

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following Patents or Trademarks:

DOCKET NO. C-08-4493-BZ	DATE FILED September 25, 2008	U.S. DISTRICT COURT Office of the Clerk, 450 Golden Gate Ave., 16 th Floor, San Francisco, CA 94102
PLAINTIFF ASUSTEK COMPUTER INC., ET AL.		DEFENDANT HELPERICH PATENT LICENSING, L.L.C.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 6,087,956		
2 6,233,430		"Pls. See Attached Copy of Complaint"
3 7,146,157		
4 7,280,838		
5 7,376,432		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wiekig	(BY) DEPUTY CLERK Thelma Nudo	DATE September 25, 2008
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COUNT VII

Declaratory Judgment

(Invalidity of U.S. Patent No. 7,280,838)

50. The averments of paragraphs 1-19 are repeated and re-alleged as though set forth in full herein.

51. HELFERICH's actions, conduct and the totality of the circumstances outlined above accusing ASUSTEK of infringing the '838 Patent have created in ASUSTEK an objectively reasonable apprehension of HELFERICH filing suit against ASUSTEK alleging infringement of claims 34 and 35 of the '838 Patent. Exhibit A, ¶¶ 4-5.

52. Each of the asserted claims of the '838 Patent are invalid for failing to satisfy one or more of the conditions of patentability set forth in Title 35 of the United States Code.

53. For at least these reasons, a substantial, continuing and actual controversy now exists between ASUSTEK and HELFERICH as to the validity of the asserted claims of the '838 Patent within the meaning of 28 U.S.C. § 2201.

54. Therefore, a judicial declaration of invalidity of the asserted claims of the '838 Patent is necessary and appropriate in order to resolve this controversy.

COUNT VIII

Declaratory Judgment

(Non-Infringement of U.S. Patent No. 7,280,838)

55. The averments of paragraphs 1-19 are repeated and re-alleged as though set forth in full herein.

56. HELFERICH's actions, conduct and the totality of the circumstances outlined above accusing ASUSTEK of infringing certain claims of the '838 Patent have created in ASUSTEK an objectively reasonable apprehension of HELFERICH filing suit against ASUSTEK alleging infringement of claims 34 and 35 of the '838 Patent. Exhibit A, ¶¶ 4-5.

57. None of ASUSTEK's products infringe the asserted claims of the '838 Patent.

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1 ASUSTEK an objectively reasonable apprehension of HELFERICH filing suit against ASUSTEK
2 alleging infringement of claims 1 and 8 of the '432 Patent. Exhibit A, ¶¶ 4-5.

3 67. None of ASUSTEK's products infringe the asserted claims of the '432 Patent.

4 68. For at least these reasons, a substantial, continuing and actual controversy now
5 exists between ASUSTEK and HELFERICH as to the infringement of the asserted claims of the
6 '755 Patent within the meaning of 28 U.S.C. § 2201.

7 69. Therefore, a judicial declaration of non-infringement of the asserted claims of the
8 '432 Patent is necessary and appropriate in order to resolve this controversy.

9 **REQUEST FOR RELIEF**

10 WHEREFORE ASUSTEK PRAYS FOR THE FOLLOWING RELIEF:

11 A. A declaration that ASUSTEK's products have not and do not infringe any of the
12 asserted claims of any patent-in-suit;

13 B. A declaration that each asserted claim of the PATENTS-IN-SUIT is invalid;

14 C. A permanent injunction enjoining HELFERICH, its respective officers, agents,
15 servants, employees, attorneys and all persons and entities acting in concert with any of them
16 from making any claim to any person or entity that ASUSTEK's products infringe any claim of
17 the PATENTS-IN-SUIT;

18 D. A permanent injunction enjoining HELFERICH, its respective officers, agents,
19 servants, employees, attorneys and all persons and entities acting in concert with any of them
20 from interfering with or threatening to interfere with, the manufacture, sale, license or use of
21 ASUSTEK's products by ASUSTEK, its distributors, customers, licensees, successors or assigns
22 and others;

23 E. A permanent injunction enjoining HELFERICH, its respective officers, agents,
24 servants, employees, attorneys and all persons and entities acting in concert with any of them
25 from instituting or prosecuting any lawsuit or proceeding, or placing in issue the right of
26 ASUSTEK, its distributors, customers, licensees, successors or assigns and others to make, use,
27 sell, offer to sell or import ASUSTEK's products;

28 F. A declaration that the present action is an exceptional case under 35 U.S.C. § 285

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and award ASUSTEK its attorneys' fees, costs and expenses incurred in connection with this action; and

G. Award ASUSTEK any other relief the Court deems just and proper.

Dated: September 25, 2008

PAUL, HASTINGS, JANOFSKY & WALKER LLP

By: 
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ASUSTEK COMPUTER INC.
and ASUS COMPUTER INTERNATIONAL

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ADR

ORIGINAL FILED

SEP 25 2008

Richard W. Wieking
Clerk, U.S. District Court
Northern District of California
San Jose

7 Attorneys for Plaintiffs
ASUSTEK COMPUTER INC. and
8 ASUS COMPUTER INTERNATIONAL

E-filing

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

C08 04493

ASUSTEK COMPUTER INC. and ASUS
COMPUTER INTERNATIONAL,

Case No.

Plaintiffs,

COMPLAINT FOR DECLARATORY
JUDGMENT

v.

JURY TRIAL DEMANDED

HELPERICH PATENT LICENSING, L.L.C.,

Defendant.

1 Plaintiffs ASUSTeK Computer Inc. and ASUS Computer International (collectively,
2 "ASUSTEK"), by their undersigned attorneys, file this Complaint against Helperich Patent
3 Licensing, L.L.C. ("HELPERICH"):

4 **INTRODUCTION**

5 1. This action concerns the invalidity and non-infringement of the following five
6 United States Patents, which, on information and belief, are exclusively licensed to HELPERICH:
7 U.S. Patent No. 6,087,956; U.S. Patent No. 6,233,430; U.S. Patent No. 7,146,157; U.S. Patent
8 No. 7,280,838, and U.S. Patent No. 7,376,432 (collectively, the "PATENTS-IN-SUIT").

9 2. On September 11, 2008, HELPERICH filed a Complaint for Patent Infringement
10 in the United States District Court for the Northern District of Illinois titled *Helperich Patent*
11 *Licensing, L.L.C. v. Asustek Computer Inc., et al.*, Civil Action No. 08-CV-5189 (the "ILLINOIS
12 ACTION"). A true and correct copy of this Complaint is attached hereto as Exhibit A. In the
13 ILLINOIS ACTION, HELPERICH alleged that ASUSTeK, including through its subsidiary Asus
14 Computer International, manufactures or sells wireless electronic devices such as cellular
15 telephones" that infringe certain claims of the PATENTS-IN-SUIT. Exhibit A, ¶¶3-5. In the
16 ILLINOIS ACTION, HELPERICH accused specific ASUSTeK products of infringing the
17 PATENTS-IN-SUIT.

18 3. On September 22, 2008, the Court in the ILLINOIS ACTION *sua sponte*
19 dismissed the action due to "serious jurisdiction and venue issues...without prejudice to the
20 refiling of this complaint in defendant ASUS Computer International's home district..." A true
21 and correct copy of this minute order is attached hereto as Exhibit B.

22 4. In light of HELPERICH's prior litigation against ASUSTEK asserting
23 infringement of certain claims of the PATENTS-IN-SUIT, and now that the ILLINOIS ACTION
24 has been dismissed against ASUSTEK without prejudice, ASUSTEK has an objective, reasonable
25 apprehension that HELPERICH will attempt to file a new action for patent infringement against
26 ASUSTEK in another jurisdiction.

27 5. Accordingly, ASUSTEK respectfully requests a declaration from this Court that
28 ASUSTEK does not infringe any claim of the PATENTS-IN-SUIT by making, selling, importing,

1 or offering to sell its products outside the United States and to further declare the asserted claims
2 of the PATENTS-IN-SUIT invalid.

3 **THE PARTIES**

4 6. ASUSTeK Computer Inc. ("ASUSTeK") is a Taiwanese company with its
5 principal place of business in Taiwan, Republic of China.

6 7. ASUS Computer International ("ACI") is a California company, located in
7 Fremont, California. ACI is a wholly-owned sales subsidiary of ASUSTeK.

8 8. ASUSTEK is informed and believes that HELFERICH is an Illinois Limited
9 Liability Company with its principal place of business in East Brunswick, New Jersey.
10 ASUSTEK is informed and believes that HELFERICH is the exclusive licensee of the
11 PATENTS-IN-SUIT by assignment.

12 **JURISDICTION**

13 9. This Court has subject matter jurisdiction over all claims for declaratory judgment
14 of patent non-infringement and invalidity set forth herein under 28 U.S.C. §§ 1331 and 1338(a),
15 the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and under the laws of the United
16 States concerning patents, 35 U.S.C. §§ 1 *et seq.*

17 10. This Court has personal jurisdiction over HELFERICH under California Code of
18 Civil Procedure § 410.10, the California Long Arm Statute, because in both correspondence to
19 ASUSTeK and in its Complaint filed in the ILLINOIS ACTION, HELFERICH accuses
20 ASUSTeK and its California sales subsidiary, ACI, allegedly of infringing the PATENTS-IN-
21 SUIT by, *inter alia*, "offering to sell" certain wireless electronic devices, such as cellular
22 telephones. Exhibit A, ¶¶3-5. ACI is ASUSTeK's U.S. sales subsidiary, and was specifically
23 named as a defendant in the ILLINOIS ACTION, thereby causing effects in California to a
24 California corporation. In addition, upon information and belief, the sole inventor of the
25 PATENTS-IN-SUIT is a resident of California and has operated businesses in California.

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VENUE

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2 11. Venue is proper in the Northern District of California under 28 U.S.C. §§ 1391(b)
3 and (c).

FACTUAL BACKGROUND

The Patents-In-Suit

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6 12. The PATENTS-IN-SUIT describe technologies relating to wireless messaging.

7 13. U.S. Patent No. 6,087,956 (the '956 Patent) entitled "Paging Transceivers and
8 Methods for Selectively Erasing Information" issued on July 11, 2000 and lists Richard J.
9 Helferich as inventor. On information and belief, HELFERICH asserts that it is the exclusive
10 licensee of the '956 Patent. A true and correct copy of the '956 Patent is attached hereto as
11 Exhibit C.

12 14. U.S. Patent No. 6,233,430 (the '430 Patent) entitled "Paging Transceivers and
13 Methods for Selectively Retrieving Messages" issued on May 15, 2001 and lists Richard J.
14 Helferich as inventor. On information and belief, HELFERICH asserts that it is the exclusive
15 licensee of the '430 Patent. A true and correct copy of the '430 Patent is attached as Exhibit D.

16 15. U.S. Patent No. 7,146,157 (the '157 Patent) entitled "Systems and Methods for
17 Downloading Audio Information to a Mobile Device" issued on December 5, 2006 and lists
18 Richard J. Helferich as inventor. On information and belief, HELFERICH asserts that it is the
19 exclusive licensee of the '157 Patent. A true and correct copy of the '157 Patent is attached as
20 Exhibit E.

21 16. U.S. Patent No. 7,280,838 (the '838 Patent) entitled "Paging Transceivers and
22 Methods for Selectively Retrieving Messages" issued on October 9, 2007 and lists Richard J.
23 Helferich as inventor. On information and belief, HELFERICH asserts that it is the exclusive
24 licensee of the '838 Patent. A true and correct copy of the '838 Patent is attached as Exhibit F.

25 17. U.S. Patent No. 7,376,432 (the '432 Patent) entitled "Paging Transceivers and
26 Methods for Selectively Retrieving Messages" issued on May 20, 2008 and lists Richard J.
27 Helferich as inventor. On information and belief, HELFERICH asserts that it is the exclusive
28 licensee of the '432 Patent. A true and correct copy of the '432 Patent is attached as Exhibit G.

1 objectively reasonable apprehension of HELFERICH filing suit against ASUSTEK alleging
2 infringement of claims 2 and 3 of the '157 Patent. Exhibit A, ¶¶ 4-5.

3 42. Each of the asserted claims of the '157 Patent is invalid for failing to satisfy one or
4 more of the conditions of patentability set forth in Title 35 of the United States Code.

5 43. For at least these reasons, a substantial, continuing and actual controversy now
6 exists between ASUSTEK and HELFERICH as to the validity of the asserted claims of the '157
7 Patent within the meaning of 28 U.S.C. § 2201.

8 44. Therefore, a judicial declaration of invalidity of the asserted claims of the '157
9 Patent is necessary and appropriate in order to resolve this controversy.

10 **COUNT VI**

11 **Declaratory Judgment**

12 **(Non-Infringement of U.S. Patent No. 7,146,157)**

13 45. The averments of paragraphs 1-19 are repeated and re-alleged as though set forth
14 in full herein.

15 46. HELFERICH's actions, conduct and the totality of the circumstances outlined
16 above accusing ASUSTEK of infringing certain claims of the '157 Patent have created in
17 ASUSTEK an objectively reasonable apprehension of HELFERICH filing suit against ASUSTEK
18 alleging infringement of claims 2 and 3 of the '157 Patent. Exhibit A, ¶¶ 4-5.

19 47. None of ASUSTEK's products infringe the asserted claims of the '157 Patent.

20 48. For at least these reasons, a substantial, continuing and actual controversy now
21 exists between ASUSTEK and HELFERICH as to the infringement of the asserted claims of the
22 '157 Patent within the meaning of 28 U.S.C. § 2201.

23 49. Therefore, a judicial declaration of non-infringement of the asserted claims of the
24 '157 Patent is necessary and appropriate in order to resolve this controversy.

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