

EXHIBIT P

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MOTOROLA MOBILITY, INC.,)
)
Plaintiff,)
)
v.) C.A. No. 10-867 (GMS)
)
APPLE INC. and NEXT SOFTWARE, INC.,)
)
Defendants.)

**MOTOROLA'S ANSWERING BRIEF IN OPPOSITION TO
DEFENDANTS' MOTION TO DISMISS OR TRANSFER**

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NATURE AND STAGE OF THE PROCEEDINGS

Plaintiff Motorola Mobility, Inc. (“Motorola”) respectfully submits this Opposition to Defendants Apple Inc. (“Apple”) and NeXT Software, Inc.’s (“NeXT”) (collectively, “Defendants”) Motion to Dismiss or Transfer (D.I. 9).

SUMMARY OF ARGUMENT

Defendants improperly seek to thwart Motorola’s choice of forum for this action. Motorola, a Delaware corporation, properly brought suit in this Court against Defendants, both of which are subject to specific personal jurisdiction here because they have previously sought to enforce the patents-in-suit in this district. Furthermore, Apple – the sole defendant on eleven of the twelve patents-in-suit – unquestionably has significant contacts with this forum through its business activities and is subject to general personal jurisdiction here.

This action was the first-filed action between Motorola and Defendants on the patents at issue involving the products at issue. After Motorola initiated this action on October 8, 2010 seeking a declaratory judgment on the twelve patents-in-suit, Apple filed an action in the Western District of Wisconsin on October 29, 2010 asserting three *different* patents against Motorola (Complaint (Ex. A)) and alleging infringement by the products at issue here (the “Wisconsin Action”). More than a month later, on December 2, 2010, Apple and NeXT filed an Amended Complaint in the Wisconsin Action adding allegations of infringement of the twelve patents-in-suit here to its original complaint (Amended Complaint (Ex. B)).¹

¹ During a December 17, 2010 Preliminary Pretrial Conference, the Wisconsin court informed the parties that the case would be placed on the court’s normal trial schedule, with trial at the end of April 2012. In doing so, the court denied Apple’s and NeXT’s request for a more extended schedule. Despite their request for a longer time to trial, Defendants may point to the Wisconsin schedule as a factor supporting their motion to transfer here. The Wisconsin court noted, however, that it was aware that related actions and transfer motions are pending in other districts and the ITC, and stated that it expected motion practice to determine which patents would be litigated in which forum. Motorola

Defendants' arguments that Delaware is an inconvenient or otherwise inappropriate forum in which to litigate the invalidity and noninfringement of the patents-in-suit are difficult to fathom in light of (1) Defendants' ongoing efforts to enforce the same twelve patents against other parties in this Court for products involving the same technology at issue here, and (2) Apple's recent motion to transfer another patent infringement action *from* the Western District of Wisconsin *to* Delaware (that motion is still pending in Wisconsin). There can be no dispute that Defendants have availed themselves of this forum for enforcement actions involving the patents-in-suit. They should not now be permitted to avoid the jurisdiction of this Court when Motorola properly seeks to litigate the invalidity and noninfringement of those same patents here.

Various private and public factors, including considerations of judicial economy, also weigh significantly against transfer. As noted above, Defendants' infringement actions seeking to enforce the patents-in-suit against other parties for products involving the same technology at issue here are currently pending in this Court. *Apple Inc., NeXT Software, Inc. f/k/a/ NeXT Computer, Inc. v. High Tech Computer Corp., a/k/a HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., and Exedea, Inc.*, C.A. No. 10-166-GMS; *Apple Inc. v. High Tech Comp. Corp., a/k/a/ HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., Exedea, Inc.*, C.A. No. 10-167-GMS. As the Federal Circuit recognized just last week, in denying a petition for a writ of mandamus seeking a transfer from the Eastern District of Texas, prior litigation in that district, "coupled with the fact that there is co-pending litigation before the trial court involving the same patent and underlying technology, provides a substantial justification for maintaining the suit in the Eastern District of Texas." *In re Vistaprint Limited and OfficeMax Inc.*, Misc. Dkt No. 954, -- F.3d --, 2010 WL 5136034 (Fed. Cir. Dec. 15, 2010). (Fed. Cir. Slip. Op. (Ex. C) at 8.)

plans to file shortly a motion to dismiss or transfer the twelve patents Apple and NeXT are attempting to add to the Wisconsin Action.

Similarly, Defendants' other infringement actions in this Court involving the same patents and the same underlying technology provide a substantial justification for maintaining Motorola's action in Delaware. Defendants' motion to transfer or dismiss should be denied.

STATEMENT OF FACTS

The key facts are not disputed. First, it cannot be disputed that this action is the first-filed action between Motorola and defendants on the patents-in-suit, and that the Wisconsin action is the second-filed action. Defendants have admitted (Defendants' Br. at 2) that the products at issue in this action are the same as those in the Wisconsin Action, namely, the Droid, Droid 2, Droid X, Cliq, Cliq XT, BackFlip, Devour A555, il, and Charm products. (*See, e.g.*, D.I. 1 ¶ 14; Complaint in the Wisconsin Action (Ex. A ¶ 7); Amended Complaint in the Wisconsin Action (Ex. B ¶ 8).) Defendants also cannot dispute that the patents at issue here are the same patents as those Defendants asserted in the Wisconsin Action in their December 2, 2010 Amended Complaint. (Ex. B ¶¶ 12-23).) In short, Defendants decided to assert those patents against Motorola in the Wisconsin Action after the validity and infringement of those patents had already been challenged by Motorola in this Court.²

It also cannot be disputed that Apple and NeXT have sought and are seeking to enforce the same twelve patents-in-suit in this Court against other parties in co-pending actions involving products based on the same technology at issue here, namely, mobile phones incorporating the Android platform. (D.I. 1 ¶¶ 6-7; C.A. 10-166, D.I. 1 ¶ 15; C.A. 10-167, D.I. 1 ¶ 13.) On March

² The three Apple patents originally at issue in the Wisconsin Action are generally directed to different technology than the twelve patents at issue here and added by Apple to the Wisconsin Action in their Amended Complaint. The three original Apple patents in the Wisconsin Action are directed to the features of the graphical user interface, whereas the twelve patents at issue here are primarily asserted against features in the Android platform used by Motorola and HTC (the defendant in certain of Apple's previous Delaware actions).

2, 2010, Apple and NeXT sued HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., and Exedea, Inc. for infringement of ten of the twelve patents-in-suit. *Apple Inc., NeXT Software, Inc. f/k/a/ NeXT Computer, Inc. v. High Tech Computer Corp., a/k/a HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., and Exedea, Inc.*, C. A. No. 10-166-GMS (Complaint (Ex. D ¶ 7)). On that same day, Apple sued the same defendants for infringement of the remaining two patents-in-suit. *Apple Inc. v. High Tech Comp. Corp., a/k/a/ HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., Exedea, Inc.*, C.A. No. 10-167-GMS (Complaint (Ex. E ¶ 6)) (with C.A. 10-166, “the HTC Actions”).

In addition, in *Nokia Corp. v. Apple Inc.*, C.A. No. 09-1002-GMS, and in *Nokia Corp. v. Apple Inc.*, C.A. No. 09-791-GMS, Apple asserted a total of seven of those patents in this Court by counterclaim. (Apple Inc.’s Answer, Defenses, and Counterclaims, Exs. F, G.) The 09-1002 action is currently stayed pending an ITC proceeding. (C.A. 09-1002, D.I. 13.) All four of the actions involving these patents are assigned to the same judge.

Moreover, in the HTC Actions, Apple and NeXT *opposed* a motion by the defendants to transfer to the Northern District of California, where Apple is *located*, arguing that “[I]ike HTC, Apple is capable of litigating cases on the East Coast.” (Opp. to Defendants’ Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404 (Ex. H) at 13.) Apple and NeXT argued vigorously in opposing transfer that, based on the pending *Nokia* cases in this district involving some of the same patents and issues, transfer would be wasteful and inefficient:

These four cases share numerous overlapping patents and thus share numerous identical issues of fact and law. For example, both sets of cases will involve construction of a number of identical patent claims, a number of the same fact witnesses will need to testify in both cases, and a number of the same experts will provide reports and testimony involving issues of infringement and validity of the overlapping patents. Sending these cases to another District would, as the Supreme Court has noted, be wasteful and inefficient. Rather than transfer the two present cases out of this

District—so that different judges on opposite ends of the country will separately (and potentially inconsistently) decide common issues of fact and law—these cases should be consolidated with the related Delaware actions before the same judge.

(Ex. H at 1 (internal citation omitted).) Apple and NeXT noted that “the convenience of the parties and the interests of judicial economy both would best be served by keeping these actions in the District of Delaware” before a single judge “[e]ven if these cases are not consolidated.”

(Ex. H at 2.)³

Apple is also currently seeking to transfer a patent infringement action filed against it in Wisconsin to Delaware. *Nokia Corp. v. Apple Inc.*, C.A. No. 10-249 (W.D. Wisc.) (the “Nokia Wisconsin Action”) (Mem. in Support of Motion to Transfer Venue to the District of Delaware Pursuant to 28 U.S.C. § 1404 (Ex. I)). In its June 29, 2010 memorandum in support of its transfer motion, Apple told the Wisconsin court that it has no “meaningful relationship with the Western District of Wisconsin Apple Inc. is a California corporation with its principal place of business in Cupertino, California; it has no corporate offices or research facilities in Wisconsin.” (Ex. I at 7.) That motion is still pending.

ARGUMENT

I. Defendants’ Motion to Dismiss for Improper Venue Should Be Denied

Defendants bear the burden of proving that venue is improper on their motion to dismiss. *See, e.g., Chase Bank USA N.A. v. Hess Kennedy Chartered LLC*, 589 F. Supp. 2d 490, 501 (D. Del. 2008) (stating that “the moving party bears the burden of proving that venue is improper”).

³ This Court denied Apple’s motion to consolidate (C.A. No. 10-167, D.I. 56) but noted that if “the parties have claim construction disputes regarding claims that are asserted both in C.A. No. 10-167 (*Apple, Inc. v. High Tech Computer Corp.*) and in C.A. No. 09-971 (*Nokia Corporation v. Apple, Inc.*), the court will hear those claim construction arguments at the Markman hearing for C.A. No. 09-971, currently scheduled for May 16, 2011.”

Pursuant to 28 U.S.C. § 1391(b), venue is proper in a judicial district where any defendant resides, if all defendants reside in the same state. 28 U.S.C. § 1391(b)(1). Pursuant to 28 U.S.C. § 1391(c), a corporation is deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action was commenced. 28 U.S.C. § 1391(c). Because both Apple and NeXT were subject to personal jurisdiction in this district at the time Motorola commenced this action, venue is proper here and Defendants' arguments to the contrary are wrong as a matter of law.

A. Apple Is Subject to Personal Jurisdiction in This District

Apple is the owner of eleven of the twelve patents in suit, and the only defendant with respect to those eleven patents. Apple is subject to personal jurisdiction here on the basis of its retail operations and other business contacts in this district. *See, e.g., Daughtry v. Family Dollar Stores, Inc.*, 634 F. Supp. 2d 475, 482-83 (D. Del. 2009) (finding venue proper in Delaware under § 1391(c) on the grounds that defendant's operation of a store in Delaware "would subject defendant to personal jurisdiction in Delaware"). Apple does not dispute that it has a retail store in Newark, Delaware, or that it is subject to general personal jurisdiction in Delaware. (Defs. Br. at 5.) Nor could it. In addition, Apple has asserted the patents-in-suit here in the HTC actions pending before this Court and seven of them in the Nokia actions pending before this Court, subjecting it to specific personal jurisdiction with respect to those patents, as discussed below.

B. NeXT Has Waived Any Objection to Personal Jurisdiction in This District Through Its Efforts to Enforce One of the Patents-in-Suit Here

NeXT is the owner of only one of the twelve patents-in-suit and a defendant only with respect to that one patent, U.S. Patent No. 5,481,721 ("the '721 Patent"). Having previously sought to enforce the '721 Patent in one of the HTC actions in this district, and therefore having purposefully availed itself of this forum with respect to that patent, NeXT is subject to personal

jurisdiction in this Court with respect to the ‘721 Patent.⁴

The Federal Circuit, this Court, and other courts in the Third Circuit have held that a defendant in a patent declaratory judgment or infringement action that has previously sought to enforce the same or related patents in the forum is subject to specific personal jurisdiction in the forum.⁵ The Federal Circuit held that a defendant-patentee in a declaratory judgment action was subject to personal jurisdiction on the basis of prior efforts to enforce the patent in the forum “extra-judicially,” by targeting plaintiff’s business activities at a convention. *See Campbell Pet Co. v. Miale*, 542 F. 3d 879, 886 (Fed. Cir. 2008); *see also Frank’s Casing Crew & Rental Tools, Inc. v. PMR Technologies, Ltd.*, 292 F. 3d 1363, 1372 (Fed. Cir. 2002) (holding that defendant in declaratory judgment patent action waived personal jurisdiction defense where defendant had sought to bring into the action new infringement claims against new parties not arising out of the same transaction or occurrence).

This Court has held that a defendant in a patent infringement action consented to personal jurisdiction where it had previously filed a patent infringement suit in the forum that had a “logical relationship” to the suit in which it sought to contest personal jurisdiction. *See Foster Wheeler*, 1993 WL 669447 at *4. This Court noted that exercising jurisdiction over the defendant “seems a small price to exact for allowing [defendant] purposefully to avail itself of

⁴ Defendants argue (Defs. Br. at 5) that the Delaware long-arm statute does not authorize the exercise of personal jurisdiction over NeXT. However, irrespective of NeXT’s contacts with Delaware for purposes of the long-arm statute, NeXT has waived any objection to personal jurisdiction through its prior suit to enforce the ‘721 Patent in Delaware. *See, e.g., Foster Wheeler Energy Corp. v. Metallgesellschaft AG*, C.A. No. 91-214, 1993 WL 669447 at *4 (D. Del. Jan. 4, 1993) (finding waiver of personal jurisdiction objection on the basis of Defendant’s having brought infringement action in the forum and stating that in light of waiver, “an application of long-arm jurisdiction analysis is unnecessary”).

⁵ Federal Circuit law applies to the question of personal jurisdiction over a defendant-patentee in a declaratory judgment action. *See, e.g., Electronics For Imaging, Inc. v. Coyle*, 340 F. 3d 1344, 1348 (Fed. Cir. 2003).

the benefits of a [Delaware] forum as a plaintiff [in the prior action] . . . A contrary conclusion would senselessly diminish the jurisdictional weight ordinarily accorded to so direct an invocation of the state’s benefits and protections.” *Id.* (internal quotations and citations omitted).

Other courts in the Third Circuit have held that a defendant-patentee in a declaratory judgment action that has previously sought to enforce one or more of the patents-in-suit in the same forum has waived any objection to personal jurisdiction in that forum for purposes of the declaratory judgment action. *See, e.g., Pro Sports Inc. v. West*, 639 F. Supp. 2d 475, 481-83 (D.N.J. 2009) (finding a defendant-patentee in a declaratory judgment action subject to personal jurisdiction in the forum in which the patentee had previously sued other parties to enforce the patent-in-suit); *Pharmanet, Inc. v. DataSci Ltd. Liability Co.*, C.A. No. 08-2965, 2009 WL 396180 at *13 (D.N.J. Feb. 17, 2009) (finding personal jurisdiction over defendant-patentee in declaratory judgment action on the basis of defendant-patentee’s filing of an infringement suit two days after plaintiff filed the declaratory judgment action); *see also Neuralstem, Inc. v. Stemcells, Inc.*, 573 F. Supp. 2d 888, 896, 896 n.9 (D. Md. 2008) (exercising personal jurisdiction over a defendant-patentee in a declaratory judgment action that had previously filed suit asserting related patents against the plaintiff in the forum). The court in *Pro Sports* reasoned that the declaratory judgment action and the prior enforcement action were materially related and noted that the defendant could not “use personal jurisdiction as both sword and shield.” *Pro Sports*, 639 F. Supp. 2d at 482.

NeXT, which has purposefully availed itself of this forum to enforce its ‘721 Patent, may not now object to personal jurisdiction to shield it from Motorola’s declaratory judgment action, properly brought in this venue on that same patent.

C. The Events Giving Rise to Motorola’s Declaratory Judgment Claims Arose in Delaware

28 U.S.C. § 1391(b)(2) sets out as an alternative venue “a judicial district in which a substantial part of the events or omissions giving rise to the claim occurred.” Contrary to Defendants arguments, in a declaratory judgment action seeking a determination of noninfringement, the relevant events for purposes of § 1391(b)(2) are the acts of infringement on which the claim is based. *Dex Prods., Inc. v. Houghteling*, C.A. No. 05-05126, 2006 WL 1751903 at *2-3 (N.D. Cal. Jun. 23, 2006) (rejecting defendants’ argument that proper venue for patent declaratory judgment action was location where work on patent and license agreement at issue took place and holding instead that proper venue was location of alleged infringing acts); *see also Carnegie Mellon Univ. v. Marvell Tech. Grp., Ltd.*, C.A. No. 09-290, 2009 WL 3055300 at *2-3 (W.D. Pa. Sept. 21, 2009) (stating that claim in patent infringement action arose where alleged infringement occurred, rather than where development, testing, research, and decision-making regarding the sales and marketing of the allegedly infringing products took place).

Here, Motorola has pled that it has a reasonable apprehension of suit from Defendants because defendants have a history of asserting the patents-in-suit against products, including the products at issue here, that use the Android platform. (D.I. 1 ¶¶ 6-7.) Defendants’ actions to enforce these patents include the HTC Actions asserting the patents-in-suit. *Apple Inc. v. High Tech Comp. Corp., a/k/a/ HTC Corp., HTC (B.V.I.) Corp., HTC America, Inc., Exedea, Inc.*, C.A. No. 10-167-GMS. In the two HTC actions, Apple and NeXT have alleged that the defendants in these actions committed tortious acts of patent infringement in Delaware. (C.A. No. 10-166, D.I. 1 ¶ 10; C.A. No. 10-167, D.I. 1, ¶ 9.) In fact, in opposing the motion to transfer these HTC actions, Apple and NeXT argued that their “claims arose in the District of Delaware as much as in any other district, because that is where the infringement occurred.” (Ex. H at 11.)

Defendants argued explicitly that the actions giving rise to that case “were not Apple’s development of its patents but, rather, the defendants’ *infringement* of them.” (Ex. H at 11 (emphasis in original).)

Motorola has pled that, “[l]ike HTC, Motorola Mobility manufactures and sells mobile phones that use the Android operating system.” (D.I. 1 ¶ 7.) Motorola’s declaratory judgment claims therefore arose in Delaware.⁶

II. Defendants’ Motion to Transfer Should Be Denied

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.” 28 U.S.C. § 1404(a). The party moving for transfer bears the burden of demonstrating that transfer is warranted and that the balance of interests weighs in favor of transfer. *See, e.g., Shutte v. Armco Steel Corp.*, 431 F. 2d 22, 25 (3rd Cir. 1970) (stating that the “burden is on the moving party to establish that a balancing of proper interests weigh in favor of the transfer); *Safety Braking Corp. v. Six Flags Theme Parks Inc.*, C.A. No. 07-127, 2009 WL 1617931 at *2 (D. Del. Jun. 9, 2009) (stating that the “movant bears the burden of

⁶ Defendants’ cited precedent is wholly inapposite. Defendants’ argument (Defs. Br. at 7) that *St. Clair Intellectual Property Consultants, Inc. v. Mirage Systems, Inc.* involved the grant of a motion to dismiss under “analogous circumstances” is incorrect. *St. Clair Intellectual Property Consultants, Inc. v. Mirage Systems, Inc.*, 419 F. Supp. 2d 620 (D. Del. 2006). In *St. Clair*, a diversity action that did *not* involve claims of patent infringement, the plaintiff sought a declaration of patent ownership and alleged various tort injuries. *See id.* at 622. All the parties agreed that the main issue in the case was ownership of the patents-in-suit. *See id.* at 623. This Court found that venue was improper because all the events and omissions leading up to the ownership dispute occurred in California. *See id.* The other case cited by Defendants (Defs. Br. at 6 n.3), *Lex Computer & Mgmt. Corp. v. Eslinger & Pelton, P.C.*, similarly did not involve claims of patent infringement. *See Lex Computer & Mgmt. Corp. v. Eslinger & Pelton, P.C.*, 676 F. Supp. 399, 406 (D.N.H. 1987) (finding venue improper for declaratory judgment claim for patent invalidity where venue rested solely on letters sent into states other than the forum notifying plaintiffs of patent infringement).

establishing the need for transfer”). Although transfer is within the court’s discretion, “a transfer is not to be liberally granted.” *Shutte*, 431 F. 2d at 25. It is settled law in the Third Circuit that “[a] transfer will be denied if the factors are evenly balanced or weigh only slightly in favor of the transfer.” *Pfizer Inc. v. Sandoz Inc.*, C.A. No. 09-742, 2010 WL 256548 at *3 (D. Del. Jan. 20, 2010).

A. The First-Filed Rule Weighs Heavily Against Transfer

Although decisions regarding transfer of patent actions are governed by the law of the regional circuit, Federal Circuit law governs the determination whether a court should decline jurisdiction over a patent declaratory judgment action in favor of a later-filed patent infringement action. *Compare 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) *with Electronics for Imaging, Inc. v. Coyle*, 394 F.3d 1341, 1345-46 (Fed. Cir. 2005) (stating that Federal Circuit law applies to the “question whether to accept jurisdiction in an action for a declaration of patent rights in view of a later-filed suit for patent infringement”).

In any event, the law of both the Third and Federal Circuits strongly favors application of the first-filed rule here and denial of Defendants’ transfer motion. The Federal Circuit has expressly held that the first-filed rule is equally applicable when the first-filed action is a declaratory judgment action. *See, e.g., Electronics for Imaging*, 394 F. 3d at 1347-48 (reversing district court’s dismissal of first-filed declaratory judgment action on the grounds that it was an “anticipatory” action prompting a “race to the courthouse” as an abuse of discretion). In *Electronics for Imaging*, the Federal Circuit emphasized that to invoke an exception to the first-filed rule, “there must . . . be sound reason that would make it unjust or inefficient to continue the first-filed action.” *Id.* at 1347 (internal quotations and citations omitted). Third Circuit law establishes that “in the absence of extraordinary circumstances, bad faith, inequitable conduct, or

forum shopping, “[i]n all cases of federal concurrent jurisdiction, the court which first has possession of the subject must decide it.” *Pfizer*, 2010 WL 256548 at *4 (quoting *EEOC v. Univ. of Pa.*, 850 F. 2d 969, 971-72 (3rd Cir. 1988)).

Defendants cannot argue that the Wisconsin Action was the first-filed and do not argue that there are any extraordinary circumstances that would justify departing from the first-to-file rule.

B. Defendants Have Not Met Their Burden to Demonstrate Motorola Could Have Brought the Action in Wisconsin at the Time of Filing in this Court

In determining whether to transfer an action, the court must first determine whether the action could have been brought in the transferee district at the time it was filed. *Shutte*, 431 F. 2d at 24 (stating that a transfer is authorized by § 1404(a) “only if the plaintiff had an unqualified right to bring the action in the transferee forum at the time of the commencement of the action”). Specifically, venue must have been proper in the transferee forum and the transferee court must have had personal jurisdiction over all the defendants. *Id.*

Defendants present no evidence to demonstrate that NeXT would have been subject to personal jurisdiction in the Western District of Wisconsin. On the contrary, in a futile attempt to meet their burden on this issue, Defendants assert incorrectly that if venue is proper in Delaware it is also proper in Wisconsin. (Defs. Br. at 10.) Defendants are wrong on both the facts and the law. As a preliminary matter, by suing to enforce its ‘721 Patent in Delaware, NeXT has waived any objection to specific personal jurisdiction in this forum. Therefore, irrespective of NeXT’s jurisdictional contacts with Delaware, NeXT is subject to jurisdiction in Delaware on the basis of this waiver. *See, e.g., Foster Wheeler*, 1993 WL 669447 at *4 (finding waiver of personal jurisdiction objection on the basis of Defendant’s having brought infringement action in the forum and stating that in light of waiver, “an application of long-arm jurisdiction analysis is

unnecessary). Defendants have presented no evidence that NeXT had ever attempted to enforce this patent or any related patent in Wisconsin at the time Motorola filed this action to demonstrate the existence of a similar waiver in that forum. Defendants' efforts to equate the two fora in the jurisdictional analysis must therefore fail. Second, in the absence of such a waiver, it is Defendants' burden to demonstrate that NeXT had the requisite contacts with Wisconsin to subject it to jurisdiction there at the relevant time. *See, e.g., Safety Braking Corp.*, 2009 WL 1617931 at *4 (denying transfer on the grounds that the court was unable to conclude that the action could have been brought in the potential transferee forum where the movant failed to present evidence supporting jurisdiction there over defendants).

As a result, in the absence of any evidence that NeXT was subject to personal jurisdiction in Wisconsin at that time, Defendants cannot meet their burden to show the action could have been brought in Wisconsin at the time Motorola filed this action in Delaware.

C. The Relevant Private Factors Weigh Against Transfer

The Third Circuit applies the following private interest factors in evaluating motions to transfer: (1) the plaintiff's choice of forum, (2) the defendant's preferred forum, (3) where the claim arose, (4) the convenience of the parties, (5) the convenience of the witnesses, but only to the extent that the witnesses may be unavailable for trial in one of the fora, and (6) the location of books and records, again, only to the extent that they may not be available in one of the fora. *See Pfizer*, 2010 WL 2565478 at *3. If these factors are neutral or weigh only slightly in favor of transfer, the transfer motion must be denied. *Id.*

1. Motorola's Choice of Forum Weighs Heavily Against Transfer

In the Third Circuit, "[i]t is black letter law that a plaintiff's choice of a proper forum is a paramount consideration in any determination of a transfer request, and that choice . . . should not lightly be disturbed." *Shutte*, 431 F. 3d at 25 (internal quotations and citations omitted); *see*

also *Pfizer*, 2010 WL 2565478 at *3. The Third Circuit in *Shutte* stressed that “unless the balance of convenience of the parties is strongly in favor of defendant, the plaintiff’s choice of forum should prevail.” *Shutte*, 431 F. 2d at 25. The law is settled in this Court that a “corporation’s decision to incorporate in a particular state is a rational and legitimate reason to choose to litigate in that state.” See, e.g., *Acuity Brands, Inc. v. Cooper Industries, Inc.*, C.A. No. 07-444, 2008 WL 2977464 at *2 (D. Del. Jul. 31, 2008) (denying transfer in part on the grounds that because the plaintiff was incorporated in Delaware, Delaware was the plaintiff’s “home turf,” and “this fact alone supports a finding that [plaintiff’s] choice of this forum is proper and should be accorded paramount consideration in any determination of a transfer request”); *Trilegiant Loyalty Solns, Inc. v. Maritz, Inc.*, C.A. No. 04-360, 2005 WL 441077 at *2 (D. Del. Feb. 15, 2005) (denying transfer and giving paramount consideration to plaintiff’s choice to litigate in its state of incorporation). In opposing transfer of the HTC Actions, Apple and NeXT emphasized that the “plaintiff’s selection of a proper forum is a paramount consideration that should not be lightly disturbed.” (Ex. H at 5 (internal quotations and citation omitted).)

As Defendants themselves emphasized in their opposition to transfer in the HTC actions, the deference that should be accorded to plaintiff’s choice of forum is “heightened by the efficiencies resulting from [plaintiff’s] choice to litigate the same patents in a single forum.” (Ex. H at 1.) The existence of four related actions in this Court involving the patents-in-suit only increases defendants’ burden to overcome Motorola’s choice to litigate here. As the Federal Circuit recently held, and as Defendants pointed out in their opposition to transfer in the HTC actions (Ex. H at 6), “the existence of multiple lawsuits involving the same issues is *a paramount consideration* when determining whether a transfer is in the interest of justice.” *In*

re Volkswagen of Am., Inc., 566 F. 3d 1349, 1351 (Fed. Cir. 2009) (emphasis added).

2. Defendants' Choice of Forum Does Not Favor Transfer

As noted, the Defendants' choice of forum must be disregarded in that it is not a forum in which the action could initially have been brought and therefore does not meet the threshold requirement in the transfer analysis. In any event, Defendants' choice of forum should be given particularly little weight here, in light of Defendants' willingness to enforce their patents in this forum and to seek transfer *to* this forum *from* Wisconsin when it suits their litigation strategy.

3. Where the Claims Arose Weighs Against Transfer

As discussed earlier, Motorola's noninfringement declaratory judgment claims arose where the alleged acts of infringement took place. *See Carnegie Mellon Univ. v. Marvell Tech. Grp., Ltd.*, C.A. No. 09-290, 2009 WL 3055300 at *2-3 (W.D. Pa. Sept. 21, 2009) (stating that claim in patent infringement action arose where alleged infringement occurred, rather than where development, testing, research, and decision-making regarding the sales and marketing of the allegedly infringing products took place); *see also Personalized User Model LLP v. Google, Inc.*, C.A. No. 09-525, 2009 WL 3460767 at *2 (D. Del. Oct. 27, 2009) (denying transfer in part on the grounds that "[b]ecause of the national scope of the technology in question, the Court finds that Plaintiff's claim arose in Delaware to the same extent as in any other district" so that "this factor weighs against transfer"). As Defendants themselves have argued in opposing transfer of the HTC actions, their "claims arose in the District of Delaware as much as in any other district, because that is where the infringement occurred." (Ex. H at 11.) Defendants argued explicitly that the actions giving rise to that case "were not Apple's development of its patents but, rather, the defendants' *infringement* of them." (Ex. H at 11 (emphasis in original).)

Motorola has pled that, “[l]ike HTC, Motorola Mobility manufactures and sells mobile phones that use the Android operating system.” (D.I. 1 ¶ 7.) Motorola’s declaratory judgment claims therefore arose in Delaware.

4. Convenience of the Parties Does Not Favor Transfer

The convenience of the parties favors Delaware: Motorola is a Delaware corporation and Apple has a physical presence here. *See id.* at *4. By Apple’s own admission, Apple does not have “any meaningful relationship with the Western District of Wisconsin” and “has no corporate offices or research facilities in Wisconsin.” (Apple D. Wisc. Transfer Motion Mem. (Ex. I at 7).) This Court has found that a large company with substantial annual sales such as Apple will not be unduly burdened by litigating in Delaware. *See, e.g., Magsil Corp. v. Seagate Technology*, C.A. No. 08-940, 2009 WL 1259043 (D. Del. Apr. 30, 2009) (denying transfer in part on the grounds that “[t]he defendants are large national and international corporations, several generating billions of dollars of annual revenue, and will not suffer meaningful financial hardship if required to litigate in Delaware”); *Trilegiant*, 2005 WL 441077 at *2 (denying transfer and noting that the defendant had annual sales greater than \$1 billion).

5. Convenience of the Witnesses Does Not Favor Transfer

The convenience of the witnesses does not weigh in favor of transfer. Defendants do not contend that any third-party witnesses will be available in Wisconsin who would not be available in Delaware. This Court has stated explicitly that “[a]s for the convenience to the witnesses, it is only relevant to the extent that they would be unavailable for trial in the forum.” *Acuity Brands*, 2008 WL 2977464 at *2 (denying transfer and noting that “as this court has previously held, a flight to Delaware is not an onerous task warranting transfer”).

6. The Location of Books and Records Does Not Favor Transfer

As this Court has stated, a “court should consider the location of books and records in its

analysis only to the extent that the files could not be produced in the alternative forum.” *Acuity*, 2008 WL 2977464 at *3 (denying transfer and explaining that this factor does not weigh in favor of transfer because “discovery can be conducted at any location convenient to the parties and their employees,” that “the only event that will take place in Delaware is the trial,” and that “today’s modern technology allows for the easy exchange of electronic discovery”).

In contrast to their position here, in Defendants’ opposition to HTC’s motion to transfer the HTC Delaware Action to the Northern District of California, where Apple is headquartered, Defendants argued:

First, under Third Circuit law, Apple’s choice of forum is entitled to far more deference than HTC argues Second, HTC is a large international company fully capable of litigating the present cases in the District of Delaware without suffering any disruption of its business activities. HTC is not based in the Northern District of California – its witnesses and personnel will have to travel regardless of the district in which these cases proceed, and relevant documents (both electronic and physical) will need to be shipped in either circumstance. Further, HTC cannot identify *any* potential third party witnesses who would be unable to testify in a Delaware proceeding. For these reasons, none of the “private” factors that HTC purports to identify in support of its motion favors transferring these cases to California.

(Ex. H at 1-2.) Defendants also made the point that “the fact that HTC is not seeking to transfer these cases to its home districts indicates that proximity to the forum is not actually a concern for it.” (Ex. H at 12.) Having taken those positions earlier this year in a case involving ten of the same patents on a motion to transfer to Apple’s home forum in California, Apple’s contrary position here seeking a transfer to Wisconsin cannot be taken seriously.

D. Judicial Economy Considerations and Other Relevant Public Interest Factors Weigh Heavily Against Transfer

The Third Circuit applies the following public interest factors in evaluating transfer questions: (1) the enforceability of the judgment, (2) practical considerations that could make the trial easier, quicker, or less expensive, (3) court congestion, (4) local interest in the

controversy, (5) public policies of the fora, and (6) the trial judge's familiarity with the applicable state law. *See id.* at *3.

1. Practical Considerations and Judicial Economy Weigh Heavily Against Transfer

Most significantly, practical considerations and judicial economy favor denial of transfer where, as here, there are co-pending suits involving the same patents and the same underlying technology in the forum. The Federal Circuit has stated that “the existence of multiple lawsuits involving the same issues is a paramount consideration when determining whether a transfer is in the interest of justice.” *In re Volkswagen of America, Inc.*, 566 F. 3d 1349, 1351 (Fed. Cir. 2009). In its recent refusal to order the Eastern District of Texas to reverse its denial of a transfer motion, the Federal Circuit noted that maintaining two cases before the same court involving the same patents and technology “may be beneficial from the standpoint of judicial resources,” even if the cases do not involve the same defendants and accused products. *In re Vistaprint Limited and OfficeMax Inc.*, Misc. Dkt No. 954, -- F.3d --, 2010 WL 5136034 (Fed. Cir. Dec. 15, 2010). (Ex. C at 4.) Apple itself has argued that “[o]ne of the most important factors in assessing the ‘interests of justice’ is whether transfer would permit related litigation to proceed in the same district.” (Ex. I at 12.)

2. Delaware's Substantial Interest Weighs Against Transfer

Delaware also has an interest in maintaining lawsuits brought by a corporate citizen such as Motorola. *See id.* at *5; *Acuity Brands*, 2008 WL 2977464 at *2 (denying transfer and stating that “Delaware clearly has a substantial interest in maintaining lawsuits brought by its corporate citizens”). None of the parties to this case is incorporated in Wisconsin or has any other ties that would give Wisconsin a local interest in the action. Defendants do not dispute that the remaining factors do not weigh in favor of transfer. (Defs. Br. at 12.)

Because the first-filed rule, the plaintiff's choice of forum, and judicial economy considerations weigh heavily against transfer, two other factors (convenience of the parties, local interest in the action) weigh against transfer, and the remaining factors do not weigh in favor of transfer, Defendants' motion should be denied.

III. The Doctrine of *Forum Non Conveniens* Is Inapplicable

Under Third Circuit law, courts invoke the doctrine of *forum non conveniens* to dismiss an action in favor of an alternative forum “when an alternative forum has jurisdiction to hear the case, and when trial in the chosen forum would establish . . . oppressiveness and vexation to a defendant . . . out of all proportion to plaintiff's convenience.” *Technology Development Corp. v. Onischenko*, 174 Fed. Appx. 117, 2006 WL 869292 at * 2 (3rd Cir. 2006) (vacating district court dismissal on *forum non conveniens* grounds where district court had failed to set out how much deference it accorded plaintiff's choice of forum); *Chase Bank USA N.A. v. Hess Kennedy Chartered LLC*, 589 F. Supp. 2d 490, 501-2 (D. Del. 2008) (denying motion to dismiss based on *forum non conveniens* and noting that “[o]rdinarily, dismissal will be appropriate where trial in the plaintiff's chosen forum imposes a heavy burden on the defendant or the court, and where the plaintiff is unable to offer any specific reasons of convenience supporting his choice”). Most *forum non conveniens* cases “involve a defendant, sued far from home, arguing against being forced to litigate in a remote forum.” *Technology Development Corp.*, 2006 WL 869292 at **5. Where a defendant conducts business throughout the United States, and has litigated in the allegedly inconvenient forum voluntarily, it is “very difficult for [a] [c]ourt to conclude that it would be ‘oppressive,’ ‘vexatious,’ or ‘out of all proportion to [Defendant’s] convenience’” to require the defendant to litigate in Delaware. *See Chase Bank*, 589 F. Supp. 2d at 502.

The *forum non conveniens* factors essentially parallel the transfer factors under 28 U.S.C. § 1404, except that dismissal based on *forum non conveniens* is a “more extraordinary step” than

transfer and requires an even more extensive showing by Defendants that Motorola's chosen forum is inconvenient. *See id.* Defendants have made no such showing here and their motion should be rejected.

CONCLUSION

For the foregoing reasons, Motorola respectfully requests that the Court deny Defendants' motion to dismiss or transfer.

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CERTIFICATE OF SERVICE

I hereby certify that on December 20, 2010, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to:

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