UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

MOTOROLA MOBILITY, INC., Plaintiff, v. APPLE INC. Defendant.	Case No. 10-CV-23580-UU **JURY TRIAL DEMANDED**
APPLE INC., Counterclaim Plaintiff, v. MOTOROLA, INC. and MOTOROLA MOBILITY, INC., Counterclaim Defendants.	

MOTOROLA MOBILITY INC.'S AND MOTOROLA INC.'S
OPPOSITION TO APPLE INC.'S MOTION TO TRANSFER VENUE

February 3, 2011

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INTRODUCTION

Motorola Mobility, Inc. ("Mobility") and Motorola, Inc. (collectively, "Motorola") hereby submit this opposition to Apple, Inc.'s ("Apple's") motion to transfer venue to the Western District of Wisconsin or dismiss this action on *forum non conveniens* grounds. (D.I. 37.)

SUMMARY OF ARGUMENT

Despite Apple's efforts to obscure the key facts and governing precedent, the law and the facts are straightforward and require denial of Apple's motion. The Eleventh Circuit and this Court have set out a strong presumption that the plaintiff's choice of forum should be respected, particularly when there are reasonable and legitimate reasons for that choice. The Eleventh Circuit and this Court have also established a strong presumption in favor of the first-filed action. The party seeking transfer has a heavy burden to demonstrate that the balance of factors strongly favors transfer. Apple has utterly failed to meet its heavy burden to justify transfer, ignoring the numerous, incontrovertible factors weighing heavily against transfer and presenting only vague and unsubstantiated argument that transfer would promote the interest of justice.

Factors weighing heavily against transfer include the status of this action as first-filed, Mobility's substantial connections to this forum, and the nexus of this forum to the subject of the action. Mobility filed this action nearly a month before Apple filed the Wisconsin Action. Despite Apple's assertion that "Motorola has no apparent connection to the Southern District of Florida" (Apple Br. at 8), Mobility's Plantation, Florida location constitutes a substantial presence here and is the basis for significant ties to this District. One of the products Apple has accused of infringement in a permissive counterclaim was designed and developed, and is marketed and supported in Plantation.

Against the weight of these factors requiring denial of its motion, Apple offers wholly

unsubstantiated argument that consolidation of all the parties' disputes in the Western District of Wisconsin would somehow promote the interest of justice. What Apple fails to point out is that *none* of the Mobility or Apple patents at issue here are at issue in the Wisconsin Action. The technologies at issue here are different from those at issue in the Wisconsin Action. And despite its burden to proffer facts that strongly justify transfer, Apple has not provided evidence that a single non-party witness will be available for trial in Wisconsin who would not be available here. In fact, Apple has provided no evidence whatsoever that this forum is inconvenient in any respect.

Apple favors sweeping generalizations and discussion of its "goals," rather than sober consideration of the key facts at issue and the governing precedent. Apple seeks to persuade this Court to take a bird's-eye view of multiple unrelated actions in various jurisdictions and to base a transfer decision on Apple's unsupported assertions about "increased efficiency and convenience." But the transfer analysis is fact-specific and the facts here weigh heavily against transfer. Apple's inability to ground its motion in *any* of the relevant facts necessary to support transfer according to binding precedent of this Court and the Eleventh Circuit requires that its motion be denied.

STATEMENT OF FACTS

The key facts requiring denial of Apple's transfer motion are: (1) Mobility filed this action on October 6, 2010, nearly a month before Apple filed the Wisconsin Action on October 29, 2010; (2) Mobility's Plantation location constitutes a substantial presence here and is the basis for Mobility's significant ties to this District; (3) one of the products Apple has accused of infringement in a permissive counterclaim, the i1 IDEN phone, was designed and developed, and is marketed and supported in Plantation; (4) none of the Mobility or Apple patents at issue here

are at issue in the Wisconsin Action; and (5) the technologies at issue in the two actions are virtually non-overlapping.

In contrast, the "facts" that Apple attempts to rely on are, at best, irrelevant, and at worst, mischaracterizations. Apple's statement that "Motorola has no apparent connection to the Southern District of Florida" (Apple Br. at 8) is inexcusable, given that Mobility's website lists its Plantation location. (Mobility Office Locations (Ex. 1); Motorola FY 2009 10-K (Ex. 2) at 4.)[1]

Apple's statements that "judicial efficiency would be best served if all of the district court cases were litigated in the same venue" and that "the Western District of Wisconsin is the venue most appropriate in light of convenience for the parties, convenience of the witnesses, and interests of justice" (Apple Br. at 2) are argument, not fact. Similarly, Apple's statement that "[t]he district court cases involve the same parties, related technologies, substantially overlapping accused products, and common witnesses," (Apple Br. at 2) is both incomplete and inaccurate. Notably, Apple does not address the undisputed key fact that *none* of the Mobility or Apple patents at issue here are at issue in the Wisconsin Action, or address in any detail the technologies it describes as "related." Because Apple's "facts" cannot serve as the basis for transfer of this action, its motion should be denied.

I. Mobility Filed This Action Nearly a Month Before Apple Filed its Action in the Western District of Wisconsin

Mobility filed this action on October 6, 2010, nearly a month before Apple filed the Wisconsin Action on October 29, 2010. (D.I. 1; Wisconsin Apple Complaint (Ex. F to the Declaration of Steven S. Cherensky in Support of Defendant and Counterclaim Plaintiff Apple

[1] All exhibits, unless otherwise indicated, are attached to the Declaration of Ed DeFranco filed concurrently herewith.

Inc.'s Motion to Transfer Venue ("Cherensky Decl.") (D.I. 38)).) Apple answered the complaint in this action on November 18, 2010, asserting infringement of the six Apple patents at issue here in permissive counterclaims. (D.I. 17.) Apple amended its complaint in the Wisconsin Action on December 2, 2010 (Wisconsin Apple Amended Complaint (Ex. L to Cherensky Decl.)), asserting twelve patents in addition to the three asserted in its original complaint in that action. Notably, none of the 15 Apple patents at issue in the Wisconsin Action are at issue here. Apple could have asserted the six patents at issue here in the Wisconsin Action, either when it filed its original complaint or when it filed its amended complaint there, but chose not to do so. On January 12, 2011, Apple filed the present motion to transfer this action to Wisconsin.

II. Mobility's Plantation, Florida Location Is the Basis for its Substantial Ties to this District

Mobility's facility in Plantation is located at 8000 West Sunrise Boulevard, Plantation, Florida 33322. (Declaration of Christopher Masci in Opposition to Apple's Motion to Transfer Venue ("Masci Decl.") ¶ 3.) The Plantation location handles sales operations other than distribution for a total of thirty (30%) percent of Motorola Mobility sales units, including fifty (50%) percent of the iDEN Worldwide sales. (Masci Decl. ¶ 4.) The Plantation location's sales for Motorola Mobility in 2010 were $2.055 billion and a total of 15.5 million handsets shipped. (Masci Decl. ¶ 8.) Other products such as 3G products are designed and developed at the Plantation location. (Masci Decl. ¶ 5.)

The Plantation location manages and provides technical support for several Mobility phones, including iDEN phones. (Masci Decl. ¶ 6.) The Plantation location is the development site for several products, including iDEN and CDMA handsets. (Masci Decl. ¶ 8.) The Plantation location houses the headquarters for Latin America business for Mobility. (Masci Decl. ¶ 7.) This organization includes, management, sales, finance, legal, and operations. The

Plantation site also includes the Latin America (LATAM) sales organization for all of Mobility and the iDEN International sales organization. (Masci Decl. ¶ 8.)

III. One of the Products Apple Has Accused of Infringement in this Action Was Developed and Designed in Plantation and Is Also Marketed and Supported Here

Plantation is the main Motorola Mobility campus for the design and development of iDEN products, including the development of software for all iDEN products. (Masci Decl. ¶ 4.) The i1 IDEN phone was developed at Plantation over a period of 18 months, from January 2009 through June 2010. (Declaration of Jim Conroy in Opposition to Apple's Motion to Transfer Venue ("Conroy Decl.") ¶ 4).) All of the lead Mobility employees for the product and most of the rest of the employees who worked on the product were located in Plantation. (Conroy Decl. ¶ 4.) The bulk of the work on the product was carried out in Plantation and included software design work, electrical work, mechanical work, media decision-making, and marketing, including direction of the user interface design. (Conroy Decl. ¶¶ 2, 4.) This work included the design of the accused unlock gesture feature on the i1 phone. (Conroy Decl. ¶ 4.)

Some of the software work on the product was carried out in Nanjing, China; a small amount of mechanical industrial design work on the product was carried out in Chicago; and a small amount of work on third-party applications was carried out in San Diego. (Conroy Decl. ¶ 5.) A manager at the Plantation facility oversaw integration of work on the i1 phone carried out at other locations. (Conroy Decl. ¶ 5.)

Work on the i1 IDEN phone was a priority for the Plantation location. (Conroy Decl. ¶ 6.) Plantation was the logical choice as the location for development of this product because the Mobility employees with expertise in the IDEN network are located in Plantation. The technology for the i1 IDEN phone grew out of this expertise. (Conroy Decl. ¶ 6.) At peak, about 74 people at the Plantation location were working on the i1 IDEN phone: 39 were software

engineers, 14 were electrical engineers, 14 were mechanical engineers, and the balance were working on marketing, quality, and management work. (Conroy Decl. ¶ 7.) Numerous documents relating to the design, development, testing, and marketing of the i1 phone are located at the Plantation facility. (Conroy Decl. ¶ 12.)

IV. None of the Mobility or Apple Patents at Issue Here Are at Issue in the Wisconsin Action

None of the six Mobility patents at issue here are at issue in the Wisconsin action.[2] Similarly, none of the six Apple patents at issue here are at issue in the Wisconsin Action. There are two groups of Apple patents at issue in the Wisconsin action: (1) three patents that Apple asserted in its original complaint, and (2) twelve additional unrelated patents it asserted in an Amended Complaint nearly two months after Motorola brought a declaratory judgment action on these twelve patents in Delaware, where all twelve patents were already the subject of four pending related actions against other defendants. (Wisconsin Apple Amended Complaint (Ex. L to Cherensky Decl.) at ¶¶12-23).) Motorola has moved to transfer Apple's Wisconsin claims

[2] Specifically, the six Motorola patents at issue here are the '987 Patent, entitled, "Receiver Having Concealed External Antenna"; the '119 Patent, entitled, "Multiple Pager Status Synchronization System and Method"; the '006 Patent, entitled, "Method and Apparatus for Communicating Summarized Data"; the '737 Patent, entitled, "Apparatus for Controlling Utilization of Software Added to a Portable Communication Device"; the '531 Patent, entitled, "System for Communicating User Selected Criteria Filter Prepared at Wireless Client to Communication Server for Filtering Data Transferred from Host to Said Wireless Client"; and the '161 Patent, entitled, "Method and Apparatus in a Wireless Messaging System for Facilitating an Exchange of Address Information." (D.I. 1.) The Motorola patents at issue in the Wisconsin Action are U.S. Patent Nos.: 6,175,559 ("the '559 Patent"), entitled, "Method for Generating Preamble Sequences in a Code Division Multiple Access System"; 6,359,898 ("the '898 Patent"), entitled, "Method for Performing a Countdown Function During a Mobile-Originated Transfer for a Packet Radio System"; 5,319,712 ("the '712 Patent"), entitled, "Method and Apparatus for Providing Cryptographic Protection of a Data Stream in a Communication System"; 5,572,193 ("the '193 Patent"), entitled, "Method for Authentication and Protection of Subscribers in Telecommunications Systems"; 5,490,230 ("the '230 Patent"), entitled, "Digital Speech Coder Having Optimized Signal Energy Parameters"; and 5,311,516 ("the '516 Patent"), entitled, "Paging System Using Message Fragmentation to Redistribute Traffic."

based on these twelve additional patents to Delaware. (Wisconsin Motorola Transfer Motion (Ex. 3).) That motion has been fully briefed but not yet decided by the Western District of Wisconsin.

V. There Is Virtually No Overlap in the Technologies at Issue Here and in the Wisconsin Action

A. The Mobility Patents at Issue Here Are "Non-Essential" Patents, While Those at Issue in the Wisconsin Action Are "Essential" Patents

The Mobility patents at issue here are all "non-essential patents," while those at issue in the Wisconsin Action are "essential patents." The "essential" Mobility patents at issue in the Wisconsin Action raise different technological and legal issues from the "non-essential" patents at issue here. "Essential" patents in the mobile phone industry relate to fundamental features of mobile phones that the industry agrees all mobile phones should incorporate, such as the way a phone communicates over a wireless network. The owner of an essential patent, used to practice such an industry standard, may be subject to obligations to license the patent to others on "fair/reasonable and non-discriminatory" terms ("F/RAND"). Apple has raised F/RAND defenses in the Wisconsin Action alleging that Mobility has violated various obligations to industry standard setting organizations in relation to the essential patents at issue.[3] (Wisconsin Apple Amended Answer and Counterclaims (Ex. 4) ¶ 91.) In contrast, the "non-essential" Mobility patents at issue in this action relate to technology that need not be standard but can vary from phone to phone without impairing the usefulness of the phone, including features such as antennas and E-mail filters.

[3] In the Wisconsin Action, Apple argued for early resolution of some of these issues, relating to three Motorola patents in suit there, in advance of the court's addressing the remaining claims relating to the remaining three Motorola patents and fifteen Apple patents. (Wisconsin Joint Planning and Scheduling Report (Ex. 5) at § G.1.)

B. Five of the Six Apple Patents at Issue Here Are Unrelated to the Fifteen Patents Currently at Issue in the Wisconsin Action and the Sixth Is Only Generally Related to a Subset of Those at Issue There

The Apple patents at issue here[4] similarly raise different issues from those at issue in the Wisconsin Action. Here, three of the six asserted Apple patents (the '560, '509, and '456 Patents) relate to features of set-top (cable) boxes, such as the ability to display a program guide; two (the '646 and '116 Patents) relate to adding or removing a device, for example, a video display, to a computer system; and the sixth (the '849 Patent) relates to an "unlock" feature of a touchscreen phone.

The three original patents Apple asserted in the Wisconsin Action are wholly unrelated to set-top boxes or adding devices to a computer system. Instead, they relate to the way in which a user "interfaces" with a device such as a phone, for example, the way in which the phone responds to touches, taps, and other inputs from the user. (Wisconsin Apple Complaint (Ex. F to Cherensky Decl.) at ¶¶ 8-10.) Although Apple may attempt to argue that these patents relate to the "unlock" patent (the '849 Patent) Apple has asserted here, they relate, if at all, only in the general sense that the unlock feature is one of many aspects of the "interface" between the user and the phone. (Florida Apple Answer, Affirmative Defenses and Counterclaims (D.I. 17) ¶¶ 155-56, 161-62, 167-68, 173-74, 179-180, 185-86.) In any event, the i1 IDEN phone, one of the Mobility products accused of infringing the '849 Patent, was developed, designed, manufactured,

[4] The Apple patents at issue here are U.S. Patent Nos. 5,583,560 ("the '560 Patent"), entitled, "Method and Apparatus for Audio-Visual Interface for the Subjective Display of Listing Information on a Display"; 5,594,509 ("the '509 Patent"), entitled, "Method and Apparatus for Audio-Visual Interface for the Display of Multiple Levels of Information on a Display"; 5,621,456 ("the '456 Patent"), entitled "Methods and Apparatus for Audio-Visual Interface for the Display of Multiple Program Categories"; 6,282,646 ("the '646 Patent"), entitled, "System for Real-Time Adaptation to Changes in Display Configuration"; 7,380,116 ("the '116 Patent"), entitled, "System for Real-time Adaptation to Changes in Display Configuration"; and 7,657,849 ("the '849 Patent"), entitled, "Unlocking a Device by Performing Gestures on an Unlock Image."

and marketed at Mobility's Plantation location. (Wisconsin Apple Complaint (Ex. F to Cherensky Decl.) at ¶ 8; Conroy Decl.) The twelve patents Apple subsequently added in the Wisconsin Action that are the subject of Mobility's motion to dismiss relate to functionality of the operating system and are also unrelated to the Apple patents at issue here.

ARGUMENT

I. None of the Transfer Factors as Applied by the Eleventh Circuit and this Court Support Transfer of this Action to Wisconsin

Settled law in the Eleventh Circuit and this Court establishes that Apple must meet a very heavy burden to demonstrate that transfer is warranted.[5] *See, e.g., Manuel v. Covergys Corp.*, 430 F.3d 1132, 1135 (11th Cir. 2005) (setting out the requirement that the party arguing against the forum of the first-filed action "carry the burden of proving compelling circumstances" demonstrating that another forum should decide the case) (internal quotations and citation omitted); *Mason v. SmithKline Beecham Clinical Labs.*, 146 F. Supp. 2d 1355, 1359 (S.D. Fla. 2001) (denying transfer and stating that "[t]he burden is on the defendant, when it is the moving party, to establish that there should be a change in forum"); *Geltech Solns, Inc. v. Marteal, Ltd.*, Civil Action No. 09-81027, 2010 WL 1791423, at *6 (S.D. Fla. May 5, 2010) (denying transfer and stating that "[i]n a motion to transfer, the burden is on the movant to establish that the suggested forum is more convenient") (internal quotations and citation omitted); *Carrizosa v. Chiquita Brands Int'l, Inc.*, Civil Action No. 07-60821, 2007 WL 3458987, at *3 (S.D. Fla. Nov. 14, 2007) (denying transfer and stating that "[i]n a motion to transfer venue, the movant has the burden of persuading the trial court that the transfer is appropriate and should be granted").

[5] Regional circuit law, rather than Federal Circuit law, applies to the general question of transfer of a patent infringement action. *See, e.g., Winner Int'l Royalty Corp. v. Wang*, 202 F. 3d 1340, 1352 (Fed. Cir. 2000) (applying law of regional circuit in upholding district court's denial of transfer motion).

A. This Action Is the First-Filed Action and Apple Must Demonstrate Compelling Circumstances to Warrant an Exception to the First-Filed Rule

The Eleventh Circuit has set out a heavy presumption in favor of the first-filed action in the transfer analysis. *See, e.g., Manuel*, 430 F.3d at 1135 (upholding district court's decision to entertain first-filed declaratory judgment action, noting that "there is a strong presumption across the federal circuits that favors the forum of the first-filed suit under the first-filed rule," and emphasizing that "[w]e are no exception"). The court in *Manuel* stressed that "we require that the party objecting to jurisdiction in the first-filed forum carry the burden of proving 'compelling circumstances' to warrant an exception to the first-filed rule.'" *Id*. (citations omitted). In *Manuel*, the Eleventh Circuit rejected the argument that the plaintiff engaged in forum shopping, stating, "[w]e remain unconvinced that compelling circumstances exist to justify . . . an exception to the well-established first-filed rule." *Id*. at 1136.

It is beyond dispute that Mobility filed this infringement action nearly a month before Apple filed the Wisconsin Action. It is also beyond dispute that Apple filed permissive infringement counterclaims here asserting six patents before it sought transfer of this action two months later. Apple's efforts to persuade this Court to depart from the heavily favored first-filed rule through its vague and unsubstantiated charges of "tying up resources in three disparate jurisdictions" (Apple Br. at 5) are wholly undermined by its own decision to litigate here. Apple has presented no circumstances at all, let alone "compelling" circumstances, to justify departure from the first-filed rule.

B. Mobility's Choice of Forum Should Not Be Disturbed Unless It Is Strongly Outweighed by Other Factors

The Eleventh Circuit has stated that "[t]he plaintiff's choice of forum should not be disturbed unless it is clearly outweighed by other considerations." *Robinson v. Giarmarco & Bill, P.C.*, 74 F.3d 253, 260 (11th Cir. 1996) (affirming denial of transfer motion) (internal

quotations and citation omitted). Where transfer would "merely shift inconvenience from the defendants to the plaintiff," the plaintiff's choice of forum should prevail. *Id*.; *Carrizosa*, 2007 WL 3458987, at *3 (stating that "[t]he movant must . . . show that the balance of convenience strongly favors transfer in order to overcome the presumption in favor of the plaintiff's choice of forum," even where the plaintiff is not resident in the forum and even where the operative facts underlying the cause of action did not occur in the forum) (internal quotations and citation omitted); *see also Omega Patents, LLC v. Lear Corp*., Civil Action No. 07-1422, 2009 WL 1513392, at *4 (M.D. Fla. Jan. 23, 2009) (denying transfer motion and stating that the Eleventh Circuit "continues to credit a Plaintiff's choice of forum, unless clearly outweighed by other considerations," even where the plaintiff is not resident in the forum).[6]

Apple presents no credible evidence of any considerations that outweigh Mobility's choice of forum. Other than its unsubstantiated assertions that transfer will be in the interest of justice (discussed further below), Apple offers only the similarly unfounded argument that the convenience of the parties and witnesses favors transfer. (Apple Br. at 8-9.) But this entire argument rests on Apple's inexplicable assertion that Mobility has "no apparent connection" to this district, despite Mobility's extensive Plantation facility and the design, development, marketing, and support in Plantation of the i1 IDEN phone that Apple has accused of infringement.

C. All Non-Neutral Transfer Factors Weigh Heavily Against Transfer

[6] *Windmere Corp. v. Remington Prods., Inc*. does not support Apple's untenable argument that Motorola's choice of forum should be given "less consideration" here. *See* 617 F. Supp. 8 (S.D. Fla. 1985) (granting transfer where there was no nexus between the facts underlying the action and this District, and transfer was sought to a forum where both defendants were residents and where the operative facts occurred).

1. The Public Interest Weighs Heavily Against Transfer

(a) Mobility's Plantation Location Is the Basis for Its Substantial Connection to this Forum

Mobility's Plantation location is the basis for Mobility's substantial connections to this forum.[7] (*See generally* Masci Decl.; Conroy Decl.) Despite Apple's vague and wholly unsupported charges of forum-shopping (Apple Br. at 7),[8] Mobility's choice of this forum, where it has a substantial connection, was reasonable and legitimate. *See, e.g., Geltech,* 2010 WL 1791423, at *8 (denying transfer and finding that the plaintiff was not "engaging in forum shopping" because it had a "substantial connection" to the forum and because the same federal trademark law would apply in either forum); *see also Mason*, 146 F. Supp. 2d at 1360 (denying transfer and finding that there was no reason to believe that plaintiffs in choosing the forum "sought to harass or oppress Defendants by imposing unnecessary legal expenses on them").

(b) The Consolidation Apple Seeks Is Not in the Interest of Justice

The consolidation Apple seeks will not advance the interest of justice. Instead, consolidation will produce an unworkably large number (33) of patents and an unreasonably

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[7] *Cellularvision Tech. & Telecomms., L.P. v. Alltell Corp*. does not support the proposition that this case might be appropriately transferred to a different forum, such as Apple's home forum. 508 F. Supp. 2d 1186, 1188 (S.D. Fla. 2007) (stressing repeatedly that it was undisputed that the plaintiff had "no direct relationship or connections to the State of Florida other than the presence of its counsel in Florida").

[8] Apple incorrectly characterizes Motorola's arguments in *Research in Motion Ltd. v. Motorola, Inc*., Civil Action No. 08-317 (N.D. Tex.). (Motorola's Notice of Related Case and Motion to Transfer (Ex. S to Cherensky Decl.).) There, RIM had filed two separate declaratory judgment actions in the Northern District of Texas, Dallas Division. The earlier-filed of these actions involved seven Motorola patents, and the later-filed involved four related Motorola patents. Because the actions had been assigned to different judges in the Dallas Division, Motorola sought transfer of the later-filed action to the docket of the judge hearing the earlier-filed action. Contrary to Apple's inaccurate characterization, in the RIM action, Motorola sought to have a single judge (rather than two separate judges in the same district and division) hear RIM's declaratory judgment claims on a group of 11 related Motorola patents. To the extent that the RIM action is relevant in any respect to Motorola's opposition to Apple's transfer motion, Motorola's arguments in the two contexts are wholly consistent.

complicated mixture of technologies and legal issues. (Wisconsin Apple Amended Complaint (Ex. L to Cherensky Decl.); Wisconsin Motorola Answer and Counterclaims (Ex. K to Cherensky Decl.); Delaware Motorola Complaint (Ex. D to Cherensky Decl.); Florida Mobility Complaint (D.I. 1); Florida Apple Answer, Affirmative Defenses and Counterclaims (D.I. 17).) There are no common patents and virtually no overlap of technologies here and in the Wisconsin Action. The essential Mobility patents at issue in the Wisconsin Action raise different technological and legal issues from the non-essential Mobility patents at issue here. The patents Apple asserted here are similarly unrelated to those it asserted in the Wisconsin Action, with the arguable exception of the unlock patent. This patent is related only in a general sense to a subset of the patents at issue in the Wisconsin Action, and has been asserted against the i1 IDEN phone, which was designed and developed, and is marketed and supported at Mobility's Plantation location.

The arguable overlap of the *general technology* of one out of 12 patents at issue here with the three patents Apple originally asserted in the Wisconsin Action is utterly insufficient to justify transfer.[9] This Court has explicitly found that even where some gains in efficiency could be realized from transfer to a different venue, the party moving for transfer must demonstrate that "judicial gains will 'clearly outweigh' Plaintiffs' choice," and that "'the interests of justice' would 'strongly favor' transfer." *Carrizosa*, 2007 WL 3458987, at *4. In *Carrizosa*, this Court found that even where there are some overlapping questions of fact and law, if "specific factual claims" will ultimately predominate, the purported gains in efficiency do not outweigh the

[9] Apple's reliance on *Cont'l Grain Co*. is wholly misplaced. *See Cont'l Grain Co. v. The Barge FBL-58*5, 364 U.S. 19, 26 (1960). (holding that joinder of an *in rem* admiralty proceeding could not prevent transfer of an action to the forum where an earlier-filed action was pending, where all claims arose out of the sinking of a barge, and stating that "two cases involving precisely the same issues" should not simultaneously be pending in different district courts).

plaintiff's choice of forum and transfer should be denied. *See id*.

The Federal Circuit has held that even where the proposed transferee forum is a "well-known patent forum," and "has heard cases involving some of the same patents," if there is no ongoing litigation in the proposed transferee forum "requiring consolidation," judicial efficiency does not weigh in favor of transfer. *See Micron Tech., Inc. v. Mosaid Techs., Inc*., 518 F.3d 897, 905 (Fed. Cir. 2008) (applying transfer factors to reverse district court's dismissal of a first-filed declaratory judgment action in favor of a second-filed infringement action in the Eastern District of Texas). Here, although there is litigation between the parties in Wisconsin, it does not involve any of the same patents and is largely, if not wholly, unrelated. The Federal Circuit in *Mosaid* emphasized that, "[a]pplying the relevant convenience factors, it would be an abuse of discretion to transfer the action." *Id*.

Apple inexplicably relies on *Global Innovation Technology Holdings, LLC v. Acer Am. Corp*., 634 F. Supp. 2d 1346 (S.D. Fla. 2009), to support its untenable arguments that the prospect of consolidation with the Wisconsin Action outweighs the heavy presumption in favor of the first-filed action here. (Apple Br. at 7, 10 n.4.) In *Global Innovation*, this Court, *on the basis of the first-filed rule*, transferred a patent infringement action to the Eastern District of Texas, where an earlier-filed infringement action by the plaintiff was pending. *See Global Innovation*, 643 F. Supp. 2d at 1349 (stating, "[t]he Court hereby TRANSFERS this case to the Eastern District of Texas, in view of the first-filed rule"). Furthermore, in *Global Innovation*, the overlap between the first and second filed actions was extensive: the "exact same" patents were at issue in both cases, and the defendants in the second-filed action were resellers of the

technology developed by the defendants in the first-filed action.[10] *See id*.

(c) Docket Congestion and Speed to Trial Weigh Against Transfer

Contrary to Apple's unfounded speculations regarding docket congestion and speed to trial here and in Wisconsin, these factors either weigh against transfer or are neutral.[11] For civil cases resolved in the twelve months prior to March 31, 2010, the median time to trial here was 15.5 months as compared to 13.8 months in the Western District of Wisconsin. (Federal Judicial Caseload Statistics, March 31, 2010 (Ex. 7) at Table C-5.) But the Southern District of Florida has a shorter overall time to resolution – 3.7 months – than does the Western District of Wisconsin, at 5.4 months. Furthermore, the scheduling order in the Wisconsin Action provides for trial to begin on April 30, 2012 (Wisconsin Preliminary Pretrial Conference Order (Ex. P to Cherensky Decl.) at 7), while this Court has scheduled trial to begin only three and a half months later, on August 13, 2012 (D.I. 45). If this action were transferred and consolidated with the Wisconsin Action, as Apple requests, trial in that action would likely be delayed, as a result of the addition of the twelve patents at issue here, for a total of 33 patents-in-suit.

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[10] Apple's reliance on *Nokia Corp. v. Apple Inc*., is misplaced. *See* Civil Action No. 10-249 (W.D. Wisc. Jan. 5, 2011) (Ex. R to Cherensky Decl.) (transferring action where neither party had any connection to the transferor forum and there was no factual nexus to the transferor forum). In that action neither Nokia nor Apple had a connection to the district in question, a fact that Apple stressed in arguing for transfer out of Wisconsin, repeatedly asserting that it had "no corporate offices or research facilities in Wisconsin," "lack[ed] any meaningful contacts with Wisconsin," and did "not conduct relevant operations or maintain relevant facilities in Wisconsin." (Wisconsin Apple Motion to Transfer Nokia Case (Ex. 6) at 7.) Apple also relies on *Abbott Labs. v. Selfcare, Inc*., an unpublished opinion from the Northern District of Illinois, that is equally inapposite. Civil Action No. 98-7102, 1999 WL 162805 (N.D.Ill. Mar. 15, 1999) (transferring a declaratory judgment action to the forum where a related infringement action was pending and where plaintiff in the transferee forum was seeking to add the patents at issue in the Northern District of Illinois to the complaint).

[11] In any event, Apple's own conduct undermines its arguments that speed to trial supports its transfer request. Apple did not initiate the Wisconsin action until nearly a month after Motorola initiated this action, and did not amend its complaint there to assert twelve additional patents until nearly two months later.

2. The Locus of Operative Facts Weighs Against Transfer

This Court has held that where there is "no factual nexus exclusively surrounding" the proposed transferee forum, this factor does not weigh in favor of transfer. *See Stiefel Labs., Inc. v. Galderma Labs., Inc*., 588 F. Supp. 2d 1336, 1340 (S.D. Fla. 2008). Apple has presented no evidence of any nexus with Wisconsin. And with good reason. Apple's assertions, in a recent motion to transfer a case out of Wisconsin, that it had "no corporate offices or research facilities in Wisconsin," "lack[ed] any meaningful contacts with Wisconsin," and did "not conduct relevant operations or maintain relevant facilities in Wisconsin," effectively preclude it from proffering any contrary argument here. (Wisconsin Apple Motion to Transfer Nokia Case (Ex. 6) at 7.) In fact, the only evidence of any factual nexus with either forum is the evidence Mobility has presented of the nexus of this forum with one of the accused products, the i1 IDEN mobile phone, which was designed and developed, and is marketed and supported here. (Conroy Decl.; Masci Decl.) This factor therefore weighs against transfer.

3. The Location of Relevant Documents and the Relative Ease of Access to Sources of Proof Weighs Against Transfer

In general, given the "current world of expedited transfer of information," the location of documents and the ease of access to sources of proof does not figure prominently in the transfer analysis. *See Stiefel*, 588 F. Supp. 2d at 1340. Nonetheless, the only evidence presented regarding the location of any relevant documents in either forum is Mobility's evidence that documents relevant to the i1 IDEN phone are located in this district. (Conroy Decl. ¶ 12.) Therefore this factor weighs against transfer.

4. The Convenience of the Witnesses and the Parties Weighs Against Transfer

Apple's erroneous arguments that the convenience of the witnesses and parties favors transfer are based on its inexplicable misstatement that "Motorola has no apparent connection to

the Southern District of Florida." (Apple Br. at 8.) Apple goes on to assert, equally incorrectly, that "[n]one of the potential witnesses or sources of evidence in this case are likely to be located in Florida." (Apple Br. at 8.) Apple's speculative and unsubstantiated discussion of the possible residences of various inventors of the patents at issue should be disregarded, both because Apple has submitted no evidence in support and also because the general convenience of witnesses, in contrast to the availability of compulsory process, is not a significant factor in the transfer analysis. *See, e.g., Stiefel,* 588 F. Supp. 2d at 1340; *Mason,* 146 F. Supp. 2d at 1361.

5. The Forum's Familiarity with the Governing Law Is Neutral

Because federal patent law is at issue in this case, this factor is neutral.

II. Apple Has Failed to Meet its Heavy Burden Under the Doctrine of *Forum Non Conveniens* to Demonstrate that Mobility's Choice of Forum Should Be Disturbed

This Court has stated that "[a] court conducting *forum non conveniens* analysis must begin with the premise that the plaintiff's choice of forum rarely should be disturbed." *Del Monte Fresh Produce Co. v. Dole Food Co., Inc.*, 136 F. Supp. 2d 1271, 1276 (S.D. Fla. 2001) (denying motion to dismiss on *forum non conveniens* grounds). The *forum non conveniens* factors essentially parallel the transfer factors under 28 U.S.C. § 1404, and this Court has described 28 U.S.C. § 1404(a) as the "statutory codification of the common law doctrine of *forum non conveniens*." *Id*. at 1281. The party seeking dismissal on *forum non conveniens* grounds bears the burden of showing that (1) an adequate alternative forum exists; (2) relevant public and private interests weigh in favor of dismissal; and (3) the plaintiff can reinstate the suit in the alternative forum without undue inconvenience or prejudice. *See, e.g., Biologics, Inc. v. Wound Systems, LLC,* Civil Action No. 09-362, 2009 WL 997239, at *3 (M.D. Fla. Apr. 14, 2009) (denying motion to dismiss on *forum non conveniens* grounds and denying transfer on the grounds that defendant had not met its burden for dismissal or transfer). Because Apple has not

met its burden to demonstrate that there is any justification to disturb Mobility's choice of forum, either through transfer or through dismissal on *forum non conveniens grounds*, its *forum non conveniens* motion, like its transfer motion, should be denied.[12]

CONCLUSION

For the foregoing reasons, Motorola respectfully requests that the Court deny Apple's motion to transfer venue or dismiss on *forum non conveniens* grounds.

[12] *Meterlogic, Inc. v. Copier Soln's, Inc*. does not support Apple's unfounded argument that dismissal on *forum non conveniens* grounds is warranted here. *See* 185 F. Supp. 2d 1292 (S.D. Fla. 2002) (granting transfer where jurisdiction over parents of defendant corporations was available only in the transferee forum and where a related action filed by plaintiff against the corporate parents was pending).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on February 3, 2011, I served the foregoing document via a Notice of Electronic Filing generated by CM/ECF to all counsel of record on this case.

/s/ Douglas J. Giuliano
Douglas J. Giuliano