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

13 BROADCOM CORPORATION and
14 ATHEROS COMMUNICATIONS, INC.,

15 Plaintiffs,

16 v.

17 WI-LAN, INC.,

18 Defendant.

Case No. C 08-CV-5543 JW

NOTICE OF RULING

19
20 Defendant Wi-LAN Inc. ("Wi-LAN") respectfully submits the attached Order received
21 today granting Wi-LAN's motion for leave to add United States Patent No. 6,549,759 ("the '759
22 patent") to the first-filed action between the parties that is pending in the United States District
23 Court for the Eastern District of Texas, *Wi-LAN, Inc. v. Acer et al.*, Civil Action No. 2:07-CV-
24 473 (TJW). This ruling is relevant to Wi-LAN's motion under Local Rule 6-3 to change the time
25 for Wi-LAN to respond to Broadcom's declaratory judgment complaint regarding the same '759
26 patent.
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Dated: February 3, 2009

Respectfully Submitted,

MCKOOL SMITH, P.C.

By: _____ /S/

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Attorneys for specially appearing defendant
Wi-LAN, Inc.

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.

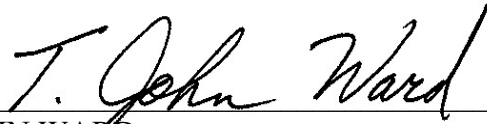
The first to file rule applies when the two pending actions are so duplicative that one court should decide the subject matter of both actions. *Tex. Instruments v. Micron Semiconductor*, 815 F.Supp. 994, 997 (E.D.Tex.1993). This is true when both actions involve closely related questions or common subject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