



**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**
717 MADISON PLACE, N.W.
WASHINGTON, D.C. 20439

JARRETT B. PERLOW
CLERK OF COURT

CLERK'S OFFICE
202-275-8000

April 18, 2025

NOTICE OF DOCKETING

Federal Circuit Docket No.: 2025-1659

Federal Circuit Short Caption: Optoma Technology, Inc. v. Maxell, Ltd.

Date of Docketing: April 18, 2025

Originating Tribunal: United States District Court for the Northern District of California

Originating Case No.: 3:24-cv-08147-TLT

Appellant: Optoma Technology, Inc.

A notice of appeal has been filed and assigned the above Federal Circuit case number. The court's official caption is included as an attachment to this notice. Unless otherwise noted in the court's rules, the assigned docket number and official caption or short caption must be included on all documents filed with this Court. It is the responsibility of all parties to review the Rules for critical due dates. The assigned deputy clerk is noted below and all case questions should be directed to the Case Management section at (202) 275-8055.

The following filings are due within 14 days of this notice:

- [Entry of Appearance](#) or [Notice of Unrepresented Person](#). (Fed. Cir. R. 47.3.)
- [Certificate of Interest](#). (Fed. Cir. R. 47.4; not required for unrepresented and federal government parties unless disclosing information under Fed. Cir. R. 47.4(a)(6))
- [Docketing Statement](#). Note: The Docketing Statement is due in 30 days if the United States or its officer or agency is a party in the appeal. (Fed. Cir. R. 47.6 and the [Mediation Guidelines](#); no docketing statement is required in cases with an unrepresented party)
- [Statement Concerning Discrimination](#) in MSPB or arbitrator cases. (Fed. Cir. R. 15(c); completed by petitioner only)

- Fee payment or appropriate fee waiver request, if the docketing fee was not prepaid (see Fee Payment below).

FILING DOCUMENTS: Each counsel representing a party must be a member of the court's bar and registered for the court's electronic filing system. Parties represented by counsel must make all filings through the court's electronic filing system.

Unrepresented parties may choose to submit case filings to the court either in paper or through the court's electronic filing system; electronic filing will only be permitted for unrepresented parties after successful registration for the court's electronic filing system and submission of a completed Notice of Unrepresented Person Appearance. Fed. Cir. R. 25(a). The court's Electronic Filing Procedures may be accessed [here](#).

CONTACT INFORMATION: Electronic filers, or unrepresented parties registered to receive electronic service, must update their contact information in their PACER service center profile whenever their contact information changes. Counsel must file an amended Entry of Appearance and unrepresented parties must file an amended Notice of Unrepresented Person Appearance whenever contact information changes. Fed. Cir. R. 25(a)(5).

FEE PAYMENT: Unless the filing fee was prepaid, fee payment must be submitted within fourteen days after this notice. Fed. Cir. R. 52(d). For outstanding docketing fees due to this court, electronic filers must pay the fee using the event Pay Docketing Fee through the court's electronic filing system. Fed. Cir. R. 52(e). Docketing fees due to other courts, such as U.S. District Courts, the U.S. Court of Appeals for Veterans Claims, and non-vaccine cases at the U.S. Court of Federal Claims, must be submitted to those courts in accordance with their procedures. A filer wishing to proceed without fee payment must submit a motion for leave to proceed in forma pauperis, or other fee waiver request, within fourteen days.

OFFICIAL CAPTION: The court's official caption is attached and reflects the lower tribunal's caption pursuant to Fed. R. App. P. 12(a), 15(a), and 21(a). Please review the caption carefully and promptly advise this court in writing of any improper or inaccurate designations.



Jarrett B. Perlow
Clerk of Court

By: J. Phillips, Deputy Clerk

Attachments:

- Official caption
- Paper Copies of General Information and Forms (to unrepresented parties only):
 - [General Information and Overview of a Case in the Federal Circuit](#)
 - [Notice of Unrepresented Person Appearance](#)
 - [Informal Brief](#)
 - [Informal Reply Brief](#) (to be completed only after receiving the opposing party's response brief)
 - [Motion and Affidavit for Leave to Proceed in Forma Pauperis](#) (only to filers owing the docketing fee)
 - [Supplemental in Forma Pauperis Form for Prisoners](#) (only to filers in a correctional institution)
 - [Statement Concerning Discrimination](#) (only to petitioners in MSPB or arbitrator case)

cc: United States District Court for the Northern District of California

Official Caption

OPTOMA TECHNOLOGY, INC.,
Plaintiff-Appellant

v.

MAXELL, LTD.,
Defendant-Appellee

Short Caption

Optoma Technology, Inc. v. Maxell, Ltd.

FORM 1. Notice of Appeal from a United States Federal Court (District Court, Court of Appeals for Veterans Claims, Court of Federal Claims (non-vaccine appeals), and Court of International Trade) Form 1 March 2023

UNITED STATES

DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

NOTICE OF APPEAL

Notice is hereby given that the appellant(s) listed below hereby appeal(s) the below-noted case to the United States Court of Appeals for the Federal Circuit.

Case number being appealed: Case No. 3:24-cv-08147-TLT

Case title being appealed: Optoma Technology, In v. Maxell Ltd.

Date of final judgment or order being appealed: 03/14/2025

List all Appellants (List each party filing this appeal. Do not use “et al.” or other abbreviations. Attach continuation pages if necessary.)

Optoma Technology, Inc.

Date: 04/14/2025

Signature: /s/ Donald R. McPhail

Name: Donald R. McPhail

Address: Merchant & Gould PC

1900 Duke Street, Suite 600

Alexandria, VA 22314

Phone Number: 703-684-2500

Email Address: dmcphail@merchantgould.com

ADRMOP,AO279,APPEAL,CLOSED,PRVADR

U.S. District Court
California Northern District (San Francisco)
CIVIL DOCKET FOR CASE #: 3:24-cv-08147-TLT
Internal Use Only

Optoma Technology Inc. v. Maxell Ltd.
Assigned to: Judge Trina L Thompson
Cause: 28:2201 Declaratory Judgement

Date Filed: 11/19/2024
Date Terminated: 03/14/2025
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff**Optoma Technology Inc.**represented by **Donald R. McPhail**

Merchant & Gould P.C.
1900 Duke Street, Suite 600
Alexandria, VA 22314
703-684-2500
Fax: 612-332-9081
Email: dmcphail@merchantgould.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Eric Ronald Chad

Merchant and Gould
80 South 8th St.
3200 IDS Center
Minneapolis, MN 55402
United Sta
612-336-4742
Email: echad@merchantgould.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Scott P. Shaw

Merchant & Gould
8383 Wilshire Blvd.
Suite 935
Beverly Hills, CA 90211
303-357-1670
Fax: 612-332-9081
Email: sshaw@merchantgould.com
ATTORNEY TO BE NOTICED

I hereby certify that the annexed
instrument is a true and correct copy
of the original on file in my office.

ATTEST:
MARK B. BUSBY
Clerk, U.S. District Court
Northern District of California

by: Karen Gorman Karen Gorman
Deputy Clerk

Date: 4/15/2025

V.

Defendant

Maxell, Ltd.
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Maxell Ltd.

represented by **Michael A. Molano**

Mayer Brown LLP
575 Market Street
Ste 2500
San Francisco, CA 94105
415-874-4230
Email: mmolano@mayerbrown.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Bryan Nese

Mayer Brown LLP
1999 K Street NW
Washington, DC 20006
202-263-3266
Email: bnese@mayerbrown.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Don Hyun Min

Mayer Brown LLP
1999 K Street, NW
Washington, DC 20006
202-263-3153
Email: dmin@mayerbrown.com
ATTORNEY TO BE NOTICED

Jamie Beaber

Mayer Brown LLP
1999 K Street NW
Washington, DC 20006
202-263-3153
Email: jbeaber@mayerbrown.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Ryan Regan

Mayer Brown LLP
300 South Tryon Street
Suite 1800
28202
Charlotte, NC 28202
704-444-3520
Email: rregan@mayerbrown.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Young Kyoung Kim

Mayer Brown LLC
1999 K Street, N.W.
Washington D.C., DC 20006-1101
Maxell, Ltd.
EX2009
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202-263-3349

Email: clairekim@mayerbrown.com

PRO HAC VICE

ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
04/14/2025	60	NOTICE OF APPEAL to the Federal Circuit as to 58 Order, Terminated Case by Optoma Technology Inc.. Filing fee \$ 605, receipt number BCANDC-20564856. Appeal Record due by 5/14/2025. (McPhail, Donald) (Filed on 4/14/2025) (Entered: 04/14/2025)
03/31/2025	 59	Transcript of Proceedings held on 03/11/25, before Judge Trina Thompson. Court Reporter/Transcriber Echo Reporting, Inc., telephone number echoreporting@yahoo.com. Tape Number: 1:59 - 2:46. Per General Order No. 59 and Judicial Conference policy, this transcript may be viewed only at the Clerk's Office public terminal or may be purchased through the Court Reporter/Transcriber until the deadline for the Release of Transcript Restriction. After that date it may be obtained through PACER. Any Notice of Intent to Request Redaction, if required, is due no later than 5 business days from date of this filing. (Re 57 Transcript Order, 56 Transcript Order) Redaction Request due 4/21/2025. Redacted Transcript Deadline set for 5/1/2025. Release of Transcript Restriction set for 6/30/2025. (Related documents(s) 57 , 56) (Jauregui, Tara) (Filed on 3/31/2025) (Entered: 03/31/2025)
03/14/2025	58	ORDER GRANTING 35 MOTION TO DISMISS. Signed by Judge Trina L. Thompson on 3/14/2025. (rfm, COURT USER) (Filed on 3/14/2025) (Entered: 03/14/2025)
03/13/2025	57	TRANSCRIPT ORDER for proceedings held on March 11, 2025 before Judge Trina L Thompson by Maxell Ltd., for Recorded Proceeding - San Francisco. (Molano, Michael) (Filed on 3/13/2025) (Entered: 03/13/2025)
03/13/2025	56	TRANSCRIPT ORDER for proceedings held on March 11, 2025 before Judge Trina L Thompson by Optoma Technology Inc., for Recorded Proceeding - San Francisco. (McPhail, Donald) (Filed on 3/13/2025) (Entered: 03/13/2025)
03/11/2025	55	Minute Entry for proceedings held before Judge Trina L Thompson: Motion Hearing held on 3/11/2025. re 35 MOTION to Dismiss <i>Under the First-to-File Rule</i> filed by Maxell Ltd. The motion having been argued and submitted, the Court takes it under submission. Liberty Recording Time: 1:59 - 2:46. Plaintiff Attorney: Donald McPhail. Defendant Attorney: Bryan Nese, Michael Molano. <i>(This is a text-only entry generated by the court. There is no document associated with this entry.)</i> (rfm, COURT USER) (Date Filed: 3/11/2025) Transcriber - Tara Jauregui, email: echoreporting@yahoo.com 3/14/2025 (bns, COURT STAFF). (Entered: 03/11/2025)

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03/11/2025	54	QUESTIONS FOR THE PARTIES Re: Dkt. No. 35 . Signed by Judge Trina L. Thompson on 3/7/2025. (rfm, COURT USER) (Filed on 3/11/2025) (Entered: 03/11/2025)
03/11/2025	53	RESPONSE re 50 Order <i>Questions to the Parties re Dkt. 35</i> by Optoma Technology Inc.. (McPhail, Donald) (Filed on 3/11/2025) (Entered: 03/11/2025)
03/10/2025	52	RESPONSE to March 7 Questions for the Parties by Maxell Ltd.. (Nese, Bryan) (Filed on 3/10/2025) (Entered: 03/10/2025)
03/04/2025	51	Statement re 50 Order <i>[Joint Statement re Jurisdiction and Relationship of Parties]</i> by Optoma Technology Inc.. (Chad, Eric) (Filed on 3/4/2025) (Entered: 03/04/2025)
02/26/2025	50	ORDER RE JURISDICTION AND RELATIONSHIP OF PARTIES Re: Dkt. No. 35 . Signed by Judge Trina L. Thompson on 2/26/2025. (rfm, COURT USER) (Filed on 2/26/2025) (Entered: 02/26/2025)
02/26/2025	49	CASE MANAGEMENT AND SCHEDULING ORDER. Signed by Judge Trina L. Thompson on 2/26/2025. Initial Case Management Conference set for 2/27/2025 is vacated. Private ADR to be completed by 11/10/2025. Jury Selection and Trial set for 7/19/2027 - 7/26/2027 at 8:30 AM in San Francisco, Courtroom 09, 19th Floor before Judge Trina L Thompson. Estimated Length: 5 days. Final Pretrial Conference set for 6/10/2027 at 3:00 PM in San Francisco, Courtroom 09, 19th Floor. Joint Pretrial Statement with Objections due by 5/14/2027. Dispositive Motion Hearing set for 3/30/2027 at 2:00 PM in San Francisco, Courtroom 09, 19th Floor before Judge Trina L Thompson. Dispositive Motion due by 1/15/2027. Close of Expert Discovery is 12/17/2026. Rebuttal Reports due by 12/3/2026. Opening Reports due by 11/5/2026. Close of Fact Discovery is 10/29/2026. Further Case Management Conference set for 10/23/2025 at 2:00 PM in San Francisco - Videoconference Only. Joint Case Management Statement due by 10/16/2025. Claims Construction Hearing set for 8/25/2025 11:00 AM in San Francisco, Courtroom 09, 19th Floor before Judge Trina L Thompson. Opening Claim Construction Brief due by 7/21/2025. Responsive Claim Construction Brief due by 8/4/2025. Reply Claim Constructions Brief due by 8/11/2025. Further Case Management Conference set for 6/26/2025 at 2:00 PM in San Francisco - Videoconference Only. Case Management Statement due by 6/18/2025. Amended Pleadings due by 5/1/2025.

Maxell, Ltd.

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		Exhibit 4 to the Declaration of Eric Chad, # 6 Exhibit 5 to the Declaration of Eric Chad, # 7 Exhibit 6 to the Declaration of Eric Chad, # 8 Exhibit 7 to the Declaration of Eric Chad, # 9 Exhibit 8 to the Declaration of Eric Chad, # 10 Exhibit 9 to the Declaration of Eric Chad, # 11 Exhibit 10 to the Declaration of Eric Chad, # 12 Exhibit 11 to the Declaration of Eric Chad, # 13 Exhibit 12 to the Declaration of Eric Chad, # 14 Exhibit 13 to the Declaration of Eric Chad, # 15 Exhibit 14 to the Declaration of Eric Chad)(Chad, Eric) (Filed on 1/21/2025) (Entered: 01/21/2025)
01/13/2025	37	Statement re 36 Order, by Optoma Technology Inc.. (Chad, Eric) (Filed on 1/13/2025) (Entered: 01/13/2025)
01/07/2025	36	ORDER re ECF 35 : The Court ORDERS the parties to file a joint statement listing all related cases by Monday, January 13, 2025. The parties must provide the jurisdiction and posture of each case. Signed by Judge Trina L. Thompson on 1/7/2025. (This is a text-only entry generated by the court. There is no document associated with this entry.) (tltlc3, COURT STAFF) (Filed on 1/7/2025) (Entered: 01/07/2025)
01/06/2025	35	MOTION to Dismiss <i>Under the First-to-File Rule</i> filed by Maxell Ltd.. Motion to Dismiss Hearing set for 3/11/2025 02:00 PM in San Francisco, Courtroom 09, 19th Floor. Responses due by 1/21/2025. Replies due by 1/28/2025. (Attachments: # 1 Declaration of Michael A. Molano in Support, # 2 Exhibit 1 to Molano Declaration, # 3 Exhibit 2 to Molano Declaration, # 4 Exhibit 3 to Molano Declaration, # 5 Proposed Order)(Molano, Michael) (Filed on 1/6/2025) (Entered: 01/06/2025)
12/30/2024	34	Order GRANTING 33 Motion for Pro Hac Vice as to Ryan Regan. Signed by Judge Trina L Thompson on 12/30/2024. (rfm, COURT USER) (Filed on 12/30/2024) (Entered: 12/30/2024)
12/20/2024	33	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number ACANDC-20167826.) filed by Maxell Ltd.. (Attachments: # 1 Certificate of Good Standing)(Regan, Ryan) (Filed on 12/20/2024) (Entered: 12/20/2024)
12/19/2024	32	Order GRANTING 31 Motion for Pro Hac Vice as to Eric Chad. Signed by Judge Trina L Thompson on 12/19/2024. (rfm, COURT USER) (Filed on 12/19/2024) (Entered: 12/19/2024)
12/19/2024		(Court only) ***Motions terminated: 29 MOTION to Transfer Case filed by Maxell Ltd.. (rfm, COURT USER) (Filed on 12/19/2024) (Entered: 12/19/2024)
12/18/2024	31	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number ACANDC-20156219.) filed by Optoma Technology Inc.. (Attachments: # 1 Certificate of Good Standing)(Chad, Eric) (Filed on 12/18/2024) (Entered: 12/18/2024)
12/17/2024		(Court only) ***Deadlines terminated. 30 Order,,. (rfm, COURT USER) (Filed on 12/17/2024) (Entered: 12/17/2024)
12/17/2024	30	CLERKS NOTICE: Defendant's Motion to Transfer and Change of Venue, ECF 29 , was merely noticed for hearing. The January 21,2025 date hearing date is VACATED for failure to comply with Civil Local Rule 7-2 and failure to file supporting papers. Defendant shall re-notice and file the motion for a hearing in compliance with Local Rule 7-2(a) and Judge Thompson. Maxell, Ltd. EX2009

		Standing Order. The briefing schedule will be generated upon compliance with this order. Signed by Judge Trina L. Thompson on 12/17/2024. (This is a text-only entry generated by the court. There is no document associated with this entry.) (tltlc3, COURT STAFF) (Filed on 12/17/2024) (Entered: 12/17/2024)
12/13/2024	29	MOTION to Transfer Case filed by Maxell Ltd.. Motion Hearing set for 1/21/2025 02:00 PM in San Francisco, Courtroom 09, 19th Floor before Judge Trina L Thompson. Responses due by 12/27/2024. Replies due by 1/3/2025. (Molano, Michael) (Filed on 12/13/2024) (Entered: 12/13/2024)
12/12/2024	28	Order re. ECF 16 26 : The Court as a courtesy recognizes ECF 16 and ECF 26 as follows and designates them as: Motion to Transfer (ECF 16) and Opposition/Response to Motion to Transfer (ECF 26). Signed by Judge Trina L. Thompson on 12/12/2024. (This is a text-only entry generated by the court. There is no document associated with this entry.) (tltlc3, COURT STAFF) (Filed on 12/12/2024) (Entered: 12/12/2024)
12/12/2024	27	NOTICE of Appearance filed by Don Hyun Min on behalf of Maxell Ltd. (Min, Don) (Filed on 12/12/2024) (Entered: 12/12/2024)
12/11/2024	26	NOTICE by Optoma Technology Inc. re 16 Notice (Other) <i>Opposition to Defendant's Notice of Pendency of Other Action or Proceeding</i> (Shaw, Scott) (Filed on 12/11/2024) (Entered: 12/11/2024)
12/03/2024	25	Order GRANTING 22 Motion for Pro Hac Vice as to Young Kyoung (Claire) Kim. Signed by Judge Trina L Thompson on 12/3/2024. (rfm, COURT USER) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/03/2024	24	Order GRANTING 21 Motion for Pro Hac Vice as to Jamie B. Beaver. Signed by Judge Trina L Thompson on 12/3/2024. (rfm, COURT USER) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/03/2024	23	Order GRANTING 20 Motion for Pro Hac Vice as to Bryan Nese. Signed by Judge Trina L Thompson on 12/3/2024. (rfm, COURT USER) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/03/2024	22	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number ACANDC-20104147.) filed by Maxell Ltd.. (Attachments: # 1 Certificate of Good Standing)(Kim, Young Kyoung) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/03/2024	21	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number ACANDC-20104091.) filed by Maxell Ltd.. (Attachments: # 1 Certificate of Good Standing)(Beaver, Jamie) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/03/2024	20	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number ACANDC-20104021.) filed by Maxell Ltd.. (Attachments: # 1 Certificate of Good Standing)(Nese, Bryan) (Filed on 12/3/2024) (Entered: 12/03/2024)
12/02/2024	19	Order GRANTING 18 Motion for Pro Hac Vice as to Donald McPhail. Signed by Judge Trina L Thompson on 12/2/2024. (rfm, COURT USER) (Filed on 12/2/2024) (Entered: 12/02/2024)
12/02/2024	18	MOTION for leave to appear in Pro Hac Vice (Filing fee \$ 328, receipt number BCANDC-20101135.) filed by Optoma Technology Inc.. (Attachments: # 1 Certificate of Good Standing)(Maxell, Ltd.) (Filed on 12/2/2024) (Entered: 12/02/2024)

		Certificate of Good Standing)(McPhail, Donald) (Filed on 12/2/2024) (Entered: 12/02/2024)
12/02/2024	17	CLERKS NOTICE - REASSIGNED CASE - NOTICE OF NEW HEARING DATE: You are notified that the Court has scheduled an Initial Case Management Conference before Judge Trina L. Thompson upon reassignment. For a copy of Judge Thompson's Standing Order and other information, please refer to the Court's website at www.cand.uscourts.gov. Initial Case Management Conference set for 2/27/2025 at 2:00 PM in San Francisco - Videoconference Only. This proceeding will be held via a Zoom webinar. Joint Case Management Statement due by 2/20/2025. Webinar Access: All counsel, members of the public, and media may access the webinar information at https://www.cand.uscourts.gov/trina-l-thompson/ General Order 58. Persons granted access to court proceedings held by telephone or videoconference are reminded that photographing, recording, and rebroadcasting of court proceedings, including screenshots or other visual copying of a hearing, is absolutely prohibited. Zoom Guidance and Setup: https://www.cand.uscourts.gov/zoom/. <i>(This is a text-only entry generated by the court. There is no document associated with this entry.)</i> (rfm, COURT USER) (Filed on 12/2/2024) (Entered: 12/02/2024)
11/27/2024	16	NOTICE by Maxell Ltd. / <i>Notice of Pendency of Other Action or Proceeding Pursuant to Civil Local Rule 3-13</i> (Attachments: # 1 Exhibit 1)(Molano, Michael) (Filed on 11/27/2024) (Entered: 11/27/2024)
11/27/2024	15	WAIVER OF SERVICE Returned Executed filed by Optoma Technology Inc.. Service waived by Maxell Ltd. waiver sent on 11/21/2024, answer due 2/19/2025. (Shaw, Scott) (Filed on 11/27/2024) (Entered: 11/27/2024)
11/27/2024	14	CONSENT/DECLINATION to Proceed Before a US Magistrate Judge by Optoma Technology Inc... (Shaw, Scott) (Filed on 11/27/2024) (Entered: 11/27/2024)
11/26/2024	13	ORDER REASSIGNING CASE. Case reassigned using a proportionate, random, and blind system pursuant to General Order No. 44 to Judge Trina L Thompson for all further proceedings. Magistrate Judge Sallie Kim no longer assigned to case,. Signed by Clerk on 11/26/24. (as, COURT STAFF) (Filed on 11/26/2024) (Entered: 11/26/2024)
11/26/2024	12	CLERK'S NOTICE OF IMPENDING REASSIGNMENT TO A U.S. DISTRICT COURT JUDGE: The Clerk of this Court will now randomly reassign this case to a District Judge because either (1) a party has not consented to the jurisdiction of a Magistrate Judge, or (2) time is of the essence in deciding a pending judicial action for which the necessary consents to Magistrate Judge jurisdiction have not been secured. You will be informed by separate notice of the district judge to whom this case is reassigned. ALL HEARING DATES PRESENTLY SCHEDULED BEFORE THE Maxell, Ltd.

EX2009

		CURRENT MAGISTRATE JUDGE ARE VACATED AND SHOULD BE RE-NOTICED FOR HEARING BEFORE THE JUDGE TO WHOM THIS CASE IS REASSIGNED. <i>This is a text only docket entry; there is no document associated with this notice.</i> (bxl, COURT STAFF) (Filed on 11/26/2024) (Entered: 11/26/2024)
11/26/2024	11	CONSENT/DECLINATION to Proceed Before a US Magistrate Judge by Maxell Ltd... (Molano, Michael) (Filed on 11/26/2024) (Entered: 11/26/2024)
11/26/2024	10	Certificate of Interested Entities by Maxell Ltd. identifying Other Affiliate The Master Trust Bank of Japan, Ltd. for Maxell Ltd.. (Molano, Michael) (Filed on 11/26/2024) (Entered: 11/26/2024)
11/26/2024	9	NOTICE of Appearance filed by Michael A. Molano on behalf of Maxell Ltd. (Molano, Michael) (Filed on 11/26/2024) (Entered: 11/26/2024)
11/22/2024	8	***FILED IN ERROR. PLEASE DISREGARD *** see 4 for relevant submission. CLERK'S NOTICE REGARDING THE FILING OF AN ACTION REGARDING A PATENT. Please e-file a proposed "Report on the Filing or Determination of an Action or Appeal Regarding a Copyright" form AO 120 using the event <i>Civil Events Other Filings Other Documents Patent/Trademark Report</i> , within five days of this notice. (This is a text-only entry generated by the court. There is no document associated with this entry.) (ecg, COURT STAFF) (Filed on 11/22/2024) Modified on 11/22/2024 (ecg, COURT STAFF). (Entered: 11/22/2024)
11/21/2024	7	Initial Case Management Scheduling Order with ADR Deadlines: Case Management Statement due by 2/17/2025. Initial Case Management Conference set for 2/24/2025 01:30 PM in San Francisco, - Videoconference Only. (kmg, COURT STAFF) (Filed on 11/21/2024) (Entered: 11/21/2024)
11/21/2024	6	Summons Issued as to Maxell Ltd.. (kmg, COURT STAFF) (Filed on 11/21/2024) (Entered: 11/21/2024)
11/19/2024	5	Case assigned to Magistrate Judge Sallie Kim. Counsel for plaintiff or the removing party is responsible for serving the Complaint or Notice of Removal, Summons and the assigned judge's standing orders and all other new case documents upon the opposing parties. For information, visit <i>E-Filing A New Civil Case</i> at http://cand.uscourts.gov/ecf/caseopening. Standing orders can be downloaded from the court's web page at www.cand.uscourts.gov/judges. Upon receipt, the summons will be issued and returned electronically. A scheduling order will be sent by Notice of Electronic Filing (NEF) within two business days. Consent/Declination due by 12/3/2024. (exl, COURT STAFF) (Filed on 11/19/2024) (Entered: 11/19/2024)
11/19/2024	4	REPORT on the filing or determination of an action regarding (cc: form mailed to register). (Shaw, Scott) (Filed on 11/19/2024) (Entered: 11/19/2024)
11/19/2024	3	Rule 7.1 Disclosures by Optoma Technology Inc. identifying Corporate Parent Optoma Holdings Limited, Other Affiliate Coretronic Corporation for Optoma Technology Inc.. (Shaw, Scott) (Filed on 11/19/2024) (Entered: 11/19/2024)

Maxell, Ltd.

EX-2009

11/19/2024	<u>2</u>	Proposed Summons. (Shaw, Scott) (Filed on 11/19/2024) (Entered: 11/19/2024)
11/19/2024	<u>1</u>	COMPLAINT against Maxell Ltd. (Filing fee \$ 405, receipt number ACANDC-20064752.). Filed by Optoma Technology Inc.. (Attachments: # <u>1</u> Exhibit 1, # <u>2</u> Exhibit 2, # <u>3</u> Exhibit 3, # <u>4</u> Exhibit 4, # <u>5</u> Civil Cover Sheet) (Shaw, Scott) (Filed on 11/19/2024) (Entered: 11/19/2024)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

OPTOMA TECHNOLOGY INC.,

Plaintiff,

v.

MAXELL LTD.,

Defendant.

Case No. [24-cv-08147-TLT](#)

**ORDER GRANTING MOTION TO
DISMISS**

Re: Dkt. No. 35

Several months after Defendant Maxell filed suit against Coretronic Corp. (“Coretronic”) and Optoma Taiwan (“Optoma TW”) in the Eastern District of Texas alleging infringement of seven patents, Plaintiff Optoma Technology, Inc. (“Optoma USA”) filed the instant action against Maxell seeking a declaratory judgment of non-infringement as to three of the same patents.

Before the Court is Maxell’s motion to dismiss based on the first-to-file rule. Having considered the parties’ briefs, oral arguments, the relevant legal authority, and for the reasons below, the Court **GRANTS** the motion to dismiss without prejudice.

I. BACKGROUND

Optoma USA is a visual solutions provider that purchases the products Maxell accused of infringing the asserted patents in Asia, imports them into devices in the United States, and sells them. ECF 38, Declaration of Eric R. Chad, Ex. 4 ¶ 15. Optoma USA is headquartered in Fremont, California. *Id.* ¶ 18. Although Coretronic, Optoma TW, and Optoma USA are separate entities, Coretronic is the “ultimate parent company” of both Optoma TW and Optoma USA. ECF 51.

On July 9, 2024, Maxell filed a complaint in the Eastern District of Texas against Coretronic and Optoma TW for the infringement of seven patents (“Texas Action”). ~~Maxell, Ltd.~~

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1 1, at 116; *Maxell, Ltd. v. Coretronic Corp.*, No. 24-cv-00088-RWS-JBB. These include U.S.
 2 Patent Nos. 7,159,988 ('988), 7,850,313 ('313), 8,593,580 ('580), 9,322,530 ('530), 9,547,266
 3 ('226), 9,565,388 ('388), and 9,900,569 ('569). ECF 35, Ex. 1 ¶ 93.

4 On November 19, 2024, Optoma USA filed the instant complaint requesting that the Court
 5 issue a judgment declaring that Optoma USA did not infringe the '988, '388, or '569 patents.
 6 ECF 1 ("Compl.") at 16–17. On November 27, 2024, Maxell filed a notice pursuant to Civil Local
 7 Rule 3-13 to inform the Court that there was an action pending in Texas involving the same
 8 subject matter and substantially the same parties. ECF 16. In this notice, Maxell requested that
 9 the Court either transfer or dismiss the action. *Id.* at 3. Optoma USA filed an opposition. ECF
 10 26. As a courtesy, the Court designated the notices as a motion to transfer and an opposition to a
 11 motion to transfer, and Maxell set a hearing date. ECF 29. The Court, however, vacated the
 12 hearing date for failure to comply with Civil Local Rule 7-2. ECF 30. In response, Maxell
 13 properly noticed a motion to dismiss. ECF 35 ("Mot."). Optoma USA then filed a timely
 14 response. ECF 38 ("Opp'n"). Maxell filed a timely reply. ECF 39 ("Reply"). The Court held
 15 oral arguments on March 11, 2025. ECF 55.

16 II. LEGAL STANDARD

17 The Federal Circuit has determined that the first-to-file rule applies to patent cases. *See*
 18 *Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 937 (Fed. Cir. 1993), *abrogated on other*
 19 *grounds by Wilton v. Seven Falls Co.*, 515 U.S. 277 (1995) (holding that the general rule favors
 20 the forum of the first-filed action). "When two actions that sufficiently overlap are filed in
 21 different federal district courts, one for infringement and the other for declaratory relief, the
 22 declaratory judgment action, if filed later, is generally to be stayed, dismissed, or transferred to the
 23 forum of the infringement action." *Futurewei Techs., Inc. v. Acacia Rsch. Corp.*, 737 F.3d 704,
 24 708 (Fed. Cir. 2013) (citing *Merial Ltd. v. Cipla Ltd.*, 681 F.3d 1283, 1299 (Fed. Cir. 2012); *see*
 25 *also Pacesetter Sys., Inc. v. Medtronic, Inc.*, 678 F.2d 93, 94–95 (9th Cir. 1982) (explaining that
 26 the first-to-file rule is a "generally recognized doctrine of federal comity which permits a district
 27 court to decline jurisdiction over an action when a complaint involving the same parties and issues
 28 has already been filed in another district"). "This 'first-to-file' rule exists to 'avoid conflicting

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1 decisions and promote judicial efficiency.” *Futurewei Techs.*, 737 F.3d at 708 (quoting *Merial*,
2 681 F.3d at 1299).

3 Exceptions to the first-to-file rule may be made if they are justified by “considerations of
4 judicial and litigant economy, and the just and effective disposition of disputes.” *Elecs. for*
5 *Imaging, Inc. v. Coyle*, 394 F.3d 1341, 1347 (Fed. Cir. 2005) (quoting *Genentech*, 998 F.2d at
6 938). There must be “sound reason that would make it unjust or inefficient to continue the first-
7 filed action.” *Id.*

8 “Application of the first-to-file rule is generally a matter for a district court’s discretion,
9 exercised within governing legal constraints.” *Futurewei Techs.*, 737 F.3d at 708. Courts in the
10 Ninth Circuit look to three factors to when applying the first-to-file rule: “(1) the chronology of
11 the actions; (2) the similarity of the parties; and (3) the similarity of the issues.” *Apple Inc. v.*
12 *VolP-Pal.com, Inc.*, 506 F. Supp. 3d 947, 958 (N.D. Cal. 2020) (citing *Alltrade, Inc. v. Uniweld*
13 *Prods.*, 946 F.2d 622, 625–26 (9th Cir. 1991)).

14 **III. DISCUSSION**

15 **A. First-to-file rule**

16 Maxell requests that the Court dismiss this declaratory judgment action under the first-to-
17 file rule. Mot. at 4. Optoma USA counters that the Ninth Circuit’s three-factor test does not apply
18 to this case because Federal Circuit law governs patent cases. Opp’n at 8. However, the Federal
19 Circuit has left the application of the first-to-file rule to the “district court’s discretion.” *Futurewei*
20 *Techs.*, 737 F.3d at 708. Courts in this district have applied the three-factor first-to-file rule in
21 patent litigation. See, e.g., *Renesas Elecs. Am. Inc. v. Monterey Research, LLC*, No. 24-cv-06223-
22 JSC, 2024 WL 5077109 (N.D. Cal. Dec. 10, 2024); *SMIC, Ams. v. Innovative Foundry Techs.*
23 *LLC*, 473 F. Supp. 3d 1021, 1026 (N.D. Cal. 2020); *Microchip Tech., Inc. v. United Module Corp.*,
24 No. 10-cv-04241-LHK, 2011 WL 2669627 (N.D. Cal. July 7, 2011). The Court, therefore, applies
25 the three-factor test to the instant case.

26 **i. Chronology of the actions**

27 For the chronology of lawsuits to be satisfied, the action in the transferee district court
28 “must have been filed prior to the action in the transferor district court.” *Wallerstein v. Maxell, Ltd.*

Fresh Vegetable, Inc., 967 F. Supp. 2d 1289, 1293 (N.D. Cal. 2013). Here, there is no dispute that the Texas Action was filed first. The Texas Action was filed on July 9, 2024. *Maxwell, Ltd. v. Coretronic Corp.*, No. 24-cv-00088-RWS-JBB, ECF 1. The instant action was filed on November 9, 2024. ECF 1. The first factor, therefore, weighs in favor of applying the first-to-file rule.

ii. Similarities of the parties

Next, the first-to-file rule “requires only substantial similarity of parties,” but the cases need not have the exact same parties. *Kohn L. Grp., Inc. v. Auto Parts Mfg. Miss., Inc.*, 787 F.3d 1237, 1240 (9th Cir. 2015). Here, the Court finds that parties are substantially similar. Maxell is common to both actions. Coretronic, one of the defendants in the Texas Action, is the ultimate parent company of Optoma USA. ECF 51. The other defendant in the Texas Action, Optoma TW, is the sister company. Opp’n at 3.

Because Coretronic is the parent company of Optoma USA, the Court finds that the parties Coretronic and Optoma USA are substantially similar. *See Renesas*, 2024 WL 5077109, at *3 (finding that the parties were substantially similar when the defendant in the Texas action was the parent company of the plaintiff in the declaratory judgment action); *SMIC*, 473 F. Supp. 3d at 1026 (determining that the parties were substantially similar when the parent entity was named in the Texas action but not the declaratory judgment action); *Microchip Tech.*, 2011 WL 2669627, at *3 (concluding that the parties were substantially similar when the defendant in the Texas action was “the wholly owned subsidiary” of the plaintiff in the declaratory judgment). Although Optoma USA argues that Optoma TW is a completely separate entity from Optoma USA, having an additional party does not preclude a finding of substantial similarity because the first-to-file rule does not require the parties to be identical. *See Kohn L. Grp.*, 787 F.3d at 1240.

The second factor therefore weighs in favor of applying the first-to-file rule.

iii. Similarities of the issues

For the third factor of the first-to-file rule, “[t]he issues in both cases also need not be identical, only substantially similar.” *Id.* (internal citations omitted). Where there is “substantial overlap” between the two lawsuits, such that they have the same legal issues at the “heart” of their disputes, the “similarity of the issues” factor is satisfied. *Id.* at 1241.

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Here, the issues are similar because they involve three of the same patents. All three of the patents in this declaratory judgment action are also part of the Texas Action. *See* ECF 35, Ex. 1 (asserting violations of the ‘988, ‘388, and ‘569 patents). Although the Texas Action has four additional patents, the fact that the three patents are the same in both is enough to find that the issues are similar because the issues need not be identical. *See Renesas*, 2024 WL 5077109, at *3 (finding that the issues in the Texas action and the declaratory judgment action had substantial overlap because they involved the same four patents); *SMIC*, 473 F. Supp. 3d at 1026 (finding that the issues were substantially similar when the Texas action “allege[d] infringement of the same patents that [were] the basis for Plaintiffs’ declaratory judgment claims” in the second-filed action); *Microchip*, 2011 WL 2669627, at *3 (determining that the issues were substantially the same when plaintiffs sought a declaratory judgment “for non-infringement and invalidity with respect to the same three patents” in the Texas action).

The third factor, therefore, also weighs in favor of applying the first-to-file rule. Because all three factors weigh in favor of applying the first-to-file rule, the Court will apply the first-to-file rule unless one of the exceptions apply.

B. Exceptions to the first-to-file rule

Optoma USA argues that three exceptions of the first-to-file rule, the absence of jurisdiction, forum shopping exception, and balance of convenience, preclude application of the first-to-file rule. *Opp’n* at 10, 12.

Courts, however, have concluded that the court of the first-filed action, rather than the court of the second-filed action, should decide whether an exception to the first-to-file rule applies. *See TCT Mobile (US) Inc. v. Cellular Commc’ns Equip. LLC*, No. SACV 20-00702 JVS (ADSx), 2020 WL 8172714, at *3–4 (C.D. Cal. July 31, 2020) (finding that the weight of the authority suggests that it is more appropriate for the first-filed court to determine whether exceptions apply); *EMC Corp. v. Bright Response, LLC*, No. 12-cv-2841-EMC, 2012 WL 4097707, at *5 (N.D. Cal. Sept. 17, 2012) (deferring the resolution of whether any exceptions preclude the application of the first-to-file rule to the first-filed court); *Juniper Networks, Inc. v. Mosaid Tech., Inc.*, No. 11-cv-6264-PJH, 2012 WL 1029572, at *2 (N.D. Cal. Mar. 26, 2012) (concluding that it is the *Maxell*, with

the first-filed action that should weigh “factors that might create an exception to the first-to-file rule”); *Intuitive Surgical, Inc. v. Cal. Inst. Of Tech.*, No. C07-0063-CW, 2007 WL 1150787, at *3 (N.D. Cal. Apr. 18, 2007) (deferring to the first-filed court to “decide the appropriate forum and whether an exception to the first-to-file rule is applicable”). Therefore, as this is the Court of the second-filed action, the Court need not reach the exceptions.

Furthermore, it is unnecessary for the Court to reach the balance of convenience factors here because the Texas Action will consider the relevant venue questions and convenience factors on the pending motion to transfer. *See Microchip Tech.*, 2011 WL 2669627, at *7 (“[A] court in an earlier filed-action should consider all relevant convenience factors in its analysis of the appropriate forum on a motion to transfer.”); *EMC Corp.*, 2012 WL 4097707, at *3 (declining to rule on the convenience factors because a motion to transfer was fully briefed before the Texas court, so reaching the convenience factors in the second-filed action would risk inconsistent results).

IV. DISMISS, STAY, OR TRANSFER

Having concluded that the first-to-file rule is appropriate in this case, and that the Court is not the appropriate court to determine whether any exceptions to the first-filed rule apply, the Court may use its discretion to dismiss, stay, or transfer the case. Maxell only asks the Court to dismiss or stay the case. Mot. at 1.

“Dismissal is proper where the court of first filing provides adequate remedies.” *Intersearch Worldwide, Ltd. v. Intersearch Grp., Inc.*, 544 F. Supp. 2d 949, 963 (N.D. Cal. 2008) (citing *Alltrade*, 946 F.2d at 627–28).

In this case, the Court determines that dismissal would promote judicial economy. Although there is a pending motion to transfer in the Texas Action, the Court finds that Coretronic, as Optoma USA’s ultimate parent company, will adequately protect Optoma USA’s interests in the Texas Action. *See id.* at 963 (granting the motion to dismiss without prejudice based on the first-to-file rule because the court of the first filing provided adequate remedies). During oral argument, Maxell’s counsel also invited Optoma USA to join the Texas Action, stating that Maxell would not oppose a motion to intervene. The Texas Action is still *Maxell, Ltd.*

1 stages, and Maxell indicated a willingness to adjust the schedule in the Texas Action to
2 accommodate Optoma USA. Because the Eastern District of Texas is familiar with the patents at
3 issue, the Court determines that the Texas Action can effectively resolve the issues asserted in this
4 case. *See SMIC*, 473 F. Supp. 3d at 1028 (granting the motion to dismiss without prejudice
5 because the Texas action was in the early stages and the Texas court was capable of efficiently
6 resolving the issues “given that it [was] already familiarizing itself with the patents at issue”). The
7 Court, therefore, finds that it is in the interest of judicial economy to dismiss this case.

8 **V. CONCLUSION**

9 Accordingly, the motion to dismiss is **GRANTED** without prejudice.

10 This Order resolves ECF 35.

11 The Clerk of the Court is ordered to close the case.

12 **IT IS SO ORDERED.**

13 Dated: March 14, 2025

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15 TRINA L. THOMPSON
16 United States District Judge
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