IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MEKIKI CO., LTD. and MEKIKI CREATES CO., LTD.,	)	
Plaintiffs and Counter Defendants	)	C.A. No. 09-745 (JAP)
	)	**JURY TRIAL DEMANDED**
v.	)	
FACEBOOK, INC.,	)	
Defendant and Counterclaimant.	)	

APPENDIX A TO DEFENDANT FACEBOOK, INC.'S
REPLY BRIEF TO ITS MOTION TO TRANSFER VENUE UNDER 28 U.S.C. § 1404(a)

Plaintiffs' Argument	**Case Law Refuting Plaintiffs' Argument**
"It is black letter law that plaintiff's choice of forum is the 'paramount consideration' in determining whether to transfer a case under Section 1404(a) . . . Every district court within the Third Circuit follows the settled law that elevates plaintiff's choice of forum to the 'paramount consideration' in ruling on Section 1404(a) transfer motions." (Opp'n Br. at 16-17.)	"Thus, in cases like the instant one where a lawsuit is brought in a district that is not the Plaintiff's home forum, **Plaintiff's choice is accorded less weight**." *QinetiQ Ltd. v. Oclaro, Inc.*, No 09-372 (JAP), 2009 WL 5173705, at *3 (D. Del. Dec. 18, 2009). "[P]laintiff's preference to litigate in the District of Delaware is not unshakeable. . . . **[T]he deference given to plaintiff's forum choice is lessened because plaintiff is not litigating on its home turf**." *Teleconference Sys. v. Proctor & Gamble Pharms., Inc.*, 676 F. Supp. 2d 321, 330-31 (D. Del. 2009) (internal citations and quotations omitted). "Plaintiff's choice [of forum] is an important but **not determinative factor, especially where plaintiff and its claim have no significant nexus to Delaware**." *Teleconference Sys.*, 676 F. Supp. 2d at 333-34. "[The] 'home turf rule' is merely a short-hand way of saying that, under the balancing test inherent in any transfer analysis, **the weaker the connection between the forum and *either* the plaintiff *or* the lawsuit, the greater the ability of a defendant to show sufficient inconvenience to warrant transfer**." *Affymetrix, Inc. v. Synteni, Inc.*, 28 F. Supp. 2d 192, 199 (D. Del. 1998). "When the plaintiff has chosen to bring suit in a district that is not his 'home turf' and which has no connection to any of the acts giving rise to the lawsuit, the convenience to the plaintiff is not as great as it would be were [he] litigating at or near [his] principal place of business or at the site of the activities at issue in the lawsuit." *Burstein v. Applied Extrusion Techs., Inc.*, 829 F. Supp. 106, 110 (D. Del. 1992) (internal quotations omitted). "If the plaintiff chooses a forum which is not his "home turf" and which has no connection to any of the acts giving rise to the lawsuit, however, the convenience to the plaintiff of litigating in his chosen forum is not as great. This reduction in convenience **lessens the defendant's burden to show that the balance of convenience favors transfer**." *Kirschner Bros. Oil., Inc. v. Pannill*, 697 F. Supp. 804, 806 (D. Del. 1988).

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
	"Where the forum selected by plaintiff is connected neither with the plaintiff nor with the subject matter of the lawsuit, meeting **the burden of showing sufficient inconvenience** to tip the 'balance' of convenience 'strongly in favor of defendant' **will ordinarily be less difficult**." *Burroughs Wellcome Co. v. Giant Food, Inc.*, 392 F. Supp. 761, 763 (D. Del. 1975). *Nintendo*, 589 F.3d at 1200: > [T]he plaintiff's choice of venue corresponds to the burden that a moving party must meet in order to demonstrate that the transferee venue is a clearly more convenient venue. This court held that the district court in that case gave too much weight to the plaintiff's choice of venue by affording the plaintiff's choice considerable deference. This court granted mandamus, determining that the petitioner met its burden to establish that the district court clearly abused its discretion in denying transfer. This case appears to repeat the erroneous methodology that led this court to grant mandamus in *TS Tech*. **The district court gave the plaintiff's choice of venue far too much deference.**
"As a 'large international corporation' similar to the defendants denied transfer in the *Magsil* litigation, Facebook will not be inconvenienced, relative to its physical and financial condition, by litigating in Delaware." (Opp'n Br. at 21.)	*Genentech*, 566 F.3d at 1345: > Concerning the convenience of the parties, as we noted above, Genentech is headquartered within the Northern District of California. Biogen conducts research and development from its facilities in San Diego, California and at least some of its employees and managers would have to travel approximately half the distance to attend trial in Northern District of California than in the Eastern District of Texas. Sanofi is a German corporation that will be traveling a great distance no matter which venue the case is tried in and will be only slightly more inconvenienced by the case being tried in California than in Texas. **Thus the parties' convenience factor favored transfer, and not only slightly.**
"As an initial matter, Facebook's claims relating to the convenience of its own	*Genentech*, 566 F.3d at 1345: > Concerning the **convenience of the parties,** as we noted

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
witnesses (or Mekiki's witnesses) are irrelevant to this factor as these witnesses are presumed willing to testify at trial and are not part of the analysis of the convenience of the witnesses factor." (Opp'n Br. at 22 (citation and internal quotations omitted).)	above, Genentech is headquartered within the Northern District of California. Biogen conducts research and development from its facilities in San Diego, California and at least some of its employees and managers would have to travel approximately half the distance to attend trial in Northern District of California than in the Eastern District of Texas. Sanofi is a German corporation that will be traveling a great distance no matter which venue the case is tried in and will be only slightly more inconvenienced by the case being tried in California than in Texas. **Thus the parties' convenience factor favored transfer, and not only slightly**. "The **convenience of the parties** and witnesses, and the location of relevant evidence, are the **most important factors in the § 1404(a) analysis**." *Teleconference Sys.*, 676 F. Supp. 2d at 331. "The convenience and cost of attendance for witnesses is an important factor in the transfer calculus." *Nintendo*, 589 F.3d at 1198-99 (citing *Genentech*, 566 F.3d at 1343). *Genentech*, 566 F.3d at 1343 (citations and quotations omitted): We start with an important factor, the convenience for and cost of attendance of witnesses. *See generally Neil Bros. Ltd. v. World Wide Lines, Inc.*, 425 F. Supp. 2d 325, 329 (E.D.N.Y.) ('The convenience of the witnesses is probably the single most important factor in transfer analysis"). In *Volkswagen*, the Fifth Circuit noted that additional distance from home means additional travel time; additional travel time increases the probability for meal and lodging expenses; and additional travel time with overnight stays increases the time which these fact witnesses must be away from their regular employment. Because it generally becomes more inconvenient and costly for witnesses to attend the trial the further they are away from home, the Fifth Circuit established the 100-mile rule, which requires that when the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
	direct relationship to the additional distance to be traveled."
"[T]rial testimony is as often comprised of recorded depositions as it is of witnesses appearing live to testify. To the extent Facebook later learns that any witness it intends to offer to testify is unavailable or unwilling to testify, it can simply depose the witness." (Opp'n Br. at 23.)	*Teleconference Sys.*, 676 F. Supp. 2d at 333: The ability of potential witnesses to be subject to **compulsory process is also a factor that weighs heavily in the balance of convenience analysis**. *Affymetrix v. Synteni*, 28 F. Supp. 2d 192, 203 (D. Del. 1998). *See also In re Genentech*, 566 F.3d 1338, 1343 (Fed. Cir. 2009) ('the convenience of the witnesses is probably the single most important factor in transfer analysis') (citing *Neil Bros. Ltd. v. World Wide Lines, Inc.*, 425 F. Supp. 2d 325, 329 (E.D.N.Y. 2006)). . . . *See Genentech*, 566 F.3d at 1345 ('the fact **that the transferee venue is a venue with usable subpoena power here weighs in favor of transfer**, and not only slightly'). *See also Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 511, (U.S. 1947) ('to fix the place of trial at a point where litigants cannot compel personal attendance and may be forced to try their cases on deposition, is to create a condition not satisfactory to court, jury or most litigants'). The fact that . . . relevant witnesses, may voluntarily appear in Delaware for trial, is not the same as them being subject to compulsory subpoena power. *Sherwood Med. Co. v. IVAC Med. Sys., Inc.*, No 960305 (MMS), 1996 WL 700261, at *5 (D. Del. Nov. 25, 1996) ("a witness's agreement to appear 'is not the same as having them amenable to the subpoena power of the trial court'"); *Ricoh Co. v. Aeroflex, Inc.*, 279 F. Supp. 2d 554, 558 n.2 (D. Del. 2003) (an assertion by plaintiff opposing transfer that a third party with relevant information would cooperate in discovery is "suspect at best"). "Because the Eastern District of Texas does not have absolute subpoena power over Dr. Chang, i.e., it does not have the subpoena power to require that Dr. Chang attend both a trial and a deposition, and **because the [transferee venue] does have absolute subpoena power over at least four non-party witnesses, the district court should have considered this factor in favor of transfer.**" *Hoffmann-La Roche*, 587 F.3d at 1338 (citing *Genentech*, 566 F.3d at 1345).

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
	"[T]here is[sic] a substantial number of witnesses within the subpoena power of the Northern District of California and no witness who can be compelled to appear in the Eastern District of Texas. **The fact that the transferee venue is a venue with usable subpoena power here weighs in favor of transfer, and not only slightly**." *Genentech*, 566 F.3d at 1345.
"Facebook also argues that the Northern District of California would be a less expensive forum because it would require less travel costs, but patent litigation is expensive regardless of the forum and this does not present a legitimate reason to transfer a case." (Opp'n Br. at 23.)	*Genentech*, 566 F.3d at 1343 (citations and quotations omitted): In *Volkswagen*, the Fifth Circuit noted that **additional distance from home means additional travel time; additional travel time increases the probability for meal and lodging expenses; and additional travel time with overnight stays increases the time which these fact witnesses must be away from their regular employment**. Because it generally becomes more inconvenient and costly for witnesses to attend the trial the further they are away from home, the Fifth Circuit established the 100-mile rule, which requires that when the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled. *Genentech*, 566 F.3d at 1345: Concerning the convenience of the parties, as we noted above, Genentech is headquartered within the Northern District of California. Biogen conducts research and development from its facilities in San Diego, California and at least some of its employees and managers would have to travel approximately half the distance to attend trial in Northern District of California than in the Eastern District of Texas. Sanofi is a German corporation that will be traveling a great distance no matter which venue the case is tried in and will be only slightly more inconvenienced by the case being tried in California than in Texas. Thus the parties' convenience factor favored transfer, and not only slightly.
"For Facebook to show that the 'availability of documents' factor weighs in favor of transfer, it must	*Nintendo*, 589 F.3d at 1199-1200 (citations and quotations omitted): The district court also erred in considering as neutral the

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
demonstrate that relevant evidence will be unavailable for trial in Delaware." (Opp'n Br. at 25 (citation omitted).)	relative ease of access to sources of proof. The fact that access to some sources of proof presents a lesser inconvenience now than it might have absent recent developments does not render this factor superfluous. In *Genentech*, this court held that **in patent infringement cases, the bulk of the relevant evidence usually comes from the accused infringer. Consequently, the place where the defendant's documents are kept weighs in favor of transfer to that location**. "Keeping this case in the Eastern District of Texas will impose **a significant and unnecessary burden on the petitioners to transport documents that would not be incurred if the case were to proceed in the Northern District of California**. *Genentech*, 566 F.3d at 1346 (citation omitted). "Although it is true that the moving parties have not demonstrated that the parties' relevant documents and evidence cannot be made available in Delaware, **it is also a fact that it is substantially more convenient for the documents and evidence to be produced in the Northern District of California rather than the District of Delaware**." *Teleconference Sys.*, 676 F. Supp. 2d at 334.
"Facebook's infringing products and services are supplied to and used by hundreds of thousands of Facebook users in Delaware (and elsewhere in the world). This makes the District of Delaware a proper forum and weighs against transfer." (Opp'n Br. at 26.)	*Teleconference Sys.*, 676 F. Supp. 2d at 331: **In order to meaningfully address the § 1404(a) analysis the Court must identify the "real underlying dispute."** *Micron Technology*, 518 F.3d at 904. After this is done appropriate weight can be given to the interests of the different parties in the case. It is naive and inaccurate to assume that the interests of [defendant], the manufacturer and distributor of the [allegedly infringing] product or system, and the party who may have to indemnify its customers' damages, is the same as its customers. No matter how much plaintiff focuses on [defendant's] damage claims against its customers, **at bottom the focus of the case is on [defendant's] alleged infringement of plaintiff's patent. Plaintiff and [defendant], therefore, are unquestionably the key parties in the [] action.** Although the convenience or inconvenience to [defendant's] customers is not irrelevant, the focus of the Court's analysis should be on plaintiff and

Plaintiffs' Argument	Case Law Refuting Plaintiffs' Argument
	[defendant]. *See Honeywell Int'l Inc. v. Audiovox Commc'ns Corp.*, Case Nos. 04-1337 (KAJ) and 04-1338 (KAJ), 2005 WL 2465898, at *3 (D. Del. May 18, 2005) (citation omitted) (litigation against or brought by a manufacturer of an infringing product takes precedence over a suit by the patent owner against customers of the manufacturer); *accord Commissariat A L'Energie Atomique v. Dell Computer Corporation, et al.*, C.A. No. 03-484 (KAJ), 2004 WL 1554382, at *3 (D.Del. May 13, 2004); *Ricoh*, 279 F. Supp. 2d at 557 (citation omitted) (a manufacturer is presumed to have a greater interest in defending its patent against a charge of patent infringement compared to a customer). Plaintiff's claims against [defendant's] customers are fundamentally claims against the ordinary users of [defendant's] [allegedly infringing] product or system. Thus, the dispute between plaintiff and [defendant] will essentially resolve the validity of plaintiff's claims against [defendant's] customers. *Ricoh, supra.*[FN13] FN13. . . . Second, and perhaps more **importantly, even if each individual customer's use must be examined, the focus of the case is still on plaintiff's claims via-a-vis [defendant]**. In practical terms, the Court's ruling on plaintiff's infringement claim against [defendant], and the ruling on [defendant's] invalidity defense, is likely to resolve the issues against all of [defendant's] customers.
"Facebook ignores the court congestion factor, conceding that it does 'not appear to either favor or disfavor transfer.' However, not only does this factor not support transfer, it counsels for keeping the case in the District of Delaware." (Opp'n Br. at 27-28.)	*Teleconference Sys.*, 676 F. Supp. 2d at 335: The ninth factor to consider is the administrative difficulty in the competing fora resulting from court congestion. The Court finds this factor neutral. **Although there is presently a backlog in Delaware**, the parties are aware that these cases will be tried and managed before District and Magistrate Judges in New Jersey. The Court is confident that the case will be handled as efficiently and expeditiously in New Jersey as it will be in the Northern District of California. Thus, **administrative difficulties in handling these cases is not a factor that weighs for or against transfer**.