)." *Ontel*
23 *Prods. v. Project Strategies Corp.*, 899 F. Supp. 1144, 1150 (S.D.N.Y. 1995).
24

25 Precedent is clear that such anticipatory filings should not be accorded priority. "Because
26 the cases were filed within days of each other, the Court turns to the anticipatory filing cases for
27

1 guidance. Those cases teach that when, as here, a declaratory judgment action has been triggered
2 by a cease and desist letter, equity militates in favor of allowing the second-filed action brought
3 by the true plaintiff in the dispute to proceed to judgment rather than the first.” *K-Swiss Inc. v.*
4 *Puma AG Rudolf Dassler Sport*, 2009 WL 2049702, at *3 (C.D. Cal. July 9, 2009).

5 **III. CONCLUSION**

6 Both this Court and the Eastern District of Texas Court have held that the Texas Action is
7 first-filed with respect to the ‘759 patent. The remaining declaratory judgment plaintiffs have
8 further presented argument to this Court that their actions substantially overlap with the Intel
9 ‘759 patent action and should be joined together. Plaintiffs should not now be heard to argue
10 otherwise. Nor may the Plaintiffs plausibly argue that it is more convenient to proceed with two
11 simultaneous overlapping actions rather than a single action. Accordingly, Wi-LAN respectfully
12 requests that the Court transfer the actions brought by Broadcom, Atheros, Marvel, and Apple to
13 the Eastern District of Texas.
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1 Dated: August 24, 2009

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ATTORNEYS FOR DEFENDANT
WI-LAN INC.

CERTIFICATE OF SERVICE

1
2
3 I hereby certify that on August 24, 2009, a true and correct copy of the foregoing WI-
4 LAN'S MOTION TO TRANSFER REMAINING DECLARATORY JUDGMENT CLAIMS
5 was filed electronically with the Clerk of the Court using CM/ECF System. Notice of this filing
6 will be sent by operation of the Court's electronic filing system to all parties indicated on the
7 electronic filing receipt. Parties may access this filing through the Court's electronic filing
8 system.

9
10 By: /s/ Michael G. McManus

11 Michael G. McManus
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