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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

PULSE ELECTRONICS, INC., a Delaware corporation,) Case No.: 3:20-cv-01676-BEN-DEB
) Related Case: 3:18-cv-00373-BEN-
Plaintiff,) MSB
)
v.) ORDER GRANTING DEFENDANT’S
) MOTION TO DISMISS
U.D. ELECTRONIC CORP., a Taiwan corporation,)
) [ECF Nos. 13, 16, 18]
Defendant.)

I. INTRODUCTION

Plaintiff PULSE ELECTRONICS, INC., a Delaware corporation (“Plaintiff” or “Pulse”) brings this action for patent infringement against Defendant U.D. Electronic Corp., a Taiwan corporation (“Defendant” or “UDE”). Complaint, ECF No. 1 (“Compl.”).

Before the Court is Defendant’s Motion to Dismiss Pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure (the “Motion”). ECF No. 13. The Motion was submitted on the papers without oral argument pursuant to Civil Local Rule 7.1(d)(1) and Rule 78(b) of the Federal Rules of Civil Procedure (“FRCP”). ECF No. 19.

After considering the papers submitted, supporting documentation, and applicable law, the Court **GRANTS** Plaintiff’s Motion to Dismiss *without prejudice*.

///

1 **II. BACKGROUND**

2 This case is one of several lawsuits in which Plaintiff accuses Defendant of
3 infringing on the claims of various patents it owns.

4 **A. Statement of Facts**

5 The accused products in this case relate to RJ-45 Integrated Connector Modules
6 (“ICMs”)¹ that connect electronic devices across local area networks (“LANs”). Compl.
7 at 3²:6-13.

8 Founded in 1947, Plaintiff designs and manufactures electronic components,
9 including RJ-45 ICMs, which are intended for use with electronics. Compl. at 3:6-10.
10 Plaintiff maintains its headquarters in San Diego, California, *id.* at 2:5-7, but its
11 “engineering design centers and manufacturing facilities supply products to a broad
12 international customer base,” *id.* at 3:9-10. Plaintiff owns more than 100 United States and
13 international patents dealing with RJ-45 ICM technology, *id.* at 3:23-25, one of which is at
14 issue in this case and covers various methods for limiting electromagnetic interference
15 (“EMI”), or the disruption of the operation of an electronic product due to electromagnetic
16 waves. *Pulse I*, 2021 WL 981123, at *2. On August 10, 2004, the United States Patent
17 and Trademark Office (the “USPTO”) issued the relevant patent in suit pertaining to this
18 case, United States Patent Number 6,773,302 (the “302 Patent”):

19
20
21 ¹ A detailed description of the ICMs at issue in this patent dispute is provided in the
22 Court’s order on the parties’ cross-motions for summary judgment in the related case to
23 this matter: *Pulse Electronics, Inc. v. U.D. Electronics Corp.*, Case No. 3:18-cv-00373-
24 BEN-MSB, 2021 WL 981123, *1 (S.D. Cal. Mar. 16, 2021) (“*Pulse I*”). The Court takes
25 judicial notice of the record in *Pulse I*. See FED. R. EVID. 201(b)(1)-(2) (providing that at
26 any stage of a proceeding, courts may take judicial notice of (1) facts not subject to
27 reasonable dispute and “generally known within the trial court’s territorial jurisdiction”
28 and (2) adjudicative facts, which “can be accurately and readily determined from sources
whose accuracy cannot reasonably be questioned”); see also *Rand v. Rowland*, 154 F.3d
952, 961 (9th Cir. 1998) (noting that a district court may take judicial notice “of its own
records, either at the behest of the defendant or *sua sponte*”).

² Unless otherwise indicated, all page number references are to the ECF-generated
page number contained in the header of each ECF-filed document.

Patent No.	Title	Description	Issue Date	Expiration Date
6,773,302	Advanced Microelectronic Connector Assembly and Method of Manufacturing	An advanced modular plug connector assembly incorporating a substrate disposed in the rear portion of the connector housing, the substrate adapted to receive one or more electronic components such as choke coils, transformers, or other signal conditioning elements or magnetics.	August 10, 2004	March 28, 2022 ³

Reply at 9:27-28; *see also* Exhibit “A” to Complaint, ECF No. 1-3 at 2.

Founded in 2005, Defendant is a Taiwan corporation that manufactures and supplies communications equipment, including RJ-45 ICMs, for integration into computer networking devices overseas. Compl. at 2:8-10, 3:26-27. Defendant is headquartered in Taoyuan City, Taiwan and operates two factories in Guandong and Sichuan, China. *See* Exhibit “M” to Compl., ECF No. 1-15 at 4.

Plaintiff alleges that “Defendant makes, uses, offers to sell, sells and/or imports into the United States products that infringe” on the 302 Patent, including, but not limited to, the following Accused Products:

Accused Products:	Series:	Claims Infringed:
1G multi-port ICM products	M1, M4, M6, MC, N1, N6, N8, RM, and RN series 1G devices	18 19
“Multi-Gigabyte” (e.g., 2.5G/5G) single- and multi-port ICM products	GM2, GM4, and GM6 series 2.5G devices	22 23

³ “[A] patent typically expires 20 years from the day the application for it was filed. *Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015) (citing 35 U.S.C. § 154(a)(2) (providing that a patent “grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States”)). “[W]hen the patent expires, . . . the right to make or use the article, free from all restriction, passes to the public.” *Id.* In this case, Pulse Engineering, Inc. applied for the 302 Patent on March 14, 2002, meaning it would expire on March 14, 2022. *See* ECF No. 1-3 at 2. However, the 302 Patent also notes that “[s]ubject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 14 days.” *See id.*; *see also* 35 U.S.C. § 154(b). Thus, the 302 Patent would expire fourteen (14) days after the original expiration date, or on March 28, 2022. *See also* Reply at 9:27-28.

1 *See* Compl. at 5:5-11, 8:13-18.

2 Plaintiff alleges Defendant directly infringes, in violation of 35 U.S.C. § 271(a), “by
3 making, using, offering to sell, selling, and/or importing into the United States, without
4 authority, Accused Products that infringe at least claims 18, 19, 22 and 23 of the ’302
5 Patent.” Compl. at 8:13-17. Plaintiff also alleges that Defendant has induced infringement
6 of the 302 Patent in violation of 35 U.S.C § 271(b), “by actively inducing related entities,
7 retailers, and/or customers to make, use, sell, offer to sell, and/or import, products covered
8 by one or more claims of the ’302 patent.” *Id.* at 18:1-4. Finally, Plaintiff also argues that
9 Defendant commits contributory infringement of the 302 Patent, in violation of 35 U.S.C.
10 § 271(c), by performing the below acts:

11 offering to sell or selling within the United States and/or
12 importing into the United States, without authorization, one or
13 more components or products of which the ’302 Patent covers
14 with the knowledge (at least as of October 14, 2016 or the filing
15 of the Original Complaint in Case No. 3:18-CV-00373 filed on
16 February 16, 2018) that such component(s) are especially made
17 or especially adapted for use in infringement of the ’302 Patent
18 and are not are staple articles of commerce suitable for
19 substantial non-infringing use.

20 Compl. at 30:13-22.

21 Finally, Plaintiff also alleges that “the Accused Products underwent an extensive
22 sales cycle that involved Defendant’s substantial U.S.-based use of the Accused Devices.”
23 Compl. at 5:12-22. Plaintiff pleads that “[b]ut for this U.S.-based infringing activity by
24 Defendant, such design wins would not have been achieved, and Defendant would not have
25 benefited from the resulting sales and associated revenue and profit.” *Id.*

26 **B. Procedural History**

27 **1. Pulse I⁴**

28 On February 16, 2018, Plaintiff first asserted the 302 Patent against Defendant in

⁴ All “ECF No.” references in Section II(B)(1) only are to the docket in *Pulse I* rather than the docket in this case.

1 *Pulse I*, where it initially accused Defendant of infringing on four patents: U.S. Patent No.
2 (1) 7,959,473 (the “473 Patent”), (2) 9,178,318 (the “318 Patent”), (3) 6,593,840 (the “840
3 Patent”), and (4) the 302 Patent. *See* ECF. No. 25-1 ¶ 14; *see also* Compl. at 4:8-11. On
4 June 11, 2018, UDE filed its Answer along with eight counterclaims for non-infringement
5 and invalidity of the 302, 473, 318, and 840 Patents. ECF. No. 13.

6 On January 17, 2020, Plaintiff filed a First Amended Complaint. ECF No. 61.
7 However, on July 6, 2020, the Court granted Defendant’s motion to dismiss the FAC
8 *without prejudice* and granted leave to amend. Order, ECF No. 100. The Court found
9 Plaintiff did not allege sufficient facts to establish a plausible claim for relief under the
10 *Twombly/Iqbal* standard as to both induced and contributory infringement. *Id.* at 4-5.

11 On December 17, 2018, the Court granted Defendant’s motion to stay *Pulse I*,
12 pending *inter partes* review (“IPR”) of all four patents-in-suit. Order, ECF No. 28 at 6-7.
13 Later that month, the Patent Trial and Appeal Board (“PTAB”) granted IPR of the 302
14 Patent. ECF No. 45 at 4:20-28. As such, on February 14, 2020, this Court granted a joint
15 motion for dismissal of the claims related to the 302 Patent *without prejudice*. ECF No.
16 72. As to the other patents, however, the PTAB denied institution of a trial. ECF No. 46
17 at 5:23-27. Thus, on November 18, 2019, this Court granted Plaintiff’s Motion to Lift the
18 Stay as to the remaining patents-in-suit, which had been in place during the IPR. Order,
19 ECF No. 52.

20 On July 16, 2020, Plaintiff filed a Second Amended Complaint, which became the
21 operative complaint and alleged three claims for relief for direct, induced, and contributory
22 infringement of the 473, 318, and 840 Patents. SAC. Shortly thereafter, on July 30, 2020,
23 the Court issued its Claim Construction Order. ECF No. 107.

24 On March 15, 2021, the Court in *Pulse I* denied Plaintiff’s motion for summary
25 judgment, granted-in-part Defendant’s motion for summary judgment, and ordered
26 Plaintiff to show cause as to why summary judgment should not be granted in Defendant’s
27 favor by coming forward with evidence of infringing acts within the United States. *See*
28 ECF No. 160. Two weeks later, on March 31, 2021, the Court dismissed the remaining

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