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ORIGINAL FILED

DEC 1 11 2008

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Clerk, U.S. District Court
Northern District of California
San Jose

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15 MARVELL SEMICONDUCTOR, INC.
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17 **UNITED STATES DISTRICT COURT**
18 **NORTHERN DISTRICT OF CALIFORNIA**

19 Marvell Semiconductor, Inc.
and Marvell Asia Pte., Ltd.

Case No. _____

20 Plaintiffs,

COMPLAINT

21 v.

JURY TRIAL DEMANDED

22 WI-LAN, INC.,

23 Defendant.

1 **COMPLAINT**

2 Plaintiffs Marvell Semiconductor, Inc. and Marvell Asia Pte., Ltd. (“Marvell”), for their
3 complaint against defendant Wi-LAN, Inc. (“Wi-LAN”), allege:

4 **NATURE OF THE ACTION**

5 1. This is an action for declaratory judgment of non-infringement, invalidity, and
6 unenforceability of a United States Patent pursuant to the Declaratory Judgment Act, 28 U.S.C.
7 §§ 2201-02, and the Patent Laws of the United States, 35 U.S.C. § 100 *et seq.*, and for such other
8 relief as the Court deems just and proper.

9 **INTRADISTRICT ASSIGNMENT**

10 2. This action includes patent-based declaratory judgment claims arising in connection
11 with conduct occurring in or directed to Santa Clara County. Moreover, Marvell's headquarters
12 and other facilities are located in Santa Clara County, and Marvell employees with knowledge of
13 the products likely to be at issue in this action are located within Santa Clara County.
14 Accordingly, assignment to the San Jose Division is appropriate.

15 **PARTIES**

16 3. Marvell Semiconductor, Inc. is a corporation organized under the laws of the state of
17 California. Marvell's principal place of business is 5488 Marvell Lane, Santa Clara, California
18 95054.

19 4. Marvell Asia Pte., Ltd. is a corporation organized and existing under the laws of
20 Singapore and maintains its principal place of business in Singapore.

21 5. On information and belief, defendant Wi-LAN, Inc., is a corporation organized and
22 existing under the laws of Canada and having its principal place of business at 11 Holland Avenue,
23 Suite 608, Ottawa, Ontario, Canada.

1 indirectly, any valid and enforceable claim of the '759 patent, either literally or under the doctrine
2 of equivalents, nor is it aware of any infringement of the '759 patent.

3 13. A substantial controversy exists between the parties which is of sufficient immediacy
4 and reality to warrant declaratory relief.

5 14. This Court has personal jurisdiction over Wi-LAN. Wi-LAN has conducted business in
6 and directed to California pertaining to the '759 patent, and has engaged in various acts in and
7 directed to California.

8 THE PATENT

9 15. The '759 patent is titled "Asymmetric Adaptive Modulation in a Wireless
10 Communication System," and bears an issuance date of April 15, 2003. A copy of the '759 patent
11 is attached hereto as Exhibit 1.

12 COUNT I – DECLARATION OF NONINFRINGEMENT OF U.S. PATENT NO. 6,549,759

13 16. Marvell repeats and realleges the allegations in paragraphs 1-15 as though fully set
14 forth herein.

15 17. Marvell has not infringed and does not infringe, directly or indirectly, any valid and
16 enforceable claim of the '759 patent.

17 18. As a result of the acts described in the foregoing paragraphs, there exists a substantial
18 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

19 19. A judicial declaration is necessary and appropriate so that Marvell may ascertain its
20 rights regarding the '759 patent.

21 COUNT II – DECLARATION OF INVALIDITY OF U.S. PATENT NO. 6,549,759

22 20. Marvell repeats and realleges the allegations in paragraphs 1-19 as though fully set
23 forth herein.

1 21. The '759 patent is invalid for failure to meet the conditions of patentability and/or
2 otherwise comply with one or more of 35 U.S.C. §§ 100 *et seq.*, 101, 102, 103, 112 and 132.

3 22. As a result of the acts described in the foregoing paragraphs, there exists a substantial
4 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

5 23. A judicial declaration is necessary and appropriate so that Marvell may ascertain its
6 rights regarding the '759 patent.

7 **COUNT III – DECLARATION OF UNENFORCEABILITY OF U.S. PATENT NO. 6,549,759**

8 24. Marvell repeats and realleges the allegations in paragraphs 1-23 as though fully set forth
9 herein.

10 25. Individuals subject to the duty of candor under 37 CFR 1.56 ("Applicants") engaged in
11 inequitable conduct by withholding or misstating material information with intent to deceive the
12 USPTO in connection with prosecuting the '759 patent, rendering the '759 patent unenforceable.

13 26. During prosecution of the '759 patent, Applicants were aware of prior art that they
14 knew was material to patentability, including prior public disclosures material to patentability that
15 they deliberately failed to properly disclose to the USPTO with intent to deceive.

16 27. For example, on or around July 7, 2000, a document entitled "Media Access Control
17 Layer Proposal for the 802.16.1 Air Interface Specification" was submitted to the 802.16 MAC
18 Subgroup by Glen Sater, of Motorola, and Kenneth L. Stanwood, of Ensemble Corporation.
19 Kenneth L. Stanwood is a named inventor on the '759 patent.

20 28. Applicants' public disclosures, including those described above, were material to the
21 patentability of the application that issued as the '759 patent. During prosecution of the
22 application that issued as the '759 patent, with intent to deceive the USPTO, the applicants
23 intentionally failed to disclose these public disclosures to the USPTO. Under Wi-LAN's improper

1 and incorrect applications of the '759 patent's claims, these disclosures constitute prior art that
2 renders the claims of the '759 patent invalid under 35 U.S.C. §§ 102 and/or 103.

3 29. As a result of the acts described in the foregoing paragraphs, there exists a substantial
4 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

5 30. A judicial declaration is necessary and appropriate so that Marvell may ascertain its
6 rights regarding the '759 patent.

7 **PRAYER FOR RELIEF**

8 Wherefore, Plaintiffs request that judgment be entered in favor of Marvell and prays that
9 the Court grant the following relief to Marvell:

10 A. A declaration that Marvell has not infringed, either directly or indirectly, and valid
11 or enforceable claim of the '759 patent;

12 B. A declaration that the '759 patent is invalid;

13 C. A declaration that the '759 patent is unenforceable;

14 D. An order declaring that Marvell is a prevailing party and that this is an exceptional
15 case, awarding Marvell its costs, expenses, disbursements, and reasonable attorney fees under 35
16 U.S.C. § 285 and all other applicable statutes, rules and common law; and

17 E. Such other relief as this Court may deem just and proper.

18 **JURY DEMAND**

19 Plaintiffs demand a trial by jury as to all issues and claims so triable.

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1 Dated: December 10, 2008

Respectfully submitted,

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