

United States District Court  
Northern District of California

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

APPLE INC.,

Plaintiff,

v.

VOIP-PAL.COM, INC.,

Defendant.

Case No. 20-CV-02460-LHK

**ORDER DENYING CONSOLIDATED  
MOTION TO DISMISS**

Re: Dkt. No. 32

AT&T CORP., et al.,

Plaintiffs,

v.

VOIP-PAL.COM, INC.,

Defendant.

Case No. 20-CV-02995-LHK

CELLCO PARTNERSHIP,

Plaintiff,

v.

VOIP-PAL.COM, INC.,

Defendant.

Case No. 20-CV-03092-LHK

Case Nos. 20-CV-02460-LHK, 20-CV-02995-LHK, 20-CV-03092-LHK  
ORDER DENYING CONSOLIDATED MOTION TO DISMISS

1 Plaintiffs Apple, Inc. (“Apple”); AT&T Corp., AT&T Services, Inc., and AT&T Mobility  
2 (collectively, “AT&T”); and Cellco Partnership d/b/a Verizon Wireless (“Verizon”) (collectively,  
3 “Plaintiffs”) each sue Defendant VoIP-Pal.com, Inc. (“Defendant”) for a declaration of non-  
4 infringement and invalidity of U.S. Patent No. 10,218,606 (“the ’606 patent”). In addition, Apple  
5 sues Defendant for a declaration of non-infringement and invalidity of U.S. Patent No. 9,935,872  
6 (“the ’872 patent”). Before the Court is Defendant’s consolidated motion to dismiss Plaintiffs’  
7 complaints.<sup>1</sup> Having considered the parties’ submissions, the relevant law, and the record in this  
8 case, the Court DENIES Defendant’s motion to dismiss.

9 **I. BACKGROUND**

10 This case represents the latest chapter in a long dispute between the parties regarding  
11 whether Plaintiffs infringe Defendant’s patents, which relate to a system for routing internet-  
12 protocol communications. Below, the Court discusses in turn: (1) the parties; (2) Defendant’s first  
13 set of lawsuits against the Plaintiffs, originally filed in the District of Nevada in 2016 (“the 2016  
14 cases”); (3) Defendant’s second set of lawsuits against Apple and Amazon, originally filed in the  
15 District of Nevada in 2018 (“the 2018 cases”); (4) Defendant’s most recent lawsuits against  
16 Plaintiffs, filed in the Western District of Texas in April of 2020 (“the Texas cases”); and (5) the  
17 instant cases, which were filed by Plaintiffs in this Court in April and May of 2020.

18 **A. The Parties**

19 Plaintiff Apple is a California corporation with its principal place of business in Cupertino,  
20 California. ECF No. 1 ¶ 7. Apple “designs, manufactures, and markets mobile communication and  
21 media devices and personal computers, and sells a variety of related software, services,  
22 accessories, networking solutions, and third-party digital content and applications.” *Id.* Apple  
23 “provides, supports, and/or operates messaging technology, including iMessage, an instant  
24 messaging service supported by Apple’s Messages application and computer infrastructure that  
25

26 <sup>1</sup> Briefing was consolidated in these three cases. For ease of reference and unless otherwise  
27 specified, the Court refers to documents filed in the Apple litigation, Case No. 20-CV-02460-  
28 LHK.

1 allows smartphone and desktop users to send messages including text, images, video and audio to  
2 other users.” *VoIP-Pal.Com, Inc. v. Apple Inc.*, 375 F. Supp. 3d 1110, 1117 (N.D. Cal. 2019)  
3 (quotation omitted).

4 Plaintiff AT&T Corp. is a New York corporation with its principal place of business in  
5 Bedminster, New Jersey. Case No. 20-CV-02995-LHK, ECF No. 1 ¶ 7. Plaintiff AT&T Services,  
6 Inc. is a Delaware corporation with its principal place of business in Dallas, Texas. *Id.* ¶ 8.  
7 Plaintiff AT&T Mobility LLC is a Delaware corporation with its principal place of business in  
8 Atlanta, Georgia. *Id.* ¶ 9. AT&T “supports and operates a messaging platform . . . [that] allows  
9 smartphone users to send messages including text, images, video and audio to others.” *VoIP-*  
10 *Pal.Com*, 375 F. Supp. 3d at 1117 (quotation omitted). AT&T also supports Voice over Internet  
11 Protocol products and services as well as a Wi-Fi based calling platform. *Id.* at 1117–18.

12 Plaintiff Cellco Partnership d/b/a Verizon Wireless is a Delaware corporation with its  
13 principal place of business in Basking Ridge, New Jersey. Case No. 20-CV-03092-LHK, ECF No.  
14 1 ¶ 7. Verizon “supports and operates a messaging platform . . . [that] allows smartphone users to  
15 send messages including text, images, video and audio to others.” *VoIP-Pal.Com*, 375 F. Supp. 3d  
16 at 1118 (quotation omitted). Verizon also supports Voice over Internet Protocol products and  
17 services and a Wi-Fi based calling platform. *Id.*

18 Defendant VoIP-Pal is a Nevada corporation with its principal place of business in  
19 Bellevue, Washington. ECF No. 1 ¶ 8. Defendant owns a portfolio of patents relating to Internet  
20 Protocol based communication. *VoIP-Pal.Com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926, 930 (N.D.  
21 Cal. 2019).

## 22 **B. The 2016 Cases**

23 On February 9, 2016, Defendant sued Apple in the District of Nevada for infringement of  
24 U.S. Patent Nos. 8,542,815 (“the ’815 patent”), and 9,179,005 (“the ’005 patent”), both of which  
25 relate to a system for routing calls between a caller and a callee over Internet Protocol. *VoIP-*  
26 *Pal.Com*, 375 F. Supp. 3d at 1118, 1122. The following day, Defendant sued Verizon and AT&T  
27 in the District of Nevada for infringement of the same patents. *Id.* On October 6, 2016, Defendant

1 sued Twitter in the District of Nevada for infringement of the same patents. *Id.* at 1121. The  
2 District of Nevada stayed the cases pending *inter partes* review. *Id.*

3 After the stays were lifted, on February 28, 2018, Twitter moved to change venue to the  
4 Northern District of California. *VoIP-Pal.Com, Inc. v. Twitter, Inc.*, Case No. 16-CV-02338, 2018  
5 WL 3543031, at \*1 (D. Nev. July 23, 2018). On July 23, 2018, the District of Nevada granted  
6 Twitter's motion for change of venue. *Id.* On October 1, 2018, the District of Nevada granted  
7 Verizon and Defendant's stipulation to transfer the case. *VoIP-Pal.Com*, 375 F. Supp. 3d at 1121.  
8 On October 4, 2018, the District of Nevada granted a similar stipulation by AT&T and Defendant.  
9 *Id.* The following day, the District of Nevada granted a similar stipulation by Apple and  
10 Defendant. *Id.* As a result, all four cases were transferred to this Court, where they were  
11 consolidated.

12 On March 25, 2019, this Court granted Apple, AT&T, Verizon, and Twitter's consolidated  
13 motion to dismiss all four cases. *Id.* at 1117. In a 45-page order, the Court concluded that the '815  
14 and '005 patents were unpatentable under 35 U.S.C. § 101. *Id.* at 1138, 1144. On March 16, 2020,  
15 the Federal Circuit affirmed this Court's decision. *VoIP-Pal.Com, Inc. v. Apple, Inc.*, 798 F. App'x  
16 644, 645 (Fed. Cir. 2020). On May 18, 2020, the Federal Circuit denied Defendant's petition for  
17 panel or en banc rehearing. *VoIP-Pal.Com, Inc. v. Twitter*, Case No. 2019-1808, ECF No. 99.

### 18 **C. The 2018 Cases**

19 On May 24, 2018, Defendant sued Apple in the District of Nevada for infringement of four  
20 more patents: U.S. Patent Nos. 9,537,762 ("the '762 patent"); 9,813,330 ("the '330 patent");  
21 9,826,002 ("the '002 patent"); and 9,948,549 ("the '549 patent"). *VoIP-Pal.Com*, 411 F. Supp. 3d  
22 at 934. Like the two patents that were the subject of the 2016 Cases, these four patents relate to a  
23 system for routing communications over Internet Protocol. *Id.* at 931. On June 15, 2018,  
24 Defendant sued Amazon in the District of Nevada for infringement of the same patents. *Id.* The  
25 lawsuits against Apple and Amazon were transferred from the District of Nevada to this Court,  
26 where they were consolidated and related to the 2016 cases. *Id.*

27 On November 1, 2019, this Court granted Apple and Amazon's consolidated motion to



1 dismiss both cases with prejudice. *Id.* at 930. Just as with the 2016 Cases, the Court concluded, in  
2 a 68-page order, that the four patents were unpatentable under 35 U.S.C. § 101. *Id.* at 941. On  
3 November 3, 2020, the Federal Circuit affirmed this Court’s decision. *VolP-Pal.Com, Inc. v.*  
4 *Apple, Inc.*, 828 F. App’x 717, 717 (Fed. Cir. 2020). If Defendant chooses to petition for  
5 rehearing, the petition is due on December 17, 2020. *See Order, VolP-Pal.Com, Inc. v. Apple, Inc.*,  
6 Case No. 2020-1241 (Fed. Cir. Nov. 9, 2020). If Defendant chooses to petition the United States  
7 Supreme Court for a writ of certiorari, Defendant’s petition is due on April 3, 2021. *See Order,*  
8 *March 19, 2020* (ordering that “the deadline to file any petition for a writ of certiorari due on or  
9 after the date of this order is extended to 150 days from the date of the lower court judgment”).

10 **D. The Texas Cases**

11 In April of 2020, Defendant sued Apple, AT&T, Verizon, Amazon, Facebook, and Google  
12 in the Waco Division of the Western District of Texas for infringement of the ’606 patent. *VolP-*  
13 *Pal.Com, Inc. v. Facebook, Inc.*, Case No. 20-CV-00267-ADA, ECF No. 1 (W.D. Tex. Apr. 2,  
14 2020); *VolP-Pal.Com, Inc. v. Google LLC*, Case No. 20-CV-00269-ADA, ECF No. 1 (W.D. Tex.  
15 Apr. 3, 2020); *VolP-Pal.Com, Inc. v. Amazon.Com, Inc.*, Case No. 20-CV-00272-ADA, ECF No.  
16 1 (W.D. Tex. Apr. 6, 2020); *VolP-Pal.Com, Inc. v. Apple Inc.*, Case No. 20-CV-00275-ADA,  
17 ECF No. 1 (W.D. Tex. Apr. 7, 2020); *VolP-Pal.Com, Inc. v. AT&T Inc.*, Case No. 20-CV-00325-  
18 ADA, ECF No. 1 (W.D. Tex. Apr. 24, 2020); *VolP-Pal.Com, Inc. v. Verizon Comms., Inc.*, Case  
19 No. 20-CV-00275-ADA, ECF No. 1 (W.D. Tex. Apr. 24, 2020). Like the six patents that were the  
20 subjects of the 2016 and 2018 Cases, the ’606 patent relates to a system for routing  
21 communications over Internet Protocol. Specifically, the ’606 patent shares a common  
22 specification, title, parent application, inventors, and owner with Defendants’ six other patents that  
23 were examined by this Court in the 2016 and 2018 cases. *Compare* ECF No. 1-1 *with VolP-*  
24 *Pal.Com, Inc. v. Apple Inc.*, Case No. 18-CV-06217-LHK, ECF No. 1-2.

25 On September 29, 2020, United States District Judge Alan Albright of the Western District  
26 of Texas stayed the six cases pending before him until this Court enters an order on the instant  
27 motion to dismiss and the motion to dismiss in a related declaratory judgment action, *Twitter, Inc.*

1 v. *VolP-Pal.com, Inc.*, Case No. 20-CV-02397-LHK. See *VolP-Pal.Com, Inc. v. Facebook, Inc.*,  
2 Case No. 20-CV-00267-ADA, ECF No. 47 (W.D. Tex. Apr. 2, 2020).

3 **E. The Instant Cases**

4 After Defendant filed the Texas cases, Plaintiffs filed the instant cases in the Northern  
5 District of California. On April 10, 2020, Apple sued Defendant for a declaration of non-  
6 infringement and invalidity of the '606 patent. ECF No. 1. On April 14, 2020, Apple amended its  
7 complaint to also seek a declaration of non-infringement and invalidity of the '872 patent. ECF  
8 No. 10. Like the '606 patent, the '872 patent shares a common specification, title, parent  
9 application, inventors, and owner with Defendants' six other patents that were examined by this  
10 Court in the 2016 and 2018 cases. Compare ECF No. 10-2 with *VolP-Pal.Com, Inc. v. Apple Inc.*,  
11 Case No. 18-CV-06217-LHK, ECF No. 1-2.

12 On April 30, 2020, AT&T also sued Defendant for a declaration of non-infringement and  
13 invalidity of the '606 patent. Case No. 20-CV-02995-LHK, ECF No. 1. On May 5, 2020, Verizon  
14 filed a similar complaint against Defendant. Case No. 20-CV-03092-LHK, ECF No. 1. In addition,  
15 on April 7, 2020, Twitter sued Defendant for a declaration of non-infringement and invalidity of  
16 the '606 patent. Case No. 20-CV-02397-LHK, ECF No. 1.

17 On April 27, 2020, this Court granted Apple's motion to relate its declaratory judgment  
18 action to the 2016 case against Apple. ECF No. 18. Similarly, on May 22, 2020, this Court granted  
19 AT&T's motion to relate its declaratory judgment action to the 2016 case against AT&T. Case  
20 No. 20-CV-02995-LHK, ECF No. 23. On May 26, 2020, this Court granted Verizon's motion to  
21 relate its declaratory judgment action to the 2016 case against Verizon. Case No. 20-CV-03092-  
22 LHK, ECF No. 18. On May 26, 2020, this Court related the Apple, AT&T, Verizon, and Twitter  
23 cases. ECF No. 24. On June 4, 2020, this Court consolidated the motion to dismiss briefing for the  
24 Apple, AT&T, and Verizon cases but ordered that the motion to dismiss in the Twitter case be  
25 briefed separately. ECF No. 26.

26 On July 10, 2020, Defendant filed a consolidated motion to dismiss the instant case. ECF  
27 No. 32 ("Mot."). On July 31, 2020, Plaintiffs filed a consolidated opposition. ECF No. 43

1 (“Opp’n”). On August 14, 2020, Defendant filed a reply. ECF No. 44 (“Reply”).

2 **II. LEGAL STANDARD**

3 **A. Motion to Dismiss Under Rule 12(b)(1)**

4 A defendant may move to dismiss for lack of subject matter jurisdiction pursuant to Rule  
5 12(b)(1) of the Federal Rules of Civil Procedure. While lack of statutory standing requires  
6 dismissal for failure to state a claim under Rule 12(b)(6), lack of Article III standing requires  
7 dismissal for want of subject matter jurisdiction under Rule 12(b)(1). *See Maya v. Centex Corp.*,  
8 658 F.3d 1060, 1067 (9th Cir. 2011).

9 “A Rule 12(b)(1) jurisdictional attack may be facial or factual.” *Safe Air for Everyone v.*  
10 *Meyer*, 373 F.3d 1035, 1039 (9th Cir. 2004). “In a facial attack, the challenger asserts that the  
11 allegations contained in a complaint are insufficient on their face to invoke federal jurisdiction.”  
12 *Id.* The Court “resolves a facial attack as it would a motion to dismiss under Rule 12(b)(6):  
13 Accepting the plaintiff’s allegations as true and drawing all reasonable inferences in the plaintiff’s  
14 favor, the court determines whether the allegations are sufficient as a legal matter to invoke the  
15 court’s jurisdiction.” *Leite v. Crane Co.*, 749 F.3d 1117, 1121 (9th Cir. 2014). “[I]n a factual  
16 attack,” on the other hand, “the challenger disputes the truth of the allegations that, by themselves,  
17 would otherwise invoke federal jurisdiction.” *Safe Air for Everyone*, 373 F.3d at 1039. “In  
18 resolving a factual attack on jurisdiction,” the Court “may review evidence beyond the complaint  
19 without converting the motion to dismiss into a motion for summary judgment.” *Id.* The Court  
20 “need not presume the truthfulness of the plaintiff’s allegations” in deciding a factual attack. *Id.*

21 Once the defendant has moved to dismiss for lack of subject matter jurisdiction under Rule  
22 12(b)(1), the plaintiff bears the burden of establishing the Court’s jurisdiction. *See Chandler v.*  
23 *State Farm Mut. Auto Ins. Co.*, 598 F.3d 1115, 1122 (9th Cir. 2010).

24 **B. Motion to Dismiss Under Rule 12(b)(2)**

25 In a motion challenging personal jurisdiction under Federal Rule of Civil Procedure  
26 12(b)(2), the plaintiff, as the party seeking to invoke the jurisdiction of the federal court, has the  
27 burden of establishing that jurisdiction exists. *See In re Boon Global Ltd.*, 923 F.3d 643, 650 (9th



1 Cir. 2019). “Where, as here, the defendant’s motion is based on written materials rather than an  
2 evidentiary hearing, ‘the plaintiff need only make a prima facie showing of jurisdictional facts to  
3 withstand the motion to dismiss.’” *Ranza v. Nike, Inc.*, 793 F.3d 1059, 1068 (9th Cir. 2015)  
4 (quoting *CollegeSource, Inc. v. AcademyOne, Inc.*, 653 F.3d 1066, 1073 (9th Cir. 2011)).

5 However, this standard “is not toothless,” and the party asserting jurisdiction “cannot  
6 simply rest on the bare allegations of its complaint.” *In re Boon Global Ltd.*, 923 F.3d at 650  
7 (quoting *Schwarzenegger v. Fred Martin Motor Co.*, 374 F.3d 797, 800 (9th Cir. 2004)). Thus,  
8 courts may consider declarations and other evidence outside the pleadings to determine whether it  
9 has personal jurisdiction. *See id.* At this stage of the proceeding, “uncontroverted allegations in  
10 plaintiff’s complaint must be taken as true, and ‘[c]onflicts between parties over statements  
11 contained in affidavits must be resolved in the plaintiff’s favor.’” *Id.* (quoting *Schwarzenegger*,  
12 374 F.3d at 800). On the other hand, courts “may not assume the truth of allegations in a pleading  
13 which are contradicted by affidavit.” *Mavrix Photo, Inc. v. Brand Techs., Inc.*, 647 F.3d 1218,  
14 1223 (9th Cir. 2011).

#### 15 **C. Motion to Dismiss Under Rule 12(b)(3)**

16 Under Federal Rule of Civil Procedure 12(b)(3), a defendant may move to dismiss a  
17 complaint for improper venue. Once the defendant has challenged the propriety of venue in a  
18 given court, the plaintiff bears the burden of showing that venue is proper. *Piedmont Label Co. v.*  
19 *Sun Garden Packing Co.*, 598 F.2d 491, 496 (9th Cir. 1979). When considering a motion to  
20 dismiss for improper venue, a court may consider facts outside of the pleadings. *Murphy v.*  
21 *Schneider National, Inc.*, 362 F.3d 1133, 1138 (9th Cir. 2004).

22 Pursuant to 28 U.S.C. § 1406(a), if the court determines that venue is improper, the court  
23 must either dismiss the action or, if it is in the interests of justice, transfer the case to a district or  
24 division in which it could have been brought. Whether to dismiss for improper venue, or  
25 alternatively to transfer venue to a proper court, is a matter within the sound discretion of the  
26 district court. *See King v. Russell*, 963 F.2d 1301, 1304 (9th Cir. 1992).

#### 27 **D. Leave to Amend**



1 If the Court determines that a complaint should be dismissed, it must then decide whether  
2 to grant leave to amend. Under Rule 15(a) of the Federal Rules of Civil Procedure, leave to amend  
3 “shall be freely given when justice so requires,” bearing in mind “the underlying purpose of Rule  
4 15 to facilitate decisions on the merits, rather than on the pleadings or technicalities.” *Lopez v.*  
5 *Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc) (alterations and internal quotation marks  
6 omitted). When dismissing a complaint for failure to state a claim, “a district court should grant  
7 leave to amend even if no request to amend the pleading was made, unless it determines that the  
8 pleading could not possibly be cured by the allegation of other facts.” *Id.* at 1130 (internal  
9 quotation marks omitted). Accordingly, leave to amend generally shall be denied only if allowing  
10 amendment would unduly prejudice the opposing party, cause undue delay, or be futile, or if the  
11 moving party has acted in bad faith. *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522, 532  
12 (9th Cir. 2008).

### 13 **III. DISCUSSION**

14 Defendant moves to dismiss the instant three cases for three reasons: (1) this Court should  
15 decline to exercise jurisdiction under the first-to-file rule; (2) this Court lacks personal jurisdiction  
16 over Defendant; and (3) venue is improper. Mot. at 8–18. In addition, Defendant argues that  
17 Apple’s claim for a declaration of non-infringement and invalidity of the ’872 patent should be  
18 dismissed because the Court lacks subject matter jurisdiction over that claim. Mot. at 18–21.  
19 Defendant’s argument stems from the fact that Defendant has not sued Apple for infringement of  
20 the ’872 patent.

21 The Court first analyzes Defendants’ arguments regarding the first-to-file rule, personal  
22 jurisdiction, and venue. The Court’s analysis of these arguments applies equally to each of the  
23 instant three cases. The Court then addresses Defendant’s argument regarding subject matter  
24 jurisdiction, which only pertains to Apple’s claim regarding the ’872 patent.

#### 25 **A. First-To-File Rule**

26 Defendant first argues that this Court should exercise its discretion to dismiss the instant  
27 three cases under the first-to-file rule. Mot. at 5–15. The first-to-file rule is “a doctrine of federal

1 comity . . . that generally favors pursuing only the first-filed action when multiple lawsuits  
2 involving the same claims are filed in different jurisdictions.” *Merial Ltd. v. Cipla Ltd.*, 681 F.3d  
3 1283, 1299 (Fed. Cir. 2012). The first-to-file rule is “intended to avoid conflicting decisions and  
4 promote judicial efficiency.” *Id.* “Resolution of whether the second-filed action should proceed  
5 presents a question sufficiently tied to patent law that the question is governed by [Federal Circuit]  
6 law.” *Futurewei Tech., Inc. v. Acacia Research Corp.*, 737 F.3d 704, 708 (Fed. Cir. 2013).

7 The first-to-file rule “is not absolute; exceptions may be made if justified by  
8 ‘considerations of judicial and litigant economy, and the just and effective disposition of  
9 disputes.’” *Acacia*, 737 F.3d at 708 (quoting *Elecs. for Imaging, Inc. v. Coyle*, 394 F.3d 1341,  
10 1347 (Fed. Cir. 2005)). “Exceptions . . . are not rare,” but “[t]here must be . . . sound reason that  
11 would make it unjust or inefficient to continue the first-filed action.” *Elecs. for Imaging*, 394 F.3d  
12 at 1347 (quoting *Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 937–38 (Fed. Cir. 1993)).

13 “Application of the first-to-file rule is generally a matter for a district court’s discretion,  
14 exercised within governing legal constraints.” *Acacia*, 737 F.3d at 708. In determining whether the  
15 first-to-file rule should be applied, “an ample degree of discretion, appropriate for disciplined and  
16 experienced judges, must be left to the lower courts.” *Cipla*, 681 F.3d at 1299 (quoting *Kerotest*  
17 *Mfg. Co. v. C–O–Two Fire Equip. Co.*, 342 U.S. 180, 183–84 (1952)). To apply the first-to-file  
18 rule, courts must generally consider: (1) the chronology of the actions; (2) the similarity of the  
19 parties; and (3) the similarity of the issues. *Alltrade, Inc. v. Uniweld Prods.*, 946 F.2d 622, 625–26  
20 (9th Cir. 1991).

21 Defendant contends that all three of these factors favor application of the first-to-file rule.  
22 Mot. at 7. First, Defendant contends that the chronology of the actions favors applying the rule  
23 because the Texas cases were filed before the instant cases. Mot. at 7. Defendant contends that the  
24 parties are sufficiently similar because the parties in the instant cases are exactly the same as the  
25 parties in the Texas cases, with the exception of AT&T Mobility. *Id.* Finally, Defendant argues  
26 that the issues are the same because both the Texas cases and the instant cases concern whether  
27 Plaintiffs have infringed the ’606 patent. *Id.*

1 However, Defendant's argument completely ignores the history of disputes between the  
2 parties regarding whether Plaintiffs infringe Defendant's family of patents related to  
3 communications over internet protocol, including a set of cases filed in 2016 and another set filed  
4 in 2018, all of which were adjudicated by this Court. *See* p. 3–5, *supra* (recounting the history of  
5 the 2016 and 2018 cases). Based on the existence of these prior cases, the Court determines that  
6 the first-to-file rule should not be applied here because there is "sound reason that would make it  
7 unjust or inefficient to continue" the Texas cases. *Elects. for Imaging*, 394 F.3d at 1347 (quoting  
8 *Genentech*, 998 F.2d at 937–38).

9 Specifically, it would be more efficient for this Court to resolve the parties' dispute  
10 regarding the '606 patent because this Court already resolved the parties' disputes regarding the  
11 patentability of Defendant's six other patents in the 2016 and 2018 cases. *See VolP-Pal.Com*, 375  
12 F. Supp. 3d at 1110; *VolP-Pal.Com, Inc.*, 411 F. Supp. 3d at 926. The six patents that the Court  
13 analyzed in the 2016 and 2018 cases share a common specification, title, parent application,  
14 inventors, and owner with the '606 patent. *Compare* ECF No. 1-1 with *VolP-Pal.Com, Inc. v.*  
15 *Apple Inc.*, Case No. 18-CV-06217-LHK, ECF No. 1-2. Moreover, the 2016, 2018, and instant  
16 cases involve substantially similar technology and accused products. In the 2016 and 2018 cases,  
17 this Court wrote 113 pages addressing the validity of Defendants' patents and was subsequently  
18 affirmed by the Federal Circuit. *See VolP-Pal.Com*, 375 F. Supp. 3d at 1110 (45-page opinion),  
19 *aff'd*, 798 F. App'x at 645; *VolP-Pal.Com, Inc.*, 411 F. Supp. 3d at 926 (68-page opinion), *aff'd*,  
20 828 F. App'x at 717. By contrast, the Western District of Texas has not previously adjudicated the  
21 parties' disputes regarding this family of patents. Accordingly, given this Court's familiarity with  
22 these disputes, it would be more efficient for this Court to adjudicate the instant cases.<sup>2</sup>

23  
24 <sup>2</sup> Defendant argues that, "[w]ithout a dismissal, judicial resources will be inefficiently spent  
25 because 'the same issues addressed by the [Texas] court will be needlessly reconsidered' by this  
26 Court." Mot. at 8 (quotation omitted). However, Defendant's argument is actually a reason for this  
27 Court to consider the instant cases. Because this Court has already become familiar with the  
28 Defendant's family of patents and Plaintiff's allegedly infringing technologies, having the Texas  
court address these issues would mean that the same issues addressed by this Court would be  
needlessly reconsidered by the Texas court.



1 Furthermore, it would be more efficient for the instant cases to be heard in this district  
2 because of the relative ease of access to sources of proof. Indeed, a significant amount of evidence  
3 relevant to potentially infringing conduct is located in this district, where one of the Plaintiffs,  
4 Apple, is incorporated and has its principal place of business. *See In re Genentech*, 566 F.3d 1338,  
5 1345 (Fed. Cir. 2009) (“In patent infringement cases, the bulk of the relevant evidence usually  
6 comes from the accused infringer.”). In addition, hearing the cases in this district would be more  
7 convenient for witnesses from Plaintiff Apple, which is located in this district. *In re Apple*, --- F.  
8 3d ---, 2020 WL 6554063, at \*7 (Fed. Cir. 2020) (concluding that the location of witnesses  
9 weighed in favor of transferring a patent infringement case against Apple from the Western  
10 District of Texas to this district).

11 In similar circumstances, the Federal Circuit recently granted a writ of mandamus  
12 permitting Apple to transfer a patent infringement case from the Western District of Texas to this  
13 district. *Id.* at \*3. The Federal Circuit concluded that the district court had abused its discretion in  
14 denying Apple’s motion to transfer because evidence relevant to the infringing conduct, as well as  
15 witnesses, were located in this district, where Apple is headquartered. *Id.* at \*4, \*7. The Federal  
16 Circuit also emphasized that there were significant connections between this district and the events  
17 that gave rise to the suit — Apple’s development of potentially infringing products. *Id.* at \*9.  
18 Finally, the Federal Circuit explained that other cases in the district presented overlapping issues.  
19 *Id.* at \*8. For similar reasons, it would be more efficient for the instant cases to be heard by this  
20 Court.

21 In addition to promoting judicial efficiency, permitting this Court to hear the instant cases  
22 would also achieve the first-to-file rule’s goal of “avoid[ing] conflicting decisions.” *Cipla*, 681  
23 F.3d at 1299. This Court has already concluded in two opinions that six of Defendant’s patents  
24 failed to recite patent-eligible subject matter, and this Court’s opinions were affirmed by the  
25 Federal Circuit. *VolP-Pal.Com*, 375 F. Supp. 3d at 1138, 1144, *aff’d*, *VolP-Pal.Com, Inc.*, 798 F.  
26 App’x at 645; *VolP-Pal.Com, Inc.*, 411 F. Supp. 3d at 941, *aff’d*, 828 F. App’x at 717. Given that  
27 the ’606 patent shares a common specification, title, parent application, inventors, and owner with



1 Defendants' six other patents that were examined by this Court in the 2016 and 2018 cases, the  
2 Western District of Texas's decision on the '606 patent could conflict with this Court's prior  
3 orders. This potential conflict is exactly what the first-to-file rule is intended to avoid. *Cipla*, 681  
4 F.3d at 1299.

5 Furthermore, Defendant never provides any reason why these cases should be heard by  
6 Judge Albright in Waco, Texas. Defendant is neither incorporated in nor headquartered in Texas,  
7 much less in Waco, which is located over 100 miles from Austin. ECF No. 1 ¶ 8. Defendant never  
8 alleges that witnesses or evidence relevant to this case are located in Waco or Texas, or that the  
9 events that gave rise to this case occurred in Waco or Texas. These circumstances suggest that  
10 Defendant may be forum shopping, attempting to avoid this Court's unfavorable decisions by  
11 filing in another district.

12 Defendant argues that Plaintiffs "have engaged in blatant forum shopping." Mot. at 11.  
13 The Court disagrees. Whether or not this district is Plaintiffs' preferred forum, Plaintiffs had  
14 legitimate reasons to file in this district, including the presence of Plaintiff Apple's headquarters in  
15 this district and the fact that this Court resolved related cases involving patents from the same  
16 family that share a common specification, title, parent application, inventor, and owner as well as  
17 substantially similar technology and accused products as the instant cases. By contrast, Defendant  
18 filed its latest cases in Waco, Texas, where Defendant lacks ties.

19 The Court declines to apply the first-to-file rule to permit Defendant to forum shop.  
20 Indeed, courts have recognized that the first-to-file rule should not be applied in cases of forum-  
21 shopping. *See Genentech*, 998 F.2d at 938 (explaining that "first-filed suits have sometimes been  
22 dismissed when forum shopping was the only motive for the filing"); *Alexander v. Franklin Res.,*  
23 *Inc.*, Case No. 06-7121, 2007 WL 518859, at \*4 (N.D. Cal. Feb. 14, 2007) (declining to apply the  
24 first-to-file rule because "[o]ne could reasonably infer forum-shopping here, where the same  
25 plaintiff . . . filed a similar lawsuit in New Jersey, and after receiving unfavorable rulings from that  
26 court, filed the instant case").

27 Moreover, courts are less likely to apply the first-to-file rule when the cases are filed close

1 together. *See, e.g., Tempco Elec. Heater Corp. v. Omega Engineering, Inc.*, 819 F.2d 746, 749  
2 (7th Cir. 1987) (declining to apply first-to-file rule when second case was filed four days later);  
3 *Assoc. Mills, Inc. v. Regina Co., Inc.*, 675 F. Supp. 446, 448 (N.D. Ill. 1987) (twelve days later).  
4 The instant cases the Northern District of California were each filed within days of their  
5 counterparts in the Western District of Texas. Apple filed its lawsuit in this district just three days  
6 after being sued in the Western District of Texas. Similarly, AT&T filed its complaint six days  
7 after being sued, and Verizon filed its complaint eleven days after being sued. Because the cases  
8 were filed so close together, the first-to-file rule has less force. Thus, the Court declines to apply  
9 the first-to-file rule in favor of the Texas cases.

#### 10 **B. Personal Jurisdiction**

11 Defendant next argues that this Court lacks personal jurisdiction over it. Mot. at 15–17.  
12 The Court applies Federal Circuit law to the question of whether the Court has personal  
13 jurisdiction over Plaintiffs’ infringement claims because “the jurisdictional issue is ‘intimately  
14 involved with the substance of the patent laws.’” *Avocent Huntsville Corp. v. Aten Int’l Co.*, 552  
15 F.3d 1324, 1328 (Fed. Cir. 2008) (quoting *Akro Corp. v. Luker*, 45 F.3d 1541, 1543 (Fed. Cir.  
16 1995)). “Determining whether personal jurisdiction exists over an out-of-state defendant involves  
17 two inquiries: whether a forum state’s long-arm statute permits service of process, and whether the  
18 assertion of personal jurisdiction would violate due process.” *Avocent*, 552 F.3d at 1329 (quoting  
19 *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1359 (Fed. Cir. 2001)).

20 California’s long arm statute, Cal. Civ. Proc. Code § 410.10, is co-extensive with federal  
21 due process requirements, and therefore the jurisdictional analyses under California law and  
22 federal due process merge into one. *See* Cal. Civ. Proc. Code § 410.10 (“[A] court of this state  
23 may exercise jurisdiction on any basis not inconsistent with the Constitution of this state or of the  
24 United States.”); *Mavrix Photo, Inc. v. Brand Techs., Inc.*, 647 F.3d 1218, 1223 (9th Cir. 2011)  
25 (“California’s long-arm statute . . . is coextensive with federal due process requirements, so the  
26 jurisdictional analyses under state law and federal due process are the same.”).

27 For a court to exercise personal jurisdiction over a defendant consistent with due process,

1 that defendant must have “certain minimum contacts” with the relevant forum “such that the  
2 maintenance of the suit does not offend ‘traditional notions of fair play and substantial justice.’”  
3 *Int’l Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945) (quoting *Milliken v. Meyer*, 311 U.S. 457,  
4 463 (1940)).

5 A court may exercise either general or specific jurisdiction over a defendant. *Avocent.*, 552  
6 F.3d at 1330. “To be subject to general jurisdiction, a defendant business entity must maintain  
7 ‘continuous and systematic general business contacts’ with the forum, even when the cause of  
8 action has no relation to those contacts.” *Synthes (U.S.A.) v. G.M. Dos Reis Jr. Ind. Com. de*  
9 *Equip. Medico*, 563 F.3d 1285, 1297 (Fed. Cir. 2009) (quotation omitted). In the instant case,  
10 Plaintiffs do not argue that Defendant is subject to general jurisdiction in this forum. Accordingly,  
11 the Court considers whether the Court has specific jurisdiction over Defendant.

12 Specific jurisdiction is appropriate when a suit “aris[es] out of or relate[s] to the  
13 defendant’s contacts with the forum.” *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466  
14 U.S. 408, 414 n. 8 (1984). To determine whether a court can exercise specific jurisdiction  
15 consistent with due process, the Federal Circuit considers: “(1) whether the defendant  
16 ‘purposefully directed’ its activities at residents of the forum; (2) whether the claim ‘arises out of  
17 or relates to’ the defendant’s activities with the forum; and (3) whether assertion of personal  
18 jurisdiction is ‘reasonable and fair.’” *Xilinx, Inc. v. Papst Licensing GmbH & Co. KG*, 848 F.3d  
19 1346, 1353 (Fed. Cir. 2017) (quoting *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1360 (Fed. Cir.  
20 2001)). “The first two factors correspond with the minimum contacts prong of the [International  
21 Shoe] analysis, and the third factor corresponds with the ‘fair play and substantial justice’ prong of  
22 the analysis.” *Inamed*, 249 F.3d at 1360. The Court initially considers the first two factors. The  
23 Court then considers the third factor.

24 **1. Whether the Defendant Purposefully Directed Its Activities at Residents of the**  
25 **Forum, and Whether the Claim Arises Out of or Relates to Those Activities**

26 The first two factors require the Court to determine whether the defendant purposefully  
27 directed its activities at residents of the forum, and whether the claim arises out of or relates to



1 those activities. *Xilinx*, 848 F.3d at 1353. With respect to the first factor, “it is essential in each  
2 case that there be some act by which the defendant purposefully avails itself of the privilege of  
3 conducting activities within the forum State, thus invoking the benefits and protections of its  
4 laws.” *Id.* (quoting *Hanson v. Denckla*, 357 U.S. 235, 253 (1958)). As to the second factor, “the  
5 court must determine whether ‘the suit aris[es] out of or relate[s] to the defendant’s contacts with  
6 the forum.’” *Id.* (quoting *Goodyear Dunlop Tires Operations, S.A. v. Brown*, 564 U.S. 915, 923–  
7 24 (2011)).

8 The plaintiff has the burden of establishing these two factors. *Elecs. for Imaging v. Coyle*,  
9 340 F.3d 1344, 1350 (Fed. Cir. 2003). “Without discovery and a record on jurisdiction, [the Court]  
10 must resolve all factual disputes in the plaintiff’s favor.” *Nuance Comms., Inc. v. Abbyy Software*  
11 *House*, 626 F.3d 1222, 1231 (Fed. Cir. 2010). “[W]here the plaintiff’s factual allegations are not  
12 directly controverted, [they] are taken as true for purposes of determining jurisdiction.” *Id.*  
13 (quoting *Akro*, 45 F.3d at 1543). “To survive a motion to dismiss in the absence of jurisdictional  
14 discovery, plaintiffs need only make a prima facie showing of jurisdiction.” *Id.*

15 When the plaintiff is bringing a declaratory judgment for non-infringement, the claim  
16 “arises out of or relates to the activities of the defendant patentee in enforcing the patent or patents  
17 in suit.” *Avocent*, 552 F.3d at 1332. “The relevant inquiry for specific personal jurisdiction then  
18 becomes to what extent has the defendant patentee ‘purposefully directed [such enforcement  
19 activities] at residents of the forum,’ and the extent to which the declaratory judgment claim  
20 ‘arises out of or relates to those activities.’” *Id.* (quoting *Breckenridge Pharm., Inc. v. Metabolite*  
21 *Labs*, 444 F.3d 1356, 1363 (Fed. Cir. 2006)). “A declaratory judgment claim arises out of the  
22 patentee’s contacts with the forum state only if those contacts ‘relate in some material way to the  
23 enforcement or the defense of the patent.’” *Maxchief Invs. Ltd. v. Wok & Pan, Ind., Inc.*, 909 F.3d  
24 1134, 1138 (Fed. Cir. 2018) (quoting *Avocent*, 552 F.3d at 1336).

25 Under Federal Circuit law, “ordinary cease-and-desist notices sent by a patentee to an  
26 alleged infringing party in a different state are not sufficient to subject the patentee to specific  
27 jurisdiction in that state.” *Radio Sys. Corp. v. Accession, Inc.*, 638 F.3d 785, 789 (Fed. Cir. 2011).



1 “The crux of the due process inquiry should focus first on whether the defendant has had contact  
2 with parties in the forum state beyond the sending of cease and desist letters.” *Breckenridge*, 444  
3 F.3d at 1366. Indeed, “certain other patent enforcement actions, taken in conjunction with the  
4 issuance of cease-and-desist letters, are sufficient to support specific jurisdiction.” *Id.* “Examples  
5 of these ‘other activities’ include initiating judicial or extrajudicial patent enforcement within the  
6 forum, or entering into an exclusive license agreement or other undertaking which imposes  
7 enforcement obligations with a party residing or regularly doing business in the forum.” *Avocent*,  
8 552 F.3d at 1334. These activities need not be directed towards parties in the lawsuit. *Id.*

9 In the instant case, the Court concludes that Defendant has purposefully directed its  
10 enforcement activities towards the forum state by: (1) litigating six lawsuits on claims of  
11 infringement of patents in the same family in the Northern District of California (2) stipulating to  
12 transfer five lawsuits, four of them against Plaintiffs in the instant three cases, to this district; (3)  
13 never contesting personal jurisdiction in the Northern District of California in those six lawsuits;  
14 (4) engaging multiple California law firms in its infringement lawsuits; and (5) meeting with  
15 Apple in the Northern District of California in 2016 regarding claims of infringement of patents in  
16 the same family. The Court first considers Defendant’s litigation efforts in this district and then  
17 considers Defendant’s meetings with Apple.

18 First, the fact that a defendant “has engaged in judicial patent enforcement (with respect to  
19 the patents at issue or a related patent)” in the same district can support personal jurisdiction.  
20 *ActiveVideo Networks, Inc. v. TransVideo Elecs., Ltd.*, 975 F. Supp. 2d 1083, 1097–98 (N.D. Cal.  
21 2013); *see also Avocent*, 552 F.3d at 1338–39 (noting that a lawsuit in the same forum on the same  
22 patent “is a significant contact with the forum materially related to the enforcement of the relevant  
23 patent”). For example, another court in this district found that a defendant had purposefully  
24 directed its activities to the forum by litigating six cases in this district “regarding the very same or  
25 related patents.” *Id.* at 1096–97. Furthermore, the District of New Jersey found that a defendant  
26 had purposefully directed its activities to the forum by suing other defendants in that district for  
27 patent infringement. *Pro Sports Inc. v. West*, 639 F. Supp. 2d 475, 481 (D.N.J. 2009). In addition,

1 the District of Maryland concluded that personal jurisdiction existed when a defendant had filed “a  
2 prior suit against [the plaintiff in the district] with respect to related patents.” *Neuralstem, Inc. v.*  
3 *StemCells, Inc.*, 573 F. Supp. 2d 888, 898 (D. Md. 2008).<sup>3</sup>

4 Accordingly, Defendant’s act of litigating six cases in this district regarding related patents  
5 demonstrates that Defendant has purposefully directed its enforcement activities towards the  
6 forum state. Defendant points out that, unlike in *ActiveVideo*, *Pro Sports*, and *Neuralstem*,  
7 Defendant did not file its infringement lawsuits in this district—rather, Defendant filed in Nevada.  
8 However, Defendant stipulated to transfer its infringement lawsuits against Apple, Verizon, and  
9 AT&T to this district. Defendant then litigated those cases in this district without contesting  
10 personal jurisdiction.

11 Furthermore, even if Defendant had opposed the transfer of its infringement lawsuits  
12 against Apple, AT&T, and Verizon to this district, Defendant still would have purposefully  
13 availed itself of the courts in California because Defendant continued to prosecute its lawsuits in  
14 this district. In *Kyocera Communications v. Potter Voice Technologies*, the district court relied on  
15 this same reasoning. Case No. 13-CV-0766-H, 2013 WL 2456032, at \*3 (S.D. Cal. June 5, 2013).  
16 In that case, the defendant had initially brought suit in Colorado and opposed transfer to  
17 California. *Id.* The district court nonetheless concluded that the defendant had purposefully availed  
18 itself of the California courts because the defendant had continued prosecuting the lawsuit in  
19 California. *Id.* The instant cases more strongly support a finding of personal jurisdiction because  
20 Defendant stipulated to transfer its lawsuits to this district and then did not contest personal  
21 jurisdiction in this district. Accordingly, the Court concludes that Defendant’s infringement  
22

23  
24 <sup>3</sup> In *Xilinx*, the Federal Circuit stated: “We have considered forum-related activities of the patentee  
25 with respect to the patents in suit that do not necessarily relate to the particular controversy, such  
26 as exclusive licensing, though at the same time we have (appropriately) rejected the existence of  
27 contacts concerning other patents as being pertinent to the minimum contacts analysis.” *Xilinx*,  
848 F.3d at 1353. However, *Xilinx* itself did not raise the question of whether courts can consider  
litigation involving other patents. Moreover, this statement is not specific to litigation involving  
related patents, like the patents at issue here.

1 litigation, involving substantially similar technology and accused products as well as six patents  
2 from the same family that share a common specification, title, parent application, inventors, and  
3 owner as the patents at issue here, demonstrates that Defendant purposefully directed its  
4 enforcement activities towards this district.

5 In addition, the Court notes that Defendant has engaged California lawyers for the 2016  
6 and 2018 cases, as well as the instant cases. Courts have found that defendants purposefully  
7 directed their enforcement activities to the forum state by hiring lawyers from that state to  
8 prosecute their infringement actions. *See, e.g., Kyocera*, 2013 WL 2456032, at \*3 (concluding that  
9 the defendant had purposefully directed its enforcement activities to California because the  
10 defendant was suing California residents for infringement and had “retained counsel in California  
11 for that lawsuit”). So too here.

12 Furthermore, beyond stipulating to transfer these Plaintiffs’ cases to the Northern District  
13 of California, Defendant made efforts to enforce its family of patents in this district. For example,  
14 Defendant’s representative met with Apple in Sunnyvale, California, located in this district,  
15 regarding Apple’s potential infringement of Defendant’s patents. *Modi Decl.* ¶ 2. Courts have  
16 concluded that similar meetings can give rise to personal jurisdiction. *See Xilinx*, 848 F.3d at 1354  
17 (finding personal jurisdiction over a defendant in a declaratory judgment action because the  
18 defendant “purposefully directed its activities to California when it sent multiple notice letters to  
19 [the plaintiff] and traveled there to discuss [the plaintiff’s] alleged patent infringement and  
20 potential licensing arrangements”); *Elecs. for Imaging*, 340 F.3d at 1351 (finding personal  
21 jurisdiction over defendants in a declaratory judgment action where “two representatives of  
22 defendants visited [plaintiff’s] facility in California”). The Court comes to the same conclusion in  
23 the instant three cases.<sup>4</sup>

24  
25 <sup>4</sup> In addition to its meeting with Apple, Defendants likely investigated their infringement claims  
26 against Apple and Twitter, which reside in this district, and that investigation would have also  
27 constituted purposefully directing enforcement activities at the forum. *See PharmaNet, Inc. v.*  
28 *DataSci Ltd. Liability Co.*, Case No. 08-2965, 2009 WL 396180, at \*13 (D.N.J. 2009) (concluding  
that there was personal jurisdiction because “it is likely that Defendant took steps to investigate



1 In sum, the Court concludes that Defendant has undertaken substantial enforcement  
2 activities in California, including prosecuting their six lawsuits for infringement of patents from  
3 the same family, meeting with Apple in California regarding infringement, and retaining counsel  
4 in California to prosecute their lawsuits. “Far from being random, fortuitous, or attenuated . . . the  
5 totality of these contacts sufficiently make out [Plaintiffs’] case that [Defendant], by ‘engag[ing]  
6 in significant in significant activities in California . . . purposefully directed [its] activities to  
7 California.” *Elecs. for Imaging*, 340 F.3d at 1351.

8 Finally, the claim at issue in the instant cases arises out of or relates to these activities  
9 because the activities described above relate to patent enforcement. *Avocent*, 552 F.3d at 1330.  
10 Although Defendant points out that not all these activities relate to the enforcement of the patents  
11 at issue in this case, the Court points out that courts have found personal jurisdiction even where  
12 the enforcement activities were tied to related patents. *ActiveVideo*, 975 F. Supp. 2d at 1097–98  
13 (concluding that there was personal jurisdiction over the defendant based on the defendant’s  
14 previous infringement lawsuits in the district with respect to the patents at issue or a related  
15 patent); *NeuralStem*, 573 F. Supp. 2d at 898 (finding that there was personal jurisdiction over the  
16 defendant because the defendant voluntarily filed infringement cases in the district with respect to  
17 highly related patents). The patents in the instant cases share a common specification, title, parent  
18 application, inventors, and owner with Defendants’ six patents in the 2016 and 2018 cases before  
19 this Court. *Compare* ECF Nos. 1-1, 10-2 with *VolP-Pal.Com, Inc. v. Apple Inc.*, Case No. 18-CV-  
20 06217-LHK, ECF No. 1-2. Moreover, the 2016 and 2018 and instant cases share substantially  
21 similar technology and accused products. Accordingly, the Court concludes that plaintiffs have  
22 made a prima facie showing on the first two factors, as required for specific jurisdiction.

## 23 2. Whether Assertion of Personal Jurisdiction is Reasonable and Fair

24 The Court next considers whether the assertion of personal jurisdiction is reasonable and  
25

26 and compile its case against [a company in the forum] prior to the suit’s filing in order to comply  
27 with it[s] obligations under Federal Rule of Civil Procedure 11(b)).



1 fair. The reasonableness inquiry “is not limited to the specific facts giving rise to, or relating to,  
2 the particular litigation.” *Xilinx*, 848 F.3d at 1355. For the reasonableness inquiry, the burden is on  
3 the defendant, who must “present a compelling case that the presence of some other considerations  
4 would render jurisdiction unreasonable under the five-factor test articulated by the Supreme Court  
5 in *Burger King [Corporation v. Rudewicz]*, 471 U.S. 462, 475–77 (1985).” *Breckenridge*, 444 F.3d  
6 1356, 1363 (Fed. Cir. 2006). The five factors outlined in *Burger King* include: (1) the burden on  
7 the defendant; (2) the forum State’s interest in adjudicating the dispute; (3) the plaintiff’s interest  
8 in obtaining convenient and effective relief; (4) the interstate judicial system’s interest in obtaining  
9 the most efficient resolution of controversies; and (5) the shared interest of the several States in  
10 furthering fundamental substantive social policies. *Avocent*, 552 F.3d at 1331 (citing *Burger King*,  
11 471 U.S. at 475–77). The Court addresses each factor in turn.

12 First, Defendant would incur a minimal burden of litigating in this district. Defendant is  
13 based in Washington, and several of its executives are located near the West Coast, in Washington  
14 and Utah. ECF No. 1 ¶ 8; ECF No. 43-36. Accordingly, only minimal travel is required to get to  
15 Northern California.

16 Moreover, the Federal Circuit has repeatedly concluded that a defendant’s previous  
17 lawsuits in a forum demonstrates that the defendant would not face an undue burden in litigating  
18 there. *See Xilinx*, 848 F.3d at 1357–58 (explaining that “[t]he lack of significant burden on [the  
19 defendant] is also evidenced by [the defendant’s] prior litigations in California itself,” including  
20 seven patent infringement lawsuits there); *Acorda Therapeutics Inc. v. Mylan Pharma. Inc.*, 817  
21 F.3d 755, 764 (Fed. Cir. 2016) (concluding that the burden on defendant “will be at most modest,  
22 as [the defendant] . . . has litigated many . . . lawsuits” in the forum); *Viam Corp. v. Iowa Exp.-*  
23 *Imp. Trading Co.*, 84 F.3d 424, (Fed. Cir. 1996) (concluding that litigation in California was not  
24 unduly burdensome because the defendant had filed previous lawsuits in California). In the instant  
25 case, Defendant has prosecuted six lawsuits in this district. Thus, the Court concludes that  
26 litigating the instant cases would not be unduly burdensome.

27 The Federal Circuit has also concluded that litigation in a forum would not be unduly

1 burdensome when the defendant has traveled to that forum. *See Xilinx*, 848 F.3d at 1357 (finding  
2 that a defendant corporation based in Germany would have a minimal burden of litigating in  
3 California because the defendant’s representatives had traveled to California to meet with the  
4 plaintiff’s representatives). Defendant’s representative traveled to California to meet with a  
5 representative of Apple. Accordingly, the Court concludes that Defendant would incur a minimal  
6 burden by litigating in this district, so the first factor does not weigh against a finding of personal  
7 jurisdiction.

8 As to the second factor, “California has a substantial interest in protecting its residents  
9 from unwarranted claims of patent infringement.” *Elecs. for Imaging*, 340 F.3d at 1352. One  
10 plaintiff in the instant three cases, Apple, is incorporated and has its principal place of business in  
11 California. Thus, the second factor weighs in favor of personal jurisdiction.

12 On the third factor, Plaintiffs also have “an undisputed interest in protecting [themselves]  
13 from patent infringement.” *Id.* Plaintiff Apple, which has its principal place of business in  
14 California, “indisputably has an interest in protecting itself from patent infringement by obtaining  
15 relief ‘from a nearby federal court’ in its home forum.” *Xilinx*, 848 F.3d at 1356. Thus, the third  
16 factor weighs in favor of personal jurisdiction.

17 On the fourth factor, the most efficient resolution of the instant cases would be possible in  
18 this district. As explained above, this Court has already presided over six cases alleging  
19 infringement of Defendant’s patents from the same family by all but two of the same Plaintiffs.  
20 Moreover, this Court has already written 113 pages of opinions analyzing Defendant’s patents,  
21 which were subsequently affirmed by the Federal Circuit. *See p. 11, supra*. Thus, the most  
22 efficient resolution of the instant cases would be for them to be heard in this Court, and the fourth  
23 factor weighs for personal jurisdiction.

24 Finally, on the fifth factor, “[t]here does not appear to be any conflict between the interests  
25 of California and any other state, because ‘the same body of federal patent law would govern the  
26 patent invalidity claim irrespective of the forum.’” *Xilinx*, 848 F.3d at 1356 (quoting *Elecs. for*  
27 *Imaging*, 340 F.3d at 1352). Thus, the fifth factor does not weigh against a finding of personal

1 jurisdiction.

2 In sum, Defendant “fail[s] to convince [this Court] that this is one of the ‘rare’ situations  
3 in which sufficient minimum contacts exist but where the exercise of jurisdiction would be  
4 unreasonable.” *Elecs for Imaging*, 340 F.3d at 1352. Accordingly, the Court concludes that it has  
5 personal jurisdiction over the Defendant in the instant cases.

6 **C. Improper Venue**

7 Defendant additionally argues that venue is improper. Mot. at 17–18. Venue in declaratory  
8 judgment actions for non-infringement of a patent is governed by the general venue statute, 28  
9 U.S.C. § 1391. Under § 1391(b)(1), venue is proper in any judicial district where a defendant  
10 resides. *Id.* § 1391(b)(1). Under § 1391(c)(2), for purposes of venue, a corporate defendant  
11 “reside[s] . . . in any judicial district in which such defendant is subject to the court’s personal  
12 jurisdiction with respect to the civil action in question.” *Id.* § 1391(c)(2). Because the Court has  
13 personal jurisdiction over Defendant in the instant cases, venue is also proper in this district.

14 **D. Subject Matter Jurisdiction**

15 Only Apple seeks declaratory judgment of non-infringement or invalidity as to the ‘872  
16 patent. Neither Verizon nor AT&T assert this claim. Therefore, Defendant’s final argument  
17 addresses only Apple’s claim for a declaratory judgment of non-infringement and invalidity as to  
18 the ‘872 patent. Mot. at 18–21. Defendant argues that the Court lacks subject matter jurisdiction  
19 over Apple’s claim for a declaratory judgment as to the ‘872 patent because Defendant has not yet  
20 sued Apple for infringement of the ‘872 patent.

21 Generally, dismissal for lack of subject matter jurisdiction under Federal Rule of Civil  
22 Procedure 12(b)(1) “is a procedural question not unique to patent law,” and is therefore governed  
23 by regional circuit law. *Toxgon Corp. v. BNFL, Inc.*, 312 F.3d 1379, 1380 (Fed. Cir. 2002).  
24 However, “[w]hether an actual case or controversy exists so that a district court may entertain an  
25 action for declaratory judgment of non-infringement and/or invalidity is governed by Federal  
26 Circuit law.” *3M Co v. Avery Dennison Corp.*, 673 F.3d 1372, 1377 (Fed. Cir. 2012).

27 The Declaratory Judgment Act states that, “[i]n the case of actual controversy within its



1 jurisdiction, . . . any court of the United States, upon the filing of an appropriate pleading, may  
2 declare the rights and other legal relations of any interested party in seeking such declaration.” 28  
3 U.S.C. § 2201(a). The phrase “actual controversy” refers to “cases” and “controversies” that are  
4 justiciable under Article III of the Constitution. *Assoc. for Molecular Pathology v. U.S. Patent &*  
5 *Trademark Office*, 689 F.3d 1303, 1318 (Fed. Cir. 2012), *rev’d in part on other grounds by Assoc.*  
6 *for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576 (2013). Thus, without a case or  
7 controversy, there cannot be a claim for declaratory relief. *ActiveVideo Networks*, 975 F. Supp. at  
8 1086.

9 The Court has subject matter jurisdiction in a declaratory judgment action when “the facts  
10 alleged, under all the circumstances, show that there is a substantial controversy, between parties  
11 having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a  
12 declaratory judgment.” *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007). Under the  
13 “all the circumstances” test, courts have “unique and substantial discretion in deciding whether to  
14 declare the rights of litigants.” *Id.* at 136.

15 In case law following *MedImmune*, the Federal Circuit has explained that, in the context of  
16 patent disputes, an actual controversy requires “an injury in fact traceable to the patentee,” which  
17 requires “both (1) an affirmative act by the patentee related to the enforcement of his patent rights  
18 and (2) meaningful preparation to conduct potentially infringing activity.” *Assoc. for Molecular*  
19 *Pathology*, 689 F.3d at 1318. In the instant case, the parties do not dispute the second factor  
20 because Apple already markets the products and services at issue. Opp’n at 18.

21 In order to meet the affirmative act requirement, “more is required than ‘a communication  
22 from a patent owner to another party, merely identifying its patent and the other’s product line.’  
23 [But] [h]ow much more is required is determined on a case-by-case analysis.” 3*M*, 673 F.3d at  
24 1378–79. In *Cepheid v. Roche Molecular Systems, Inc.*, another Court in this district listed factors  
25 that the Federal Circuit and Supreme Court have generally considered in determining whether the  
26 patentee has taken an affirmative act: (1) the strength of threatening language in communications  
27 between the parties; (2) the depth and extent of infringement analysis conducted by the patent

holder; (3) whether the patent holder imposed a deadline to respond; (4) any prior litigation between the parties; (5) the patent holder's history of enforcing the patent at issue; (6) whether the patent holder's threats have induced the alleged infringer to change its behavior; (7) the number of times the patent holder has contacted the alleged infringer; (8) whether the patent holder is a holding company with no income other than enforcing patent rights; (9) whether the patent holder refused to give assurance it will not enforce the patent; (10) whether the patent holder has identified a specific patent and specific infringing products; (11) the extent of the patent holder's familiarity with the product prior to suit; (12) the length of time that transpired after the patent holder asserted infringement; and (13) whether communications initiated by the plaintiff appear as an attempt to create a controversy. *ActiveVideo*, 975 F. Supp. 2d at 1087–88 (citing *Cepheid v. Roche Molecular Systems, Inc.*, Case No C-12-4411 EMC, 2013 WL 184125, at \*6 (N.D. Cal. Jan. 17, 2013)).

Analyzing “all the circumstances,” the Court concludes that Defendant has engaged in an affirmative act sufficient to confer jurisdiction over Apple’s declaratory judgment claim for non-infringement of the ’872 patent. *MedImmune, Inc.*, 549 U.S. at 127. The Court comes to this conclusion based on the extensive litigation campaign undertaken by Defendant against Apple on related patents. The Federal Circuit has repeatedly held that prior litigation on related patents can be an affirmative act that supports subject matter jurisdiction over a declaratory judgment claim. See *Arkema*, 706 F.3d at 1358 (concluding that prior litigation was a “sufficient affirmative act on the part of the patentee for declaratory judgment purposes”); *Danisco*, 744 F.3d 1331 (“[A] history of patent litigation between the same parties involving related technologies, products, and patents is another circumstance to be considered, which may weigh in favor of the existence of subject matter jurisdiction.”); *Teva Pharm. USA, Inc. v. Novartis Pharm. Corp.*, 482 F.3d 1330, 1344 (Fed. Cir. 2007) (“[R]elated litigation involving the same technology and the same parties is relevant in determining whether a justiciable declaratory judgment controversy exists on other related patents.”).

In the instant case, Defendant has engaged in a litigation campaign to assert its related

1 patents against Apple, filing three lawsuits that allege that Apple has infringed seven patents. *See*  
2 *VolP-Pal.Com, Inc. v. Apple Inc.*, 375 F. Supp. 3d at 1110 (lawsuit against Apple for infringing  
3 two related patents); *VolP-Pal.Com, Inc. v. Apple Inc.*, 411 F. Supp. 3d at 926 (lawsuit against  
4 Apple for infringing four related patents); *VolP-Pal.Com, Inc. v. Apple Inc.*, Case No. 20-CV-  
5 00275-ADA, ECF No. 1 (W.D. Tex. Apr. 7, 2020) (lawsuit against Apple for infringing one  
6 related patent). These seven patents share a common specification, title, parent application,  
7 inventors, and owner with the '872 patent, and the Apple technology implicated is the same.  
8 *Compare* ECF No. 10-2 with *VolP-Pal.Com, Inc. v. Apple Inc.*, Case No. 18-CV-06217-LHK,  
9 ECF No. 1-2. Accordingly, the prior litigation between the parties weighs heavily in favor of a  
10 finding that Defendant has engaged in an affirmative act related to the enforcement of its patent  
11 rights.

12 Furthermore, Defendant has publicly stated that it will continue to assert its patent rights  
13 against Apple until it is successful. In an April 8, 2020 press release, which was issued after the  
14 dismissal of Defendant's first lawsuit was affirmed by the Federal Circuit and immediately after  
15 Defendant filed its most recent lawsuit against Apple, Defendant's CEO stated:

16 [W]e are undeterred in our fight to assert our intellectual property  
17 rights. . . . I can tell you; we are not finished . . . We remain firm in  
18 our resolve to achieve monetization for our shareholders and will  
continue to see this fight through until a successful resolution is  
reached.

19 ECF No. 10-9. Although the Court does not find this statement sufficient to demonstrate an  
20 affirmative act on its own, the statement provides helpful context as to Defendant's intentions with  
21 respect to asserting its patent rights against Apple.

22 Assessing "all the circumstances," the Court concludes that Defendant has engaged in an  
23 affirmative act related to the enforcement of its patent rights based on Defendant's extensive  
24 history of litigation against Apple for infringement of related patents and Defendant's statement  
25 that Defendant would continue to litigate until Defendant achieved monetization for Defendant's  
26 shareholders. *See Monolithic Power Sys.*, No. C 07-2363 CW, 2007 WL 2318924, at \*3 (N.D. Cal.  
27 Aug. 13, 2007) ("[T]he assertion of rights, evidenced through a prior lawsuit between the same



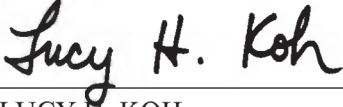
1 parties regarding the same technology . . . and solidified through the express press release  
2 statement indicating an intent to sue alleged patent infringers, presents enough evidence to  
3 establish the case or controversy required for declaratory judgment jurisdiction.”). Thus, the Court  
4 has subject matter jurisdiction over Apple’s claim for a declaration of non-infringement and  
5 invalidity of the ’872 patent.<sup>5</sup>

6 **IV. CONCLUSION**

7 For the foregoing reasons, the Court DENIES Defendant’s consolidated motion to dismiss  
8 Plaintiffs’ complaints.

9 **IT IS SO ORDERED.**

10  
11 Dated: December 11, 2020



LUCY H. KOH  
United States District Judge

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23 <sup>5</sup> In the motion to dismiss, Defendant stresses that Defendant has not made a specific threat to  
24 Apple regarding the ’872 patent. Mot. at 20. However, at a case management conference in the  
25 2016 cases, Defendant represented to this Court that Defendant did not then intend to file  
26 additional lawsuits against Plaintiffs. ECF No. 43-4 at 10 (The Court: “Are we just going to keep  
27 getting more continuations and then are you going to assert those four continuations against the  
28 other Defendants here?” Counsel: “Your Honor, at this time there’s no intention to assert any of  
the other patents against any of the other defendants. I can’t promise you that that would never  
change, but that is not the current intent.”). Despite these representations, Defendant chose to file  
additional lawsuits, including the 2018 cases and the Texas cases.