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12
 13 **UNITED STATES DISTRICT COURT**
 14 **NORTHERN DISTRICT OF CALIFORNIA**

15
 16 RESONAC HARD DISK
 CORPORATION and RESONAC
 17 AMERICA, INC.,

18 Declaratory Judgment
 19 Plaintiff,

20 v.

21 MR TECHNOLOGIES GMBH,

22 Declaratory Judgment
 23 Defendant.

Case No. 5:25-cv-8631-PHK

**MR TECHNOLOGIES’ NOTICE
 OF MOTION AND MOTION TO
 DISMISS OR TRANSFER, AND
 MEMORANDUM OF POINTS
 AND AUTHORITIES IN
 SUPPORT THEREOF**

Date: February 12, 2026

Time: 1:30

Courtroom: F – 15th Floor

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TO THE COURT AND TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on February 12, 2026, at 1:30 p.m., in Courtroom F - 15th Floor of the above Court, before the honorable Peter H. Kang, or at such later date and time as may be set by the Court, Plaintiff MR Technologies, GMBH (“MR Tech” or “Plaintiff”), will and hereby does move for a for Order dismissing the complaint in this action pursuant Federal Rule of Civil Procedure 12(b)(6), or in the alternative, transferring venue to the Central District of California pursuant to 28 § U.S.C. 1404(a).

The motion is based on the attached memorandum of points and authorities, the declaration of Paul A. Kroeger and exhibits attached thereto, and any subsequently filed supplemental briefing and accompanying papers, the pleadings and papers filed in this action, and any other arguments, evidence and matters submitted to this Court at the hearing or otherwise.

RUSS AUGUST & KABAT

Dated: December 29, 2025

By: /s/ Marc Fenster

Marc Fenster
Brian Ledahl
Dale Chang
Paul Kroeger

Attorneys for Plaintiff
MR TECHNOLOGIES, GMBH

RUSS, AUGUST & KABAT

TABLE OF CONTENTS

1

2

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

I. INTRODUCTION 1

II. FACTUAL BACKGROUND..... 3

 A. The Parties 3

 B. The CDCA’s Extensive History with the Asserted Patents and
 Accused Technologies..... 4

 C. The CDCA Case Against Toshiba..... 5

 D. This NDCA Declaratory Judgment Action 6

III. LEGAL STANDARD..... 6

IV. THE COURT SHOULD DECLINE JURISDICTION IN FAVOR OF
THE EARLIER-FILED CDCA CASE..... 7

 A. This Case Should Be Dismissed Under the First-to-File Rule..... 7

 B. The Customer-Suit Exception Does Not Apply 10

 1. The Exception Is a Narrow, Discretionary Doctrine
 Aimed at Efficiency Which Overwhelmingly Favors the
 First-Filed CDCA Case 10

 2. Resonac’s Indemnification Obligation Makes
 Participation in the CDCA Case the Proper Remedy..... 13

V. IN THE ALTERNATIVE, THE COURT SHOULD TRANSFER
THIS CASE TO THE CDCA 15

VI. CONCLUSION..... 19

TABLE OF AUTHORITIES

RUSS, AUGUST & KABAT

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Cases

Aliphcom v. Wi-LAN Inc.,
10-CV-02337-LHK, 2010 WL 4699844 (N.D. Cal. Nov. 10, 2010)..... 18

Am. Acad. of Sci. v. Novell Inc.,
No. 91-4300, 1992 WL 313101 (N.D. Cal. July 9, 1992) 12

Barnes & Noble, Inc. v. LSI Corp.,
823 F. Supp. 2d 980 (N.D. Cal. 2011) 8

Bristol-Myers Squibb Co.,
No. C 13-2045 SI, 2013 WL 3829599 (N.D. Cal. July 23, 2013) 18

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No. C 03-02197 2003 WL 21982473 (N.D. Cal. Aug. 8, 2003) 19

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No. C 12-02766 RS, 2012 WL 3279532 (N.D. Cal. Aug. 10, 2012)..... 16, 18

Eli Lilly & Co. v. Genentech, Inc.,
No. 13-CV-0919 YGR, 2013 WL 4396718 (N.D. Cal. Aug. 13, 2013)... 7, 16

Finisar Corp. v. Capella Photonics, Inc.,
No. 20-CV-07629-EMC, 2021 WL 810227 (N.D. Cal. Mar. 3, 2021) 14

Ford Motor Co. v. United States,
811 F.3d 1371 (Fed. Cir. 2016) 14

Futurewei Techs., Inc. v. Acacia Research Corp.
737 F.3d 704 (Fed. Cir. 2013) 8

Gov’t Emps. Ins. Co. v. Dizol,
133 F.3d 1220 (9th Cir. 1998) 6

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NO. 971, 2011 WL 4630923 (Fed. Cir. Feb. 9, 2011)..... 18

In re Vistaprint Ltd.,
628 F.3d 1342 (Fed. Cir. 2010) 7, 9, 18

In re Volkswagen of Am., Inc.,
566 F.3d 1349 (Fed. Cir. 2009) 16

Kahn v. Gen. Motors Corp.,
889 F.2d 1078 (Fed. Cir. 1989) 10

RUSS, AUGUST & KABAT

1 *Katz v. Siegler*,
 909 F.2d 1459 (Fed. Cir. 1990) 10, 12

2 *Kohn Law Grp., Inc. v. Auto Parts Mfg. Miss., Inc.*,
 3 787 F.3d 1237 (9th Cir. 2015) 8, 9

4 *Limelight Networks, Inc. v. Akamai Techs., Inc.*,
 5 572 U.S. 915 (2014)..... 11

6 *Microchip Tech., Inc. v. United Module Corp.*,
 7 CV-10-04241-LHK, 2011 WL 2669627 (N.D. Cal. July 7, 2011)..... 10

8 *Microsoft Corp. v. Commonwealth Sci. & Indus. Rsch. Organisation*,
 9 No. 6:06 CV 549, 2007 WL 4376104 (E.D. Tex. Dec. 13, 2007) 12

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 11 755 F.3d 899 (Fed. Cir. 2014) 13

12 *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*,
 13 139 F.4th 1340 (Fed. Cir. 2025) 14

14 *MR Technologies GMBH v. Toshiba America Electronic Components, Inc.*,
 15 No. 25-cv-00786-JVS-DFM (C.D. Cal. Apr. 15, 2025) 5

16 *MR Techs. GmbH v. Western Digital Techs., Inc.*,
 17 No. 8:22-cv-01599-JVS-DFM (C.D. Cal. Aug. 26, 2022) 4, 5

18 *PETA, Inc. v. Beyond the Frame, Ltd.*,
 19 CV 10-07576 MMM (SSx) (C.D. Cal. Feb. 16, 2011)..... 9

20 *Proofpoint, Inc. v. InNova Patent Licensing, LLC*,
 21 No. 5:11-CV-02288-LHK, 2011 U.S. Dist. LEXIS 120343 (N.D. Cal. Oct.
 22 17, 2011) *passim*

23 *R.R. St. & Co. Inc. v. Transp. Ins. Co.*,
 24 656 F.3d 966 (9th Cir. 2011) 6

25 *Regents of Univ. of Cal. v. Eli Lilly & Co.*,
 26 119 F.3d 1559 (Fed. Cir. 1997) 7, 16

27 *Ruckus Wireless, Inc. v. Harris Corp.*,
 28 11-cv-019440-LHK, 2012 WL 588782 (N.D. Cal. Feb. 22, 2012) 8

Samsung Elecs. Co. v. Tech. Consumer Prods., Inc.,
 No. 1:23-CV-186, 2024 WL 1961320 (D. Del. May 2, 2024) 11

Stormedia Texas, LLC. v. Compusa, Inc., et al
 No. 2:07-cv-00025 (E.D. Tex.), 2008 WL 2885814 (E.D. Tex. July 23, 2008)
 15

RUSS, AUGUST & KABAT

1 *Sybase, Inc. v. Vertica Sys., Inc.*,
No. C-09-05647 MHP, 2010 WL 1689956 (N.D. Cal. Apr. 23, 2010) .. 17, 18

2 *Tegic Commc'ns Corp. v. Bd. of Regents of Univ. of Tex. Sys.*,
3 458 F.3d 1335 (Fed. Cir. 2006) 10

4 *Teleconference Sys. v. Proctor & Gamble Pharms., Inc.*,
5 676 F. Supp. 2d 321 (D. Del. 2009)..... 14

6 *Teledyne Techs. Inc. v. Harris Corp.*,
No. CV 11-00139 DDP (AJWx), 2011 WL 2605995 (C.D. Cal. July 1, 2011)
7 7

8 *Wilton v. Seven Falls Co.*,
9 515 U.S. 277 (1995)..... 6

10 *Wireless Consumers All., Inc. v. T-Mobile USA, Inc.*,
No. C 03- 3711 MHP, 2003 WL 22387598 (N.D. Cal. Oct. 14, 2003)..... 17

11 **Statutes**

12 28 U.S.C. § 1404(a) 15

13 28 U.S.C. § 2201(a) 6

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RUSS, AUGUST & KABAT

1 **I. INTRODUCTION**

2 Six months before Resonac filed this action, MR Technologies (“MRT”) sued
3 Toshiba in the Central District of California (“CDCA”), alleging infringement of the
4 same patents by the same accused hard disk drives (HDDs) at issue here. Toshiba
5 makes and sells the accused HDDs. Resonac allegedly supplies the media used in
6 those drives. Under the first-to-file rule, this later-filed declaratory action should be
7 dismissed in favor of the earlier-filed case against Toshiba.

8 The CDCA is not just the first-filed forum; it is the most knowledgeable.
9 Judge Selna, who is presiding over the Toshiba case, has already managed a complex
10 case involving two of the three patents at issue here. Through that litigation, Judge
11 Selna has developed a detailed understanding of the technology, construed the
12 claims, adjudicated numerous infringement and validity disputes, presided over an
13 eight-day jury trial, and entered judgment on a substantial verdict for MRT.

14 Resonac nonetheless asks this Court to exercise declaratory-judgment
15 jurisdiction and declare that the accused HDDs do not infringe, under the apparent
16 theory that the customer-suit exception to the first-to-file rule should give its claims
17 priority. But the customer-suit exception is a narrow, discretionary tool aimed at
18 efficiency, not a vehicle to undermine the jurisdiction of the court that has already
19 invested substantial judicial resources in the patents and the technology. If Resonac
20 truly believes it is the proper party to litigate these issues, the proper course is to
21 intervene in the Toshiba case before the judge who has already climbed the steep
22 learning curve required to adjudicate these issues.

23 Even setting aside the CDCA court’s familiarity with the patents and
24 technology, the customer-suit exception still does not justify Resonac’s bid for
25 declaratory relief here. The alleged direct infringer is Toshiba, not Resonac.
26 Toshiba is the entity that imports, offers for sale, and sells the accused HDDs in the
27 United States. Indeed, the claims of two of the patents-in-suit require a “magnetic
28 recording system, comprising: a writing head.” Resonac’s standalone media has no

RUSS, AUGUST & KABAT

1 writing head and therefore cannot be the claimed “magnetic recording system.”
2 Only the accused HDDs have the claimed writing head, and it is Toshiba that makes
3 and sells those HDDs. This means, as to the infringement allegations that give rise
4 to any justiciable controversy here, Resonac is at most an indirect infringer whose
5 liability cannot be resolved without litigating whether Toshiba’s accused HDDs
6 directly infringe. Toshiba’s participation would thus be unavoidable and the case
7 would expand into a full merits fight involving the same issues already being
8 litigated in the first-filed action.

9 It would further complicate the dispute by introducing intent and knowledge
10 questions unique to indirect infringement, including what Resonac knew and when,
11 and what it intentionally encouraged or supplied for use in HDDs it knew Toshiba
12 would import into the U.S. Proceeding here would therefore create disputes
13 unnecessary to resolving the first-filed case against the direct infringer, while
14 multiplying proceedings and risking inconsistent rulings. Indeed, MRT’s
15 enforcement efforts have been directed at HDD manufacturers, with no indication
16 that MRT has ever intended to sue Resonac or any other media supplier. And so,
17 absent this declaratory action, there would be no reason for any court to adjudicate
18 these indirect infringement issues at all.

19 Worse, the Court or a jury could find that Resonac lacked the requisite intent
20 or knowledge as to some accused products and resolve the indirect infringement
21 issues on that basis without determining whether those products infringe.
22 For example, Resonac may contend that it lacked knowledge of the patents until well
23 after April 2019, the start of the damages period for Toshiba’s alleged infringement.
24 The Court could then dispose of the indirect infringement claims as to accused
25 HDDs sold before Resonac became aware of the patents, without determining
26 whether those products infringe. The parties would then be back to where they
27 started as to those products in the Toshiba case, after needless discovery and motion
28 practice here.

1 At minimum, the Court should transfer this action to the CDCA where the
2 first-filed case against Toshiba is underway before Judge Selna. Toshiba is located
3 in that forum, and Resonac has agreed to indemnify Toshiba and can participate
4 there. And because both courts sit in California, any incremental difference in
5 witness convenience or access to evidence is marginal at best. In these
6 circumstances, the public-interest factors carry decisive weight: judicial economy,
7 the pendency of the first-filed action, and the need to avoid duplicative proceedings
8 and inconsistent rulings all point to the CDCA as the court best positioned to
9 adjudicate MRT’s claims efficiently and consistently.

10 II. FACTUAL BACKGROUND

11 A. The Parties

12 MR Technologies (“MRT”) is a privately held company based in Austria.
13 MRT owns U.S. Patent Nos. 9,928,864 (“’864 Patent,” Ex. 1), 11,138,997
14 (“’997 Patent,” Ex. 2), and 12,020,734 (“’734 Patent,” Ex. 3) (collectively, “Patents-
15 in-Suit”). In general, the patents relate to “multilayer exchange spring recording
16 media ... used in magnetic hard disk drives.” *See* Ex. 4 (CDCA CC Order) at 1-2.
17 The media includes a multilayered “nucleation host” in which “a property called
18 ‘anisotropy’ increases as the layers get closer to the [underlying] hard magnetic
19 storage layer.” *See* Ex. 5 (CDCA SJ Order) at 3. “Anisotropy refers to the excess
20 energy required to magnetize the grains in a layer from the easy direction to the hard
21 direction.” *Id.* “[T]he layers of the nucleation host act magnetically as steps, to assist
22 in decreasing the amount of energy required to write to the hard magnetic storage
23 layer.” *Id.* The claims of the ’997 and ’734 patents require a “magnetic recording
24 system, comprising: a writing head.” *See* Ex. 2 (’997 patent) at claims 1, 7; Ex. 3
25 (’734 patent) at claim 1. The “writing head” is a separate component from the
26 “magnetic recording media.” *See id.*

27 Resonac Hard Disk Corporation (“RHDC”) is a Japanese corporation that
28 makes and sells magnetic recording media. Compl. ¶¶ 2, 18.

RUSS, AUGUST & KABAT

1 Resonac America, Inc. (“REA”) is a California corporation that purports to
2 provide services “related to RHDC’s business of selling magnetic recording media
3 to customers.” Compl. ¶¶ 3, 18.

4 MRT has never communicated with RHDC or REA much less accused them
5 of infringement, and Resonac does not allege otherwise. *See generally* Compl.

6 **B. The CDCA’s Extensive History with the Asserted Patents
7 and Accused Technologies**

8 In August 2022, MR Tech asserted the ’864 and ’997 patents against Western
9 Digital Technologies, Inc. (“WD”) in *MR Techs. GmbH v. Western Digital Techs.,*
10 *Inc.*, No. 8:22-cv-01599-JVS-DFM (C.D. Cal. Aug. 26, 2022). The case was
11 assigned to Judge Selna who presided over the case from start to finish.

12 The accused products were WD hard disk drives (HDDs) sold in the U.S.
13 since March 27, 2018, the issue date of the ’864 Patent. Some of the accused WD
14 HDDs used magnetic recording media supplied by RHDC (formerly known as
15 Showa Denko).¹ *See* Ex. 6 (July 23, 2024 Trial Tr. Vol. II) at 72:11-24 (WD director
16 testifying that “Showa Denko media [are] used in the accused products”).

17 In December 2023, after holding a technology tutorial and a claim
18 construction hearing, the court issued a claim construction order construing the
19 claims of the ’864 and ’997 patents. *See* Ex. 4 (CC Order); Ex. 7 (Tech Tutorial
20 Hearing Tr.); Ex. 8 (Markman Hearing Tr.). One of the key terms the court construed
21 was “nucleation host ... comprises ferromagnetic layers with increasing anisotropy
22 constant K from layer to layer.” Ex. 4 (CC Order) at 9-11.

23 Between February and July 2024, the court held hearings and issued orders on
24 numerous motions by the parties, including summary judgment motions regarding
25 infringement and validity and *Daubert* motions challenging each side’s infringement
26 and validity experts. *See, e.g.*, Exs. 9 - 10 (SJ Orders); Ex. 11 (Daubert Order).

27 ¹ Showa Denko changed its name to Resonac HD Yamagata Corporation in January
28 2023 and then to Resonac Hard Disk Corporation (RHDC) in July 2024.
<https://www.resonac.com/corporate/network/group/rhdc.html>.

1 On July 26, 2024, after the court presided over an eight-day trial, the jury
2 returned its verdict, finding both patents valid and infringed by the accused HDDs
3 (including, as discussed above, HDDs containing RHDC media), and awarding
4 \$262,388,800 in damages to MRT. *See* Ex. 12 (Judgment).

5 In August 2024, MRT asserted the '734 patent against WD in *MR Techs.*
6 *GmbH v. Western Digital Techs., Inc.*, No. 24-cv-01848-JVS-DFM (C.D. Cal.
7 Aug. 22, 2024). The '734 patent is a direct continuation of and shares the same
8 specification as the '997 patent. Nearly all the claim limitations of the '734 patent
9 are identical to those of the '997 patent.

10 In May 2025, after having been resolved between the parties, the court
11 dismissed both cases pursuant to the parties' joint stipulation of dismissal.

12 **C. The CDCA Case Against Toshiba**

13 In April 2025, MRT asserted the '864, '997, and '734 patents against Toshiba
14 America Electronic Components, Inc. ("TAEC") and Toshiba Electronic Devices
15 and Storage Corporation ("TDSC") (collectively, "Toshiba") in *MR Technologies*
16 *GMBH v. Toshiba America Electronic Components, Inc.*, No. 25-cv-00786-JVS-
17 DFM (C.D. Cal. Apr. 15, 2025). TAEC is a California corporation headquartered in
18 Irvine, California. TDSC is a Japanese corporation. The case has been assigned to
19 Judge Selna, ensuring efficiency and consistency in the adjudication of the patents
20 and recurring claim construction, infringement, and validity issues.

21 In October 2025, after filing its answer to MRT's complaint, Toshiba filed an
22 opposed motion to stay pending resolution of the present declaratory judgment
23 action.² In the motion, Toshiba represents that "Toshiba has a contractual right to
24 indemnification from Resonac in this circumstance, and Resonac has agreed to
25 indemnify Toshiba in accordance with the terms of the parties' agreement."
26 Ex. 13 at 6.

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² The hearing date for the motion is currently set for March 2, 2026.

1 **D. This NDCA Declaratory Judgment Action**

2 In October 2025, six months after MRT filed the Toshiba case, Resonac filed
3 this action for declaratory relief. Resonac did so despite having agreed to indemnify
4 Toshiba in the CDCA case and despite Judge Selna’s deep familiarity with the
5 patents and the underlying technology, including Resonac media used in the
6 WD HDDs that were found to infringe. *See* Section II.B above.

7 Resonac seeks a declaration of non-infringement, alleging that its media does
8 not meet the limitation “nucleation host ... comprises ferromagnetic layers with
9 increasing anisotropy constant K from layer to layer.” Compl. ¶¶ 32, 37.
10 The construction of this term was a core dispute in the CDCA case against WD. *See*
11 Section II.B above. Resonac does not seek a declaration of invalidity.

12 **III. LEGAL STANDARD**

13 The Declaratory Judgment Act confers on district courts “unique and
14 substantial discretion in deciding whether to declare the rights of litigants.”
15 *Wilton v. Seven Falls Co.*, 515 U.S. 277, 286–88 (1995); 28 U.S.C. § 2201(a)
16 (a court “*may* declare the rights and other legal relations of any interested party
17 seeking such declaration.”) (emphasis added). “In the declaratory judgment context,
18 the normal principle that federal courts should adjudicate claims within their
19 jurisdiction yields to considerations of practicality and wise judicial administration.”
20 *Id.* at 288; *see also R.R. St. & Co. Inc. v. Transp. Ins. Co.*, 656 F.3d 966, 975
21 (9th Cir. 2011) (“[W]e have allowed district courts broad discretion as long as it
22 furthers the Declaratory Judgment Act’s purpose of enhancing ‘judicial economy
23 and cooperative federalism’”) (citing *Gov’t Emps. Ins. Co. v. Dizol*, 133 F.3d 1220,
24 1224 (9th Cir. 1998) (en banc)). “The district court ... should discourage litigants
25 from filing declaratory actions as a means of forum shopping; and it should avoid
26 duplicative litigation.” *Dizol*, 133 F.3d at 1225.

27 Considerations of practicality and wise judicial administration carry particular
28 weight in patent cases where courts invest heavily to learn the patents and relevant

1 technology. *See Teledyne Techs. Inc. v. Harris Corp.*, No. CV 11-00139 DDP
 2 (AJWx), 2011 WL 2605995 (C.D. Cal. July 1, 2011) (dismissing DJ action in favor
 3 of a parallel infringement action because the other court had “already issued claim
 4 construction rulings on three of the four patents at issue” and was “quite familiar
 5 with the patents at issue,” making it inefficient and wasteful to proceed with the DJ
 6 action); *see also In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010)
 7 (“Here, the trial court became very familiar with the only asserted patent and the
 8 related technology during a prior litigation. That, coupled with the fact there is co-
 9 pending litigation before the trial court involving the same patent and underlying
 10 technology, provides a substantial justification for maintaining suit in the Eastern
 11 District of Texas.”); *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1565
 12 (Fed. Cir. 1997) (“[I]n a case such as this in which several highly technical factual
 13 issues are presented and the other relevant factors are in equipoise, the interest of
 14 judicial economy may favor transfer to a court that has become familiar with the
 15 issues.”); *Eli Lilly & Co. v. Genentech, Inc.*, No. 13-CV-0919 YGR, 2013 WL
 16 4396718, at *6 (N.D. Cal. Aug. 13, 2013) (“[I]n highly technical cases . . . judicial
 17 economy favors transfer to a court that has a working familiarity with the
 18 background technology or science”).

19 **IV. THE COURT SHOULD DECLINE JURISDICTION IN FAVOR**
 20 **OF THE EARLIER-FILED CDCA CASE**

21 **A. This Case Should Be Dismissed Under the First-to-File Rule**

22 The Court should decline jurisdiction in favor of the first-filed CDCA case
 23 against Toshiba given the substantially similar parties and issues and the CDCA
 24 court’s deep familiarity with the patents and technologies at issue. *See* Section II.B
 25 above. “When two actions that sufficiently overlap are filed in different federal
 26 district courts, one for infringement and the other for declaratory relief, the
 27 declaratory judgment action, if filed later, generally is to be stayed, dismissed, or
 28 transferred to the forum of the infringement action.” *Futurewei Techs., Inc. v. Acacia*

1 *Research Corp.* 737 F.3d 704, 708 (Fed. Cir. 2013); *see also Barnes & Noble, Inc.*
 2 *v. LSI Corp.*, 823 F. Supp. 2d 980, 986–87 (N.D. Cal. 2011) (“The first-filed action
 3 is preferred . . . unless considerations of judicial and litigant economy, and the just
 4 and effective disposition of disputes, require otherwise.”) (quotations omitted).
 5 “[T]he policy of the first-to-file rule[] is to maximize judicial economy, consistency,
 6 and comity.” *Kohn Law Grp., Inc. v. Auto Parts Mfg. Miss., Inc.*, 787 F.3d 1237,
 7 1240 (9th Cir. 2015); *see also Ruckus Wireless, Inc. v. Harris Corp.*, 11–cv–019440–
 8 LHK, 2012 WL 588782 at *2 (N.D. Cal. Feb. 22, 2012) (“This rule promotes judicial
 9 efficiency and prevents the risk of inconsistent decisions that would arise from
 10 multiple litigations of identical claims.”). “The application of the rule requires
 11 consideration of (1) the chronology of the two actions; (2) the similarity of the
 12 parties; and (3) the similarity of the issues.” *Proofpoint, Inc. v. In Nova Patent*
 13 *Licensing, LLC*, No. 5:11-CV-02288-LHK, 2011 U.S. Dist. LEXIS 120343, at *18
 14 (N.D. Cal. Oct. 17, 2011).

15 All three factors weigh in favor of applying the first-to-file rule. There is no
 16 dispute the Toshiba case was filed before this declaratory judgment action.
 17 The parties and issues are sufficiently similar. Resonac’s interest here is derivative
 18 of Toshiba’s in the CDCA action. *See* Compl. ¶ 7 (“These claims are being asserted
 19 by MRT in at least one ongoing lawsuit . . . which appears premised on Toshiba’s
 20 use of magnetic recording media that is supplied by Resonac.”), ¶ 28 (“Toshiba has
 21 already requested that . . . Resonac indemnify and defend Toshiba with respect to
 22 MRT’s infringement claims”); Ex. 14 (Toshiba’s Motion to Stay) at 6 (“Toshiba has
 23 a contractual right to indemnification from Resonac . . . and Resonac has agreed to
 24 indemnify Toshiba in accordance with the terms of the parties’ agreement.”).
 25 Indeed, Resonac and Toshiba effectively concede the first-to-file rule applies by
 26 asserting the customer-suit exception to that rule. *See* Compl. ¶ 27 (“Toshiba relies
 27 upon Resonac to supply most (if not all) of the magnetic recording media for these
 28

1 HDD products.”); Ex. 14 at 1 (“These circumstances fall squarely within the
2 customer suit exception”).³

3 Given the substantial overlap, the Court should dismiss this case in favor of
4 the first-filed CDCA action. *Futurewei*, 737 F.3d at 709 (“[K]eeping the issue in the
5 [first-filed] case will serve key objectives of the first-to-file rule, including
6 minimization or avoidance of duplication of effort, waste of judicial resources, and
7 risk of inconsistent rulings that would accompany parallel litigation.”) (quotations
8 omitted). Dismissal is especially warranted because the CDCA court has already
9 invested significant time and resources in learning the patents and relevant
10 technologies (including Resonac media used in WD HDDs), construing the claims
11 (including the “nucleation host” limitation that Resonac contests here), and in
12 adjudicating similar non-infringement issues. *See* Section II.B above; *In re*
13 *Vistaprint Ltd.*, 628 F.3d 1342, 1344 (Fed. Cir. 2010) (“[H]aving the same magistrate
14 judge handle this and the co-pending case involving the same patent would be more
15 efficient than requiring another magistrate or trial judge to start from scratch.”).
16 Moreover, the risk of inconsistent decisions is even more prominent here because
17 this Court would be deciding infringement issues in isolation given Resonac seeks
18 only a declaration of non-infringement. *See generally* *Compl.; Amazon.com, Inc. v.*
19 *Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“[T]he claims of
20 a patent ... must be interpreted and given the same meaning for purposes of both
21 validity and infringement analyses.”).

22 _____
23 ³ “Regarding similarity of the parties, courts have held that the first-to-file rule does
24 not require exact identity of the parties.” *Kohn Law Grp., Inc. v. Auto Parts Mfg.*
25 *Miss., Inc.*, 787 F.3d 1237, 1240 (9th Cir. 2015); *see also PETA, Inc. v. Beyond the*
26 *Frame, Ltd.*, CV 10-07576 MMM (SSx) (C.D. Cal. Feb. 16, 2011) (“Indeed, the
27 first-to-file rule does not require identical parties *or* issues, so long as the actions are
28 substantially similar or involve substantial overlap.”); *Proofpoint*, 2011 U.S. Dist.
LEXIS 120343, at *18 (“Although the first-filed rule is not *clearly* applicable here
...the focus on judicial efficiency that underlies both the first-filed rule and the
transfer analysis plainly supports the Court’s decision to decline jurisdiction.”)
(emphasis original).

RUSS, AUGUST & KABAT

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B. The Customer-Suit Exception Does Not Apply

The customer-suit exception should not be applied here. First, the exception is a discretionary efficiency tool and applying it here would be extremely inefficient given the substantial overlap with the Toshiba case and the CDCA court’s deep investment in these patents and this technology. Second, Resonac’s indemnification obligation confirms the dispute belongs in the CDCA because the proper remedy is to intervene or otherwise participate in the Toshiba case, not to litigate a parallel declaratory suit in a different forum to chase a different outcome.

1. The Exception Is a Narrow, Discretionary Doctrine Aimed at Efficiency Which Overwhelmingly Favors the First-Filed CDCA Case

Applying the customer-suit exception here would be tremendously inefficient and run counter to the very purpose of the exception. “The guiding principles in the customer suit exception cases are efficiency and judicial economy.” *Tegic Commc’ns Corp. v. Bd. of Regents of Univ. of Tex. Sys.*, 458 F.3d 1335, 1343 (Fed. Cir. 2006); *Microchip Tech., Inc. v. United Module Corp.*, CV-10-04241-LHK, 2011 WL 2669627, *5 (N.D. Cal. July 7, 2011). The exception is not an entitlement for a supplier to displace the first-filed forum; it is a case-management doctrine, applied with “an eye toward wise judicial administration,” conservation of resources, and comprehensive resolution. *See Kahn v. Gen. Motors Corp.*, 889 F.2d 1078, 1081 (Fed. Cir. 1989); *Katz v. Siegler*, 909 F.2d 1459, 1463 (Fed. Cir. 1990).

Here, the CDCA court is the far better forum to resolve the dispute and would better serve judicial economy and the efficient resolution of the dispute. “Given the substantial similarity of the issues and the considerable energy already invested by the [CDCA], it would not be in the interest of justice or judicial economy for this Court to entertain [Resonac’s] claim.” *Proofpoint, Inc. v. InNova Patent Licensing, LLC*, No. 5:11-CV-02288-LHK, 2011 U.S. Dist. LEXIS 120343, at *20 (N.D. Cal. Oct. 17, 2011); *see also* Section II.B above.

1 Even setting aside the CDCA court’s familiarity, the customer-suit exception
2 still does not warrant entertaining Resonac’s declaratory relief claims here. As in
3 *Mitek*, extensive involvement by Toshiba, the direct infringer, would be required. It
4 is Toshiba (not Resonac) that imports, offers for sale, and sells the accused HDDs in
5 the United States. Resonac is therefore, at most, an indirect infringer and any
6 indirect-infringement theory against Resonac necessarily turns on proof of direct
7 infringement by Toshiba. *See Limelight Networks, Inc. v. Akamai Techs., Inc.*, 572
8 U.S. 915, 920 (2014) (“there can be no indirect infringement without direct
9 infringement.”) (citation omitted). Thus, “key elements of indirect infringement []
10 could not be proven (or disproven) without third-party involvement.” *Mitek*, 139
11 F.4th at 1356. For example, “induced infringement requires a finding that the alleged
12 infringer affirmatively induced that infringement with knowledge that the induced
13 acts constituted patent infringement, and contributory infringement similarly
14 requires that alleged infringer had knowledge of patent infringement.” (internal
15 quotations and citations omitted). Accordingly, in addition to proof of Toshiba’s
16 direct infringement, “investigation would be necessary to find what [Resonac] knew
17 about [Toshiba’s] activity and whether [Resonac] directed or encouraged some or
18 all elements of such infringement[.]” *Id.* at 1356-57 (internal quotations omitted).

19 Other recent authority underscores the inefficiency. In *Samsung*, the court
20 declined to give priority to the manufacturer suit where, as here, the customer (HGC)
21 was the alleged direct infringer and the manufacturer’s (TCP) exposure was
22 derivative. *Samsung Elecs. Co. v. Tech. Consumer Prods., Inc.*, No. 1:23-CV-186,
23 2024 WL 1961320, at *1-2 (D. Del. May 2, 2024) (“[U]nlike a claim for direct
24 infringement, for indirect infringement, Samsung will have to prove some *mens rea*
25 on the part of TCP [which] means that resolution of the infringement case against
26 TCP may not necessarily resolve the case against HGC.”). The court explained that
27 severing or staying the direct-infringer (customer) action would risk bringing the
28 parties “back to square one” because the indirect-infringer (manufacturer) action

1 could be resolved without reaching the question of direct infringement. *Id.* at *2
2 (“For example, the Court or jury could conclude that TCP lacked the appropriate
3 *mens rea*, decline to reach the infringement questions, and then everyone would be
4 back to square one in the suit against HGC.”).

5 The same is true here. Resonac may represent, for example, that it lacked
6 knowledge of the patents until after the April 2019 start date of Toshiba’s alleged
7 damages period. The Court or a jury could then dispose of the indirect infringement
8 allegations for HDDs sold before Resonac’s alleged knowledge date without ever
9 deciding whether those drives infringe. That would bring the parties right back
10 where they started as to those products in the Toshiba action, having burned time
11 and resources on duplicative discovery and motion practice in this Court for no
12 substantive benefit. Far from promoting efficiency, such an outcome is the opposite
13 of what the customer-suit exception is meant to accomplish. *Id.* at *2 n.2
14 (“That result defies the ‘Supreme Court’s mandate that determinations of priority
15 between manufacturer and customer suits should be made with an eye toward wise
16 judicial administration, giving regard to conservation of judicial resources and
17 comprehensive disposition of litigation[.]’”) (citing *Am. Acad. of Sci. v. Novell Inc.*,
18 No. 91-4300, 1992 WL 313101, at *2 (N.D. Cal. July 9, 1992) (cleaned up)); *see*
19 *also Katz v. Siegler*, 909 F.2d 1459, 1463 (Fed. Cir. 1990) (“[A] primary question is
20 whether the issues and parties are such that the disposition of one case would be
21 dispositive of the other.”); *Microsoft Corp. v. Commonwealth Sci. & Indus. Rsch.*
22 *Organisation*, No. 6:06 CV 549, 2007 WL 4376104, at *3 (E.D. Tex. Dec. 13, 2007)
23 (“[T]he customers’ end products are what allegedly directly infringe, not the
24 components [and so] [t]he [manufacturer action] would not completely resolve the
25 issues of the [customer actions] as the fact-finder would still need to find that the
26 customers directly infringed before finding that [manufacturer] indirectly
27 infringed.”).

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RUSS, AUGUST & KABAT

1 The risk of wasted resources is particularly acute because MRT has targeted
2 its enforcement efforts exclusively at HDD manufacturers, never threatening
3 Resonac or any other upstream supplier. Absent Resonac’s tactical decision to file
4 this action, no court would need to resolve hypothetical indirect infringement
5 theories against a component supplier. The only reason these derivative issues are
6 now in play is because Resonac chose to manufacture a dispute that MRT itself
7 declined to bring.

8 In sum, the customer-suit exception does not justify Resonac’s attempt to
9 avoid the CDCA court; it underscores why this later-filed DJ action should be
10 dismissed.

11 **2. Resonac’s Indemnification Obligation Makes**
12 **Participation in the CDCA Case the Proper Remedy**

13 Resonac’s indemnification obligation to Toshiba also counsels against the
14 customer-suit exception. As the Federal Circuit explained, where a supplier has
15 agreed to indemnify a customer that has already been sued, the supplier’s proper
16 course is to defend its customer in the earlier-filed customer action:

17 A case has already been filed against these customers in the Eastern
18 District of Texas. Appellees cannot seek a declaration from a New York
19 court on behalf of customers they must indemnify where a suit against
20 these very same customers on all the same issues was already underway
21 in a Texas court. By agreeing to indemnify any one of their customers,
22 Microsoft could defend its customers and efficiently and effectively
23 participate in the Texas action.

24 *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 904 (Fed. Cir. 2014) (citation
25 omitted). Consistent with *Microsoft*, this Court has likewise ruled that “where a
26 manufacturer has an obligation to indemnify its customers, it has to ‘stand in the
27 shoes of the customers’ in the district” where the customer suit is pending. *Finisar*
28 *Corp. v. Capella Photonics, Inc.*, No. 20-CV-07629-EMC, 2021 WL 810227, at *4

1 (N.D. Cal. Mar. 3, 2021); *see also* *Teleconference Sys. v. Proctor & Gamble*
2 *Pharms., Inc.*, 676 F. Supp. 2d 321, 327 (D. Del. 2009) (“The customer suit
3 exception is applicable when the first suit is brought against the customer in a district
4 where the manufacturer cannot be joined as a defendant.”).

5 That logic applies with full force here: by agreeing to indemnify Toshiba,
6 Resonac can “stand in the shoes” of and defend Toshiba in the CDCA action; it
7 cannot use indemnity to justify a second lawsuit in a second forum. Courts routinely
8 refuse to entertain declaratory actions when intervention in the first-filed customer
9 case is the efficient, orderly path. In *Mitek*, the Federal Circuit affirmed dismissal of
10 the supplier’s DJ action where the district court concluded the “best” way for the
11 supplier to protect itself was to intervene in customer litigation. *Mitek Sys., Inc. v.*
12 *United Servs. Auto. Ass’n*, 139 F.4th 1340, 1356 (Fed. Cir. 2025) (“These concerns
13 do not undermine the district court’s conclusion that intervention remains the more
14 effective avenue for Mitek to defend its software—particularly when weighed
15 against the practical challenges of pursuing this declaratory judgment action.”).
16 Likewise, in *Proofpoint*, this Court declined declaratory judgment jurisdiction and
17 expressly encouraged the supplier to intervene in the first-filed infringement action
18 rather than proceed with a separate declaratory suit in a different forum. *See*
19 *Proofpoint*, 2011 U.S. Dist. LEXIS 120343, at *20 (“Instead, the Court encourages
20 Proofpoint to move to intervene in the Texas Action or bring a separate action for
21 declaratory judgment in the Eastern District of Texas and seek to relate that claim to
22 the Texas Action.”). Resonac’s proper remedy is straightforward: intervene,
23 indemnify, or otherwise participate in the first-filed action before the judge who
24 already knows the patents and the technology. *See Ford Motor Co. v. United States*,
25 811 F.3d 1371, 1379–80 (Fed. Cir. 2016) (“While the existence of another adequate
26 remedy does not necessarily bar a declaratory judgment, district courts may refuse
27 declaratory relief where an alternative remedy is better or more effective.”) (citation
28 omitted).

1 Resonac’s own litigation history confirms that intervention is the proper
 2 remedy. Resonac (formerly Showa Denko K.K. (“SDK”))⁴ has intervened in at least
 3 one patent case involving its media, acknowledging that “intervention is the most
 4 efficient and expeditious way for SDK ... to litigate the patent issues surrounding
 5 its recording media products and to adequately protect their own interests and those
 6 of their [] customers.” *Stormedia Texas, LLC. v. Compusa, Inc.*, et al EDTX-2-07-
 7 cv-00025; Ex. 15 (Motion to Intervene); *see also id.* at 5 (SDK’s “participation as a
 8 defendant will significantly expedite discovery, as information relating to the design
 9 and production of the recording media will be obtainable through usual discovery
 10 procedures.”). Indeed, Resonac acknowledged that intervention better serves
 11 efficiency and judicial economy because a separate declaratory judgment action
 12 would “only multiply the number of different actions—possibly in different
 13 jurisdictions—litigating identical issues of patent infringement and invalidity ...
 14 [which] the ‘customer suit exception’ was intended to avoid.” *Id.* at 12-13.

15 **V. IN THE ALTERNATIVE, THE COURT SHOULD TRANSFER**
 16 **THIS CASE TO THE CDCA**

17 If the Court does not dismiss this declaratory judgment action, it should
 18 transfer the case to the CDCA where Judge Selna can coordinate or consolidate
 19 Resonac’s claims with the Toshiba case. The public-interest factor of judicial
 20 economy is decisive given Judge Selna has already invested substantial judicial
 21 resources in these patents and the technology, and having this Court re-do that work
 22 would waste resources and invite inconsistent rulings. The private-interest factors
 23 also favor transfer or are at worst neutral.

24 A district court may “for the convenience of parties and witnesses, in the
 25 interest of justice, . . . transfer any civil action to any other district court or division
 26 where it might have been brought.” 28 U.S.C. § 1404(a) (1994). “Consideration of
 27 the interest of justice, which includes judicial economy, may be determinative to a

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⁴ See <https://www.resonac.com/corporate/name-change.html>.

1 particular transfer motion, even if the convenience of the parties and witnesses might
2 call for a different result.” *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559,
3 1565 (Fed. Cir. 1997) (citation omitted); *see also In re Volkswagen of Am., Inc.*, 566
4 F.3d 1349, 1351 (Fed. Cir. 2009) (“[T]he existence of multiple lawsuits involving
5 the same issues is a paramount consideration when determining whether a transfer
6 is in the interest of justice.”). “Thus, in patent litigation ‘in which several highly
7 technical factual issues are presented and the other relevant factors are in equipoise,
8 the interest of judicial economy may favor transfer to a court that has become
9 familiar with the issues.’” *Cisco Sys., Inc. v. TiVo, Inc.*, No. C 12-02766 RS, 2012
10 WL 3279532, at *6 (N.D. Cal. Aug. 10, 2012) (citing *Regents*, 119 F.3d at 1565);
11 *Proofpoint*, 2011 WL 4915847, at *7 (“[T]he focus on judicial efficiency [] underlies
12 both the first-filed rule and the transfer analysis.”).

13 As an initial matter, this action could have been brought in the CDCA because
14 MRT is subject to personal jurisdiction there and events giving rise to Resonac’s
15 claims (which are derivative of MRT’s infringement claims against Toshiba in the
16 CDCA case) have occurred there.

17 As explained above, the CDCA case already places the asserted patents, the
18 accused HDD technology, and the relevant parties before a single court. The CDCA
19 court has invested substantial time learning the patents and the underlying magnetic-
20 recording technology through extensive prior proceedings. *See* Section II.B above.
21 Absent dismissal (or transfer), the very inefficiency the first-to-file rule is designed
22 to prevent would result—multiple courts simultaneously addressing the same patents
23 and overlapping infringement issues, with duplicative discovery and a heightened
24 risk of inconsistent rulings. There is simply no reason to sacrifice the judicial
25 economy and orderly case management achieved by adjudicating MRT’s claims in
26 the first-filed CDCA forum.

27 Regarding the private interest factors, the CDCA is more convenient for the
28 parties. The alleged direct infringer Toshiba is located there; the first-filed case is

1 there; and litigating related issues before one court avoids duplicative depositions
2 and discovery disputes that would otherwise be litigated twice.

3 To the extent Resonac points to REA’s NDCA presence, REA’s alleged role
4 is ancillary at best. RHDC—not REA—“is the Resonac entity primarily responsible
5 for design and manufacture of the magnetic recording media.” Ex. 13 (Toshiba’s
6 Motion to Stay) at 9. And it is RHDC that owes the indemnification obligation to
7 Toshiba. *Id.* at 4. (“Toshiba has, in accordance with the indemnification provision
8 of its supply agreement with RHDC, specifically requested indemnification from
9 Resonac with regard to the allegations in MRT’s Complaint” and “Resonac has
10 agreed to indemnify Toshiba in accordance with the terms of the agreement.”). *Id.*
11 at 4. By contrast, REA merely offers services “related to RHDC’s business of selling
12 magnetic recording media to customers.” Compl. ¶¶ 3, 18. REA does not even allege
13 that it provided any such services in connection with the accused Toshiba HDDs.
14 Regardless, any difference in witness convenience “will be somewhat limited given
15 the relatively close proximity between the Districts[.]” *Herrera v. Command Sec.*
16 *Corp.*, No. C-12-1079 EMC, 2012 WL 6652416, at *9 (N.D. Cal. Dec. 20, 2012).

17 Indeed, the only plausible explanation for Resonac’s decision to sue in this
18 Court—a new forum with no meaningful connection to the parties, the patents, or
19 the events giving rise to the dispute—is to sidestep Judge Selna’s prior findings and
20 established familiarity with these patents. *Sybase, Inc.*, 2010 WL 1689956, at *2
21 (granting transfer where “[p]laintiff’s filing of this action smacks of forum shopping
22 and a response to an unfavorable decision suffered in the Eastern District.”);
23 *Wireless Consumers All., Inc. v. T-Mobile USA, Inc.*, No. C 03- 3711 MHP, 2003
24 WL 22387598, at *5 (N.D. Cal. Oct. 14, 2003) (“[E]vidence of plaintiff’s attempt to
25 avoid a particular precedent from a particular judge weighs heavily ... and would
26 often make the transfer of venue proper”). MRT has never indicated any intent to
27 sue Resonac. MRT’s enforcement conduct confirms the dispute belongs where MRT
28 put it: against the direct infringer in the first-filed forum.

1 Accordingly, the public-interest consideration of judicial economy far
2 outweighs any purported benefit of proceeding in NDCA. *See In re Vistaprint Ltd.*,
3 628 F.3d 1342, 1346–47 (Fed. Cir. 2010) (district court’s prior experience with
4 patent-in-suit is a “legitimate and substantial” reason to transfer a related case to that
5 district); *Aliphcom v. Wi-LAN Inc.*, 10-CV-02337-LHK, 2010 WL 4699844, *3
6 (N.D. Cal. Nov. 10, 2010) (granting transfer because “the risk of inconsistent
7 judgments and waste of judicial resources must outweigh the equitable concern of
8 [DJ plaintiff’s] convenience in litigating its claim.”), *aff’d*, *In re Aliphcom*, MISC.
9 NO. 971, 2011 WL 4630923 (Fed. Cir. Feb. 9, 2011). The CDCA has lived with
10 these patents through the entire lifecycle of complex litigation. Asking this Court to
11 re-learn the technology, re-construe the claims, and issue infringement rulings that
12 might conflict with the CDCA’s prior rulings, verdict, and judgment would be an
13 immense waste of judicial resources.

14 In these circumstances, transferring the dispute to the forum already familiar
15 with the patents and technology best serves the interests of justice by avoiding
16 duplicative discovery and claim-construction work, reducing the risk of inconsistent
17 rulings, and conserving judicial and party resources. *See Sybase, Inc. v. Vertica Sys.,*
18 *Inc.*, No. C-09-05647 MHP, 2010 WL 1689956, at *1 (N.D. Cal. Apr. 23, 2010)
19 (finding that instant suit was “merely round two” of litigation already pending in
20 Eastern District of Texas, and granting motion to transfer where the judge in that
21 district “ha[d] become very familiar with the related patent”); *Bristol-Myers Squibb*
22 *Co.*, 2013 WL 3829599, at *4 (granting transfer where the transferee court had
23 gained expertise from presiding over multiple suits involving the patents, including
24 issuing claim constructions and hearing substantive invalidity arguments); *Cisco*
25 *Sys., Inc. v. TiVo Inc.*, 2012 WL 3279532, at *6 (transfer promotes the “efficient and
26 expeditious administration of justice” where the transferee court is already familiar
27 with the relevant technology); *Broadcom Corp. v. Agere Sys., Inc.*, 2003 WL
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RUSS, AUGUST & KABAT

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21982473, at *1 (granting transfer to court handling case on related patents to avoid duplicative work and wasted effort).

VI. CONCLUSION

There is no reason for this Court to expend its resources on a parallel suit over the same patents and accused products. The Court should decline to exercise jurisdiction and dismiss this action or, at minimum, transfer it to the CDCA where it can be more efficiently managed with the first-filed Toshiba case by the court already familiar with the patents and the issues.

RUSS AUGUST & KABAT

Dated: December 29, 2025

By: /s/ Marc Fenster

Marc Fenster
Brian Ledahl
Dale Chang
Paul Kroeger

Attorneys for Plaintiff
MR TECHNOLOGIES, GMBH

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CERTIFICATE OF SERVICE

I hereby certify that on December 29, 2025, I electronically served the foregoing MR TECHNOLOGIES’ MOTION TO DISMISS OR TRANSFER via email upon all counsel of record.

/s/ Marc Fenster

CERTIFICATE OF COMPLIANCE

Pursuant to the Civil Local Rules of the Northern District of California, including Civil Local Rule 7-4(b), counsel certifies that this Motion to Dismiss or, in the Alternative, Transfer complies with the applicable word-count limitations. This motion contains 5,820 words, excluding the portions exempt by the Local Rules.

Dated: December 29, 2025

/s/ Marc Fenster