In the

United States Court of Appeals

for the

Federal Circuit

IN RE: VOIP-PAL.COM, INC.,
Petitioner

Appeal from the United States District Court for the Northern District of California
in Case Nos. 20-CV-02460-LHK, 20-CV-02995-LHK and 20-CV-03092-LHK
United States District Judge Lucy H. Koh

PETITION FOR WRIT OF MANDAMUS

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number

Short Case Caption IN RE VOIP-PAL.COM, INC.

Filing Party/Entity VOIP-PAL.COM, INC.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box**. Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 01/12/2021

Signature: /s/Lewis E. Hudnell, III

Name: Lewis E. Hudnell, III

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☐ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☑ None/Not Applicable
VoIP-Pal.com, Inc.	VoIP-Pal.com, Inc.	

☐ Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable ☐ Additional pages attached

Lewis E. Hudnell, III Nicolas S. Gikkas HUDNELL LAW GROUP, P.C.		

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☐ None/Not Applicable ☐ Additional pages attached

VoIP-Pal.Com, Inc. v. Apple, Inc., No. 6:20-cv-00275-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. AT&T, Inc. et al., No. 6:20-cv-00325-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Verizon Communications, Inc. et al., No. 6:20-cv-00327-ADA (W.D. Tex.)
VoIP-Pal.Com, Inc. v. Facebook, Inc., No. 6:20-cv-00267-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Google, LLC, No. 6:20-cv-00269-ADA (W.D. Tex.)	VoIP-Pal.Com, Inc. v. Amazon.com, Inc. et al., No. 6:20-cv-00272-ADA (W.D. Tex.)
Twitter, Inc. v. VoIP-Pal.com, Inc., Case No. 5:20-CV-02397-LHK (N.D. Cal.)		

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☑ None/Not Applicable ☐ Additional pages attached

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ABBREVIATION	TERM
VoIP-Pal	Defendant-Petitioner VoIP-Pal.com, Inc.
Apple, Inc.	Apple, Inc.
AT&T	AT&T, Corp., AT&T Services, Inc., and AT&T Mobility LLC
Verizon	Cellco Partnership d/b/a Verizon Wireless
Amazon	Amazon.com, Inc., Amazon.com Services, LLC, and Amazon Web Services, Inc.
Facebook	Facebook, Inc.
Google	Google, LLC
Twitter	Twitter, Inc.
The ’606 patent	U.S. Patent No. 10,218,606
The ’872 patent	U.S. Patent No. 9,935,872
The 2016 cases	*VoIP-Pal.com, Inc. v. Twitter, Inc.*, No. 5:18-cv-04523-LHK (N.D. Cal.); *VoIP-Pal.com, Inc. v. Verizon Wireless Services, LLC*, No. 18-cv-06054-LHK (N.D. Cal.); *VoIP-Pal.com, Inc. v. AT&T Corp.*, No. 3:18-cv-06177-LHK (N.D. Cal.); and *VoIP-Pal.com, Inc. v. Apple, Inc.*, No. 3:18-cv-06217-LHK (N.D. Cal.)

The 2018 cases	*VoIP-Pal.com, Inc. v. Amazon.com, Inc.*, No. 5:18-cv-7020 (N.D. Cal.) and *VoIP-Pal.com, Inc. v. Apple Inc.*, No. 5:18-cv-6216 (N.D. Cal.)
WDTX	Western District of Texas
NDCAL	Northern District of California
DNV	District of Nevada
The WDTX cases	*VoIP-Pal.Com, Inc. v. Facebook, Inc.*, No. 6:20-cv-00267-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Google, LLC*, No. 6:20-cv-00269-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Amazon.com, Inc. et al.*, No. 6:20-cv-00272-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Apple, Inc.*, No. 6:20-cv-00275-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. AT&T, Inc. et al.*, No. 6:20-cv-00325-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Verizon Communications, Inc. et al.*, No. 6:20-cv-00327-ADA, (W.D. Tex.)

STATEMENT OF RELATED CASES

This petition concerns three patent-infringement actions involving the '606 patent and three declaratory-judgment actions involving the '606 patent subsequently filed by the Respondents in a different district court: *VoIP-Pal.Com, Inc. v. Apple, Inc.*, No. 6:20-cv-00275-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. AT&T, Inc. et al.*, No. 6:20-cv-00325-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Verizon Communications, Inc. et al.*, No. 6:20-cv-00327-ADA (W.D. Tex.); *Apple, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-CV-02460-LHK (N.D. Cal.); *AT&T Corp., et al. v. VoIP-Pal.com., Inc.*, Case No. 5:20-CV-02995-LHK; and *Cellco Partnership d/b/a Verizon Wireless v. VoIP-Pal.com., Inc.*, Case No. 5:20-CV-03092-LHK (N.D. Cal.).

The '606 patent also asserted against other defendants in the following separate lawsuits: *VoIP-Pal.Com, Inc. v. Facebook, Inc.*, No. 6:20-cv-00267-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Google, LLC*, No. 6:20-cv-00269-ADA (W.D. Tex.); *VoIP-Pal.Com, Inc. v. Amazon.com, Inc. et al.*, No. 6:20-cv-00272-ADA (W.D. Tex.). The '606 patent is also the subject of the following declaratory-judgment action: *Twitter, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-CV-02397-LHK (N.D. Cal.).

I. INTRODUCTION

VoIP-Pal respectfully requests that this Court grant mandamus relief and reverse the district court's Order denying VoIP-Pal's Consolidated Motion to Dismiss the underlying declaratory-judgment actions under the first-to-file rule. The grounds for mandamus in this case are especially compelling. There is no legitimate dispute that VoIP-Pal filed suit on the '606 patent against the Respondents in the WDTX first. In a deliberate effort to strip VoIP-Pal of its chosen venue, the Respondents subsequently filed declaratory-judgment actions on the '606 patent in the NDCAL. Relying principally on its limited familiarity with related VoIP-Pal patents, the district court willfully endorsed the Respondents' ploy. Yet as one court in the NDCAL has recognized, "[t]he Declaratory Judgment Act is not to be invoked to deprive a plaintiff of his conventional choice of forum." *Z-Line Designs, Inc. v. Bell'O Int'l*, LLC, 218 F.R.D. 663, 665 (N.D. Cal. 2003) (citations and quotations omitted). Another NDCAL court has stated, "the law should leave no room for this practice." *See Marvell Semiconductor, Inc. v. Monterey Research, LLC*, No. 20-CV-03296-VC, 2020 U.S. Dist. LEXIS 210873, at *3 (N.D. Cal. Nov. 11, 2020). The potential ramifications of not granting mandamus relief to stop this manipulative practice are severe. If left intact, the district court's erroneous ruling will license any accused infringer to transmute the patent owner's choice of forum into its own choice of forum whenever it is sued on a related patent in a forum it does not like.

This case is not the first time the Respondents have manipulated VoIP-Pal's choice of forum to their advantage. VoIP-Pal previously filed suits against the Respondents, Twitter, and Amazon in VoIP-Pal's home venue—the DNV. Because the DNV granted Twitter's motion to transfer for improper venue to the NDCAL, VoIP-Pal had to agree to transfer its cases against the Respondents to the NDCAL. But when the cases arrived in the NDCAL, the district court did not even want them. At its first case management conference, the district court wanted to transfer them to another NDCAL judge:

> THE COURT: Okay. So why don't -- I mean, believe me, I would be so happy to transfer these to any of my colleagues.

Appx871, 7:12-14. Alternatively, the district court wanted to transfer the cases to another venue:

> THE COURT: Now, I wouldn't mind transferring this case to another venue. Are we sure that venue is proper here under TC Heartland and Cray? Is that right?

Appx884, 20:7-9. Not only did the district court not want VoIP-Pal's cases, but it did not want any future VoIP-Pal patents, which it labeled "a cancer" before it even assessed their validity:

> THE COURT: I see. *I don't want this to keep growing like a cancer*, though, because I'm sure they're growing the family as we speak, and are we just going to keep getting more continuations and then are you going to assert those four continuations against the other defendants here?

Appx874, 10:11-15 (emphasis added). Considering the district court's overt bias against VoIP-Pal's patents, it is unsurprising that the district court rid itself of VoIP-Pal's previous cases the quickest way that it could—it invalidated the asserted claims of six VoIP-Pal patents under § 101 at the Rule 12 stage. Now, the district court, clearly abusing its discretion, has cast aside the first-to-file rule so that it can invalidate yet another VoIP-Pal patent.

Rather than swiftly dismiss these second-filed-declaratory-judgment actions for the Respondents' flagrant violation of the first-to-file rule, the district court, changing its tune, welcomed VoIP-Pal's allegedly cancerous patent because "the Western District of Texas' decision on the '606 patent could conflict with this Court's prior orders." Appx13. The district court clearly made an erroneous conclusion of law because the first-to-file rule is intended to avoid conflict between two *pending* cases on the *same patent*, not between a pending case and previously adjudicated and *closed* cases on *different patents*. Even more troubling, the district court's protectiveness of its prior orders plainly revealed that it had predetermined the fate of the '606 patent, which is immensely prejudicial to VoIP-Pal. The district court's Order even prompted two distinguished, technically-expert members of VoIP-Pal's board to resign due to what they viewed as an intolerably biased and unjust decision.

But the district court did not stop with these egregious errors. The district court also inexplicably and falsely accused VoIP-Pal of improper forum shopping despite VoIP-Pal's previous cases against the Respondents being transferred out of VoIP-Pal's home forum. Moreover, the district court openly asked whether the previous cases could be transferred to another venue, and none of the Respondents have challenged VoIP-Pal's choice of the WDTX as an improper venue. Relying on *In re Apple*, 979 F.3d 1332 (Fed. Cir. 2020), in which this Court found that Judge Alan D Albright—the same judge in VoIP-Pal's WDTX cases—abused his discretion by failing to transfer a case against Respondent Apple to the NDCAL, the district court evidently felt emboldened to keep these second-filed-declaratory-judgment actions in the NDCAL. But the facts of *In re Apple* (2020) are irrelevant to the facts in these cases. If anything, the district court's reliance on *In re Apple* (2020) further evidences the district court's unreasonable and erroneous steps to keep the parties' dispute regarding the '606 patent away from the WDTX.

Among those missteps, the district court skewed its analysis of an exception to the first-to-file rule by only considering two convenience factors and by claiming only that Apple witnesses and Apple sources of proof were allegedly located in the NDCAL. The record, however, contained no evidence supporting either of these conclusions. Also, the district court's opinion is devoid of any analysis of AT&T or Verizon. The district court further erred by shifting the burden to prove an exception

to the first-to-file rule from Respondents to VoIP-Pal. Given this flawed analysis, the district court could not reasonably conclude that its limited familiarity with related VoIP-Pal patents rose to the level of a substantial countervailing consideration sufficient to justify an exception to the first-to-file rule.

Finally, the district court made no finding that it was the first-filed court and in fact analyzed the first-to-file rule as if it were the second-filed court. But as the second-filed court, the district court should have dismissed, stayed, or transferred its cases so that the first-filed court—the WDTX—could determine how the first-filed cases should proceed. *See Futurewei Techs., Inc. v. Acacia Research Corp.*, 737 F.3d 704, 708 (Fed. Cir. 2013) ("When two actions that sufficiently overlap are filed in different federal district courts, one for infringement and the other for declaratory relief, the declaratory judgment action, if filed later, generally is to be stayed, dismissed, or transferred to the forum of the infringement action.").

For all of these reasons, the district court abused its discretion and mandamus should be granted.

II. RELIEF SOUGHT

VoIP-Pal respectfully requests that the Court grant the petition for a writ of mandamus, vacate the district court's Order denying VoIP-Pal's Consolidated Motion to Dismiss under the First-to-File Rule, and remand with instructions to

dismiss these second-filed-declaratory-judgment actions so the first-filed court in the WDTX can decide how these subsequently filed actions should proceed.

III. ISSUES PRESENTED

Whether the district court abused its discretion in declining to apply the first-to-file rule by: (1) erroneously concluding that the WDTX's decision regarding the '606 patent could conflict with the district court's prior orders; (2) erroneously accusing VoIP-Pal of forum shopping; (3) erroneously invoking an exception to the first-to-file rule without a factual basis in the record; (4) erroneously shifting the burden to prove an exception to the first-to-file rule to VoIP-Pal; and (5) erroneously finding its limited familiarity with previous VoIP-Pal cases sufficient to override the first-to-file rule.

IV. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

A. The Parties

VoIP-Pal is a small Nevada corporation with offices in Bellevue, Washington. Appx679. In addition, not in the record below, but factually true, is that VoIP-Pal is registered as a foreign corporation in Texas and has an office in Waco, Texas, where one of its advisors works. *See* https://www.voip-pal.com/contact-us (last visited Jan. 12, 2021). VoIP-Pal has no employees, offices, holdings, or assets in California. VoIP-Pal has neither licensed nor filed suit on its patents in California. Instead,

VoIP-Pal filed the first six suits asserting its patents in its home district—the DNV—in 2016 and 2018.

The Respondents are geographically dispersed. AT&T Services, Inc. is a Delaware corporation with principal places of business in San Antonio, Texas (WDTX) and Dallas, Texas. Appx2013; Appx709. AT&T Mobility, LLC is a Delaware corporation with a principal place of business in Atlanta, Georgia. Appx2013. AT&T Corp. is a New York corporation with a principal place of business in Bedminster, New Jersey. *Id.* Cellco Partnership does business under the name of Verizon Wireless. Appx2294. Verizon is a Delaware corporation with its principal place of business in Basking Ridge, New Jersey. *Id.* Apple is the only party that is headquartered in the NDCAL. Appx287; Appx679. Apple's second-largest office, however, is in Austin, Texas, which is in the WDTX. Appx679.

B. VoIP-Pal's 2016 Cases Against AT&T, Apple, Twitter, And Verizon

In 2016, VoIP-Pal filed four lawsuits in the DNV against AT&T, Verizon, Apple, and Twitter. In each case, VoIP-Pal asserted two patents related to the '606 patent. Shortly after the Supreme Court decided *TC Heartland*, the DNV granted Twitter's motion to transfer Twitter's action to the NDCAL for improper venue. *See VoIP-Pal.com, Inc. v. Twitter, Inc.*, Case No. 2:16-cv-02338-RFB-CWH, 2018 U.S. Dist. LEXIS 122807 (D. Nev. July 23, 2018). Consequently, VoIP-Pal was forced

to agree to transfer the remaining Nevada cases to the NDCAL. Appx1864-1866; Appx1868-1870; Appx1872-1875.

Between August 14 and November 7, 2018, the 2016 cases were assigned to Judge Lucy H. Koh—the same judge in these second-filed-declaratory-judgment actions. On March 25, 2019, Judge Koh granted the defendants' Rule 12 motion to dismiss VoIP-Pal's asserted claims as invalid under § 101 and closed the 2016 cases. *See VoIP-Pal.Com, Inc. v. Apple Inc.*, 375 F. Supp. 3d 1110 (N.D. Cal. 2019); Appx1557-1560. Thus, Judge Koh presided over the 2016 cases for less than eight months, considered one Rule 12 motion, and dismissed the 2016 cases at the pleadings stage over a year before the Respondents filed their declaratory-judgment actions. Among other things, Judge Koh did not conduct a *Markman* hearing, issue a claim construction order, consider motions for summary judgment, consider *Daubert* motions, or conduct a trial. Judge Koh also never considered the Respondents' accused products and services or their infringement. On March 16, 2020, this Court affirmed Judge Koh's decision invalidating the asserted claims in the 2016 cases. *See VoIP-Pal.Com, Inc. v. Twitter, Inc.*, 798 F. App'x 644 (Fed. Cir. 2020).

C. VoIP-Pal's 2018 Cases Against Apple And Amazon

In 2018, VoIP-Pal filed two additional lawsuits against Apple and Amazon in the DNV. In the 2018 cases, VoIP-Pal asserted four patents related to the '606 patent

and the two patents in the 2016 cases. Because the DNV transferred the Twitter case, VoIP-Pal again had no choice but to agree to transfer the 2018 cases to the NDCAL. Appx1877-1879; Appx1881-1884.

Between November 6 and 28, 2018, the 2018 cases were assigned to Judge Koh. On November 1, 2019, Judge Koh granted a Rule 12 motion to dismiss VoIP-Pal's asserted claims as invalid under § 101 and closed the 2018 cases. *See VoIP-Pal.com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926 (N.D. Cal. 2019); Appx1562-1563. Thus, Judge Koh presided over the 2018 cases for less than a year, considered one Rule 12 motion, and dismissed the 2018 cases at the pleadings stage over five months before Respondents filed their declaratory-judgment actions. Like the 2016 cases, Judge Koh did not conduct a *Markman* hearing, issue a claim construction order, consider motions for summary judgment, consider *Daubert* motions, or conduct a trial. Although the parties briefed claim construction, Judge Koh never referenced the briefs in ruling on the motion to dismiss. Judge Koh also never considered the Respondents' accused products and services or their infringement. On November 3, 2020, this Court affirmed Judge Koh's decision invalidating the asserted claims in the 2018 cases. *See VoIP-Pal.com, Inc. v. Apple, Inc.*, No. 20-1241, 2020 U.S. App. LEXIS 34684 (Fed. Cir. Nov. 3, 2020).

D. VoIP-Pal's WDTX Cases

On April 2, 2020, VoIP-Pal sued Facebook and WhatsApp in the WDTX for infringing VoIP-Pal's '606 patent. Appx604. This suit was the first one that VoIP-Pal filed asserting the '606 patent. Subsequently, VoIP-Pal filed suits in the WDTX against Google (April 3), Amazon (April 6), Apple (April 7), AT&T (April 24), and Verizon (April 24). *Id.*; Appx679; Appx708-709; Appx738-740. The cases were assigned to Judge Albright.

On July 8, 2020, AT&T and Verizon filed a Motion to Stay in Favor of the First-Filed Case or, in the Alternative, to Stay, Dismiss, or Transfer under the First-Filed Rule or 28 U.S.C. § 1404(a). Appx2257-2259. Apple filed a similar motion the next day. Appx616-617. Despite their declaratory-judgment actions being filed second, the Respondents inexplicably argued to the WDTX that their actions were filed first. Appx633-634; Appx2273-2275.

Just before briefing completed on Respondents' motions, Judge Albright conducted an initial status conference in which he was apprised of Respondents' motions and VoIP-Pal's Motion to Dismiss from which this petition arises. Judge Albright indicated that he was "not persuaded yet to stay what we're doing on the basis of the parallel case in California" but that he "may reach out to Judge Koh, if she were so inclined to take [his] call." Appx2673, 38:13-16. Then, on September

29, 2020, Judge Albright *sua sponte* stayed VoIP-Pal's WDTX cases without ruling on Respondents' motions. Appx2690-2691.

E. The NDCAL Declaratory-Judgment Actions

In a deliberate attempt to manipulate VoIP-Pal's choice of venue for the '606 patent, Apple, AT&T, and Verizon all chose to file actions in the NDCAL seeking declarations of non-infringement and invalidity of the '606 patent. Apple filed its declaratory-judgment action on April 10, 2020—three days after VoIP-Pal filed its WDTX complaint against Apple. Appx28. Four days later, Apple amended its complaint to seek a declaration of non-infringement and invalidity of VoIP-Pal's '872 patent, despite VoIP-Pal never taking any affirmative steps to enforce the '872 patent against Apple. Appx285. AT&T filed its declaratory-judgment action on April 30, 2020—six days after VoIP-Pal filed its WDTX complaint against AT&T. Appx2011. Verizon filed its declaratory-judgment action on May 5, 2020—11 days after VoIP-Pal filed its WDTX complaint against Verizon. Appx2292.

Subsequently, Apple moved to relate its declaratory-judgment action to VoIP-Pal's 2016 case against Apple, which had been closed for over a year. Appx606-607. Without articulating any basis, the district court granted Apple's motion to relate the very next business day before VoIP-Pal's opposition was due. Appx615. The district court also granted AT&T's and Verizon's motions to relate without stating any bases. Appx2634; Appx2635.

Apple's, AT&T's, and Verizon's attempt to divert litigation on the '606 patent to the NDCAL—risking conflicting outcomes from actions pending in two different courts—was improper on multiple grounds under well-settled law. Hence, VoIP-Pal moved to dismiss these three declaratory-judgment actions in their entirety for violation of the first-to-file rule, lack of personal jurisdiction, improper venue, and lack of subject-matter jurisdiction. Appx2288, #31. Yet, despite these glaring jurisdictional infirmities, the district court denied VoIP-Pal's motion to dismiss. Appx1-27.

V. LEGAL STANDARD

As the Supreme Court explained over a century ago, the general rule is that "where the same matter is brought before courts of concurrent jurisdiction, the one first obtaining jurisdiction will retain it until the controversy is determined, to the entire exclusion of the other." *Pac. Live Stock Co. v. Or. Water Bd.*, 241 U.S. 440, 447 (1916). The first-to-file rule instructs that when two cases of sufficient overlap are simultaneously pending in different federal courts, the second-filed of those two cases is generally to be dismissed, stayed, or transferred in favor of the first-filed case. *See Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 937-38 (Fed. Cir. 1993), *abrogated on other grounds by Wilton v. Seven Falls Co.*, 515 U.S. 277 (1995). The general rule that the first-filed actions is favored may be even stronger when the second-filed actions are declaratory-judgment actions, such as in the instant cases.

See Brillhart v. Excess Ins. Co. of Am., 316 U.S. 491, 495 (1942); *Z-Line Designs*, 218 F.R.D. at 665. "When two actions that sufficiently overlap are filed in different federal district courts, one for infringement, the other for declaratory relief, *the declaratory judgment action, if filed later, generally is to be stayed, dismissed, or transferred to the forum of the infringement action*." *Futurwei*, 737 F.3d at 708 (citing *Merial*, 681 F.3d at 1299) (emphasis added).

In patent cases, Federal Circuit law governs application of the first-to-file rule. *Futurewei*, 737 F.3d at 708 ("Resolution of whether the second-filed action should proceed presents a question sufficiently tied to patent law that the question is governed by this circuit's law."); *Elecs. For Imaging, Inc. v. Coyle*, 394 F.3d 1341, 1345-46 (Fed. Cir. 2005). As the Court has explained, "[a]lthough district courts can, in the exercise of discretion, dispense with the first-to-file rule, there must 'be sound reason that would make it unjust or inefficient to continue the first-filed action.'" *See Commns. Test Design v. Contec, LLC*, 952 F.3d 1356, 1364 (Fed. Cir. 2020) (quoting *Genentech*, 998 F.2d at 938). Thus, exceptions to the first-to-file rule are justified only in limited circumstances, such as "considerations of judicial and litigant economy, and the just and effective disposition of disputes." *See Elecs. For Imaging*, 394 F.3d at 1347.

Although the decision whether to apply the first-to-file rule is ordinarily discretionary, "[a] district court by definition abuses its discretion when it makes an

error of law." *Koon v. United States*, 518 U.S. 81, 100 (1996); *see also Elecs. For Imaging*, 394 F.3d at 1345. An abuse of discretion may also be found when (1) the district court's decision was clearly unreasonable, arbitrary, or fanciful; (2) the district court's findings were clearly erroneous; or (3) the record contains no evidence upon which the district court rationally could have based its decision. *See 3M v. Norton Co.*, 929 F.2d 670, 673 (Fed. Cir. 1991).

Mandamus relief is warranted where: (1) the petitioner's "right to issuance of the writ is clear and indisputable"; (2) there is "no other adequate means to attain the relief [the petitioner] desires"; and (3) the "writ is appropriate under the circumstances." *Cheney v. U.S. Dist. Court for D.C.*, 542 U.S. 367, 380-81 (2004) (quotation marks omitted). The Court has reviewed first-to-file rule decisions in the exercise of its mandamus jurisdiction. *See In re Nitro Fluids L.L.C.*, No. 20-142, 2020 U.S. App. LEXIS 33984 (Fed. Cir. Oct. 28, 2020); *In re Google Inc.*, 588 F. App'x 988 (Fed. Cir. 2014).

VI. REASONS FOR ISSUING THE WRIT

The district court's denial of VoIP-Pal's motion to dismiss under the first-to-file rule meets the high standard for mandamus relief. The district court abused its discretion by not adhering to the first-to-file rule, which required it to send the question of how the overlapping cases should proceed to the first-filed court—the WDTX. Applying that rule in these cases required dismissal of the Respondents'

second-filed-declaratory-judgment actions in favor of VoIP-Pal's first-filed WDTX actions. The district court abused its discretion in concluding otherwise.

A. Mandamus Is Warranted Because The District Court Abused Its Discretion By Failing To Dismiss The Second-Filed Actions In Favor Of The First-Filed Actions.

1. The district court's concern that the WDTX could reach a conflicting decision regarding the '606 patent was clearly erroneous.

The district court's conclusion that not applying the first-to-file rule would achieve the goal of avoiding conflicting results was clearly erroneous and highly prejudicial. Appx12. The district court misapplied this Court's precedent in *Merial v. Cipla* when it concluded that the first-to-file rule is intended to avoid conflict between its *prior orders* invalidating the asserted claims of six VoIP-Pal patents in *closed* cases and any decision of the WDTX on the '606 patent in the *pending* WDTX cases. Appx13. Rather, the first-to-file rule is intended to avoid conflict between two or more *pending* cases that involve overlapping issues:

> The only potential results *of adjudicating these cases in parallel fashion* would be the Texas and California courts . . . disagree [on the major issues of the litigation], thus producing conflicting decisions.

In re Google Inc., 588 Fed. Appx. at 990 (citing *Merial Ltd. v. Cipla Ltd.*, 681 F.3d 1283, 1299 (Fed. Cir. 2012)) (emphasis added).

Because the district court misconstrued *Merial*, its reasoning that "the Western District of Texas' decision on the '606 patent could conflict with this

Court's prior orders" was plainly erroneous. Appx13. Not only are neither the previously asserted patents nor previously asserted claims pending before the WDTX, but the result in the 2016 and 2018 cases does not mean that the claims of the '606 patent are ineligible—they are different and distinct claims. It is black letter law that "[e]ach patent asserted raises an independent and distinct cause of action." *Kearns v. Gen. Motors Corp.*, 94 F.3d 1553, 1555 (Fed. Cir.1996). Separate patents represent separate property rights and separate claims within the same patent represent separate property rights. Indeed, the patent statute expressly provides that each claim of a patent is presumed valid independently of the validity of any other claim. *See* 35 U.S.C. § 282. Given that presumption, patent eligibility must be evaluated, like any other ground of invalidity, claim-by-claim. *See Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 942 (Fed. Cir. 1992) ("grounds of invalidity must be analyzed on a claim-by-claim basis") (citing *Shelcore, Inc v. Durham Industries, Inc.*, 745 F.2d 621, 624 (Fed. Cir. 1984) ("a party challenging the validity of a claim, absent a pretrial agreement or stipulation, must submit evidence supporting a conclusion of invalidity of each claim the challenger seeks to destroy")). Thus, any decision by the WDTX on the '606 patent could not, by definition, conflict with the district court's prior orders.

Moreover, as noted above, the district court found the asserted claims of six VoIP-Pal patents ineligible at the Rule 12 stage, without the benefit of a fully

developed factual record and without conducting claim construction. Typically, however, Judge Albright does not decide eligibility issues before claim construction. *See Slyce Acquisition v. Syte – Visual Conception*, 19-CV-00257-ADA, 2020 U.S. Dist. LEXIS 9451, at *16 (W.D. Tex. Jan. 10, 2020). Putting aside the fact that different claims of a different patent are pending in the WDTX, there is simply no risk that the WDTX could reach a decision that conflicts with the district court's prior orders because the WDTX's decision would be based on a different record. Indeed, this Court has even affirmed judgments where one district court found the claims of certain patents eligible at the Rule 12 stage but a different district court found *the same claims of the same patents* ineligible at the summary judgment stage. *See GoDaddy.com, LLC v. RPost Communs. Ltd. et al.*, 2016 U.S. Dist. LEXIS 73921, at *83-*84, n.25 (D. Az. June 7, 2016), aff'd by 2017 U.S. App. LEXIS 7978 (Fed. Cir., May 5, 2017). Thus, the district court's reliance on "the '606 patent shar[ing] a common specification, title, parent application, inventors, and owner" as the six patents in the 2016 and 2018 cases is unavailing. Appx12-13. "[D]ifferent judgments can be reached and must be affirmed even on essentially the same evidentiary record. That is a vagary of our justice system." *Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1571 (Fed. Cir. 1993). At most, the district court's prior orders could inform the WDTX that caution must be taken before reaching any

contrary legal conclusion regarding the '606 patent. *Id.* at 1569. These prior orders, however, do not supply a sound reason to disregard the first-to-file rule.

The district court's fear that the WDTX could reach a decision on the '606 patent that conflicts with its prior orders was not only clear error, but also revealed that the district court had prejudged the Respondents' declaratory-judgment claims of invalidity of the '606 patent. The only plausible understanding of the district court's reasoning is that if the WDTX were to find the claims of the '606 patent eligible, then that would conflict with the district court's prior orders in the 2016 and 2018 cases. If the district court had not prejudged the '606 patent claims as ineligible, then it too could find the claims of the '606 patent eligible. But clearly the district court did not think that because it believed that that outcome would conflict with its prior orders.

Notably, the Order was not the first time that the district court made highly prejudicial statements against VoIP-Pal's patents before assessing their merits. At the same hearing cited in footnote five of the Order, the district court likened the '606 patent, then pending as a continuation, to "a cancer" in the immediately preceding clause of the sentence cited in the Order:

> THE COURT: I see. *I don't want this to keep growing like a cancer*, though, because I'm sure they're growing the family as we speak, and are we just going to keep getting more continuations and then are you going to assert those four continuations against the other defendants here?

Appx27 (emphasis added). Both this statement and the district court's fear that the WDTX could reach a conflicting decision regarding the '606 patent appear to arrogate to the district court a paramount authority to invalidate the claims of the '606 patent. Indeed, the Order prompted two long-standing directors of VoIP-Pal, who perceived the district court as being intractably biased against the '606 patent, to resign. *See* https://www.ceocfointerviews.com/emilmalakoped121920.html (last visited Jan. 12, 2021). The district court's predisposition to invalidate allegedly cancerous claims of the '606 patent is highly prejudicial to VoIP-Pal and renders its failure to apply the first-to-file rule in this case manifestly unjust.

2. The district court's belief that VoIP-Pal engaged in improper forum shopping was clearly unreasonable.

The district court's refusal to apply the first-to-file rule because it believed that VoIP-Pal engaged in improper forum shopping was also clearly erroneous. As a plaintiff, VoIP-Pal had the privilege of selecting whatever forum it considered most advantageous. *See Norwood v. Kirkpatrick*, 349 U.S. 29, 31 (1955) ("plaintiffs [is] generally accorded [the] privilege of bringing an action where he chooses."). Even the district court recognized in *Ruckus Wireless v. Harris* that "the patent holder has the prerogative to choose its own forum." *See Ruckus Wireless, Inc. v. Harris Corp.*, No. 11-CV-01944-LHK, 2012 U.S. Dist. LEXIS 22336, at *11 (N.D. Cal. Feb. 22, 2012)). That is not forum shopping. The district court even held in *Ruckus Wireless* that "improper forum shopping is not a 'consideration[] of judicial

and litigant economy, and the just and effective disposition of disputes' that would require the Court to dispense with the general rule favoring the forum of the first-filed case." *Id.* at *12 (citations omitted). Inexplicably, the district court ignored its own first-to-file rule precedent, which VoIP-Pal cited in its Motion, and applied other precedent that was entirely inapposite. Appx1540-1541 (citing *Ruckus Wireless*).

First, the district court cited *Genentech Inc. v. Eli Lilly & Co.* for the proposition that "first-filed suits have sometimes been dismissed when forum shopping was the *only motive for filing*." Appx13 (emphasis added). But the *Genentech* court was reviewing a dismissal by the first-filed court; it was not upholding a refusal to dismiss an action by the second-filed court due to alleged forum shopping. *See Genentech*, 998 F.2d at 935. Additionally, the Court in *Genentech* found that forum shopping was not the "only motive for filing" the first-filed suit because *one of the two* defendants in the first-filed suit had ties to the forum. *Id.* at 938. Conversely, *all* of the Defendants-Respondents have ties to the WDTX. Appx679; Appx708-709; Appx738-739. Indeed, none of the Respondents challenged VoIP-Pal's choice of forum under § 1406. Thus, the district court could not reasonably conclude that forum shopping was VoIP-Pal's *only motive for filing* in the WDTX. The district court appeared to believe that VoIP-Pal engaged in forum shopping simply because VoIP-Pal allegedly lacked ties to the WDTX. Appx13.

But the district court cited no evidence to support this conclusion, which is untrue—VoIP-Pal has an office in Waco. *See* https://www.voip-pal.com/contact-us (last visited Jan. 12, 2021).

Second, the district court's reliance on *Alexander v. Franklin Res., Inc.* was misplaced. Appx13. In that case, the court found that the plaintiff engaged in forum shopping because it filed a suit in the NDCAL after receiving an unfavorable ruling in a similar suit that it filed pending in New Jersey. *See Alexander v. Franklin Res., Inc.*, Case No. 06-7121, 2007 U.S. Dist. LEXIS 19727, at *11 (N.D. Cal. Feb. 14, 2007). But in this case, VoIP-Pal did not choose the WDTX because it received an unfavorable ruling in the NDCAL. VoIP-Pal chose a forum different than the NDCAL because it never chose to litigate the 2016 and 2018 cases in the NDCAL in the first place—it chose Nevada. But because Nevada transferred VoIP-Pal's original cases, VoIP-Pal, unlike the plaintiff in *Alexander*, had to choose a different forum to litigate the '606 patent. Moreover, the court in *Alexander* transferred the plaintiff's second-filed suit to New Jersey where the plaintiff's first-filed case was pending. *Id.* *Alexander*, however, does not stand for the proposition that the second-filed court can refuse to dismiss a declaratory-judgment action filed against the party believed to have engaged in forum shopping after that party has already filed suit elsewhere.

Furthermore, the district court's belief that the Respondents had legitimate reasons to file declaratory-judgment actions in the NDCAL was also clearly unreasonable. Appx13. The district court gave absolutely no weight to the fact that the Respondents filed their second-filed actions with full knowledge of VoIP-Pal's first-filed WDTX cases in a deliberate attempt to manipulate VoIP-Pal's choice of venue. The tactic of initiating second-filed-declaratory-judgment actions by accused infringers is not new, and both the Ninth Circuit, where the district court sits, and the Supreme Court have long rejected the tactic's legitimacy. As the Ninth Circuit explained, "[d]eclaratory relief is intended to serve a unique function in patent disputes, eliminating multiple litigation and protecting competitors from infringement actions that are threatened but not pursued." *Pacesetter Sys. v. Medtronic, Inc.*, 678 F.2d 93, 97 (9th Cir. 1982). Like the appellant in *Pacesetter*, each of the Respondents improperly seeks a "declaratory judgment action [that] multiplies litigation." *Id.* These second-filed-declaratory-judgment actions do not shield them from "an unfair infringement action, but attempt[] to remove ongoing litigation from the forum chosen by the plaintiff." *Id.* As the Supreme Court has held, "'[t]he [party] who is charged with infringing a patent cannot stretch the Federal Declaratory Judgments Act to give (it) a paramount right to choose the forum for trying out questions of infringement and validity. He is given an equal start in

the race to the courthouse, not a headstart.'" *Id.* (quoting *Kerotest Manf. Co. v. C-O-Two Fire Equipment Co.*, 342 U.S. 180, 185 (1952)).

The unreasonableness of the district court's endorsement of the Respondents' tactics is further underscored by *Marvell Semiconductor v. Monterey Research*—another recent NDCAL first-to-file rule decision. Monterey sued Marvell for patent infringement in Delaware. Subsequently, Marvell brought a duplicative action for declaratory relief against Monterey in the NDCAL. Citing the district court's authority in *Ruckus Wireless*, the *Marvell* court dismissed the second-filed-declaratory-judgment action and reasoned that it was more appropriate for Marvell to seek transfer of the Delaware action rather than drag the second-filed court into the fray:

> But the law should not leave room for this practice [filing a duplicative declaratory judgment action and requesting a stay], particularly in patent cases, which are expensive and time-consuming enough as it is. Even if a defendant in a patent case feels strongly that venue is lacking in the first lawsuit, there is simply no need to file a duplicative lawsuit for declaratory relief in a different court. There is no need to drag a second judge into addressing the initial question of whether venue is proper in the first lawsuit, and no need to keep a second lawsuit on file while waiting for the first judge to rule on that question. If venue is improper in the initial case, or if the initial case should be transferred for convenience, the defendant can simply file a motion to that effect and await the outcome.

Marvell Semiconductor, 2020 U.S. Dist. LEXIS 210873, at *3. The *Marvell* court's reasoning is especially pertinent to the instant cases because the Respondents have all filed motions to transfer VoIP-Pal's WDTX case against them to the NDCAL.

Appx616-617; Appx2257-2259. At the very least, the district court should have stayed the Respondents' second-filed actions until the WDTX decides their transfer motions. *See, e.g.*, *Google LLC v. Sonos, Inc.*, No. C 20-06754-WHA, 2020 U.S. Dist. LEXIS 218149, at *6 (N.D. Cal. Nov. 20, 2020) ("Google's choice of forum is entitled to no weight [as the declaratory judgement plaintiff]. Rather, the proper course is to stay this case and defer to Judge Albright's ruling on Google's just-filed motion to transfer under Section 1404 . . .").

Moreover, it is not the district court's job to police forum shopping under the first-to-file rule; it is the first-filed court's job. Indeed, VoIP-Pal's WDTX cases are still pending and the WDTX still needs to decide the Respondents' transfer motions. As the district court's own precedent counsels, the district court should have let the WDTX decide the convenience transfer issues. *See Ruckus Wireless*, 2012 U.S. Dist. LEXIS 22336, at *11 ("[T]he parties *correctly* agree that the forum convenience factors are more properly addressed by the [first-filed court].") (emphasis added); *see also Pacesetter*, 678 F.2d at 96 ("[N]ormally the forum *non conveniens* argument should be addressed to the court in the first-filed action."). By refusing to apply the first-to-file rule and not letting the WDTX decide Respondents' transfer motions, the district court frustrated federal comity, ignored its own precedent, and needlessly created multiple suits and confusion. Thus, the district court clearly abused its discretion.

3. The district court abused its discretion because it applied an exception to the first-to-file rule without a factual basis in the record.

The district court further abused its discretion by concluding that it would be more efficient for it to hear its cases as compared to the WDTX "because of the relative ease to sources of proof" and because "it would be more convenient for witnesses from Plaintiff Apple." Appx12. The record, however, contains absolutely no evidence upon which the district court could have based either of these conclusions. The reason that there was no such evidence is simple—the Respondents never presented any evidence. The Respondents never argued that sources of proof and witness convenience favored the NDCAL, much less any of the § 1404(a) convenience factors. Appx813. Instead, the district court made these arguments *for* the Respondents and erroneously filled the void in the record with inapplicable case law, not facts.

Specifically, the district court concluded that a "significant amount of evidence relevant to potentially infringing conduct is located in [the NDCAL]" because Apple is located in the NDCAL. Appx12. The only support that the district court provided for this conclusion was *In re Genentech*, which stated the general proposition that most of the relevant evidence in patent cases usually comes from the accused infringer. Appx12. But the record contained no evidence and Apple made no showing that evidence relevant to Apple's non-infringement claim is

located in the NDCAL. In other cases where Apple has failed to make such a showing, this Court has rejected using *In re Genentech's* general proposition to establish that evidence relevant to Apple's conduct is located in the NDCAL. *In re Apple Inc.*, 743 F.3d 1377, 1379, n.3 (Fed. Cir. 2014). Moreover, the district court conducted no analysis of where evidence relevant to AT&T's and Verizon's claims is located, and there was nothing in the record showing that it is located in the NDCAL.

Similarly, the district court considered only Apple in its paper-thin witness convenience analysis stating that "hearing the cases in [the NDCAL] would be more convenient for witnesses from *Plaintiff Apple*." Appx12 (emphasis added). Ironically, the district court tried to justify its reasoning with another one of this Court's venue decisions involving Apple, *In re Apple* (2020). *Id.* Even more ironically, the district court relied on *In re Apple* (2020) to help Apple despite the fact that one member of the *In re Apple* (2020) panel—Judge Moore—criticized Apple for waging ad hominem attacks on Judge Albright. *See In re Apple*, 979 F.3d at 1348 (Moore, J., dissenting). But undeterred, the district court again erroneously relied on only case law to reach its conclusion and not the actual record of these cases.

The Supreme Court has long held that § 1404(a) requires "individualized, case-by-case consideration of convenience and fairness." *In re Genentech, Inc.*, 566

F.3d 1338, 1346 (Fed. Cir. 2009) (quoting *Van Dusen v. Barrack*, 376 U.S. 612, 622 (1964)). Although *In re Apple* (2020) involved the transfer of a patent infringement case against Apple from the WDTX to the NDCAL, the particular facts of that case in no way justified the district court's conclusion that it would be more efficient to hear Apple's declaratory-judgment action in the NDCAL. And those facts are irrelevant to AT&T's and Verizon's actions. Moreover, it was stunning that the district court would base the exercise of its own discretion on *In re Apple* (2020)'s finding that Judge Albright abused his discretion instead of the facts of the instant cases.

Not only was the district court's convenience analysis based on no evidence, but it was woefully incomplete. Following well-settled Ninth Circuit precedent in other cases, the district court has considered as many as ten convenience factors. *See Esquer v. Stockx, LLC*, Case No. 19-CV-05933-LHK, 2020 U.S. Dist. LEXIS 112493, at *6 (N.D. Cal. June 26, 2020) (citing *Jones v. GNC Franchising, Inc.*, 211 F.3d 495, 498-99 (9th Cir. 2000)). While it is not surprising that the district court did not conduct a complete convenience analysis because the Respondents did not argue any of the convenience factors, the district court erred by cherry-picking only two convenience factors that it thought favored Apple. Indeed, in the first-to-file context, the district court was required to weigh the convenience factors just as it would "*for any other transfer motion*." *Micron Tech., Inc. v. MOSAID Techs., Inc.*,

518 F.3d 897, 905 (Fed. Cir. 2008) (emphasis added). Moreover, the district court failed to conduct any analysis and cited no facts regarding any convenience factors for AT&T and Verizon. Thus, the district court's claim that its first-to-file analysis "applies equally to each of the instant three cases" was clearly erroneous. Appx9.

4. The district court abused its discretion because it erroneously shifted Respondents' burden to establish an exception to the first-to-file rule to VoIP-Pal.

Compounding the errors of its threadbare convenience analysis, the district court carelessly and erroneously shifted the Respondents' burden to prove an exception to the first-to-file rule to VoIP-Pal. VoIP-Pal had the burden to show that the first-to-file rule applied, not that exception to it did not apply. This Court firmly set forth the law in this regard in *Futurewei v. Acacia Research*. In affirming the dismissal of a second-filed-declaratory-judgment action, this Court applied the first-to-file rule and held that the *declaratory-judgment plaintiff* (non-movant) failed to show "any substantial countervailing considerations" to support an exception to the first-to-file rule. *See Futurewei*, 737 F.3d at 709. In this case, the district court clearly shifted the burden to prove an exception to VoIP-Pal—the declaratory-judgment defendant (movant)—not just once, but three times.

First, the district court stated "Defendant never provides any reason why these cases should be heard by Judge Albright in Waco, Texas." Appx13. Not only does the first-to-file rule not require such a showing, but VoIP-Pal never argued that these

declaratory-judgment actions should be transferred to the WDTX—it argued that these actions should be dismissed, just like the movant in *Futurewei*. Second, the district court claimed that "Defendant is neither incorporated in nor headquartered in Texas, much less in Waco." *Id.* This claim, however, has nothing to do with the first-to-file analysis. Moreover, VoIP-Pal is registered as a foreign corporation in Texas and maintains an office in Waco. *See* https://www.voip-pal.com/contact-us (last visited Jan. 12, 2021). Third, and most egregiously, the district court improperly faulted VoIP-Pal for "never alleg[ing] that witnesses or evidence relevant to this case are located in Waco or Texas, or that the events that gave rise to this case occurred in Waco or Texas." Appx13. VoIP-Pal never made any such allegations simply because it did not need to, not because it could not. All VoIP-Pal needed to prove was that the first-to-file rule required the district court to dismiss the instant cases. VoIP-Pal did not need to disprove the exception to the first-to-file rule that the district court applied. *See Futurewei*, 737 F.3d at 709. By relieving Respondents' burden to show that an exception applied and imposing a non-existent countervailing burden on VoIP-Pal, the district court committed an error of law that by definition is an abuse of discretion.

5. The district court abused its discretion by giving dispositive weight to its alleged familiarity with the parties' dispute.

Finally, the district court abused its discretion when it found that its familiarity with the previously adjudicated and closed 2016 and 2018 cases concerning related

patents justified overriding the first-to-file rule. The district court's alleged familiarity, however, did not rise to the level of a substantial countervailing consideration to support an exception in this case. Neither the Respondents nor the district court offered any authority to support a familiarity exception to the first-to-file rule, much less familiarity with closed cases. Even if this novel consideration is an appropriate consideration under the first-to-file rule, the district court's limited experience with the 2016 and 2018 cases hardly constituted a substantial countervailing consideration to dispense with the deference owed to the first-filed court and to deprive VoIP-Pal of its choice of forum. *See Futurewei*, 737 F.3d at 709.

As discussed above, the district court presided over the 2016 cases for less than eight months, considered one Rule 12 motion regarding different patents, and dismissed the 2016 cases on the pleadings over a year before VoIP-Pal filed its first WDTX case. Among other things, the district court did not conduct a *Markman* hearing, issue a claim construction order, consider motions for summary judgment, consider *Daubert* motions, or conduct a trial. Contrary to what it claimed, the district court had no familiarity with Respondents' "allegedly infringing technologies." Appx1, n.2. Indeed, the district court never considered the Respondents' accused products nor their respective infringement. Thus, the district court had no basis to

conclude "that the same issues addressed by this Court would be needlessly reconsidered by the Texas court." *Id.*

Similarly, the district court presided over the 2018 cases for less than a year, considered one Rule 12 motion regarding different patents and dismissed the 2018 cases on the pleadings over five months before VoIP-Pal filed its first WDTX case. Like the 2016 cases, the district court did not conduct a *Markman* hearing, issue a claim construction order, consider motions for summary judgment, consider *Daubert* motions, or conduct a trial. Although the parties briefed claim construction, the district court never referenced the briefs in ruling on the motion to dismiss. The district court never considered the Respondents' accused products and services nor their respective infringement. Indeed, AT&T and Verizon were not even parties to the 2018 cases.

In short, the district court cannot plausibly claim any special familiarity with the '606 patent as compared to the WDTX. If general familiarity with some of VoIP-Pal's patents is enough for the district court to disregard the first-to-file rule, then VoIP-Pal can never assert a patent outside the NDCAL without the risk of an accused infringer subsequently filing a declaratory-judgment action that hauls VoIP-Pal back to the NDCAL. This absurd result does not exhibit a sound exercise of discretion and should not stand.

B. The Mandamus Relief VoIP-Pal Seeks Is Appropriate Under The Circumstances.

Although a writ of mandamus is an extraordinary form of relief, this Court has made clear that the improper application of the first-to-file rule based on an abuse of discretion is a proper subject for mandamus relief. *See In re Nitro Fluids L.L.C.*, 2020 U.S. App. LEXIS 33984; *In re Google Inc.*, 588 F. App'x 988. It is also clear that a district court abuses its discretion when (1) the district court's decision was clearly unreasonable, arbitrary, or fanciful; (2) the district court's decision was based on an erroneous conclusion of law; (3) the district court's findings were clearly erroneous; or (4) the record contains no evidence upon which the district court rationally could have based its decision. *See 3M*, 929 F.2d at 673. Any one of the district court's multiple errors set forth above warrants mandamus relief.

C. VoIP-Pal Has No Other Adequate Means To Proceed In The WDTX, The First-Filed Court.

Lastly, VoIP-Pal's request for a writ of mandamus seeks relief that VoIP-Pal has "no other adequate means" to obtain. *Cheney*, 542 U.S. at 380-81. A petitioner lacks "adequate" alternative means to obtain relief where the rights it seeks to protect "cannot be vindicated by direct appeal." *In re Princo Corp.*, 478 F.3d 1345, 1357 (Fed. Cir. 2007).

Absent mandamus relief, Judge Albright will most likely transfer all six of VoIP-Pal's WDTX cases to the NDCAL and VoIP-Pal will again be forced to litigate

its patents in a forum that it did not choose. At that point, the only relief available to VoIP-Pal will be a direct appeal following final judgment in the declaratory-judgment actions and the transferred WDTX cases. A direct appeal of a final judgment is an inadequate remedy for a failure to apply the first-to-file rule because VoIP-Pal cannot demonstrate it would have won the case had it been tried in the appropriate venue. *See Pacific Car & Foundry Co. v. Pence*, 403 F.2d 949, 952 (9th Cir. 1968). Thus, a writ of mandamus is the only means VoIP-Pal has to obtain the relief it seeks.

VII. CONCLUSION

In conclusion, the district court committed at least five critical errors in its first-to-file rule analysis. Accordingly, VoIP-Pal respectfully requests that the Court grant this petition, hold that the district court abused its discretion in failing to apply the first-to-file rule, vacate the district court's decision, and order the district court to dismiss the Respondents' second-filed-declaratory-judgment actions.

Dated: January 12, 2021

Respectfully submitted,

By: /s/ Lewis E. Hudnell, III

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

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CERTIFICATE OF SERVICE

I hereby certify that on January 12, 2021, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Fedreal Circuit by using the appellate CM/ECF system.

I further certify that the Petition has been served on the following case participants by email:

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