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**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

MICRON TECHNOLOGY, INC.,
Plaintiff,
v.
MOSAID TECHNOLOGIES, INC.,
Defendant.

Case Number C 06-4496 JF (RS)
ORDER¹ DENYING MOTION TO
TRANSFER
[re: docket no.43]

Defendant Mosaid Technologies, Inc. (“Mosaid”) moves to transfer the instant action to the Eastern District of Texas pursuant to 28 U.S.C. § 1404(a). The Court has considered the briefing submitted by the parties and amicus curiae as well as the oral arguments presented at the hearing on May 30, 2008. For the reasons discussed below, the motion will be denied.

I. BACKGROUND

Micron Technology Inc. (“Micron”) filed this action for declaratory relief against Mosaid on July 24, 2006. The next day, Mosaid filed a patent infringement suit in the Eastern District of Texas against Micron and Powerchip Semiconductor Corporation (“Powerchip”). On July 27,

¹ This disposition is not designated for publication in the official reporter.

1 2006, Mosaid moved to dismiss Micron’s declaratory relief action for lack of subject matter
2 jurisdiction. After a hearing on October 20, 2007, the Court granted Mosaid’s motion.

3 Following an intervening change in the controlling law, the United States Court of
4 Appeals for the Federal Circuit reversed and remanded on February 29, 2008. *Micron*
5 *Technology, Inc. v. Mosaid Technologies, Inc.*, 518 F.3d 897 (Fed. Cir. 2008). The Federal
6 Circuit also applied 28 U.S.C. § 1404(a) to determine the proper forum for the instant case and
7 concluded that the Northern District of California is the more appropriate forum. *Micron*, 518
8 F.3d at 901, 902–03, 905. The Federal Circuit considered several “convenience factors” as part
9 of its analysis: “the convenience and availability of witnesses, the absence of jurisdiction over all
10 necessary or desirable parties, and the possibility of consolidation with related litigation.” *Id.* at
11 905 (citing *Genentech* 998 F.2d at 938). The court found that neither the availability of
12 witnesses nor jurisdiction over parties weighed in favor of either forum, and “the record [did] not
13 show any ongoing litigation requiring consolidation.” *Id.* Notably, the Federal Circuit stated “it
14 would be an abuse of discretion to transfer the action.” *Id.* Mosaid’s motion for rehearing
15 subsequently was denied. On April 23, 2008, Mosaid brought the instant motion to transfer the
16 instant case for consolidation with the concurrently pending action in the Eastern District of
17 Texas.

18 II. DISCUSSION

19 Section 1404(a) provides that “for the convenience of parties and witnesses, in the
20 interest of justice, a district court may transfer any civil action to any other district or division
21 where it might have been brought.” 28 U.S.C. § 1404(a). As noted by the Federal Circuit, “the
22 general rule favors the forum of the first-filed action” but “the trial courts have discretion to
23 make exceptions to this general rule in the interest of justice or expediency.” *Micron*, 518 F.3d
24 at 904 (citing *Genentech Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 937 (Fed. Cir. 1993)).

25 Mosaid argues that notwithstanding the unambiguous direction in the Federal Circuit’s
26 opinion, that court’s § 1404(a) analysis has been superseded by subsequent developments in the
27 litigation in the Eastern District of Texas. Because the scope of the Texas action is broader than
28 that of the instant case—including additional patents and an additional defendant—and because

1 that action has progressed further toward trial, Mosaid claims that judicial efficiency now weighs
2 in favor of transferring the instant case to the Eastern District of Texas notwithstanding the
3 Federal Circuit's reasoning.

4 However, having conferred with the assigned judge in the Texas action, this Court
5 concludes that the Texas action is not so advanced as to justify revisiting the Federal Circuit's
6 § 1404 analysis. While the parties have conducted significant discovery and have resolved
7 certain procedural issues, the Texas court has not conducted a *Markman* hearing. Both the Texas
8 court and this Court have substantial experience adjudicating patent cases, and it appears that any
9 discovery taken in the Texas action is transferable to this Court.

10 Micron asserts fourteen patents in the instant case; in the Texas action, Mosaid has
11 asserted infringement by Micron of eight of these fourteen patents as well as infringement of four
12 additional patents. With the exception of one patent not asserted against Powerchip, Mosaid has
13 asserted identical claims against Micron and Powerchip. Because different patents are at issue in
14 both actions, the parties will have to dedicate additional time and resources if the cases are
15 consolidated irrespective of the forum in which the consolidated case ultimately is tried.
16 Moreover, Powerchip has moved to intervene in the instant action, which further weakens
17 Mosaid's argument that the Eastern District of Texas is the more appropriate forum because it is
18 the only forum in which all patents are before the court.

19 Because the Court concludes that the circumstances have not changed significantly since
20 the Federal Circuit conducted its § 1404 analysis, the motion to transfer will be denied. In
21 keeping with its comments during oral argument, the Court will use its best efforts to expedite
22 claim construction and the setting of an early trial date.

IV. ORDER

For the reasons set forth above, the motion to transfer is DENIED.

IT IS SO ORDERED.

DATED: June 17, 2008.



JEREMY FOGEL
United States District Judge

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