UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TYLER DIVISION

UNILOC USA, INC. and **UNILOC SINGAPORE PRIVATE LIMITED**, Plaintiffs, v. **NATIONAL INSTRUMENTS, INC., et al.,** Defendants.	Civ. Action No.: 6:10-cv-00472 LED **JURY TRIAL DEMANDED**

PLAINTIFFS' OPPOSITION TO DEFENDANTS'
MOTION TO TRANSFER VENUE PURSUANT TO 28 U.S.C. § 1404

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Federal Cases

Statutes

Rules

Plaintiffs, Uniloc USA, Inc. and Uniloc Singapore Private Ltd. (together "Uniloc"), respectfully submit this opposition to the motion of certain defendants to transfer this case to the District of Rhode Island pursuant to Fed. R. Civ. P. 1401(a).[1/] For the reasons set forth herein, defendants' motion should be denied.[2/]

I. INTRODUCTION.

Defendants neither prove that this case "might have been brought" in the District of Rhode Island, nor that Rhode Island is "clearly more convenient" than this District for all parties and witnesses. As a threshold matter, defendants fail to offer any reliable evidence that any one of them is subject to personal jurisdiction in Rhode Island. Defendants' conclusory declarations asserting that they have offered for sale and/or sold accused product in Rhode Island are insufficient to make out a *prime facie* case of personal jurisdiction. Failure to meet this threshold requirement alone is an independent ground for denying their motion.

Defendants mistakenly attempt to meet their burden of showing that the transferee forum is *clearly* more convenient by relying on briefs filed by different defendants, *Sony et al.*, in a different case. Proper analysis of whether to transfer under Section 1404(a), however, requires a fact-intensive analysis of, at a minimum, the location of party witnesses, non-party witnesses and evidence. As defendants in this case fail to submit any evidence specific to them, they cannot meet their burden of showing that Rhode Island is clearly more convenient in this case. Defendants' failure in this regard provides another independent basis for denying their motion.

With respect to the convenience, defendants concede that they are "located throughout the country." Defs' br., p. 2. However, with a dozen defendants in the six Uniloc cases pending

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1/ Defendant FileMaker, Inc. has filed a separate Joinder to the present motion. According to moving defendants, defendant Pervasive Software, Inc., based in Texas, does not oppose their motion. Defs' br., p. 1.

2/ Defendants failed to meet-and-confer with Uniloc's counsel prior to filing their motion as required by Local Rule 7(h) and, further, failed to attach a Certificate of Conference at the end of the motion as required by Local Rule 7(i). On this basis alone, their motion should be denied.

in this District residing in this State, and none residing in Rhode Island, these cases have a strong Texas connection. Thus, it cannot seriously be argued that transfer will decrease travel expenses, distances traveled and time away from home.

Additionally, the fact that the patent-in-suit was litigated years ago in the District of Rhode Island does not mandate transfer to that district. The Federal Circuit recently explained that a court's knowledge gained from litigation is perishable in nature and the lapse in time between two suits involving the same patent would result in no judicial efficiency because the same court would be forced to relearn a considerable amount. Regardless, judicial economy does not, by itself, weigh so heavily in favor of transfer as to nullify all of the other public and private factors that weigh heavily against transfer. Accordingly, defendants fail to satisfy their heavy burden of proving the convenience of the parties and witnesses and interest s of justice warrant transfer.

II. FAILURE TO PROVE THAT UNILOC COULD HAVE BROUGHT SUIT IN RHODE ISLAND IS FATAL TO DEFENDANTS' MOTION.

The "threshold question" when analyzing a case's eligibility for 1404(a) transfer is "whether the judicial district to which transfer is sought would have been a district in which the claim could have been filed." *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004). When the answer to this threshold question is "no," the motion for transfer should be denied without further analysis of the Section 1404(a) factors. *See*, *e.g.*, *Chirife v. St. Jude Med., Inc.*, 2009 U.S. Dist. LEXIS 50482 at 3-4 (E.D. Tex. Jun. 16, 2009).

Defendants have failed to prove that they are <u>all</u> subject to specific or general jurisdiction in Rhode Island. First, no evidence at all was submitted by defendant Pervasive Software regarding Pervasive's amenability *vel non* to jurisdiction in Rhode Island. Thus, defendants have failed to show that Uniloc could have filed against Pervasive in Rhode Island and their motion

should be denied. *Id.* The declarations submitted by the other defendants are equally lacking. While each declares that it has offered for sale and/or sold at least one accused product in Rhode Island, *see* Defs' Exs. 6-14, none has made the requisite statement that an accused product was sold in Rhode Island prior to Uniloc filing this lawsuit. *See, e.g. Liaw Su Teng v. Skaarup Shipping Corp.*, 743 F.2d 1140, 1149 (5th Cir. 1984) (transfer analysis focuses on the situation that existed at the time suit was brought). Moreover, the Rhode Island District Court has explained that, even had one online sale occurred, such a sale would be "the kind of fortuitous, random, and attenuated contact that the Supreme Court has held insufficient to warrant the exercise of jurisdiction." *Swarowski Optik N. Am. Ltd. v. Euro Optics, Inc.*, 2003 U.S.Dist. Ct. LEXIS, at *26 (D.R.I. Aug. 25, 2003).[3/] As defendants failed to show that jurisdiction would have been proper in Rhode Island over all defendants, this case cannot be transferred. *Acceleron, LLC v. Egenera, Inc.*, 634 F. Supp. 2d 758, 764-65 (E.D. Tex. 2009).

III. RHODE ISLAND IS NOT CLEARLY MORE CONVENIENT.

Defandants bear the burden of showing that "good cause" exists for transferring Uniloc's case and must do so by proving that Rhode Island is "clearly more convenient." *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). If defendants fail to show that Rhode Island is clearly more convenient, Uniloc's choice of this forum should be respected. *In re Volkswagen of Am., Inc.*, 545 F.3d 303, 315 (5th Cir. 2008) ("[t]his 'good cause' burden reflects the appropriate deference to which the plaintiff's choice of venue is entitled.") Defendants' generalized and factually unsupported allegations fail to satisfy their burden.

The Fifth Circuit Court of Appeals has adopted the private and public factors enunciated in *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 67 S. Ct. 839, 91 L. Ed. 1055 (1947), as appropriate

[3/] Federal Circuit and First Circuit law are controlling on this issue. *Silent Drive, Inc. v. Strong Indus., Inc.*, 326 F.3d 1194, 1200-01 (Fed. Cir. 2003); *3D Sys., Inc. v. Aarotech Laboratories, Inc.*, 160 F.3d 1373, 1377 (Fed. Cir. 1998).

for determining whether a §1404(a) transfer is for the convenience of parties and witnesses and in the interest of justice. *In re Volkswagen*, 545 F.3d at 315. However, the *Gilbert* factors are not necessarily exhaustive or exclusive, and none "can be said to be of dispositive weight." *Id.* These factors are addressed below.

A. The Private Factors Weigh Against Transfer.

The private interest factors are: (1) the relative ease of access to sources of proof; (2) the availability of compulsory process; (3) the cost of attendance for willing witnesses; and (4) all other practical problems.[4] *Id.* None of these factors weighs in favor of transfer.

1. The relative ease of access to sources of proof weighs against transfer.

Courts have recognized that in patent cases the accused infringer's documents normally amount to "the bulk of relevant evidence". *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009). Defendants' motion to transfer is highly unusual in that no documents of any of the moving defendants are alleged to be located in the proposed transferee venue. Defendants make no showing of any other evidence or witnesses located in Rhode Island. This is not surprising, since none of the defendants is located in Rhode Island.

Two of the defendants (National Instruments and Pervasive), however are headquartered in Austin, Texas. The remaining defendants are located throughout the country and in Israel. Further, none of the defendants is incorporated in Rhode Island and none has a place of business or an employee in Rhode Island. As two defendants reside in Texas, relevant evidence regarding the design, functionality, technical specifications, sales and marketing of their respective accused products is clustered in and around this District.

[4] As in most patent cases, the third and fourth public factors, familiarity of the forum with the law that will govern the case and the avoidance of unnecessary problems of conflict of laws, are neutral. Defendants do not assert that there are "other practical problems" at issue and Uniloc is unaware of any and as such this factor is neutral as well.

Obviously, this Court is far more convenient to National Instruments and Pervasive, which are both headquartered in Austin, Texas, than is Rhode Island. These two defendants, their witnesses and documents need travel only 229 miles from Austin to Tyler. In contrast, they would have to travel 1,957 miles from Austin to trial in Providence. Thus, any argument by National Instruments and Pervasive that they wish to be transferred to Rhode Island for the sake of convenience must be rejected. The same holds true for all but two of the other U.S. defendants, as evidenced by the following table showing the comparative distances from their respective headquarters to Tyler as compared to Providence:[5/]

Defendant	**Headquarters**	**Distance to Tyler**	**Distance to Providence**
Nat'l Instruments	Austin, TX	229	1,957
Pervasive	Austin, TX	229	1,957
Adobe	San Jose, CA	1,875	3,165
FileMaker	Santa Clara, CA	1,879	3,167
Pinnacle	Mountain View, CA	1,886	3,169
Sonic	Novato, CA	1,936	3,116
Onyx	Salt Lake City, UT	1,407	2,392
Symantec	Mountain View, CA	1,886	3,169
Aladdin Inc.	Arlington Heights, IL	919	1,028
CA	Islandia, NY	1,579	219
SafeNet	Belcamp, MD	1,511	180

[5/] Source: www.mapquest.com.

As a result, this Court is far more convenient than Rhode Island for the great majority of the defendants (and for Uniloc). Thus, on the whole, defendants cannot legitimately argue that it is more convenient to litigate this case in Rhode Island than in this Court. Additionally, many of Uniloc's relevant documents are located in the Eastern District of Texas. Lin Decl., ¶ 7. Uniloc has maintained an office in Plano, Texas for approximately two and a half years. *Id.*, ¶ 4. Moreover, just like all defendants, Uniloc has no offices, facilities, or employees in Rhode Island. *Id.*, ¶ 8. Thus, Tyler is also more convenient than Rhode Island for Uniloc.[6/]

Due to the clear inconvenience of Rhode Island, defendants are forced to argue that it does not matter because documents can easily be moved around the country. *Sony et al.* br., pp. 12-13.[7/] The Fifth Circuit has explicitly rejected this faulty reasoning, explaining that "[d]espite technological advances that certainly lighten the relative inconvenience of transporting large amounts of documents across the country, this factor is still part of the transfer analysis." *In re Volkswagen of Am., Inc.*, 545 F.3d at 316. Accordingly, this Court has determined that "whether documents may be produced electronically is no longer relevant in the convenience analysis." *ATEN Int'l Co. Ltd. v. Emine Tech. Co., Ltd.*, 261 F.R.D. 112, 124 (E.D. Tex. 2009). Instead, this factor is analyzed as though "voluminous documents must be transported from their physical location . . . to the trial venue." *Id.* at 123.[8/]

2. The availability of compulsory process weighs against transfer.

[6/] Defendants ignore this geographic evidence and simply argue that Rhode Island is convenient because the Court there conducted a technology tutorial. While such an argument may be relevant for the purposes of judicial economy, it has no relevance to this factor.

[7/] As noted in the Introduction above, defendants do nothing more than adopt the arguments of the *Sony* case defendants as their own. To be clear, it is Uniloc's position that by doing nothing more, defendants cannot meet the heavy burden placed upon them and their motion should be denied. Nonetheless, Uniloc responds to those arguments of Sony *et al.* in this brief to relieve the Court of the burden of searching through the pleadings from other cases to piece together the defendants' arguments herein.

[8/] Defendants' assertion that "defendants that would allegedly be inconvenienced do not oppose transfer to the RI District" is irrelevant. "The fact that [defendants are] agreeable to having th[is] case[] heard in [Rhode Island] is irrelevant [to the 1404(a) transfer analysis]." *Wolf Designs, Inc. v. Donald McEvoy Ltd., Inc.*, 355 F. Supp. 2d 848, 852 (N.D. Tex. 2005).

The next factor to be considered under *Volkswagen I* is the availability of compulsory process in the transferee forum over potential witnesses. *Volkswagen I* at 203. This factor also strongly supports denying defendants' motion. As the moving parties, defendants must "specifically identify key witnesses and outline the substance of their testimony." *Mangosoft Intellectual Prop. v. Skype Techs., S.A.*, 2007 U.S. Dist. LEXIS 48622 at *5 (E.D. Tex. Jul. 5, 2007). Defendants, however, fail to identify a single witness in either venue. Therefore, defendants fail to effectively address this factor and it cannot support their burden of proof. *Knapper v. Safety Kleen Sys., Inc.*, 2009 U.S. Dist. LEXIS 30118 at *20 (E.D. Tex. Apr. 3, 2009).

Although not its burden, Uniloc has identified 29 key non-party witnesses that reside either in this District or elsewhere in Texas. *See* Ex. A. The District of Rhode Island has no subpoena power over these witnesses. Moreover, the Federal Circuit has explained that when a district, such as this District, has "usable subpoena power," this fact weighs against transfer, "and not only slightly," to a district that has none. *In re Genentech, Inc.*, 566 F.3d at 1345, As defendants have failed to meet their burden of identifying any non-party witnesses, and because this is the only district with usable subpoena power, this factor weighs strongly against transfer.

3. The cost of attendance for willing witnesses weighs against transfer.

Next, the court must weigh the relative cost between the districts for witnesses to travel and attend trial. Because the District of Rhode Island is almost 1700 miles from Tyler, Texas, the Fifth Circuit's "100 mile" rule applies. Under this rule, the inconvenience to witnesses increases in direct relationship to the additional distance they must travel. *Volkswagen I* at 204-205. The court must consider the convenience of both the party and non-party witnesses. *Id.* at

204 (requiring courts to "contemplate consideration of the parties and witnesses"); *Fujitsu Ltd. v. Tellabs, Inc.*, 639 F. Supp. 2d 761, 765-66 (E.D. Tex. 2009).

Defendants have failed to identify a single party witness or employee who might testify in either forum. Thus, this factor cannot support transfer. *Knapper*, 2009 U.S. Dist. LEXIS 30118 at *20. As stated above, two defendants are headquartered in Texas and Uniloc believes that at least 29 witnesses are located in Texas. When parties and witnesses are located within the existing venue, as here, and other parties are widely dispersed, the court's central location weighs against transfer. *In re Genentech, Inc.*, 566 F.3d at 1343-44. This District is centrally located for the non-Texas based defendants.

Additionally, the round-trip travel time for each party is significantly less if this case remains in Texas. The majority of defendants will be forced to endure substantially greater travel times if the case is transferred to Rhode Island. Additional distance means additional travel time which increases the probability for meal, lodging expenses for overnight stays and increases the time which these witnesses must be away from their regular employment. *Volkswagen I* at 205. Hearings, and especially trial, in Providence would cost substantially more for willing witnesses and the parties in general. The cost of hotels, food, rental cars, local counsel, parking, and temporary office space is unquestionably much less in Tyler than in Rhode Island. All things considered, out-of-pocket costs for a trial in Providence, Rhode Island can be expected to be between $130,220 and $153,980, up to nearly two times more than the expected out of pocket costs of roughly $87,000 for trial in Tyler, Texas. *See* Ex. B *(*Declaration of Dianna Case), ¶ 15. *See also, Sanofi-Aventis Deutschland GmbH v. Genentech, Inc.*, 607 F. Supp. 2d 769, 779-80 (E.D. Tex. 2009). Therefore, this factor also weighs strongly against transfer.

B. The Public Factors Weigh Against Transfer.

1. Court congestion weighs against transfer.

In a single paragraph on page 11 of the adopted brief in the *Uniloc v. Sony et al.* case, defendants argue that median time to trial in Rhode Island is 19 months as compared with 25 months in this district. Defendants' selective reliance on irrelevant court statistics fails to paint a true picture of the relative congestion between the districts. Uniloc assumes that defendants are adopting the flawed assertion from the *Sony* case that median time to trial in Rhode Island is 19 months as compared with 25 months in this District. As Uniloc pointed out in that case, this faulty premise is based upon a selective reliance on irrelevant court statistics and fails to paint a true picture of the relative congestion between the two districts. When all the facts are examined, the District of Rhode Island is a clearly more congested venue. According to a 2009 PricewaterhouseCoopers (PWC) patent litigation study the Eastern District of Texas ranks fifth out of the twenty most active patent districts with a median time-to-trial in patent cases of 1.79 years (21 months). Bostock Decl., ¶ 8. Indeed, at a Status Conference held on April 4, 2011, this Court was setting *Markman* hearings in the February-April 2012 timeframe (10-12 months) and trial dates in the January-March 2013 timeframe (21-23 months). As the District of Rhode Island is not included in the PWC Study, Uniloc reviewed every patent case filed since 2003 to determine their median time-to-trial. Based on the only two patent cases to go to trial in the past seven years, the median time to trial in the District of Rhode Island was 51 months. *Id*. at ¶ 10. Accordingly, this factor weighs strongly against transfer. *Acceleron, LLC*, 634 F. Supp. 2d at 767.

Defendants' reliance on the median time form filing to trial of <u>all</u> civil cases is misplaced. The proper focus is on the difference between the median times from filing to trial for *patent* cases between the two districts. *See Realtime Data, LLC v. Packeteer, Inc.*, 2009 U.S. Dist. LEXIS 81067 at *35-37 (E.D. Tex. Mar. 5, 2009). Defendants also erroneously fail to acknowledge that there are two-and-a-half times as many judges in this District than in Rhode

Island. *See* Ex. C. Moreover, the number of active pending cases per judgeship, clearly a significant fact to consider, is 967 in Rhode Island compared with 463 in this District. *Id.* Thus, both the median time to trial and the relative caseload in the two districts demonstrate that this District is less congested.

With an average time to *Markman* of 28 months (versus 10-12 months for this Court) and an average time to trial of 51 months (versus 19-20 months for this Court), transfer of this case to Rhode Island will result in additional delay. This delay will operate to the prejudice of Uniloc. The patent-in-suit expires in 2013. Thus, it is unlikely that Uniloc could even get to trial in Rhode Island before the patent expires, hampering Uniloc's ability to recover damages and obtain injunctive relief. Accordingly, this factor weighs heavily against transfer.

2. The local interests weigh against transfer.

Uniloc is a Texas corporation and has maintained an office in Plano for over two years. Lin Decl., ¶ 4. Thus, Texas has a particularized interest in the trial of Uniloc's case as a whole. *Acceleron, LLC*, 634 F. Supp. 2d at 767-68. Texas' interest in this case is further bolstered by the fact, as set forth above, that defendants National Instruments and Pervasive both have their principal places of business in this State. *Id.* at 768. None of the defendants has a headquarters or principal place of business in Rhode Island. As a result, this factor strongly favors denying transfer.

3. Defendants have not shown that Judicial Economy weighs heavily in favor of transfer.

Defendants argue that judicial economy weighs heavily in favor of transfer. Uniloc disagrees.

a. There will be no judicial economy gained by transferring only one of the cases pending before this Court.

In its six pending cases in this Court, Uniloc alleges infringement of the same patent-in-suit as in this case against a large number of defendants. Transferring this case to Rhode Island would not serve judicial economy because in three of the cases none of the defendants has moved to transfer to Rhode Island (or to anywhere else). Thus, those three cases at least will remain in this District. Furthermore, around a dozen of the remaining defendants are Texas companies based in Texas and, therefore, likely not subject to personal jurisdiction in Rhode Island. As a result, judicial economy would be served by keeping all of the cases together in this Court, not by transferring this case to Rhode Island.

b. Defendants fail to prove that overlap between this case and the *Microsoft* case is substantial.

Judicial economy weighs in favor of transfer when there is substantial overlap between suits in two different districts. *Invitrogen Corp. v. GE Elec. Co.*, 2009 U.S. Dist. LEXIS 9127 at *12 (E.D. Tex. Feb. 9, 2009). There is substantial overlap if one court is extensively familiar with the technology or legal issues, has construed the claims, and the cases involve the same or similar defendants and products. *Zoltar Satellite Sys., Inc. v. LG Electronics Mobile Communications Co.*, 402 F. Supp. 2d 731, 737 (E.D. Tex. 2005). Conversely, the overlap is small if risk of inconsistent claim constructions is small and the cases involve different defendants with different products. *ConnecTel, LLC v. Cisco Sys., Inc.*, 2005 U.S. Dist. LEXIS 2252 at *10 (E.D. Tex. Feb. 16, 2005).

It cannot be disputed that this case involves different products from eleven new defendants that were, and are, not parties to the Rhode Island case against Microsoft. Further,

none of the defendants in this case has asserted that they use the accused Microsoft activation system. Thus, defendants have failed to establish that the cases involve the same or similar parties or technologies. As a result, defendants have failed to establish that judicial economy would be served by transferring this case to Rhode Island.

Defendants also argue that this case should be transferred to prevent inconsistent claim construction. *Sony et al.* br., pp. 8-9. Defendants do not identify, however, a single claim term that would potentially be construed inconsistently by this Court as compared with Judge Smith's constructions in the Rhode Island case. Moreover, while it is undeniable that Judge Smith construed the disputed terms of the patent-in-suit, that claim construction was partially appealed and several key claim terms were construed by the Federal Circuit. *Uniloc USA, Inc. v. Microsoft Corp.*, 2008 U.S. App. LEXIS 16938 (Fed. Cir. Aug. 7, 2008). Federal Circuit claim constructions have a *stare decisis* effect and a "district court must apply the Federal Circuit's claim construction even where a non-party to the initial litigation would like to present new arguments." *Rambus Inc. v. Hynix Semiconductor Inc.*, 569 F. Supp. 2d 946, 963 (N.D. Cal. 2008). This unique situation greatly reduces the possibility of inconsistent claim construction. In addition, any risk of possible inconsistent claim construction of terms that were not ruled on by the Federal Circuit can be avoided by referring to Judge Smith's prior claim construction. *ConnecTel, LLC v. Cisco Sys. Inc.*, 2005 U.S. Dist. LEXIS 2252 at *12 (E.D. Tex. Feb. 16, 2005).

Finally, defendants argue that Uniloc's choice of venue in this Court should not be given deference because Uniloc filed the prior suit against Microsoft in Rhode Island. *Sony et al.* br., pp. 9-10. Defendants' argument should be rejected. First, the Federal Circuit has rejected the position that "once a patent is litigated in a particular venue the patent owner will necessarily have a free pass to maintain all future litigation involving that patent in that venue. *In re*

Vistaprint Ltd., 628 F.3d 1342, 1347 (Fed. Cir. 2010) n, 3 (Fed. Cir. 2010). Second, Uniloc filed the Rhode Island complaint against Microsoft *et al.* in Rhode Island in September, 2003. *See* Bostock Decl., ¶ 3. At that time, Uniloc USA was a Rhode Island corporation with a principal place of business in Rhode Island. Lin Decl., ¶ 6. Moreover, one of the three original defendants therein was also a Rhode Island corporation having a principal place of business in Rhode Island. Bostock Decl., ¶ 4. Of the other two defendants, one (Microsoft) was based in Washington and the other (Aladdin) was based in Illinois. *Id.* Thus, Uniloc properly brought suit in Rhode Island. In contrast, none of the defendants in this case is a Rhode Island corporation, nor does any defendant have a place of business in Rhode Island.

Third, while defendants list a litany of proceedings from the *Microsoft* case, they fail to explain how these proceedings relate to the current litigation and the current accused products. The bulk of the prior litigation was focused on Microsoft and its products. For example, fifteen of the twenty witnesses introduced at trial where specific to Microsoft and its products. Bostock Decl., ¶ 5. Two of the remaining witnesses were Uniloc's technical expert relating the patent to Microsoft's technology and Uniloc's damages expert calculating damages from the sale of the Microsoft products. *Id.* Those transcripts would be available just as easily in Tyler. Moreover, of the 690,000 pages of documents produced in the litigation, over 600,000 pages (87 %) were produced by Microsoft. Uniloc produced less than 90,000 pages.[9] *Id.* at 6.

Any argument that judicial economy is best served by transfer to Rhode Island due to the pendency of the *Uniloc v. Microsoft* case before Judge Smith in that court is factually incorrect. First, that case is on appeal to the Federal Circuit. Second, Judge Smith has taken himself off the *Uniloc v. Microsoft* case and referred it for assignment to Judge Young of the District of

[9] This disparity is to be expected, because as the Fed. Cir. has explained, in patent cases the bulk of the relevant evidence comes from the accused infringer. *In re Genentech, Inc.*, 566 F.3d at 1345.

Massachusetts, sitting by designation. *See* Ex. D. Judge Young has had no prior involvement with the '216 patent or the *Uniloc v. Microsoft* case. In any event, if and when the *Uniloc v. Microsoft* case goes forward in Massachusetts, Judge Young will be focused on remand solely on the issue of damages as the issues of infringement, willful infringement, claim construction and validity have already been tried and appealed. The only issue being remanded for trial is damages. *See Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292 (Fed. Cir. 2011), reh'g denied (Mar. 22, 2011), . Thus, defendants' argument that Judge Smith's experience in that case supports transfer should be rejected. As this case involves different parties with different products, and because the chance of inconsistent adjudication is greatly reduced, the overlap with the previous *Microsoft* litigation is not substantial. Accordingly, judicial economy does not weigh in favor of transfer.

4. Any Judicial Economy that could have been realized by transferring this case has been lost due to the lapse in time between now and the *Microsoft* litigation

The Federal Circuit recently held that prior litigation does not control the judicial economy/transfer analysis. In *In re Verizon Business Network Services, Inc.*, Misc. Dkt. No. 956, slip op. (Fed. Cir. Mar. 23, 2011) (copy submitted as Exhibit E), the plaintiff opposed transfer from this District to the Northern District of Texas on the grounds that this Court was familiar with the patent-in-suit from settled litigation several years earlier that included claim construction of 25 claim terms. *Id.*, pp. 2-3. The Federal Circuit disagreed, stating *inter alia* that this Court "would have to relearn a considerable amount based on the lapse in time between the two suits." *Id.*, p. 5. The same is true for the Rhode Island court, even were Judge Smith still presiding over the *Microsoft* case. Judge Smith issued the claim construction order in that case almost five years ago on August 22, 2006. *See* Ex. F. Trial took place almost two years ago in

March-April, 2009. Moreover, as the Federal Circuit noted in the *Verizon* case, none of the witnesses resided in this District. Ex. E, p. 5. Likewise, defendants herein have identified no witness or evidence located in Rhode Island. Thus, as in the *Verizon* case, the fact that the patent-in-suit was previously litigated in Rhode Island does not favor transfer, particularly where the prior judge in that case has removed himself from all further proceedings therein.

5. Judicial Economy is not dispositive in this case.

Even if, notwithstanding the foregoing, this Court finds that judicial economy weighs in favor of transfer, this factor alone does not trump every other factor weighing against it. Indeed to hold so would violate the Fifth Circuit's mandate that no single factor is dispositive. *In re Volkswagen of Am., Inc.*, 545 F.3d at 315. While the Federal Circuit has held that judicial economy may outweigh the private interests of the parties, it has rejected any *per se* rules when it comes to favoring any factors over others. *In re Vistaprint Ltd.*, 628 F.3d at 1346. In this case, the private and public factors overall are in Uniloc's favor.[10/] Similarly, where this Court found judicial economy dispositive, the other public and private factors viewed as a whole either favored transfer or were neutral. *See e.g. Invitrogen,* 2009 U.S. Dist. LEXIS 9127 at *19 (judicial economy weighed in favor and remaining factors were neutral or slightly favored transfer).

IV. CONCLUSION

For the reasons set forth above, defendants' motion to transfer should be denied. A proposed Order is submitted as Exhibit G.

[10/] Many of the cases cited in the Sony *et al.* brief and relied upon by defendants herein are distinguishable on other grounds as well. Unlike this case, neither *Jackson, Invitrogen, Am. Calcar* nor *Zoltar* had Texas parties and thus there was no localized interest. *Jackson v. Intel Corp.*, 2009 U.S.Dist. LEXIS 22117 at *10 (E.D. Tex. Mar. 19, 2009); *Invitrogen*, 2009 U.S. Dist. LEXIS 9127 at *8; *Am. Calcar Inc.*, 2006 U.S. Dist. LEXIS 69373 at *4-6; *Zoltar Satellite Sys., Inc.*, 402 F. Supp. 2d at 738-39. Also unlike this case, both *Invitrogen* and *Kentic Concepts* involved transfer of cases that involved the same or essentially the same parties as in the previous suits. *Invitrogen*, 2009 U.S. Dist. LEXIS 9127 at *14; *Kinetic Concepts*, 2008 U.S. Dist. LEXIS 2900 at *5.

Dated: April 11, 2011

Respectfully Submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on April 11, 2011. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this documents through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A).

/s/ Dean Bostock

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