

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE NORTHERN DISTRICT OF CALIFORNIA

3 U.S. ETHERNET INNOVATIONS, LLC,
4

5 Plaintiff,

6 v.

7 ACER, INC., et al.,

8 Defendants,

9 ATHEROS COMMUNICATIONS, INC., et
al.,

10 Intervenors.

No. C 10-3724 CW

ORDER SUMMARIZING
RULINGS ON MOTION
TO LIMIT ASSERTED
CLAIMS AND MOTION
TO ENJOIN (Docket
Nos. 947, 951)

11 _____/
12 U.S. ETHERNET INNOVATIONS, LLC,

13 Plaintiff,

14 v.

15 AT&T MOBILITY, LLC, et al.,

16 Defendants,

No. C 10-5254 CW

ORDER SUMMARIZING
RULINGS ON MOTION
TO LIMIT ASSERTED
CLAIMS, MOTION TO
ENJOIN, AND MOTION
TO STRIKE (Docket
Nos. 481, 484)

17 _____/
18 In these patent infringement suits, on February 27, 2014, the
19 Court held a case management conference and ruled on several
20 motions brought by several Intervenors¹ and Defendants² in these
21 cases. The rulings are summarized below.

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23 ¹ Intel Corporation, Marvell Semiconductor Inc., Atheros
24 Communications Inc., and Sigma Designs, Inc.

25 ² Acer Inc., Acer America Corporation, Apple, Inc., ASUS
26 Computer International, Asustek Computer Inc., AT&T Services,
27 Inc., Dell Inc., Fujitsu Ltd., Fujitsu America, Inc., Gateway
28 Inc., Hewlett Packard Co., Sony Corporation, Sony Corporation of
America, Sony Electronics Inc., Toshiba Corporation, Toshiba
America, Inc., and Toshiba America Information Systems, Inc.

1 In both Case No. 10-3724 (the Acer case) and Case No. 10-5254
2 (the AT&T case), Defendants and Intervenor move to limit the
3 number of asserted claims asserted by Plaintiff U.S. Ethernet
4 Innovations, LLC (USEI). The Court finds that a two-tiered
5 limitation is appropriate. Accordingly, seven days after the
6 close of fact discovery, USEI shall make an Initial Election of
7 Asserted Claims limited to sixteen claims per chip supplier
8 implicated in USEI's infringement contentions in these cases,³
9 including those who are parties to the suit (Intervenor Intel,
10 Marvell, Atheros, and Sigma) and those who are not (Oracle, SiS,
11 and National Semiconductor). USEI's initial election shall not
12 exceed thirty claims total.

13 Ten days after USEI has made its Initial Election of Asserted
14 Claims, Defendants shall make a Prior Art References Election of
15 no more than twenty-five prior art references total.

16 Fourteen days after all dispositive orders have issued, USEI
17 will further narrow its case to no more than twelve claims per
18 chip supplier, whether present or not, for a total of no more than
19 twenty claims against all parties.

20 The limits set by the Court are not immutable. Claims may be
21 reintroduced upon a good cause showing by USEI that those claims
22 raise distinct issues of infringement and invalidity.

23 Next, Intervenor Intel and non-party Lenovo move to enjoin
24 USEI from pursuing duplicative claims in the Eastern District of
25 Texas against Lenovo (Lenovo case). The Lenovo case is currently
26 stayed at the parties' request, subject to either party reopening

27 _____
28 ³ See Acer case, Docket No. 1009, Ex. A.

1 the case.⁴ At the hearing, Lenovo asserted that its potential
2 liability to USEI in the Lenovo case would depend wholly on
3 Lenovo's use of Intel's chip, and thus agreed to be bound by the
4 infringement and invalidity findings in the Northern District of
5 California litigation. Therefore, the Court finds it appropriate
6 to enjoin USEI from seeking to reopen the Lenovo case without
7 first seeking this Court's approval. If the parties agree to
8 transfer the Lenovo case to this district, however, they may do
9 so.

10 Lastly, Sigma moves to strike as untimely USEI's infringement
11 contentions served on January 13, 2014. USEI's January 13, 2014
12 infringement contentions exceed the bounds of Sigma's counterclaim
13 for declaratory judgment of non-infringement and USEI has not
14 shown good cause for amending its infringement theories.
15 Accordingly, the Court grants Sigma's motion to strike.

16 IT IS SO ORDERED.

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18 Dated: 5/20/2014


CLAUDIA WILKEN
United States District Judge

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24 _____
25 ⁴ U.S. Ethernet Innovations, LLC v. Lenovo (United States)
26 Inc., Case No. 6:13-cv-00612-JDL (E.D. Tex. 2013), Docket Nos. 63,
27 64. The Texas court stayed the Lenovo case because the Northern
28 District of California litigation before the undersigned "involves
the same patents-in-suit and . . . is likely to moot . . . or, at
a minimum, streamline the issues presented" in the Lenovo case.
Id., Docket No. 64 at 1.