UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

APPLE INC., Plaintiff, vs. WI-LAN, INC., Defendant.	CASE NO. 14cv2235 DMS (BLM) **ORDER REQUESTING SUPPLEMENTAL BRIEFING**

Defendant's motion to dismiss portions of Plaintiff's Second Amended Complaint is currently pending before the Court. After further review of the parties' briefs and the legal authority cited therein, the Court requests supplemental briefing on the following issue: It appears unclean hands is generally asserted as an affirmative defense to a claim of patent infringement. That was the case in *Reid-Ashman Manufacturing, Inc. v. Swanson Semiconductor Service, L.L.C.*, No. C-06-4693 JCS, 2007 WL 1394427 (N.D. Cal. May 10, 2007), and *Multimedia Patent Trust v. Apple Inc.*, No. 10-CV-2618-H (KSC), 2012 WL 6863471 (S.D. Cal. Nov. 9, 2012). If a party prevails on an unclean hands affirmative defense, the remedy appears to be dismissal of the patent infringement claim or judgment in that defendant's favor, not a finding that the patent is unenforceable. In their briefing on the present motion, the parties rely on *Reid-Ashman* and *Multimedia Patent Trust*, which set out different standards for this affirmative defense, but they fail to cite any case law that supports Apple's *claim* that the Court may declare the Patents in Suit unenforceable based on unclean hands, and

more specifically, that the Court may declare the Patent in Suit unenforceable based on the kind of conduct alleged in this case. Absent any such authority, Apple's claim would be legally invalid, and thus subject to dismissal on that basis. Therefore, the Court requests supplemental briefing from the parties on whether Apple's claim for a declaratory judgment of unenforceability based on unclean hands is legally cognizable in the first instance. The parties may submit supplemental briefs on this issue, of no more than five (5) pages, on or before **December 5, 2014**.

IT IS SO ORDERED.

DATED: November 26, 2014

HON. DANA M. SABRAW
United States District Judge