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E-FILED on 10/10/2012

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

REALTEK SEMICONDUCTOR CORPORATION,

Plaintiff,

v.

LSI CORPORATION
and AGERE SYSTEMS LLC,

Defendants.

No. C-12-03451 RMW

ORDER GRANTING IN PART AND DENYING IN PART MOTION TO DISMISS

[Re Docket No. 23]

Defendants LSI Corporation ("LSI") and Agere Systems LLC ("Agere") move to dismiss all causes of action in plaintiff's complaint. Plaintiff opposes the motion. On October 5, 2012, the court held a hearing to consider defendants' motion. Having considered the papers submitted by the parties and the arguments of counsel, and for the reasons set forth below, the court grants in part and denies in part the motion.

I. BACKGROUND

This case arises out of defendants' alleged breach of an obligation to license certain patents on reasonable and non-discriminatory ("RAND") terms to companies practicing technical standards promulgated by the Institute of Electrical and Electronics Engineers ("IEEE").

1 In brief, standards facilitate the adoption and advancement of new technologies, enable
2 development of products that interoperate with one another, and reduce costs for both suppliers and
3 purchasers. Compl. ¶¶ 18-19. At the same time, technical standardization creates a "lock-in" effect
4 and the risk of "patent hold-up." *Id.* ¶ 21. To combat these risks, standard development
5 organizations have adopted rules, policies, and procedures requiring participants to disclose relevant
6 intellectual property rights and commit to offering licenses to so-called "essential" patents to any
7 implementer of the standard on RAND terms. *Id.* ¶¶ 22-24.

8 At issue in this case is the standard for wireless internet connectivity known as "WLAN,"
9 "Wi-Fi," or "802.11." *Id.* ¶ 25. WLAN is based on the 802.11 wireless networking standard
10 developed by the IEEE beginning in the early 1990s. *Id.* ¶ 28. Since the initial 802.11 protocol was
11 released in 1997, a number of amendments have been issued, including 802.11e and 802.11g. *Id.*

12 Defendant Agere owns rights in a number of patents and pending applications, including
13 U.S. Patent Nos. 6,452,958 ("the '958 patent") and 6,707,867 ("the '867 patent"), that defendants
14 assert are or may become "essential" to comply with one or more amendments to the 802.11
15 standard. *Id.* ¶ 33. Agere is a wholly-owned subsidiary of defendant LSI, who acquired Agere in
16 2007. *Id.* ¶ 13. Prior to the releases of the 802.11 protocols, Agere submitted Letters of Assurance
17 pursuant to IEEE bylaws stating it "is prepared to grant a license to an unrestricted number of
18 applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to
19 comply with the [Proposed] IEEE Standard." *Id.* ¶ 34. These letters identified the '958 and '867
20 patents as including "one or more claims that may be required to practice" the 802.11e and 802.11g
21 standards. *Id.* Plaintiff alleges that the IEEE has relied on these Letters of Assurance in releasing
22 the 802.11 standard and amendments to that standard, and that the IEEE otherwise would have
23 revised the standards to employ alternative technologies or stopped working on the protocols. *Id.* ¶
24 35.

25 Plaintiff Realtek Semiconductor Corporation ("Realtek") is a designer and supplier of
26 integrated circuits, including for WLAN technology. *Id.* ¶ 9. In March 2012, a representative of
27 LSI contacted Realtek and asserted that Realtek products, as incorporated into certain third-party
28 devices, infringe the '958 and '867 patents. *Id.* ¶ 42. Less than a week later, defendants filed a

1 complaint with the U.S. International Trade Commission ("ITC") against Realtek and other
2 respondents alleging, *inter alia*, that Realtek infringed the '958 and '867 patents. *Id.* Based on that
3 complaint, the ITC instituted Investigation No. 337-TA-837 on April 11, 2012. *Id.*

4 On May 24, 2012, Realtek responded to LSI's letter and requested that LSI and/or Agere
5 disclose the RAND license terms consistent with Agere's contractual obligations. *Id.* ¶ 43. On June
6 20, 2012, LSI provided license terms to Realtek for the identified "essential" patents.¹ *Id.* Realtek
7 alleges that the effect of the proposal, if accepted, is that Realtek would have to pay a royalty
8 exceeding the selling price of Realtek's products, which Realtek contends is "inherently
9 unreasonable." *Id.* Thus, Realtek alleges, defendants have breached their RAND obligations. *Id.*

10 Realtek further alleges, on information and belief, that defendants have made licensing
11 proposals to other component manufacturers that included a different royalty structure that did not
12 have the effect of requiring a royalty that exceeds the selling price of the component. *Id.* ¶ 44.
13 Thus, Realtek alleges, defendants have also breached their RAND obligations by failing to license
14 their patents on non-discriminatory terms. *Id.*

15 Realtek filed the present action against Agere and LSI on June 29, 2012, asserting claims for
16 (1) breach of contract, (2) promissory estoppel, (3) declaratory judgment that defendants must offer
17 Realtek a RAND license or that the alleged "essential" patents are unenforceable as to Realtek, and
18 (4) unfair competition under Cal. Bus. & Prof. Code § 17200.

19 II. ANALYSIS

20 Defendants move to dismiss all four claims in plaintiff's complaint. Defendants argue that
21 the claims for breach of contract and promissory estoppel are insufficiently pleaded and not ripe for
22 adjudication, the declaratory judgment claim is duplicative of other claims and also not ripe, and the
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25 ¹ Defendants have submitted a copy of the proposal to the court. Decl. of Ryan D. Philips, Exh. A
26 (submitted under seal). "[D]ocuments whose contents are alleged in a complaint and whose
27 authenticity no party questions, but which are not physically attached to the pleading, may be
28 considered in ruling on a Rule 12(b)(6) motion to dismiss." *Branch v. Tunnell*, 14 F.3d 449, 454
(9th Cir. 1994), *overruled on other grounds by Galbraith v. Cnty. of Santa Clara*, 307 F.3d 1119
(9th Cir. 2002). Plaintiff's complaint refers to the proposal and its contents, i.e., the terms of the
license offer, Compl. ¶ 43, and the proposal's authenticity has not been questioned. Thus, the court
will consider the proposal in ruling on defendants' motion.

1 unfair competition claim lacks allegations of competitive harm or redressable injury. The court
2 addresses each claim in turn.

3 **A. Breach of Contract**

4 Defendants argue that plaintiff has failed to allege a breach of contract because there is no
5 requirement that defendants' opening proposal be a complete offer of RAND terms. Defendants
6 further argue that parties are required to negotiate in good faith prior to filing suit on RAND
7 commitments, and that the court should not step in until negotiations have reached an impasse.
8 Defendants contend that their initial offer was made in good faith and was clearly an invitation to
9 further discussion and negotiation. Finally, defendants argue that plaintiff is simply asking for an
10 advisory opinion because plaintiff does not allege that it would be willing to accept a RAND license.

11 Plaintiff responds that defendants' arguments are simply attempts to dispute the factual
12 allegations, which is inappropriate at this stage. Plaintiff argues that it has alleged that defendants'
13 contract required them to make a RAND offer and defendants' bad faith breaches include filing the
14 ITC case before offering any licensing terms and offering inherently unreasonable, unfair, and
15 discriminatory terms. Finally, plaintiff argues that the case is ripe because a concrete and specific
16 dispute exists between the parties and there is no requirement that infringement first be proved or
17 conceded.

18 **1. Nature of the Alleged Breach**

19 The parties have identified several relevant cases concerning a patentee's obligations to
20 license standards-essential patents on RAND terms, including under the IEEE's rules and policies.
21 The court finds *Microsoft Corp. v. Motorola, Inc.*, --- F. Supp. 2d ----, 2012 WL 2030098 (W.D.
22 Wash. 2012), particularly instructive. That case, like this one, involved Letters of Assurance sent to
23 the IEEE in connection with the 802.11 standard. *Id.* at *2. On October 21, 2010, Motorola sent a
24 letter to Microsoft offering terms for licensing patents that might be essential to the 802.11 standard.
25 *Id.* at *3. Microsoft filed its complaint on November 9, 2010 alleging that the offered terms were
26 "blatantly unreasonable." *Id.* at *4, *10. It does not appear that Microsoft had attempted to
27 negotiate with Motorola between receiving the October 21 letter and filing suit.

1 The *Microsoft* court rejected Motorola's argument that Microsoft had repudiated its rights to
2 a RAND license by failing to apply for a license and negotiate its terms: "Although Motorola
3 correctly asserts that the IEEE and ITU Policies contemplate that RAND licenses will be negotiated
4 between the patent holder and the implementer of the standard, it does not follow that negotiating in
5 good faith is a condition precedent to Motorola's promise to grant licenses on RAND terms." *Id.* at
6 *7-9; *see also Apple, Inc. v. Motorola, Inc.*, --- F. Supp. 2d ----, 2012 WL 2376664 at *12 (N.D. Ill.
7 2012) (Posner, J.) ("Motorola agreed to license its standards-essential patents on FRAND terms as a
8 *quid pro quo* for their being declared essential to the standard. . . . It does not claim to have
9 conditioned agreement on prospective licensees' making counteroffers in license negotiations.").
10 Defendants here have not framed their argument in terms of repudiation, but the *Microsoft* court's
11 decision is relevant because it reflects the court's willingness to entertain the case despite the fact
12 that Microsoft had not engaged in much if any negotiation with Motorola. In addition, both
13 *Microsoft* and *Apple v. Motorola* suggest that RAND licensing obligations exist independent of
14 whether the parties attempt to negotiate a license. It follows that, at least to some extent, a breach
15 must be ascertainable without reference to private negotiations.

16 The *Microsoft* court found, on a motion for summary judgment, that Motorola was not
17 contractually obligated to make an initial offer on RAND terms. 2012 WL 2030098 at *12. Rather,
18 the court found, Motorola's Letters of Assurance and the IEEE's Intellectual Property Rights Policy
19 focused on the resulting license, not the opening offer, and "envision[] a negotiation between the
20 parties towards a resulting RAND license." *Id.* at *11-12. At the same time, the *Microsoft* court
21 found that "any offer by Motorola (be it an initial offer or an offer during a back-and-forth
22 negotiation) must comport with the implied duty of good faith and fair dealing inherent in every
23 contract." *Id.* at *12 (citing *Badgett v. Sec. State Bank*, 807 P.2d 356, 360 (Wash. 1991)). It was
24 possible, the court held, for an initial offer to be so blatantly unreasonable as to breach that duty of
25 good faith; in light of the record, however, the court could not make that determination without first
26 determining what a true RAND royalty rate would be and comparing Motorola's offers against it.
27 *Id.*

1 Here, although Realtek asserts the theory rejected by *Microsoft*—that defendants' initial offer
2 had to be on RAND terms—the court cannot conclude, under the liberal pleading standards of a
3 motion to dismiss, that Realtek's complaint fails to state a claim for breach of contract. Although
4 certain allegations of defendants' obligations are probably more in the nature of legal conclusions
5 that need not be accepted as true, *see Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009), there is
6 sufficient factual matter to render Realtek's claim plausible. Realtek's allegations, as a whole,
7 resemble those made by other plaintiffs claiming a breach of RAND obligations. In *Microsoft*, for
8 example, Microsoft argued that Motorola's proposed royalty rate resulted in "blatantly unreasonable"
9 cash payments of \$4 billion per year and applied to a "blatantly unreasonable" base, i.e., the sale
10 price of computers and game consoles rather than the value of the specific component or feature that
11 incorporates the patented invention. *Id.* at *10. In *Apple, Inc. v. Motorola Mobility, Inc.*, 2011 WL
12 7324582 (W.D. Wis. 2011), the court found sufficient allegations

13 that Motorola has made royalty demands on Apple that exceeded those made on
14 comparable parties for use of the declared-essential patents, discriminated against
15 Apple by terminating Qualcomm's contract with Motorola solely as to Apple,
16 demanded a rate that was based on the total revenue base of Apple's products rather
17 than the revenue from the components that utilize the technologies of the declared-
18 essential patents, sought to include cross-licenses to certain of Apple's non-essential
19 patents as a condition of a licensing agreement and sued Apple when Apple refused
20 to accede to Motorola's demands.

21 *Id.* at *11. At the least, Realtek's allegations plausibly support a claim that defendants breached
22 their duty of good faith and fair dealing.²

23 Defendants argue that a royalty exceeding the selling price of an infringing product is not
24 inherently unreasonable. But reasonableness turns on the entirety of the terms and circumstances,
25 and the court sees no reason the royalty rate as compared to selling price cannot be one relevant
26 factor. Defendants also argue that Realtek has failed to identify what terms in the proposal it is
27 complaining about and has not addressed whether the alternatives made in the initial proposal were
28 unreasonable as well. To the extent defendants are suggesting that the proposal was not specific
enough to constitute a concrete offer, that is at best a question of fact the court cannot resolve at this

² Although the *Microsoft* court was applying Wisconsin contract law, California law, to the extent it applies, also imposes an implied duty of good faith in every contract. *See Harm v. Frasher*, 181 Cal. App. 2d 405, 417 (1960). Because the parties have not addressed the choice of law issue, the court does not rule on what laws should ultimately govern the contract claims in this case.

1 disadvantage in private negotiations such that the determination of a true RAND rate almost
2 necessarily must be conducted by a court.

3 Defendants argue that, if Realtek can seek a court determination of RAND terms that it may
4 ultimately reject, defendants are similarly entitled to pursue their patent rights, including an
5 exclusion order from the ITC. However, courts have questioned whether injunctive relief is
6 appropriate where a patent is encumbered by RAND licensing obligations. *See Microsoft II*, 2012
7 WL 4477215 at *10 ("[H]owever the RAND rate is to be determined . . . , injunctive relief against
8 infringement is arguably a remedy inconsistent with the licensing commitment."); *Apple v.*
9 *Motorola*, 2012 WL 2376664 at *12 ("By committing to license its patents on FRAND terms,
10 Motorola . . . implicitly acknowledged that a royalty is adequate compensation for a license to use
11 that patent."). The parties do not dispute that defendants could pursue an injunction to enforce a
12 court determination that Realtek must pay specified damages, but neither this case nor the ITC
13 proceeding has approached that stage. The court is troubled by defendants' decision to choose, in
14 the first instance, a forum for enforcing their patent rights in which money damages are unavailable
15 and the only relief is injunctive in nature. Since defendants have done so, there appears even less
16 reason for this court to wait before determining the reasonable royalty rate, which is all defendants
17 are initially entitled to. Thus, the motion to dismiss Realtek's breach of contract claim is denied.

18 **B. Promissory Estoppel**

19 Both sides contend that Realtek's promissory estoppel claim rises or falls on the same
20 arguments as the breach of contract claim. Thus, for the reasons discussed above, the motion to
21 dismiss this claim is denied.

22 **C. Declaratory Judgment**

23 Defendants argue that Realtek's claim for declaratory judgment is duplicative of Realtek's
24 earlier claims because it seeks the same relief and adds no new dimension or theory of liability. In
25 light of its analysis above of Realtek's contract claim, the court finds the declaratory judgment claim
26 sufficiently distinct at this stage. For example, Realtek seeks a declaratory judgment setting forth
27 the terms and conditions for a license on RAND terms. Compl. ¶ 69. Although the *Microsoft* court
28 found it necessary to determine those terms to adjudicate Microsoft's contract claim, the court also

1 stated it "can envision a situation where an offer is so exorbitant and unjustified that it breaches the
2 patentee's duty to offer in good faith without needing to weigh it against a true RAND agreement."
3 2012 WL 2030098 at *12-13. The court cannot know at this stage how Realtek's claims will unfold.
4 In addition, as discussed above, the determination of a reasonable royalty is part of a live
5 controversy between the parties over defendants' claims of patent infringement, which is
6 independent of whether defendants breached the alleged contract. Thus, the motion to dismiss the
7 declaratory judgment claim is denied.

8 **D. Unfair Competition Under § 17200**

9 Defendants argue that Realtek has failed to allege competitive harm supportive of a § 17200
10 claim. *See Cel-Tech Commc'ns, Inc. v. Los Angeles Cellular Tel. Co.*, 20 Cal.4th 163, 197 (1999)
11 (holding an "unfair" act or practice under § 17200 "means conduct that threatens an incipient
12 violation of an antitrust law, or violates the policy or spirit of one of those laws because its effects
13 are comparable to or the same as a violation of the law, or otherwise significantly threatens or harms
14 competition"). Defendants rely on *ESS Technology, Inc. v. PC-Tel, Inc.*, 1999 WL 33520483 at *3
15 (N.D. Cal. 1999), in which this court found the plaintiff "failed to sufficiently allege injury to
16 competition beyond the impact on plaintiff." While the plaintiff had alleged that the defendant's
17 practices unfairly discriminated against latecomers to the market, foreclosed market entry, and
18 diminished consumer choice, the court found there was no injury to competition because "[t]here is
19 no allegation that consumers have been forced to pay higher prices or that the quality of the choices
20 available to them has been adversely affected." *Id.*

21 Realtek argues that it has alleged specific injury to the entire WLAN product market, not just
22 Realtek. However, even in making that argument, Realtek focuses on the alleged impact on Realtek
23 itself. *See* Dkt. No. 28 at 12:12-28. Similarly, at the hearing, counsel argued that Realtek had been
24 harmed by being sued in the ITC, with the attendant defense costs and threat of an exclusion order,
25 and in not receiving the benefit of the bargain of a RAND offer. As to impact on competitors and
26 consumers, Realtek only argues that, if defendants license at royalty rates that exceed the selling
27 price of the licensed product, they "will force competitors *such as Realtek* to increase prices in the
28 downstream market in order to sell the product." *Id.* (emphasis added). However, Realtek alleges

1 that it has been treated differently than similarly-situated prospective licensees. Compl. ¶ 44. Thus,
2 taken as a whole, Realtek's factual allegations do not plausibly suggest that other competitors or
3 consumers will be adversely affected. *But see Apple v. Motorola Mobility*, 2011 WL 7324582 at *3,
4 *14 (upholding antitrust claim on similar allegations). At most, Realtek's allegations support the
5 suggestion that competitors are harmed in their ability to invest in and bring to market innovative
6 products because, through the alleged conduct towards Realtek, other manufacturers lack
7 "confidence that holders of claimed essential patents will not seek to enjoin their products or
8 demand exorbitant, non-RAND licensing terms." Compl. ¶ 75. However, the impact such
9 diminished confidence would have on competition is too speculative to meet the plausibility
10 standard. Thus, because Realtek fails to allege harm to competition, the § 17200 claim is dismissed.

11 **III. ORDER**

12 For the foregoing reasons, the court grants in part and denies in part defendants' motion to
13 dismiss. Realtek's claim for unfair competition under § 17200 is dismissed. The remainder of the
14 motion to dismiss is denied.

15 The court further sets this case for a status conference on December 7, 2012 at 10:30 a.m. to
16 determine what discovery remains to be done and for further scheduling. The parties are to file a
17 joint case management statement by November 30, 2012 including a summary of the discovery
18 completed, what good faith efforts have been made to do the discovery that has not been completed,
19 and the status of the ITC investigation.

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DATED: October 10, 2012


RONALD M. WHYTE
United States District Judge