

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

RESEARCH IN MOTION LIMITED and §  
RESEARCH IN MOTION CORPORATION, §

Plaintiffs, §

CIVIL ACTION NO. 3:08-CV-0317-O

v. §

ECF

MOTOROLA, INC., §

Defendant. §

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MOTOROLA'S NOTICE OF RELATED CASE AND MOTION TO TRANSFER

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TO THE HONORABLE COURT:

Defendant Motorola, Inc., hereby files this Notice of Related Case and Motion to Transfer. This case relates to a recently filed case, 3:08CV0284-G, assigned to the Honorable A. Joe Fish, and Motorola requests that this case be transferred to that Court. Motorola respectfully further states as follows:

On February 21, 2008, Plaintiffs Research in Motion Limited and Research in Motion Corporation (collectively, "RIM") filed the complaint in this action. The Complaint requests, *inter alia*, declaratory judgment that RIM does not infringe Motorola's U.S. Patent Nos. 5,157,391; 5,394,140; 5,612,682; and 5,974,447. *See* Exhibit "A" at ¶¶15-34.

The Civil Cover Sheet in this action lists, as a related case, an action filed by RIM against Motorola, purportedly on February 16, 2008 (3:08CV0284-G), assigned to the Honorable A. Joe Fish, (the original action). *See* Exhibit "A" at 8. RIM's complaint in the original action asserts twenty-two claims for relief, including, *inter alia*, allegations that Motorola infringes nine patents under the patent laws; requests for declaratory judgment that RIM does not infringe

seven of Motorola's patents (not including the four patents in this action); allegations that Motorola has violated federal antitrust laws; and assertions of five state law claims. *See* Exhibit "B" at ¶¶115-137.

In addition to the two actions filed by RIM in this district, Motorola filed two separate actions in the District of Delaware and in the Eastern District of Texas.<sup>1</sup> *See* Exhibit "C"; Exhibit "D." There is considerable overlap between these four actions. With respect to each of the patents in those actions, one party affirmatively asserts patent infringement claims in one district, and the other party defensively seeks declaratory judgment in a different district.

On February 26, 2008, counsel for Motorola contacted counsel for RIM and requested that RIM consent to this transfer motion. On February 28, 2008, counsel for RIM informed counsel for Motorola that RIM was still considering Motorola's request. On March 2, 2008, RIM declined to consent to Motorola's request.

As RIM admits in the Civil Cover Sheet, this case is certainly related to the original action. The parties to the two actions are identical, and Motorola asserts that the four Motorola patents in this case are infringed by the same RIM products that infringe the seven Motorola patents involved in the original action. Throughout its Complaint in the original action, RIM refers to the negotiations between RIM and Motorola towards renewing a cross license agreement. That agreement, if consummated, would have encompassed the Motorola patents in suit here as well as the Motorola patents in suit in the original action. In its Complaint in the original action, RIM makes frequent reference to, and relies on, allegations to the effect that Motorola supposedly "has demanded exorbitant royalties for additional patents, not essential to

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<sup>1</sup> Motorola's actions, both denominated *Motorola v. Research In Motion Limited and Research In Motion Corporation*, are Civil Action No. 1:08-cv-00104 (D. Del.) (the Delaware action); and Civil Action No. 2:08-cv-00069-TJW (E.D. Tex.) (the E.D. Texas action).

the standards....” Exhibit “B” at ¶¶ 39, 88, 90, 92, 110, 165, 177, 192, 193, 201-202. Such nonessential patents encompass both the four Motorola patents of this action and the seven Motorola patents of the original action — patents in both actions were involved in the failed negotiations that RIM (incorrectly) alleges to have been the subject of exorbitant or unreasonable royalty demands.

In addition, given the multiplicity and duplication of averments spread out over four different actions in three districts, Motorola is considering motions seeking the most economical and expeditious manner of resolving the pending claims and disputes between the parties. Transferring this case as requested will facilitate and simplify that process, allowing one Judge in this District to consider and decide on the proper course of action.

The district court has the inherent power to transfer cases from one court to another for the expeditious administration of justice. *See, e.g., United States v. Martinez*, 686 F.2d 334, 338 (5th Cir. 1982).

Because the two actions obviously involve closely related issues of fact and law, it is appropriate for the Court to transfer this action to Judge Fish’s docket in the interest of judicial economy and to avoid the possibility of inconsistent outcomes.

Dated: March 4, 2008

Respectfully Submitted,

/s/ Eric W. Pinker

Eric W. Pinker (TSBN 16016550)

Mark E. Turk (TSBN 00786298)

Angela V. Colmenero (TSBN 24048399)

LYNN TILLOTSON & PINKER, LLP

750 N. St. Paul Street, Suite 1400

Dallas, Texas 75201

(214) 981-3837 Telephone

(214) 981-3839 Facsimile



*Of Counsel:*

Jesse J. Jenner (Motion For Admission *Pro Hac Vice* To Be Submitted)

ROPES & GRAY LLP

1211 Avenue of the Americas

New York, New York 10036

Telephone: (212) 596-9000

*jesse.jenner@ropesgray.com*

Norman H. Beamer (Motion For Admission *Pro Hac Vice* To Be Submitted)

ROPES & GRAY LLP

525 University Avenue

Palo Alto, CA 94301

Telephone: (650) 617-4000

*norman.beamer@ropesgray.com*

Nicole M. Jantzi (Motion For Admission *Pro Hac Vice* To Be Submitted)

ROPES & GRAY LLP

700 12th Street, NW, Suite 900

Washington, DC 20005

Telephone: (202) 508-4600

*nicole.jantzi@ropesgray.com*

**CERTIFICATE OF CONFERENCE**

Counsel for Motorola contacted counsel for RIM on February 26, 2008 to determine whether they were opposed to the relief requested in this motion. On March 2, 2008, counsel for RIM informed counsel for Motorola that it is opposed to this motion.

Certified on March 4, 2008.

/s/ Eric W. Pinker

Eric W. Pinker

**CERTIFICATE OF SERVICE**

The undersigned does hereby certify that a true and correct copy of the foregoing was served upon the following counsel *via ECF* on March 4, 2008.

George W. Bramblett, Jr.  
Phillip B. Philbin  
John R. Emerson  
HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Tel: 214-651-5000  
Fax: 214-651-5940

William F. Lee  
Michelle D. Miller  
William J. Bohler  
WILMER CUTLER PICKERING HALE AND DORR LLP  
60 State Street  
Boston, Massachusetts 02109  
Tel: 617-526-6000  
Fax: 617-526-5000

/s/ Eric W. Pinker

Eric W. Pinker