

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

MOSAID TECHNOLOGIES INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 6:05CV120
)	
INFINEON TECHNOLOGIES NORTH)	
AMERICA CORP.,)	
)	
INFINEON TECHNOLOGIES AG,)	
)	
INFINEON TECHNOLOGIES HOLDING)	
NORTH AMERICA INC., and)	
)	
INFINEON TECHNOLOGIES RICHMOND LP,)	
)	
Defendants.)	

**INFINEON TECHNOLOGIES NORTH AMERICA CORPORATION'S
MOTION FOR A CHANGE OF VENUE TO THE NORTHERN
DISTRICT OF CALIFORNIA PURSUANT TO 28 U.S.C. § 1404(A)**

Infineon respectfully requests that the Court transfer this action to the Northern District of California for consolidation and/or coordination with an earlier-filed action that is presently pending before Judge Fogel involving the same parties, same DRAM technology, and closely related patents. Parallel consideration of the complex and fact-intensive claims and technology at issue here will result in litigation of the same or very closely related issues in different forums at the same time, wasting both Court and party resources and creating substantial risk of inconsistent rulings and judgments. Indeed, in view of the complexity of the technology and the need to avoid duplicative consideration of the related factual and legal questions, the Judicial Panel on Multidistrict Litigation consolidated the California action for pretrial proceedings with another co-pending action, since settled, brought by

Mosaid against another DRAM manufacturer (despite each action involving only one plaintiff and family of defendants).

Not only will this case involve the same synchronous DRAM products at issue in the California case, and thus an extensive overlap on damages issues, this action will also involve many of the same technical aspects of those products, such as voltage generation/regulation, word line/bit line activation, and improving circuit timing. As a result, the Court that tries this case will need to be familiar with the same transistor-level circuit schematics, the same product description manuals, the same electronic circuit simulation files, and the same damages documents and theories that have already been the subject of so much focus in the earlier-filed action, and will presumably be the focus of the trial in the Northern District of California. Moreover, both this case and the California trial will implicate numerous existing rulings that will have to be studied and applied redundantly by two separate federal courts.

It is well recognized that patent cases are appropriately transferred to courts already having a familiarity with the key issues and evidence resulting from previous litigation involving the patents-in-suit, as well as to courts where the same parties had previously litigated a patent case involving the same products. Here, the case for transfer is stronger because the same parties and products are *presently involved* in litigation in another jurisdiction. If transfer were not granted, the parties will litigate many of the same issues in two different forums at the same time, resulting in substantial duplication of effort and an increased risk of inconsistent rulings or judgments.

Not only will a transfer yield efficiencies, it will also deter parties from inappropriately splitting claims to monitor the progress of existing patent litigations in other jurisdictions before filing later cases in the Eastern District of Texas or elsewhere if dissatisfied with how the earlier-filed litigation has progressed. Indeed, that is what happened here, as Mosaid repeatedly amended its claims to add other patents to the California suit, yet waited years before filing the instant suit, doing so only

after summary judgment was entered against it on six patents and certain damages issues in the earlier-filed California Infineon/Mosaid case.¹

The purely tactical nature of Mosaid's serial litigation is confirmed by the fact that neither party is located here, and no unique operative facts exist or occurred in Texas. Infineon's headquarters is in San Jose, located in the Northern District of California. Mosaid is based in Kanata, Ontario with its United States offices similarly located in the Northern District of California. No Infineon DRAM products were designed here, and many of Infineon's witnesses and documents are located in California, as well as numerous potential third party witnesses.

I. Factual Background

A. The Ongoing Prior DRAM Litigation Between Infineon and Mosaid.

The litigation between Infineon Technologies North America Corp. ("Infineon") and Mosaid Technologies Inc. ("Mosaid") dates back to December 11, 2002, when Infineon filed a declaratory action against Mosaid in the Northern District of California for a finding of non-infringement and invalidity of seven Mosaid patents relating to semiconductor dynamic random access memory ("DRAM") technology. *See* Dec. 11, 2002 Infineon Complaint, Ex. A. Mosaid counterclaimed in the Northern District of California for infringement of all seven of these same patents. *See* Feb. 7, 2003 Mosaid Counterclaims, Ex. B at 9-18. Mosaid subsequently amended its pleadings to include an allegation of infringement of U.S. Patent No. 6,067,272 ("the '272 patent"), which is the direct predecessor of U.S. Patent No. 6,657,919 ("the '919 patent") asserted in this case, and then later amended again to include an additional two patents. *See* Mosaid Amended and Third Amended Answer and Counterclaims, Exs. D at 18-19 & E at 22-23. Pre-trial proceedings in the Northern District of California were consolidated by the Judicial Panel on Multidistrict Litigation ("JPML")

¹ Indeed, Mosaid's stated motivation for filing this suit was essentially to pressure Infineon to settle the existing litigation by licensing Mosaid's patents. *See* Mosaid June 23, 2005 Press Release, Ex. C.

with another litigation between Mosaid and Samsung in the District of New Jersey (now settled). *See* September 15, 2003 JPML Order, Ex. F.

In granting Infineon's request to centralize the litigation, the JPML noted the "complex" nature of the Mosaid DRAM-related patents, which could "be expected to share factual and legal questions" between the two litigations, as well as the need to "ensur[e] that common parties and witnesses are not involved in discovery demands and other pretrial matters in one action which duplicate activity that has already occurred or would occur in the other action." *See id.* at 1-2. For these reasons, the JPML concluded that centralization was necessary in order to "conserve the resources of the parties, their counsel, and the judiciary." *See id.* at 2.

Following claim construction, Mosaid dropped three patents from the MDL consolidated action, including a stipulated dismissal of the '272 patent. *See* May 24, 2004 Stipulated Dismissal, Ex. G. Infineon then moved for summary judgment of non-infringement and no damages on six of the seven remaining patents. On April 1, 2005, that Court entered summary judgment of non-infringement in favor of Infineon on all asserted claims of six of the seven patents then at issue as well as on certain damages issues. *See Mosaid Techs. Inc. v. Samsung Elecs. Co.*, 362 F. Supp. 2d 526 (D. N.J. 2005). The case was subsequently remanded to the Northern District of California. *See Infineon Techs. N. Am. Corp. v. Mosaid Techs. Inc.*, Civ. No. 02-5772 (Fogel, J.); Conditional Remand Order, No. 1540 (J.P.M.L. Apr. 28, 2005), Ex. H.

B. This Case Involves the Same Infineon Products and Technology as the Ongoing California Case.

Mosaid's allegations here involve patents on similar technology to the patents at issue in the California case. Specifically:

- U.S. Patent No. RE 37,641 ("the '641 patent"), Ex. I, asserted here is directed to certain circuitry for facilitating charging the bit lines found in DRAM chips, and is similar to the Lines family of patents, Ex. J, at issue in the California litigation which are directed to circuitry for charging word lines to allow full voltage levels to be carried over bit lines to the DRAM cell.

- U.S. Patent No. 6,057,676 (“the ‘676 patent”), Ex. K, asserted here is directed to a voltage generator and regulator similar to the voltage generator and regulator circuitry of the Foss family of patents, Ex. L, at issue in the California case.
- The ‘919 patent asserted here is directed to certain circuitry for delay locked loops, and is a direct descendant of the ‘272 patent that was once at issue in the California litigation. These two patents share the same specification and figures, and have very similar claims. *See* ‘919 and ‘272 Patents, Ex. M. Like the Lines and Foss patents in the California action, the ‘919 patent uses transistors and buffer technology to improve signal transmission and timing issues. *See* Ex. M & March 23, 2004 Markman Opinion, Ex. N.

Further, Mosaid has indicated that its allegations concerning these patents target Infineon’s complex semiconductor DRAM chip products. A large volume of complex documentary evidence showing each of the millions of individual transistor connections used in the circuit layouts of these chips and describing their operation were produced in the California case, and will be considered by the Northern District of California during trial. Also, several weeks of sophisticated simulations concerning the Infineon DRAM products at issue here were conducted by Mosaid at Infineon’s San Jose facility in the Northern District of California. The enormous amount of data painstakingly generated during those simulations, and relied on by Mosaid in its expert reports, resides in that facility. Mosaid already indicated it will want to rely on those simulations here, as well as to conduct new simulations. Thus, not only are the same products involved here and the patented technology related, the same evidence and issues will be raised here as well.²

With regard to Mosaid’s damages claims, there is likewise significant overlap between this case and the California litigation, which involve discovery into the same product sales to the same customers and the same negotiation history between the parties. Accordingly, MOSAID has again requested all of Infineon’s DRAM sales since the company was formed in 1999, the same discovery it

² Mosaid has not yet provided notice of which particular Infineon DRAM products it is accusing in this litigation, but has sought discovery into every DRAM product Infineon has manufactured or sold since the company was formed in 1999. *See* Mosaid Interrogatories, Ex. O. This discovery overlaps with the discovery sought in the Northern District of California action. *See* Mosaid Doc. Req., Ex. P. Because of this extensive overlap, the parties have stipulated that the documents produced in the first case may now be used in the second case.

sought in the first case. *See* Mosaid's First Set of Interrogatories & Feb. 27, 2004 Second Set of Document Requests, Exs. O & P. In particular, the damages issues implicated by the California litigation include the following:

- The parties dispute the appropriate amount for a reasonable royalty, including disagreements about the impact of numerous past licenses granted by Mosaid covering the entirety of its patent portfolio in exchange for a lump-sum payment. Infineon contends that a reasonable royalty may be determined from MOSAID's portfolio-wide lump-sum licensing practices. MOSAID, on the other hand, seeks damages by applying a running royalty theory that is inconsistent with its own past licenses;
- The size of the Infineon sales base potentially subject to an alleged reasonable royalty under MOSAID's flawed running royalty theory, with Mosaid claiming a sales base significantly larger than that shown by the sales figures produced by Infineon;
- Mosaid's lack of entitlement to pre-suit damages in light of its failure to comply with 35 U.S.C. § 287.

These issues, and rulings made in connection with them, which will be considered by the Northern District of California, will be critical in this case as well, where the alleged damages claimed by Mosaid are likewise dependent upon the same points.

C. Infineon's North American Operations are Based in California, and Have No Substantial Connection to this Judicial District

Infineon designs, develops, and manufactures semiconductor products for a variety of applications, including computers, wireless communications, automotive security, and chip cards. *See* Infineon Website Info., Ex. Q at 1. Infineon Technologies North America Corp. is a Delaware corporation with a principal place of business in San Jose, California, which is located within the Northern District of California. *See* Mosaid Complaint ¶ 2. Infineon's San Jose headquarters has technical documents relating to a number of Infineon products, financial and marketing records relating to nationwide sales of Infineon products, as well as a variety of Infineon's other business records. *See* Infineon's April 14, 2003 Initial Disclosures, Ex. R at 4.

Infineon's product design takes place primarily in research and development centers in California, North Carolina, and Vermont, as well as in various locations abroad. *See* Ex. Q at 2.

Infineon also maintains a number of sales offices and representative offices around North America, including in San Jose and Texas. *See* Ex. Q at 3-14. Infineon's sales and representative offices in Texas are located in Austin, Houston, and Dallas, none of which is in the Eastern District. *See id.* Further, Infineon's Texas sales and representative offices were not a source of production documents in the California case. *See* Infineon Disclosures, Ex. R at 4.

In addition to Infineon Technologies North America Corp., Mosaid has sued three other Infineon entities, none of which have any connection to the Eastern District of Texas. Infineon Technologies Holding North America Inc., is a Delaware corporation with a principal place of business in Wilmington, Delaware. *See* Mosaid Complaint ¶ 4. Infineon Technologies AG is German corporation with its principal place of business in Munich, Germany. *See id.* ¶ 3. Finally, Infineon Technologies Richmond, LP is a Delaware limited partnership with a principal place of business in Sandston, Virginia. *See* Infineon Answer & Counterclaims ¶ 5.

D. Mosaid is a Canadian Company with a California Presence and No Connection to this Judicial District

Mosaid Technologies Inc. is an Ontario corporation that maintains its principal place of business in Kanata, Ontario, Canada. *See* Mosaid Complaint ¶ 1. As far as Infineon is aware, Mosaid's only North American corporate location is a sales and marketing office in Santa Clara, California, which is located in the Northern District of California. *See* Mosaid Annual Report 2004 at 14 and Mosaid Website Info., Exs. S & T.

E. Potential Third Party Witnesses In the Northern District of California

A number of third-party licensees of Mosaid's patents have corporate headquarters or offices in the Northern District of California, including NEC Electronics America, Oki Semiconductor North America, Fujitsu, and Mitsubishi Electronic. *See* Third-Party Website Info., Ex. U. These third parties in the Northern District likely possess information relevant to calculating a reasonable royalty measure of damages and determining Mosaid's compliance with 35 U.S.C. § 287. During the first litigation,

Infineon served subpoenas on several of these third party licensees, and obtained documents that will likely be relevant at trial.

II. Legal Standard

For the convenience of the parties and witnesses, as well as in the interest of justice, the Court may transfer this case to the Northern District of California pursuant to section 1404(a), which provides:

For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

28 U.S.C. § 1404(a). The decision to transfer is within sound discretion of this Court. *Hanby v. Shell Oil Co.*, 144 F. Supp. 2d 673, 676 (E.D. Tex. 2001); *see also Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955). In determining whether to transfer venue, courts consider two categories of factors: (1) the public interest in the fair and efficient administration of justice, which includes the concern for judicial economy, and (2) private interests. The public interest factors to be considered include: “(a) administrative difficulty, (b) localized interests in resolving localized controversies, (c) jurors’ time, and (d) conflict of laws.” *See Logan v. Hormel Foods Corp.*, Docket No. 6:04-cv-211, Slip Op. at 3 (E.D. Tex. Aug. 25, 2004) (*citing Mohamed v. Mazda Motor Corp.*, 90 F. Supp. 2d 757, 771. (E.D. Tex. 2000)).

The private interests to be considered include:

(a) a plaintiff’s choice of forum, (b) convenience and location of witnesses and the parties, (c) cost of obtaining the attendance of witnesses and other trial costs, (d) place of the alleged wrong, (e) location of counsel, (f) accessibility and location of sources of proof, and (g) possibility of delay and prejudice if transfer is granted.

See, e.g. id.; ConnectTel LLC v. Cisco Sys., Inc., Docket No. 2:04-cv-396, Slip. Op. at 3 (E.D. Tex. February 16, 2005) (*citing Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508 (1947)).

ARGUMENT

I. The Public Interest Factors Strongly Favor Transfer

“In a patent case, public interest considerations, including the concern for judicial economy, may be determinative [of a venue change], even if the parties’ considerations call for a different result.” *See Logan*, Docket No. 6:04-cv-211 at 3 (citing *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1565 (Fed. Cir. 1997)). Here, transfer is favored by both significant public interests and the private convenience factors.

A. Judicial Economy and Administrative Efficiency Strongly Favor Transfer

Courts have consistently recognized the adverse effect on judicial economy that results when related litigations proceed in separate forums. *See, e.g., id.* at 4; *Hunter Eng’g Co. v. Accu Indus., Inc.*, 245 F.Supp.2d 761, 776 (E.D. Va. 2002). Such litigation is a duplicative use of scarce judicial resources, risks inconsistent results, and impedes the administration of justice. *See id.*; *Mastercard Int’l Inc. v. Lexcel Solutions, Inc.*, No. 03 Civ. 7157, 2004 WL 1368299, *8 (S.D.N.Y. June 16, 2004) (“It would be inefficient and a waste of judicial resources to subject the same parties to suit over interconnected claims concerning identical technology and underlying disputes in two separate fora”) (Ex. V). Accordingly, “[i]n a case involving several highly technical factual issues . . . judicial economy may favor transfer to a court that is already familiar with the issues.” *See Logan*, Docket No. 6:04-CV-211 at 3. Here, transfer is appropriate because the unusual posture of this case dictates that judicial economy will suffer if litigation is divided between the Northern District of California and this District.

This litigation began with a case currently pending before the Northern District of California, in which Mosaid and Infineon dispute patent infringement involving the same Infineon DRAM technology that will be at issue in this litigation, and Mosaid patents covering similar technology to those asserted here. During the course of the anticipated trial and post-trial motions in California, the Northern District of California will be required to familiarize itself with the technology at issue and

will consider a large volume of complex evidence detailing the operation of Infineon DRAMs. If a damages trial is required, the trier will also consider evidence regarding various damages issues, such as the appropriate reasonable royalty amount in light of patent portfolio licenses MOSAID previously extended to other DRAM manufacturers. All of these materials and issues are implicated by Mosaid's claims here. Thus, transfer is favored because maintaining some of Mosaid's allegations in the Eastern District of Texas, while the others go to trial in the Northern District of California, will necessitate duplicative consideration of all of this evidence and may result in inconsistent rulings and judgments.

Numerous decisions have held that a transferee forum's familiarity with complex patent infringement issues, such as those involved here, strongly supports transfer. *See, e.g., Logan*, Docket No. 6:04-cv-211 at 4; *Maurice Mitchell Innovations, L.P., v. Intel Corp.*, Docket No. 2:04-cv-450, Slip Op. at 6-7 (E.D. Tex. March 30, 2005); *Acco Brands, Inc. v. PC Guardian Anti-Theft Prods., Inc.*, Docket No. 2:03-cv-425 (E.D. Tex. July 23, 2004) (transferring to a district that had "substantial experience with these parties and the accused device"); *Hunter*, 245 F. Supp. 2d at 776 ("[w]here a party has previously litigated claims involving certain issues in one forum . . . 'a court in that district will likely be familiar with the facts of the case. As a matter of judicial economy, such familiarity is highly desirable'"). As discussed above, a great deal of complex technical evidence and damages disputes relating to Infineon's DRAM products overlap between this litigation and the one pending in the Northern District of California. Accordingly, the familiarity with all of these materials and issues that will be acquired by the Northern District of California during trial, and the public interest in avoiding duplication of such effort by this Court, strongly supports transfer. *See id.*

Furthermore, transfer is particularly appropriate when the two litigations in question are proceeding concurrently. *See Continental Grain Co. v. FBL-585*, 364 U.S. 19, 26 (1960) ("To permit a situation in which two cases involving precisely the same issues are simultaneously pending in different District Courts leads to the wastefulness of time, energy and money that s 1404(a) was

designed to prevent.”); *Technical Concepts L.P. v. Zurn Indus.*, No. 02 C 5150, 2002 WL 31433408, *6 (N.D.Ill. Oct. 31, 2002) (“[w]hen pending litigation involves the same parties and similar legal, technical and infringement issues, transfer to that venue is logical and strongly favored”) (Ex. W); *Intel*, Docket No. 2:04-cv-450 at 7 (noting the duplication of judicial resources and other inefficiencies caused by two ongoing overlapping litigations) *citing Mymail*, 223 F.R.D. at 458. Maintaining this case here could result in concurrent litigations on the same product and overlapping judgments, which heightens the inefficiency of proceeding in multiple forums simultaneously and the risk of inconsistent results.³ By contrast, transfer would allow Judge Fogel to consolidate or otherwise coordinate the two cases. Such considerations already led to consolidation by the JPML earlier in this litigation, and likewise favor transfer here. *See JPML Order*, Ex. F at 1-2 (consolidating cases due to the “complex” nature of the Mosaid patents, “share[d] factual and legal questions,” and the need to “ensur[e] that common parties and witnesses” are not burdened with duplicative litigation demands).

B. Considerations of Local Interest and of Jurors’ Time Favor Transfer

The citizens of the Northern District of California have a strong local interest in resolving this controversy as both parties reside in, and many of Infineon’s employees live or work in, the Northern District of California, which is the center of U.S.-based accused activity in this patent infringement matter. *See Exs. Q at 2, S & T*. In contrast, there is less corresponding local interest in the Eastern District of Texas given the non-residency of the parties and the lack of specific contacts with this District. Consequently, transfer of venue is supported by this point. *See, e.g., Hanby*, 144 F. Supp. 2d at 679 (transferring venue because of strong local interest in resolving the controversy in transferee district compared to transferor).

³ Recognizing such concerns, the Court’s Rules require that “[w]henver a civil matter . . . involves subject matter that either comprises all or a material part of the subject matter or operative facts of another action . . . then pending before this or another court . . . counsel for the filing party shall identify the collateral proceedings . . . on the civil cover sheet filed in this court.” *See L.R. CV-42(a)*. Mosaid has not done so.

II. The Private Interest Factors Favor Transfer

Although the public interest factor of judicial economy is the most compelling one in this case, such that it would “be determinative, even if the parties’ considerations call for a different result,” (*Logan*, Docket No. 6:04-cv-211 at 3 (*citing Regents of Cal.*, 119 F.3d at 1565)), the private interest factors also favor transfer. In particular, the following private interest factors favor transfer—(1) the convenience and location of witnesses and the parties, (2) cost of obtaining the attendance of witnesses and other trial costs, (3) place of the alleged wrong, and (4) accessibility and location of sources of proof. The plaintiff’s choice of forum is entitled to little weight here, where the plaintiff does not reside in this district and the plaintiff has filed claims on other related patents in the transferee forum in the currently pending case.

A. Plaintiff’s Choice of a Forum With No Meaningful Relationship to This Litigation Deserves Little Weight

The significant benefit to judicial economy that will follow from a transfer of venue cannot be outweighed by plaintiff’s forum choice, which in any event, deserves little weight here. This District has held that “the usual deference accorded the plaintiff’s choice of forum is of minimal value when none of the parties reside in this division of this District.” *See Rock Bit Int’l, Inc. v. Smith Int’l, Inc.*, 957 F. Supp. 843, 844 (E.D. Tex. 1997); *see also Logan*, Docket No. 6:04-cv-211 at 5 (“[a]lthough a plaintiff’s forum choice usually carries substantial weight in a transfer analysis, courts are less deferential when the plaintiff does not reside in the chosen forum, and operative facts have not occurred there.”) Here, Mosaid is a foreign corporation that maintains no offices or business operations in Texas, but rather, has its only United States presence at a corporate office located in the Northern District of California. *See Ex. S.* Infineon likewise has no presence in the Eastern District of Texas, and no “operative facts” relating to the design, manufacture, and sale of the accused products occur here. Rather, Infineon’s U.S. sales, marketing, and distribution is based in San Jose, Ex. Q at 2, which constitutes the relevant hub of accused activity that is “often the critical and controlling

consideration in adjudicating a motion to transfer venue.” *See Minka Lighting, Inc. v. Trans Globe Imports, Inc.*, 2003 WL 21251684, *3 (N.D. Tex. May 23, 2003) (granting transfer after applying “center of gravity” test for accused activity in patent action to determine the preferred forum) (Ex. X). Thus, the parties’ readily apparent lack of connection to the Eastern District of Texas, in contrast with the centering of accused activity in San Jose, diminishes the significance of Mosaid’s forum choice.

Such facts are reminiscent of *Logan*, where this Court was “forced to wonder” why the plaintiff would choose to bring suit in a District where neither party was located, when another Court was already familiar with the technology at issue. *See Logan*, Docket No. 6:04-cv-211 at 5. Here too, Mosaid chose a new forum for its allegations involving the same Infineon DRAM technology involved in the ongoing case only five days after receiving an unfavorable summary judgment ruling in the first case. Moreover, the three patents asserted by Mosaid in this “new” litigation include one that is a direct descendant of a patent once at issue in the California action, and another two that Mosaid raised during licensing negotiations with Infineon before the California litigation was even filed. Mosaid should not be permitted to engage in serial litigation and claim splitting between two separate forums to hedge its bets against unfavorable rulings—a tactic disfavored by this Court. *See id.*; *ConnectTel*, Docket No. 2:04-cv-396 at 6 (noting the undesirable effects of “forum shopping” for more favorable rulings).

B. Transfer Would Increase Convenience to the Parties and Party Witnesses

Because both Infineon and Mosaid maintain their U.S. corporate headquarters in the Northern District of California, litigating in both parties’ home district will be more convenient. *See Minka Lighting*, 2003 WL at *2 (finding it “more convenient and economical for California corporations to litigate this matter in their home district rather than halfway across the country”) (Ex. X).⁴ Employees

⁴ Infineon North America’s presence in the Northern District of California is also sufficient to satisfy the threshold requirement that this suit could have been brought in the transferee forum, where it resides and is subject to venue. *See* (Continued...)

at Infineon's North American headquarters, within the Northern District of California, are likely to serve as fact witnesses regarding Infineon's business, finances, licensing negotiations with Mosaid and other third parties, as well as marketing, distribution, and sales of Infineon's semiconductor products. *See Infineon Disclosures, Ex. R. at 3.*

Further, any Infineon witnesses who travel to California from other locations would have the convenience of continuing to perform their business duties from Infineon's San Jose headquarters. Mosaid's witnesses will likewise likely benefit from the convenience of traveling to a location where Mosaid maintains corporate offices. Thus, the relative convenience to both parties' witnesses, the mitigation of disrupting ongoing business, as well as the potential monetary savings for securing trial attendance of California employee witnesses favor transfer to the Northern District of California. *See Gundle Lining Constr. Corp. v. Fireman's Fun Ins. Co.*, 844 F. Supp. 1163, 1166 (S.D. Tex. 1994).

Moreover, transfer will allow the Northern District of California to consolidate and/or coordinate the trials in the earlier-filed Infineon/Mosaid action and this case. Regardless of location, this presents a significant convenience and cost savings for all of the witnesses involved and thus further favors transfer.

C. The Northern District of California Is More Convenient for Non-Party Witnesses and Allows for Compulsory Trial Attendance for These Witnesses

This litigation involves a number of non-party witnesses, whose convenience "is the more important factor and is accorded greater weight." *See Gundle*, 844 F. Supp. at 1166 (transferring for convenience of non-party witnesses, in part because of availability of compulsory process over the majority of non-party witnesses only in transferee court). Many third-party licensees of Mosaid's patents-in-suit, from whom Infineon subpoenaed and obtained documents that will likely be relevant at

28 U.S.C. § 1404(a); 28 U.S.C. § 1400(b). The Northern District also has subject matter jurisdiction over this patent infringement action. 28 U.S.C. §§ 1331, 1338.

trial, are located in the Northern District of California, including NEC, Oki, Fujitsu, and Mitsubishi. *See* Ex. U. Transfer is therefore favored by the fact that only the Northern District of California would have the power to compel attendance at trial of these potential witnesses. *See, e.g. Robertson v. Kiamichi R.R. Co.*, 42 F. Supp. 2d 651, 658 (E.D. Tex. 1999); *Lindloff v. Schenectady Int'l*, 950 F. Supp. 183, 185-86 (E.D. Tex. 1996).

D. Transfer to the Northern District of California Would Ease Access To Sources of Proof

Because Infineon's headquarters is located in San Jose, California, and Mosaid's only corporate location in the United States is nearby in Santa Clara, the bulk of U.S.-based documents relevant to this litigation are already within the Northern District of California, which further favors transfer. *See* Infineon Disclosures, Ex. R at 4; *see also Gundle*, 844 F. Supp. at 1166 (location of documentary evidence in transferee district favors transfer). In particular, Infineon identified the following locations of relevant documents in the California litigation:

- Data books, schematics and other technical documents relating to certain Infineon DRAM products are located at Infineon's San Jose headquarters,
- Financial and marketing records relating to sales of certain Infineon DRAM products are located at Infineon's San Jose headquarters, and
- Certain of Infineon's other business records are also located Infineon's San Jose headquarters.

See Infineon Disclosures, Ex. R at 4. Further, Mosaid insisted on conducting simulation testing on the accused Infineon DRAM products at Infineon's San Jose facility during the first case and will presumably request to do so again. These simulations required several weeks of work, all within the Northern District of California. Accordingly, transfer is also favored by this factor.

IV. Conclusion

For the foregoing reasons, Infineon respectfully requests that this Court grant Infineon's motion for transfer of venue to the Northern District of California pursuant to 28 U.S.C. § 1404(a).

Date: July 15, 2005

Respectfully submitted,

/s/ Jennifer P. Ainsworth

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on this the 15th day of July, 2005.

/s/ Jennifer P. Ainsworth

Jennifer P. Ainsworth