

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF OKLAHOMA**

MILLER MENDELL, INC., a Washington)
Corporation; TYLER MILLER, an Oregon)
state resident,)
)
Plaintiff,)
)
vs.) Case No. CIV-18-990-HE
)
THE CITY OF OKLAHOMA CITY, a)
municipal corporation,)
)
Defendant.)

**DEFENDANT CITY OF OKLAHOMA CITY'S
RESPONSE IN OPPOSITION TO PLAINTIFFS' MOTION
FOR LEAVE TO FILE SECOND AMENDED COMPLAINT**

Douglas J. Sorocco, OBA # 17347
Evan W. Talley, OBA # 22923
DUNLAP CODDING PC
609 W. Sheridan Avenue
Oklahoma City, OK 73102
Tel: 405.607.8600
Fax: 405.607.8686

*Attorneys for Defendant
The City of Oklahoma City*

October 18, 2019

TABLE OF CONTENTS

TABLE OF AUTHORITIES **iii**

INTRODUCTION **1**

FACTUAL BACKGROUND **2**

ARGUMENT AND AUTHORITIES **3**

**I. THE COURT SHOULD DENY LEAVE TO AMEND WHEN AMENDMENT
 WOULD BE FUTILE.** **3**

**II. AMENDMENT WOULD BE FUTILE BECAUSE VENUE IS IMPROPER
 AS TO GUARDIAN FOR PLAINTIFFS’ CLAIMS OF PATENT
 INFRINGEMENT.** **4**

**III. GUARDIAN DID NOT WAIVE VENUE FOR CLAIMS OF PATENT
 INFRINGEMENT.** **6**

CONCLUSION **10**

..

TABLE OF AUTHORITIES

	Page(s)
<u>Cases</u>	
<i>ARP Wave, LLC v. Salpater</i> , 364 F.Supp.3d 990 (D. Minn. 2019).....	5, 9
<i>Bauchman for Bauchman v. West High School</i> , 132 F.3d 542 (10th Cir. 1997)	3, 4
<i>Bettcher Indust., Inc. v. Hantover, Inc.</i> , No. 3:14-cv-406, 2018 WL 1942179 (N.D. Ohio Apr. 25, 2018).....	8, 9
<i>Brunswick Corp. v. Suzuki Motor Co.</i> , 575 F. Supp. 1412 (E.D. Wis. 1983).....	5
<i>Coastal Steel Corp. v. Tilghman Wheelabrator</i> , 709 F.2d 190 (3d Cir. 1983)	7
<i>Cocona, Inc. v. Columbia Sportswear Co.</i> , No. 17-cv-01195-CMA-CBS, 2017 WL 4029860 (D. Colo. Sept. 12, 2017).....	9
<i>Forman v. Davis</i> , 371 U.S. 178, 83 S. Ct. 227, 9 L. Ed. 2d 222 (1962).....	3
<i>G.A. Mosites Co. of Ft. Worth, Inc. v. Aetna Cas. & Sur. Co.</i> , 545 P.2d 746 (Okla. 1976).....	7
<i>General Protecht Group, Inc. v. Leviton Mfg. Co.</i> , No. CIV-10-1020, 2010 WL 5559750 (D.N.M. Nov. 30, 2010).....	7
<i>In re Cray, Inc.</i> , 871 F.3d 1355 (Fed. Cir. 2017)	4
<i>Knapp-Monarch Co. v. Casco Products Corp.</i> , 342 F.2d 622 (7th Cir.1965)	5

...

Logistics, Inc. v. Nat'l Passenger R.R. Corp.,
272 F. Supp. 2d 784 (E.D. Wis. 2003)..... 5

Lowrimore v. Severn Trent Environmental Services, Inc.,
No. CIV-15-475-RAW, 2016 WL 799127 (E.D. Okla. Feb. 29, 2016) 7

TC Heartland LLC v. Kraft Foods Group Brands LLC,
137 S. Ct. 1514 (2017)..... 1, 3, 4

Union Steel Am. Co. v. M/V Sanko Spruce,
14 F. Supp. 2d 682 (D.N.J. 1998) 7

Uni-Systems, LLC v. United States Tennis Association, Inc.,
350 F. Supp. 3d 143 (E.D.N.Y. 2018) 5

Xantrex Technology Inc. v. Advanced Energy Industries, Inc.,
No. 07-cv-02324-WYD-MEH, 2008 WL 2185882 (D. Colo. May 23, 2008)..... 7, 8

Statutes

28 U.S.C. § 1400(b)..... 1, 4, 5, 6

Rules

Fed. R. Civ. P. 15(a) 3

INTRODUCTION

OKC opposes Plaintiffs' request for leave to amend their First Amended Complaint to add claims against Guardian Alliance Technologies, Inc. for patent infringement, defamation, and a declaration of no inequitable conduct or patent fraud. [*See*, Dkt. Nos. 55-1 and 57-1].¹ The Court should deny Plaintiffs' motion because the patent infringement claim at the heart of Plaintiffs' proposed amended complaint would be subject to dismissal for improper venue thus making amendment futile.

Under 28 U.S.C. § 1400(b), venue in a patent infringement action is only proper where the defendant (1) resides, or (2) has committed acts of infringement and has a regular and established place of business. *TC Heartland LLC v. Kraft Foods Group Brands LLC*, 137 S. Ct. 1514 (2017). Guardian neither resides in Oklahoma, nor has a regular and established place of business in Oklahoma.

Recognizing the lack of patent infringement venue over Guardian in Oklahoma, Plaintiffs argue that Guardian waived its right to object to improper patent venue. However, Plaintiffs' patent venue waiver theory fails as a matter of law. Plaintiffs were not a party to the Subscription Agreement between OKC and Guardian, they are not third-party

¹ OKC files this response outside of the 21-day response period of LCvR7.1(g). OKC does so pursuant to an agreement between counsel that OKC would be afforded an additional seven calendar days to respond Plaintiffs' Motion for Leave, *see*, Exhibit 1 hereto, and at the direction of the Court. Even though the Court has already granted Plaintiffs' request for leave [Dkt. No. 60], based on communications between the Court and counsel for all parties on October 18, 2019, it is OKC's understanding that, upon filing of this Response, the Court's previous order granting Plaintiffs leave will be stricken.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.