

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**United States District Court**  
For the Northern District of California

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

U.S. Ethernet Innovations, LLC,  
Plaintiff,

NO. C 10-03724 JW  
NO. C 10-05254 JW  
NO. C 10-03481 JW

v.

**NOTICE OF INTENT TO APPOINT A  
TECHNICAL ADVISOR, KWAN CHAN**

Acer, Inc., et al,  
\_\_\_\_\_/

AT&T, Inc., et al.,  
\_\_\_\_\_/

Defendants.

Zions Bancorporation, et al.,  
\_\_\_\_\_/

Plaintiffs,

v.

U.S. Ethernet Innovations, LLC,  
\_\_\_\_\_/

Defendant.

In preparation for the upcoming Markman and upon review of the Patents-in-Suit as well as the parties' contentions regarding claim construction, the Court finds that due to the complexity of these related cases and the Patents-in-Suit, the Court would benefit from the services of a technical advisor on this case.

1 **II. STANDARDS**

2 A district judge has inherent authority to appoint a technical advisor when the judge deems it  
3 desirable and necessary. Ass'n of Mexican-Am. Educators v. California, 231 F.3d 572, 590 (9th Cir.  
4 2000) (*en banc*). The exercise of this authority should be used sparingly and only in highly  
5 complicated cases. TechSearch, L.L.C. v. Intel Corp., 286 F.3d 1360, 1378 (Fed. Cir. 2002)  
6 (interpreting the Ninth Circuit standard for appointing technical advisors). In those limited cases,  
7 where the complexity of the science and technology involves something well beyond regular  
8 questions of fact and law, the district court has the inherent authority to tap the outside skill and  
9 expertise of a technical advisor. Fed. Trade Comm'n v. Enforma Natural Prod., Inc., 362 F.3d 1204,  
10 1213 (9th Cir. 2004); see also Reilly v. United States, 863 F.2d 149, 157 (1st Cir. 1988). The  
11 technical advisor acts as educator, advising on terminology so that the district court can better  
12 understand complex evidence and properly discharge its role as decision maker. See TechSearch,  
13 286 F.3d at 1377.

14 In Reilly, while conceding that a district court has inherent authority to appoint an expert as a  
15 technical advisor, the appellant argued that such power is strictly circumscribed by Fed. R. Evid.  
16 706(a). 863 F.2d at 154. The First Circuit held the plain language of 706(a) indicates that the rule is  
17 confined to court-appointed expert witnesses and does not embrace expert advisors or consultants:

18 [706(a)] establishes a procedural framework for nomination and selection of an expert  
19 witness and for the proper performance of his role after an appointment is accepted. . . . By  
20 and large, these modalities—though critically important in the realm customarily occupied by  
21 an expert witness—have marginal, if any, relevance to the functioning of technical advisors.  
22 Since an advisor, by definition, is called upon to make no findings and to supply no  
23 evidence, . . . , provisions for depositions, cross-questioning, and the like are inapposite.

24 Id. at 155-56.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**III. PROPOSED ORDER OF APPOINTMENT**

Accordingly, the Court gives notice to the parties that the Court intends to appoint Mr. Kwan Chan<sup>1</sup> as a “Technical Advisor” under the following terms:

1. Any advice provided to the Court by Mr. Chan will not be based on any extra-record information.
2. To the extent that the Court may ask Mr. Chan to provide a formal written report on technical advice concerning the case, a copy of the formal written report prepared by Mr. Chan shall be provided to the parties. However, the Court reserves the right to have informal verbal communications with Mr. Chan which are not included in any formal written report.
3. Mr. Chan may attend all case-related court proceedings.
4. Mr. Chan may review any pleadings, motions or documents submitted to the Court.
5. As a Technical Advisor, Mr. Chan will make no written findings of fact and will not supply any evidence to the Court. Thus, Mr. Chan will be outside the purview of “expert witnesses” under Fed. R. Evid. 706. As such, the provisions in Rule 706 for depositions and questioning of expert witnesses will be inapplicable to Mr. Chan. See Reilly, 863 F.2d at 155-56.
6. Mr. Chan will have no contact with any of the parties or their counsel except for billing purposes.
7. Each party shall bear the cost of the Technical Advisor on a *per capita* basis, payable in advance. Within ten (10) days of appointment, the parties shall meet and confer with Mr. Chan and develop a plan to set up a trust account whereby the parties shall deposit, initially, \$10,000 each to cover the anticipated fees and costs. Mr. Chan shall issue statements to the parties and draw from the trust account every fifteen (15) days for his performance of the appointment. Mr. Chan will bill at the rate of \$450.00 per hour.

---

<sup>1</sup> Attached to this Proposed Order is a courtesy copy of Mr. Chan’s resume.

1 The Technical Advisor shall report to the Court on a periodic basis, every sixty (60) days,  
2 regarding the state of his fees and expenses and make a recommendation to the Court as to whether  
3 the trust account needs additional deposits from the parties as the case progresses.

4 All matters pertaining to the fees of Mr. Chan are referred to the assigned Magistrate Judge.

5 8. Mr. Chan shall file a declaration that he will adhere to the terms of his appointment.

6 On or before **October 14, 2011**, any party to the litigation wishing to object to Mr. Chan's  
7 appointment on any ground shall file a Notice of Objection to Appointment of Technical Advisor.  
8 Among the grounds for objection, the Court specifically would wish to know of any objection based  
9 on the following grounds:

10 (a) Bias on the part of Mr. Chan;

11 (b) Lack of funds to share the fees of the advisor on the part of the objecting party.

12 Any objection shall be lodged directly with the Magistrate Judge. The objection shall state  
13 the grounds of objection and be accompanied by a supporting declaration and legal memorandum  
14 supporting the objection. The Magistrate Judge shall not advise Judge Ware of the identity of any  
15 party making an objection. The Magistrate Judge may confer with the parties to determine if any  
16 modification of the terms of appointment would overcome the objection. Thereafter, the Magistrate  
17 Judge shall submit a recommendation to Judge Ware in accordance with paragraphs 1-7 or as  
18 modified, or of non-appointment due to objections. Judge Ware shall determine whether to make  
19 the appointment under any modified terms of appointment.

20

21

22 Dated: September 29, 2011

23

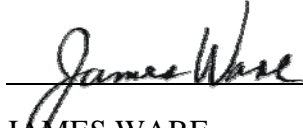
24

25

26

27

28

  
\_\_\_\_\_  
JAMES WARE  
United States District Chief Judge

1 **THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:**

2

- 3 Andy Tindel atindel@andytindel.com
- 4 Anthony H. Son ason@wileyrein.com
- 5 Ashlea Pflug araymond@winston.com
- 6 Barry Kenneth Shelton shelton@fr.com
- 7 Benjamin Charles Elacqua elacqua@fr.com
- 8 Brian Christopher Claassen Brian.Claassen@kmob.com
- 9 Bruce A Smith bsmith@jwfirm.com
- 10 Charlene Marie Morrow cmorrow@fenwick.com
- 11 Charles Ainsworth charley@pbatyler.com
- 12 Christopher Frederick Jeu cjeu@mofo.com
- 13 Christopher Needham Cravey ccravey@wmalaw.com
- 14 Christopher Ronald Noyes christopher.noyes@wilmerhale.com
- 15 Craig Steven Summers 2css@kmob.com
- 16 Danny Lloyd Williams dwilliams@wmalaw.com
- 17 Darryl Michael Woo dwoo@fenwick.com
- 18 David J Healey healey@fr.com
- 19 David J. Healey Healey@fr.com
- 20 David Lee Gann [dgann@rgrdlaw.com](mailto:dgann@rgrdlaw.com)
- 21 David T McDonald david.mcdonald@klgates.com
- 22 David T Pollock dpollock@reedsmith.com
- 23 Deron R Dacus ddacus@rameyflock.com
- 24 Dominic E. Massa dominic.massa@wilmerhale.com
- 25 Douglas R. Young dyoung@fbm.com
- 26 E Joseph Benz jbenz@csgrr.com
- 27 Eric Louis Toscano etoscano@reedsmith.com
- 28 Garland T. Stephens stephens@fr.com
- Harold H Davis harold.davis@klgates.com
- Hector J. Ribera hribera@fenwick.com
- Hiep Huu Nguyen hnguyen@winston.com
- Hsiang H. Lin jlin@ftbklaw.com
- Irfan A Lateef ial@kmob.com
- Irfan Ahmed Lateef ial@kmob.com
- Jack Wesley Hill fedserv@icklaw.com
- Jack Wesley Hill fedserv@icklaw.com
- James Patrick Brogan jbrogan@cooley.com
- Jason S Jackson jjackson@rgrdlaw.com
- Jeffrey Fuming Yee yeej@gtlaw.com
- Jeffrey K. Joyner joynerj@gtlaw.com
- Jennifer Parker Ainsworth jainsworth@wilsonlawfirm.com
- Jessica M. Kattula jkattula@rgrdlaw.com
- John Christopher Herman jherman@rgrdlaw.com
- John K. Grant johnkg@rgrdlaw.com
- John Philip Brinkmann brinkmann@fr.com
- John W Thornburgh thornburgh@fr.com
- Jonah D Mitchell jmitchell@reedsmith.com
- Jonah Dylan Mitchell jmitchell@reedsmith.com
- Jordan Jaffe jordanjaffe@quinnemanuel.com
- Karl J Kramer kkramer@mofo.com
- Kevin P.B. Johnson kevinjohnson@quinnemanuel.com
- Kimball R Anderson kanderson@winston.com

28

**United States District Court**

For the Northern District of California

- 1 Kyle D Chen [kyle.chen@cooley.com](mailto:kyle.chen@cooley.com)
- 2 Kyung Kim [dkim@wmalaw.com](mailto:dkim@wmalaw.com)
- 3 Lam Khanh Nguyen [lnguyen@cooley.com](mailto:lnguyen@cooley.com)
- 4 Laura Katherine Carter [lcarter@winston.com](mailto:lcarter@winston.com)
- 5 Lillian J Pan [lpn@orrick.com](mailto:lpn@orrick.com)
- 6 Lionel Marks Lavenue [Lionel.Lavenue@finnegan.com](mailto:Lionel.Lavenue@finnegan.com)
- 7 Mahmoud Munes Tomeh [2mmt@kmob.com](mailto:2mmt@kmob.com)
- 8 Mark Daniel Selwyn [mark.selwyn@wilmerhale.com](mailto:mark.selwyn@wilmerhale.com)
- 9 Marko R Zoretic [2mrz@kmob.com](mailto:2mrz@kmob.com)
- 10 Matthew Clay Harris [mch@emafirm.com](mailto:mch@emafirm.com)
- 11 Matthew J. Brigham [mbrigham@cooley.com](mailto:mbrigham@cooley.com)
- 12 Michael J Newton [mike.newton@alston.com](mailto:mike.newton@alston.com)
- 13 Michael J. Bettinger [mike.bettinger@klgates.com](mailto:mike.bettinger@klgates.com)
- 14 Michael L Brody [Mbrody@winston.com](mailto:Mbrody@winston.com)
- 15 Nicholas James Nugent [nicholas.nugent@finnegan.com](mailto:nicholas.nugent@finnegan.com)
- 16 Patricia Kane Schmidt [patricia.schmidt@klgates.com](mailto:patricia.schmidt@klgates.com)
- 17 Peter M Jones [pjones@rgrdlaw.com](mailto:pjones@rgrdlaw.com)
- 18 Ray R. Zado [rayzado@quinnemanuel.com](mailto:rayzado@quinnemanuel.com)
- 19 Richard T Ting [rting@reedsmith.com](mailto:rting@reedsmith.com)
- 20 Robert Christopher Bunt [rcbunt@pbatyler.com](mailto:rcbunt@pbatyler.com)
- 21 Robert M Parker [rmparker@pbatyler.com](mailto:rmparker@pbatyler.com)
- 22 Roderick Bland Williams [rick.williams@klgates.com](mailto:rick.williams@klgates.com)
- 23 Roger Brian Craft [bcraft@findlaycraft.com](mailto:bcraft@findlaycraft.com)
- 24 Ruben Singh Bains [rbains@wmalaw.com](mailto:rbains@wmalaw.com)
- 25 Ryan K. Walsh [rwalsh@rgrdlaw.com](mailto:rwalsh@rgrdlaw.com)
- 26 Scott D. Baker [sbaker@reedsmith.com](mailto:sbaker@reedsmith.com)
- 27 Scott Richard Mosko [scott.mosko@finnegan.com](mailto:scott.mosko@finnegan.com)
- 28 Sean Sang-Chul Pak [seanpak@quinnemanuel.com](mailto:seanpak@quinnemanuel.com)
- Seth M Sproul [sproul@fr.com](mailto:sproul@fr.com)
- Seth McCarthy Sproul [sproul@fr.com](mailto:sproul@fr.com)
- Steven S. Baik [sbaik@ftbkllaw.com](mailto:sbaik@ftbkllaw.com)
- Thomas J. Friel [tfriel@cooley.com](mailto:tfriel@cooley.com)
- Thomas John Ward [jw@jwfirm.com](mailto:jw@jwfirm.com)
- Thomas John Ward [jw@jwfirm.com](mailto:jw@jwfirm.com)
- Timothy Paar Walker [timothy.walker@klgates.com](mailto:timothy.walker@klgates.com)
- Todd Richard Gregorian [tgregorian@fenwick.com](mailto:tgregorian@fenwick.com)
- William F. Lee [william.lee@wilmerhale.com](mailto:william.lee@wilmerhale.com)

**Dated: September 29, 2011**

**Richard W. Wieking, Clerk**

By:           /s/ JW Chambers            
**Susan Imbriani**  
**Courtroom Deputy**