



## I. BACKGROUND FACTS

### A. This Dispute Has No Meaningful Connection to the Eastern District of Texas

Innovative Sonic has no apparent contact with the Eastern District of Texas. Innovative Sonic is "a corporation organized and existing under the laws of the Republic of Mauritius." (Dkt. No. 1 (Complaint) at ¶ 1). Its principal place of business is in the "Republic of China." (*Id.*) Its employees appear to reside exclusively in the Republic of China, and its lead counsel (Mr. Ronald S. Lemieux) is based in Northern California.<sup>1</sup> (*Id.*) On information and belief, Plaintiff has no offices, employees, operations or files in the Eastern District.

Like Plaintiff, neither of the RIM defendants or the accused subject matter have substantial ties to the Eastern District. None of the accused products were developed in the Eastern District of Texas or have any special relationship to the district. (Declaration of Barbara Parvis ("Parvis Decl.") ¶ 16). RIM's accused products are sold nationwide through third parties such as phone carriers, and those sales include the Eastern District. But aside from that unremarkable fact, this lawsuit has no meaningful connection to this district or Court.

### B. This Dispute Has a Substantial Connection to the Northern District of Texas

The Northern District, by contrast, has strong connections to and a unique interest in this lawsuit. RIM Corporation, the only domestic party to this action, has its headquarters in Irving, Texas – which is located squarely in the Northern District. (Parvis Decl. ¶ 2). Much of the subject matter implicated by Plaintiff's Complaint in this action, including the RIM products accused of infringement and the development and sale of such products, are closely linked to the Northern District of Texas. RIM Corporation's Irving, Texas campus is the location for significant activities related to the manufacture and sale of RIM's accused products. It is where RIM Corporation houses many of its research and development and customer service employees, as well as members of its Global Department of Licensing and Standards. (Parvis Decl. ¶ 8). It is where documents, records, and certain manufacturing activities relating to the accused

---

<sup>1</sup> Plaintiff's Complaint designates Mr. Otis Carroll as its Attorney-in-Charge. On information and belief, the lead counsel for Plaintiff Innovative Sonic is Mr. Lemieux.

products can be found or accessed. (Parvis Decl. ¶¶ 3, 8, & 10). Indeed, Irving, Texas is the location where representatives of Plaintiff and RIM engaged in a face-to-face meeting prior to the filing of this lawsuit. (Parvis Decl. ¶ 4).

Moreover, the Northern District also provides more convenient travel options for the both Innovative Sonic and RIM. Innovative Sonic and defendant Research In Motion Limited ("RIM Limited") are foreign entities based in Taiwan and Canada, respectively. (Dkt. No. 1 (Complaint) at ¶ 1); (Dkt. No. 17 (RIM Answer) at ¶ 2 of Counterclaims). The Northern District provides convenient access to an international airport with several daily flight options for witnesses and representatives from these entities to attend or otherwise participate in proceedings in this matter.

The Fifth and Federal Circuit Courts of Appeal have routinely required transferring to the more convenient venue under facts far less compelling.

## II. LEGAL STANDARD

As this Court is well aware, 28 U.S.C. § 1404(a) provides that "[f]or the convenience of 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." The standard calls on courts to transfer cases when the transferee forum is "clearly more convenient" than the venue chosen by the plaintiff. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). Regional circuit law applies to the determination of transfer. *Id.*

Under Fifth Circuit law, the plaintiff's choice of forum is not dispositive; instead, public and private interest factors are weighed in the convenience determination. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 314 (5th Cir. 2008) ("*Volkswagen II*") (citing *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 67 S. Ct. 839 (1947) (en banc)). "The private interest factors are: '(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious and inexpensive.'" *Id.* at 315 (quoting *In re Volkswagen AG* ("*Volkswagen I*"), 371 F.3d 201, 203 (5th Cir. 2004)). "The

public interest factors are: '(1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws [in] the application of foreign law.'" *Id.* (quoting *Volkswagen I*, 371 F.3d at 203).

These factors are discussed in detail below, but it is worth noting that a single factor supports retaining this case in the Eastern District. Under the facts before this Court and the foregoing precedent, transfer is necessary for the convenience of the parties and witnesses.

### III. ARGUMENT

#### A. Defendants Have Met the Burden of Overcoming Any Deference That Plaintiff's Choice of Forum May be Entitled to

Innovative Sonic brought its complaint in the Eastern District. But the convenience factors substantially point to the Northern District. The Federal Circuit has made clear that the combination of parties and witnesses being located in or near the transferee venue and a lack of parties and witnesses in the plaintiff's chosen venue is an important consideration. *In re Acer Am. Corp., et al.*, 626 F.3d 1252, 1254-55 (Fed. Cir. 2010). Further, under Fifth Circuit law, the plaintiff's choice of venue is not a distinct factor in the venue transfer analysis, but instead is represented in the movant's burden. *Volkswagen II*, 545 F.3d at 315. Among the four private interest and four public interest factors analyzed below, every factor that impacts the current analysis favors transferring this matter to the Northern District.

#### B. Private Interest Factors: Easy Access to Sources of Proof and the Convenience of the Parties and Witnesses Heavily Favor Transfer to the Northern District

**Access to Sources of Proof:** No physical evidence relevant to this matter appears to be stored in the Eastern District. Other than an empty warehouse that RIM Corporation owns, through a subsidiary, in Plano, Texas, RIM does not own or lease any office space within the boundaries of the Eastern District of Texas. (Parvis Decl. ¶¶ 13, 14). Innovative Sonic, a company that operates out of Taiwan, has no apparent operations or employees in this district.

By contrast, RIM Corporation has substantial operations in the Northern District of Texas relating to the accused BlackBerry devices. RIM Corporation's licensing and standardization group is based in Irving, Texas, and manufacturing activities and records relating to the accused products are similarly located in or accessible from the Northern District. (Parvis Decl. ¶¶ 3, 8, & 10). Moreover, the Northern District is where the parties conducted their pre-suit negotiation and the place of employment of the RIM Corporation employees involved in the negotiation. (Parvis Decl. ¶¶ 4, 5). Transferring the present action to the Northern District of Texas—where many of the activities associated with the accused products occurred and where RIM's United States business operations are headquartered—would be significantly more convenient. *In re Genentech, Inc.*, 566 F.3d 1338, 1346 (Fed. Cir. 2009) (finding that because the majority of the evidence typically comes from the accused infringer, "the place where the defendant's documents are kept weighs in favor of transfer to that location") (citation omitted); *see also On Semiconductor Corp. v. Hynix Semiconductor, Inc.*, No. 6:09-cv-390, 2010 WL 3855520 at \*2 (E.D. Tex. Sept. 30, 2010) ("This factor will turn upon which party, usually the accused infringer, will most probably have the greater volume of documents relevant to the litigation and their presumed location in relation to the transferee and transferor venues.").

**Subpoena Power of the District:** The second factor concerns the court's ability to compel witnesses to attend trial. The Federal Circuit has noted that where there are far more witnesses within the subpoena power of the transferee district, that fact would favor transfer: "[t]he fact that the transferee venue is a venue with usable subpoena power [] weighs in favor of transfer, *and not only slightly.*" *In re Genentech*, 566 F.3d at 1345 (emphasis added). RIM is not currently aware of any relevant third-party witnesses within the subpoena power of this Court. With respect to potential party witnesses, RIM believes the Northern District will have subpoena power over all employees at RIM Corporation's Irving facilities. Accordingly, this factor favors transfer. *See Lindloff v. Schenectady Int'l*, 950 F. Supp. 183, 185-86 (E.D. Tex. 1996) (holding that where the court would lack subpoena power "over any of Defendant's officers or employees who are outside the Eastern District and who might be unwilling to appear at trial . . . [and] it

does not appear that the Galveston court will have this problem, this factor favors the transfer of this case to Galveston").

**Convenience and Costs of Travel:** The convenience for and cost of attendance of witnesses is an important factor in the transfer analysis. *In re Genentech, Inc.*, 566 F.3d at 1343. Courts in the Fifth Circuit have recognized that the greater the distance, the more inconvenient and costly it is for witnesses to attend trial. In particular, "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." *In re Volkswagen II*, 545 F.3d at 317 (citations omitted). Accordingly, the Fifth Circuit observes a 100-mile rule, which provides 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." *Id.*

The Northern District has a distinct advantage with regards to convenience and costs of travel for this matter. RIM Corporation has its U.S. headquarters in the Northern District and it would be far more convenient for its witnesses to attend court proceedings in that forum. (Parvis Decl. ¶¶ 2, 11). Specifically, RIM Corporation's headquarters in Irving, Texas are located approximately 12 miles from the courthouse for the United States District Court for the Northern District of Texas, Dallas Division, versus approximately 110 miles from the courthouse for the United States District Court for the Eastern District of Texas, Tyler Division. (Declaration of Li Chen ("Chen Decl."), Exhs. 1 and 2). It will be much more convenient for RIM Corporation's employees based in Irving—who will have relevant information and documents related to RIM's claims and/or defenses—to attend trial in Dallas rather than in Tyler. (Parvis Decl. ¶ 11). If RIM Corporation's employees based in Irving must attend a trial in Tyler, they will likely need to make overnight travel arrangements and incur expenses for accommodations, meals, and travel. *Id.*

RIM employees traveling from outside of Texas will also save time and expense if the trial is in Dallas instead of Tyler due to the availability of a large number of direct flights to the Dallas/Fort Worth International Airport ("DFW Airport"). (Chen Decl., Exh. 3). Moreover, RIM Corporation's Irving facility can provide temporary office space for visiting employees as well as access to the RIM internal computer network and other necessary resources such as assistants, conference rooms, and videoconferencing to allow these employees to continue their work during trial. (Parvis Decl. ¶ 12).

Indeed, the Northern District is also more convenient and cost-efficient for Plaintiff than the Eastern District. There are several daily flight options into DFW Airport from Taiwan, where Innovative Sonic is based. (Chen Decl., Exh. 4). While a connection to Tyler could be had from DFW Airport, the connection adds both travel time and inconvenience. (Chen Decl., Exh. 5). These travel options make a material difference for foreign witnesses attending a hearing or trial in this matter. *See, e.g., Volkswagen II*, 545 F.3d at 317 ("Witnesses not only suffer monetary costs, but also the personal costs associated with being away from work, family, and community."). The presence of potential witnesses and RIM Corporation's headquarters within the Northern District, and the convenience of DFW Airport, weigh this factor in favor of transfer.

**Practical Problems:** No other practical problems appear relevant to this transfer analysis. *In re Horseshoe Entm't*, 337 F.3d 429, 434 (5th Cir. 2003) (finding this factor is only applicable "in rare and special circumstances" and only if "such circumstances are established by clear and convincing evidence."). The present lawsuit is in its infancy. The Court only recently issued an order setting the date for the initial scheduling conference in this action. (Dkt. No. 24 (Order Setting Scheduling Conference), entered Feb. 2, 2011). Because this Court has not yet invested significant resources in the merits of the case, transfer should not pose any burden on the judicial system or result in any significant delay. *Rich v. S. Gulf Operators*, 879 F. Supp. 49, 51 (E.D. Tex. 1995) ("Additionally, the case is in its early stages, so there is little chance that a

transfer of venue would create appreciable delay or prejudice."). At the very least, this factor does not pose any obstacles to transfer.

**C. The Public Interest Factors: The Northern District's Unique Localized Interest in the Case Favors Transfer**

**Relative Congestion of the Court Dockets:** "To the extent that court congestion is relevant, the speed with which a case can come to trial and be resolved may be a factor." *In re Genentech*, 566 F.3d at 1347. This case is likely to be tried more expeditiously in the Northern District because that forum has less congestion. Recent statistics reflect significantly heavier caseloads faced by jurists in the Eastern District (463 pending cases per judge), as compared to those in the Northern District (377 pending cases per judge). (Chen Decl., Exh. 6). These statistics also show that the average time from filing to trial for civil cases is slightly less in the Northern District (20 months) versus the Eastern District (22 months). (*Id.*) The lack of congestion in the Northern District weighs slightly in favor of a transfer to that forum, or, at a minimum, makes this factor neutral.

**Localized Connection:** The Northern District has an obvious connection and substantial local interest in adjudicating this case. RIM Corporation has its U.S. headquarters and principal place of business in Irving, which is located within the Northern District. (Parvis Decl. ¶ 2). RIM Corporation's Irving, Texas offices house many of RIM Corporation's Global Department of Licensing and Standards employees, as well as many research and development and customer service employees. (Parvis Decl. ¶ 8). The Northern District has a very strong and unique connection to this matter. *See Cypress/Spanish Fort I, L.P. v. Prof'l Servs., Indus., Inc.*, 2010 WL 3766882, at \*3 (N.D. Tex. Sept, 27, 2010) (noting that the location of a party's principal place of business gives a particular district a strong interest in the matter in question); *see also Colorquick, L.L.C. v. Vistaprint Ltd.*, 2010 WL 5136050, at \*6 (E.D. Tex. July 22, 2010).

By contrast, the Eastern District has virtually no connection to this case. No research or development of the accused products occurred in the Eastern District. (Parvis Decl. ¶ 16). As discussed above, other than an empty warehouse that RIM Corporation, through a subsidiary,



owns in Plano, Texas—a warehouse that is currently on the market for resale—the Eastern District has no apparent significant ties to the parties. While the accused products are offered for sale within this district, a circumstance shared with every other United States judicial district, "the sale of an accused product offered nationwide does not give rise to a substantial interest in any single venue." *In re TS Tech USA Corp.*, 551 F.3d at 1321.

The strong and particular connection of the Northern District to this matter favors transfer.

**Familiarity of Law and Conflict of Law:** Both the Eastern and Northern District Courts are capable of applying federal patent law. *In re TS Tech*, 551 F.3d at 1320 ("[P]atent claims are governed by federal law,' and as such 'both [courts are] capable of applying patent law to infringement claims.'") (citation omitted). Transfer of this action will not present any conflict of laws issues. *Id.* at 1320. Moreover, like the Eastern District, the Northern District courts also have a set of special rules that they follow in patent cases. These last two public interest factors are neutral.

#### IV. CONCLUSION

The relevant public and private convenience factors substantially weigh in favor of transferring this matter to the Northern District. Not one factor supports keeping the matter in the Eastern District. This lawsuit should be transferred to the Northern District of Texas.

Dated: March 16, 2011

Respectfully submitted,

By: /s/ Li Chen

Li Chen  
Texas Bar No. 24055297  
Email: [lchen@sidley.com](mailto:lchen@sidley.com)  
Tung T. Nguyen  
Texas Bar No. 24007745  
Email: [tnguyen@sidley.com](mailto:tnguyen@sidley.com)  
**SIDLEY AUSTIN LLP**  
717 N. Harwood Street, Suite 3400

Dallas, TX 75201  
Tel: (214) 981-3300  
Fax: (214) 981-3400

David T. Pritikin  
Illinois Bar No. 2256339  
Email: [dpritikin@sidley.com](mailto:dpritikin@sidley.com)  
**SIDLEY AUSTIN LLP**  
Bank One Plaza  
One South Dearborn Ave  
Chicago, IL 60603  
Telephone: 312-853-7359  
Facimile: 312-853-7036

Edward G. Poplawski  
California Bar No. 113590  
Email: [epoplawski@sidley.com](mailto:epoplawski@sidley.com)  
**SIDLEY AUSTIN LLP**  
555 West Fifth Street  
Los Angeles, CA 90013  
Tel: (213) 896-6000  
Fax: (213) 896-6600

Eric Hugh Findlay  
Texas Bar No. 00789886  
Email: [efindlay@findlaycraft.com](mailto:efindlay@findlaycraft.com)  
Roger Brian Craft  
Texas Bar No. 04972020  
Email: [bcraft@findlaycraft.com](mailto:bcraft@findlaycraft.com)  
**FINDLAY CRAFT**  
6760 Old Jacksonville Hwy, Suite 101  
Tyler, TX 75703  
Tel: (903) 534-1100  
Fax: (903) 534-1137

**ATTORNEYS FOR DEFENDANTS  
RESEARCH IN MOTION LIMITED AND  
RESEARCH IN MOTION CORPORATION**

**CERTIFICATE OF CONFERENCE**

On March 15, 2011, counsel for Defendants Research in Motion Limited and Research in Motion Corporation conferred with counsel for Plaintiff Innovative Sonic Limited via teleconference regarding the foregoing motion and thereby complied with the meet and confer requirement in Local Rule CV-7(h). Subsequent to the teleconference, Plaintiff's counsel indicated that Plaintiff will not oppose the foregoing motion to transfer of venue in this matter.

*/s/ Li Chen* \_\_\_\_\_

**CERTIFICATE OF SERVICE**

I hereby certify on this 16th day of March, 2011, that a copy of the foregoing was filed electronically in compliance with Local Rule CV-5(a). As such, this document was served on all counsel of record who have consented to electronic service through the Court's CM/ECF system pursuant to Local Rule CV-5(a)(3).

*/s/ Li Chen* \_\_\_\_\_