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AO 120 (Rev. 3/04)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court **CENTRAL DISTRICT OF CAL** on the following Patents or Trademarks:

CASE NO. CV 08-03423 DATE FILED 9/23/2008		U.S. DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA (WESTERN DIVISION)	
PLAINTIFF NUANCE COMMUNICATIONS, INC. A Delaware Corporation		DEFENDANT ECOPY, INC. A Delaware Corporation	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1 5,261,009	11/9/1993	NUANCE COMMUNICATIONS, INC.	
2 5,381,489	1/10/1995	NUANCE COMMUNICATIONS, INC.	
3 6,038,342	3/14/2000	NUANCE COMMUNICATIONS, INC.	
4			
5			

BY **M**
 CLERK OF DISTRICT COURT
 CENTRAL DISTRICT OF CALIF.
 2008 MAY 23 PM 2:39

FILED

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY		
	<input checked="" type="checkbox"/> Amendment	<input checked="" type="checkbox"/> Answer	<input checked="" type="checkbox"/> Cross Bill <input checked="" type="checkbox"/> Other: Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT <p style="text-align: center;">See attached minute order</p>
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CLERK A. Abersman , Acting	(BY) DEPUTY CLERK S. Eagle	DATE 9/2/08
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. CV 08-3423 AHM (FFMx) Date September 2, 2008
Title NUANCE COMMUNICATIONS, INC. v. ECOPY, INC.

Present: The A. HOWARD MATZ, U.S. DISTRICT JUDGE
Honorable

Stephen Montes

Not Reported

Deputy Clerk

Court Reporter / Recorder

Tape No.

Attorneys **NOT** Present for Plaintiffs:

Attorneys **NOT** Present for Defendants:

Proceedings: IN CHAMBERS (No Proceedings Held)

I. INTRODUCTION

This matter is before the Court on the parties' cross-motions to transfer this action, pursuant to 28 U.S.C. § 1404(a). On May 23, 2008, Plaintiff Nuance Communications, Inc. ("Nuance") filed a complaint for patent infringement against Defendant eCopy, Inc. ("eCopy"). The complaint asserts nine claims for relief, including claims for infringement of three patents and claims for false and deceptive advertising, trademark infringement, and unfair competition.

This case is related to a patent infringement action that Nuance filed in this District on February 19, 2008 against Lexmark International, Inc., Abbyy USA Software House, Inc., and Abbyy Software House ("the Abbyy action"). *Nuance Communications, Inc. v. Abbyy Software House, et al*, CV 08-1097 (C.D.Cal. filed February 19, 2008). Both actions involve three patents that Nuance owns and claims have been infringed. On June 3, 2008, this Court transferred the Abbyy action to the Northern District of California, where Abbyy USA had previously filed a declaratory judgment action and where Abbyy USA's principal place of business is located.

On July 15, 2008, eCopy moved to transfer this action to the District of Massachusetts, pursuant to 28 U.S.C. § 1404(a). On July 21, 2008, Nuance then moved to transfer this action to the Northern District of California. For the following reasons,

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the Court GRANTS Nuance's motion,¹ DENIES eCopy's motion,² and TRANSFERS this action to the Northern District of California.

II. LEGAL STANDARD

As this Court stated in its June 3, 2008 order in the *Abbyy Software* action, Title 28 section 1404(a) of the United States Code provides that "[f]or the convenience of the 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." The burden is on the moving party to establish that a transfer would allow a case to proceed more conveniently and better serve the interests of justice. See *Commodity Futures Trading Comm'n v. Savage*, 611 F.2d 270, 279 (9th Cir. 1979) (movant, the defendant, had the burden to justify by particular circumstances that the transferor forum was inappropriate).

Factors to be considered in evaluating motions to transfer under Section 1404(a) include: (1) the location where the events giving rise to the suit took place; (2) the convenience of the parties; (3) the convenience of the witnesses; (4) the location of books and records; (5) the local interest in deciding local controversies at home; (6) the familiarity of the trial judge with the applicable state law in diversity cases; (7) the interest of justice in general; (8) the plaintiff's forum preference; (9) the enforceability of judgment and (10) the relative congestion of the courts' calendars. *Piper Aircraft Co. v. Reyno*, 454 U.S. 235 (1981); *Gulf Oil Co. v. Gilbert*, 330 U.S. 501, 508 (1947).³

"Section 1404(a) is intended to place discretion in the district court to adjudicate motions for transfer according to an individualized, case-by-case consideration of convenience and fairness." *Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 29 (1988). In determining whether to transfer a case, a district court "must balance the preference accorded plaintiff's choice of forum with the burden of litigating in an inconvenient forum. The defendant must make a strong showing of inconvenience to warrant upsetting

¹ Dkt. No. 24.

² Dkt. No. 16.

³ The parties do not address the ninth factor, the enforceability of judgment.

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the plaintiff's choice of forum." *Decker Coal Co. v. Commonwealth Edison Co.*, 805 F.2d 834, 843 (9th Cir. 1986) (citations omitted) (affirming trial court's denial of defendant's motion to transfer case from Montana to Illinois where liability witnesses resided in Illinois and Indiana, but damages witnesses resided in Montana and claim arose in Montana). A plaintiff's choice of forum is not dispositive, however. *See Lou v. Belzberg*, 834 F.2d 730, 739 (9th Cir. 1987) (affirming district court's transfer of shareholder derivative suit from Los Angeles to the Southern District of New York, reasoning that because "operative facts have not occurred within the forum and the forum has no interest in the parties or subject matter, [plaintiff's] choice is entitled to only minimal consideration.")⁴

III. DISCUSSION

A. **The Parties**

Nuance is a Delaware corporation with its principal place of business in Burlington, Massachusetts. (Compl. ¶ 2.) According to the briefing filed in connection with the motion to transfer the Abby action, Nuance has two offices and three employees in Northern California.

eCopy is a Delaware corporation with its principal place of business in Nashua, New Hampshire. (Schmid Decl. ¶ 3.) eCopy has approximately 90 employees who reside in Massachusetts and seven employees who reside in California. (Schmid ¶¶ 4-5.)

B. **The Location Where the Events Giving Rise to the Suit Took Place**

The parties agree that the events giving rise to this lawsuit did not take place in this District. Nuance claims that eCopy has infringed Nuance's patents in California by selling infringing products in the state. Specifically, eCopy's infringing products are sold

⁴ The Ninth Circuit also concluded that the following facts supported the district court's transfer of the case: "(1) the stock purchase agreement was negotiated and executed in New York, (2) the majority of the witnesses live and work in the New York area where they are subject to subpoena, (3) all the defendants are subject to personal jurisdiction in New York, and (4) the costs of litigation would be drastically reduced if the case were heard in New York." *Lou*, 834 F.2d at 739.

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in the Northern District of California by a third party, Canon USA. (See Miller Decl. Ex. 1.) Nuance also asserts that the named inventors on the three patents-in-suit and the attorneys who prosecuted the patents are all located in the Northern District. eCopy contends that the locus of facts giving rise to this lawsuit took place in New Hampshire, where eCopy is headquartered and where it designed the allegedly infringing products. On balance, this factor slightly favors transfer to the Northern District of California.

C. The Convenience of the Parties

None of the parties maintain headquarters, corporate offices, or facilities in this District. Nuance maintains two offices in the Northern District and is litigating the Abby action there. However, its headquarters are in Massachusetts. eCopy is located in New Hampshire, "one mile from the Massachusetts border," but it transacts business and has employees in California. This factor slightly favors transfer to the District of Massachusetts.

D. The Convenience of the Witnesses

"The convenience of witnesses is often the most important factor in determining whether a transfer pursuant to § 1404 is appropriate." *Amini Innovation Corp. v. JS Imports, Inc.*, 497 F.Supp.2d 1093, 1111 (C.D. Cal. 2007). Nuance asserts that the named inventors on the three patents-in-suit (Phillip Bernzott, John Dilworth, David George, Bryan Higgins, and Jeremy Knight), the attorneys who prosecuted the patents and executives of the companies to which the patents were originally assigned are all located in the Northern District of California. Nuance argues that these inventors and assignors may testify as to the patents' validity (eCopy has raised the affirmative defense of patent invalidity), the assignment of the patents to Nuance, and the proper construction of their claims. For its part, eCopy argues that litigating in Massachusetts would be more convenient for its employees and potential witnesses. However, eCopy does not identify any such individuals by name. This factor favors transfer to the Northern District of California.

E. The Location of Books and Records

eCopy asserts that all documents in its possession or control that are relevant to this lawsuit are located in New Hampshire. Nuance does not point to relevant documents

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that are located in the Northern District of California. Accordingly, this factor favors transfer to the District of Massachusetts, but in this electronic age the location of books and records is of little consequence.

F. The Local Interest in Deciding Local Controversies at Home

The parties are corporations headquartered in Massachusetts and New Hampshire but the patents-in-suit were prosecuted by inventors and attorneys in the Northern District of California. Accordingly, this factor favors neither party.

G. The Familiarity of the Trial Judge with the Applicable State Law

Nuance's complaint against eCopy involves claims under California law for false and deceptive advertising and unfair competition. A judge in the Northern District of California is likely to be more familiar with California law than a judge in the District of Massachusetts. This factor favors transfer to the Northern District of California.

H. The Interests of Justice in General

Transferring this action to the District of Massachusetts would waste judicial resources and risk inconsistent claim construction rulings. *Abby Software*— a related case involving the same plaintiff and the alleged infringement of the same three patents— is already pending in the Northern District of California. It makes little sense for two patent infringement actions (and related declaratory judgment actions) involving the same three patents to proceed before two separate courts. Both courts would have to construe the patents' claims and rule on issues (such as the patent's validity) that largely involve the same facts. If the Court transfers this action to the Northern District of California, moreover, Nuance represents that it will seek coordination or consolidation with the Abby action.

eCopy argues that these "cases are not similar" and are only "loosely related" because the Abby action involves five patents whereas this action involves three. The "technology appears different" because, eCopy contends, the lawsuits involve different infringing products. Finally, this action includes trademark and false advertising claims that Nuance has not asserted in the Abby action. In addition, eCopy points to a declaratory judgment action that its "supplier" Image Recognition Integrated Systems,

