

**Case No. 21-112**

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*In the*  
**United States Court of Appeals**  
*for the*  
**Federal Circuit**

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IN RE: VOIP-PAL.COM, INC.,  
*Petitioner*

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*Appeal from the United States District Court for the Northern District of California  
in Case Nos. 20-CV-02460-LHK, 20-CV-02995-LHK and 20-CV-03092-LHK  
United States District Judge Lucy H. Koh*

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**REPLY IN SUPPORT OF  
PETITION FOR WRIT OF MANDAMUS**

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 21-112

**Short Case Caption** IN RE VOIP-PAL.COM, INC.

**Filing Party/Entity** VOIP-PAL.COM, INC.

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: January 25, 2021

Signature: /s/Lewis E. Hudnell, III

Name: Lewis E. Hudnell, III

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>VoIP-Pal.com, Inc.</p>	<p>VoIP-Pal.com, Inc.</p>	

Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

Lewis E. Hudnell, III Nicolas S. Gikkas HUDNELL LAW GROUP, P.C.		

**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable  Additional pages attached

VoIP-Pal.Com, Inc. v. Apple, Inc., No. 6:20-cv-00275-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. AT&T, Inc. et al., No. 6:20-cv-00325-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Verizon Communications, Inc. et al., No. 6:20-cv-00327-ADA (W.D. Tex.)
VoIP-Pal.Com, Inc. v. Facebook, Inc., No. 6:20-cv-00267-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Google, LLC, No. 6:20-cv-00269-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Amazon.com, Inc. et al., No. 6:20-cv-00272-ADA (W.D. Tex.)
Twitter, Inc. v. VoIP-Pal.com, Inc., Case No. 5:20-CV-02397-LHK (N.D. Cal.)		

**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached


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ABBREVIATION	TERM
VoIP-Pal	Defendant-Petitioner VoIP-Pal.com, Inc.
Apple	Plaintiff-Respondent Apple, Inc.
AT&T	Plaintiffs-Respondents AT&T, Corp., AT&T Services, Inc., and AT&T Mobility LLC
Verizon	Plaintiffs-Respondents Cellco Partnership d/b/a Verizon Wireless
Respondents	Apple, AT&T, and Verizon
RB##	Responsive Brief of Plaintiffs-Respondents Apple Inc., AT&T Corp., et al., Cellco Partnership dba Verizon Wireless
AB##	Brief of Amicus Curiae Raymond A. Mercado, Ph.D. In Support of Petitioner's Petition for Writ of Mandamus (Corrected), Dkt. No. 21-2
Amazon	Amazon.com, Inc., Amazon.com Services, LLC, and Amazon Web Services, Inc.
Facebook	Facebook, Inc.
Google	Google, LLC
Twitter	Twitter, Inc.
The '606 patent	U.S. Patent No. 10,218,606



The '872 patent	U.S. Patent No. 9,935,872
The 2016 cases	<i>VoIP-Pal.com, Inc. v. Twitter, Inc.</i> , No. 5:18-cv-04523-LHK (N.D. Cal.); <i>VoIP-Pal.com, Inc. v. Verizon Wireless Services, LLC</i> , No. 18-cv-06054-LHK (N.D. Cal.); <i>VoIP-Pal.com, Inc. v. AT&amp;T Corp.</i> , No. 3:18-cv-06177-LHK (N.D. Cal.); and <i>VoIP-Pal.com, Inc. v. Apple, Inc.</i> , No. 3:18-cv-06217-LHK (N.D. Cal.)
The 2018 cases	<i>VoIP-Pal.com, Inc. v. Amazon.com, Inc.</i> , No. 5:18-cv-7020 (N.D. Cal.) and <i>VoIP-Pal.com, Inc. v. Apple Inc.</i> , No. 5:18-cv-6216 (N.D. Cal.)
WDTX	Western District of Texas
NDCAL	Northern District of California
DNV	District of Nevada
The WDTX cases	<i>VoIP-Pal.Com, Inc. v. Facebook, Inc.</i> , No. 6:20-cv-00267-ADA (W.D. Tex.); <i>VoIP-Pal.Com, Inc. v. Google, LLC</i> , No. 6:20-cv-00269-ADA (W.D. Tex.); <i>VoIP-Pal.Com, Inc. v. Amazon.com, Inc. et al.</i> , No. 6:20-cv-00272-ADA (W.D. Tex.); <i>VoIP-Pal.Com, Inc. v. Apple, Inc.</i> , No. 6:20-cv-00275-ADA (W.D. Tex.); <i>VoIP-Pal.Com, Inc. v. AT&amp;T, Inc. et al.</i> , No. 6:20-cv-00325-ADA (W.D. Tex.); <i>VoIP-Pal.Com, Inc. v. Verizon Communications, Inc. et al.</i> , No. 6:20-cv-00327-ADA, (W.D. Tex.)
PTAB or Board	Patent Trial and Appeal Board

## I. SUMMARY OF REPLY ARGUMENT

The Court should grant this Petition because the district court clearly abused its discretion in disregarding the first-to-file rule simply because it had previously found the asserted claims of six VoIP-Pal patents ineligible at the pleadings stage. Despite being the second-filed court, the district court took unreasonable and erroneous steps to ensure that it controlled the fate of the claims of a different VoIP-Pal patent—the '606 patent. Those steps included wrongly concluding that VoIP-Pal's *only* motive for filing suit in the WDTX was forum shopping, determining that the NDCAL would be more convenient than the WDTX for only Apple despite there being no evidence presented to support that conclusion, requiring VoIP-Pal to prove that it had ties to the WDTX, and unduly weighting its alleged familiarity with different patents. Ultimately, the district court used unsound reasons to keep the parties' dispute regarding the '606 patent away from the WDTX because it feared that the WDTX could find the '606 patent claims eligible. Mandamus relief is warranted to correct this unjust abuse of discretion.

Unsurprisingly, Respondents invite the Court to adopt an unreasonably broad view of the exceptions to the first-to-file rule in order to hide the district court's unsound reasoning. Respondents argue that VoIP-Pal's Petition should be denied solely because the district court has "familiarity with the parties' dispute." RB7-8. Yet Respondents fail to produce a single case where a court disregarded the first-to-

file rule for this reason. The Court should not allow Respondents to excuse the district court's abuse of discretion at the expense of allowing a nonexistent familiarity exception to swallow the first-to-file rule. Doing so endorses Respondents' tactic of purposefully filing subsequent declaratory-judgment actions to usurp VoIP-Pal's choice of forum, which should have no place in the law. Accordingly, the Court should grant VoIP-Pal's Petition.

## **II. RESPONSE TO COUNTERSTATEMENT OF CASE AND FACTS**

### **A. Agreeing to Transfer The DNV Cases Against Respondents To The NDCAL Was Unavoidable.**

Respondents' repeated claim that VoIP-Pal freely consented to transfer its DNV cases against Respondents to the NDCAL is inaccurate. First, Respondents incorrectly state that the DNV "dismissed the case against Twitter for improper venue." RB3. The DNV transferred the Twitter DNV case to the NDCAL over VoIP-Pal's opposition. *See VoIP-Pal.com, Inc. v. Twitter, Inc.*, No. 2:16-cv-02338-RFB-CWH, 2018 U.S. Dist. LEXIS 122807, at \*15 (D. Nev. July 23, 2018). Second, VoIP-Pal opposed Verizon's motion to transfer the Verizon DNV case, which was fully briefed at the time the DNV decided Twitter's motion. Appx1864. But, as stated in a stipulation with Verizon, "*because the Twitter, Inc. case was transferred to California,*" VoIP-Pal agreed to transfer the Verizon DNV case to the NDCAL. Appx1865 (emphasis added). It was pointless for VoIP-Pal to maintain its opposition to Verizon's motion and it would have been pointless for VoIP-Pal to

oppose transfer motions by Apple and AT&T, which they both threatened to file. Appx2953-2956. Respondents well know that once the DNV granted Twitter's transfer motion, the DNV would likely grant Verizon's motion and any Apple or AT&T motion. Thus, VoIP-Pal indeed had no choice but to agree to transfer its DNV cases against Respondents to the NDCAL.

**B. The District Court Referred To VoIP-Pal's Patents As A "Cancer."**

Respondents also mischaracterize the record to hide the fact that the district court referred to VoIP-Pal's patents as a "cancer." The district court did not make the cancer comment in the context of VoIP-Pal's cases as Respondents claim. The cancer comment came immediately after asking VoIP-Pal's counsel whether the four patents in the 2018 cases "share the same spec" as the two patents in the 2016 cases and asking Respondents' counsel whether the two set of patents were "related." Appx873-874, 9:24-10:5. The district court also did not "ask[] [VoIP-Pal] whether the cases would keep 'growing like a cancer.'" RB4. Rather, the district court affirmatively stated "I don't want this to keep growing like a cancer." Appx874, 10:11-12. In the very next breath, the district court confirmed that "this" was VoIP-Pal's patent family: "because I'm sure they're *growing the family* as we speak." *Id.*, 10:12-13 (emphasis added). Even if the district court had referred to VoIP-Pal's cases as a cancer, which it did not, that would not make its comment any less

prejudicial. VoIP-Pal's cases were patent cases and thus the comment still exhibited bias toward VoIP-Pal's patents.

**C. Respondents' Claim That VoIP-Pal Has Made *Ad Hominem* Attacks Against Public Officials Is Disingenuous.**

Respondents try to downplay the prejudice of the district court's cancer comment by smearing VoIP-Pal. Rather than explain how labeling the '606 patent as a "cancer" did not show bias, Respondents divert the Court's attention to letters that Apple cited in its sanctions motion against VoIP-Pal in PTAB proceedings. RB5. Respondents, however, ignore that this Court has already considered those letters and affirmed the Board's denial of Apple's motion. *See Apple Inc. v. VoIP-Pal.com, Inc.*, 976 F.3d 1316, 1324 (Fed. Cir. 2020). Respondents also conveniently omit that Apple repeatedly accused the Board of bias against Apple in the same proceedings after the Board issued final written decisions rejecting Apple's petitions, which the Court can judicial notice of. Appx2948-2949 (alleging that Substitute Panel was "instilled" with "reciprocal bias against Apple" and put "a thumb on the scale in favor of VoIP-Pal"); *see L.A. Biomed. Research Inst. v. Eli Lilly & Co.*, 849 F.3d 1049, 1061 n.6 (Fed. Cir. 2017). But unlike the district court, the Board made no prejudicial comments about the merits of Apple's petitions before evaluating them. Thus, not only is Respondents' retread of events at the PTAB a red herring, but it is incomplete and disingenuous. Indeed, Apple is the last party that should be accusing others of making *ad hominem* attacks; Judge Moore recently

criticized Apple for waging *ad hominem* attacks on Judge Albright—the judge in VoIP-Pal’s WDTX cases. *See In re Apple*, 979 F.3d 1332, 1348 (Fed. Cir. 2020) (Moore, J., dissenting).

### III. REASONS FOR ISSUING THE WRIT

#### A. The District Court Clearly Abused Its Discretion By Not Dismissing Respondents’ Actions.

Respondents’ claim that the district court’s “familiarity with the parties” constituted “a reasonable and sufficient justification” to disregard the first-to-file rule lacks merit. A district court cannot merely apply an exception to the first-to-file rule. Exceptions must be justified by “substantial countervailing considerations,” particularly when the second-filed cases are declaratory-judgment actions. *See Futurewei Techs., Inc. v. Acacia Research Corp.*, 737 F.3d 704, 708-09 (Fed. Cir. 2013). In cases arising from other circuits, this Court has held that exceptions to the first-to-file rule must be justified by “compelling circumstances.” *See In re Nitro Fluids L.L.C.*, 978 F.3d 1308, 1311 (Fed. Cir. 2020). Even the Ninth Circuit, where the district court sits, has instructed that the first-to-file rule ““should not be disregarded lightly.”” *See Alltrade, Inc. v. Uniweld Products, Inc.*, 946 F.2d 622, 625 (9th Cir. 1991) (citations omitted). But neither Respondents nor the district court cited any case where a district court disregarded the first-to-file rule based on the court’s alleged familiarity with the parties’ history of disputes, much less a case

holding that such familiarity could constitute a substantial countervailing consideration.

Moreover, the district court's reasons for applying an exception to the first-to-file rule were unsound. As *amicus curiae* Dr. Raymond Mercado points out, finding the claims of related patents ineligible did not give the district court a free pass to disregard VoIP-Pal's choice to litigate the '606 patent in the WDTX. AB8-9. The district court cited no evidence that it could resolve the '606 patent dispute more efficiently than the WDTX. See *In re Link\_A\_Media Devices Corp.*, 662 F.3d 1221, 1224 (Fed. Cir. 2011) (granting mandamus where there was no evidence that the experience of the court denying transfer could produce a speedier resolution). The fact that “the '606 patent share[s] a common specification, title, parent application, inventors, and owner” as the six patents in the 2016 and 2018 cases is meaningless—that is generally true for any continuation patent. The district court failed to assert any familiarity with the *claims* of the '606 patent or their file history and Respondents do not dispute that the district court never previously considered their accused products. Cf. *In re Vistaprint Ltd.*, 628 F.3d 1342, 1347 n.3 (Fed. Cir. 2011) (denying mandamus where the court denying transfer provided detailed explanation of its familiarity with the patent-at-issue). The district court's two previous opinions are minimally relevant because they addressed a single legal issue—eligibility—regarding *different* claims of *different* patents based solely on the

pleadings. In short, the district court's alleged familiarity with the '606 patent dispute is simply too tenuous to constitute a sound reason to disregard the first-to-file rule. *See In re Verizon Bus. Network Servs.*, 635 F.3d 559, 562 (Fed. Cir. 2011) (granting mandamus where the court's previous claim construction ruling was insufficient to support denying transfer).

**B. The District Court's Errors Warrant Mandamus Relief.**

**1. The district court misapplied the conflict avoidance goal of the first-to-file rule.**

Respondents' claim that the district court's conclusion that "the Western District of Texas' decision on the '606 patent could conflict with this Court's prior orders" was reasonable and consistent with the purpose of the first-to-file rule is meritless. Appx13. Respondents argue that "[t]his Court has never held that a district court can *only* consider potentially conflicting decisions in currently pending cases." RB11 (emphasis in original). Yet, Respondents cite no case where a court has disregarded the first-to-file rule because of the potential for inconsistent results between a closed case and a pending case. Rather, this Court has interpreted *Merial's* goal of "avoid[ing] conflicting decisions" to mean avoiding conflicting decisions between *pending cases*. *In re Google Inc.*, 588 Fed. Appx. 988, 990 (Fed. Cir. 2014) (citing *Merial Ltd. v. Cipla Ltd.*, 681 F.3d 1283, 1299 (Fed. Cir. 2012)). Even the district court correctly recognized this goal in other cases:



If the [first-filed] action and the instant case were to proceed in both courts, duplicative and potentially inconsistent claim construction and infringement analyses would inevitably result. *The first-to-file rule exists to prevent this situation . . .*

*Interactive Fitness Holdings, LLC v. ICON Health & Fitness, Inc.*, Case No.: 10-CV-04628-LHK, 2011 U.S. Dist. LEXIS 39636, at \*11 (N.D. Cal. Apr. 5, 2011) (emphasis added). Ironically, after VoIP-Pal filed its Petition, the district court stayed Respondents' second-filed-declaratory-judgment actions because "[i]f both the Western District of Texas and the Northern District of California proceed to rule on the same '606 patent issues, there is a risk of potentially inconsistent rulings." Appx2961-2962. The district court should have applied the same logic to its first-to-file decision.

Applying an erroneous understanding of "avoid[ing] inconsistent decisions" allowed the district court to use the mere possibility that the WDTX could find the claims of the '606 patent eligible as a reason to keep the '606 patent dispute away from the WDTX. Respondents dispute this reading of the district court's Order but fail to offer any other reading. RB11. If the district court believed the WDTX would find the claims of the '606 patent ineligible, then it would not have cited the potential for inconsistent rulings as a reason to keep the '606 patent dispute away from the WDTX. Rather, the district court believed that finding the claims of the '606 patent ineligible would be consistent with its prior orders. Its belief was no accident. Respondents all asserted in their second-filed-declaratory-judgment complaints that

“consistent with this Court’s earlier judgments concerning related patents, none of the elements of the ’606 patent’s claims recites an inventive concept.” Appx35 ¶37; Appx294, ¶41; Appx2020, ¶41; Appx2301, ¶45 (emphasis added). But the possibility that the WDTX could find the claims of the ’606 patent eligible notwithstanding the district court’s prior orders in closed cases is not the type of inconsistency that the first-to-file rule is intended to avoid. Because the district court plainly misconstrued what *Merial* meant by “avoid[ing] conflicting decisions,” it committed a fundamental error of law that warrants mandamus relief.

Contrary to what Respondents claim, the Twitter declaratory-judgment action also does not excuse the district court’s disregard of the first-to-file rule. RB12-13. The district court never identified the Twitter action as a reason for departing from the first-to-file rule. Nor is it certain that the Twitter action will proceed in the NDCAL. Although that action lacks the first-to-file issue, the district court stayed the Twitter action along with Respondents’ actions after VoIP-Pal filed its Petition. Appx2962. If the Court grants VoIP-Pal’s Petition and orders the district court to dismiss Respondents’ actions, then the district court may also dismiss the Twitter action. At a minimum, VoIP-Pal will have a basis to transfer the Twitter action to the WDTX, where VoIP-Pal’s six infringement cases involving the ’606 patent will proceed.

Respondents note that three of the defendants in VoIP-Pal's WDTX cases have moved to transfer their respective cases to the NDCAL. RB3 n.1. Respondents have done likewise. But these motions actually support granting VoIP-Pal's Petition. As the district court's own precedent counsels, the district court should have let the WDTX—the first-filed court—decide these motions in the first place. *See Ruckus Wireless, Inc. v. Harris Corp.*, No. 11-CV-01944-LHK, 2012 U.S. Dist. LEXIS 22336, at \*11 (N.D. Cal. Feb. 22, 2012) (“[T]he parties *correctly* agree that the forum convenience factors are more properly addressed by the [first-filed court].”) (emphasis added); *see also Pacesetter Sys. v. Medtronic, Inc.*, 678 F.2d 93, 96 (9th Cir. 1982). Respondents had no legitimate reason to file duplicative declaratory-judgment actions in the NDCAL. *See Marvell Semiconductor, Inc. v. Monterey Research, LLC*, No. 20-CV-03296-VC, 2020 U.S. Dist. LEXIS 210873, at \*3 (N.D. Cal. Nov. 11, 2020). If Respondents and the other WDTX defendants believe that VoIP-Pal's first-filed cases should be transferred to the NDCAL, then they should simply await the WDTX's decision on their pending motions. *Id.* Although Judge Albright stayed VoIP-Pal's WDTX cases, he did not explain why. Appx2691. Any inferences Respondents draw from this stay are pure speculation.

**2. The district court wrongly concluded that VoIP-Pal engaged in forum shopping.**

Respondents' attempt to justify the district court's conclusion that VoIP-Pal engaged in forum shopping is nonsensical. Like the district court, Respondents fault

VoIP-Pal for filing suit in the WDTX and not the NDCAL because the WDTX “lacks any meaningful geographical connection to Petitioner.” RB15. But even if VoIP-Pal’s Waco office and the consultant who works in that office are not a meaningful geographical connection to the WDTX, which they are, VoIP-Pal has no geographical connection to the NDCAL. Appx2934. Respondents do not even assert otherwise. Thus, VoIP-Pal had little reason to file suit in the NDCAL.

Inexplicably, Respondents attempt to distinguish *Genentech v. Eli Lilly* for the exact proposition that the district court cited it for—that it may disregard the first-to-file rule when forum shopping was the *only* motive for filing. RB16. Regardless, Respondents’ own authority, *Khan v. GMC*, shows that that is the law. RB15. In *Kahn*, this Court expressly stated that a court may depart from the first-to-file rule “where forum shopping *alone* motivated the choice of sites for the first suit.” *See Kahn v. GMC*, 889 F.2d 1078, 1081 (Fed. Cir. 1989) (emphasis added); *see also Zelenkofske Axelrod Consulting L.L.C. v. Stevenson*, No. 99-3508, 1999 U.S. Dist. LEXIS 12137, at \*10 (E.D. Pa. Aug. 5, 1999) (“Moreover, to justify a disregard of the first-filed rule, forum shopping must be the sole reason for choosing one forum over another and thus will rarely be found where the first action was filed in a logical place.”). In fact, *Genentech* cited *Khan* for this proposition. *See Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 938 (Fed. Cir. 1993) (citing *Khan*, 889 F.2d at 1081). Thus, under either the district court’s or Respondents’ authority, the district court

could not reasonably conclude that VoIP-Pal's *only* motive for filing in the WDTX was forum shopping because venue is proper in the WDTX as to Respondents and the other WDTX defendants and none of them have challenged it.

Respondents falsely assert that VoIP-Pal's only motive for filing in the WDTX was the procedural differences between the NDCAL and the WDTX in deciding patent-eligibility issues. RB17. Not only do Respondents take VoIP-Pal's comparison of these differences out of context, but choosing a forum because it offers certain procedural advantages is a plaintiff's privilege, not forum shopping. *See Atl. Marine Constr. Co. v. United States Dist. Court*, 571 U.S. 49, 63 (2013) ("plaintiffs are ordinarily allowed to select whatever forum they consider most advantageous . . . we have termed their selection the 'plaintiff's venue privilege.'") (citations omitted); AB13. Moreover, Respondents overlook that the DNV also has procedural differences in deciding eligibility issues as compared to the NDCAL. *See* District of Nevada Local Rules of Patent Practice LPR 1-4(c); AB3 n.1. Tellingly, Respondents never accused VoIP-Pal of forum shopping by choosing to litigate in the DNV. Having forced VoIP-Pal to choose a different forum to litigate the '606 patent, Respondents cannot now complain that VoIP-Pal chose a forum that offers at least some of the DNV's procedures and that is undisputedly a proper venue for all of the Respondents.

**3. Respondents’ alleged convenience evidence does not support the district court applying an exception to the first-to-file rule.**

Respondents’ claim that their evidence on the convenience factors was in the record is demonstrably false. The only convenience evidence that Respondents identify is their analysis in the WDTX cases, which they referenced in one sentence of a footnote in their opposition to VoIP-Pal’s motion to dismiss. Appx826. These arguments, however, were not briefed and therefore were not before the district court. *See United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1579 (2020) (“[parties represented by competent counsel] . . . are responsible for advancing the facts and argument entitling them to relief.”) (internal citations omitted); *United States v. Great Am. Ins. Co. of N.Y.*, 738 F.3d 1320, 1328 (Fed. Cir. 2013) (“It is well established that arguments that are not appropriately developed in a party’s briefing may be deemed waived.”); *Intellicheck Mobilisa v. Wizz Sys., LLC*, 173 F. Supp. 3d 1085, 1108 (W.D. Wash. Mar. 28, 2016). Moreover, Respondents relegated their illusory convenience argument to a footnote, and thus waived it. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (“[A]rguments raised in footnotes are not preserved.”). Further, Respondents’ attempt to rely on a convenience analysis presented to the WDTX proves VoIP-Pal’s point—the WDTX as the first-filed court should decide the convenience transfer issue, not the NDCAL.

The only evidence actually before the NDCAL that Respondents identify are the parties' stipulations to transfer the 2016 and 2018 cases from the DNV to the NDCAL. But this alleged evidence is irrelevant for several reasons. First, the district court never considered the parties' stipulations in its first-to-file analysis. The reason is simple—Respondents did not present any arguments based on the stipulations, much less the desperate arguments that they make now. Appx817-818. Second, the statements in the stipulations that Respondents rely on concern the relative convenience of the parties and witnesses between the DNV and the NDCAL, not between the WDTX and the NDCAL. Contrary to what Respondents claim, moving the comparison from the DNV to the WDTX *does* change the convenience analysis because Respondents all have a significant presence in the WDTX. Appx679; Appx708-709; Appx738-739. Third, the district court “has previously held, considerations such as [convenience of [] employee witnesses, access to sources of proof, and the parties' contacts with this forum] cannot trump the judicial efficiency considerations which underlie the first-to-file rule.” *See Interactive Fitness Holdings*, 2011 U.S. Dist. LEXIS 39636, at \*10. Thus, by conducting a perfunctory convenience analysis, which addressed only two factors and only Apple, the district court clearly abused its discretion by disregarding the first-to-file rule. *See In re Nitro Fluids L.L.C.*, 978 F.3d 1308, 1312 (Fed. Cir. 2020) (granting

mandamus relief where second-filed court improperly assessed convenience factors in first-to-file analysis).

**4. The district court erroneously shifted Respondents' burden to establish an exception to the first-to-file rule to VoIP-Pal.**

Just as the district court made arguments for Respondents, Respondents struggle mightily to explain why the district court did not improperly foist a burden to prove an exception to the first-to-file rule onto VoIP-Pal. Respondents' claim that they argued that VoIP-Pal's motion to dismiss should be denied because of the litigation history between the parties—the district court's primary rationale—is false. RB22 n.3. Respondents argued that VoIP-Pal's motion should be denied because “[t]he related 2016, 2018, and 2020 [NDCAL] Cases are first-filed cases.” Appx819. It is also false that VoIP-Pal did not respond to this absurd argument. It did. Appx1533-1538. Unsurprisingly, the district court rejected Respondents' argument.

Respondents then argued that an exception to the first-to-file rule should apply:

[E]ven if this Court was to determine that the Texas Cases were the ‘first-filed’ after analyzing [the first-to-file rule factors], the exceptions to the first-to-file rule—including forum shopping, bad faith, convenience and availability of witnesses, and possibility of consolidation with related litigation—also support this Court exercising jurisdiction over these cases.



*Id.* Even assuming Respondents met their burden to prove an exception, which they did not, VoIP-Pal had no burden to present any countervailing evidence as Respondents suggest. RB23. Yet the district court explicitly faulted VoIP-Pal for not presenting any such evidence in the first instance. Appx13 (“Defendant never provides any reason why these cases should be heard by Judge Albright”). Neither Respondents nor the district court cited any authority for concocting this nonexistent burden and dumping it on VoIP-Pal. Lacking any reasonable basis for doing so, the district court abused its discretion.

**5. The district court abused its discretion by giving dispositive weight to its alleged familiarity with the parties’ dispute.**

Finally, Respondents effectively admit the district court’s familiarity with the ’606 patent dispute can be stated in one sentence “it had already written two opinions . . . addressing the invalidity of related patents, and the ’606 patent shares a common specification, title, parent application, inventors, and owner with those related patents.” RB25. That is it in a nutshell. The district court had no familiarity with the claims of the ’606 patent, their file history, or the products that Respondents claim do not infringe because the district court never previously considered any of this evidence. As Dr. Mercado notes, other district courts have consistently rejected attempts to override the first-to-file rule based on second-filed-declaratory-judgment actions involving continuation patents. AM7; *see, e.g., Sefac USA, Inc. v. Gray Manufacturing Company, Inc.*, No. 19-5375, 2020 U.S. Dist. LEXIS 143491, at \*1

n.1 (E.D. Pa. 2020); *Collectis S.A. v. Precision Biosciences, Inc.*, 858 F. Supp. 2d 376, 384 (D. Del. 2012); *Abbott Laboratories v. Johnson and Johnson, Inc.*, 524 F. Supp. 2d 553, 558 (D. Del. 2007), *aff'd*, 297 F. App'x 966 (Fed. Cir. 2008). Also, as noted above, the record contained no evidence from which the district court could reasonably conclude that its alleged familiarity with related patents would judicial efficiencies.

#### IV. CONCLUSION

In conclusion, Respondents' arguments should not stop the Court from concluding that the district court abused its discretion in disregarding the first-to-file rule and that mandamus relief is warranted. Accordingly, VoIP-Pal respectfully requests that the Court grant this Petition, vacate the district court's Order, and order the district court to dismiss Respondents' second-filed-declaratory-judgment actions.

Dated: January 25, 2021

Respectfully submitted,

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS**

**Case Number:** 21-112

**Short Case Caption:** IN RE: VOIP-PAL.COM, INC.

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Name: Lewis E. Hudnell, III

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I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

Dated: January 25, 2021

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