

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL LTD.,

Plaintiff,

v.

APPLE INC,

Defendant.

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CIVIL ACTION NO. 5:19-CV-00036-RWS



ORDER

Before the Court is Defendant Apple, Inc.’s Motion to Transfer Venue to the Northern District of California under 28 U.S.C. § 1404 (Docket No. 57). Apple contends that venue is clearly more convenient in the Northern District of California. For the reasons set forth below, Apple’s Motion is **DENIED**.

I. Background

Plaintiff Maxell Ltd. sued Apple, Inc. alleging infringement of 10 Maxell patents.¹ Maxell alleges that various aspects of Apple’s iPhone, iPad and Mac products infringe the Asserted Patents, including: cameras; navigation capabilities; authentication systems; telecommunications techniques; video streaming; “do not disturb” functionality; power management technologies; and smartwatch integration.

A. The Parties

Apple is a Delaware corporation headquartered in Cupertino, California, within the Northern District of California (“NDCA”). Docket No. 57-1 ¶ 6. According to Apple’s declarant, Michael Jaynes, most of Apple’s management, marketing, research and development employees

¹ U.S. Patent Nos. 6,748,317; 6,580,999; 8,339,493; 7,116,438; 6,408,193; 10,084,991; 6,928,306; 6,329,794; 10,212,586 and 6,430,498 (collectively, the “Asserted Patents”).

as well as its 12 relevant witnesses are all in NDCA. *Id.* at ¶¶ 7, 15, 22–35. Furthermore, Apple asserts that its engineering, sales and marketing documents are either located in NDCA or electronically accessible from there, and none are located in the Eastern District of Texas (“EDTX”). *Id.* at ¶¶ 33–36. According to Mr. Jaynes, Apple has no regular place of business or employees relevant to this case in EDTX. *Id.* at ¶¶ 19–20, 36.

Apple has several operations elsewhere in Texas, including thousands of employees at its facilities in Austin. Docket No. 65-3; Docket No. 65-4. Apple holds out its Austin facilities as playing “a very critical and integral role—they are designing chips that go into all the devices [Apple] sell[s].” Docket No. 65-3 at 3.² It is a base of Apple’s microchip design. *Id.* Apple’s Austin engineers played a major role in developing Apple’s ‘A’ series processors and other components in the iPhone and iPad. *Id.* Apple also manufactures its Mac Pro computers in Austin. *Id.* Apple’s Texas facilities house Apple’s customer support services for its iOS and Mac devices. Docket No. 65-5 at 2. And Apple at least partially supports its Maps software from Austin. *Id.*

Maxell is a Japanese corporation headquartered in Kyoto, Japan. As for Maxell’s connections with this district, Hitachi Maxell, Ltd.,³ the prior owner of the Asserted Patents, worked with Alan Loudermilk in this district beginning in 2014. Docket No. 65-51 ¶¶ 5, 8. Mr. Loudermilk began working as Maxell’s agent and representative for licensing negotiations with Apple concerning some of the Asserted Patents. *Id.* ¶ 4. Mr. Loudermilk’s documents from the negotiations are located in this district. *Id.* ¶ 6–7.

[REDACTED]

[REDACTED]

[REDACTED]

² Cites to docket entries are to the ECF pagination.

³ The relationship between Maxell, Hitachi Maxell and Hitachi is discussed *infra* in Section I.B.

[REDACTED]

Apple moves the Court to transfer this case to NDCA for convenience under 28 U.S.C. § 1404. However, before analyzing the traditional § 1404(a) factors, the Court must resolve the parties’ dispute regarding the forum selection clause contained in a 2011 NDA.

B. Prior Negotiations and Communications Concerning the Asserted Patents

The parties have a history of negotiations dating back to the early 2010s. Interwoven into this legacy is the corporate history of Maxell and third-party Hitachi, Ltd (“Hitachi”). Prior to October 2017, Maxell was known as Hitachi Maxell, Ltd. Following a reorganization, Hitachi Maxell, Ltd. became Maxell Holdings, Ltd. by way of a name change and transferred certain assets to Maxell, Ltd., including the Asserted Patents. In this litigation, Maxell has treated Maxell, Ltd. as the direct successor to Hitachi Maxell, Ltd.⁴

Between at least 2011 and June 2013, Hitachi owned some of the Asserted Patents, including the ’317, ’999, ’498 and ’493 patents. Hitachi is a separate entity from the Maxell entities, but it has held varying ownership interests in Hitachi Maxell, Ltd. After June 2013, Hitachi transferred the Asserted Patents to Hitachi Maxell, Ltd.

[REDACTED]

⁴ For the purposes of discovery Maxell has treated both Maxell, Ltd. and the extinct Hitachi Maxell, Ltd. as a single entity and responded to discovery on behalf of both entities.

[REDACTED]

In June 2013, Apple and Hitachi began separate discussions over Hitachi’s “Consumer’s Smart Phone Related Patents.” See Docket No. 57-22. [REDACTED]

[REDACTED]

II. Applicability of the [REDACTED]

Apple now contends that the forum selection clause in the [REDACTED] mandates transfer to NDCA.

A. Legal Standard

Section 1404(a) provides that “[f]or 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

[REDACTED]

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