

EXHIBIT Z



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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

MICROSOFT CORPORATION,

Plaintiff,

v.

MOTOROLA, INC., et al.,

Defendants.

No. C10-1823 JLR

ORDER GRANTING IN PART AND
DENYING IN PART MOTOROLA'S
MOTIONS TO DISMISS, DENYING
MICROSOFT'S MOTION TO DISMISS
AND CONSOLIDATING CASE NO.
C10-1823JLR AND C11-343JLR

MOTOROLA MOBILITY, INC., et al.

Plaintiffs

v.

MICROSOFT CORPORATION,

Defendant.

I. INTRODUCTION

This matter comes before the Court on motions to dismiss pursuant to Fed. R. Civ. P. 12(b)(1) and 12(b)(6) filed by Motorola, Inc., Motorola Mobility, Inc., and General Instrument Corporation (collectively, "Motorola") (Case No. C10-1823JLR, dkt. #57; Case No. C11-343JLR, dkt. #73), and Microsoft's motion to dismiss (Case No. C11-343JLR, dkt. #74). Microsoft moves the Court to dismiss Case No. C11-343 and to force Motorola to file counterclaims in Case No. C10-1823 under Fed. R. Civ. P. 13(a) and the first to file rule.

1 Having considered the memoranda, declarations, exhibits, oral argument, and the record herein,
2 the Court GRANTS in part and DENIES in part Motorola's motions to dismiss (Case No. C10-
3 1823, dkt. #57; Case No. C11-343, dkt. #73), and DENIES Microsoft's motion to dismiss
4 (Case No. C11-343, dkt. #74).

5 **II. FACTUAL BACKGROUND**

6 In Case No. C10-1823JLR (the "contract case"), Microsoft filed suit on November 9,
7 2010 against Motorola alleging breach of contract, promissory estoppel, waiver, and
8 declaratory judgment. Microsoft alleges that Motorola entered into an actual or implied
9 contract with the Institute of Electrical and Electronics Engineers Standards Association
10 ("IEEE-SA" or "IEEE") and the International Telecommunications Union ("ITU") for the
11 benefit of their members and affiliates, including Microsoft. Microsoft alleges that Motorola
12 breached its obligations to provide licenses to purported "essential" patents on reasonable and
13 non-discriminatory ("RAND" or "FRAND") terms and conditions. Microsoft alleges that
14 Motorola became bound to contractual commitments imposed by the Standards Determining
15 Organizations ("SDOs") when (1) Motorola chose to take part in the standard setting process
16 for certain wireless internet technology, known as 802.11 or WLAN, and video coding
17 technology, known as H.264, and (2) Motorola declared that it owned patents that were
18 essential or necessary to implement those standards. Microsoft alleges that those contractual
19 commitments obligated Motorola to offer licenses to these patents on RAND terms to
20 Microsoft and all other potential licensees. Microsoft alleges that Motorola breached, and
21 continues to breach, its commitments by failing to offer RAND terms by conditioning licenses
22 to these technologies on a discriminatory and unreasonable royalty. Microsoft alleges that it
23 provided H.264 and WLAN technology capability in its Xbox, Windows 7 and Windows Phone
24 7 products. There are two portfolios of patents at issue in this case.

25 In Case No. C11-343 (the "patent infringement case"), which was filed on November
26 10, 2010 in the Western District of Wisconsin, Motorola Mobility, Inc. and General Instrument
Corporation filed suit against Microsoft for patent infringement for Patents Nos. 7,310,374,

1 7,310,375, and 7,310,376 (Patents 374, 375, and 376, respectively) with respect to Microsoft's
2 Windows and Internet Explorer products. Dkt. #29. Motorola's patent infringement case
3 arises under patent laws of the United States, 35 U.S.C. §§ 101 et seq. On January 25, 2011,
4 Microsoft filed an answer and counterclaim, in which it raises identical breach of contract
5 claims as the contract case. On February 18, 2011, the Western District of Wisconsin
6 transferred the case to this Court pursuant to 28 U.S.C. §1404. Case No. C11-343, dkt. #44.

7 Only three patents (374, 375, and 376) are at issue in both the contract case and the
8 patent infringement case.

9 **III. STANDARD OF REVIEW**

10 **A. Fed. R. Civ. P. 12(b)(6)**

11 Pursuant to Federal Rule of Civil Procedure 12(b)(6), the Court construes the complaint
12 in the light most favorable to the non-moving party. Livid Holdings Ltd. v. Salomon Smith
13 Barney, Inc., 416 F.3d 940, 946 (9th Cir. 2005). The Court must accept all well-pleaded
14 allegations of material fact as true and draw all reasonable inferences in favor of the plaintiff.
15 Wyler Summit P'ship v. Turner Broad. Sys., 135 F.3d 658, 661 (9th Cir. 1998). "To survive a
16 motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state
17 a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, __ U.S. __, 129 S. Ct. 1937,
18 1949 (2009). "A claim has facial plausibility when the plaintiff pleads factual content that
19 allows the court to draw the reasonable inference that the defendant is liable for the misconduct
20 alleged." Id. Dismissal can be based on the lack of a cognizable legal theory or the absence of
21 sufficient facts alleged under a cognizable legal theory. Balistreri v. Pacifica Police Dep't, 901
22 F.2d 696, 699 (9th Cir. 1990). Dismissal is inappropriate unless it appears beyond a doubt that
23 plaintiff can prove no set of facts in support of the claim entitling him to relief. Livid
24 Holdings, 416 F.3d at 946.

25 The Court generally may not consider material beyond the pleadings in ruling on a
26 motion to dismiss. Lee v. City of Los Angeles, 250 F.3d 668, 688 (9th Cir. 2001). However,
the Court may consider material properly submitted as part of the complaint, may consider
documents whose contents are alleged in the complaint and whose authenticity is not

1 questioned, and may take judicial notice of matters of public record without converting the
2 motion to dismiss to a motion for summary judgment.¹ Id.

3 **B. Fed. R. Civ. P. 12(b)(1)**

4 “If a claim is unripe, federal courts lack subject matter jurisdiction and the complaint
5 must be dismissed.” S. Pac. Transp. Co. v. City of Los Angeles, 922 F.2d 498, 502 (9th Cir.
6 1990). A motion to dismiss for lack of subject matter jurisdiction is brought pursuant to Fed.
7 R. Civ. P. 12(b)(1). “A claim is not ripe for adjudication if it rests upon contingent future
8 events that may not occur as anticipated, or indeed may not occur at all.” Texas v. United
9 States, 523 U.S. 296, 300 (1998) (internal citations omitted). A claim is ripe for adjudication
10 where “there is a substantial controversy, between parties having adverse legal interests, of
11 sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” Principal
12 Life Ins. Co. v. Robinson, 394 F.3d 665, 669 (9th Cir. 2005).

13 **IV. ANALYSIS**

14 **A. Motions to Dismiss pursuant to 12(b)(1) and 12(b)(6)**

15 **1. Breach of Contract Claim**

16 Microsoft alleges that Motorola “entered into express or implied contractual
17 commitments with the IEEE-SA, the ITU-T, and their respective members and affiliates
18 relating to the WLAN standard and H.264 technologies.” Case No. C10-1823, dkt. #53 (Am.
19 Compl.) ¶81; Case No. C11-343, dkt. #37 (Countercl.) ¶103. Microsoft also alleges that every
20 third party, including itself, “that would potentially implement WLAN and H.264 technologies
21 was an intended beneficiary of those contracts” and that Motorola was “contractually obligated
22 to offer a license to any essential patents consistent with the applicable licensing commitments
23 and the patent policy of the IEEE-SA Standards Board Bylaws and the ITU-T, respectively.”
24 Am. Compl. ¶¶82-83; Countercl. ¶¶104-105.

25 ¹Motorola has submitted numerous exhibits to contradict Microsoft’s factual allegations and for
26 varying other purposes. The Court has ignored these exhibits because they are improper and irrelevant
at this stage of the pleadings. Dkt. #41 (Supp. Beamer Decl.), Exs. 1-8; dkt. #58 (3d Beamer Decl.),
Exs. 7-8, 10-11; dkt. #63 (2d Supp. Beamer Decl.), Exs. 3-5.

1 Microsoft alleges that Motorola breached the agreement by failing to offer licenses to
2 Microsoft on RAND terms and by initiating patent actions seeking improperly to enjoin or
3 exclude Microsoft from using the technology of the SDO Patents in Suit. Am. Compl. ¶¶84-
4 85; Countercl. ¶¶106-107. Microsoft alleges that Motorola's demand of fixed royalty payment
5 based on the price of the end product is unreasonable and discriminatory because the
6 components of the Xbox related to the essential patents is a small fraction of the entire device.
7 Id. ¶¶64-72, 79; Countercl. ¶¶85-93, 101. Microsoft also alleges that it has suffered resulting
8 damage. Am. Compl. ¶86-87; Countercl. ¶¶108-109.

9 These factual allegations are sufficient to state a claim for breach of contract. N.W.
10 Indep. Forest Mfrs. v. Dep't of Labor & Indus., 78 Wn. App. 707, 712 (1995); see Research in
11 Mot. Ltd. v. Motorola, Inc., 644 F. Supp. 2d 788, 797 (N.D. Tex. 2008) (breach of contract
12 claim survived 12(b)(6) motion where plaintiff alleged that defendant had "refused to extend
13 FRAND . . . licensing terms to [plaintiff] for any of [defendant's] purportedly essential patents
14 . . . and has instead demanded of [plaintiff] terms that are unfair, unreasonable, and, on
15 information and belief, discriminatory.").

16 Motorola attempts to insert a requirement that Microsoft negotiate the license terms
17 prior to filing suit for breach of contract. During oral argument, Motorola argued that the IEEE
18 and the ITU guidelines provide the legal basis for requiring negotiations. However, the
19 guidelines provide no such requirement. There is no legal basis for Motorola's contention that
20 Microsoft was required to negotiate the precise license terms prior to filing a breach of contract
21 claim. Motorola also argues that the breach of contract claim should be dismissed because it
22 seeks only an advisory opinion of what the terms of a RAND license would be. Dkt. #57
23 (Mot.) at 13; dkt. #62 (Reply) at 9. Motorola is mistaken. Microsoft seeks, among other
24 things, a determination of whether the flat royalty rate on the price of the end product was
25 unreasonable and discriminatory where the allegedly essential patent was only a small fraction
26 of the device. Accordingly, these arguments are rejected.

1 a. Microsoft's breach of contract claim is ripe for adjudication

2 Motorola argues that Microsoft's claims in the amended complaint were "not ripe
3 because the contractual obligations to which Microsoft claims beneficiary status are designed
4 to benefit 'applicants' for licenses on RAND terms" and "because RAND License terms were
5 intended to be determined through bilateral negotiations between involved parties." Dkt. #57
6 (Mot.) at 10-11. Again, Motorola has failed to provide any legal authority that requires
7 negotiations as a precondition to a breach of contract claim based on RAND licensing
8 commitments.

9 All that is required for a claim to be ripe is "a substantial controversy, between parties
10 having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a
11 declaratory judgment." Principal Life Ins., 394 F.3d at 669. As previously stated, Microsoft
12 has properly pled a claim for breach of contract. Microsoft also alleges an immediate and
13 certain injury because Motorola's alleged breaches injured Microsoft's "business or property,
14 including damages associated with the cost of defending the improperly filed Motorola Patent
15 Actions." Case No. C10-1823, dkt. #53 (Am. Compl.) ¶86; Case No. C11-343 dkt. #37
16 (Countercl.) ¶108. Microsoft also alleges that it is "threatened by imminent loss of profits, loss
17 of customers and potential customers, and loss of goodwill and product image." Am. Compl.
18 ¶87; Countercl. ¶109.

18 Accordingly, Microsoft's breach of contract claim is ripe for adjudication.

19 2. Promissory Estoppel

20 Motorola argues that Microsoft's promissory estoppel claim should be dismissed
21 because Microsoft has alleged a valid contract, and promissory estoppel is not a doctrine
22 designed to give a party to a negotiated commercial bargain a second bite at the apple in the
23 event it fails to prove breach of contract. Dkt. #57 at 15. At this early stage of the case,
24 plaintiff may plead alternative causes of action, regardless of whether the claims are consistent.
25 See Fed. R. Civ. P. 8(d)(2) & (3).

1 Under Washington law, there are five elements of a promissory estoppel claim: (1) a
2 promise (2) that promisor should reasonably expect to cause the promisee to change his
3 position, and (3) actually causes promisee to change position (4) justifiably relying on the
4 promise (5) in such a manner that injustice can be avoided only by enforcing the promise.
5 McCormick v. Lake Wash. Sch. Dist., 99 Wn. App. 107, 117 (1999).

6 Microsoft alleges that Motorola “made a clear and definite promise to potential licensees
7 through their commitments to the IEEE and the ITU that they would license any essential
8 patents under reasonable terms, and on a non-discriminatory basis.” Case No. C10-1823, dkt.
9 #53 (Am. Compl.) ¶89; Case No. C11-343 dkt. #37 (Countercl.) ¶111. Microsoft alleges that
10 the intended purpose of Motorola’s promises was to induce reliance and that Motorola “knew
11 or should have reasonably expected that this promise would induce companies producing
12 products in wireless networking and H.264 technologies, like Microsoft to develop products
13 compliant with the relevant standards.” Am. Compl. ¶90; Countercl. ¶112. Microsoft alleges
14 that it “developed and marketed its products and services in reliance on [Motorola’s] promises,
15 as described above, including making their products and services compliant with WLAN
16 technical standards and including H.264 technologies in various Microsoft product offerings.”
17 Am. Compl. ¶91; Countercl. ¶113. Finally, Microsoft alleges that it has been harmed as a
18 result of its reasonable reliance on defendant’s promises and is threatened by imminent loss of
19 profits, customers, potential customers, goodwill, and product image. Am. Compl. ¶93;
20 Countercl. ¶115.

21 These facts are sufficient to state a claim for promissory estoppel.

22 3. Waiver

23 Motorola argues that Microsoft’s cause of action for waiver should be dismissed
24 because waiver is not a cause of action, but a defense. Dkt. #57 (Mot.) at 16. Microsoft
25 responds that Microsoft’s waiver allegation is a predicate for a claim for injunctive relief. Dkt.
26 #60 (Opp’n) at 20. During oral argument, Microsoft conceded that its waiver claim is part and
parcel to its breach of contract and promissory estoppel claims. Microsoft has not cited, and

1 the Court is unaware of, any legal authority allowing waiver as a cause of action, or as a
2 predicate to a claim for injunctive relief.

3 Accordingly, the Court dismisses Microsoft's waiver claim.

4 **4. Declaratory Judgment**

5 Motorola moves to dismiss this claim because it seeks the same relief as sought by
6 Microsoft's other claims. Dkt. #57 (Mot.) at 16-17. Microsoft seeks declaratory judgment
7 "that Defendants have not offered license terms to Microsoft conforming to applicable legal
8 requirements." Case No. C10-1823, dkt. #53 (Am. Compl.) ¶102; Case No. C11-343 dkt. #37
9 (Countercl.) ¶124.

10 To maintain a claim under the Declaratory Judgment Act, "a plaintiff must establish
11 standing by showing 'that there is a substantial controversy, between parties having adverse
12 interest, of sufficient immediacy and reality to warrant issuance of a declaratory judgment.'" Scott v. Pasadena Unified Sch. Dist., 306 F.3d 646, 658 (9th Cir. 2002); see also Aydin Corp.
13 v. Union of India, 940 F.2d 527, 529 (9th Cir. 1991). Requests for declaratory judgment orders
14 that merely impose the remedies provided for in other claims are duplicative and may be
15 dismissed on that basis. Swartz v. KPMG LLP, 476 F.3d 756, 766 (9th Cir. 2007). A
16 declaratory judgment is "not ripe for adjudication if it rests upon 'contingent future events that
17 may not occur as anticipated, or indeed may not occur at all.'" Hodgers-Durgin v. De La Vina,
18 199 F.3d 1037, 1044 (9th Cir. 1999).

19 Microsoft seeks the following judicial decrees: (1) "that Defendants are liable for breach
20 of contract"; (2) "that Defendants are liable for promissory estoppel"; (3) "that defendants have
21 not offered royalties to Microsoft under reasonable rates with reasonable terms and conditions
22 that are demonstrably free of any unfair discrimination"; (4) "that Microsoft is entitled to
23 license from Defendants any and all patents that fall within [Motorola's] commitments to the
24 IEEE in relation to WLAN technology on a non-discriminatory basis on reasonable terms and
25 conditions"; and (5) "that Microsoft is entitled to license from Defendants any and all patents
26 that fall within [Motorola's] commitments to the ITU-T in relation to H.264 technology on a

1 non-discriminatory basis on reasonable terms and conditions.” Am. Compl., Prayer for Relief
2 ¶¶A-B, F-G; see Countercl., Prayer for Relief ¶¶J-K, O-Q. During oral argument, Microsoft
3 conceded that the relief it was seeking is the consequence of the same ruling on its other
4 claims, which is an injunction that requires Motorola to make a RAND offer.

5 Accordingly, the Court finds that Microsoft’s declaratory judgment cause of action is
6 duplicative of its other claims. In its breach of contract claim, Microsoft alleges that Motorola
7 was “contractually obligated to offer a license to any essential patents consistent with the
8 applicable licensing commitments and the patent policy of the IEEE-SA Standards Board
9 Bylaws and the ITU-T” and that Motorola breached these contracts “by refusing to offer
10 licenses to any essential patents (including the STO Patents in Suit) under reasonable rates,
11 with reasonable terms, and on a non-discriminatory basis.” Am. Compl. ¶¶ 83-84. Microsoft
12 also alleges that Motorola is “not entitled to enjoin or exclude Microsoft from implementing
13 the technology of the STO Litigated Patents.” Id. ¶85. Microsoft seeks to “enjoin Defendants
14 from further demanding excessive royalties from Microsoft that are not consistent with
15 [Motorola’s] obligations.” Id., Prayer for Relief, ¶E.

16 Based on the duplication between Microsoft’s declaratory judgment claim and its other
17 claims, the Court dismisses Microsoft’s declaratory judgment claim.

18 **B. Microsoft’s Motion to Dismiss with Leave for Motorola to File
19 Counterclaims**

20 Microsoft seeks to dismiss Motorola’s patent infringement case and to require Motorola
21 to file its patent claims as compulsory counterclaims in Microsoft’s contract case. Dkt. #74.
22 Microsoft brings the motion pursuant to Fed. R. Civ. P. 13(a) and the first to file rule.

23 **1. Compulsory Counterclaims**

24 A counterclaim is compulsory if it “arises out of the transaction or occurrence that is the
25 subject matter of the opposing party’s claim” and “does not require adding another party over
26 whom the court cannot acquire jurisdiction.” Fed. R. Civ. P. 13(a)(1). The Ninth Circuit
applies the “logical relationship test” which “attempts to analyze whether the essential facts of
the various claims are so logically connected that considerations of judicial economy and
ORDER REGARDING MOTIONS TO DISMISS - 9

1 fairness dictate that the issues be resolved in one lawsuit.” Pochiro v. Prudential Ins. Co. of
2 Am., 827 F.2d 1246, 1249 (9th Cir. 1987).

3 Here, the subject matter of the two actions are distinct. In the contract case, Microsoft
4 contends that Motorola breached an agreement that was entered into for the benefit of certain
5 third parties, including Microsoft, by refusing to offer licenses to essential patents under
6 reasonable rates, with reasonable terms, and on a non-discriminatory basis, and by filing
7 several patent infringement actions which seek to enjoin Microsoft from implementing the
8 relevant technology in Xbox, Windows 7 and Windows 7 Phone products. Case No. C10-
9 1823, dkt. #53 (Am. Compl.) ¶¶61-69. The facts underlying the contract case relate to
10 Motorola’s dealings with SDOs and Motorola’s licensing and enforcement practices. The
11 claims in the contract case arise under state law. In contrast, in the patent infringement case,
12 Motorola alleges that Microsoft infringed patents 374, 375, and 376 (which are three of the
13 many patents at issue in the contract case) with respect to Microsoft’s Windows and Internet
14 Explorer products. Case No. C11-343, dkt. #29. Motorola’s patent infringement case arises
15 under patent laws of the United States, 35 U.S.C. §§ 101 et seq. Id. ¶7.

16 Additionally, in its original complaint in the contract case and its answer and
17 counterclaim in the patent infringement case, Microsoft concedes that “Motorola’s breach of its
18 commitments does not depend on . . . whether Microsoft has infringed any valid Motorola
19 patents.” Case No. C10-1823, dkt. #1 (Compl.) ¶8; Case No. C11-343, dkt. #37 (Answer &
20 Counter Claim) ¶29.

21 However, there will be some factual overlap between the two cases. As the Wisconsin
22 District Judge Crabb noted, the result of the contract case could limit the damages available to
23 Motorola in the patent infringement case if this Court determines that the royalty rate for
24 licensing the 374, 375 and 376 patents were too high. Case No. C11-343, dkt. #44.
25 Additionally, if the parties do not negotiate a RAND rate, this Court will need to issue a RAND
26 rate to determine damages in both cases.

1 The Court finds that the essential facts are not so intertwined and logically connected
2 that considerations of judicial economy and fairness dictate that the issues be resolved in one
3 lawsuit. Nevertheless, the Court finds that these cases are appropriate for consolidation
4 because the actions involve at least some common questions of law or fact, and the interests of
5 judicial economy will be served by consolidation. Fed. R. Civ. P. 42(a).

6 2. First to File Rule

7 “There is a generally recognized doctrine of federal comity which permits a district
8 court to decline jurisdiction over an action when a complaint involving the same parties and
9 issues has already been filed in another district.” Pacesetter Sys., Inc. v. Medtronic, Inc., 678
10 F.2d 93, 95 (9th Cir. 1982) (emphasis added). The Ninth Circuit has reasoned:

11 Normally sound judicial administration would indicate that when two
12 identical actions are filed in courts of concurrent jurisdiction, the court
13 which first acquired jurisdiction should try the lawsuit and no purpose
14 would be served by proceeding with a second action. However, this “first
15 to file” rule is not a rigid or inflexible rule to be mechanically applied, but
16 rather is to be applied with a view to the dictates of sound judicial
17 administration. . . . [T]he “first to file” rule normally serves the purpose
18 of promoting efficiency well and should not be disregarded lightly.
19 Circumstances and modern judicial reality, however, may demand that we
20 follow a different approach from time to time[.] The Supreme Court has
21 emphasized that the solution of these problems involves determinations
22 concerning wise judicial administration, giving regard to conservation of
23 judicial resources and comprehensive disposition of litigation, and that an
24 ample degree of discretion, appropriate for disciplined and experienced
25 judges, must be left to the lower courts.

26 Id. (internal citations and quotations omitted).

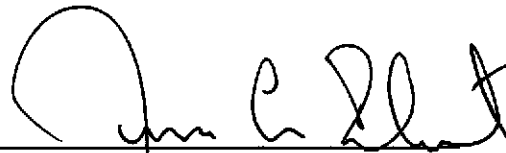
Here, the patent infringement case was transferred from the Western District of
Wisconsin to this Court. See Case No. C11-343, dkt. #44. Accordingly, both the contract case
and the patent infringement case is currently pending in the same district and before the same
judge. Under these circumstances, the first to file rule does not require dismissal of the patent
infringement case.

1 Rather, as previously stated, consolidation of the contract case and the patent
2 infringement case pursuant to Fed. R. Civ. P. 42(a), and coordination of the case schedules will
3 conserve judicial resources and avoid unnecessary cost or delay.

4 **V. CONCLUSION**

5 The Court GRANTS in part and DENIES in part Motorola's motions to dismiss. Case
6 No. C10-1823, dkt. #57; Case No. C11-343, dkt. #73. The Court also DENIES Microsoft's
7 motion to dismiss the patent infringement case. Case No. C11-343, dkt. #74. The Court
8 further ORDERS that the cases be consolidated into Case No. C10-1823 pursuant to Fed. R.
9 Civ. P. 42(a) for all purposes. The briefing schedule set forth in Case No. C10-1823 shall
10 apply to all issues. All documents hereafter filed in these cases shall be filed and docketed
11 under Case No. C10-1823. No further documents shall be filed in Case No. C11-343. The
12 Court invites the parties to file a proposed protocol for coordinating the handling of both cases.
13 The Clerk of the Court is requested to file a copy of this Order in both cases and to close Case
14 No. C11-343.

15 DATED this 31st day of May, 2011.



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17 James L. Robart
18 United States District Judge
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