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2 IN THE UNITED STATES DISTRICT COURT
3
4 FOR THE NORTHERN DISTRICT OF CALIFORNIA

5 MONOLITHIC POWER SYSTEMS, INC.,

6 Plaintiff,

7 v.

8 O2 MICRO INTERNATIONAL LIMITED,

9 Defendant.

No. C 08-04567 CW

ORDER GRANTING O2
MICRO'S MOTION TO
DISMISS CLAIMS AND
ADMINISTRATIVE
MOTION TO VACATE
TRIAL DATE AND ALL
RELATED DATES
(Docket Nos. 385 and
397)

10 _____/
11 O2 MICRO INTERNATIONAL LIMITED,

12 Counterclaimant,

13 v.

14 MONOLITHIC POWER SYSTEMS, INC.;
15 ASUSTEK COMPUTER INC.; ASUSTEK
16 COMPUTER INTERNATIONAL AMERICA; BENQ
CORPORATION; and BENQ AMERICA CORP.,

17 Counterclaim-Defendants.
18 _____/

19 Defendant and Counterclaimant O2 Micro International Limited
20 asks the Court to dismiss with prejudice all claims and
21 counterclaims between the parties concerning its United States
22 Patent No. 7,417,382 ('382 patent). In addition, O2 Micro moves to
23 vacate all trial-related dates. Plaintiff and Counterclaim-
24 Defendant Monolithic Power Systems, Inc., and Counterclaim-
25 Defendants ASUSTeK Computer Inc. and ASUS Computer International
26 (collectively, ASUS) do not oppose O2 Micro's motions. They
27 object, however, to any dismissal of their invalidity and
28 unenforceability claims with prejudice "to their ability to assert

1 such claims in the future where such an assertion is warranted
2 under the circumstances." MPS and ASUS's Response at 1.

3 O2 Micro seeks dismissal of the claims and counterclaims in
4 this action based on its covenant not to sue MPS or ASUS for patent
5 infringement concerning any and all claims of the '382 patent. The
6 covenant, included with O2 Micro's motion to dismiss, provides:

7 In the course of discovery, this is a complete list of
8 MPS's CCFL inverter controller and driver products of
9 which O2 Micro was informed and is aware: MP1007, MP1008,
10 MP1009, MP1010, MP1010A, MP1010B, MP1011, MP1011A,
11 MP1012, MP1013, MP1015, MP1016, MP1017, MP1018, MP1018C,
12 MP1021, MP1022, MP1022A, MP1023, MP1024, MP1025, MP1025A,
MP1026, MP1027, MP1028, MP1029, MP1030, MP1031, MP1032,
MP1033, MP1035, MP1037, MP1038, MP1039, MP1041, MP1046,
MP1048, MP1052, MP1060, MP1061, MP1070, MP1080, MP1088,
MP1251, MP1872, MP1900, MP10091, VN800, VN801, VN830, and
VN831;

13 By its signature to this motion as of the date of its
14 signature, O2 Micro covenants not to assert the '382
15 Patent against MPS or MPS's direct or indirect customers,
16 including ASUSTeK, for past or future infringement by (i)
17 any and all current and past MPS CCFL inverter
18 controllers or drivers, including the following: MP1007,
19 MP1008, MP1009, MP1010, MP1010A, MP1010B, MP1011,
20 MP1011A, MP1012, MP1013, MP1015, MP1016, MP1017, MP1018,
21 MP1018C, MP1021, MP1022, MP1022A, MP1023, MP1024, MP1025,
22 MP1025A, MP1026, MP1027, MP1028, MP1029, MP1030, MP1031,
23 MP1032, MP1033, MP1035, MP1037, MP1038, MP1039, MP1041,
MP1046, MP1048, MP1052, MP1060, MP1061, MP1070, MP1080,
MP1088, MP1251, MP1872, MP1900, MP10091, VN800, VN801,
VN830, and VN831; (ii) any MPS CCFL inverter controller
or driver products incorporating only insubstantial
changes to the design and relevant operation of the
products listed in (i); and (iii) any MPS CCFL inverter
modules and end-user devices including any ASUSTeK
devices incorporating such MPS CCFL inverter controller
or driver products described in (i) and (ii) above.

24 O2 Micro further covenants that any assignment or
25 exclusive license to the '382 patent will be subject to
26 this covenant.

27 O2 Micro's Mot. to Dismiss at 5-6. As O2 Micro correctly notes,
28 this covenant renders this action non-justiciable for lack of an
actual case or controversy, which divests the Court of subject

1 matter jurisdiction. See Benitec Australia, Ltd. v. Nucleonics,
2 Inc., 495 F.3d 1340, 1347-49 (Fed. Cir. 2007); Crossbow Tech., Inc.
3 v. YH Tech., 531 F. Supp. 2d 1117 (N.D. Cal. 2007).

4 Accordingly, the Court GRANTS O2 Micro's motion to dismiss
5 (Docket No. 385) and motion to vacate all trial-related dates
6 (Docket No. 397). All claims and counterclaims are dismissed with
7 prejudice for lack of subject matter jurisdiction. To be clear,
8 this dismissal does not preclude MPS and ASUS from, in the future,
9 claiming invalidity and unenforceability of the '382 patent if
10 circumstances differ materially from those here or otherwise
11 warrant such an assertion. Because this Order disposes of all
12 claims and counterclaims in this action, the Clerk shall enter
13 judgment. All trial-related dates are vacated.

14 MPS and ASUS state that they intend to move for attorneys'
15 fees and non-taxable costs. Unless the parties stipulate to the
16 contrary, any such motion must be filed within fourteen days of the
17 entry of judgment. Civil L.R. 54-5(a).

18 IT IS SO ORDERED.

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20 Dated: June 23, 2010



21 CLAUDIA WILKEN
22 United States District Judge
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