IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

Case No. 1:10cv023580-Civ-UU

MOTOROLA MOBILITY, INC., Plaintiff, v. APPLE INC., Defendant.	**JURY TRIAL DEMANDED**
APPLE INC., Counterclaim Plaintiff, v. MOTOROLA, INC. and MOTOROLA MOBILITY, INC., Counterclaim Defendants.	

DEFENDANT AND COUNTERCLAIM PLAINTIFF APPLE INC.'S MOTION TO TRANSFER VENUE

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Plaintiff Motorola Mobility, Inc. ("Motorola") filed its Original Complaint in this Court for Patent Infringement against Defendant Apple Inc. ("Apple") on October 6, 2010. D.E. No. 1. Apple respectfully moves to transfer venue pursuant to 28 U.S.C. § 1404(a). Specifically, for the purposes of judicial efficiency, Apple seeks a transfer of this action to the Western District of Wisconsin, where Motorola has already voluntarily moved patent claims against Apple that Motorola originally filed in its home forum, the Northern District of Illinois, and where Apple has sought to resolve the pending declaratory judgment patent claims Motorola filed against it in the District of Delaware. Indeed, for reasons of efficiency and judicial economy, Apple seeks to consolidate all pending district court patent claims between Apple and Motorola in the Western District of Wisconsin. In the alternative, Apple moves to dismiss this case on grounds of *forum non conveniens*.

I. INTRODUCTION

This case arises out of a multi-district patent dispute between Motorola and Apple.[1] On the same day that Motorola filed this complaint, it also filed ***three*** other complaints against Apple: two in the Northern District of Illinois and one with the United States International Trade Commission ("ITC"). *See* Declaration of Steven S. Cherensky in Support of Defendants' Motion to Transfer Venue [hereinafter "Cherensky Decl."] Exhs. A-C. Two days later, on October 8, 2010, Motorola filed yet another complaint against Apple in yet another forum, this time the District of Delaware, seeking declaratory judgment of non-infringement and invalidity of twelve Apple patents. *See* Cherensky Decl. Exh. D. On October 29, 2010, Apple also filed its own complaints in the Western District of Wisconsin and with the USITC. *See*

[1] In addition to the parties named in the above-captioned action, Motorola, Inc. (the parent company to Motorola Mobility, Inc.) and NeXT Computer, Inc. (a wholly-owned subsidiary of Apple Inc.) are also named as parties in other pending litigation.

Cherensky Decl. Exhs. E-G. On November 9, 2010, on its own accord and without notice to Apple, Motorola dismissed the two complaints it had filed in the Northern District of Illinois—***its home forum***—*see* Cherensky Decl. Exhs. H-I, in order to assert infringement of those sets of patents as counterclaims against Apple in the Western District of Wisconsin, *see* Cherensky Decl. Exhs. J-K. On November 18, 2010, Apple answered Motorola's complaint in this action and asserted infringement of additional patents via counterclaims. D.E. No. 17.

All told, Motorola and Apple are currently engaged in six patent infringement disputes in four distinct fora: two separate investigations before the ITC, two suits in the Western District of Wisconsin (one of which has been stayed pending resolution of the ITC investigations), one in the District of Delaware, and the action currently pending in this Court. Yet despite the geographic diversity of the relevant fora, these cases—and the district court cases in particular—share critical features that militate in favor of their resolution in a single venue. The district court cases involve the same parties, related technologies, substantially overlapping accused products, and common witnesses. Accordingly, judicial efficiency would be best served if all of the district court cases were litigated in the same venue. Specifically, as explained below, the Western District of Wisconsin is the venue most appropriate in light of convenience for the parties, convenience of the witnesses, and the interests of justice.

In furtherance of this goal of increased efficiency and convenience, Apple is actively engaged in efforts to transfer adjudication of Motorola's declaratory judgment patent claims from the District of Delaware to the Western District of Wisconsin. On December 2, 2010, Apple amended its complaint in the Western District of Wisconsin to include the twelve patents at issue in Motorola's declaratory judgment action filed in Delaware. *See* Cherensky Decl. Exh. L. On the same day, Apple filed a motion to dismiss or, in the alternative, to transfer

venue in the District of Delaware. *See* Cherensky Decl. Exhs. M-N. That motion is now fully briefed and pending adjudication.

Indeed, on December 28, 2010, counsel for Apple proposed to counsel for Motorola that all district court actions between the parties be consolidated in one district. *See* Cherensky Decl. Exh. O. Despite the obvious advantages of adjudicating the parties' claims in a single forum, and the fact that Motorola itself has already selected the Western District of Wisconsin over its home forum in the Northern District of Illinois to hear at least some of its patent infringement claims against Apple, Motorola has yet to respond to Apple's proposal, *see* Cherensky Decl. at ¶ 16. Furthermore, in the Joint Planning and Scheduling Report filed in this action, Motorola stated that it "does not believe that consolidation is appropriate" and indicated it would oppose any motion to transfer filed by Apple. D.E. No. 27 at 10. Accordingly, Apple now moves for an order transferring this action to the Western District of Wisconsin.

II. ARGUMENT AND AUTHORITIES

A. Legal Standards For Transfer Motions Pursuant To 28 U.S.C. § 1404(a)

Pursuant to 28 U.S.C. § 1404(a), "[f]or the convenience of the parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought." Congress authorized courts to transfer venue in order to avoid unnecessary inconvenience to the parties, witnesses, or the public, and to conserve time, energy, and money. *See Van Dusen v. Barrack*, 376 U.S. 612, 616 (1964). "The decision to transfer a case to another district is left to the sound discretion of the trial court." *Brown v. Conn. Gen. Life Ins. Co.*, 934 F.2d 1193, 1197 (11th Cir. 1991).[2] This analysis requires an "individualized, case-by-case consideration of convenience and fairness." *Van Dusen*, 376

[2] Although this is a patent infringement action, on issues unrelated to substantive patent law, the Federal Circuit applies the laws of the regional circuit in which the district court sits, in this case the Eleventh Circuit. *See e.g.*, *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008).

U.S. at 622.

In order to obtain a transfer of venue, "the moving party must demonstrate that (1) an adequate alternative forum is available, (2) the public and private factors weigh in favor of dismissal, and (3) the plaintiff can reinstate his suit in the alternative forum without undue inconvenience or prejudice." *Leon v. Million Air, Inc.*, 251 F.3d 1305, 1310-11 (11th Cir. 2001). The public and private factors considered by courts in adjudicating transfer motions include:

> (1) the convenience of the witnesses; (2) the location of relevant documents and the relative ease of access to sources of proof; (3) the convenience of the parties; (4) the locus of operative facts; (5) the availability of process to compel the attendance of unwilling witnesses; (6) the relative means of the parties; (7) a forum's familiarity with the governing law; (8) the weight accorded a plaintiff's choice of forum; and (9) trial efficiency and the interests of justice, based on the totality of the circumstances.

Manuel v. Convergys Corp., 430 F.3d 1132, 1135 n.1 (11th Cir. 2005).

B. Motorola Could Have Filed Suit In The Western District Of Wisconsin

The threshold question in any motion to transfer venue is whether the plaintiff could have brought suit in the proposed transferee court. *See Jewelmasters, Inc. v. May Dep't Stores Co.*, 840 F. Supp. 893, 894 (S.D. Fla. 1993). Here, Motorola itself has already moved patent infringement claims against Apple from its home district, the Northern District of Illinois, to the Western District of Wisconsin. Moreover, in making that move, Motorola asserted that the Western District of Wisconsin was a proper venue for its counterclaims against Apple for essentially the same reasons that it alleged venue was proper in this district, *i.e.*, that Apple operates retails stores within both districts and places allegedly infringing devices within the stream of commerce. *Compare* D.E. No. 1 with Cherensky Decl. Exhs. J-K. Thus, it can hardly dispute that this action could also have originally been brought in the Western District of Wisconsin.

C. The Relevant Factors Favor A Transfer To The Western District of Wisconsin

Once it has been established that this action could have been brought in the transferee forum, the private and public factors must then be considered. As discussed below, on balance these factors favor a transfer to the Western District of Wisconsin. Specifically, both increased judicial efficiency and the convenience to the parties as well as third-party witnesses weigh strongly in favor of transfer.

1. Judicial Efficiency And The Interests Of Justice Favor A Transfer

Motorola's efforts to litigate patent infringement claims concerning the same parties, overlapping products, and related technologies in three separate district courts generates precisely the sort of inefficiencies the transfer doctrine is designed to prevent. Although Motorola has every right to litigate its claims against Apple, it is not entitled to tie up resources in three disparate jurisdictions in the process. As the U.S. Supreme Court has explained, litigating the same issues in different courts inevitably "leads to the wastefulness of time, energy and money that §1404(a) was designed to prevent." *Cont'l Grain Co. v. The Barge FBL-585*, 364 U.S. 19, 26 (1960). Transferring this action to the Western District of Wisconsin would provide genuine opportunities to streamline numerous aspects of this case, from discovery to consumption of judicial resources.

Despite the fact that the same products stand accused of patent infringement in the Wisconsin actions and the action currently pending in this Court, Motorola would have this Court and the Western District of Wisconsin expend resources understanding the function, design, and operation of these products and related patent technologies, resolving overlapping discovery disputes, and issuing evidentiary rulings on similar, if not identical, matters.

As stated above, the same products are implicated in both the Wisconsin and

Florida cases. Specifically, Motorola accuses Apple's iPhone, iPad, iPod and Mac products of infringing its patents, while Apple accuses Motorola's mobile phone products, and its mobile phone products running the Android operating system in particular, of infringing its patents. These products fall into the general category of computing devices, with most of the accused products representing mobile communications and mobile computing devices. And the parties' infringement allegations concern interrelated aspects of the operation of these devices.

The identity of the accused products and general technological areas covered by the asserted patents means that absent transfer both this Court and the Western District of Wisconsin would have to invest significant resources studying the same products and same general technology; an unnecessarily inefficient result. "To require two different courts to educate themselves about the same underlying technology does not promote judicial efficiency." Cherensky Decl. Exh. R [*Nokia Corp. v. Apple Inc.*, Case No. 3:10-cv-00249-wmc (D.E. 67), Slip Op., at 11-12 (W.D. Wis. Jan. 5, 2011)] (granting Apple's motion for transfer where the same products stood accused in both the transferor and transferee venues and the patents asserted in those venues shared "at least some degree of overlapping technology"); *Abbott Labs. v. Selfcare, Inc.*, No. 98-CV-7102, 1999 WL 162805, at *2 (N.D. Ill. Mar. 15, 1999) ("The two actions, even though directed to different patents, involve the same parties and substantially similar technology. They also involve similar complex factual and legal questions that will require the expenditure of considerable time and effort. Requiring two courts to devote limited resources educating themselves about the same underlying technology would undermine values of judicial economy.").

Furthermore, both courts would inevitably be forced to resolve closely related discovery disputes. Judicial efficiency is hardly served by forcing multiple courts to resolve such

similar discovery disputes. In addition, simultaneously litigating in Delaware, Florida, ***and*** Wisconsin (as Motorola apparently wishes to do)—in addition to the two investigations in the ITC—would create unnecessary scheduling conflicts as well as considerably complicate discovery and pretrial proceedings.

Closer to trial, the parties would likely raise similar motions *in limine* and disputes concerning jury instructions, thus creating a serious risk of conflicting evidentiary rulings. Moreover, to the extent that the parties consider settlement, negotiations in one case will be inextricably intertwined with events in another case. Allowing related cases to proceed on separate schedules in separate courts would complicate settlement discussions and potentially hamper a global settlement between the parties.

This court has recognized that "trial efficiency and the interests of justice especially favor consolidated litigation in patent cases." *Global Innovation Tech. Holdings, LLC v. Acer Am. Corp.*, 634 F. Supp. 2d 1346, 1348 (S.D. Fla. 2009). But even if these cases are not fully consolidated after transfer to the Western District of Wisconsin, litigating the entire dispute within a single forum will facilitate coordination of discovery and the resolution of any pretrial disputes. Similarly, both the parties and the court system will benefit from having a single judge that is familiar with the parties, their products, and the technology in dispute, even where different patents are asserted. *See, e.g.*, *Abbott Labs.*, 1999 WL 162805, at *2.

Motorola has itself made these very arguments in its own motions for transfer. Indeed, Motorola's present insistence on maintaining four related actions between the same parties and pertaining to the same products in three separate district courts is a striking reversal from the anti-forum-shopping, pro-efficiency position it took under nearly identical circumstances less than three years ago. Motorola characterized transfer as a means to facilitate

"the most economical and expeditious manner of resolving the pending claims and disputes between the parties" when it faced a "multiplicity and duplication of averments spread out over four different actions in three districts," see Cherensky Decl. Exh. S [*Research in Motion Ltd. v. Motorola, Inc.*, Case No. 3:08-cv-00317-K, Motorola's Notice of Related Case and Motion to Transfer (D.E. No. 7), at 3 (N.D. Tex. Mar. 4, 2008)]. Indeed, in that case, Motorola affirmatively argued that the fact that the same products were accused in the various litigations supported transfer.[3] *Id.*

2. Convenience Of The Witnesses And The Parties Favors A Transfer

Motorola has no apparent current connection to the Southern District of Florida and pleads no such connection in its complaint. As Motorola states in its complaint, it is incorporated in Delaware and has its principal place of business in Libertyville, Illinois. *See* D.E. No. 1 at ¶ 2. Apple, on the other hand, is a California corporation, headquartered in Cupertino, California. *Id.* at ¶ 3. None of the potential witnesses or sources of evidence in this case are likely to be located in Florida. Moreover, nearly all of the probable third-party witnesses are outside of this Court's subpoena power.

The only conceivable connection to Florida in this case arises from the fact that out of the thirty-three patents being asserted in the various district court disputes, three Motorola patents name Florida residents as inventors. This fact does not weigh against transfer, however, because all of the individuals residing in Florida are listed in Motorola's initial disclosures as

[3] There is some argument to be made for transferring this case to a different forum, such as Apple's home jurisdiction. *See Cellularvision Tech. & Telecomms., L.P. v. Alltell Corp.*, 508 F. Supp. 2d 1186, 1193 (S.D. Fla. 2007) (observing that "in patent infringement cases, when the Plaintiff has not brought suit in its home jurisdiction, the defendant's home jurisdiction in which the majority of development, testing, research, production, and decisions regarding marketing and sales took place is the most convenient venue under 1404(a)"). Apple proposed proceeding in the Western District of Wisconsin, however, because that court has already issued a scheduling order. *See* Cherensky Decl. Exhs. O-P.

reachable only through counsel for Motorola, and thus appear to be under Motorola's control. *See* Cherensky Decl. Exh. Q. Accordingly, the Western District of Wisconsin's lack of subpoena power as to those witnesses does not disfavor transfer. Moreover, the fact that these are the only potential witnesses for either party with a Florida connection in multi-district litigation concerning thirty-three patents and numerous accused products underscores the absence of a meaningful connection to Florida in this case.

Aside from the Floridian inventors, the overwhelming majority of Motorola's witnesses appear to be located in the Midwest, near Motorola's principal place of business. *See id.* Similarly, none of Apple's witnesses are Florida-based. Of the six Apple patents at issue in this action, all but two of the named inventors are identified on the face of the patents as residing in California; the remaining two are identified as residing in Colorado. None of the Apple patents being asserted in ***any*** jurisdiction list an inventor residing in Florida. Thus, for both Apple and Motorola's witnesses, Wisconsin is a much closer venue than Florida.

Likewise, transferring this case to the Western District of Wisconsin would also be more convenient for the parties. Although Apple and Motorola are both large corporations that are not likely to experience extreme hardship as a result of the financial burdens of this particular litigation, proceeding in a single venue would undoubtedly reduce the overall costs incurred by both parties.

3. The Remaining Factors Are Neutral

The other remaining public and private factors are largely neutral. For example, while all of the documents are located outside this district, production of those documents is unlikely to be more burdensome in Wisconsin than it would be in Florida.

Although the plaintiff's choice of forum is generally given deference, *see*

Robinson v. Giarmarco & Bill, P.C., 74 F.3d 253, 260 (11th Cir. 1996), "where the operative facts underlying the cause of action did not occur within" the chosen forum, this factor is entitled to "less consideration." *Windmere Corp. v. Remington Prods., Inc.*, 617 F. Supp. 8, 10 (S.D. Fla. 1985).[4] Here, the alleged infringement of the patents-in-suit is no more centered in this district than in the Western District of Wisconsin; both Apple and Motorola sell their products nationwide. Moreover, "where a plaintiff has chosen a forum that is not its home forum, only minimal deference is required, and it is considerably easier to satisfy the burden of showing that other considerations make transfer proper." *See Cellularvision*, 508 F. Supp. 2d at 1189 (citing *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 255-56 (1981)). As noted above, Motorola is a Delaware corporation with its principal place of business in Illinois. *See* D.E. No. 1 at ¶ 2. Finally, as discussed above, Motorola in fact has chosen the Western District of Wisconsin to litigate at least some of its patent claims against Apple and did so by dismissing those claims from its home forum.

If proven, docket congestion may be an appropriate consideration in a § 1404(a) motion to transfer, but it is not, by itself, a dispositive factor. *P & S Business Machs., Inc. v. Canon U.S.A., Inc.*, 331 F.3d 804, 808 (11th Cir. 2003). That said, this Court has previously recognized that the Southern District of Florida has one of the busiest dockets in the country. *See Thermal Techs., Inc. v. Dade Serv. Corp.*, 282 F. Supp. 2d 1373, 1378 (S.D. Fla. 2003); *see also Cellularvision Tech. & Telecomms., L.P. v. Cellco P'ship*, Case No. 06-60666-CIV, 2006 WL 2871858 at *4 (S.D. Fla. Sept. 12, 2006).

[4] While Motorola is likely to argue that this action should proceed because it was the first-filed case, the "first-filed presumption lands squarely within this Court's consideration of public and private factors," *see Global Innovation*, 634 F. Supp. 2d at 1348, and is outweighed by other considerations here.

D. In The Alternative, Dismissal Is Warranted Under The Doctrine Of *Forum Non Conveniens*

Alternatively, it is well established that the Court has the inherent power to decline the exercise of its jurisdiction and may dismiss a case on the common law grounds of *forum non conveniens*. *See Meterlogic, Inc. v. Copier Solutions, Inc.*, 185 F. Supp. 2d 1292, 1299 (S.D. Fla. 2002) (observing that 28 U.S.C. § 1404(a) "is the statutory codification of the common law doctrine of *forum non conveniens*"); *cf. Landis v. N. Am. Co.*, 299 U.S. 248, 254 (1936) (noting in the context of a stay motion that courts have the inherent power "to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants"). Although both inquiries revolve around whether the litigation can more appropriately be conducted in a different forum, dismissal for *forum non conveniens* is distinct from transferring venue pursuant to 28 U.S.C. § 1404(a); the former arises out of the Court's inherent discretion to decline to exercise its jurisdiction in exceptional cases. *See Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 504 (1947).

In determining whether dismissal is appropriate, courts consider whether there is an appropriate alternative forum, and whether public and private interests weigh in favor of dismissal. *See Gulf Oil*, 330 U.S. at 508-09. For the same reasons as discussed above, if the Court is not inclined to grant this motion to transfer venue, Apple nonetheless respectfully urges the Court to exercise its discretion to dismiss this action on grounds of *forum non conveniens*.

III. CONCLUSION

For the aforementioned reasons, Apple respectfully requests that the Court transfer this case to the United States District Court for the Western District of Wisconsin.

IV. CERTIFICATE OF GOOD FAITH CONFERENCE

Pursuant to S.D. Fla. L.R. 7.1(a)(3), the undersigned counsel for Apple certifies that prior to the filing of the instant motion, the parties met and conferred in a good faith effort to resolve the issues raised herein, but were unable to do so.

Dated: January 12, 2011

Respectfully submitted,

/s/ Christopher R. J. Pace
Christopher R. J. Pace (Fla. Bar No. 0721166)

Christopher R. J. Pace
Edward Soto
WEIL, GOTSHAL & MANGES LLP
1395 Brickell Avenue, Suite 1200
Miami, FL 33131
Telephone: (305) 577-3100
Facsimile: (305) 374-7159

Matthew D. Powers
Steven S. Cherensky
Jill J. Ho
WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Telephone: (650) 802-3000
Facsimile: (650) 802-3100

Mark G. Davis
WEIL, GOTSHAL & MANGES LLP
1300 Eye Street, N.W., Suite 900
Washington, DC 20005
Telephone: (202) 682-7000
Facsimile: (202) 857-0940

Patricia Young
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
Telephone: (212) 310-8000
Facsimile: (212) 310-8007

Attorneys for Apple Inc.

CERTIFICATE OF SERVICE

I hereby certify that on January 12, 2011, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to received electronically Notices of Electronic Filing.

/s/ Christopher R. J. Pace
Christopher R. J. Pace (Fla. Bar No. 0721166)

SERVICE LIST
Motorola Mobility, Inc. versus Apple Inc.
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United States District Court, Southern District of Florida

Edward M. Mullins
Fla. Bar No. 863920
emullins@astidavis.com
ASTIGARRAGA DAVIS MULLINS & GROSSMAN, P.A.
701 Brickell Avenue, 16th Floor
Miami, FL 33131
Telephone: (305) 372-8282
Facsimile: (305) 372-8202

Attorneys for Motorola Mobility, Inc.
Electronically served via CM/ECF

Of Counsel:
Charles K. Verhoeven
QUINN EMANUEL URQUHART & SULLIVAN, LLP
50 California Street, 22nd Floor
San Francisco, CA 93111
(415) 875-6600

Edward J. DeFranco
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
(212) 849-7000

David A. Nelson
QUINN EMANUEL URQUHART & SULLIVAN, LLP
500 West Madison Street, Suite 2450
Chicago, IL 60661
(312) 705-7400

Attorneys for Motorola Mobility, Inc.
Electronically served via email

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APPLE INC.,

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_____ /

ORDER GRANTING APPLE INC.'S MOTION TO TRANSFER VENUE

The Court having considered Apple Inc.'s Motion to Transfer Venue, it is ORDERED AND ADJUDGED:

1. The Motion to Transfer Venue is hereby GRANTED.

2. This action is transferred to the United States District Court for the Western District of Wisconsin. The Clerk is directed to send the entire file to the Clerk for the Western District of Wisconsin.

_____
Hon. Ursula Ungaro
United States District Judge

Copies to:

All Counsel of Record