

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

**ROCKSTAR CONSORTIUM US LP  
AND NETSTAR TECHNOLOGIES  
LLC**

**Plaintiffs,**

**v.**

**GOOGLE INC.**

**Defendant.**

**Case No. 2:13-cv-00893-JRG-RSP**

**JURY TRIAL DEMANDED**

**PLAINTIFFS' SUPPLEMENTAL BRIEF**  
**IN RESPONSE TO GOOGLE'S MOTION TO TRANSFER**

In its Motion to Transfer, Google argued that “[k]ey witnesses” regarding prior art “likely” resided in the Northern District of California. Mot. at 3. Google served its Invalidity Contentions on May 23, 2014, and several subpoenas in June 2014, after transfer briefing was complete. *See* Bonn Decl. Exh. 2. Far from showing a locus of witnesses in the Northern District of California, Google’s contentions confirm that prior art witnesses are spread throughout the country and even internationally, with many residing in subpoena range of this Court. Few such witnesses appear to be located in California. *See* Exh. 1.<sup>1</sup>

**Prior Art Patents.** Four inventors and two assignees of alleged prior art patents or patent applications appear to reside in Texas within subpoena range of this Court. Exhs. 1, 6, 31. By contrast, only three inventors of a single patent and two assignees appear to reside in California. Exhs. 1, 7-8, 10, 41. Of the remaining inventors, eight appear to reside in New York, two in New Jersey, two in Oregon, two in Japan, one in Colorado, and one in Connecticut. Exhs. 1, 3, 7, 10, 14, 22.

**Prior Art Publications.** The authors of alleged printed publication prior art appear to be scattered throughout the country in Maryland, New York, Oregon, Tennessee, and Virginia. Exhs. 1, 5, 8-10, 16, 32-36, 45, 66. In addition, many authors appear to be located abroad, including in Canada, Denmark, Finland, Poland, South Korea, and the United Kingdom, and Japan. Exhs. 1, 15, 17, 21, 23, 24-27, 37, 42. Not one is in California.

**Prior Art “In Use” Systems.** Finally, Google asserted that it intended to rely on prior “use” systems. Reply at 1. But Google’s Invalidity Contentions bely its suggestion that witnesses relevant to such alleged “use” art are primarily located in California. The AdaptX System was developed in New Jersey. Exhs. 1-3. DoubleClick, which Google now owns, appears to have

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<sup>1</sup> For the Court’s convenience, Plaintiffs submit as Exhibit 1 a chart summarizing the apparent locations of the authors, inventors, owners, and assignees of Google’s asserted prior art references.

been developed in New York and not California. Exh. 1, 11-12. Excite is now owned by IAC, a company based in New York. Exhs. 1, 13, 56. HealthGate is owned by HealthGate Data Corp. in Burlington, Massachusetts. Exhs. 1, 18, 54. The SMART system was developed by Cornell University in Ithaca, New York. Exhs. 1, 5. Submit-It! was developed in Bedford, Massachusetts, and has since been acquired by Microsoft in Redmond, Washington. Exhs. 1, 13, 39-40. Lycos appears to have been developed in Waltham, Massachusetts, and then acquired by various companies in Spain, South Korea, and India. Exhs. 1, 13, 43. WebCrawler appears to be headquartered in Bellevue, Washington. Exhs. 1, 13, 44, 51. Open Text is owned by Open Text Corp., which is based in Ontario, Canada and has offices in New York. Exhs. 1, 29-30. And while Google asserted in its transfer briefing that Infoseek witnesses were likely to be in California, it appears that certain of Infoseek's assets were acquired by a Autonomy Corp. (and later HP Autonomy), headquartered in the United Kingdom. Exhs. 1, 13, 20, 55. Of the remaining systems, three appear to be owned by one company, Yahoo!, in California (*e.g.*, Alta Vista, HotBot, and Yahoo!) and one is owned by Google (*e.g.*, NetGravity). Exhs. 1, 13.

**Subpoenas.** Google has recently served six subpoenas relating to prior art in New York, one in Georgia, one in Massachusetts, one in Oklahoma, one in Tennessee, and one in Washington. Exhs. 52, 54, 56-59, 61-62, 64-65. Only four of its fourteen subpoenas relating to prior art were served in California.<sup>2</sup> Exhs. 53, 55, 60, 63.

Google refused to represent in its transfer motion that most or even many of the prior art witnesses are located in the Northern District of California, asserting only that an unknown number of such “[k]ey witnesses” reside there. Mot. at 3. Google’s Invalidity Contentions and subpoenas demonstrate why: such witnesses live throughout the country (as well as in Canada,

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<sup>2</sup> Similarly, Google has attempted to serve subpoenas on the inventors of the asserted patents as well as patent prosecution counsel—persons who reside in the Eastern District of Texas, Florida, and Canada. Exhs. 46-50.

Europe, and Asia) and few reside in California. Indeed, it appears that four inventors and two assignees of two prior art patents are located in Texas within subpoena range of this Court. Exhs. 1, 6, 31. “[T]he relevance and materiality of these witnesses turns on more than prior art,” as prior licenses or attempts to license such patents could potentially “be germane to a standard reasonable royalty analysis.” *Innoband, Inc. v. Aso Corp.*, No. 10-CV-191-TJW-CE, 2011 WL 835934, at \*4 (E.D. Tex. March 4, 2011) (Everingham, J.) (citing *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1119-20 (S.D.N.Y. 1970)). This is yet another potential source of proof that is more readily accessed from the Eastern District of Texas than from the Northern District of California. *Id.*

Google failed to demonstrate why the fact that a handful of potential prior art witnesses reside in California—while dozens of others reside in Texas, elsewhere throughout the United States, and even internationally—merits transfer. *j2 Global Comm’s, Inc. v. Protus IP Solutions, Inc.*, No. 08-CV-211, 2009 WL 440525, at \*5 (E.D. Tex. Feb. 20, 2009) (Love, J.) (“Because the prior art witnesses are spread throughout the world, the [Northern] District of California is no more convenient than the Eastern District of Texas for these witnesses.”). To the contrary, and particularly in light of newly-amended Rule 45, “regardless of whether this case remains in E.D. Tex. or gets transferred to N.D. Cal., Defendant[] would be able to secure the attendance of [its] identified non-party witnesses at least through deposition.” *VirtualAgility, Inc. v. Salesforce.com, Inc.*, No. 13-cv-00011-JRG, 2014 WL 459719, at \*5 (E.D. Tex. Jan. 31, 2014) (Gilstrap, J.) (denying motion to transfer).

For the foregoing reasons—in addition to those set forth in Plaintiffs’ prior briefing—the Court should deny Google’s Motion to Transfer.

DATED: June 20, 2014

Respectfully submitted,

By: /s/ Amanda K. Bonn

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**CERTIFICATE OF SERVICE**

I hereby certify that all counsel of record, who are deemed to have consented to electronic service are being served this 20<sup>th</sup> day of June, 2014, with a copy of this document via the Court's CM/ECF system per Local Rule CD-5(a)(3).

/s/ Amanda K. Bonn  
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