

1 Shelley K. Wessels (#152394)
 WESELS LAW GROUP
 2 861 Bette Ave.
 Cupertino, CA 95014
 3 Tel.: 408.255.7964
 wesselslaw@earthlink.net
 4

5 Stephen G. Rudisill (of counsel)
 Gary E. Hood (of counsel)
 Russell J. Genet (of counsel)
 6 Justin D. Swindells (of counsel)
 Brian N. Anderson (of counsel)
 7 JENKENS & GILCHRIST
 225 West Washington St., Suite 2600
 8 Chicago, Illinois 60606
 Tel. 312-425-3900
 9 Fax 312-425-3909

10 Counsel for Defendants Compression Labs, Inc.,
 11 Forgent Networks, Inc. and General Instrument Corp.

12 UNITED STATES DISTRICT COURT
 13 NORTHERN DISTRICT OF CALIFORNIA
 14 SAN JOSE DIVISION

15 SUN MICROSYSTEMS, INC.,

16 Plaintiff,

17 v.

18 COMPRESSION LABS, INC.,

19 Defendant.

Case No. C04-03124 PJH

**NOTICE OF RELATED CASE;
 RESPONSE TO SUN'S NOTICE OF
 RELATED CASE; NOTICE OF
 PENDENCY OF OTHER ACTIONS AND
 PROCEEDING; RESPONSE TO SUN'S
 NOTICE OF PENDENCY OF OTHER
 ACTION OR PROCEEDING**

(DUPLICATE ORIGINAL)

20
 21 GOOGLE, INC., a Delaware Corporation,

22 Plaintiff,

23 v.

24 COMPRESSION LABS, INC., a Delaware
 corporation; FORGENT NETWORKS, INC., a
 Delaware corporation; and GENERAL
 25 INSTRUMENTS [sic] CORPORATION, a
 Delaware corporation,
 26

27 Defendants.

Case No. C04-03934 CW

**NOTICE OF RELATED CASE;
 NOTICE OF PENDENCY OF OTHER
 ACTIONS AND PROCEEDING**

(DUPLICATE ORIGINAL)

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 NOTICE OF RELATED CASE; RESPONSE TO SUN'S NOTICE OF
 RELATED CASE; NOTICE OF PENDENCY OF OTHER ACTIONS
 AND PROCEEDING; RESPONSE TO SUN'S NOTICE OF
 PENDENCY OF OTHER ACTION OR PROCEEDING

Case No. C0403124 PJH

1 **NOTICE OF RELATED CASE**

2 Defendants in each of the above-captioned cases pending in this District give notice that
 3 these two cases (the “Sun case” and the “Google case”) are “related” as provided in Civil L.R. 3-12.
 4 The plaintiffs in both of these cases seek declarations that they do not infringe the same patent, U.S.
 5 Patent No. 4,698,672¹ (the “’672 patent”), owned by the same party, Compression Labs, Inc.
 6 (“CLI”). The patent claims must be construed in both cases, and to avoid inconsistencies, the claim
 7 construction should be performed by one Judge. Further, the basis for the plaintiffs’ declaratory
 8 judgment actions are essentially the same in both cases: the allegation that the ’672 patent is
 9 infringed by each plaintiff’s use of the JPEG image compression standard (as disclosed in actions
 10 already filed by CLI in other jurisdictions, see below). Consequently, assignment to a single Judge
 11 is certain to conserve judicial resources and promote an efficient determination of the actions.

12 **NOTICE OF PENDENCY OF OTHER ACTIONS AND PROCEEDING AND**
 13 **RESPONSE TO SUN’S NOTICE OF PENDENCY OF OTHER ACTION OR**
 14 **PROCEEDING**

15 Defendants in each of the above-captioned cases give notice of the following pending other
 16 actions:

17 *Compression Labs, Inc. v. Agfa Corp. et al.*, Case No. 2:04-CV-158 DF (E.D. Tex.) (filed
 18 Apr. 22, 2004).

19 *Compression Labs, Inc. v. Dell Inc. et al.*, Case No. 2:04-CV-159 DF (E.D. Tex.) (filed Apr.
 20 22, 2004).

21 *Compression Labs, Inc. v. Acer America Corp. et al.*, Case No. 2:04-CV-294 DF (E.D. Tex.)
 22 (filed Aug. 5, 2004).

23 *Agfa Corp et al. v. Compression Labs, Inc. et al.*, Case No. 04-818 SLR (D. Del.) (filed July
 24 2, 2004).

25 *Yahoo!, Inc. v. Compression Labs, Inc. et al.*, Case No. 04-918 SLF (D. Del.) (filed Aug. 2,
 26 2004).

27 *Audiovox Corporation et al. v. Compression Labs, Inc. et al.*, Case No. 04-1293 SLR (D.
 28 Del.) (filed Sept. 24, 2004).

¹ The two additional defendants in the Google case have moved to dismiss for lack of subject matter jurisdiction (neither defendant has any ownership interest in the patent) and lack of personal jurisdiction. [See Motion and accompanying papers filed Oct. 12, 2004.]

1 Among the first three cases, filed by the patent holder CLI in the Eastern District of Texas,
 2 the first two together include 30 other defendants than those identified in the titles above; the third
 3 case includes Google and Sun among the 9 other non-title defendants. Discovery has been ordered
 4 to continue and a trial date of October, 2005, has been set for each of the three Texas actions. The
 5 Delaware actions, like the two here in Northern California, essentially involve attempts by accused
 6 infringers to secure a venue different than the one chosen by CLI. All of the cases involve CLI's
 7 allegation that the defendants have infringed the same patent at issue in the Google and Sun
 8 declaratory judgment actions in this District, the '672 patent. Further, the basis for the infringement
 9 charge is the same against each defendant (their use of the JPEG baseline standard).

10 Additionally, there is a pending proceeding before the Judicial Panel on Multidistrict
 11 Litigation ("JPML"). Google, Sun, and a third accused infringer (Yahoo!, Inc.) already filed a
 12 motion on September 27, 2004 with the JPML to consolidate and coordinate all eight cases pursuant
 13 to 28 U.S.C. § 1407 and to transfer them all here, to the Northern District of California.²
 14 Defendants in the Google and Sun actions here will reserve statement on whether the cases should
 15 be handled as Multidistrict Litigation, information requested by Civil L.R. 3-13(b)(3)(B), for their
 16 response to the Motion already filed before the Judicial Panel.

17 **RESPONSE TO SUN'S NOTICE OF RELATED CASE**

18 Sun requests that the Court delay decision on reassignment until after the JPML decision.
 19 Such a delay is unwarranted and contravenes the JPML Rules. The Multidistrict Litigation transfer
 20 motion is not anywhere close to decision; only the opening papers, by only three parties, have been
 21 filed.³ It is also a multifaceted motion involving more than 40 parties and must be decided by a
 22 Judicial Panel. By contrast, only one judge (Judge Hamilton, who has the first-filed case) will make
 23 the decision on reassigning the Sun and Google cases in this District to the same judge. *See* Civil
 24 L.R. 3-12(e). The decision requires no submissions other than the Notices of Related Cases and

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 26 ² They make this request although the two California cases are two of the last to be filed and
 involve only two of the scores of accused infringers.

27 ³ The JPML filed Sun, Google, and Yahoo!'s motion on October 4, 2004 (In re Compression
 28 Labs, Inc. Patent Litigation, Docket No. MDL-1654) and ordered that responses be filed on or
 before October 25, 2004.

1 Responses already filed, plus any additional responses, which must be filed within 10 days. Civil
 2 L.R. 3-12(d). The cases indisputably concern the same issues of infringement of the same patent
 3 owned by the same party, CLI.⁴ Yet Sun, in its Notice of Related Case, etc., filed October 13,
 4 2004, unaccountably asks the Court to delay the simple reassignment decision until the Judicial
 5 Panel decides whether to send the cases into Multidistrict Litigation and, more dauntingly, where.

6 Sun gives no reason supporting delay. Nor can it. It is beyond controversy that the filing of
 7 a motion to transfer an action pursuant to 28 U.S.C. § 1407 does not suspend the proceedings in the
 8 transferor court. In fact, the JPML's Rules of Procedure expressly direct that a pending action
 9 before the JPML does not affect pretrial proceedings:

10 The pendency of a motion, order to show cause, conditional transfer order or
 11 conditional remand order before the Panel concerning transfer or remand of an action
 12 pursuant to 28 U.S.C. § 1407 does not affect or suspend orders and pretrial
 13 proceedings in the district court in which the action is pending and does not in any
 14 way limit the pretrial jurisdiction of that court. A transfer or remand pursuant to 28
 15 U.S.C. § 1407 shall be effective when the transfer or remand order is filed in the
 16 office of the clerk of the district court of the transferee district.

17 Rule 1.5 of the *Rules of Procedure of the Judicial Panel on Multidistrict Litigation*, 199 F.R.D. 425
 18 (2001); *see also Tortola Rests., L.P. v. Kimberly-Clark Corp.*, 987 F. Supp. 1186, 1188-89 (N.D.
 19 Cal. 1997).

20 Certainly the Eastern District of Texas has seen no problem with determining reassignment
 21 now instead of later: As one can see by the case numbers, the three cases in that district have been
 22 assigned to a single judge: DF (Judge Folsom). Indeed, the third Texas action in which both Google
 23 and Sun are defendants (2:04CV294 DF), was originally assigned to Judge Ward, but was later
 24 reassigned to Judge Folsom pursuant to certain defendants' motion. Furthermore, the circumstances
 25 here in the Northern California already urge reassignment to a single judge. The principle purposes
 26 for such reassignment, judicial economy and avoiding inconsistency, *see* Civil L.R. 3-12(b), (c)(3),
 27 already exist: Defendant CLI has moved to dismiss in both cases, on the same grounds. Sun has not

28 ⁴ There is no subject matter or personal jurisdiction as to the other two defendants in the Google
 action, as shown by Defendants' Motion to Dismiss or, in the Alternative, to Transfer (filed Oct. 12,
 2004).

1 asked the Court to stay decision on those motions. They should proceed to decision, as should
2 reassignment.

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4 Dated: October 20, 2004

WESSELS LAW GROUP

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By: _____
Shelley K. Wessels

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Counsel for Defendants Compression Labs, Inc.,
Forgent Networks, Inc. and General Instrument Corp.

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