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WI-LAN INC.

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UNITED STATES DISTRICT COURT

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FOR THE NORTHERN DISTRICT OF CALIFORNIA

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SAN JOSE DIVISION

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12 BROADCOM CORPORATION AND  
ATHEROS COMMUNICATIONS, INC.,

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Plaintiffs,

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v.

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Wi-LAN Inc.,

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Defendant.

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Case No. C 08-cv-5543 JW

**MOTION PURSUANT TO CIVIL LOCAL  
RULE 6-3 TO CHANGE THE TIME FOR  
WI-LAN'S RESPONSE TO THE  
COMPLAINT UNTIL TEN DAYS AFTER  
THIS COURT'S RULING IN A RELATED  
CASE**

1 Specially appearing Defendant Wi-LAN, Inc., without consenting to the jurisdiction of this  
2 Court, respectfully moves, pursuant to Civil Local Rule 6-3, for an order changing the time to  
3 respond to the Complaint until ten (10) days after this Court's ruling in a related declaratory  
4 judgment action styled *Intel Corp. v Wi-LAN, Inc. et al*, 5:08-cv-4555 (N.D. Cal.).  
5

## 6 I. INTRODUCTION

7 The instant suit (and a number of other declaratory judgment actions recently filed in this  
8 district) is derivative of certain patent litigation in the Eastern District of Texas. In October of  
9 2007, Wi-LAN Inc. ("Wi-LAN") brought suit in Texas on two wireless communications patents  
10 against several laptop manufacturer defendants and several suppliers of wireless communication  
11 chips and modules, including Broadcom and Atheros. (Case styled *Wi-LAN Inc. v. Acer, et al.*  
12 *2:07-cv-00473-TJW* (E.D.Tex.)). The Texas litigation, as filed, concerns wireless communication  
13 devices employing the IEEE 802.11 wireless communication standard, alternatively known as the  
14 "Wi-Fi" standard. On September 30, 2008, Intel Corp., in anticipation of a new wireless product  
15 launch, filed a declaratory judgment action in this district on certain other patents owned by Wi-  
16 LAN (including the patent that is the subject of the Broadcom and Atheros declaratory judgment  
17 complaint here at issue, United States Patent No. 6,549,759 ("the '759 Patent")). Intel's new  
18 product, announced on October 8, 2008, added to its Wi-Fi product line (already at issue in the  
19 Texas) a Wi-Fi enabled product that also includes wireless communication capability under the  
20 IEEE 802.16 standard, also known as the "WiMAX" standard (in its October 8 press release, Intel  
21 refers to "its first ever combined WiMAX/Wi-Fi module"<sup>1</sup>). WiMAX is the next generation in  
22 Wi-Fi wireless communication, and extends the range of wireless communication using a laptop  
23 or other mobile device from a home or office to an entire city. (See Intel White Paper, *WiMAX and*  
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28 <sup>1</sup> Intel's October 8, 2008, Press Release attached as Exhibit 1 to the Declaration of Michael G. McManus ("McManus Dec.") in support of the application to change time.

1 *Wi-Fi Together: Synergies for Next-Generation Broadband*, July, 2008, attached as Exhibit 2 to  
2 McManus Dec.) The Wi-LAN patents already at issue in Texas (United States Patent Nos. Re.  
3 37,802 and 5,282,222) are applicable to both the Wi-Fi and WiMAX standards because, among  
4 other reasons, both standards depend on the same underlying wireless modulation technique that is  
5 the subject of these patents, called wideband Orthogonal Frequency Division Multiplexing (or  
6 “W-OFDM”). Accordingly, Wi-LAN was obliged to assert such patents against both the Wi-Fi  
7 capability and the new WiMAX capability in defendants’ laptop and wireless communication  
8 modules. (See First Amended Complaint, McManus Dec. Ex. 3.)

10 With both Wi-Fi and WiMAX capability already at issue in the first-filed Texas case, it  
11 makes little sense for the parties to proceed with WiMAX litigation (involving the same laptop  
12 and wireless communication modules and underlying technology at issue in Texas) in California  
13 as well. Consequently, Wi-LAN moved to supplement the Texas complaint to include the ‘759  
14 Patent (which is applicable to WiMAX and other wireless communications standards). Under  
15 local rules in Texas, Wi-LAN was obliged to meet and confer with the defendants prior to moving  
16 to supplement its complaint. After Wi-LAN informed the defendants of its intent to move to  
17 supplement the Texas complaint to add the ‘759 Patent, but before the meet and confer scheduled  
18 with all defendants, Broadcom filed the instant suit. (See Letter from Broadcom counsel Michael  
19 DeVries to Wi-LAN counsel Michael McManus dated December 10, 2008, attached to McManus  
20 Dec. as Exhibit 4). Following the filing of Wi-LAN’s motion to supplement, all defendants who  
21 remained in the Texas case subsequently filed declaratory judgment actions on the ‘759 Patent in  
22 this district (there have been a total of five declaratory judgment actions filed against Wi-LAN by  
23 the Texas defendants on the ‘759 Patent).<sup>2</sup>

26  
27 <sup>2</sup> In addition to the present case, the Texas defendants have filed the following declaratory judgment  
28 actions: *Acer America Corp. et al v. Wi-Lan, Inc*, Case No. 3:08-cv-5624; *Intel Corp. v. Wi-LAN, Inc., et al.*  
*Case No. 5:08-cv-04555-JW*; *Marvell Semiconductor Inc et al v. Wi-Lan, Inc*, Case No. 5:08-cv-5544; *Sony*  
*Computer Entertainment America Inc. et al v. WI-Lan, Inc.*, Case No. 3:08-cv-05742-JCS. Wi-LAN will  
MOTION PURSUANT TO CIVIL LOCAL RULE 6-3 TO CHANGE THE TIME FOR WI-  
LAN’S RESPONSE  
CASE NO. C 08-CV-5543 JW

1 On January 15, 2008, Wi-LAN filed a motion to dismiss Intel's declaratory judgment  
2 action on the basis of lack of personal jurisdiction and lack of subject matter jurisdiction and to  
3 transfer the case to Texas on the basis of the first-filed rule. On January 16, 2009, the Court  
4 related the Intel action and the instant action by Broadcom and Atheros. (Case No. 5:08-cv-04555,  
5 D.I. 10). Rather than file a substantially similar motion in the instant action (which would be due  
6 February 2 - twelve days from now), or in the other declaratory judgment actions (for which an  
7 answer is not yet imminent), Wi-LAN proposes to defer such actions until ten (10) days after this  
8 Court rules upon Wi-LAN's pending motion in the Intel case. This will permit both the Court and  
9 the parties to conserve resources yet will not alter the substantive relations of the parties. Further,  
10 a brief stay will permit the Court and the parties to make an informed determination as to whether  
11 and how this action should go forward, if at all, and permit the Court to avoid the possibility of  
12 inconsistent rulings with another district court.  
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15 Wi-LAN timely began efforts to meet and confer on this motion one day after filing its  
16 motion to dismiss Intel's declaratory judgment action. Despite such timely action, the instant  
17 motion is necessary so that the Court and Wi-LAN are not burdened with redundant motion  
18 practice by the numerous "me too" declaratory judgment actions of the several Texas defendants.  
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## 20 **II. LEGAL STANDARD**

21 A motion to change time pursuant to Local Rule 6-3 should be granted where the movant  
22 shows good cause. *See e.g., Whitney v. Wurtz*, 2006 WL 3201035 \*1 (N.D.Cal. 2006) ("Plaintiffs  
23 have shown good cause to continue the hearing.")  
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## 25 **III. ARGUMENT AND AUTHORITIES**

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28 seek similar relief in these other actions to further conserve judicial resources.

1 A case similar to the instant action was recently considered by Judge Whyte of this  
2 District. In *Girafa.com, Inc. v. Alexa Internet, Inc.*, the patentee (Alexa) filed a patent  
3 infringement action on March 21, 2008, in the Eastern District of Texas. 2008 WL 4500858  
4 (N.D.Cal. 2008). Subsequently, on June 2, 2008, the accused infringer, Girafa.com, brought an  
5 action for declaratory judgment of noninfringement and invalidity of the same patent in this  
6 district. There, the Court ordered a stay of the California action to permit the Texas Court to rule  
7 upon Girafa's pending motion to transfer the case to the Northern District of California as follows:

9 Because Girafa's motion to transfer the Texas Action to the Northern District of  
10 California is pending, this court stays the present action. *Alltrade*, 946 F.2d at 629 n.  
11 16 (“[A] stay may, for example, be appropriate to permit the court of first filing to  
12 rule on a motion to transfer.”) (citations omitted); see *Intuitive Surgical*, 2007 WL  
13 1150787, at \*3 (staying action pending first-filed court's ruling on anticipated motion  
14 to transfer). If the Texas court denies Girafa's motion to transfer, Alexa may renew  
15 its request to dismiss or transfer this action.

16 *Id.* at \*8.

17 Wi-LAN's motion to supplement its Texas complaint and its motion to transfer Intel's  
18 declaratory judgment action to Texas are each predicated substantially on the first-to-file rule.  
19 Thus, there are two pending motions that seek rulings as to whether the first-to-file rule is  
20 applicable and whether the '759 Patent should be considered with the other wireless patents at  
21 issue in Texas. There is no need to present this question a third time in a third case. The present  
22 case presents substantially the same considerations as those found in *Girafa.com, Inc. v. Alexa  
23 Internet, Inc.* and the same result should obtain.

24 Further, there is substantial overlap in the personal and subject matter jurisdiction  
25 questions that will be addressed by the Court in the pending motion (in the Intel declaratory  
26 judgment action) and in any motion that would be filed in the present case. Extension of the time  
27 for Wi-LAN to answer the declaratory judgment complaint (and the declaratory judgment actions  
28 of Broadcom's co-defendants) will provide the Courts and the parties an opportunity to determine

1 where the subject dispute will be heard in an orderly and logical manner and thereby conserve  
2 resources and avoid piecemeal litigation. *See Levi Strauss & Co. v. Esprit US Distribution Ltd.*, --  
3 - F.Supp.2d ----, 2008 WL 5062142 \*5 (N.D.Cal. 2008) (granting stay where it was “likely to  
4 preserve resources and avoid piecemeal litigation”).

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6 Further, the requested modification is of a short duration and, thus, would not alter the  
7 substantive relations of the parties.

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9 **IV. CONCLUSION**

10 In view of the foregoing, Wi-LAN respectfully moves the Court to change the time for Wi-  
11 LAN to respond to the declaratory judgment Complaint brought by Broadcom and Atheros until  
12 ten (10) days after this Court rules upon Wi-LAN’s pending motion to dismiss or transfer Intel’s  
13 declaratory judgment action.

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15 DATED: January 21, 2009

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

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18 By: \_\_\_\_\_ /s/  
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