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 10 UNITED STATES DISTRICT COURT
 11 FOR THE NORTHERN DISTRICT OF CALIFORNIA
 12 SAN JOSE DIVISION
 13

14 INTEL CORPORATION,

15 Plaintiffs,

16 v.

17 WI-LAN, INC., WI-LAN TECHNOLOGIES
 18 CORPORATION, WI-LAN
 TECHNOLOGIES, INC., and WI-LAN V-
 19 CHIP CORP.,

20 Defendants.

Case No. C 08-CV-04555 JW

DEFENDANT WI-LAN, INC.'S
 NON-OPPOSITION
 TO MOTION TO CONSIDER
 WHETHER CASES SHOULD BE
 RELATED AND OPPOSITION TO
 PROPOSED "COORDINATED
 SCHEDULE"

**[THIS DOCUMENT RELATES TO: ACER
 AMERICA CORPORATION, ET AL. V. WI-
 LAN, INC., N.D. CAL. CASE NO. 3:08-CV-
 05624-SI AND SONY COMPUTER
 ENTERTAINMENT AMERICA, INC. ET AL.
 V. WI-LAN, N.D. CAL. CASE NO. 3:08-CV-
 05742 MHP]**

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 28 DEFENDANT WI-LAN INC.'S NON-OPPOSITION TO MOTION TO CONSIDER WHETHER CASES
 SHOULD BE RELATED AND OPPOSITION TO PROPOSED "COORDINATED SCHEDULE"

1 Subsequent to the filing of the pending motion to relate filed by plaintiffs in the *Acer et*
2 *al.* and *Sony et al.* Actions (Docket Nos. 41 and 43), the landscape of the *Intel* Action (and the
3 already-related *Broadcom* and *Marvell* actions) before this Court has changed. Specifically, on
4 February 3, 2009, the Texas court overseeing a first-filed action between these same
5 parties granted Wi-LAN's motion to add United States Patent No. 6,549,759 to the Texas
6 suit. The '759 patent is the only patent in suit in the *Acer et al.* and *Sony et al.* actions (now
7 before Judges Ilston and Patel, respectively). The same is true of the other non-Intel declaratory
8 judgment actions. *See* Order granting leave to file supplemental complaint to add '759 patent,
9 attached hereto as Exhibit A at p. 2 ("the technologies, while different, are related in such a way
10 that compels trying the patents together. Indeed, the accused products include both the Wi-Fi
11 and Wi-MAX technologies. The parties are the same, and discovery will substantially overlap.")
12 In view of the Texas court's ruling, dismissal or transfer to the Eastern District of Texas of these
13 non-Intel actions is warranted. Accordingly, defendant Wi-LAN has requested that
14 plaintiffs in the non-Intel actions simply dismiss their actions without prejudice to including the
15 allegations in their declaratory judgment complaints as counterclaims to the assertions of
16 infringement of the '759 patent that have been included in the Texas action.

17 Wi-LAN otherwise does not oppose relating the *Acer et al.* and *Sony et al.* actions but
18 does oppose plaintiffs' "coordinated schedule" and related assertions in view of the Texas court's
19 ruling and the additional reasons set forth in Wi-LAN's Reply in Support of its Motion to Change
20 Time in the *Broadcom* action (Docket No. 17, attached as Exhibit B) filed January 30, 2009.
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28 DEFENDANT WI-LAN INC.'S NON-OPPOSITION TO MOTION TO CONSIDER WHETHER CASES
SHOULD BE RELATED AND OPPOSITION TO PROPOSED "COORDINATED SCHEDULE"

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Dated: February 5, 2009

MCKOOL SMITH, P.C.

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DEFENDANT WI-LAN INC.'S NON-OPPOSITION TO MOTION TO CONSIDER WHETHER CASES
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CERTIFICATE OF SERVICE

I hereby certify that on February 5, 2009, a true and correct copy of the foregoing DEFENDANT WI-LAN, INC.'S NON-OPPOSITION TO MOTION TO CONSIDER WHETHER CASES SHOULD BE RELATED AND OPPOSITION TO PROPOSED "COORDINATED SCHEDULE" was filed electronically with the Clerk of the Court using CM/ECF System. Notice of this filing will be sent by operation of the Court's electronic filing system to all parties indicated on the electronic filing receipt. Parties may access this filing through the Court's electronic filing system.

By: /s/ Michael G. McManus
Michael G. McManus

DEFENDANT WI-LAN INC.'S NON-OPPOSITION TO MOTION TO CONSIDER WHETHER CASES SHOULD BE RELATED AND OPPOSITION TO PROPOSED "COORDINATED SCHEDULE"

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.

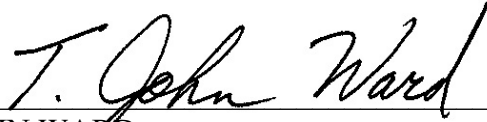
The first to file rule applies when the two pending actions are so duplicative that one court should decide the subject matter of both actions. *Tex. Instruments v. Micron Semiconductor*, 815 F.Supp. 994, 997 (E.D.Tex.1993). This is true when both actions involve closely related questions or common subject 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

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8 UNITED STATES DISTRICT COURT
9 FOR THE NORTHERN DISTRICT OF CALIFORNIA
10 SAN JOSE DIVISION

11
12 BROADCOM CORPORATION AND
ATHEROS COMMUNICATIONS, INC.,

13 Plaintiffs,

14 v.

15 Wi-LAN Inc.,

16 Defendant.
17

Case No. C 08-cv-5543 JW

**DEFENDANT WI-LAN's REPLY IN ITS
MOTION TO EXTEND TIME TO
RESPOND TO THE COMPLAINT**

18 In its Response, Plaintiff Broadcom opposes Wi-LAN's request to extend its time to
19 answer or otherwise plead in this Broadcom declaratory judgment action (or in any non-Intel
20 declaratory judgment actions). Instead, Broadcom presents a one-sided proposal to join together
21 jurisdictional motion practice in five separate declaratory judgment actions (filed at different times
22 and pending before different judges) under a wholly unreasonable time schedule. Indeed, Wi-
23 LAN's time to answer in many of the declaratory judgment actions is still a month or two away.¹

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25 ¹ The hearing date for Wi-LAN's motion to dismiss in the Intel action is currently set for March 16. The
26 time to answer in the *Marvell* declaratory judgment action is February 25 (not February 2 as Broadcom
27 states). In addition, the time to answer in the *Acer et al.* and *Sony et al.* declaratory judgment actions
28 (pending before Judges Ilston and Patel, respectively) is February 12 (twenty days from service), but the
parties have a standing agreement to extend that time without opposition by an additional 30 days to March
16. (This extension was agreed to by the parties in return for extensions granted to plaintiffs, who are
defendants in the first filed Texas action.)

1 In doing so, Plaintiff Broadcom wrongly suggests to the Court that jurisdictional motion practice
2 in all non-Intel declaratory judgment actions, including this action, will be necessary, when it is
3 likely such motion practice will not be (or will be greatly reduced). In addition, Broadcom
4 wrongly suggests that any such motion practice will involve exactly the same jurisdictional facts,
5 when it will not (because, while Wi-LAN's communications with some plaintiffs are similar to
6 those with Intel, they are also different as to others, including the non-California plaintiffs). Rather
7 than simply extend the time for Wi-LAN to answer or otherwise plead in the Broadcom
8 declaratory judgment until the Court's decision on Wi-LAN's motion to dismiss in the Intel action
9 (which is well underway), Broadcom presents Wi-LAN with two unreasonable options:

10 (i) that Wi-LAN agree for all declaratory judgment actions to be
11 bound by the Court's decision on Wi-LAN's motion to dismiss in the
12 Intel declaratory judgment action but that the non-Intel declaratory
13 judgment plaintiffs not be so bound. (Broadcom makes this proposal
14 with full knowledge that while the issues in each case substantially
15 overlap as to some plaintiffs, the issues are nonetheless
16 sufficiently unique as to other plaintiffs, and, as to the non-California
17 plaintiffs, there is likely no jurisdiction whatsoever over Wi-LAN -
18 because Wi-LAN's communications (out of which specific
19 jurisdiction would need to be established) are in no way connected to
20 California); or

21 (ii) engage in motion practice in all five declaratory judgment actions
22 at once at great cost, time, and expense to all parties and the Court,
23 and do so prematurely at a time when the period for Wi-LAN
24 to respond to the complaint filed in each action varies greatly and will
25 not expire until February and March, depending on the particular
26 action (*see* n. 1, *supra*).

27 There is no question that Wi-LAN's motion to dismiss will have a significant impact on
28 the nature and extent to which any additional jurisdictional motion practice and related discovery
will be needed, if at all, as to the plaintiffs in each additional declaratory judgment action.
Moreover, despite Broadcom's statements to the contrary in its Response, Wi-LAN is not
"intending to file on the same grounds in each action." (Response at 1.) However, until Wi-
LAN's motion in the Intel action plays itself out, Wi-LAN does not wish to relinquish its right to
move to dismiss claims brought by one or more of the plaintiffs in each of the other actions
without the context of the Court's views as to the overlapping jurisdictional facts in the Intel

1 action. Indeed, as discussed above, while Wi-LAN’s investigation of the allegations raised in each
2 of the non-Intel declaratory judgment actions remains ongoing, it is likely that as to many
3 plaintiffs there is no colorable claim of jurisdiction.

4 In view of the foregoing, Wi-LAN respectfully moves that its time to respond to the
5 Plaintiffs’ complaint be changed until ten days after the date that this Court rules upon Wi-LAN’s
6 pending motion to dismiss or transfer in *Intel Corp. v Wi-LAN, Inc.* et al, 5:08-cv-4555 (N.D.
7 Cal.).²

8 DATED: January 29, 2009

Respectfully submitted,

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TOWNSEND AND TOWNSEND AND CREW LLP

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By: _____ /s/
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Attorneys for Specially Appearing Defendant
WI-LAN INC.

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² Broadcom’s statement (*see* Response at 3) that Wi-LAN did not adequately meet and confer over this motion is inaccurate. *See* McManus Declaration ¶¶ 13-20 (submitted with the opening motion papers).

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