No. 21-_____

In the Supreme Court of the United States

WALTER A. TORMASI,

Petitioner,

v.

WESTERN DIGITAL CORPORATION,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

APPENDIX

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April 2, 2021

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NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

WALTER A. TORMASI,
Plaintiff-Appellant

v.

WESTERN DIGITAL CORPORATION,
Defendant-Appellee

2020-1265

Appeal from the United States District Court for the Northern District of California in No. 4:19-cv-00772-HSG, Judge Haywood S. Gilliam, Jr.

Decided: August 20, 2020

WALTER A. TORMASI, Trenton, NJ, pro se.

ERICA WILSON, Walters Wilson LLP, Redwood City, CA, for defendant-appellee. Also represented by ERIC STEPHEN WALTERS; REBECCA L. UNRUH, Western Digital Corporation, Milpitas, CA.

Before WALLACH, CHEN, and STOLL, *Circuit Judges.*

Opinion for the court filed PER CURIAM.

Dissenting opinion filed by *Circuit Judge* STOLL.

PER CURIAM.

Appellant Walter A. Tormasi ("Tormasi") sued Appellee Western Digital Corporation ("WDC") in the U.S. District Court for the Northern District of California ("District Court"), alleging infringement of claims 41 and 61–63 ("the Challenged Claims") of U.S. Patent No. 7,324,301 ("the '301 patent"). A.A. 13–25 (Complaint).[1] The District Court issued an order concluding that Mr. Tormasi lacked capacity to sue under Federal Rule of Civil Procedure ("FRCP") 17(b), but did not "reach the standing issue." *See Tormasi v. W. Digital Corp.*, No. 19-CV-00772-HSG, 2019 WL 6218784, at *2 (N.D. Cal. Nov. 21, 2019) (Order); *see id.* at *2–3. For the limited purpose of reviewing the District Court's determination as to whether Mr. Tormasi has capacity to sue, we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).[2] We affirm.

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[1] "A.A." refers to the appendix submitted with Mr. Tormasi's brief. "S.A." refers to the supplemental appendix submitted with WDC's brief.

[2] The District Court exercised jurisdiction under 28 U.S.C. § 1338, accordingly we have jurisdiction. *See Tormasi*, 2019 WL 6218784, at *2 (discussing the '301 patent); J.A. 13–14; *see Apotex, Inc. v. Thompson*, 347 F.3d 1335, 1342 (Fed. Cir. 2003) ("[W]e have appellate jurisdiction if the district court's original jurisdiction was based in part on section 1338, as determined by the plaintiff's well-pleaded complaint." (citing *Holmes Grp., Inc. v. Vornado Air Circulation Sys.*, 535 U.S. 826, 829 (2002)).

BACKGROUND[3]

Mr. Tormasi is an inmate in the New Jersey State Prison ("NJSP"), A.A. 133 (Declaration of Mr. Tormasi), and describes himself as an "innovator and entrepreneur," A.A. 13. NJSP maintains a "no-business" rule, which prohibits inmates from commencing or operating a business without prior approval from the Administrator. N.J. ADMIN. CODE § 10A:1-2.1 (2010); *id.* § 10A:1-2.2 (Administrator "means an administrator or a superintendent who serves as the chief executive officer of any State correctional facility within the New Jersey Department of Corrections."). While imprisoned, and without the Administrator's prior approval, Mr. Tormasi formed "an intellectual-property holding company[,]" A.A. 134, Advanced Data Solutions Corp. ("ADS"), A.A. 101 (Certificate of Incorporation). Mr. Tormasi appointed himself as "director," "Chief Executive Officer, President, and Chief Technology Officer" of ADS. A.A. 134; *see* A.A. 132–44.

In January 2005, Mr. Tormasi filed U.S. Patent Application No. 11/031,878 ("the '878 application"), which ultimately issued in January 2008, as the '301 patent.[4] A.A. 34. In early 2004 Mr. Tormasi, as ADS Director,

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[3] Because Mr. Tormasi appeals the dismissal of his Complaint pursuant to FRCP 12(b)(6), the facts recited herein draw on Mr. Tormasi's Complaint, "as well as other sources courts ordinarily examine when ruling on [FRCP] 12(b)(6) motions to dismiss, in particular, documents incorporated into the [C]omplaint by reference . . . ." *Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 551 U.S. 308, 322 (2007).

[4] Entitled "Striping Data Simultaneously Across Multiple Platter Surfaces," A.A. 34, the '301 patent "relates to the art of dynamically storing and retrieving information using nonvolatile magnetic random-access media, specifically hard disk drives," A.A. 36.

adopted resolutions that transferred Mr. Tormasi's rights in the '878 application for all shares of stock in ADS. A.A. 134. However, Mr. Tormasi also asserts that in February 2005, he contingently assigned his complete right, title, and interest in the '878 application "and its foreign and domestic progeny to ADS." A.A. 95; *see* A.A. 94–95 (Assignment). In May 2007, NJSP intercepted documents from Mr. Tormasi related to ADS, and determined that he "circumvented the procedural safeguards against inmates operating a business without prior approval." A.A. 146 (Disciplinary Report). NJSP "warned" him that "continued involvement with ADS" would "subject[] [him] to further disciplinary action." A.A. 136. Despite this warning, Mr. Tormasi continued his involvement with ADS by executing a corporate resolution that contingently transferred the '878 application from ADS to himself, in June 2007. A.A. 136–37. Mr. Tormasi explained that the purpose of the contingent transfer was "to ensure that [his] intellectual property remained enforceable, licensable, and sellable to the fullest extent possible." A.A. 136.

On March 1, 2008, ADS entered an "inoperative and void" status, for non-payment of taxes. A.A. 108 (capitalization normalized). In late 2009, before executing the 2009 transfer, Mr. Tormasi suspected WDC of infringing upon the '301 patent after reading an article examining WDC hard drives. A.A. 18. Having been barred from filing suit on behalf of ADS by the District of New Jersey, Mr. Tormasi, while he was still incarcerated, directed ADS to adopt a corporate resolution to assign and transfer "all right, title, and interest" in the '301 patent to himself in December 2009. A.A. 155 (2009 Corporate Resolutions), 157 (2009 Assignment). Mr. Tormasi asserts that "[t]he purpose of the transfer in ownership was to permit [Mr. Tormasi] to personally pursue, and to personally benefit from, an infringement action against [WDC] and others." A.A. 138.

In January 2019, at the direction of Mr. Tormasi, ADS again assigned to Mr. Tormasi "all right, title, and interest" in the '301 patent, as well as the authority "to pursue all causes of action and legal remedies arising during the entire term" of the '301 patent. A.A. 27 (2019 Assignment). Mr. Tormasi asserts that the "purpose for executing the [2019] Assignment . . . was to provide up-to-date evidence confirming" that he owned the '301 patent and "had express authority to sue for all acts of infringement." A.A. 140. In February 2019, Mr. Tormasi sued WDC for patent infringement. A.A. 13, 20–24. During the course of litigation, Mr. Tormasi learned that in 2008, ADS had entered an "inoperative and void" status. *See* A.A. 76 (Motion to Dismiss). In April 2019, WDC moved to dismiss Mr. Tormasi's suit for lack of standing and capacity to sue. A.A. 56–86. In November 2019, the District Court issued its Order, finding that Mr. Tormasi lacked capacity to sue, but did not "reach the standing issue." *Tormasi*, 2019 WL 6218784, at *2.

DISCUSSION

I. Standard of Review and Legal Standard

"We apply regional circuit law to the review of motions to dismiss for failure to state a claim under [FRCP] 12(b)(6)," *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 610 (Fed. Cir. 2016) (citation omitted), here, the Ninth Circuit.[5] The Ninth Circuit reviews a district court's decision to grant a motion to dismiss under FRCP 12(b)(6) de novo. *See Fayer v. Vaughn*, 649 F.3d 1061, 1063–64 (9th Cir. 2011). To survive a motion to dismiss for failure to state a claim, a complaint must allege "enough facts to state a claim to relief that is plausible on its face."

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[5] FRCP 12(b)(6) provides that a party may assert by motion a defense of "failure to state a claim upon which relief can be granted." FED. R. CIV. P. 12(b)(6).

Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007). "While legal conclusions can provide the complaint's framework, they must be supported by factual allegations." *Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009).

We "review[] questions of law, including . . . capacity to sue under [FRCP] 17(b), without deference." *Paradise Creations, Inc. v. UV Sales, Inc.*, 315 F.3d 1304, 1307 (Fed. Cir. 2003) (citation omitted); *see Johns v. Cty. of San Diego*, 114 F.3d 874, 877 (9th Cir. 1997) (reviewing a district court's decision as to "[a]n individual's capacity to sue" de novo). "Capacity to sue in federal district court is governed by [FRCP] 17(b)." *See S. Cal. Darts Ass'n v. Zaffina*, 762 F.3d 921, 926 (9th Cir. 2014). Under this rule, an individual's capacity to sue is determined by "the law of the individual's domicile." FED. R. CIV. P. 17(b)(1). In New Jersey, "[e]very person who has reached the age of majority . . . and has the mental capacity may prosecute or defend any action in any court." N.J. STAT. ANN. § 2A:15-1 (2013). New Jersey inmates are further governed by New Jersey Administrative Code Title 10A ("Title 10A"), *see Tormasi v. Hayman*, No. CIVA08-5886(JAP), 2009 WL 1687670, at *8 (D.N.J. June 16, 2009), which sets forth regulations governing, inter alia, adult inmates in New Jersey's prisons, *see* N.J. ADMIN. CODE § 10A:1-2.1 ("N.J.A.C. 10A:1 through 10A:30 shall be applicable to State correctional facilities under the jurisdiction of the Department of Corrections"). For instance, under Title 10A, the "no business" rule provides that "commencing or operating a business or group for profit . . . without the approval of the Administrator" is a prohibited act. *Id.* § 10A:4-4.1(a)(3)(xix).

II. The District Court Did Not Err in Dismissing Mr. Tormasi's Complaint for Lack of Capacity to Sue

The District Court concluded that "because New Jersey law prevents inmates from 'commencing or operating a business or group for profit . . . without the approval of the Administrator,'" Mr. Tormasi lacked capacity to sue WDC

for patent infringement. *Tormasi*, 2019 WL 6218784, at *2 (quoting N.J. ADMIN. CODE § 10A:4-4.1(a)(3)(xix)). Mr. Tormasi argues "that the [D]istrict [C]ourt erred by relying on the [no-business rule]." Appellant's Br. 31. Mr. Tormasi asserts that his lawsuit "cannot be construed as an unpermitted business activity" because it "seeks to enforce his personal intellectual-property rights."[6] *Id.* at 31–32. We disagree.

Mr. Tormasi's attempt to file this lawsuit as a personal action merely repackages his previous business objectives as personal activities so he may sidestep the "no business" regulation. Because these actions are a mere continuation of his prior business activities, we find that here, as in Mr. Tormasi's previous lawsuit, Mr. Tormasi's characterization of his suit as personal, as opposed to related to business, to be without merit. *Tormasi v. Hayman*, 443 F. App'x 742 (3d Cir. 2011). Mr. Tormasi is an inmate domiciled in New Jersey. A.A. 133. As such, New Jersey law applies in determining Mr. Tormasi's capacity to sue. *See* FED. R. CIV. P. 17(b)(1) (providing that "[c]apacity to sue . . . is determined . . . by the law of the individual's domicile"). While Mr. Tormasi contends that his capacity to sue is

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[6] Mr. Tormasi briefly asserts in his reply brief that he had the Administrator's "express or implied" approval to procced with his patent infringement suit. Appellant's Reply 19–20. He did not raise this argument in his opening brief or before the District Court. *See generally* Appellant's Br. 31–39; A.A. 109–44 (Opposition to Motion to Dismiss). Thus, Mr. Tormasi's argument is waived. *See Bozeman Fin. LLC v. Fed. Reserve Bank of Atlanta*, 955 F.3d 971, 974 (Fed. Cir. 2020) ("[A]rguments not raised in an appellant's opening brief [are] waived absent exceptional circumstances."); *Game & Tech. Co. v. Wargaming Grp. Ltd.*, 942 F.3d 1343, 1350–51 (Fed. Cir. 2019) (declining to consider a new argument raised for the first time on appeal).

solely determined by N.J. STAT. ANN. § 2A:15-1, *see* Appellant's Reply 14, which pertains to legal majority and mental capacity, *see* N.J. STAT. ANN. § 2A:15-1, "[l]awful incarceration brings about the necessary withdrawal or limitation of many privileges and rights, a retraction justified by the considerations underlying our penal system[,]" *Price v. Johnston*, 334 U.S. 266, 285 (1948), *abrogated on other grounds by McCleskey v. Zant*, 499 U.S. 467 (1991). Mr. Tormasi is an inmate at a New Jersey prison, subject to Title 10A, which prohibits him from operating a business. N.J. ADMIN. CODE § 10A:4-4.1(a)(3)(xix). Therefore, the "no business" rule is applicable to Mr. Tormasi.[7]

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[7] On appeal, Mr. Tormasi argues that even if he violated the "no business" rule, it does not limit the scope of N.J. STAT. ANN. § 2A:15-1 for inmates. Appellant's Br. 32–33, 36–38. Mr. Tormasi did not, however, argue to the District Court that the "no business" rule cannot generally limit the scope of an inmate's capacity to sue. *See generally* A.A. 109–44. The argument is, accordingly, waived, and Mr. Tormasi has therefore conceded that the no business rule may limit his capacity to sue. *See Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1296 (Fed. Cir. 2009) ("If a party fails to raise an argument before the trial court, or presents only a skeletal or undeveloped argument to the trial court, we may deem that argument waived on appeal[.]")); *see also Sage Prods. Inc. v. Devon Indus.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) ("[A]ppellate courts do not consider a party's new theories, lodged first on appeal."). The Dissent takes issue with this conclusion, understanding Mr. Tormasi to have preserved his argument by asserting below that the "no business" rule "'was never intended to supersede [his] right to file civil lawsuits in his personal capacity,'" but rather "that his capacity to sue is governed by § 2A:15-1, which requires only that he has 'reached the age of majority' and possesses 'mental capacity,'" leaving

Mr. Tormasi's counterargument that he has not violated the no business rule is unpersuasive. For example, we find the Third Circuit's reasoning persuasive, that Mr. Tormasi's unfiled patent application qualified as "commencing or operating a business or group for profit," as it was in furtherance of his intellectual property business. *See Tormasi*, 443 F. App'x at 745; *see also Stanton v. New Jersey Dep't of Corr.*, No. A-1126-16T1, 2018 WL 4516151, at *4 (N.J. Super. Ct. App. Div. Sept. 21, 2018), *cert. denied*, 218 A.3d 305 (N.J. 2019) (concluding that an inmate violated the "no business" rule by attempting to operate a publishing company). Here similarly, Mr. Tormasi's lawsuit is in furtherance of his intellectual property business by taking certain business actions purely to preserve the commercial value of his intellectual property. *See* A.A. 134. For instance, Mr. Tormasi asserts that he took "precautionary measures to ensure that [his] intellectual property remained *enforceable*, *licensable*, and *sellable* to the *fullest extent possible*." A.A. 136 (emphasis added). Mr. Tormasi

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his "'imprisonment status or prison behavior . . . irrelevant to the capacity-to-sue standard.'" Dissent Op. 1–2 (quoting A.A. 123–24 (Opp'n to Mot. to Dismiss)). We disagree. Mr. Tormasi made these assertions in support of his argument that the "no business" rule would run afoul of the First and Fourteenth Amendments if the "no business" rule prevented him from filing suit while imprisoned, not whether the N.J. statute superseded the "no business" rule. A.A. 122, 125. The first time that Mr. Tormasi argues that "administrative regulations cannot supersede statutes," is on appeal, Appellant's Br. 32, where he also abandons his constitutional argument, Appellant's Reply 15–16. Moreover, Mr. Tormasi does not attempt to rebut WDC's waiver argument in his Reply. Appellant's Reply 15–16. Thus, Mr. Tormasi has not preserved his legal argument, and we need not decide whether Mr. Tormasi's newly proposed interpretation of the regulation is correct.

further asserts that "[t]he purpose of [one of his] transfer[s] in ownership was to permit [himself] to . . . personally benefit from, an infringement action against WDC and other entities." A.A. 136. Mr. Tormasi then sued WDC for infringing the '301 patent and sought damages of at least $5 billion. A.A. 24. Accordingly, Mr. Tormasi's patent infringement suit is in furtherance of operating an intellectual property business for profit, and, therefore, prohibited under the "no business" rule. N.J. ADMIN. CODE § 10A:4-4.1(a)(3)(xix); *see generally Tormasi*, 443 F. App'x at 742 (finding that an unfiled patent application qualified as a prohibited act under the New Jersey "no business" rule). Because New Jersey prohibits inmates from pursuing a business, N.J. ADMIN. CODE § 10A:4-4.1(a)(3)(xix), and because of Mr. Tormasi's repeated attempts to profit as a business from the patent, *see Tormasi*, 443 F. App'x at 742 (finding Mr. Tormasi's attempt to file a patent application qualified as operating a business for profit),[8] the District Court did not err when it determined that Mr. Tormasi

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[8] The Dissent concludes that our "extension of the Third Circuit's reasoning to affirm the district court's holding that Mr. Tormasi lacks capacity to sue in this case is inappropriate given the facts of this case[,]" as "the present lawsuit involves only Mr. Tormasi's claim for alleged patent infringement, the Third Circuit's decision . . . , and the 'no business' rule should not be at issue at all." Dissent Op. 3. To the contrary, we do not cite to the Third Circuit's decision for the conclusion that Mr. Tormasi lacks capacity to sue, we cite it to demonstrate that Mr. Tormasi's patent lawsuit is in furtherance of his intellectual property business and that business violates the "no business" rule. *See Tormasi*, 443 F. App'x at 742, 745. Accordingly, it is appropriate for us to cite to the Third Circuit's decision to establish that Mr. Tormasi's conduct violated the "no business" rule. *See id.* (determining what conduct and activity constituted a violation of the "no business" rule).

lacked the capacity to bring this suit for patent infringement.[9]

CONCLUSION

We have considered Mr. Tormasi's other arguments and each of the remaining issues raised on appeal, and find them to be without merit.[10] Accordingly, the Order of the U.S. District Court for the Northern District of California, is

AFFIRMED

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[9] It is conceivable that Mr. Tormasi might, in the future, attain capacity to sue, but under the circumstances of this case, the District Court did not err in concluding that he does not presently possess that capacity.

[10] Mr. Tormasi argues that the District Court erred by dismissing his Complaint for lack of capacity to sue without first considering whether "the threshold standing/jurisdictional issue is resolved in his favor." Appellant's Br. 2. However, the actual issue raised by Mr. Tormasi is whether the District Court erred by not first determining if he met the "statutory prerequisite" of 35 U.S.C. § 281 (providing that "[a] *patentee* shall have remedy by civil action for infringement of his patent" (emphasis added)). Because capacity to sue is a threshold question, which the District Court determined, the District Court did not err by not reaching the question of whether Mr. Tormasi was a patentee under § 281, as it became moot. *Katz v. Lear Siegler, Inc.*, 909 F.2d 1459, 1463 (Fed. Cir. 1990) (finding that "it was necessary to resolve the threshold question of . . . capacity to sue").

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

WALTER A. TORMASI,
Plaintiff-Appellant

v.

WESTERN DIGITAL CORPORATION,
Defendant-Appellee

2020-1265

Appeal from the United States District Court for the Northern District of California in No. 4:19-cv-00772-HSG, Judge Haywood S. Gilliam, Jr.

STOLL, *Circuit Judge*, dissenting.

I respectfully dissent because I disagree with the majority that Mr. Tormasi waived his argument that the "no business" rule does not limit the scope of an inmate's capacity to sue under N.J. STAT. ANN. § 2A:15-1 (2013). *See* Maj. 8 n.7. To the contrary, in his briefing to the district court, Mr. Tormasi asserted that the "no business" rule "was never intended to supersede [his] right to file civil lawsuits in his personal capacity." A.A. 123. Mr. Tormasi further explained that his capacity to sue is governed by § 2A:15-1, which requires only that he has "reached the age of majority" and possesses "mental capacity." A.A. 124.

(quoting § 2A:15-1). Mr. Tormasi added that his "imprisonment status or prison behavior is irrelevant to the capacity-to-sue standard." *Id.* (citing § 2A:15-1). In my view, these assertions fairly preserved Mr. Tormasi's legal argument that the "no business" rule cannot generally limit the scope of an inmate's capacity to sue, especially in view of the fact that he is a pro se litigant. *See McZeal v. Sprint Nextel Corp.*, 501 F.3d 1354, 1356 (Fed. Cir. 2007) ("Where, as here, a party appeared pro se before the trial court, the reviewing court may grant the pro se litigant leeway on procedural matters . . . ." (italics removed)).

Indeed, Mr. Tormasi makes an important legal argument that the district court should have addressed in the first instance. It makes little sense to narrow the New Jersey statute on capacity to sue in light of the "no business" rule, which is an administrative rule of the Department of Corrections that prescribes sanctions for certain "prohibited acts." N.J. ADMIN. CODE § 10A:4-4.1(a) (2019). Under this "no business" rule, the prohibited act of "commencing or operating a business or group for profit . . . without the approval of the Administrator" is subject to "a sanction of no less than 31 days and no more than 90 days of administrative segregation," *id.* § 10A:4-4.1(a)(3), as well as one or more of the sanctions listed at section 10A:4-5.1(i–j) of the New Jersey Administrative Code, which includes loss of correctional facility privileges, loss of commutation time, loss of furlough privileges, confinement, On-The-Spot Correction, confiscation, extra duty, or a referral of an inmate to the Mental Health Unit for appropriate care or treatment. On its face, the "no business" rule does not include the loss of the capacity to sue as a punishment. And, as Mr. Tormasi further noted in his briefing to the district court, limiting the capacity to sue statute based on the "no business" rule is inconsistent with another section of the same administrative code, which expressly provides that "[i]nmates have [the] constitutional right of access to the

courts." A.A. 123 (alterations in original) (quoting N.J. ADMIN. CODE § 10A:6-2.1).

The majority relies heavily on *Tormasi v. Hayman*, 443 F. App'x 742 (3d Cir. 2011), an earlier case also involving Mr. Tormasi, in which Mr. Tormasi asserted that his constitutional rights were violated when prison officials confiscated his unfiled patent application under the "no business" rule. Rejecting Mr. Tormasi's argument that the "no business" rule did not apply to patent applications, the Third Circuit concluded that confiscation was a permissible punishment because Mr. Tormasi's intent to assign the patent application to his own corporate entity for selling or licensing purposes qualified as a violation of the "no business" rule. *Id.* at 745. As noted above, confiscation is one of the prescribed punishments for a violation of the "no business" rule. *See* N.J. ADMIN. CODE § 10A:4-5.1(i)(6). The majority's extension of the Third Circuit's reasoning to affirm the district court's holding that Mr. Tormasi lacks capacity to sue in this case is inappropriate given the facts of this case. *See* Maj. 7–10. Prison officials never enforced any disciplinary action or sanction under the "no business" rule against Mr. Tormasi; nor does Mr. Tormasi challenge any such action. Because the present lawsuit involves only Mr. Tormasi's claim for alleged patent infringement, the Third Circuit's decision in *Tormasi*, 443 F. App'x 742, and the "no business" rule should not be at issue at all. I respectfully dissent.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

WALTER A. TORMASI,

Plaintiff,

v.

WESTERN DIGITAL CORP.,

Defendant.

Case No. 19-cv-00772-HSG

ORDER GRANTING DEFENDANT'S MOTION TO DISMISS

Re: Dkt. Nos. 19, 27, 24, 29

Pending before the Court is Defendant Western Digital Corporation's motion to dismiss. Dkt. No. 19. Defendant argues that Plaintiff Walter A. Tormasi lacks standing to bring suit because he does not hold title to United States Patent Nos. 7,324,301 ("the '301 Patent") and lacks capacity to sue because he is an inmate prohibited from conducting business. Defendant also argues that Plaintiff fails to plausibly allege willful patent infringement. For the reasons explained below, the Court **GRANTS** the motion.

I. BACKGROUND

Plaintiff filed this action on February 12, 2019, alleging infringement of the '301 Patent. Dkt. No. 1 ("Compl."). The '301 Patent is titled "Striping Data Simultaneously Across Multiple Platter Surfaces" and "pertains to the field of magnetic storage and retrieval of digital information." *Id.* ¶ 1, Ex. C.

Independent claim 41 describes:

> 41. An **actuator mechanism,** said mechanism comprising at least two arms, said arms assigned to different circular carrier surfaces within an information storage and retrieval apparatus; and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to said carrier surfaces.

Id. Ex. C. at 12:5–11. Numerous claims depend from Claim 41, including, as relevant here Claim 61:

> 61. The mechanism of claim 41 wherein said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial positions; and in its operative mode, said secondary actuators execute means for providing precise independent secondary position by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

Id. Ex. C. at 12:61–13:9. Nine claims depend from Claim 61 and add further limitations such as (1) "wherein said secondary actuators are microactuators" (Claim 62) and (2) "wherein secondary actuators are microelectromechanisms" (Claim 63). *Id.* Ex. C. at 13:10–13. Plaintiff alleges that "Defendant manufactures, markets, sells, distributes and/or imports hard disk drives . . . containing dual-stage actuator systems comprising primary and secondary actuation devices," which "feature every structural element and limitation of claims 41, 61, 62, and 63" of the '301 Patent. *Id.* ¶ 21, 26.

On April 25, 2019, Defendant filed the pending motion to dismiss, for which briefing is complete. Dkt. No. 19 ("Mot."), 23 ("Opp."), and 26 ("Reply"). Plaintiff filed a related administrative motion for nunc pro tunc objection to evidence in Defendant's Reply, Dkt. No. 27, and a motion to strike Defendant's response to Plaintiff's administrative motion, Dkt. No. 29.

II. LEGAL STANDARD

Federal Rule of Civil Procedure 8(a) requires that a complaint contain "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). A defendant may move to dismiss a complaint for failing to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6). "Dismissal under Rule 12(b)(6) is appropriate only where the complaint lacks a cognizable legal theory or sufficient facts to support a cognizable legal theory." *Mendiondo v. Centinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th Cir. 2008). To survive a Rule 12(b)(6) motion, a plaintiff must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when a plaintiff pleads "factual content that allows the court to draw

the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

In reviewing the plausibility of a complaint, courts "accept factual allegations in the complaint as true and construe the pleadings in the light most favorable to the nonmoving party." *Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008). Nonetheless, Courts do not "accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences." *In re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir. 2008) (quoting *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001)). Even if the court concludes that a 12(b)(6) motion should be granted, the "court should grant leave to amend even if no request to amend the pleading was made, unless it determines that the pleading could not possibly be cured by the allegation of other facts." *Lopez v. Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc) (quotation omitted).

III. ANALYSIS

Defendant argues that Plaintiff lacks standing to bring suit because he does not hold title to the '301 Patent and lacks capacity to sue because he is prohibited from operating a business since he is an inmate in the New Jersey Department of Corrections. Mot. at 12–19. The Court need not reach the standing issue, since even if Plaintiff does have standing to assert these claims (which the Court does not now decide), Plaintiff lacks capacity to sue.

An individual's capacity to sue is determined "by the law of the individual's domicile." Fed. R. Civ. P. 17(b). Plaintiff is domiciled in New Jersey. Defendant argues that because New Jersey law prevents inmates from "commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator," Plaintiff lacks capacity to bring this patent infringement suit. N.J. Admin. Code § 10A:4-4.1(.705). The Court agrees.

Plaintiff argues that his personal right to access the courts is at issue, and that the New Jersey regulation cannot "supersede Plaintiff's right to file civil lawsuits in his personal capacity." Opp. at 11. However, Plaintiff's case materials and previous cases makes clear that what underlies this case is his purported right to conduct business, not his access to the courts. *See* Dkt. No. 1 ¶ 1

("Plaintiff is an innovator and entrepreneur"); Dkt. No. 23-1 at ¶ 14–15 (detailing that after being sanctioned for "operating [his company, Advanced Data Solutions Corp. ("ADS"),] without administrative approval," Tormasi did not cease such activities, but instead engaged in "ownership-transferring contingencies" to continue as a sole proprietor). *See also Tormasi v. Hayman*, 443 F. App'x 742, 745 (3d Cir. 2011) (holding that there was no 42 U.S.C. § 1983 violation because Tormasi's confiscated patent application "f[ell] within the ambit of" prohibited business activities).

That Plaintiff has filed this patent infringement case without ADS does not change this reality. Plaintiff previously represented that because he assigned ADS all of his interest in the patent, "he was 'unable to directly or indirectly benefit from his intellectual-property assets, either by selling all or part of ADS; by exclusively or non-exclusively licensing [the] patent to others; by using ADS or [the] patent as collateral for obtaining personal loans or standby letters of credit; or by engaging in other monetization transactions involving ADS or its intellectual-property assets." *Tormasi*, 443 F. App'x at 745. Thus, Plaintiff argued that he was not running afoul the New Jersey regulation for conducting business. *Id.* Now, however, Plaintiff includes an "Assignment of U.S. Patent No. 7,324,301" assigning "all right, title, and interest" in the '301 Patent from ADS back to him. Dkt. No. 1-1. This contradicts his previous representation, and suggests that he may now directly benefit from his patent assets. Indeed, this appears to be exactly what he seeks to do in this case by monetizing his patents and obtaining $5 billion in compensatory damages for patent infringement, in contravention of the New Jersey regulations. "Lawful incarceration brings about the necessary withdrawal or limitation of many privileges and rights, a retraction justified by the considerations underlying our penal system." *Stroud v. Swope*, 187 F.2d 850, 851 (9th Cir. 1951) (quoting *Price v. Johnston*, 334 U.S. 266, 285 (1948)). While the Fourteenth Amendment protects the right of access to the courts, *see Bounds v. Smith*, 430 U.S. 817, 828 (1977), it does not guarantee the right to freely conduct business, *see Stroud*, 187 F.2d at 851.[1] Accordingly, the

[1] Tormasi also cites the First Amendment as guaranteeing access to the courts. This right of access, however, does not grant "inmates the wherewithal to transform themselves into litigating engines capable of filing everything," but rather is limited to cases in which inmates "attack their sentences, directly or collaterally, and . . . challenge the conditions of their confinement. Impairment of any other litigating capacity is simply one of the incidental (and perfectly

Court finds that Plaintiff, as an inmate of the New Jersey Department of Corrections, lacks the capacity to sue for patent infringement.[2]

IV. CONCLUSION

Because Plaintiff lacks capacity to sue under Rule 17(b), the Court **GRANTS** Defendant's motion to dismiss with prejudice. As noted above, the Court **DENIES AS MOOT** docket numbers 27 and 29. The Court additionally **DENIES** docket number 24 and the clerk is directed to terminate the case.

IT IS SO ORDERED.

Dated: 11/21/2019

HAYWOOD S. GILLIAM, JR.
United States District Judge

constitutional) consequences of conviction and incarceration." *Lewis v. Casey*, 518 U.S. 343, 355 (1996); *see also Tormasi*, 443 F. App'x at 744 n.3.

[2] The Court need not reach Defendant's arguments that the complaint should be dismissed for failure to plausibly plead willful infringement or indirect infringement under Rule 12(b)(6). Mot. at 19–23.

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

WALTER A. TORMASI,
Plaintiff-Appellant

v.

WESTERN DIGITAL CORPORATION,
Defendant-Appellee

2020-1265

Appeal from the United States District Court for the Northern District of California in No. 4:19-cv-00772-HSG, Judge Haywood S. Gilliam, Jr.

ON PETITION FOR PANEL REHEARING AND REHEARING EN BANC

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK, MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

O R D E R

Appellant Walter A. Tormasi filed a combined petition for panel rehearing and rehearing en banc. The petition

was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on November 10, 2020.

FOR THE COURT

November 3, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

US007324301B2

(12) **United States Patent**
Tormasi

(10) **Patent No.: US 7,324,301 B2**
(45) **Date of Patent: Jan. 29, 2008**

(54) **STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES**

(75) Inventor: **Walter A. Tormasi**, Somerville, NJ (US)

(73) Assignee: **Advanced Data Solutions Corp.**, Somerville, NJ (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 127 days.

(21) Appl. No.: **11/031,878**

(22) Filed: **Jan. 10, 2005**

(65) **Prior Publication Data**

US 2005/0243661 A1 Nov. 3, 2005

Related U.S. Application Data

(60) Provisional application No. 60/568,346, filed on May 3, 2004.

(51) **Int. Cl.**
G11B 5/596 (2006.01)

(52) **U.S. Cl.** **360/78.12**

(58) **Field of Classification Search** 360/55, 360/75, 53, 63, 51, 31, 66, 46, 68, 121, 264.4, 360/61, 78.04, 77.08, 78.12
See application file for complete search history.

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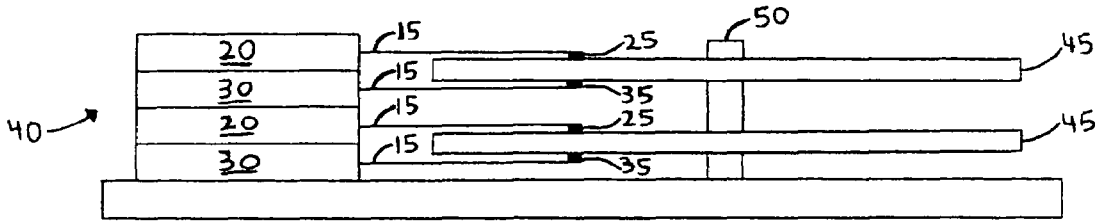
Primary Examiner—Fred F. Tzeng
(74) *Attorney, Agent, or Firm*—Sperry, Zoda & Kane

(57) **ABSTRACT**

A hard disk drive comprises an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. The drive also comprises one or more platters aggregating two or more platter surfaces whereupon data may be read from or written to by corresponding read/write heads. The independent-arm actuator and custom printed circuit board enable alternate or interleaving bits or blocks of data to be read or written simultaneously across a plurality of platter surfaces within the same physical drive.

77 Claims, 1 Drawing Sheet



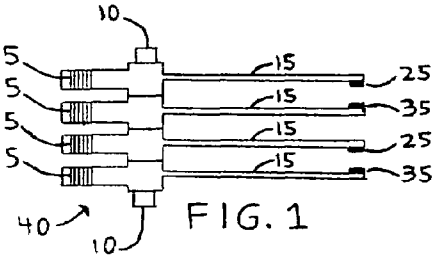


FIG. 1

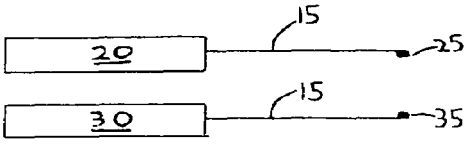


FIG. 2

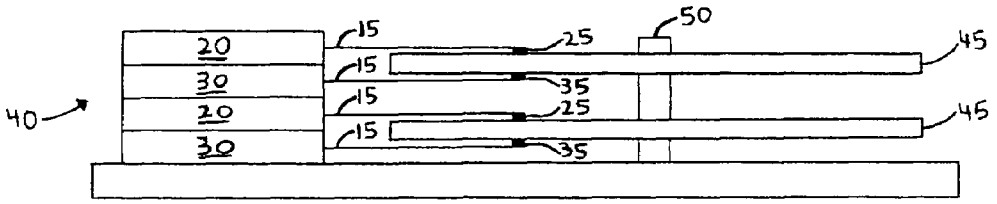


FIG. 3

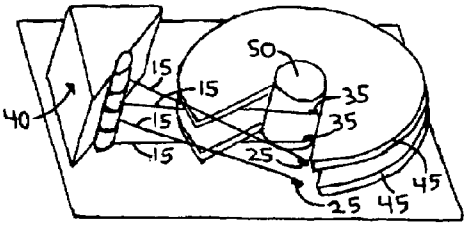


FIG. 4

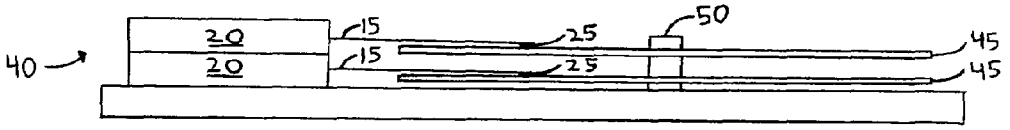


FIG. 5

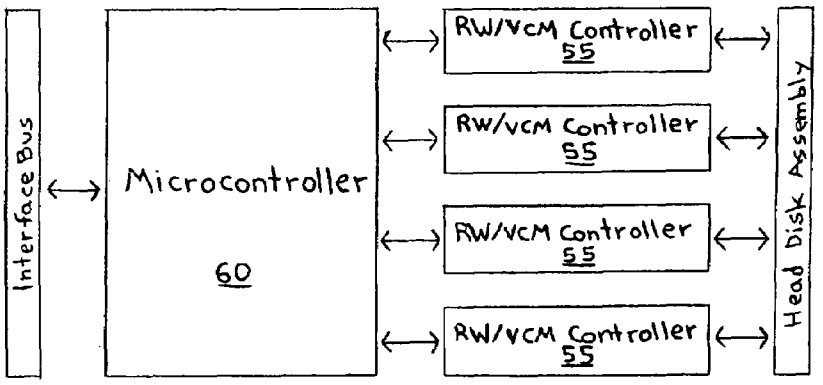


FIG. 6

STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES

CROSS-REFERENCE TO RELATED APPLICATIONS

This patent claims priority to U.S. Provisional Patent Application No. 60/568,346, said provisional application filed with the United States Patent and Trademark Office in Washington, D.C., on May 3, 2004.

FIELD OF THE INVENTION

The invention herein relates to the art of dynamically storing and retrieving information using nonvolatile magnetic random-access media, specifically hard disk drives or the like. In particular, the invention is directed toward increasing the read/write speed of a hard drive by striping data simultaneously across multiple platter surfaces within the same physical drive, thereby permitting high-speed parallel storage and retrieval of digital information.

BACKGROUND OF THE INVENTION

By way of background, the basic operation or construction of a hard disk drive has not changed materially since its introduction in the 1950s, although various individual components have since been improved or optimized. Hard drives typically contain one or more double-sided platters. These platters are mounted vertically on a common axle and rotated at a constant angular velocity by a spindle motor. During physical low-level formatting, the recording media are divided into tracks, which are single lines of concentric circles. There is a similar arrangement of tracks on each platter surface, with each vertical group of quasi-aligned tracks constituting separate cylinders. Each track is divided into sectors, which are arc-shaped segments having a defined data capacity.

Under the current iteration, each platter surface features a corresponding giant-magnetoresistive (GMR) read/write head, with the heads singly or dually attached by separate arms to a rotary voice-coil actuator. The arms are pivotably mounted to a vertical actuator shaft and connected to the shaft through a common carrier device. The common carrier device, or rack, functions as a single-movement mechanism, or comb. This actuator design physically prevents the arms from moving independently and only allows the arms to move radially across the platter surfaces in unison. As a consequence, the read/write heads are unable to simultaneously occupy different tracks or cylinders on separate platter surfaces.

A rotary actuator unitarily rotates its arms to particular tracks or cylinders using an electromagnetic voice-coil-motor system. In a typical voice-coil-motor system, an electromagnetic coil is affixed to the base of the head rack, with a stationary magnet positioned adjacent to the coil fixture. Actuation of the carrier device is accomplished by applying various magnitudes of current to the electromagnetic coil. In response to the application of current, the coil attracts or repels the stationary magnet through resulting electromagnetic forces. This action causes the arms to pivot unitarily along the axis of the actuator shaft and rotate radially across corresponding platter surfaces to particular tracks or cylinders.

A head disk assembly (HDA) houses the platters, spindle motor, and actuator mechanism. The head disk assembly is a sealed compartment containing an air-filtration system

comprising barometric and recirculation filters. The primary purpose of the head disk assembly is to provide a substantially contamination-free environment for proper drive operation.

The electronic architecture of the drive is contained on a printed circuit board, which is mounted to the drive chassis below the head disk assembly. The printed circuit board contains an integrated microcontroller, read/write (RW) controller, voice-coil-motor (VCM) controller, and other standard logic circuits and auxiliary chips. The microcontroller, RW controller, and VCM controller are typically application-specific integrated circuits, or ASICs, that perform a multitude of functions in cooperation with one another. The RW controller, for example, is connected to the read/write heads (through write-driver and preamplification circuitry) and is responsible for processing and executing read or write commands. The VCM controller is connected to the actuator mechanism (through the electromagnetic coil) and is responsible for manipulating and positioning the actuator arms during read or write operations. The microcontroller is interconnected to the foregoing circuitry and is generally responsible for providing supervisory and substantive processing services to the RW and VCM controllers under the direction of firmware located on an integrated or separate EEPROM memory chip.

Although industry standards exist, drive manufacturers generally implement custom logic configurations for different hard-drive product lines. Accordingly, notwithstanding the prevalent use of extendible core electronic architecture and common firmware and ASICs, such custom logic configurations prevent printed circuit boards from being substituted within drives across different brands or models.

Cylinders and tracks are numbered from the circumference of the platters toward the center beginning with 0. Heads and platter surfaces are numbered from the bottom head or platter surface toward the top, also beginning with 0. Sectors are numbered from the start of each track toward the end beginning with 1, with the sectors in different tracks numbered anew using the same logical pattern.

Although it is often stated that tracks within respective cylinders are aligned vertically, tracks within each cylinder are actually not aligned with such precision as to render them completely perpendicular. This vertical misalignment of the tracks occurs as a result of imprecise servo writing, latitudinal formatting differences, mechanical hysteresis, nonuniform thermal expansion and contraction of the platters, and other factors. Because these causes of track misalignment are especially influential given the high track densities of current drives, tracks are unlikely to be exactly vertically aligned within a particular cylinder. From a technical standpoint, then, it can accurately be stated that tracks within a cylinder are quasi-aligned; that is, different tracks within a cylinder can be accessed sequentially by the read/write heads without substantial radial movement of the carrier device, but, it follows, some radial movement (usually several microns) is frequently required.

As a result of its common-carrier and single-coil actuator design, core electronic architecture, and vertical track-alignment discrepancy, current drive configurations prevent data from being written simultaneously to different tracks within identical or separate cylinders. In contrast, current drives write data sequentially in a successive pattern generally giving preference to the lowest cylinder, head, and sector numbers. Pursuant to this pattern, for example, data are written sequentially to progressively ascending head and sector numbers within the lowest available cylinder number until that cylinder is filled, in which case the process begins

anew starting with the first head and sector numbers within the next adjacent cylinder. Because tracks within a given cylinder are quasi-aligned, this pattern has the primary effect of reducing the seek time required by the read/write heads for sequentially accessing successive data.

Hard disk-drives occupy a pivotal role in computer operation, providing a reliable means for nonvolatile storage and retrieval of crucial data. To date, while areal density (gigabits per square inch) continues to grow rapidly, increases in data transfer rates (megabytes per second) have remained relatively modest. Hard drives are currently as much as 100 times slower than random-access memory and 1000 times slower than processor on-die cache memory. Within the context of computer operation, these factors present a well-recognized dilemma: In a world of multi-gigahertz microprocessors and double-data-rate memory, hard drives constitute a major bottleneck in data transportation and processing, thus severely limiting overall computer performance.

One solution to increase the read/write speed of disk storage is to install two or more hard drives as a Redundant Array of Independent Disks, or RAID, using a Level 0 specification, as defined and adopted by the RAID Advisory Board. RAID **0** distributes data across two or more hard drives via striping. In a two-drive RAID **0** array, for example, the striping process entails writing one bit or block of data to one drive, the next bit or block to the other drive, the third bit or block to the first drive, and so on, with data being written to the respective drives simultaneously. Because half as much data is being written to (and subsequently accessed from) two drives simultaneously, RAID **0** doubles potential data transfer rates in a two-drive array. Further increases in potential data transfer rates generally scale proportionally higher with the inclusion into the array of additional drives.

Traditional RAID **0**, however, presents numerous disadvantages over standard single-drive configurations. Since RAID **0** employs two or more separate drives, its implementation doubles or multiplies correspondingly the probability of sustaining a drive failure. Its implementation also increases to the same degree the amount of power consumption, space displacement, weight occupation, noise generation, heat production, and hardware costs as compared to ordinary single-drive configurations. Accordingly, RAID **0** is not suitable for use in laptop or notebook computers and is only employed in supercomputers, mainframes, storage subsystems, and high-end desktops, servers, and workstations.

SUMMARY OF THE INVENTION

It is an object of the invention to institute a single-drive striping configuration wherein the striping feature employed in RAID Level **0** is incorporated into a single physical hard disk drive (as opposed to two or more separate drives) through the use of particular embodiments and modes of implementation, operation, and configuration. By incorporating the striping feature into a single physical drive, it is an object of the invention to dramatically increase the read/write speed of the drive without suffering miscellaneous disadvantages customarily associated with traditional multi-drive RAID **0** implementation.

In particular, the invention as embodied consists of a hard disk drive comprising an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. The drive also comprises one or more platters aggregating two or more platter surfaces whereupon data may be read from or written to by corresponding read/write heads. As explained in detail below, the independent-arm actuator and custom printed circuit board enable alternate or interleaving bits or blocks of data to be read or written simultaneously across a plurality of platter surfaces within the same physical drive, thereby accomplishing the primary objects of the invention.

Other objects and aspects of the invention will in part become obvious and will in part appear hereinafter. The invention thus comprises the apparatuses, mechanisms, and systems in conjunction with their parts, elements, and interrelationships that are exemplified in the disclosure and that are defined in scope by the respective claims.

BRIEF DESCRIPTION OF THE DRAWINGS

Six drawings accompany this patent. These drawings inclusively illustrate miscellaneous aspects of the invention and are intended to complement the disclosure by providing a fuller understanding of the invention and its constituents.

FIG. **1** depicts a side view of the internal components of an independent-arm actuator mechanism.

FIG. **2** depicts a side view of two one-arm actuators that compose an independent-arm actuator mechanism.

FIG. **3** depicts a side view of a head disk assembly containing an independent-arm actuator mechanism and two disk platters.

FIG. **4** depicts a perspective view of the head disk assembly featured in the previous figure.

FIG. **5** depicts a side view of another embodiment of the independent-arm actuator mechanism.

FIG. **6** depicts a block diagram of a printed circuit board containing custom core electronic architecture.

DETAILED DESCRIPTION OF THE INVENTION

As noted above, in order to effectuate the single-drive striping configuration, the invention embodies the utilization of an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. These and other aspects of the invention are discussed in detail below, as well as particular modes of implementation, operation, and configuration.

Turning now to specific aspects of the invention, the independent-arm actuator features numerous distinct characteristics. In contrast to conventional actuator design, the arms to the independent-arm actuator are connected to one and the same actuator shaft through independent carrier devices. Separate electromagnetic coils are affixed within the proximity of the base of each arm, with one or more stationary magnets positioned between each coil fixture. The independent carrier devices and separate electromagnetic coils function collectively as a multi-movement mechanism. This multi-movement mechanism allows the arms to move radially across corresponding platter surfaces independently (as opposed to unitarily or in unison) and permits each read/write head to simultaneously occupy different tracks or cylinders on separate platter surfaces.

FIG. **1** depicts a side view of the internal components of an independent-arm actuator mechanism. The actuator mechanism **40** comprises horizontally suspended arms **15** mounted separately (through independent carrier devices) to a vertical actuator shaft **10**. In accordance with the above embodiment, separate electromagnetic coils **5** are affixed to the base of each arm **15**, with one or more stationary magnets (not shown) positioned between each coil fixture **5**.

To the extent necessary, antimagnetic shielding (not shown) may be inserted between each coil fixture **5** to minimize or eliminate adjacent electromagnetic interference. Actual independent-arm actuation is accomplished by applying various magnitudes of current to the respective electromagnetic coils **5**. In response to the application of current, the coils **5** independently attract or repel the stationary magnet (s) through resulting electromagnetic forces. This action causes the arms **15** to pivot independently along the axis of the actuator shaft **10** and rotate radially across corresponding platter surfaces (not shown) to particular tracks or cylinders.

Although FIG. **1** depicts the electromagnetic coils **5** as being actual large-scale wire windings, each electromagnetic coil **5** instead features a substantially flat profile and a generally annular, triangular, square, or rectangular dimension. The stationary magnets (not shown) are similarly plate-shaped members, with each such member comprising permanent magnets and optional soft-magnetic elements. The antimagnetic shielding (not shown), which typically takes the form of foil or plates, may comprise mu metal (nickel-molybdenum-iron-copper) or its functional equivalent. As a substitute for antimagnetic shielding, however, adjacent electromagnetic interference may be reduced appreciably by placing the electromagnetic coils and/or stationary magnets in an antipodal configuration (i.e., opposite polar relationship).

As an alternative embodiment, the independent-arm actuator may comprise numerous individual one-arm actuators mounted vertically. This embodiment combines preexisting submechanisms in a unique manner never before suggested in combination. By combining individual one-arm actuators to form the independent-arm actuator mechanism, complexity of the actuator mechanism may be reduced appreciably, thereby resulting in lower potential development and production expenses being incurred by the manufacturer.

FIG. **2** depicts a side view of two individual one-arm actuators that compose an independent-arm actuator mechanism under the alternative embodiment. Whereas the top actuator **20** has its read/write head **25** facing south, the bottom actuator **30** has its read/write head **35** facing north. Both actuators **20**,**30** have substantially low-height form factors.

FIG. **3** depicts a side view of a head disk assembly for a hard drive containing two double-sided platters. The head disk assembly contains an independent-arm actuator mechanism **40** and two disk platters **45** affixed to an upright axle **50**. In accordance with the above embodiment, the independent-arm actuator **40** comprises four one-arm actuators **20**,**30** mounted vertically, with each one-arm actuator **20**,**30** assigned to different platter surfaces. Although the one-arm actuators **20**,**30** are depicted in the diagram as being separate and discrete submechanisms, it should be noted that the one-arm actuators may share the same mechanical housing, actuator shaft, stationary magnet, and other unifiable components.

FIG. **4** depicts a perspective view of the head disk assembly featured in the previous figure. To illustrate the independent nature of the actuator arms **15**, the diagram depicts each head **25**,**35** in substantially different radial positions.

FIG. **5** depicts a side view of another embodiment of the independent-arm actuator mechanism for a hard drive containing two single-sided platters. The diagram depicts an independent-arm actuator **40** comprising two one-arm actuators **20** mounted vertically. In contrast to the previous embodiment, the head **25** to each one-arm actuator **20** faces south, although a northern polarity may just as easily be employed. This actuator configuration is less preferable to the one specified previously but is nonetheless useful where the one-arm actuators cannot be accommodated within the height allocated to each platter surface. Such a situation may occur where the drive contains numerous platters that are vertically spaced in close proximity. This problem, however, may be corrected by reducing the number of platters within the drive in order to increase the vertical space between the platters.

As another embodiment, the independent-arm actuator may comprise a primary actuator mechanism and two or more secondary actuator mechanisms. Under this embodiment, the primary actuator mechanism is an ordinary single-movement device, whereas the secondary actuator mechanisms are subdevices such as microactuators or microelectromechanisms. The microactuators or microelectromechanisms are individually affixed to the tip of each primary actuator arm, with each microactuator or microelectromechanism supporting one read/write head. The primary actuator mechanism provides initial general positioning by unitarily moving the microactuators or microelectromechanisms to an approximate radial position, whereupon the microactuators or microelectromechanisms provide precise independent secondary positioning by independently moving the read/write heads to specific tracks on corresponding platter surfaces. This embodiment accomplishes independent-arm actuation and is particularly useful to effectively combat adjacent electromagnetic interference.

Pursuant to the foregoing embodiment, it is preferable that the secondary actuators (e.g., microactuators or microelectromechanisms) feature significant ranges of independent radial movement. In other words, each secondary actuator, for example, should preferably permit its read/write head to access 10,000 or more adjacent tracks on the respective platter surfaces. The secondary actuators, however, may permit their respective read/write heads to access a lesser number of adjacent tracks (e.g., 5000, 2500, 1000, 100, or 10) in accordance with the invention. These smaller ranges of independent radial movement are especially preferable where such radial restriction appreciably reduces the complexity of the secondary actuators.

The printed circuit board comprises integrated RW/VCM (i.e., read/write and voice-coil-motor) controllers and microcontroller circuitry. As embodied, each RW/VCM controller comprises read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating the respective electromagnetic coils to the independent-arm actuator mechanism and positioning the respective actuator arms during read or write operations. The microcontroller comprises an application-specific integrated circuit, or ASIC, that performs a multitude of functions, including providing supervisory and substantive processing services to each RW/VCM controller. The RW/VCM controllers and microcontroller constitute the core electronic architecture of the printed circuit board. The printed circuit board, however, also comprises peripheral electronic architecture such as an integrated EEPROM memory chip containing supporting device drivers, or firmware, as well as standard logic circuits and auxiliary chips used to control the spindle motor and other elementary components.

The number of RW/VCM controllers on the printed circuit board is equivalent to the number of arms composing the independent-arm actuator mechanism, with each RW/VCM controller assigned to different actuator arms. The integrated microcontroller is shared among the RW/VCM

controllers using separate data channels, with the microcontroller connected singly to an interface bus, preferably using an SATA, SCSI, or other prevailing high-performance interface standard. The remaining peripheral logic circuits and auxiliary chips may be connected using a variety of standard or custom configurations.

FIG. **6** depicts a block diagram of the aforementioned printed circuit board for a hard drive containing two double-sided platters. The diagram illustrates the core electronic architecture of the printed circuit board but omits peripheral electronic architecture to promote clarity. In accordance with the above embodiment, the printed circuit board comprises four RW/VCM controllers **55**, with each RW/VCM controller **55** assigned to common microcontroller circuitry **60** and different actuator arms (not shown). It should be noted that any electronic component on the printed circuit board may coexist either physically or logically or may be rearranged schematically, consolidated into a single multi-function chip, or replaced by software equivalents, among other things, as customarily occurs in an effort by manufacturers to simplify or optimize the electronic architecture of hard drives.

Similar to a RAID **0** controller or its software equivalent, the integrated microcontroller on the printed circuit board functions as an intermediary between a host system and the RW/VCM controllers. As embodied, the microcontroller intercepts read or write commands from the host system and responds pursuant to a predetermined shuffling algorithm. In executing write commands, the microcontroller apportions alternate or interleaving bits or blocks of data to each RW/VCM controller. In executing read commands, the above operation occurs in reverse sequence, with the microcontroller reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and transmitting the data to the host system in native sequential order.

The integrated RW/VCM controllers on the printed circuit board function as a massively parallel subsystem. In response to read or write commands issued by the microcontroller, each RW/VCM controller instructs its assigned actuator arm to perform the requested operation. Each RW/VCM controller and its corresponding actuator arm operate independently in relation to other similarly paired RW/VCM controllers and actuator arms. In reading or writing data, each RW/VCM controller causes its assigned actuator arm to read or write data across the respective platter surfaces, with all such read or write operations by the actuator arms occurring simultaneously in a parallel fashion.

The data that are read or written across each platter surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller. The result: Alternate or interleaving bits or blocks of data are read or written simultaneously across multiple platter surfaces within the drive. In a one-platter drive containing two platter surfaces, for example, one bit or block of data is written to (or read from) one platter surface, the next bit or block to the other platter surface, the third bit or block to the first platter surface, and so on, with data being written to (or read from) the respective platter surfaces simultaneously. This process is akin to incorporating the striping feature used in RAID **0** into a single physical drive.

To optimize data storage and retrieval, data are read or written across the respective platter surfaces in a pattern giving preference to the lowest track and sector numbers. This pattern is similar to the pattern employed in an ordinary drive with the exception that data are read or written simultaneously pursuant to the striping scheme outlined above. In addition to reducing the seek time required for simultaneously accessing pseudo-successive data, this pattern has the effect of providing consistency among the read/write pattern employed by each RW/VCM controller. As a result, although FIG. **4** depicts the heads **25**,**35** to the independent-arm actuator **40** in substantially different radial positions, the arms **15** actually move in near synchronization (albeit independently) in accordance with the identical read/write pattern common among the RW/VCM controllers.

From a conceptual standpoint, it can generally be stated that each platter surface and its corresponding RW/VCM controller and actuator arm function as discrete drive modules. Such artificial compartmentalization causes these drive modules to appear as separate physical drives to the microcontroller, thereby enabling the microcontroller to natively manipulate each module independently. Analogous to standard RAID **0** technology, these drive modules appear collectively as a single drive to the host system, with total data capacity of the drive being equal to the aggregate capacity of the individual platter surfaces.

The invention possesses several unique qualities in addition to those previously mentioned. Insofar as data are read or written simultaneously across the respective platter surfaces independently, each platter surface emulates separate drives in RAID **0** configuration. As a consequence, increases in potential data transfer rates generally scale proportionally higher with the inclusion into the drive of additional platter surfaces. Accordingly, a one-platter notebook drive, for example, would emulate two drives in RAID **0** configuration, while a five-platter desktop drive would emulate ten drives, also in RAID **0** configuration. Using the preceding example, the invention has the potential to double and decuple the read/write speeds of notebook and desktop drives, respectively, with maximum data transfer rates approaching or exceeding 500 megabytes per second.

These speed increases, it follows, are accomplished without the disadvantages associated with traditional multi-drive RAID **0** implementation. The invention as embodied consists of a single physical drive as opposed to two or more separate drives. Notwithstanding the incorporation into the drive of substitute actuator components and additional integrated logic circuits, the drive is comparable to an ordinary drive in reliability, power consumption, space displacement, weight occupation, noise generation, heat production, and hardware costs. These characteristics are not only in sharp contrast to the ramifications resulting from RAID **0** implementation, but such characteristics make the drive suitable for use in all classes of computer systems, particularly laptop and notebook computers and entry-level desktops, servers, and workstations.

Another notable quality of the invention is that it operates and functions identically to an ordinary drive from the perspective of a consumer or end user. The drive appears as a single drive to an operating system, with the internal striping process occurring surreptitiously. Because all of the necessary logic circuits are located on the printed circuit board, the drive constitutes a fully functional self-contained unit and is entirely compatible with existing technology. In addition, due to the auxiliary EEPROM memory chip containing supporting firmware, the drive is bootable and can thus serve as the primary storage medium for the operating system. These factors render the drive highly versatile, so much so, in fact, that the drive can be connected to a traditional RAID array (using a separate RAID controller or its software equivalent) to achieve additional performance and/or reliability increases beyond the already-high capability of the invention.

Although specific embodiments have been set forth, the invention is sufficiently encompassing as to permit other embodiments to be employed within the scope of the invention. The embodiments outlined above, however, provide numerous practical advantages insofar as they permit the invention to be implemented as inexpensively as possible while remaining compatible with existing technology. This has the effect of lowering development and production expenses, increasing product marketability, and promoting widespread use and adoption. The embodiments outlined above thus constitute the best modes of implementation, operation, and configuration.

What is claimed is:

1. An information storage and retrieval apparatus, said apparatus comprising: at least one circular substrate, said substrate or substrates aggregating at least two carrier surfaces capable of storing data whereupon data may be read from or written to by corresponding read/write members; and means for simultaneously and independently reading or writing alternate or interleaving bits or blocks of data across each of said plurality of carrier surfaces within said information storage and retrieval apparatus.

2. An information storage and retrieval apparatus, said apparatus comprising:

at least one circular substrate, said substrate or substrates aggregating at least two carrier surfaces capable of storing data whereupon data may be read from or written to by corresponding read/write members; an actuator mechanism with at least two arms, each of said arms assigned to different carrier surfaces; means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to the circular substrate or substrates defining the carrier surfaces; and a logic holder, said holder comprising electronic architecture for electronically controlling said information storage and retrieval apparatus, wherein in its operative mode, said information storage and retrieval apparatus executes means for permitting alternate or interleaving bits or blocks of data to be read or written simultaneously and independently across a plurality of carrier surfaces.

3. The apparatus of claim **2**, wherein said apparatus comprises a plurality of circular substrates.

4. The apparatus of claim **2**, wherein said circular substrate or substrates are nonremovable.

5. The apparatus of claim **2**, wherein said apparatus is a hard disk drive.

6. The apparatus of claim **2**, wherein said actuator mechanism comprises more than two arms.

7. The apparatus of claim **2**, wherein said actuator mechanism is rotary in nature.

8. The apparatus of claim **2**, wherein the arms to said actuator mechanism are pivotably connected to one and the same actuator shaft through independent racks and further comprising separate electromagnetic coils affixed within the proximity of the base of each arm and at least one stationary magnet positioned between each of said electromagnetic coils.

9. The apparatus of claim **8**, wherein said electromagnetic coils each feature a substantially flat profile.

10. The apparatus of claim **8**, wherein said electromagnetic coils each feature a generally annular dimension.

11. The apparatus of claim **8**, wherein said electromagnetic coils each feature a generally triangular dimension.

12. The apparatus of claim **8**, wherein said electromagnetic coils each feature a generally square dimension.

13. The apparatus of claim **8**, wherein said electromagnetic coils each feature a generally rectangular dimension.

14. The apparatus of claim **8**, wherein said stationary magnets are plate-shaped members.

15. The apparatus of claim **8**, wherein said stationary magnets comprise permanent magnets.

16. The apparatus of claim **8**, wherein said stationary magnets comprise soft-magnetic elements.

17. The apparatus of claim **8**, further comprising antimagnetic shielding affixed between each coil fixture.

18. The apparatus of claim **17**, wherein said antimagnetic shielding comprises mu metal.

19. The apparatus of claim **8**, wherein said electromagnetic coils are placed in an antipodal configuration.

20. The apparatus of claim **8**, wherein said stationary magnets are placed in an antipodal configuration.

21. The apparatus of claim **2**, wherein said actuator mechanism comprises at least two individual actuator submechanisms, said submechanisms each having only one arm, wherein said submechanisms are mounted vertically within one and the same imaginary plane, with each submechanism assigned to different carrier surfaces.

22. The apparatus of claim **21**, wherein said submechanisms share one and the same mechanical housing.

23. The apparatus of claim **21**, wherein said submechanisms share one and the same actuator shaft.

24. The apparatus of claim **21**, wherein said submechanisms share one and the same stationary magnet.

25. The apparatus of claim **2**, wherein: said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial position; and in its operative mode, said secondary actuators execute means for providing precise independent secondary positioning by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

26. The apparatus of claim **25**, wherein said secondary actuators are microactuators.

27. The apparatus of claim **25**, wherein said secondary actuators are microelectromechanisms.

28. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to 10,000 or more adjacent concentric circular tracks on the respective carrier surfaces.

29. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 5000 and 10,000 adjacent concentric circular tracks on the respective carrier surfaces.

30. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 2500 and 5000 adjacent concentric circular tracks on the respective carrier surfaces.

31. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement per-

mitting access by the read/write members to between 1000 and 2500 adjacent concentric circular tracks on the respective carrier surfaces.

32. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 100 and 1000 adjacent concentric circular tracks on the respective carrier surfaces.

33. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 10 and 100 adjacent concentric circular tracks on the respective carrier surfaces.

34. The apparatus of claim **25**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1 and 10 adjacent concentric circular tracks on the respective carrier surfaces.

35. The apparatus of claim **2**, wherein said electronic architecture comprises means for electronically intercepting read or write commands from a host system, means for electronically responding pursuant to a predetermined shuffling algorithm, and means for electronically manipulating said arms independently during read or write operations.

36. The apparatus of claim **2**, wherein said electronic architecture comprises: two or more RW/VCM controllers, said RW/VCM controllers comprising read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating and positioning said arms during read or write operations; and a microcontroller for providing supervisory and substantive processing services to said RW/VCM controllers, wherein said microcontroller, RW/VCM controllers, RW circuitry, and VCM circuitry together coexist either physically or logically or in the form of integrated circuits, discrete electronic components, or software equivalents.

37. The apparatus of claim **36**, wherein:

the number of RW/VCM controllers is equivalent to the number of arms composing said actuator mechanism, with each RW/VCM controller assigned to different of said arms; and the microcontroller is shared among the RW/VCM controllers, with the microcontroller connected to a communication channel interfacing the information storage and retrieval apparatus.

38. The apparatus of claim **36**, wherein: the microcontroller is an intermediary between a host system and the RW/VCM controllers, said microcontroller comprising means for electronically intercepting read or write commands from said host system and means for electronically responding pursuant to a predetermined shuffling algorithm, wherein in executing write commands, the microcontroller implements means for electronically apportioning alternate or interleaving bits or blocks of data to each RW/VCM controller; and in executing read commands, the microcontroller implements means for electronically reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and means for electronically transmitting said data to said host system in native sequential order.

39. The apparatus of claim **36**, wherein: in response to read or write commands issued by the microcontroller, each RW/VCM controller executes means for electronically causing its assigned arm to read or write data across the respective carrier surfaces, with all such read or write operations by said arms occurring simultaneously in a parallel fashion, wherein the data that are read or written across each carrier surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller.

40. The apparatus of claim **2**, wherein said logic holder is a printed circuit board.

41. An actuator mechanism, said mechanism comprising at least two arms, said arms assigned to different circular carrier surfaces within an information storage and retrieval apparatus; and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to said carrier surfaces.

42. The mechanism of claim **41**, wherein said actuator mechanism comprises more than two arms.

43. The mechanism of claim **41**, wherein said actuator mechanism is rotary in nature.

44. The mechanism of claim **41**, wherein: the arms to said actuator mechanism are pivotably connected to one and the same actuator shaft though independent racks; separate electromagnetic coils being affixed within the proximity of the base of each said arm; and at least one stationary magnet is positioned between each of said electromagnetic coils.

45. The mechanism of claim **44**, wherein said electromagnetic coils each feature a substantially flat profile.

46. The mechanism of claim **44**, wherein said electromagnetic coils each feature a generally annular dimension.

47. The mechanism of claim **44**, wherein said electromagnetic coils each feature a generally triangular dimension.

48. The mechanism of claim **44**, wherein said electromagnetic coils each feature a generally square dimension.

49. The mechanism of claim **44**, wherein said electromagnetic coils each feature a generally rectangular dimension.

50. The mechanism of claim **44**, wherein said stationary magnets are plate-shaped members.

51. The mechanism of claim **44**, wherein said stationary magnets comprise permanent magnets.

52. The mechanism of claim **44**, wherein said stationary magnets comprise soft-magnetic elements.

53. The mechanism of claim **44**, further comprising antimagnetic shielding affixed between each of said electromagnetic coil.

54. The mechanism of claim **53**, wherein said antimagnetic shielding comprises mu metal.

55. The mechanism of claim **44**, wherein said electromagnetic coils are placed in an antipodal configuration.

56. The mechanism of claim **44**, wherein said stationary magnets are placed in an antipodal configuration.

57. The mechanism of claim **41**, wherein said actuator mechanism comprises at least two individual actuator submechanisms, said submechanisms each having only one arm, wherein said submechanisms are mounted vertically within one and the same imaginary plane, with each said submechanism assigned to different carrier surfaces.

58. The mechanism of claim **57**, wherein said submechanisms share one and the same mechanical housing.

59. The mechanism of claim **57**, wherein said submechanisms share one and the same actuator shaft.

60. The mechanism of claim **57**, wherein said submechanisms share one and the same stationary magnet.

61. The mechanism of claim **41** wherein said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one

read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial position; and in its operative mode, said secondary actuators execute means for providing precise independent secondary positioning by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

62. The mechanism of claim **61**, wherein said secondary actuators are microactuators.

63. The mechanism of claim **61**, wherein said secondary actuators are microelectromechanisms.

64. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to 10,000 or more adjacent concentric circular tracks on the respective carrier surfaces.

65. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 5000 and 10,000 adjacent concentric circular tracks on the respective carrier surfaces.

66. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 2500 and 5000 adjacent concentric circular tracks on the respective carrier surfaces.

67. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1000 and 2500 adjacent concentric circular tracks on the respective carrier surfaces.

68. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 100 and 1000 adjacent concentric circular tracks on the respective carrier surfaces.

69. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 10 and 100 adjacent concentric circular tracks on the respective carrier surfaces.

70. The mechanism of claim **61**, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1 and 10 adjacent concentric circular tracks on the respective carrier surfaces.

71. A logic holder, said holder comprising: electronic architecture, said architecture implementing means for electronically controlling an information storage and retrieval apparatus, wherein said information storage and retrieval apparatus comprises at least one circular substrate, said substrate or substrates aggregating a plurality of carrier surfaces whereupon data may be read from or written to by corresponding read/write members simultaneously and independently; said information storage and retrieval apparatus further comprising an actuator mechanism with a plurality of arms and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to the circular substrate or substrates defining the carrier surfaces.

72. The holder of claim **71**, wherein said electronic architecture comprises means for electronically intercepting read or write commands from a host system, means for electronically responding pursuant to a predetermined shuffling algorithm, and means for electronically manipulating said arms independently during read or write operations.

73. The holder of claim **71**, wherein said electronic architecture comprises: two or more RW/VCM controllers, said RW/VCM controllers comprising read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating and positioning said arms during read or write operations; and a microcontroller for providing supervisory and substantive processing services to said RW/VCM controllers, wherein said microcontroller, RW/VCM controllers, RW circuitry, and VCM circuitry together coexist either physically or logically or in the form of integrated circuits, discrete electronic components, or software equivalents.

74. The holder of claim **73**, wherein: the number of RW/VCM controllers is equivalent to the number of arms composing said actuator mechanism, with each RW/VCM controller assigned to different arms; and the microcontroller is shared among the RW/VCM controllers, with the microcontroller connected to a communication channel interfacing the information storage and retrieval apparatus.

75. The holder of claim **73**, wherein: the microcontroller is an intermediary between a host system and the RW/VCM controllers, said microcontroller comprising means for electronically intercepting read or write commands from said host system and means for electronically responding pursuant to a predetermined shuffling algorithm, wherein in executing write commands, the microcontroller implements means for electronically apportioning alternate or interleaving bits or blocks of data to each RW/VCM controller; and in executing read commands, the microcontroller implements means for electronically reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and means for electronically transmitting said data to said host system in native sequential order.

76. The holder of claim **73**, wherein: in response to read or write commands issued by the microcontroller, each RW/VCM controller executes means for electronically causing its assigned arm to read or write data across the respective carrier surfaces, with all such read or write operations by said arms occurring simultaneously in a parallel fashion, wherein the data that are read or written across each carrier surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller.

77. The holder of claim **71**, wherein said logic holder is a printed circuit board.

* * * * *

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Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

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Walter A. Tormasi

Execution Date(s) FEB 07 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Advanced Data Solutions Corp.

Internal Address:

Street Address: 105 Fairview Avenue

City: Somerville

State: New Jersey

Country: United States Zip: 08876

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger

☐ Security Agreement ☐ Change of Name

☐ Government Interest Assignment

☐ Executive Order 9424, Confirmatory License

☐ Other

4. Application or patent number(s):

☐ This document is being filed together with a new application.

A. Patent Application No.(s)

11/031,878

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

OR/FINANCE
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5. Name and address to whom correspondence concerning document should be mailed:

Name: Walter A. Tormasi

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Fax Number: 732-560-3939

Email Address:

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 1.21(h) & 3.41) $ 40

☐ Authorized to be charged by credit card

☐ Authorized to be charged to deposit account

☒ Enclosed

☐ None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers

Expiration Date

b. Deposit Account Number

Authorized User Name

9. Signature: Walter A. Tormasi FEB 07 2005

Signature Date

Walter A. Tormasi

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 2

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01 FC:8021 40.00 OP

Assignment of Patent Application

For consideration received, WALTER A. TORMASI (Assignor), 1828 Middle Road, Martinsville, New Jersey 08836, hereby assigns, transfers, and conveys to ADVANCED DATA SOLUTIONS CORP. (Assignee), 105 Fairview Avenue, Somerville, New Jersey 08876, complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny.

Walter A. Tormasi, Assignor

FEB 07 2005

Date

I hereby certify that the above individual duly acknowledged the execution of the foregoing instrument and the powers vested in him, said acknowledgment and affirmation occurring on the below date in the State of New Jersey, County of Mercer.

Notary Public

Sworn to and Subscribed Before Me This 7th Day of Jan 2005

MILDRED D. STRIBLING
Notary Public Of New Jersey
My Commission Expires May 9, 2008

Form PTO-1595 (Rev. 03/04)
OMB No. 0651-0027 (exp. 6/30/2005)

02-12-2007

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To the Director of the U.S. Patent ... documents or the new address(es) below.

1. Name of conveying party(ies)/Execution Date(s):

Walter A. Tormasi

Execution Date(s) FEB 07 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

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State: New Jersey

Country: United States Zip: 08876

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3. Nature of conveyance:

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☐ Executive Order 9424, Confirmatory License
☐ Other

4. Application or patent number(s): ☐ This document is being filed together with a new application.

A. Patent Application No.(s)

11/031,878

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address to whom correspondence concerning document should be mailed:

Name: Walter A. Tormasi

Internal Address:

Street Address: 1828 Middle Road

City: Martinsville

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Phone Number: 732-560-1665

Fax Number: 732-560-3939

Email Address:

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 1.21(h) & 3.41) $ 40

☐ Authorized to be charged by credit card
☐ Authorized to be charged to deposit account
☒ Enclosed
☐ None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number

Authorized User Name

9. Signature: Walter A. Tormasi FEB 07 2005

Signature Date

Walter A. Tormasi

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 2

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

Assignment of Patent Application

For consideration received, WALTER A. TORMASI (Assignor), 1828 Middle Road, Martinsville, New Jersey 08836, hereby assigns, transfers, and conveys to ADVANCED DATA SOLUTIONS CORP. (Assignee), 105 Fairview Avenue, Somerville, New Jersey 08876, complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny.

Walter A. Tormasi, Assignor

FEB 07 2005

Date

I hereby certify that the above individual duly acknowledged the execution of the foregoing instrument and the powers vested in him, said acknowledgment and affirmation occurring on the below date in the State of New Jersey, County of Mercer.

Notary Public

Sworn to and Subscribed Before Me This
7th Day of Jan 2005

MILDRED D. STRIBLING
Notary Public Of New Jersey
My Commission Expires May 9, 2008

ASSIGNMENT OF U.S. PATENT NO. 7,324,301

It is hereby RESOLVED, RATIFIED, and AGREED as follows:

1. Advanced Data Solutions Corp., acting under the authority of its President and Sole Shareholder, hereby assigns to Walter A. Tormasi all right, title, and interest in U.S. Patent No. 7,324,301.

2. Said assignment shall have complete retroactive effect, permitting Walter A. Tormasi to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301.

Walter A. Tormasi
President and Sole Shareholder
Advanced Data Solutions Corp.

January 30, 2019
Date

35 USCS § 271, Part 1 of 3

Current through Public Law 116-344, approved January 13, 2021, with gaps of Public Laws 116-260, 116-283, and 116-315.

United States Code Service > TITLE 35. PATENTS (§§ 1 — 390) > Part III. Patents and Protection of Patent Rights (Chs. 25 — 32) > CHAPTER 28. Infringement of Patents (§§ 271 — 273)

§ 271. Infringement of patent

(a) Except as otherwise provided in this title [*35 USCS §§ 1* et seq.], whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)

(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit—

(A)an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act [*21 USCS § 355(j)*] or described in section 505(b)(2) of such Act [*21 USCS § 355(b)(2)*] for a drug claimed in a patent or the use of which is claimed in a patent,

(B)an application under section 512 of such Act [*21 USCS § 360b*] or under the Act of March 4, 1913 (*21 U.S.C. 151*–*158*) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent, or

(C)

(i)with respect to a patent that is identified in the list of patents described in section 351(l)(3) of the Public Health Service Act [*42 USCS § 262(l)(3)*] (including as provided under section 351(l)(7) of such Act [*42 USCS § 262(l)(7)*]), an application seeking approval of a biological product, or

(ii)if the applicant for the application fails to provide the application and information required under section 351(l)(2)(A) of such Act [*42 USCS § 262(l)(2)(A)*], an application seeking approval of a biological product for a patent that could be identified pursuant to section 351(l)(3)(A)(i) of such Act [*42 USCS § 262(l)(3)(A)(i)*],

if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug, veterinary biological product, or biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)—

(A)the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B)injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug, veterinary biological product, or biological product,

(C)damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug, veterinary biological product, or biological product, and

(D)the court shall order a permanent injunction prohibiting any infringement of the patent by the biological product involved in the infringement until a date which is not earlier than the date of the expiration of the patent that has been infringed under paragraph (2)(C), provided the patent is the subject of a final court decision, as defined in section 351(k)(6) of the Public Health Service Act [*42 USCS § 262(k)(6)*], in an action for infringement of the patent under section 351(l)(6) of such Act [*42 USCS § 262(l)(6)*], and the biological product has not yet been approved because of section 351(k)(7) of such Act [*42 USCS § 262(k)(7)*].

The remedies prescribed by subparagraphs (A), (B), (C), and (D) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285 [*35 USCS § 285*].

(5) Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act (*21 U.S.C. 355*), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under section 2201 of title 28 for a declaratory judgment that such patent is invalid or not infringed.

(6)

(A) Subparagraph (B) applies, in lieu of paragraph (4), in the case of a patent—

(i)that is identified, as applicable, in the list of patents described in section 351(l)(4) of the Public Health Service Act [*42 USCS § 262(l)(4)*] or the lists of patents described in section 351(l)(5)(B) of such Act [*42 USCS § 262(l)(5)(B)*] with respect to a biological product; and

(ii)for which an action for infringement of the patent with respect to the biological product—

(I)was brought after the expiration of the 30-day period described in subparagraph (A) or (B), as applicable, of section 351(l)(6) of such Act [*42 USCS § 262(l)(6)*]; or

(II)was brought before the expiration of the 30-day period described in subclause (I), but which was dismissed without prejudice or was not prosecuted to judgment in good faith.

(B) In an action for infringement of a patent described in subparagraph (A), the sole and exclusive remedy that may be granted by a court, upon a finding that the making, using, offering to sell, selling, or importation into the United States of the biological product that is the subject of the action infringed the patent, shall be a reasonable royalty.

(C) The owner of a patent that should have been included in the list described in section 351(l)(3)(A) of the Public Health Service Act [*42 USCS § 262(l)(3)(A)*], including as provided under section 351(l)(7) of such Act [*42 USCS § 262(l)(7)*] for a biological product, but was not timely included in such list, may not bring an action under this section for infringement of the patent with respect to the biological product.

(f)

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after—

(1)it is materially changed by subsequent processes; or

(2)it becomes a trivial and nonessential component of another product.

(h) As used in this section, the term “whoever” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(i) As used in this section, an “offer for sale” or an “offer to sell” by a person other than the patentee, or any designee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

35 USCS § 281, Part 1 of 2

Current through Public Law 116-344, approved January 13, 2021, with gaps of Public Laws 116-260, 116-283, and 116-315.

United States Code Service > TITLE 35. PATENTS (§§ 1 — 390) > Part III. Patents and Protection of Patent Rights (Chs. 25 — 32) > CHAPTER 29. Remedies for Infringement of Patent, and Other Actions (§§ 281 — 299)

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

History

HISTORY:

Act July 19, 1952, ch 950, § 1, *66 Stat. 812*.

Annotations

Notes

HISTORY; ANCILLARY LAWS AND DIRECTIVES

Prior law and revision:

Based on 35 U.S.C., 1946 ed., §§ 67 and 70 in part (R. S. § 4919; R. S. § 4921; Mar. 3, 1897, ch 396, § 6, *29 Stat. 694*; Feb. 18, 1922, ch 58, § 8, *42 Stat. 392*; Aug. 1, 1946, ch 726, § 1, *60 Stat. 778*).

The corresponding two sections of existing law are divided among *35 U.S.C. §§ 281*, *283*, *284*, *285*, *286* and *289* with some changes in language. Section 281 [*35 USCS § 281*] serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

NOTES TO DECISIONS

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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

WALTER A. TORMASI, Plaintiff, v. WESTERN DIGITAL CORPORATION, Defendant.	Case Number: 4:19-CV-00772-HSG **DEFENDANT WESTERN DIGITAL CORPORATION'S MOTION TO DISMISS [FRCP 12(B)1, FRCP 12(B)(6) AND FRCP 17(B)]** Date: August 22, 2019 Time: 2:00 p.m. Judge: Hon. Haywood S. Gilliam, Jr. Courtroom: 2, 4th Floor

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NOTICE OF MOTION

Defendant Western Digital Corporation ("WDC") hereby gives notice that on August 22, 2019, at 2:00 p.m., in Courtroom 2, 4th Floor, 1301 Clay Street, Oakland, CA 94612, before the Honorable Haywood S. Gilliam, Jr., WDC will and hereby does move under Rule 12(b)(1) of the Federal Rules of Civil Procedure ("FRCP") for an order dismissing the February 12, 2019 Complaint ("Complaint") (ECF 1) filed by Walter A. Tormasi ("Plaintiff" or "Tormasi") based on Tormasi's lack of standing to sue. WDC will and does further move under FRCP 17(b) for an order dismissing the Complaint based on Tormasi's lack of capacity to sue. WDC will and does further move for an order pursuant to FRCP 12(b)(6) for an order dismissing the claims of willful infringement and indirect infringement (if Tormasi contends the Complaint makes such claims).

RELIEF SOUGHT

WDC seeks dismissal of this action pursuant to FRCP 12(b)(1) and or FRCP 17(b) due to Tormasi's lack of standing and lack of capacity to sue. If the Court concludes that Tormasi *does* have standing and capacity, WDC seeks dismissal of Tormasi's willful infringement claim, and any claims for indirect infringement Tormasi contends were pled under Fed.R.Civ.P. 12(b)(6) for failure to state a claim.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Tormasi's suit for infringement of U.S. Patent No. 7,324,301 ("the '301 Patent") should be dismissed because Tormasi lacks both standing and capacity to bring this suit. Tormasi filed the instant action *pro se* from the New Jersey State Prison where he is serving a life sentence. Tormasi purports to have assigned the '301 Patent from Advanced Data Solutions Corporation ("ADS") – a Delaware corporation that per the patent office's records is the current owner of the '301 Patent – to himself in his capacity as ADS's "President" and "Sole Shareholder." The assignment, however, is invalid because there is not a scrap of evidence that Tormasi is President or sole shareholder of ADS or that Tormasi had the authority to assign the '301 Patent from ADS

to himself. And, by Tormasi's own admission in prior lawsuits, he does not possess the documents necessary to prove his ownership of ADS. The patent office's records show that ADS, not Tormasi, owns the '301 Patent. Tormasi, therefore, lacks standing to bring this patent infringement suit.

While this issue alone bars Tormasi's lawsuit, there are at least two additional, independent reasons why Tormasi lacks standing or capacity to sue. First, ADS has been in a void status since March 1, 2008 and was in a void status when Tormasi purported to assign the '301 Patent from ADS to himself. Thus, under Delaware law, ADS has been stripped of all of the powers previously conferred on it by Delaware, which include the power to "sell, convey, lease, exchange, transfer or otherwise dispose of, or mortgage or pledge, all or any of its property and assets." *See* 8 Del. C. § 122(4). Accordingly, even if Tormasi could show that he had the authority to assign ADS's patent to himself, because ADS lacked the power to transfer its property, the January 30, 2019 assignment is invalid.

Second, "it is a prohibited act in New Jersey state prisons for an inmate to operate a business or a nonprofit enterprise without the approval" of the prison administrator. *Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2009 U.S. Dist. LEXIS 50560, at *22 (D.N.J. June 16, 2009) ("Tormasi I") (citing N.J.A.C. 10A:4-4.1, .705) (Ex. 1).[1] In view of this law, in March 2007, prison officials confiscated as contraband documents in Tormasi's possession concerning ADS, the '301 Patent, and an unfiled provisional application. In suits filed by Tormasi seeking their return, the New Jersey federal court and the Third Circuit, affirming New Jersey's prohibition against inmates operating businesses, approved the seizure of these documents.

Tormasi's patent infringement suit – in which he claims to be an "entrepreneur" and is seeking $15 billion in damages (ECF 1 at 1, ¶ 1 & 12-13 "Prayer for Relief" ¶¶ (D-E)) – is plainly in furtherance of his efforts to monetize the '301 Patent. The New Jersey federal court and the Third Circuit have already found that Tormasi's patent licensing and monetization efforts

[1] "Ex. __" refers to Exhibits to the Declaration of Erica D. Wilson in Support of WDC's Motion to Dismiss ("Wilson Decl.") filed concurrently herewith.

constitute prohibited business operations. Tormasi's attempt to circumvent these findings by pursuing his patent monetization business as an individual rather than under the auspices of ADS does not alter the fact that this litigation is in furtherance of his business interests and is prohibited under New Jersey law. Tormasi's Complaint, therefore, should be dismissed for the additional reason that he lacks the capacity to sue since he is prohibited from conducting a business while incarcerated.

If the lawsuit is not dismissed in its entirety, Tormasi's claims of willful infringement should be dismissed because Tormasi's Complaint fails to plausibly allege that (1) WDC had pre-suit knowledge of the '301 Patent and its alleged infringement, and (2) the requisite "egregious" behavior to support such a claim. Instead, of plausibly pleading facts, Tormasi relies on rank speculation, unwarranted deductions of fact and unreasonable inferences that fall far short of plausibly pleading willful infringement. It is unclear whether Tormasi alleges indirect infringement. To extent he does, Tormasi's indirect infringement claims should also be dismissed for failure to state a claim

II. STATEMENT OF ISSUES TO BE DECIDED

1. Whether Tormasi's Complaint should be dismissed pursuant to FRCP 12(b)(1) for lack of standing to sue under Article III of the U.S. Constitution.

2. Whether Tormasi's Complaint should be dismissed because he lacks the capacity to sue.

3. Whether Tormasi's claim for willful infringement of the '301 Patent should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

4. Whether Tormasi's claims for indirect infringement of the '301 Patent (to the extent Tormasi contends the Complaint makes such claims) should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

III. FACTUAL BACKGROUND

A. The Patent-in-Suit

Plaintiff Tormasi is an inmate at the New Jersey State Prison in Trenton, New Jersey where he has been serving a life sentence since 1998. *See State v. Tormasi*, 443 N.J. Super 146, 149 (App.Div. 2015). Tormasi filed this suit for infringement of the '301 Patent against WDC on February 12, 2019. ECF 1. Tormasi's Complaint asserts that he is an "innovator and entrepreneur" and that "one of [his] inventions resulted in the issuance of U.S. Patent No. 7,324,301." ECF 1, ¶1 & Ex. C.

The face page of the '301 Patent states that it issued on January 29, 2008 and lists Walter A. Tormasi as Inventor. *Id.* It also states that the application for the '301 patent, U.S. Patent Application Ser. No. 11/031,878, was filed on January 10, 2005, and claims priority to Provisional application No. 60/568,346 (the "Provisional Application.") *Id.*

B. Tormasi Assigned the Application for the '301 Patent and Its "Progeny" to Advanced Data Solutions Corporation ("ADS")

On February 7, 2005, "[f]or consideration received," Tormasi assigned, transferred and conveyed "complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny" to "ADVANCED DATA SOLUTIONS CORP." Ex. 2. The assignment document was notarized and recorded (twice) in the United States Patent and Trademark Office ("PTO"). *Id.* The face page of the '301 Patent lists ADS as the patent's Assignee (ECF 1, Ex. C.) and the PTO's assignment records currently list ADS as the owner of the '301 Patent. Ex. 2.

C. ADS is A Delaware Corporation

In a December 1, 2008 Complaint ("2008 Complaint") filed by Tormasi against prison officials, Tormasi alleged ADS was a Delaware corporation. Ex. 3 ¶6. The Delaware Secretary of State's records show ADS was incorporated on April 19, 2004 by Angela Norton whose address is listed as that of an entity called The Company Corporation. Ex. 4. The Delaware Secretary of State also has two records of Franchise Tax Payments for ADS made in 2004 and 2005. Ex. 5.

These documents do not identify any officer, director or stockholder of ADS, and do not identify Tormasi as having any interest in ADS. *See* Exs. 4 & 5.

The February 7, 2005 assignment recorded with the PTO lists ADS's address as 105 Fairview Avenue, Somerville, New Jersey 08876 ("Fairview Avenue"). Ex. 2. Fairview Avenue is a property that was owned by Attila Tormasi or Tormasi Housing Somerville, LLC (of which Attila Tormasi was the sole member) prior to ADS's formation and until Attila Tormasi's death. Exs. 7 (deed conveying Fairview Avenue to TDKH and showing chain of title on sixth page), Ex. 8. Fairview Avenue was subsequently transferred to TDKH, LLC whose members include Kuldip Dhillon and Tejinder Dhillon. Exs. 7, 9.

In the 2008 Complaint, Tormasi alleged ADS was "an intellectual-property holding company," and that he was "the sole shareholder of ADS" and its "agent." Ex. 3 ¶¶6-7. Tormasi, however, provided no documents to support his contentions concerning ownership of ADS.

The 2008 Complaint also alleges that ADS had a "principal office and mailing address at 1828 Middle Road, Martinsville, New Jersey 08836" ("Middle Road"). Ex. 3 ¶6. Middle Road is a single-family home that was owned by Tormasi's father, Attila Tormasi, prior to ADS's incorporation until his death, when it was transferred on January 25, 2011 to Matthew Northrup. Ex. 6 (deed conveying Middle Road to Northrup and showing title chain on first page).

D. ADS is and Has Been In a "Void" Status Since March 2008

The Delaware Secretary of State's records show that ADS has been in a "void" status, and thus prohibited from transacting business since March 1, 2008. Ex. 10.

E. Tormasi's Civil Lawsuits

1. Tormasi's December 2008 Lawsuit for Alleged Violations of His Constitutional Rights

On December 1, 2008, Tormasi filed the 2008 Complaint on behalf of himself and ADS against prison officials alleging various civil rights and constitutional violations stemming from the March 3, 2007 seizure by prison officials of Tormasi's personal property. *See, e.g.,* Ex. 3 ¶¶8, 13-15. Tormasi alleged the confiscated property included *inter alia* ADS corporate paperwork,

patent prosecution documents for the '301 Patent, "an unfiled provisional patent application" and "various legal correspondence." Ex. 3 ¶ 15, 19-35.

In particular, Tormasi alleged that, while confined at New Jersey State Prison, he filed the Provisional Application with the PTO (*id.* ¶¶19-20(a)), and on May 17, 2004, assigned his entire interest in the Provisional Application to ADS in exchange for all outstanding shares of ADS common stock (the "2004 Assignment"). *Id.* ¶20(b). Tormasi alleged that due to this transaction he was "the sole owner of ADS, and ADS correspondingly owns all applications and patents stemming from [the Provisional Application]." *Id.*

Tormasi alleged the confiscated documents included the 2004 Assignment, "corporate resolutions authorizing, ratifying, and adopting" the 2004 Assignment, "stock certificates; shareholder ledgers; minutes of shareholder meetings; tax information and forms; and other related legal documents." *Id.* ¶21. Tormasi claimed that absent such documents he "cannot prove his ownership of ADS to the satisfaction of interested third parties," and stated:

> Absent such proof of ownership of ADS, plaintiff Tormasi is unable to directly or indirectly benefit from his intellectual-property assets, either by selling all or part of ADS; by exclusively or non-exclusively licensing his '301 patent to others . . . or by engaging in other monetization transactions involving ADS or its intellectual-property assets. *Id.* ¶22(a)

Tormasi further alleged the confiscation of his corporate documents prevented him from filing tax returns with the Internal Revenue Service on behalf of ADS. *Id.* ¶22(b). And, Tormasi alleged the confiscation of patent prosecution documents injured him and ADS because they "intend[ed] to enforce their rights under their '301 patent by filing infringement actions . . ." (*id.* ¶27(a)), and absent these documents they could not do so, thus preventing him and ADS from benefiting from the '301 Patent. *Id.* ¶27(a)-(b).

2. The New Jersey District Court *Sua Sponte* Dismissed Tormasi's Claims *Inter Alia* Because New Jersey Inmates are Prohibited From Operating Businesses

On June 15, 2009, the district court dismissed ADS's claims *sua sponte* finding "that a corporation may appear in the federal courts only through licensed counsel," and thus Tormasi could not pursue claims on behalf of ADS. Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *11-12.

The district court also dismissed Tormasi's claims *sua sponte*, with the exception of a claim involving documents Tormasi alleged he required to file an action for post-conviction relief. *Id.* at *28. In considering Tormasi's claims, the district court noted "it is a prohibited act in New Jersey state prisons for an inmate to operate a business or a nonprofit enterprise without the approval of the Administrator." *Id.* at *22 (citing N.J.A.C. 10A:4-4.1, .705.) The district court also confirmed that Tormasi had no federal or state constitutional right to conduct a business from prison and "had no constitutional right to file tax returns or engage in litigation in connection with the business of ADS." *Id.* at *21-22.

The court further found, "the provisions of the New Jersey Administrative Code prohibiting prisoners from operating a business, considered in conjunction with Plaintiff Tormasi's failure to allege that he was given permission to conduct a business, is as likely a motivation for the confiscation of Plaintiff Tormasi's business records." *Id.* at *23.

The Court dismissed:

> Plaintiff Tormasi's claim that he had been deprived of a constitutional right to conduct a business while incarcerated (including all related claims such as the related claims that he has a constitutional right to communicate with the U.S. Office of Patents and Trademarks regarding patent applications, and to communicate with counsel regarding the conduct of the business, and to conduct litigation with respect to the business, and to prepare and submit tax returns on behalf of the business) . . . .

Tormasi v. Hayman, Civil Action No. 08-5886 (JAP), 2011 U.S. Dist. LEXIS 25849, at *15 (D.N.J. Mar. 14, 2011) ("Tormasi II") (Ex. 11) (summarizing holding in Tormasi I).

The Court also noted that despite Tormasi's desire to pursue patent infringement litigation, he failed to state a claim for denial of access to courts because "impairment of the capacity to litigate with respect to personal business interests is 'simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration.'" Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *14-15 (quoting *Lewis v. Casey*, 518 U.S. 343, 355 (1996)).

3. Tormasi's July 24, 2009 Amended Complaint

On July 24, 2009 Tormasi filed a "1st Amended Complaint" on behalf of himself and ADS largely reiterating the allegations and claims of the December 2008 Complaint, and

including a new claim for violation of his First Amendment free speech rights. Ex. 12. On Defendants' Motion to Dismiss, the court dismissed – again – Tormasi's claims. *See* Tormasi II, 2011 U.S. Dist. LEXIS 25849, at *39.

The court also dismissed Tormasi's claim that the confiscation of his documents "violat[ed] his rights to freedom of speech under the First Amendment." *Id.* at *28, *34. In so doing, the court reiterated that Tormasi had no federal constitutional right to conduct a business in prison (*id.* at *31) and reiterated New Jersey's "no-business" rule. *Id.* at *28-29 (citing N.J.A.C. 10A:4-4.1, .705). The court highlighted the "rational connection between the no-business rule and the legitimate penological objective of maintaining security and efficiency at state correctional institutions," noting *inter alia* that "operating a business inside a correctional facility would seriously burden operation of incoming and outgoing mail procedures," and "could result in the introduction of contraband into prisons." *Id.* at *32.

4. The Third Circuit Affirmed the New Jersey's Application of the No-Business Rule to Tormasi's Unfiled Patent Application

Tormasi appealed the district court's judgment concerning his unfiled patent application, arguing that the confiscation of the application interfered with his statutory right to file to apply for a patent and violated his First Amendment rights to free speech. *See Tormasi v. Hayman*, 443 F. App'x. 742, 744-45 (3d Cir. 2011) (Ex. 13). The Third Circuit recognized that prison officials "confiscated Tormasi's patent application pursuant to a prison regulation that prohibited 'commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator.' N.J.A.C. 10A:4-4.1(.705)." *Id.* at 745.

The Court confirmed the propriety of the prison's actions finding that in Tormasi's case his intentions with respect to the unfiled application, as stated in his Complaints, showed that Tormasi intended to file the patent application in furtherance of operating a business. *Id.* The Court focused on Tormasi's allegations in his complaints that: (1) he had filed two patent applications entitled "Striping data simultaneously across multiple platter services" and assigned to ADS his entire interest in the applications; and (2) due to the confiscation of paperwork pertaining to the '301 Patent and ADS, he could not benefit from the intellectual-property assets

– *e.g.*, by selling ADS or licensing the patents, using ADS or the '301 patent as collateral, or by engaging in other monetization transactions involving ADS or its intellectual-property assets. *Id.*

The Third Circuit found it notable that Tormasi stated that he "intends to assign his confiscated provisional application and any derivate patents to plaintiff ADS . . .." *Id.* The Court held that "[u]nder these circumstances . . . the District Court did not err in holding that Tormasi's intentions regarding the unfiled patent application qualified under the regulation as 'commencing or operating a business or group for profit,'" and concluded that "the confiscation of the unfiled patent application did not violate his statutory or constitutional rights." *Id.*

F. Tormasi's Alleged Assignment of the '301 Patent From ADS to Himself

On January 30, 2019, Tormasi purported to assign the '301 Patent from ADS to himself in his supposed capacity as ADS's "President" and "Sole Shareholder" ECF 1 Ex. A. Tormasi alleges that he has standing to sue as the named inventor on the '301 Patent and by virtue of this alleged assignment. ECF 1 ¶¶7-8, Ex. A.

IV. LEGAL STANDARDS

A. Standing Challenges are Properly Brought Under FRCP 12(b)(1)

"A suit brought by a plaintiff without Article III standing is not a 'case or controversy,' and an Article III federal court therefore lacks subject matter jurisdiction over the suit." *Cetacean Cmty. v. Bush*, 386 F.3d 1169, 1174 (9th Cir. 2004) (citationsomitted). "In that event, the suit should be dismissed under Rule 12(b)(1)." *Id*; *see also White v. Lee*, 227 F.3d 1214, 1242 (9th Cir. 2000) (finding that standing "pertain[s] to a federal court's subject-matter jurisdiction under Article III" and thus is "properly raised in a motion to dismiss under Federal Rule of Civil procedure 12(b)(1), not Rule 12(b)(6)") (citations omitted).

B. On a "Factual" Challenge to Jurisdiction under Rule 12(b)(1) the Court Resolves Disputed Factual Issues Relevant to Jurisdiction

Pursuant to Rule 12(b)(1), a jurisdictional challenge may be "facial" or "factual." *Leite v. Crane Co.*, 749 F.3d 1117, 1121 (9th Cir. 2014). "A 'facial' attack accepts the truth of the plaintiff's allegations but asserts that they are insufficient on their face to invoke federal jurisdiction." *Id.* (internal citations and quotations omitted). "A 'factual' attack, by contrast,

contests the truth of the plaintiff's factual allegations, usually by introducing evidence outside the pleadings." *Id.* (citations omitted).

Significantly, where a defendant factually attacks jurisdiction, "the Court need not presume the truthfulness of the plaintiff's allegations." *White*, 227 F.3d at 1242. On the contrary, "[i]n resolving a factual attack on jurisdiction, the district court may review evidence beyond the complaint without converting the motion to dismiss into a motion for summary judgment." *Safe Air For Everyone v. Meyer*, 373 F.3d 1035, 1039 (9th Cir. 2004) (citing *Savage v. Glendale Union High Sch.*, 343 F.3d 1036, 1039 n.2 (9th Cir. 2003)).

The plaintiff bears the burden of proving by a preponderance of the evidence that each of the requirements for subject-matter jurisdiction has been met. *Leite*, 749 F.3d at 1121. Thus, where the moving party makes a factual attack on jurisdiction "'by presenting affidavits or other evidence properly brought before the court,'" the party opposing a factual challenge to jurisdiction "'***must*** furnish affidavits or other evidence necessary to satisfy its burden of establishing subject matter jurisdiction.'" *Safe Air*, 373 F.3d at 1039 (quoting *Savage*, 343 F.3d at 1039 n.2) (emphasis added). "[I]f the existence of jurisdiction turns on disputed factual issues, the district court may resolve those factual disputes itself" (*Leite*, 749 F.3d at 1121-22) unless "the issue of subject-matter jurisdiction is intertwined with an element of the merits of the plaintiff's claim." *Id.*, fn.3 (citations omitted).

C. Standing in a Patent Infringement Suit Requires that the Plaintiff Show that He Had Title to the Patent at the Time the Suit Was Filed

Standing in a patent infringement suit requires possession of title for the patent at issue at the time the suit is brought. *Filmtec Corp. v. Allied*-Signal. *Inc.*, 939 F.2d 1568, 1571 (Fed. Cir. 1991). "[T]o assert standing for patent infringement, the plaintiff must demonstrate that it held enforceable title to the patent ***at the inception of the lawsuit***. *Paradise Creations, Inc. v. UV Sales, Inc.*, 315 F.3d 1304, 1309 (Fed.Cir.2003) (emphasis in original); *see also Lans v. Digital Equip. Corp.*, 252 F.3d 1320 (Fed.Cir.2001) (affirming dismissal of plaintiff-inventor's complaint and denial of motion to amend pleadings to substitute patent assignee as plaintiff when plaintiff-inventor assigned the patent prior to filing the action).

D. Federal Rule of Civil Procedure 12(b)(6)

Under Federal Rule of Civil Procedure 12(b)(6), a district court must dismiss a complaint if it fails to state a claim upon which relief can be granted. To survive a Motion to Dismiss, a complaint must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when a party pleads "factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *see also Twombly*, 550 U.S. at 555 ("Factual allegations must be enough to raise a right to relief above the speculative level."). Conclusory allegations or "formulaic recitation of the elements of a cause of action will not do." *Iqbal*, 556 U.S at 678 (citations and internal quotations omitted).

While courts generally "accept factual allegations in the complaint as true and construe the pleadings in the light most favorable to the nonmoving party" (*Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008)), "courts do ***not*** 'accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences.'" *Hypermedia Navigation v. Google LLC*, No. 18-cv-06137-HSG, 2019 U.S. Dist. LEXIS 56803, at *2-3 (N.D. Cal. Apr. 2, 2019) (Ex. 14) (quoting *Hartman v. Gilead Scis., Inc. (In re Gilead Scis. Sec. Litig.)*, 536 F.3d 1049, 1055 (9th Cir. 2008)) (emphasis added). Moreover, if the facts alleged do not support a reasonable inference of liability, stronger than a mere possibility, the claim must be dismissed. *Iqbal*, 556 U.S. at 678-79.

E. Willful Infringement

Willful infringement is reserved for "egregious infringement behavior," which is typically described as "willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or –indeed—characteristic of a pirate." *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016). To state a claim for willful infringement, a plaintiff must plead (1) defendant had knowledge of the asserted patents at the time of the alleged wrongdoing, and (2) the defendant's conduct rises to the level of egregiousness described in *Halo*. *Hypermedia*, U.S. Dist. LEXIS 56803, at *8-10 (finding "[k]nowledge of the patent alleged to be willfully infringed

continues to be a prerequisite to enhanced damages," and dismissing complaint for willful infringement where "the complaint fails to plead egregious conduct").

Furthermore, the plaintiff must plausibly plead that defendant knew that it was allegedly infringing the asserted patents at the time the defendant's conduct is alleged to have been willful. *See, e.g., NetFuel, Inc. v. Cisco Sys. Inc.*, No. 5:18-CV-02352-EJD, 2018 U.S. Dist. LEXIS 159412, at *7-8 (N.D.Cal. Sep. 18, 2018) (Ex. 16) ("This district has recognized that there can be no infringement of a patent, willful or otherwise, until the patent issues and the defendant learns of its existence and alleged infringement") (internal citation and quotation omitted).

V. ARGUMENT

A. Tormasi Lacks Standing to Sue Because ADS Owns the '301 Patent

1. There Is No Evidence That Tormasi Had the Authority to Make the January 30, 2019 Assignment from ADS to Himself

Tormasi lacks standing to bring this patent infringement suit because he has not and cannot demonstrate that he holds title to the '301 Patent. Indeed, the only competent evidence of record – the February 7, 2005 assignment, notarized and recorded with the PTO – shows that "for consideration received," Tormasi assigned all of his rights in the '301 Patent to ADS years ago. Ex. 2. Thus, it is ADS *not* Tormasi, that holds title to the '301 Patent, and Tormasi has no standing to sue for its alleged infringement. *See Lans*, 252 F.3d at 1328 (holding the sole inventor on the patent-in-suit had no standing to sue for its infringement where prior to filing the lawsuit he had assigned the patent to his company).

"[T]he plaintiff must demonstrate that it held enforceable title to the patent ***at the inception of the lawsuit***." *Paradise* Creations, 315 F.3d at 1309 (citing *Lans*, 252 F.3d at 1328) (emphasis in original). Tormasi bears the burden of proving by a preponderance of the evidence that each of the requirements for subject matter jurisidiction, including standing, have been met. *Leite*, 749 F.3d at 1121.

Tormasi's claim that as the named "inventor/patentee" of the '301 Patent he has "statutory authority to bring suit against Defendant for infringement of said patent" (ECF 1 ¶7) is legally incorrect since he assigned his rights in the '301 Patent to ADS in February 2005. And,

the lone document provided by Tormasi – a January 30, 2019 writing in which Tormasi purported to assign the '301 Patent from ADS to himself in his alleged capacities as ADS's "President" and "Sole Shareholder" (ECF 1 Ex. A) – falls far short of meeting his burden of proving standing. This is because there is not a shred of evidence that Tormasi is either the President or sole shareholder of ADS, or that Tormasi had any right whatsoever to assign the '301 Patent from ADS to himself.

Significantly, Tormasi is not listed on ADS's incorporation document or franchise tax payment documents as an officer, director, or shareholder. Exs. 4 & 5. Moreover, Tormasi's February 7, 2005 assignment of his interest in the '301 Patent to ADS does not identify Tormasi as having an ownership interest in ADS, but rather states the assignment to ADS was for unspecified "consideration received." Ex. 2.

The February 7, 2005 assignment lists ADS's address as Fairview Avenue (Ex. 2), a property that at that time was owned by Tormasi Housing Somerville, LLC of which Tormasi's father, Attila Tormasi, was the sole member. Exs. 7 & 8. Ownership of this property was transferred in 2012 to TDKH, LLC. Ex. 7. Tormasi is not listed as a member of TDKH and it appears that he has no relationship to TDKH. Ex. 9.

In his 2008 Complaint and 1st Amended Complaint discussed above, Tormasi alleged (with no supporting documentation) that ADS's address was Middle Road. Ex. 3 ¶6 & Ex. 12 ¶6. This property, too, was owned by Tormasi's father until it was transferred to a third-party – Matthew Northrup – after Tormasi's father passed away. Ex. 6.

Lacking any evidence that Tormasi had the authority to assign ADS's '301 Patent from ADS to himself, the January 30, 2019 alleged assignment is not valid and no assignment of the '301 Patent from ADS to Tormasi was effectuated.

This case is on all fours with the facts of *Raniere v. Microsoft Corp.*, 887 F.3d 1298 (Fed. Cir. 2018). In *Raniere*, Plaintiff Keith Raniere sued Defendants for infringement of patents he allegedly owned. In 1995, however, Raniere and the other named inventors of the patents-in-suit assigned their rights to the patents to Global Technologies, Inc. ("GTI"). *Id.* at 1300. Raniere was

"not listed on GTI's incorporation documents as an officer, director or shareholder," and "GTI was administratively dissolved in May 1996." *Id.* Nearly twenty (20) years later in December 2014, "Raniere executed a document on behalf of GTI, claiming to be its 'sole owner,' that purportedly transferred the asserted patents from GTI to himself." *Id.* "Raniere's suits against [the Defendants] identified himself as the owner of the patents at issue." *Id.*

Defendants "moved to dismiss Raniere's suit for lack of standing, noting that the PTO's records indicated that Raniere did not own the patents at issue." *Id.* Raniere's counsel represented that Raniere owned GTI (and thus the December 2014 assignment was valid), but when ordered by the Court to produce documents confirming this representation, Raniere was unable to do so. *Id.* Ultimately, after Raniere was provided with multiple opportunities to produce documents evidencing his ownership of GTI but did not do so, the district court dismissed Raniere's suit for lack of standing. *Id.* at 1301. The Federal Circuit affirmed the district court's dismissal for lack of standing. *Id.* at 1307 n.2 (citing *Raniere v. Microsoft Corp.*, 673 F. App'x. 1008 (Fed. Cir. 2017)).

Where, as here, WDC makes a factual attack on jurisdiction, Tormasi "'must furnish affidavits or other evidence necessary to satisfy [his] burden of establishing subject matter jurisdiction.'" *Safe Air*, 373 F.3d at 1039 (quoting *Savage*, 343 F.3d at 1039 n.2). Tormasi's own prior own pleadings, however, confirm he cannot do so. Tormasi previously alleged that over twelve years ago prison officials confiscated as contraband ADS corporate documents, including the 2004 Assignment which he alleges gave him an ownership interest in ADS, and without such documents he "cannot prove his ownership of ADS to the satisfaction of interested third parties." Ex. 3 ¶22(a) & Ex. 12 ¶22(a).

Tormasi's Complaint must be dismissed for lack of standing.

2. The January 30, 2019 Assignment is Invalid Because ADS was in a Void Status When the Assignment Purportedly Was Made

The January 30, 2019 assignment is further invalid because ADS was in a "void" status when Tormasi purported to assign the '301 Patent from ADS to himself and has been since March 1, 2008. Ex. 10. Under Delaware law, when a company is in a "void" status, "all powers

conferred by law upon the corporation are declared inoperative." 8 Del. C. § 510 (effective Jan. 1, 2008). The powers that are conferred, and thus lost when the corporate status is void, include the power to "deal in and with real or personal property, or any interest therein, wherever situated, and to sell, convey, lease, exchange, transfer or otherwise dispose of, or mortgage or pledge, all or any of its property and assets, or any interest therein, wherever situated." 8 Del. C. § 122(4).

It is indisputable that the '301 Patent is an intangible corporate asset. Thus, due to its void status, ADS lacked (and still lacks) the power to "sell, convey, lease, exchange, transfer or otherwise dispose of" the '301 Patent. And, the attempted assignment of the '301 Patent from ADS to Tormasi is invalid.

Notably, while a void corporation may continue to hold property, and it is only in "a state of coma from which it can be easily resuscitated," until it is resuscitated (by *inter alia* paying back taxes and penalties owed (8 Del. C. § 312)) "its powers as a corporation are inoperative, and the exercise of these powers is a criminal offense." *Wax v. Riverview Cemetery Co.*, 24 A.2d 431, 436 (Del.Super.Ct. 1942)).

While the Delaware code unambiguously supports WDC's contentions regarding the invalidity of the January 30, 2019 assignment, the Court's attention is respectfully directed to *Parker v. Cardiac Sci., Inc.*, No. 04-71028, 2006 U.S. Dist. LEXIS 90014 (E.D. Mich. Nov. 27, 2006) (Ex. 17). In *Parker*, citing the Delaware Supreme Court's decision in *Krapf & Son, Inc. v. Gorson*, 243 A.2d 713 (Del. 1968), the court found that a writing ratifying a Delaware corporation's prior oral assignment of a patent was valid even though the writing was executed when the corporation was in a void status. The facts of *Krapf* and *Parker*, however, are readily distinguishable from those presented in this case.

In *Krapf*, a company's president entered into a contract on behalf of a corporation which, unbeknownst to him, had been declared void (*i.e.*, forfeited its charter) for failure to pay franchise taxes. 243 A.2d at 714. The corporation was subsequently revived pursuant to 8 Del. C. §312. *Id.* The question before the Court was whether the corporation's president could be held

personally liable for a contract he entered into on behalf of the corporation after the company was declared void and before it was revived under Delaware law. *Id.* at 714.

In holding that the president was not personally liable, the Delaware Court found that since the corporation had been properly revived, the contract was "validated." *Id.* at 715 (citing 8 Del. C. §312 (e)). The Court explained:

> The result of the reinstatement of the [corporation] was, therefore, to validate the contract with [Appellant] as a binding contract with the corporation for breach of which it could be sued.

Id. The Court also rejected Appellant's argument that 8 Del. C. § 513, which makes it a criminal offense for a person to exercise corporate powers when the corporation is in a void status, precluded the company's president from entering into a binding commitment on behalf of the corporation while it was in a void. *Id.* In so doing, the *Krapf* Court noted this criminal statute had "no bearing in a contest between private parties," but rather was "a remedy given the state against a corporation, the officers of which persist in exercising its corporate powers after the charter forfeiture." *Id.*

The *Krapf* Court also found significant the facts that the forfeiture of the company's charter was inadvertent and there was no fraud or bad faith on the part of the company president in entering into the contract. *Id.* at 715.

Similarly, in *Parker*, the Michigan court found it significant that an oral patent assignment (which was ratified by a writing executed after the company's charter was forfeited) was entered into before the company was in a void status, the forfeiture of the company's charter was inadvertent, and the company could be revived under Delaware law. 2006 U.S. Dist. LEXIS 90014, at *5-8.

The holdings of *Krapf* and *Parker* thus rest squarely on the notion that a void company can be revived under 8 Del. C. §312, and contracts entered into during this void period can ultimately be validated. Tormasi, however, cannot revive ADS. To do so would require Tormasi to take a number of actions on behalf of ADS (*see* 8 Del. C. §312) – *i.e.*, it would require Tormasi to operate a business, which as explained in Section III.E and V.B, he is prohibited from

doing as an inmate in a New Jersey prison. Thus, unlike the contracts in *Krapf* and *Parker*, Tormasi's purported assignment of the '301 Patent from ADS to himself ***cannot*** be validated.

Moreover, Tormasi's alleged assignment lacks the hallmarks of good faith and inadvertence that were present in *Krapf* and *Parker*. ADS's void status is not "inadvertent," and Tormasi's purported assignment of ADS's patent to himself is an obvious bad faith (albeit failed) effort to do an end-run around the New Jersey prison's "no-business" rule. Indeed, by bringing this patent infringement suit, Tormasi is using the courts in an effort to monetize the '301 Patent, and thus in furtherance of his business interests as an individual, which he is barred from doing under New Jersey law.[2]

B. Tormasi Lacks the Capacity to Sue Because as an Inmate in the New Jersey Prisons he is Prohibited from Operating a Business

Tormasi lacks the capacity to sue for patent infringement because doing so constitutes operating a business which is prohibited under New Jersey law. A party's capacity to sue is determined by the law of the party's domicile. FRCP 17(b). In this case, Tormasi has been incarcerated in New Jersey correctional facilities since 1998 and was a resident of New Jersey prior to his incarceration. New Jersey law, therefore, is controlling.

As discussed, N.J.A.C. 10A:4-4.1(.705) prohibits Tormasi from running a business without the approval of the Administrator. As was also discussed, in Tormasi's case, the New Jersey federal court and the Third Circuit have found that his efforts at patent monetization and enforcement run afoul of New Jersey's "no-business rule," and pursuant to this rule approved the confiscation as contraband documents that Tormasi alleges were a patent application assignment, ADS corporate documents, prosecution documents for the '301 Patent and an unfiled patent application. *See* Section II.E, above.

The fact that Tormasi is once again attempting to pursue his business interests while an inmate in a New Jersey correctional facility is evident from Tormasi's Complaint itself. In

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[2] To the extent *Parker* can be read as finding that an assignment made by a Delaware corporation in a void status is effective, it is directly contrary to 8 Del. Ch. § 510 and should not be followed.

Paragraph 1 of the Complaint, Tormasi alleges that he is "an innovator and ***entrepreneur,*** developing inventions in technology and other areas." ECF 1 ¶1 (emphasis added). While Tormasi's prior efforts at patent monetization were under the auspices of ADS, and his current attempts to pursue his business interests are as a sole proprietor, that is a distinction without a difference. *See e.g.*, *Kadonsky v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 2508, at *1, 21 (N.J.Super.A.D. Oct. 30, 2015) (Ex. 18) (Court upheld finding of .705 prohibited act violation stemming from legal work inmate Kadonsky, an individual, performed on behalf of another inmate); *Helm v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 1062 (N.J.Super.A.D. May 8, 2015) (Ex. 19) (Inmate Helm found guilty of .705 prohibited act because he signed paperwork regarding the sales of his artwork and taxes to be paid from those sales and because attorneys assisting him were compensated from income generated by the sales); *Stanton v. New Jersey Dept. of Corrections*, 2018 N.J. Super. Unpub. LEXIS 2106, at*9-10 (N.J.Super.A.D. Sep. 21, 2018) (Ex. 20) (Inmate Stanton found guilty of .705 violation where evidence showed he was selling magazines, received letters from inmates asking how they might be published, and sought price quote from publisher in his purported capacity as CEO of Starchild Publishing).

The "rational connection between the no-business rule and the legitimate penological objective of maintaining security and efficiency at state correctional institutions," articulated by the Tormasi II court – *e.g.*, "operating a business inside a correctional facility would seriously burden operation of incoming and outgoing mail procedures," and "could result in the introduction of contraband into prisons" (Tormasi II, at *32) – are particularly compelling here.

Indeed, Tormasi was previously found to have attempted to "subvert the security and safety of the facility" by attempting to mail "fourteen legal briefs that had been hollowed out to create hidden compartments" that "can easily be used to traffic contraband to and from the facility." *Tormasi v. New Jersey Dept. of Corrections*, 2007 N.J. Super. Unpub. LEXIS 1216, at *1-4 (N.J.Super.A.D. Mar. 22, 2007) (Ex. 21). The New Jersey Court found unpersuasive

Tormasi's self-serving declaration that "another inmate's documents were intermingled with [his] or that the documents were planted to fabricate charges against [him]." *Id.* at *2.

Tormasi's Complaint should be dismissed for lack of capacity to sue.

C. Tormasi Fails to Plausibly Plead Willful Infringement

Tormasi's willful infringement claim should be dismissed under Fed. R. Civ. P. 12(b)(6) because (1) Tormasi fails to plead facts plausibly supporting WDC's pre-suit knowledge of the '301 Patent and its alleged infringement; and (2) Tormasi fails to plead facts plausibly supporting that WDC's conduct was "egregious."

1. Tormasi Fails to Plausibly Plead WDC's Pre-Suit Knowledge of the '301 Patent and its Alleged Infringement

Willful infringement requires knowledge of the patent. *Hypermedia,* U.S. Dist. LEXIS 56803, at *8-9 (citations and internal quotations omitted). In this case, Tormasi pleads no ***facts*** to support the notion that WDC had pre-suit knowledge ***of the '301 Patent***, much less its alleged infringement. Indeed, Tormasi's allegations on these points consist entirely of the conclusory and unsupported statements that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." ECF 1, ¶¶36, 44. Such conclusory allegations, however, "will not do" *Iqbal,* 556 U.S at 678; *see also, e.g., Elec. Scripting Prods. v. HTC Am. Inc.*, No. 17-cv-05806-RS, 2018 U.S. Dist. LEXIS 43687, at *19-20 (N.D. Cal. Mar. 16, 2018) (Ex. 22) (Plaintiff's "conclusory statement" that its patents "were well known to defendants" because defendants had "written notice of the Patents" insufficient to plead pre-suit knowledge because it provided "no information as to what the written notice entailed or when it was delivered to, or received by [Defendant] such that [Defendant's] knowledge could reasonably be inferred.")

a) Pleading Knowledge of a Patent Application is Insufficient

Tormasi speculates that WDC was aware of the ***application*** that led to the '301 Patent. ECF 1, ¶¶37-42. Such speculation, however, falls far short of the showing required to plausibly plead pre-suit knowledge of ***the '301 Patent*** itself. Pleading "knowledge of the patent application is insufficient, without more, plausibly to support an allegation that the infringer had knowledge

of the patent-in-suit." *Adidas Am., Inc. v. Skechers USA, Inc.*, No. 3:16-cv-1400-SI, 2017 U.S. Dist. LEXIS 89752, at *9 (D. Or. June 12, 2017) (Ex. 23); *see also NetFuel*, 2018 U.S. Dist. LEXIS 159412, at *5 ("The general rule in this district is that knowledge of a patent application alone is insufficient to meet the knowledge requirement for either a willful or induced infringement claim.") Indeed, "[t]o willfully infringe ***a patent***, the patent must exist and one must have knowledge of it." *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985) (emphasis in original) "Filing an application is no guarantee any patent will issue and a very substantial percentage of applications never result in patents. What the scope of claims in patents that do issue will be is something totally unforeseeable." *Id.*

b) In Any Event, Tormasi Fails to Plausibly Plead WDC's Knowledge of the Application that Led to the '301 Patent

Even if Tormasi could plausibly plead the "knowledge" element of willfulness by pleading knowledge of the '301 ***application*** (he cannot), Tormasi's claim still fails because he does not plead ***facts*** leading to the reasonable inference that WDC had pre-suit knowledge of the '301 application. Instead, Tormasi relies entirely on rank speculation couched as "information and belief" (ECF 1 ¶¶36-44) and a mosaic of "unwarranted deductions of fact" and "unreasonable inferences" which the Court need not credit. *See Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *2-3 ("[C]ourts do not accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences") (citation omitted).

Tormasi baldly asserts "upon information and belief" – with no factual basis or any attempt at identifying the "information" on which he purportedly relies – that WDC's "legal and technology departments customarily and routinely review ***all*** published patent applications pertaining to the field of magnetic storage and retrieval." *Id.* ¶39 (emphasis added). Tormasi then unreasonably infers that since the '301 application was published in November 2005 and available in electronic databases, WDC "encountered" and "had actual knowledge of" it. *Id.*

Such a conclusory allegation falls far short of plausibly pleading WDC's knowledge of the '301 application. *See, e.g., Electronic Scripting*, 2018 U.S. Dist. LEXIS 43687, at *19-20 (Plaintiff's "allegations regarding 'defendant's exercise of due diligence pertaining to intellectual

property affecting its Devices,'" insufficient to establish knowledge of the patent-in-suit); *Nanosys, Inc v. QD Visions, Inc.*, No. 16-cv-01957-YGR, 2016 U.S. Dist. LEXIS 126745, at *4-8 (N.D. Cal. Sep. 16, 2016) (Ex. 24) (allegations that defendant's "founders and key employees were, at least, aware of and knowledgeable about developments and advances in the field and patent filings through their activities conducted through industry conferences, research, and development" insufficient to support an inference of pre-suit knowledge of patent).

Indeed, Tormasi's allegations provide no information about who at WDC supposedly "encountered" the '301 application, when this occurred or how "such an "encounter" could possibly put WDC on notice that it was infringing the claims of a patent that had not yet issued. In essence, Tormasi proposes that WDC be presumed to have actual knowledge of every published application in the field of "magnetic storage and retrieval" and, and thus every patent that issues from such patent applications, a proposition that stands the requirement of plausibly pleading knowledge of the patent-in-suit on its head.

c) Tormasi Fails to Plausibly Plead WDC's Knowledge of Alleged Infringement of the '301 Patent

Courts in this District have held that claims of willful patent infringement require an allegation not only that the defendant knew of the asserted patents, but also that the defendant knew of its alleged infringement during the relevant time period. *See, e.g., NetFuel*, 2018 U.S. Dist. LEXIS 159412, at *7-8 (N.D. Cal. Sept. 18, 2018) ("This district has recognized that 'there can be no infringement of a patent, willful or otherwise, until the patent issues and the defendant learns of its existence and ***alleged infringement***") (emphasis added);

Tormasi's complaint, however, does not allege any facts that would support that WDC had pre-suit knowledge that it infringed any claim of the '301 Patent. Tormasi's pleading in this regard consists only of the conclusory and plainly insufficient statement that "Defendant knew that its [accused devices] violated U.S. Patent No. 7,324,301." ECF 1 ¶36, 44.

Tormasi alleges that WDC began using the accused infringing devices "two or three years" after the '301 application was published – a period of time which Tormasi baldly asserts (with no factual support whatsoever) "corresponds with the lead time needed to research and

develop new technology." ECF 1, ¶41. From this Tormasi draws the unreasonable inference that WDC began "researching and developing its [accused devices] within weeks or months after having actual knowledge of Plaintiff's published patent application." *Id.* Tormasi's conclusory allegations, unwarranted factual deductions and unreasonable inferences are not well-pled, and thus do not plausibly plead WDC's knowledge of the '301 Patent and its infringement.

2. Tormasi Fails to Allege Egregious Conduct

Following the *Halo* decision, courts in this District have required plaintiffs to plead facts sufficient to demonstrate "egregious" conduct to sustain a willful infringement claim. *See, e.g., Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *10 (Dismissing willfulness claim where "the complaint fails to plead egregious conduct"); *Finjan, Inc. v. Cisco Sys. Inc.*, No. 17-CV-00072-BLF, 2017 U.S. Dist. LEXIS 87657, at *9 (N.D. Cal. June 7, 2017). (Ex. 25) (same).

In *Hypermedia,* prior to filing suit, Plaintiff sent a letter to Defendant "regarding licensing of [Plaintiff's] intellectual property." 2019 U.S. Dist. LEXIS 56803, at *3. The letter referenced a potential "non-litigation business discussion" between Plaintiff and Defendant, identified patents in Plaintiff's portfolio, and included figures from one of the patents and a chart identifying Plaintiff's patents allegedly relevant to Defendant's products. *Id.* at *3-4. Plaintiff pled that after receiving the letter, Defendant did not investigate to form a good faith basis that the patents were invalid or not infringed but continued its allegedly infringing conduct. *Id.* at *9.

This Court found that Plaintiff failed to plausibly plead "egregiousness" because "[n]othing in the complaint provide[d] specific factual allegations about [Defendant's] subjective intent or details about the nature of [Defendant's] conduct to render a claim of willfulness plausible, and not merely possible." *Id.* at *10 (citing *Slot Speaker Techs., Inc. v. Apple, Inc.*, No. 13-cv-01161-HSG, 2017 U.S. Dist. LEXIS 161400, at *8 (N.D. Cal. Sep. 29, 2017) (Ex. 15) ("Defendant's ongoing [operations], on their own, are equally consistent with a defendant who subjectively believes the plaintiff's patent infringement action has no merit."). This Court found that "Plaintiff cites no case for the broad proposition that a defendant who receives a letter asking if they are 'interested in [a] non-litigation business discussion,' must cease operations

immediately to avoid a willful infringement claim." *Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *10. (internal citations and quotations omitted).Similarly, in *Finjan v. Cisco*, the Court found Plaintiff had not plausibly plead egregiousness where Plaintiff made only conclusory assertions that "[d]espite knowledge of Finjan's patent portfolio, Defendant has sold and continues to sell the accused products and services." 2017 U.S. Dist. LEXIS 87657, at *3.

Here, Tormasi's complaint is completely devoid of any allegations suggesting any "egregious" conduct. Moreover, the conduct that Tormasi speculates occurred all centers on the publication of the ***application*** leading to the '301 and not the '301 ***Patent*** itself. Such conduct, even if true, simply could not rise to the level of egregious behavior – "[t]o willfully infringe ***a patent***, the patent must exist and one must have knowledge of it." *State Indus.*, 751 F.2d at 1236 (emphasis in original). Thus, Tormasi fails to plead "specific factual allegations about [WDC's] subjective intent or details about the nature of [WDC's] conduct to render a claim of willfulness plausible, and not merely possible." *Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *10.

Tormasi's claim for willful infringement must be dismissed.

D. Tormasi Fails to Plausibly Plead Indirect Infringement

Tormasi's Complaint alleges "General Infringement" but does not cite the sections of 35 U.S.C. §271 under which he is proceeding. ECF 1, ¶¶25-35. WDC understands Tormasi's claim to be one for direct infringement only, however, to the extent Tormasi asserts that his causes of action are also for indirect infringement – either induced infringement under §271(b) or contributory infringement under §271(c) – such claims must be dismissed under Fed. R. Civ. P. 12(b)(6) for failure to state a claim.

Liability for inducement infringement "only attach[es] if the defendant knew of the patent and knew as well that 'the induced acts constitute patent infringement.'" *Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *4 (citing *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1926 (2015) (quoting *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011)). Here, Tormasi's Complaint does not plausibly plead a cause of action for induced infringement because: (1) as discussed in Section V.C.1 above, Tormasi does not plausibly plead WDC's

knowledge of the '301 Patent; and (2) the Complaint is utterly devoid of any factual allegations from which the Court could "reasonably infer" that WDC had the specific intent to encourage any third-party to infringe the '301 Patent. *See Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *4-8 (dismissing Plaintiff's claim for induced infringement where Plaintiff failed to plausibly plead the requisite "specific intent" to encourage others to infringe).

Liability for contributory infringement under 35 U.S.C. §271(c) requires a showing that the alleged contributory infringer ***knew*** "that the combination for which [its accused infringing] component was especially designed was both patented and infringing." *Global-Tech*, 563 U.S. at 763 (citations and quotations omitted). Thus, to state a claim for contributory infringement, Tormasi must allege facts plausibly showing that (1) WDC had the requisite knowledge and (2) the accused products have "no substantial non-infringing uses." *In re Bill of Lading Transmission & Processing Sys. Patent Litig.*, 681 F.3d 1323, 1337 (Fed. Cir. 2012) (citation omitted); *see also Superior Indus. LLC v. Thor Global Enters. Ltd.*, 700 F.3d 1287, 1295-96 (Fed. Cir. 2013) (affirming dismissal of contributory infringement claim where plaintiff failed to plausibly allege lack of substantial non-infringing uses).

In this case, Tormasi fails to plausibly plead WDC's knowledge of the '301 Patent and pleads ***no*** facts to support the reasonable inferences that (a) WDC knew that any of its devices were patented and infringing, and (b) that WDC's accused infringing devices have no substantial non-infringing uses. Thus, to the extent Tormasi asserts that his cause of action for "General Infringement" includes claims for induced and/or contributory infringement, those claims must be dismissed under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim.

VI. CONCLUSION

For the foregoing reasons, Defendant Western Digital Corporation respectfully requests that its Motion to Dismiss be granted.

Dated: April 25, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

I am a partner of WALTERS WILSON LLP, and my business address is 702 Marshall Street, Suite 611, Redwood City, CA 94063.

I hereby certify that I caused to be served a copy of the following document on each of the persons listed below by the means specified:

DEFENDANT WESTERN DIGITAL CORPORATION'S ADMINISTRATIVE MOTION TO CHANGE TIME PURSUANT TO CIVIL L.R. 6-3

☑ A true and correct copy of said document was deposited in a United States postal service mailbox for delivery via first class mail, postage prepaid, on April 25, 2019.

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WALTER A. TORMASI,	:	CASE NO. 4:19-cv-00772-HSG
Plaintiff,	:	HEARING DATE: AUG. 22, 2019
v.	:	ASSIGNED JUDGE: HON. HAYWOOD S. GILLIAM, JR., U.S.D.J.
WESTERN DIGITAL CORP.,	:	
Defendant.	:	

BRIEF IN OPPOSITION TO DEFENDANT'S MOTION TO DISMISS

WALTER A. TORMASI, PLAINTIFF
ATTORNEY PRO PERSONA
OF COUNSEL AND ON THE BRIEF

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RELIEF SOUGHT

Plaintiff Walter A. Tormasi categorically opposes Defendant Western Digital Corp.'s Motion to Dismiss and respectfully requests that said motion be denied in its entirety.

STATEMENT OF ISSUES TO BE DECIDED

In its Motion to Dismiss, Defendant advances three primary arguments. The first argument asserts that Plaintiff lacks standing to bring suit. The second argument asserts that prison regulations removed Plaintiff's suing capacity. The third argument asserts that Plaintiff failed to satisfy pleading standards regarding his willful-infringement claim. Plaintiff addresses these arguments in the order listed.

STATEMENT OF FACTS

The relevant facts are detailed in Plaintiff's Complaint and accompanying Declaration and exhibits, which Plaintiff incorporates herein by reference. With that antecedent factual basis, the below discussion proceeds accordingly.

LEGAL ARGUMENT

POINT I

PLAINTIFF OWNS THE PATENT-IN-SUIT AND HAS FULL ENFORCEMENT AUTHORITY, GIVING PLAINTIFF STANDING TO SUE UNDER 35 U.S.C. § 281.

Defendant is incorrect in asserting lack of standing. This is because Plaintiff was the legal title holder of the patent-in-suit during the period of infringement. Plaintiff,

moreover, had express authority to sue for prior acts of infringement. These circumstances, among others, provided Plaintiff with standing under 35 U.S.C. § 281.

As the Court is aware, plaintiffs must have standing to sue for damages in federal court. Crown Die & Tool Co. v. Nye Tool & Mach. Works, 261 U.S. 24 (1923). This requirement applies equally to patent-infringement cases. Id. at 40-41.

The United States Code gives "patentee[s] . . . remedy by civil action for infringement." 35 U.S.C. § 281. The term "patentee," as used in § 281, is synonymous with "legal title holder" and includes not only the person or entity "to whom the patent was issued but also the successors in title to the patentee." Arachnid, Inc. v. Merit Industries, Inc., 939 F.3d 1574, 1578 n.2 (Fed. Cir. 1991) (citing 35 U.S.C. § 100(d)).

Accordingly, in order "to recover money damages for infringement," the patent-asserting person or entity "must have held the legal title to the patent during the time of the infringement." Id. at 1579. Alternatively, if legal title vested post-infringement, the title-conferring instrument must have expressly authorized "right of action for past infringements." Id. at 1579 n.7 (citing cases).

Plaintiff submits that the foregoing standards provide him with standing to sue. This is especially the case when considering not only Plaintiff's factual allegations (as set

forth in his Complaint) but also relevant extrinsic evidence (namely, his accompanying Declaration and exhibits).

As alleged in his Complaint, Plaintiff "is the . . . patentee of U.S. Patent No. 7,324,301 and, as such, has the statutory authority to bring suit against Defendant for infringement of said patent." (Compl. ¶ 7 (citing 35 U.S.C. § 281).) Plaintiff, moreover, "owns all right, title, and interest in the foregoing patent, with such ownership permitting Plaintiff 'to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301.'" (Compl. ¶ 8 (quoting Compl. Exh. A).)

These allegations are entirely sufficient to establish standing. Significantly, pursuant to Arachnid, supra, Plaintiff alleged not only current ownership but also express authority to sue for past infringement. These allegations, if true (which they are), give Plaintiff "remedy by civil action for infringement of his patent." 35 U.S.C. § 281.

Assuming, arguendo, that Plaintiff's allegations in his Complaint fail to establish standing, this Court should turn to the extrinsic evidence proffered by Plaintiff. Such extrinsic evidence consists of Plaintiff's accompanying Declaration and exhibits. Those documents confirm that Plaintiff owns the patent-in-suit and has retroactive enforcement authority.

Specifically, according to his proffered Declaration and

exhibits, Plaintiff was, and is, the sole shareholder of Advanced Data Solutions Corp. (ADS), an entity that previously owned the patent-in-suit. (Tormasi Decl. ¶¶ 7-10.) While serving as an ADS director and ADS executive, Plaintiff authorized and executed various intellectual-property Assignments in 2007, 2009, and 2019. (Tormasi Decl. ¶¶ 16-17, 23, 28-30; Tormasi Decl. Exhs. C, D, G, H, L.) Those Assignments, which included the Assignment appended to Plaintiff's Complaint, conveyed to Plaintiff all right, title, and interest in the patent-in-suit. (Tormasi Decl. Exhs. D, H, L.) Notably, the Assignments from 2007 and 2009 were executed prior to the cause of action (i.e., before the six-year period preceding Plaintiff's Complaint), with the Assignments from 2009 and 2019 giving Plaintiff express retroactive enforcement authority. (Tormasi Decl. Exhs. D, H, L.)

Like the allegations in his Complaint, Plaintiff's Declaration and exhibits establish his standing to sue under 35 U.S.C. § 281. This is because, pursuant to Arachnid, supra, Plaintiff has proven his ownership of the patent-in-suit during the term of infringement or, at the very least, proven his authority to sue for pre-ownership acts of infringement.

In challenging Plaintiff's ownership of the patent-in-suit, Defendant postulates that Plaintiff cannot present evidence establishing his status as an ADS shareholder, director, and

executive. Relying on that premise, Defendant contends that Plaintiff lacked authority to execute ADS assignments.

Contrary to Defendant's premise, Plaintiff's Declaration establishes his formation of ADS; his service as an ADS director; his appointment to various executive positions, including President and Chief Executive Officer; and his ownership of all ADS stock. (Tormasi Decl. ¶¶ 7-10, 16-17, 23, 32-33; Tormasi Decl. Exhs. C, D, G, H, L.) To Defendant's point, Plaintiff acknowledges his inability to produce certain ADS records due to seizure by prison officials. (Tormasi Decl. ¶¶ 13, 35.) However, Plaintiff's Declaration, which is supported by corroborating evidence (see Tormasi Decl. ¶ 33), is sufficient to prove his ADS ownership/stewardship. Defendant is thus incorrect is arguing that Plaintiff lacked authority to represent ADS and execute assignments on its behalf.

In its Motion to Dismiss, Defendant relies heavily on the fact that ADS entered defunct status in 2008. Defendant believes that such an irregularity prevented ADS from executing any post-2008 assignments, particularly the Assignment from 2019. Defendant therefore argues that ADS continues to hold legal title to the patent-in-suit and, consequently, that Plaintiff lacks standing to sue under 35 U.S.C. § 281. These arguments are without merit for multiple reasons.

First and foremost, long-standing Delaware law permits

defunct corporations to enter into binding contracts under certain circumstances. See Krapf & Son, Inc. v. Gorson, 243 A.2d 713, 715 (Del. 1968). Those circumstances include situations where "the forfeiture of the [corporate] charter came about by inadvertence" and where the contract was executed "in the absence of fraud or bad faith." Id. Both circumstances were present here, making the post-2008 Assignments valid.

As detailed in his Declaration, Plaintiff expected his family members to pay yearly fees to The Company Corporation for purposes of maintaining regulatory compliance. (Tormasi Decl. ¶¶ 19, 37.) Plaintiff recently learned, however, that his father suffered medical disabilities and failed to make such payments, causing Delaware officials to place ADS on defunct status in 2008. (Tormasi Decl. ¶ 37.) But because Plaintiff did not learn about the corporate default until receiving Defendant's Motion to Dismiss, Plaintiff assumed that ADS remained in good standing with Delaware officials and operated ADS accordingly. (Tormasi Decl. ¶¶ 37-39.) Ultimately, Plaintiff authorized and executed two post-2008 Assignments in his capacity as an ADS director and executive. (Tormasi Decl. ¶¶ 23, 28, 32; Tormasi Decl. Exhs. G, H, L.)

These circumstances render Plaintiff's Assignments from 2009 and 2019 authoritative despite the 2008 default by ADS. In accordance with Krapf, supra, Plaintiff has demonstrated that

the corporate default was "inadvertent" and that the post-2008 Assignments were executed "in the absence of fraud or bad faith." 243 A.2d at 715. The Assignments from 2009 and 2019 are therefore "binding on the corporation." Id.

This Court must, of course, abide by Krapf. Simply stated, federal courts are prohibited from overruling state courts on questions of state law. The ruling in Krapf is therefore controlling and must be followed and applied here.

In its Motion to Dismiss, Defendant appears to argue that Krapf is inconsistent with certain Delaware statutes and is inapplicable to the facts of this case. That argument must be rejected. First, even if Krapf is somehow materially distinguishable, Plaintiff relies on Krapf for its legal holding, not its factual similarity. Second, despite Defendant's diverging views on the impact of certain Delaware statutes, Krapf constitutes final authority in interpreting Delaware law and, as noted, must be followed and applied.

It stands to reason that Krapf is controlling and cannot be sidestepped. But even if Krapf is disregarded, Defendant continues to be wrong in arguing that ADS became incapacitated after defaulting with Delaware officials in 2008.

It is well established that improperly maintained corporations can exist de facto, with de facto corporations being equivalent to legally compliant corporations. See

C.J.S. Corporations §§ 63-64, at pp. 336-39 (West Publishing Co. 1990). It is also well established that defunct corporations continue to maintain their corporate existence for asset-disposal purposes and, further, that executives and directors of defunct corporations are permitted to retain and exercise their corporate powers and duties. See id. §§ 859, 962-64, at pp. 514, 516-21; 8 Del. Code Ann. § 278.

Based on the circumstances outlined in Plaintiff's Declaration, it is clear that ADS assumed de facto corporate status after inadvertently defaulting with Delaware regulators in 2008. It is also clear that the subsequent Assignments from 2009 and 2019 were undertaken by ADS for asset-disposal purposes. For those reasons, ADS and its stewardship had the power to authorize and execute post-2008 assignments.

Defendant's invalidity arguments are flawed in other respects. Aside from incorrectly presuming that ADS became incapacitated after its 2008 default, Defendant fails to recognize that assets of unindebted corporations are distributed to shareholders. See C.J.S. Corporations, supra, § 875, at pp. 533-34; 8 Del. Code Ann. § 281. In this case, Plaintiff was, and continues to be, the sole shareholder of ADS, with ADS having no debt/creditors. (Tormasi Decl. ¶¶ 9-10, 41.) So even if Defendant were correct that ADS instantly evaporated in 2008, all ADS assets would have been transferred to Plaintiff,

making him the current owner of the patent-in-suit.

In any event, Defendant's invalidity arguments have no bearing on Plaintiff's pre-2019 Assignments. As explained above, Plaintiff, in his capacity as an ADS director and executive, authorized and executed Assignments in June 2007 and December 2009. (Tormasi Decl. ¶¶ 16-17, 23; Tormasi Decl. Exhs. C, D, G, H.) Those Assignments remain outstanding and binding, even after ADS defaulted with regulators in 2008.

With that said, Plaintiff acknowledges that the Assignment from December 2009 was executed after the 2018 corporate default. That post-2008 Assignment, however, continues to be authoritative under Delaware law. Pursuant to 8 Del. Code Ann. § 278, "corporations, whether they expire by their own terms or are otherwise dissolved, shall nevertheless be continued, for the term of 3 years . . . to dispose of and convey their property . . . and to distribute to their stockholders any remaining assets." Here, ADS was voided in 2008. In accordance with 8 Del. Code Ann. § 278, ADS had until 2011 (three years) to transfer its property. The Assignment from 2009 fell within the three-year window, making that Assignment valid.

The upshot, of course, is that Plaintiff currently owns the patent-in-suit. Equally important, Plaintiff was the title holder during the cause of action and/or had retroactive enforcement authority. Because these conclusions survive

Defendant's evidentiary and legal challenges, Plaintiff has standing to sue under 35 U.S.C. § 281. Defendant's arguments to the contrary are without merit, mandating rejection.

POINT II

ADMINISTRATIVE PRISON REGULATIONS DO NOT, AND CANNOT, TAKE AWAY PLAINTIFF'S CAPACITY TO BRING THE PRESENT INFRINGEMENT ACTION.

Defendant asserts that Plaintiff lacks the capacity to sue under state law. Defendant bases its argument on prison regulations prohibiting inmates from operating businesses while imprisoned. Defendant's lack-of-capacity argument must be rejected, as prison regulations do not, and cannot, prevent Plaintiff from personally suing for patent infringement.

It is well established that prisoners retain the right of access to the courts under the First and Fourteenth Amendments. Bounds v. Smith, 430 U.S. 817 (1977). Pursuant to that right, prison officials must allow prisoners to file civil lawsuits and, conversely, are prohibited from "frustrat[ing] or . . . imped[ing]" any "nonfrivolous legal claim." Lewis v. Casey, 518 U.S. 343, 349, 353 (1996).

Judging from its Motion to Dismiss, Defendant seeks to lay aside Plaintiff's First and Fourteenth Amendment rights by preventing Plaintiff from filing suit while imprisoned. That incapacitation effort is untenable, to say the least.

Defendant is certainly correct that New Jersey inmates are

prohibited from operating businesses without administrative approval. N.J. Admin. Code § 10A:4-4.1(a)(3)(xiv). That prohibition, however, was never intended to supersede Plaintiff's right to file civil lawsuits in his personal capacity. In fact, prison regulations recognize that "[i]nmates have [the] constitutional right of access to the courts," going so far as requiring "[c]orrectional facility authorities [to] assist inmates in the preparation and filing of meaningful legal papers." N.J. Admin. Code § 10A:6-2.1.

To Plaintiff's knowledge, no court has ever invoked an administrative regulation to prevent inmates from suing. Nor has any court ever deemed personal litigation by an inmate tantamount to conducting prohibited business operations.

In support of its lack-of-capacity argument, Defendant cites various nonbinding cases, including Tormasi v. Hayman, 443 Fed. Appx. 742 (3d Cir. 2011). The most that can be said of such nonbinding cases is that prison officials will not be held liable under 42 U.S.C. § 1983 for seizing business-related documents from inmates. The issue here, however, is Plaintiff's capacity to sue, not the liability of prison officials. The cases cited by Defendant are therefore inapposite.

To its credit, Defendant correctly observes that Plaintiff's capacity to sue must be determined by the laws of his domicile. Fed. R. Civ. P. 17(b). Plaintiff resides in New

Jersey, making the laws thereof controlling.

Significantly, according to New Jersey statute, "[e]very person who has reached the age of majority . . . and has the mental capacity may prosecute or defend any action in any court, in person or through another duly admitted to the practice of law." N.J. Stat. Ann. § 2A:15-1. Thus, to bring suit in New Jersey, either personally or through an attorney, Plaintiff must have "reached the age of majority," which occurs at age 18 or age 21 (see N.J. Stat. Ann. § 9:17B-3); and must have possessed "mental capacity." N.J. Stat. Ann. § 2A:15-1. The litigant's imprisonment status or prison behavior is irrelevant to the capacity-to-sue standard. N.J. Stat. Ann. § 2A:15-1.

It cannot be disputed that Plaintiff is well over the ages of 18 or 21, especially considering that Plaintiff has been imprisoned at an adult penitentiary for two decades and is now near mid-life. (Tormasi Decl. ¶¶ 3, 6.) It also cannot be disputed that Plaintiff is intellectually capable, as evidenced by his educational and creative accomplishments. (Tormasi Decl. ¶¶ 4-6.) Plaintiff, in short, has met majority and competency requirements under N.J. Stat. Ann. § 2A:15-1. He therefore has the capacity to sue despite his imprisonment status.

For the sake of completeness, it must be mentioned that legislation previously existed preventing New Jersey inmates from suing while imprisoned. N.J. Stat. Ann. § 59:5-3 (repealed

by L. 1988, c. 55, § 1). Such legislation was deemed unconstitutional 37 years ago. Holman v. Hilton, 542 F. Supp. 913 (D.N.J. 1982), aff'd, 712 F.2d 854 (3d Cir. 1983).

Now, in 2019, there are no laws on the books in New Jersey declaring imprisonment status or prison behavior an incapacity for filing lawsuits. And even if such laws existed, those laws would certainly run afoul of the First and Fourteenth Amendments. Needless to say, Defendant's lack-of-capacity argument is legally unsupportable and must be rejected.

POINT III

PLAINTIFF ADEQUATELY ALLEGED DEFENDANT'S LIABILITY FOR WILLFUL INFRINGEMENT, THEREBY COMPLYING WITH PLEADING REQUIREMENTS.

Also without merit is Defendant's objection to Plaintiff's willful-infringement claim (Count II). Plaintiff had alleged willful infringement for the purpose of seeking "enhanced damages." (Compl. ¶ 44; Compl., Prayer for Relief, ¶ E, at pp. 12-13.) As discussed below, Plaintiff's willful-infringement claim meets pleading standards under Rule 8(a)(2).

It is well established that plaintiffs must do more than allege the violation of law. See Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (finding inadequate "labels and conclusions" or mere "formulaic recitation of the [claim] elements") (internal quotation marks omitted). Instead, plaintiffs must demonstrate entitlement to relief by pleading circumstances supporting civil

liability. Id. Where such circumstances "ha[ve] facial plausibility" and "allow[] the court to draw the reasonable inference that the defendant is liable for the misconduct," then the pleading passes muster under Rule 8(a)(2). Id.

In his Complaint (which must be accepted as true at this juncture), Plaintiff alleged that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301" but nevertheless "intentionally circulated infringing devices." (Compl. ¶ 36.) In support of that willful-infringement contention, Plaintiff recounted various "surrounding circumstances." (Compl. ¶ 37.)

The first circumstance concerned Defendant's process of "review[ing] all published patent applications pertaining to the field of magnetic storage and retrieval." (Compl. ¶ 39.) In conducting that review process, Defendant personally "encountered, and therefore had actual knowledge of, Plaintiff's published patent application." (Compl. ¶ 39.)

The second circumstance concerned "the timing of Defendant's adoption of [Plaintiff's disclosed] actuator improvements/innovations." (Compl. ¶ 37.) As alleged in Plaintiff's Complaint, "Defendant began utilizing dual-stage actuator systems and tip-mounted actuators approximately two or three years after the publication of Plaintiff's patent application." (Compl. ¶ 41.) Significantly, "[t]hat delayed

implementation correspond[ed] with the lead time needed to research and develop new technology." (Compl. ¶ 41.) The import is that "Defendant began researching and developing its dual-stage actuator systems and tip-mounted actuators within weeks or months after having actual knowledge of Plaintiff's published patent application." (Compl. ¶ 41.)

The third circumstance concerned the sine qua non of this civil action, namely, that Defendant "infring[ed] upon Plaintiff's patent as alleged." (Compl. ¶ 36.) In that regard, Plaintiff recounted seven instances of infringement. (Compl. ¶¶ 26-32.) He alleged that such infringement occurred via "element-by-element structural correspondence" or, at the very least, "under the doctrine of equivalents" given "similarities in function, way, and result." (Compl. ¶¶ 25, 32-33.)

In his Complaint, Plaintiff alleged that the foregoing circumstances were "indicative of Defendant's willful infringement." (Compl. ¶ 42.) Accordingly, by virtue of Defendant's alleged willful infringement, Plaintiff demanded "enhanced damages" totaling "three times base damages." (Compl. ¶ 44; Compl., Prayer for Relief, ¶ E, at pp. 12-13.)

These circumstances, all of which have "facial plausibility," demonstrate Plaintiff's entitlement to relief on his willful-infringement claim. To qualify for enhanced damages under 35 U.S.C. § 284, the defendant's alleged

willfulness need only exist on the subjective level, i.e., "without regard to whether [the] infringement was objectively reasonable." Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1933 (2016). Where such subjective willfulness is established, the defendant's behavior will generally be deemed "egregious" and warrant "enhanced damages under patent law." Id. at 1934. Plaintiff's allegations meet these standards, opening the door for enhanced damages.

Defendant, to reiterate, is accused of having actual knowledge of Plaintiff's patent application and of cultivating the underlying technology shortly thereafter. (Compl. ¶¶ 39-42.) Defendant is also accused of "intentionally circulating infringing devices" and, more specifically, of having actual knowledge "that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." (Compl. ¶¶ 36, 44.) These allegations demonstrate that Defendant possessed the requisite mens rea (subjective willfulness) under Halo.

Defendant advances three grounds in disputing Plaintiff's willful-infringement allegations. Those grounds, however, do not establish the inadequacy of Plaintiff's allegations.

Defendant first contends that Plaintiff failed to plead Defendant's knowledge of the patent-in-suit. That contention is simply untrue. Although Plaintiff focused his allegations on Defendant's discovery of the application disclosing Plaintiff's

invention, Plaintiff did indeed allege actual knowledge of the patent-in-suit. Specifically, in two paragraphs of his Complaint, Plaintiff alleged that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." (Compl. ¶¶ 36, 44.) That allegation, when construed in Plaintiff's favor, unequivocally accuses Defendant of having actual knowledge of the patent-in-suit, thereby complying with governing law.

In its second ground of attack, Defendant argues that Plaintiff's willful-infringement allegations do not arise to the level of "egregious misconduct" necessary for awarding enhanced damages. This contention is similarly baseless. The Court in Halo made clear that "egregious cases [of infringement are] typified by willful misconduct." 136 S. Ct. at 1934. Thus, by alleging willful infringement, Plaintiff alleged, by implication, that Defendant acted egregiously. Enhanced damages are therefore permitted under 35 U.S.C. § 284.

Also with merit is Defendant's argument that Plaintiff's willful-infringement claim fails to meet the pleading standards set forth in Iqbal. Perhaps Defendant would be correct had Plaintiff recounted implausible events or merely alleged willful infringement without detailing any supporting facts. In this case, Plaintiff went one step farther by pleading specific circumstances, all of which were plausible. Plaintiff's

allegations are therefore sufficient under Iqbal.

With that said, Plaintiff acknowledges that his allegations of willful infringement must ultimately be proven. That issue, however, is premature. For present purposes, it suffices to say that Plaintiff met governing pleading standards. Plaintiff's willful-infringement claim should therefore proceed to the discovery stage, at which time Plaintiff intends to substantiate his current allegations and to uncover "[o]ther evidence . . . regarding Defendant's knowledge, belief, and intent." (Compl. ¶ 43.) Such an opportunity should be afforded to Plaintiff given his well-pleaded allegations of willful infringement.

Finally, assuming, arguendo, that Defendant's miscellaneous pleading-related attacks have merit, Plaintiff respectfully requests leave to amend his Complaint. As the Court is aware, leave to amend should be freely granted when "justice so requires." Fed. R. Civ. P. 15(a)(2). The interest-of-justice condition is typically satisfied in situations where the pleading deficiency is capable of being cured. See Lopez v. Smith, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc).

In this case, Plaintiff contingently qualifies for leave to amend. Defendant argues, among other things, that Plaintiff failed to plead pre-suit knowledge of the patent and failed to satisfy pleading standards under Iqbal. Although Plaintiff disagrees with Defendant's arguments, Plaintiff can, if

necessary, cure all pleading deficiencies asserted. Under these circumstances, leave to amend is entirely appropriate and, frankly, mandated in the interest of justice.

CONCLUSION

For the above reasons, Plaintiff has standing to sue (Point I) and has requisite suing capacity (Point II), making the present lawsuit cognizable. Additionally, Plaintiff adequately pled his willful-infringement claim (Point III). This Court should therefore deny Defendant's Motion to Dismiss in its entirety. Finally, insofar as Plaintiff's willful-infringement claim is deficient, leave to amend should be granted.

Respectfully submitted,

PRO SE

Walter A. Tormasi

Dated: May 15, 2019

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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

WALTER A. TORMASI, Plaintiff, v. WESTERN DIGITAL CORPORATION, Defendant.	Case Number: 4:19-CV-00772-HSG **DEFENDANT WESTERN DIGITAL CORPORATION'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS** Date: August 22, 2019 Time: 9:00 am Judge: Hon. Haywood S. Gilliam, Jr. Courtroom: 2, 4th Floor

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Defendant Western Digital Corporation ("Defendant" or "WDC") hereby submits its Reply in support of its Motion to Dismiss (ECF 19) and in response to Plaintiff Walter A. Tormasi's ("Plaintiff" or "Tormasi") Opposition to Defendant's Motion to Dismiss (ECF 23).

I. Statement of Issues to Be Decided

1. Whether Tormasi's Complaint should be dismissed pursuant to FRCP 12(b)(1) for lack of standing to sue under Article III of the U.S. Constitution.

2. Whether Tormasi's Complaint should be dismissed because he lacks capacity to sue.

3. Whether Tormasi's claim for willful infringement of the '301 Patent should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim.

4. Whether Tormasi's claims for indirect infringement of the '301 Patent (to the extent Tormasi contends the Complaint makes such claims) should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

II. Tormasi Lacks Standing to Sue Because ADS, Not Tormasi, Holds Legal Title to the '301 Patent

Tormasi does not dispute that the application leading to the '301 Patent was assigned to Advanced Data Solutions Corp. ("ADS") in 2005, that the assignment was notarized and recorded – twice—in the United States Patent and Trademark Office ("PTO"), that ADS was the assignee at issue of the '301 Patent, and that PTO records still reflect that ADS holds legal title to the '301 Patent. Although unclear, Tormasi appears to assert that regardless of whether ADS holds legal title to the '301 Patent, as the named inventor he retains standing to sue for its infringement. ECF 23 at 3. That proposition is wrong as a matter of law, and the case law that Tormasi cites – *Arachnid, Inc. v. Merit Industries, Inc.*, 939 F.2d 1574, 1578 n.2 (Fed. Cir. 1991) – does not so hold. On the contrary, *Arachnid* makes clear that only a patent's legal title holder has standing to sue for money damages for its infringement. *Arachnid,* 939 F.3d at 1581. And, as discussed in WDC's opening brief (ECF 19 at 10, 12) where a named inventor assigns all of his right, title and interest in and to his patent he is divested of standing to sue for its infringement. *See Lans v. Digital Equip. Corp.*, 252 F.3d 1320 (Fed. Cir. 2001).

Tormasi has no standing to sue for the '301 Patent's infringement.

III. Tormasi Proffers No Competent Evidence to Show That He Is (or Ever Was) ADS's Sole Shareholder Or Had Any Authority To Assign The '301 Patent From ADS to Himself

In response to WDC's factual challenge to Tormasi's standing, Tormasi fails to produce a single document corroborating his assertion that he is (or ever was) ADS's sole shareholder, an ADS director or officer, or had any authority whatsoever to transfer ADS's ownership of the '301 Patent to himself. And, as discussed in WDC's opening brief, the competent evidence of record is to the contrary. ECF 19 at 12-14. Thus, Tormasi's arguments in favor of his standing to sue ***all*** fail because they are premised on the unsupported notion that he is and was ADS's "sole shareholder" or otherwise had authority to assign the '301 Patent from ADS to himself.

To support his standing argument, Tormasi offers a self-serving and uncorroborated declaration, a May 24, 2007 prison disciplinary report, and never-before-seen contingent assignments, assignments and alleged "corporate resolutions" (signed only by Tormasi allegedly in 2007 and 2009) in which Tormasi purports to transfer the '301 Patent from ADS to himself. *See* Declaration of Walter A. Tormasi In Opposition to Defendant's Motion to Dismiss (ECF 23-1) ("Tormasi Decl."), Exs. A, C, D, G, & H. None of these documents corroborates Tormasi's assertions concerning his status as "sole shareholder," "director" and/or "CEO" of ADS.

The prison disciplinary report states only that Tormasi possessed unspecified "paperwork/forms/legal documents pertaining to the initial start up &/or operation of an unauthorized business" and that "Tormasi by this act – circumvented the procedural safeguards against inmates operating a business without prior approval." *Id.*, Ex. A. The report says nothing about the ***content*** of these documents or Tormasi's supposed roles in ADS; it ***does not even mention ADS.*** The report cannot corroborate Tormasi's claims about his alleged roles at ADS.

Tormasi's declaration and purported assignment documents likewise are entirely uncorroborated and are signed only by Tormasi himself in his supposed capacity as ADS's "Director," "CEO" or "Sole Shareholder." *Id.,* Exs. C, D, G, & H. Tormasi's declaration and

attached exhibits thus do nothing to corroborate Tormasi's claims concerning his roles in ADS and his alleged authority to assign the '301 Patent from ADS to himself.

Tormasi's statement in his declaration that it was he who caused ADS to be formed, (*id*., ¶ 7), is likewise unsupported. The Certificate to which he points (*See* Declaration of Erica D. Wilson in Support of Defendant Western Digital Corporation's Motion to Dismiss (ECF 19-1) ("Wilson Decl."), Ex. 4) in no way identifies Tormasi as having any interest whatsoever in ADS. Indeed, it does not mention Tormasi at all. Similarly, his statements regarding his role as an ADS director, officer and sole shareholder (*Id*., ¶¶ 8-10) are entirely uncorroborated by any contemporaneous documentary evidence or third-party declarations.

Furthermore, the 2007 and 2009 "assignments" and "resolutions" have no indicia of reliability and authenticity. They are not witnessed or notarized and are not self-authenticating. Nor do they contain any contextual information to support their purported dates of execution. Neither of the alleged assignments was recorded with the PTO. In short, Tormasi has provided no evidence, other than his own self-serving declaration, to support the authenticity of those documents. Tormasi, however, is simply not credible.

In fact, Tormasi has admitted, including in statements under penalty of perjury, that ADS was the assignee of the '301 Patent in exactly the same time frame for which he now claims to have assigned the patent from ADS to himself. In a Complaint Tormasi filed on December 1, 2008 on behalf of ADS and himself for alleged civil rights violations stemming from the prison's confiscation of Tormasi's business-related documents, Tormasi stated that ADS was the "registered assignee of [the '301] patent." Wilson Decl. Ex. 3, ¶¶ 20(a)-(e) ("ADS correspondingly owns all applications and patents stemming from Plaintiff Tormasi's '346 provisional application"); *see also id.* ¶ 27(a) (stating that ADS is the "assignee" of the '301 Patent); *id.* at 25 (Tormasi's verification under penalty of perjury that the statements in the Complaint are "true and correct to the best of my knowledge"). In a "1st Amended Complaint" filed July 24, 2009 Tormasi reiterated (again under penalty of perjury) that ADS was the assignee of the '301 Patent. Wilson Decl., Ex. 12, ¶¶ 20(a)-20(e), 27 (a) and p. 27 (verification).

Tormasi made no mention of corporate resolutions or assignment documents that he allegedly executed in June 2007, well prior to the filing dates of his 2008 Complaint and 2009 amended complaint. Instead, throughout the pendency of his civil rights action, he steadfastly maintained that ADS was the assignee of the '301 Patent, and without the paperwork prison officials had confiscated as contraband he could not "prove his ownership of ADS to the satisfaction of interested third parties," and was thus unable to "directly or indirectly benefit from his intellectual-property assets." Wilson Decl., Ex. 3, ¶¶20 (a)-(e), 22(a), 27, Ex. 12, ¶¶20(a)-(e), ¶22(a), 27.

Furthermore, in appellate briefing to the Third Circuit in August ***2011*** Tormasi unequivocally asserted ADS's ownership of the '301 Patent, stating "While ADS does own Patent No. 7,324,301 (including its related applications) . . ." *See* Declaration of Erica D. Wilson in Support of Defendant Western Digital Corporation's Reply In Support of Its Motion to Dismiss ("Wilson Reply Decl."), Ex. 26 at 3; *see also id.* at 1 ("Defendants are correct that Tormasi had assigned to ADS all rights regarding Patent No. 7,324,301 (including Provisional Patent Application No. 60/568,346 and Non-Provisional Patent Application No. 11/031,878).)."

Tormasi ***now*** takes the exact opposite position in this Court, claiming that he actually assigned the '301 Patent back to himself in 2007 and/or 2009. In light of his prior statements to the New Jersey federal court and the Third Circuit, such assertions are simply not believable.[1]

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[1] This would not be the first time evidence submitted by Tormasi has been found lacking credibility. A New Jersey state court found an unsigned "affidavit" allegedly prepared years earlier by Tormasi's deceased father and presented by Tormasi after his father's death in support of a petition for post-conviction relief, to be "not believable," "inherently suspect" and "untrustworthy." *State v. Tormasi*, No. A-4261-16T4, 2018 N.J. Super. Unpub. LEXIS 2417, at *1-4 (Super. Ct. App. Div. Oct. 31, 2018) (Wilson Reply Decl., Ex. 27). Similarly, Tormasi was previously found to have attempted to "subvert the security and safety of the facility" by attempting to mail "fourteen legal briefs that had been hollowed out to create hidden compartments" that "can easily be used to traffic contraband to and from the facility." *Tormasi v. New Jersey Dept. of Corrections*, 2007 N.J. Super. Unpub. LEXIS 1216, at *1-4 (N.J. Super.A.D. Mar. 22, 2007) (Wilson Decl., Ex. 21). The New Jersey Court found unpersuasive Tormasi's self-serving declaration that "another inmate's documents were intermingled with [his] or that the documents were planted to fabricate charges against [him]." *Id.* at *2.

As the plaintiff in this action Tormasi "has the burden of proving the existence of Article III standing at all stages of the litigation." *Ctr. for Biological Diversity v. United States Fish & Wildlife Serv.*, 807 F.3d 1031, 1043 (9th Cir. 2015). Tormasi's uncorroborated claims regarding his alleged ownership of the '301 Patent – which are diametrically opposed to what he previously told various federal courts – fall far short of meeting his burden of proving that he has standing to sue for infringement of the '301 Patent.

IV. The Alleged 2007 and 2009 Assignments Are Ineffective

Even if Tormasi could somehow show that he is and was someone with authority to transfer ADS's assets to himself and could show that the June 2007 and December 2009 "corporate resolutions" and "assignment agreements" were not post-hoc litigation-inspired documents, but rather were executed on the dates stated, the assignment agreements would still be ineffective for multiple reasons. First, Tormasi states that on May 23, 2007 prison officials disciplined him for operating a business and he was "warned, explicitly and unequivocally, that [his] continued involvement with ADS matters subjected [him] to further disciplinary action." Tormasi Decl., ¶14. The 2007 and 2009 resolutions and assignment agreements reflect activities taken on behalf of ADS and thus constitute conducting a business, something Tormasi is expressly prohibited from doing. *See also* ECF 19 at 17-18; *infra* Section V.

Second, the 2007 assignment purports to be a contingent assignment and effective only on the happening of certain events. *Id.*, Ex. D. Tormasi states that "one or more of the contingencies specified in the Assignment from June 2007 were met" (*Id.*, ¶42), but fails to identify to ***which*** contingency he refers and ***when*** the unspecified contingency supposedly arose. Moreover, at all relevant times, including into 2019, Tormasi behaved as though ADS was still an operating business and holding the '301 Patent as evidenced by: (1) Tormasi's statements to the New Jersey federal court and the Third Circuit in the 2008-2011 timeframe that ADS was the assignee of the '301 Patent; (2) Tormasi's January 30, 2019 assignment of the '301 Patent to himself in his alleged capacities as ADS's sole shareholder and President (*Id.*, Ex. L); (3) Tormasi's declaration that he believed his family members were paying ADS's Delaware

franchise taxes (*Id*., ¶¶ 19, 37); and (4) Tormasi's declaration that at all relevant times, including 2019, he "believed that ADS remained in good standing with Delaware officials." *Id.*, ¶39.

Third, the 2009 assignment is ineffective for the additional reason that it was allegedly entered into when ADS was in a void status. As discussed in WDC's opening brief (ECF 19 at 14-17), although ADS could continue to hold assets while in a void status, during the period in which it was void, it had no power to assign its assets to Tormasi or anyone else.

Citing *Krapf & Son, Inc. v. Gorson*, 243 A.2d 713, 715 (Del. 1968), Tormasi argues that the 2009 and 2019 assignments of the '301 Patent from ADS to himself are valid, even though executed while ADS was in a void status, because ADS's lapse into a void status was inadvertent and the assignments were executed without fraud or bad faith. ECF 23 at 6.

In *Krapf*, however, the question before the Court was whether a corporation's president could be held personally liable for a contract he entered into on behalf of the corporation after the company was declared void and before it was revived under Delaware law. *Krapf,* 243 A.2d at 714. In holding that the president was not personally liable, the Delaware Court found that since the corporation had been properly revived under 8 Del. C. § 312(e), the contract was "validated." *Id.* at 715 (citing 8 Del. C. §312(e)). *Krapf* does not stand for the broad proposition that a contract entered into while a corporation is in a void status is valid, even if the corporation is never revived.

In this case, Tormasi proffers no evidence that ADS has been revived pursuant to §312; the alleged 2009 assignment and the 2019 assignment, therefore, cannot have been validated as was the case in *Krapf.* Moreover, ADS's void status can hardly be said to have been inadvertent, nor were the alleged assignments made in good faith. Tormasi's claim that he thought for the past 15 years that his father and brother were paying ADS's Delaware franchise taxes on his behalf is not credible. Notably, although claiming to be ADS's sole shareholder, Tormasi proffers no evidence that he provided either his father or brother with the funds with which to pay ADS's Delaware franchise taxes. And, he provides no explanation of why his father or brother, who supposedly had no interest in ADS, would pay ADS's franchise taxes for him.

Tormasi also states that he expected his brother and father would house ADS on their properties (ECF 23 at 6-7), which raises further questions concerning the ownership of ADS. Tormasi proffers no third-party declaration or documentation corroborating his assertion that his family members were to pay ADS's Delaware franchise taxes and house ADS on Tormasi's behalf.

Moreover, in his December 2008 complaint and July 24, 2009 amended complaint, Tormasi complained that the prison officials' seizure of his corporate paperwork prevented Tormasi from paying ADS's federal taxes. Wilson Decl., Ex. 3, ¶22(b), Ex. 12, ¶22(b). Tormasi thus inconsistently claims that (1) the seizure of his corporate paperwork prevented him from paying ADS's federal taxes, but (2) he believed (and never once confirmed in 15 years) that his brother and/or father were readily able to pay ADS's Delaware franchise taxes.

Tormasi claims he only learned of ADS's void status when WDC filed its April 25, 2019 Motion to Dismiss. Tormasi Decl., ¶37. Tormasi further claims that "[s]urprised by that revelation" he "conducted follow-up inquiries," and only just now discovered in 2019 that prior to his death in 2010, Tormasi's father experienced debilitating health issues that prevented him from paying the Delaware taxes. *Id.* Notably, however, Tormasi does not submit documents or a declaration from any third-party with whom he made such inquiries corroborating these supposed findings. Nor does Tormasi offer any explanation of why his brother was prevented from making the payments.

As discussed in WDC's opening brief, Tormasi's alleged assignments also lack the hallmarks of good faith that were present in *Krapf*. Tormasi's purported assignment of ADS's patent to himself is an obvious bad faith (albeit failed) effort to do an end-run around the New Jersey prison's "no-business" rule. Indeed, by bringing this patent infringement suit, Tormasi is using the courts in an effort to monetize the '301 Patent which he is barred from doing under New Jersey law.

In a last-ditch effort to claim ownership of the '301 Patent, Tormasi argues that because ADS was in a void status as of March 2008, under section 278 of the Delaware code the December 2009 assignment of the '301 Patent from ADS to himself is valid. Tormasi's argument

fails for multiple reasons. First, as discussed above, Tormasi has provided no competent evidence other than his own self-serving declaration to support the notion that he is ADS's sole shareholder and executive.

Second, §278 entitled "Continuation of corporation after dissolution for purposes of suit and winding up affairs" provides:

> All corporations, whether they expire by their own limitation or are otherwise dissolved, shall nevertheless be continued, for the term of 3 years from such expiration or dissolution . . . for the purpose of prosecuting and defending suits. . . . and of enabling them gradually to settle and close their business, to dispose of and convey their property, to discharge their liabilities and to distribute to their stockholders any remaining assets, ***but not for the purpose of continuing the business for which the corporation was organized.*** (emphasis added).

Section 278 does not address whether a corporation that is void for failure to pay franchise taxes is "otherwise dissolved" within the meaning of the code, and "[c]ourts interpreting Delaware law disagree as to whether a Delaware corporation whose charter has been forfeited or declared void for failure to pay its franchise taxes is dissolved." *V.E.C. Corp. v. Hilliard,* No. 10 cv 2542 (VB), 2011 U.S. Dist. LEXIS 152759, at *16-17 (S.D.N.Y Dec. 13, 2011) (Wilson Reply Decl., Ex. 28) (comparing cases). In at least one case, the Delaware Supreme Court did not apply § 278 to a void corporation. *See Transpolymer Indus. v. Chapel Main Corp.*, No. 284, 1990, 1990 Del. LEXIS 317, at *2 (Del. 1990) (unpublished) (Wilson Reply Decl., Ex. 29) (finding void corporation's powers "inoperative" and corporation thus lacked standing to pursue an appeal). It is therefore questionable whether §278 is even applicable here.

The better view is that a void corporation is not "otherwise dissolved" within the meaning of §278 because pursuant to 8 Del. C. §312 it can be revived by payment of the past due taxes. As the Delaware state court has clearly recognized, a corporation that has had its certificate of incorporation revoked for failure to pay franchise taxes "is not completely dead." *Wax v. Riverview Cemetery Co.,* 24 A.2d 431, 436 (Del. Super. 1942). It is instead merely "in a state of coma from which it can be easily resuscitated." *Id*; *see also In re Apple iPod iTunes Antitrust Litig.*, No. 05-CV-0037 YGR, 2014 U.S. Dist. LEXIS 165254, at *14-15 (N.D. Cal. Nov. 25,

2014) (Wilson Reply Decl., Ex. 30)("While authority is split on whether ***voided*** corporations fall under section 278, the Court finds more persuasive the approach followed by the Delaware Supreme Court—that void corporations lose their standing to pursue legal actions until the corporate status is restored") (emphasis in original) (citations omitted).

Even if ADS were considered to be "otherwise dissolved" within the meaning of §278, §278 cannot render the 2009 assignment valid. It is well-settled that §278 is specifically directed to winding up a business, not to carrying on the purposes for which it was established. *See, e.g., Gamble v. Penn Valley Crude Oil Corp.*, 104 A.2d 257, 260 (Del.Ch. 1954); *McBride v. Murphy*, 124 A. 798, 801 (Del. Ch. 1924).

In this case, Tormasi's statements and conduct show that the 2009 assignment – even if found to be authentic and executed on the date stated on the document – was not effectuated for the purpose of winding up ADS's business affairs. In his declaration, Tormasi states that he wanted to pursue patent infringement litigation with respect to the '301 Patent, and since ADS must be represented in federal court by an attorney but did not have one, Tormasi "took steps" to acquire the '301 Patent. Tormasi Decl., ¶ 22. Indeed, referring to the December 27, 2009 assignment, Tormasi explicitly states, "[t]he purpose of the transfer in ownership was to permit me to personally pursue, and to personally benefit from, an infringement action against Defendant and others." *Id.*, ¶23. And, at all relevant times, including through 2019, Tormasi claims that he "believed that ADS remained in good standing with Delaware officials." *Id.*, ¶ 39. Section 278 is inapplicable.

Tormasi also argues that if ADS were dissolved, as sole shareholder the ADS assets – *i.e.,* the '301 Patent – would automatically transfer to him. ECF 23 at 8. Again, Tormasi has adduced no competent evidence that he is the sole shareholder of ADS. Moreover, Section 277 of the Delaware General Corporation Law states that "[n]o corporation shall be dissolved . . . under this chapter" until all franchise taxes have been paid and all annual franchise tax reports have been filed by the corporation. 8 Del. Code § 277. Thus, ADS could not be dissolved and its

assets distributed to its shareholders until all of the franchise taxes have been paid and all annual franchise tax reports have been filed by ADS. To date, that has not occurred.

V. Tormasi Lacks the Capacity to Sue

Tormasi's patent infringement suit is in furtherance of his personal business interests – *i.e.,* monetization of the '301 Patent – and is thus prohibited under New Jersey's law precluding inmates from operating businesses. Tormasi admits that "New Jersey inmates are prohibited from operating businesses without administrative approval." ECF 23 at 10-11 (citing N.J.A.C. 10A:4-4.1). And, Tormasi does not deny that he does *not* have the authorization of prison officials to operate any business.

Instead, Tormasi – while proclaiming himself an "entrepreneur" (ECF 1, ¶ 1) and seeking $15 billion in damages for alleged infringement of the '301 Patent (*id.*, "Prayer for Relief," ¶¶ D & E) – implies that because he is operating in his "personal capacity" his patent infringement suit cannot be deemed in furtherance of prohibited business operations. ECF 23 at 11. Tormasi cites nothing supporting the notion that the ***form*** of a business is in any way relevant to New Jersey's prohibition on inmates operating a business. Nor does Tormasi make any effort to distinguish the cases cited in WDC's opening brief in which New Jersey inmates operating in their individual capacities were found to have violated New Jersey's "no business" rule. *See* ECF 19 at 17-18.

Tormasi does not meaningfully address the opinions of the New Jersey federal court and the Third Circuit finding that his patent monetization and enforcement efforts conducted under the auspices of ADS ran afoul of New Jersey's "no-business rule" but rather declares them "inapposite." ECF 23 at 11.

Tormasi's concurrently filed request for appointment of *pro bono* counsel for settlement purposes (ECF 24), underscores that this patent infringement action is part of an overall patent monetization strategy. In his accompanying declaration, Tormasi explains that *pro bono* counsel's assistance is required *inter alia* "to determine and apply reasonable royalty rates to [WDC's] revenue." ECF 24-1, ¶11. Tormasi further notes that any settlement likely will include licensing or sale of the '301 Patent and that *pro bono* counsel's assistance is needed to assist him

with valuing the patent. ECF 24-1, ¶14. And, Tormasi's declaration in support of his opposition to WDC's Motion to Dismiss states that the alleged assignments of the '301 Patent from ADS to Tormasi were done to ensure the '301 Patent "remained enforceable, licensable, and sellable to the fullest extent possible." Tormasi Decl., ¶15.

This is precisely the sort of conduct that the New Jersey court has found runs afoul of New Jersey's "no business" rule. *See Helm v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 1062 (N.J.Super. A.D. May 8, 2015) (Wilson Decl., Ex. 19) (Inmate Helm found guilty of operating a business without authorization where he signed paperwork regarding the sales of his artwork and taxes to be paid from those sales and because attorneys assisting him were compensated from income generated by the sales).

Tormasi ***knowingly*** misstates the law regarding an inmate's right of access to the courts under the First and Fourteenth Amendments when he argues that New Jersey's "no-business" rule cannot prevent him from suing for patent infringement. ECF 23 at 10. Tormasi argues that *Bounds v. Smith*, 430 U.S. 817 (1977) established an inmate's right of access to the courts and that under the Supreme Court's holding in *Lewis v. Casey*, "prison officials must allow prisoners to file civil lawsuits and, conversely, are prohibited from 'frustrat[ing] or . . . imped[ing]' any 'nonfrivolous legal claim.'" ECF 23 at 10 (citing *Lewis v. Casey,* 518 U.S. 343, 349, 353 (1996)).

Lewis, however, says no such thing, and, in fact holds the precise opposite. In holding that a claim for denial of the right of access to courts requires a showing of "actual injury," the *Lewis* court explained that "***the injury requirement is not satisfied by just any type of frustrated legal claim.***" 518 U.S. at 354 (emphasis added). Rather, an inmate's constitutional right of access to the courts is limited to inmate suits "attack[ing] their sentences" or "conditions of their confinement" and ***"[i]mpairment of any other litigating capacity is simply one of the incidental (and perfectly constitutional) consequences conviction and incarceration.***" *Id.* at 355 (emphasis in original and added).

Tormasi is well-aware of these limits on an inmate's right of access to the courts; he was apprised of this by both the New Jersey federal district court and the Third Circuit in a prior civil rights lawsuit he brought based *inter alia* on his alleged inability to bring patent infringement litigation. Citing the Supreme Court's decisions in *Bounds* and *Lewis*, the New Jersey federal court emphasized that an inmate's "right of access to the courts is not, however, unlimited" and does not extend to patent infringement litigation. *Tormasi v. Hayman*, No. 08-5886 (JAP) 2009 U.S. Dist. LEXIS 50560, at *13-15 (D.N.J. Jun. 16, 2009) ("Tormasi I") (Wilson Decl., Ex. 1). The New Jersey court stated:

> Here, the Complaint fails to state a claim with respect to Plaintiff Tormasi's desire to pursue patent violation litigation, as impairment of the capacity to litigate with respect to personal business interests is "simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration."

Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *14-15 (quoting *Lewis v. Casey*, 518 U.S. at 355).

The court reiterated the *Lewis* court's limitations on an inmate's right of access to the courts in *Tormasi v. Hayman*, No. 08-5886, 2011 U.S. Dist. LEXIS 25849, at *21-22 (D.N.J. March 14, 2011) ("Tormasi II") (Wilson Decl., Ex. 11).

And, on appeal, the Third Circuit likewise cited *Lewis* for the proposition that an inmate's right of access to the courts is limited to attacking their sentences or conditions of confinement, and stated "[b]ecause Tormasi's complaints about his ability to pursue patent matters do not fall into one of these categories, we agree that he failed to state an access to the courts claims." *Tormasi v. Hayman*, 443 Fed. Appx. 742, 744, n.3 (3d Cir. 2011) (Wilson Decl., Ex. 13).

In August 2011 briefing to the Third Circuit, Tormasi acknowledged under *Lewis* he had no constitutional right to bring patent infringement litigation. Indeed, Tormasi wrote,

> Defendants, for example, cite Lewis v. Casey, 518 U.S. 343, 116 S. Ct. 2174, 135 L. Ed. 2d 606 (1996), for the proposition that Tormasi has no right to pursue "patent violation litigation." ***While defendants are technically correct***, Tormasi does not seek "access to the courts" to litigate infringement actions against patent violators.

Wilson Reply Decl., Ex. 26 at 3-4 (emphasis added).

Tormasi's reliance on *Holman v. Hilton*, 542 F. Supp. 913 (D.N.J. 1982), *aff'd* 712 F.2d 854 (3d Cir. 1983) is misplaced. *Holman* does not, as Tormasi suggests, stand for the proposition that preventing inmates from bringing whatever sort of lawsuit they choose is unconstitutional. Rather, in *Holman* the court found a state statute prohibiting New Jersey inmates from bringing suit in New Jersey state court against ***"public entit[ies] or public employee[s]"*** (*i.e.,* prison officials) while incarcerated violated Plaintiff's (an inmate serving a life sentence who alleged prison officials wrongfully took his personal property) constitutional rights to due process. *Holman,* 542 F. Supp. at 914-15 & n.3 (emphasis added).

Here, Tormasi attempts to bring a patent infringement suit in furtherance of his personal business interests, something he is not entitled to do. In any event, the Supreme Court's ruling in *Lewis* – handed down 13 years ***after*** *Holman* – is binding precedent. To the extent the district court or Third Circuit opinions in *Holman* can be said to be in conflict with *Lewis*, the Supreme Court's ruling is controlling.

Tormasi lacks the capacity to bring suit in furtherance of his personal business interests.

VI. Tormasi Fails To State a Claim For Willful Infringement

As discussed fully in WDC's opening brief (ECF 19 at 19-23) Tormasi's complaint fails to state a claim for willful infringement. Tormasi does not plausibly plead WDC's knowledge of the '301 Patent or knowledge of its infringement. Tormasi admits that the entirety of his allegations concerning WDC's knowledge of the '301 ***Patent*** and alleged infringement of the ***patent*** consist of his conclusory statement that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." ECF 23 at 17. As discussed in WDC's opening brief, such conclusory allegations, "will not do." *Ashcroft v. Iqbal*, 556 U.S 662, 678 (2009); *see also* ECF 19 at 19-20.

Tormasi's claim for willful infringement likewise fails because he pleads no facts to support the notion that WDC's conduct was "egregious" as required to state a claim for willfulness. *See, e.g., Hypermedia Navigation v. Google LLC,* No. 18-cv-06137-HSG, 2019 U.S. Dist. LEXIS 56803, at *10 (N.D. Cal. April 2, 2019) (Wilson Decl., Ex. 14). Tormasi argues that

by alleging WDC's conduct was willful he has "by implication" alleged "egregiousness." ECF 23 at 17. That is a backwards analysis, and Tormasi's bare allegation of willfulness utterly fails to meet the pleading standard of this Court. Tormasi fails to plead "specific factual allegations about [WDC's] subjective intent or details about the nature of [WDC's] conduct to render a claim of willfulness plausible, and not merely possible." *Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *10.

Tormasi does not dispute that the "surrounding circumstances" he alleges give rise to his willfulness claim center on the publication of the ***application*** leading to the '301 and not the '301 ***Patent*** itself. Nor does Tormasi dispute that he lacks any basis whatsoever for the allegations, made upon information and belief, concerning WDC's supposed knowledge and use of the application leading to the '301 Patent. *See* ECF 1, ¶¶ 36-44. Instead, Tormasi argues that all allegations in the complaint must be accepted as true. ECF 23 at 14-15. However, "courts do not accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences." *Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *2-3 (citations and internal quotations omitted). Tormasi's baseless allegations need not be accepted as true.[2]

VII. Conclusion

For the foregoing reasons and the reasons set forth in WDC's opening brief (ECF 19), WDC respectfully requests that its Motion to Dismiss be granted.

Dated: June 13, 2019

Respectfully submitted,

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[2] Tormasi does not appear to contend that he pled causes of action for indirect infringement. To the extent he does, however, such causes of action should be dismissed for failure to state a claim for the reasons set forth in WDC's opening brief. *See* ECF 19 at 23-24.

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CERTIFICATE OF SERVICE

I am a partner of WALTERS WILSON LLP, and my business address is 702 Marshall Street, Suite 611, Redwood City, CA 94063.

I hereby certify that I caused to be served a copy of the following document on each of the persons listed below by the means specified:

DEFENDANT WESTERN DIGITAL CORPORATION'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS

☑ A true and correct copy of said document was mailed via first class United States mail, postage prepaid, on June 13, 2019.

Walter A. Tormasi
#136062/268030C
NJSP
P.O. Box 861
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Dated: June 13, 2019.

/s/ Erica D. Wilson
Erica D. Wilson

N.J.A.C. 10A:4-4.1

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NJ - New Jersey Administrative Code > TITLE 10A. CORRECTIONS > CHAPTER 4. INMATE DISCIPLINE > SUBCHAPTER 4. INMATE PROHIBITED ACTS

§ 10A:4-4.1 Prohibited acts

(a) An inmate who commits one or more of the following numbered prohibited acts shall be subject to disciplinary action and a sanction that is imposed by a Disciplinary Hearing Officer or Adjustment Committee with the exception of those violations disposed of by way of an on-the-spot correction. Prohibited acts preceded by an asterisk (*) are considered the most serious and result in the most severe sanctions (see N.J.A.C. 10A:4-5, Schedule of Sanctions for Prohibited Acts). Prohibited acts are further subclassified into five categories of severity (Category A through E) with Category A being the most severe and Category E the least severe. These categories correspond to the categories of sanctions at N.J.A.C. 10A:4-5 and the categories in the severity of offense scale at N.J.A.C. 10A:9-1.13.

1.Category A: A finding of guilt for any offense in Category A shall result in a sanction of no less than 181 days and no more than 365 days of administrative segregation per incident and one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(e)*, unless a medical or mental health professional determines that the inmate is not appropriate for administrative segregation placement. Where a medical or mental health professional has made such a determination, the inmate shall receive one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(e)*.

i.*.001 killing

ii.*.002 assaulting any person

iii.*.003 assaulting any person with a weapon

iv.*.007 hostage taking

v.*.009 misuse, possession, distribution, sale, or intent to distribute or sell, an electronic communication device, equipment, or peripheral that is capable of transmitting, receiving, or storing data and/or electronically transmitting a message, image, or data that is not authorized for use or retention (see "electronic communication device" definition at *N.J.A.C. 10A:1-2.2*)

vi.*.012 throwing bodily fluid at any person or otherwise

vii.*.050 sexual assault

viii.*.101 escape

ix.*.151 setting a fire

x.*.202 possession or introduction of a weapon, such as, but not limited to, a sharpened instrument, knife, or unauthorized tool

xi.*.251 rioting

xii.*.252 encouraging others to riot

xiii.*.360 unlawfully obtaining or seeking to obtain personal information pertaining to an inmate's victim or the victim's family or pertaining to DOC staff or other law enforcement staff or the family of said staff

xiv.*.803 attempting to commit, aiding another person to commit or making plans to commit any Category A and or B offense

2.Category B: A finding of guilt for any offense in Category B shall result in a sanction of no less than 91 days and no more than 180 days of administrative segregation per incident and one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(g)*, unless a medical or mental health professional determines that the inmate is not appropriate for administrative segregation placement. Where a medical or mental health professional has made such a determination, the inmate shall receive one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(f)*.

i.*.004 fighting with another person

ii.*.005 threatening another with bodily harm or with any offense against his or her person or his or her property

iii.*.006 extortion, blackmail, protection: demanding or receiving favors, money or anything of value in return for protection against others, to avoid bodily harm, or under threat of informing

iv.*.008 abuse/cruelty to animals

v.*.010 participating in an activity(ies) related to a security threat group

vi.*.011 possession or exhibition of anything related to a security threat group

vii.*.014 unauthorized physical contact with any person with an article, item, or material such as anything readily capable of inflicting bodily injury

viii.*.054 refusal to register as a sex offender or any refusal to register as required by law

ix.*.102 attempting or planning escape

x.*.150 tampering with fire alarms, fire equipment, or fire suppressant equipment

xi.*.153 stealing (theft)

xii.*.154 tampering with or blocking any locking device

xiii.*.155 adulteration of any food or drink

xiv.*.201 possession or introduction of an explosive, incendiary device, or any ammunition

xv.*.203 possession or introduction of any prohibited substances such as drugs, intoxicants or related paraphernalia not prescribed for the inmate by the medical or dental staff

xvi.*.204 use of any prohibited substances such as drugs, intoxicants, or related paraphernalia not prescribed for the inmate by the medical or dental staff

xvii.*.205 misuse of authorized medication

xviii.*.207 possession of money or currency (in excess of $ 50.00) unless specifically authorized

xix.*.211 possessing any staff member's clothing and/or equipment

xx.*214 possession of unauthorized keys or other security equipment

xxi.*.215 possession with intent to distribute or sell prohibited substances such as drugs, intoxicants, or related paraphernalia

xxii.*.216 distribution or sale of prohibited substances such as drugs, intoxicants, or related paraphernalia

xxiii.*.253 engaging in, or encouraging, a group demonstration

xxiv.*.255 encouraging others to refuse to work or to participate in work stoppage

xxv.*.258 refusing to submit to testing for prohibited substances

xxvi.*.259 failure to comply with an order to submit a specimen for prohibited substance testing (see N.J.A.C. 10A:3-5)

xxvii.*.260 refusing to submit to mandatory medical or other testing such as, but not limited to, mandatory testing required by law or court order

xxviii.*.261 tampering with a test specimen

xxix.*.306 conduct which disrupts or interferes with the security or orderly running of the correctional facility

xxx.*.352 counterfeiting, forging or unauthorized reproduction or use of any classification document, court document, psychiatric, psychological or medical report, money, or any other official document

xxxi.*.502 interfering with the taking of count

xxxii.*.551 making intoxicants, alcoholic beverages, or prohibited substances such as narcotics and controlled dangerous substances or making related paraphernalia

xxxiii.*.552 being intoxicated

xxxiv.*.704 perpetrating frauds, deceptions, confidence games, riots, or escape plots

xxxv.*.708 refusal to submit to a search

xxxvi.*.751 giving or offering any official or staff member a bribe or anything of value

xxxvii.*.803 attempting to commit, aiding another person to commit or making plans to commit any Category A and/or B offense

3.Category C: A finding of guilt for any offense in Category C can result in a sanction of no less than 31 days and no more than 90 days of administrative segregation in addition to one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(j)*.

i..009A misuse, possession, distribution, sale, or intent to distribute or sell, an electronic communication device, equipment, or peripheral that is capable of transmitting, receiving or storing data and/or electronically transmitting a message, image, or data that is not authorized for use or detention by an inmate who is assigned to a Residential Community Release Program (see "electronic communication device" definition at *N.J.A.C. 10A:1-2.2*).

ii..013 unauthorized physical contact with any person, such as, but not limited to, physical contact not initiated by a staff member, volunteer, or visitor

iii..051 engaging in sexual acts with others

iv..052 making sexual proposals or threats to another

v..053 indecent exposure

vi..103 wearing a disguise or mask

vii..204A use by an inmate who is assigned to a Residential Community Program of any prohibited substances such as drugs, intoxicants, or related paraphernalia not prescribed for the inmate by the medical or dental staff

viii..212 possessing unauthorized clothing

ix..254 refusing to work, or to accept a program or housing unit assignment

x..351 counterfeiting, forging, or unauthorized reproduction or use of any document not enumerated in prohibited act *.352

xi..401 participating in an unauthorized meeting or gathering

xii..402 being in an unauthorized area

xiii..501 failing to stand count

xiv..552A being intoxicated while the inmate is assigned to a Residential Community Program

xv..601 gambling

xvi..602 preparing or conducting a gambling pool

xvii..603 possession of gambling paraphernalia

xviii..702 unauthorized contacts with the public

xix..705 commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator

xx..706 soliciting funds and/or noncash contributions from donors within or without the correctional facility except where permitted by the Administrator

xxi..752 giving money or anything of value to, or accepting money or anything of value from, another inmate

xxii..753 purchasing anything on credit

xxiii..754 giving money or anything of value to, or accepting money

xxiv..802 attempting to commit, aiding another person to commit or making plans to commit any Category C, D, and or E offense

4.Category D: A finding of guilt for any offense in Category D can result in a sanction of either zero or 30 days of administrative segregation in addition to one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1*(*l*).

i..152 destroying, altering, or damaging government property, or the property of another person

ii..206 possession of money or currency ($ 50.00 or less) unless specifically authorized

iii..210 possession of anything not authorized for retention or receipt by an inmate or not issued to him or her through regular correctional facility channels

iv..256 refusing to obey an order of any staff member

v..305 lying, providing a false statement to a staff member

vi..553 smoking where prohibited

vii..554 possession of tobacco products or matches where not permitted

viii..653 tattooing

ix..709 failure to comply with a written rule or regulation of the correctional facility

x..802 attempting to commit, aiding another person to commit or making plans to commit any Category C, D, and or E offense

5.Category E: A finding of guilt for any offense in Category E shall result in a sanction of one or more of the sanctions listed at *N.J.A.C. 10A:4-5.1(n)*. Administrative segregation does not apply to Category E.

i..208 possession of property belonging to another person

ii..209 loaning of property or anything of value

iii..213 mutilating or altering clothing issued by the government

iv..257 violating a condition of any Residential Community Program and or Residential Community Release Program

v..301 unexcused absence from work or any assignment; being late for work

vi..302 malingering, feigning an illness

vii..303 failing to perform work as instructed by a staff member

viii..304 using abusive or obscene language to a staff member

ix..451 failure to follow safety or sanitation regulations

x..452 using any equipment or machinery which is not specifically authorized

xi..453 using any equipment or machinery contrary to instructions or posted safety standards

xii..651 being unsanitary or untidy; failing to keep one's person and one's quarters in accordance with posted standards

xiii..701 unauthorized use of mail or telephone

xiv..703 correspondence or conduct with a visitor in violation of regulations

xv..707 failure to keep a scheduled appointment with medical, dental or other professional staff

xvi..802 attempting to commit, aiding another person to commit or making plans to commit any Category C, D, and or E offense

History

HISTORY:

Notice of Correction: Asterisk was omitted for *.306.

See: 18 N.J.R. 2138(d).

Amended by R.1987 d.154, effective April 6, 1987.

See: 19 N.J.R. 178(a), 19 N.J.R. 534(a).

Added *.008 abuse/cruelty to animals.

Notice of Correction: .352 was omitted from the end of .351.

See: 19 N.J.R. 1658(c).

Amended by R.1991 d.276, effective June 3, 1991.

See: 23 N.J.R. 658(a), 23 N.J.R. 1797(b).

Added .150 and amended *.151.

Administrative Corrections in (a): In .150 corrected suppressant.

See: 24 N.J.R. 2731(a).

Amended by R.1993 d.488, effective October 4, 1993.

See: 25 N.J.R. 3416(a), 25 N.J.R. 4599(a).

Administrative Correction.

See: 26 N.J.R. 1228(a).

Amended by R.1994 d.254, effective May 16, 1994.

See: 26 N.J.R. 1286(a), 26 N.J.R. 2129(a).

Amended by R.1994 d.264, effective June 6, 1994.

See: 26 N.J.R. 1287(a), 26 N.J.R. 2285(b).

Amended by R.1995 d.237, effective May 1, 1995.

See: 27 N.J.R. 436(a), 27 N.J.R. 1801(c).

Amended by R.1996 d.209, effective May 6, 1996 (operative August 19, 1996).

See: *28 N.J.R. 763(a)*, *28 N.J.R. 2387(b)*.

In (a) added refusing a breathalyzer test.

Amended by R.1996 d.237, effective May 20, 1996.

See: *28 N.J.R. 1464(a)*, *28 N.J.R. 2555(b)*.

In (a) added exception for on-the-spot corrections, in .254 added refusal of housing unit assignment, and deleted provision for transfer to the Vroom Readjustment Unit.

Petition for Rulemaking: Notice of Receipt of and Action on a Petition for Rulemaking.

See: *29 N.J.R. 813(b)*, *29 N.J.R. 948(a)*.

Amended by R.1997 d.225, effective June 2, 1997.

See: *29 N.J.R. 834(a)*, *29 N.J.R. 2562(b)*.

In (a), inserted "*.260 refusing to submit to mandatory medical testing".

Amended by R.1997 d.276, effective July 7, 1997.

See: *29 N.J.R. 1663(a)*, *29 N.J.R. 2836(a)*.

In Schedule of Prohibited Acts, added .261 (tampering with a urine specimen).

Amended by R.1997 d.325, effective August 4, 1997.

See: *29 N.J.R. 2542(a)*, *29 N.J.R. 3452(a)*.

In (a), upgraded .150 (tampering with fire alarms, fire equipment or fire suppressant equipment) and .154 (tampering with or blocking any locking device) into asterisk offenses.

Amended by R.1998 d.366, effective July 20, 1998.

See: *30 N.J.R. 1719(a)*, *30 N.J.R. 2619(a)*.

Inserted new prohibited acts .010 and .011.

Amended by R.1999 d.333, effective October 4, 1999.

See: *31 N.J.R. 1847(a)*, *31 N.J.R. 2891(a)*.

In (a), in prohibited act .351, inserted an asterisk preceding ".352", and inserted prohibited act .360.

Petition for Rulemaking.

See: *32 N.J.R. 3668(a)*.

Amended by R.2004 d.3, effective January 5, 2004.

See: *35 N.J.R. 4168(a)*, *36 N.J.R. 195(a)*.

Amended prohibited act 260 to include references to mandatory testing.

Amended by R.2004 d.294, effective August 2, 2004.

See: *36 N.J.R. 1657(a)*, *36 N.J.R. 3552(a)*.

Inserted ".204A" and "552A".

Emergency amendment, R.2005 d.435, effective November 15, 2005, (to expire January 14, 2006).

See: *37 N.J.R. 4575(a)*.

In (a), prohibited act *.009, substituted "," for "or" in two places and added "distribution, sale, or intent to distribute or sell, an" "communication device," "or peripheral that is capable of transmitting, receiving or storing data and/or electronically transmitting a message, image or data that is" and "(see "electronic communication device" definition at *N.J.A.C. 10A:1-2.2*)."

Adopted concurrent amendment, R.2006 d.58, effective January 11, 2006.

See: *37 N.J.R. 4575(a)*, *38 N.J.R. 993(a)*.

Provisions of R.2005, d.435, adopted without change.

Amended by R.2006 d.398, effective November 20, 2006.

See: *38 N.J.R. 3121(a)*, *38 N.J.R. 4867(a)*.

In entry ".652" in table in (a), substituted "self-mutilation" for "self mutilation", and in entry ".705" in table in (a), substituted "Administrator" for "Superintendent".

Amended by R.2009 d.237, effective August 3, 2009.

See: *41 N.J.R. 1645(a)*, *41 N.J.R. 2925(a)*.

In the entry for "*.054" in (a), inserted "or any refusal to register as required by law".

Amended by R.2009 d.236, effective August 3, 2009.

See: *41 N.J.R. 1649(a)*, *41 N.J.R. 2927(a)*.

In (a), added the entry for ".009A".

Petition for Rulemaking.

See: *47 N.J.R. 233(e)*, *300(b)*.

Amended by R.2017 d.007, effective January 3, 2017.

See: *48 N.J.R. 915(a)*, *49 N.J.R. 105(a)*.

Rewrote the section.

Annotations

Notes

Chapter Notes

Case Notes

Punishment of Christian Scientist inmate who refused to submit to tuberculosis test furthered compelling state interest in preventing spread of tuberculosis in prison, as would justify such test's substantial burden on inmate's right of free exercise of religion under *Religious Freedom Restoration Act. Karolis v. New Jersey Dept. of Corrections, D.N.J. 1996, 935 F.Supp. 523*.

Department of Corrections violated an inmate's due process rights by sanctioning him for failure to submit to drug testing without providing a valid statement of reasons for the sanctions imposed because they were not the minimum sanctions required, and the inmate had mental health issues that might have negated one of the otherwise mandatory penalties. *Malacow v. New Jersey Dep't of Corr., 2018 N.J. Super. LEXIS 165 (2018)*.

In a prison disciplinary appeal, the reviewing court reversed the sanctions imposed for an inmate's commission of various infractions in a single incident because under current rules, he could not have been sanctioned to more than a total of 365 days of administrative segregation under *N.J.A.C. 10A:1-2.2* and he could not have received any time in disciplinary detention and, thus, served more than the maximum sanction presently available. *Mejia v. New Jersey Dep't of Corr., 2016 N.J. Super. LEXIS 108 (2016)*.

Final decision of the New Jersey Department of Corrections, finding an inmate guilty of disciplinary infraction *.011, which is defined in *N.J.A.C. 10A:4-4.1* as possession or exhibition of anything related to a security threat group (STG), was upheld on appeal as the regulation gave him fair notice that possession of gang-related letters was prohibited and the admission of the letters, along with an intelligence investigator's report at the disciplinary hearing, provided substantial evidence supporting the infraction. *Jenkins v. New Jersey Dep't of Corr., 412 N.J. Super. 243, 989 A.2d 854, 2010 N.J. Super. LEXIS 35 (2010)*.

Disciplinary infraction *.011, as defined in *N.J.A.C. 10A:4-4.1* is neither facially vague nor unconstitutionally vague as applied since, at a minimum, the regulation provides an inmate proper notice of the prohibited conduct and what constituted prohibited literature related to security threat groups (STGs), that STG activity will not be tolerated, and it identifies general categories of behavior that will subject them to disciplinary action. *Jenkins v. New Jersey Dep't of Corr., 412 N.J. Super. 243, 989 A.2d 854, 2010 N.J. Super. LEXIS 35 (2010)*.

Department of Corrections was authorized to discipline a prisoner, who tested positive for cocaine and opiates upon his return to a State prison after escaping from a halfway house, for violating the Department's regulation prohibiting the use of drugs; under *N.J.S.A. 30:1B-3* and *N.J.S.A. 30:4-91.3*, the Commissioner of Corrections maintains authority over adult offenders committed to State correctional institutions, even at times when they are physically outside prison walls. *Ries v. Dep't of Corr., 396 N.J. Super. 235, 933 A.2d 638, 2007 N.J. Super. LEXIS 328 (App.Div. 2007)*.

When the evidentiary phase of a hearing has begun but is adjourned before completion, and the original hearing officer is unavailable on the date the hearing resumes, the evidentiary phase of the hearing must begin anew before the replacement hearing officer. Especially when credibility determinations are to be made, principles of fundamental fairness require that the same finder of fact receive all the evidence and make determinations based on all the proofs. *RATTI v. DEPARTMENT OF CORRECTIONS, 391 N.J. Super. 45, 916 A.2d 1078, 2007 N.J. Super. LEXIS 61 (2007)*.

In an inmate's disciplinary action appeal, the appellate court rejected the Department of Correction's blanket policy of keeping confidential all security camera videotapes in order to preclude inmates from learning camera angles, locations, or blind spots. The appellate court remanded the case to the Department to develop a record, regarding the justification of withholding the videotape from the inmate of a fight he was involved in and found guilty of misconduct, as the Department had to set forth the particular need for confidentiality of the videotape that could be reviewed by the appellate court. *ROBLES v. NEW JERSEY DEP'T OF CORRECTIONS, 388 N.J. Super. 516, 909 A.2d 755, 2006 N.J. Super. LEXIS 295 (2006)*.

Contact-visit loss component of zero tolerance drug-alcohol policy was enforceable against inmate who violated disciplinary rule prohibiting possession of drugs after announcement of policy but before formal amendment of regulation. *Walker v. Department of Corrections, 324 N.J.Super. 109, 734 A.2d 795 (N.J.Super.A.D. 1999)*.

Standard embodied in inmate disciplinary rule prohibiting using abusive or obscene language to staff member was not valid basis for imposing disciplinary punishment for inmate's vulgar and offensive statement in context of

psychotherapy that was not threatening or exhortative of disobedience or violence. *Pryor v. New Jersey Dept. of Corrections, 288 N.J.Super. 355, 672 A.2d 717 (A.D.1996)*.

Amendment to administrative code that added refusal to register as sex offender to list of prohibited acts was not unconstitutional. *A.F. v. Fauver, 287 N.J.Super. 354, 671 A.2d 155 (A.D.1996)*.

Determination whether remark constitutes threat; objective analysis whether remark conveys basis for fear. *Jacobs v. Stephens, 139 N.J. 212, 652 A.2d 712 (1995)*.

Finding that inmate threatened guard with bodily harm was supported by evidence. *Jacobs v. Stephens, 139 N.J. 212, 652 A.2d 712 (1995)*.

Prison officials' decision to place inmate in nonpunitive management control unit was supported by record. *Taylor v. Beyer, 265 N.J.Super. 345, 627 A.2d 166 (A.D.1993)*.

State prison sanctions for infractions only applicable if county inmate notified of infractions. *Bryan v. Department of Corrections, 258 N.J.Super. 546, 610 A.2d 889 (A.D.1992)*.

Procedural safeguards not properly applied in prison disciplinary proceeding involving confidential informant. *Fisher v. Hundley, 240 N.J.Super. 156, 572 A.2d 1174 (A.D.1990)*.

Information provided by confidential informant for use in prison disciplinary hearing must be part of confidential record. *Fisher v. Hundley, 240 N.J.Super. 156, 572 A.2d 1174 (A.D.1990)*.

New prison disciplinary hearing required when procedural safeguards were absent in first hearing or in presence of newly discovered evidence. *Fisher v. Hundley, 240 N.J.Super. 156, 572 A.2d 1174 (A.D.1990)*.

Research References & Practice Aids

CROSS REFERENCES:

Possession of inter-office envelopes, see *N.J.A.C. 10A:18-2.26*, *10A:18-3.13*.

End of Document

No. 2020-1265

IN THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

WALTER A. TORMASI,

Plaintiff-Appellant,

v.

WESTERN DIGITAL CORPORATION,

Defendant-Appellee.

On Appeal From the United States District Court, Northern District of California, No. 4:19-cv-00772-HSG, Hon. Haywood S. Gilliam, Jr., U.S.D.J.

BRIEF ON BEHALF OF APPELLANT WALTER A. TORMASI

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STATEMENT OF RELATED CASES

No related cases are pending before the Court, nor has this case been before the Court on prior occasions.

JURISDICTIONAL STATEMENT

This matter arises from plaintiff-appellant Walter A. Tormasi's patent-infringement complaint filed in the district court under 35 U.S.C. § 281. Appx13-55. The district court had original and exclusive jurisdiction over Tormasi's patent-infringement action under 28 U.S.C. §§ 1331 and 1338(a).

The district court entered its dispositive order on November 21, 2019, with Tormasi filing his notice of appeal within 30 days thereafter (i.e., on December 6, 2019) in accordance with Fed. R. App. P. 4(a). Appx1-5, 11, 188.

This Court has original jurisdiction over appeals of final judgments under 28 U.S.C. § 1291 and exclusive jurisdiction over patent-related appeals under 28 U.S.C. § 1295(a)(1).

STATEMENT OF ISSUES PRESENTED FOR REVIEW

This appeal involves two of the most important issues impacting the district court's jurisdiction and Tormasi's ability to seek redress for the misconduct alleged.

Tormasi is imprisoned in New Jersey and, during his imprisonment, was awarded U.S. Patent No. 7,324,301. That patent is the subject of Tormasi's infringement action.

One issue in this appeal (Point I) is whether Tormasi

lawfully owns the patent-in-suit and, by extension, whether Tormasi has standing to sue for infringement under 35 U.S.C. § 281. The standing issue goes directly to whether the federal judiciary has jurisdiction under Article III of the United States Constitution. Needless to say, the standing issue is threshold in nature, mandating that the standing issue be resolved ab initio for jurisdictional purposes.

Another issue in this appeal (Point II) is whether Tormasi has requisite suing capacity under N.J. Stat. Ann. § 2A:15-1 and whether prison administrative regulations are capable of superseding the capacity-to-sue statute. The suing-capacity issue, although potentially dispositive, is subservient to the standing/jurisdictional issue. This is because Tormasi's capacity to sue comes into play only after the threshold standing/jurisdictional issue is resolved in his favor.

The standing-to-sue and suing-capacity issues were raised and argued by the parties in the district court. Appx73-80, 113-125, 169-181. Both issues were either adjudicated on the merits (in the case of the suing-capacity issue) or relate to jurisdiction (in the case of the standing-to-sue issue). Id. at 3-5. Such issues are thus ripe for appellate consideration.

STATEMENT OF THE CASE

Tormasi is an innovator and entrepreneur, developing inventions in technology and other areas. Appx13. One of

Tormasi's inventions resulted in the issuance of U.S. Patent No. 7,324,301. Id. at 13, 34-42. That patent pertains to the field of magnetic storage and retrieval. Id. at 13-14, 34-42.

As explained in his infringement complaint, every hard disk drive features an actuator mechanism. Id. at 16. The purpose of the actuator mechanism is to position the read/write heads over the data tracks of the storage media. Id. Tormasi's patent encompasses, among other things, improvements to the actuator mechanism upon which hard drives depend. Id.

One embodiment of Tormasi's invention features an innovative dual-stage actuator system. Id. That dual-stage system comprises an ordinary primary actuator in conjunction with tip-mounted secondary actuators. Id. at 16-17. The secondary actuators constitute "subdevices" such as "microactuators" or "microelectromechanisms." Id. at 17. This design, when structured according to the patent, enables independent movement of the read/write heads. Id.

Appellee Western Digital Corp. (WDC) is one of the largest vendors of hard disk drives. Id. at 14. In its prior fiscal year, WDC sold tens of millions of hard drives and generated over $20 billion in revenue. Id. WDC is publicly traded on the NASDAQ exchange, and its market presence in this country is ubiquitous. Id. In fact, WDC distributes hard drives in all 50 states, either by selling directly to consumers or supplying

retailers, manufacturers, importers, and wholesalers. Id.

Tormasi alleged that WDC committed patent infringement by circulating hard drives containing "dual-stage actuator system[s] and tip-mounted actuators." Id. at 20. Tormasi alleged that such infringement occurred "through . . . element-by-element structural correspondence and under the doctrine of equivalents." Id. He alleged, in particular, that WDC's "dual-stage actuator system[s] and tip-mounted actuators, as structured, constitute 'means for moving [the arm-mounted read/write heads] simultaneously and independently across corresponding carrier surfaces.'" Id. (brackets in original). He also alleged that WDC's apparatus, relative to Tormasi's device, "performs the same function," "implements that function the same way," and "achieves the same result." Id. at 21. These characteristics, according to Tormasi, rendered WDC's hard drives in violation of various independent and dependent claims of the patent-in-suit. Id. at 20-21.

Tormasi further alleged that WDC's infringement was willful in nature. Id. at 22-24. Specifically, based on "surrounding circumstances," Tormasi alleged that WDC "knew that its dual-stage actuator system[s] and tip-mounted actuators violated U.S. Patent No. 7,324,301" but, despite such knowledge, "intentionally circulated infringing devices." Id. at 22.

To remedy the infringement alleged, Tormasi sought

compensatory and enhanced damages totaling $15 billion. Id. at 24-25. Tormasi also sought, among other things, an injunction preventing WDC from circulating infringing devices in the United States and its territories/possessions. Id. at 24.

WDC moved to dismiss Tormasi's complaint at the pleading stage. Id. at 56-86. In its moving papers, WDC argued that Tormasi lacked standing to sue (meaning that no justiciable controversy existed, thereby depriving the district court of jurisdiction). Id. at 73-78. WDC also argued that Tormasi lacked suing capacity under state law. Id. at 78-80.

WDC's lack-of-standing argument was based on the premise that Tormasi's Delaware holding company, Advanced Data Solutions Corp. (ADS), continued to own the patent-in-suit. Id. at 73-78, 169-178. To support that premise, WDC challenged the validity of various ADS ownership-transferring assignments and disputed Tormasi's ability to prove his position as an ADS shareholder, director, and executive. Id. at 73-78, 170-178.

WDC's capacity-to-sue argument relied on Tormasi's imprisonment status. Id. at 78-80, 178-181. Even though N.J. Stat. Ann. § 2A:15-1 permits any mentally competent adult to bring suit, WDC contended that prison administrative regulations superseded the capacity-to-sue statute. Appx78-80, 178-181. Specifically, WDC argued that Tormasi's lawsuit constituted prohibited business activities under N.J. Admin.

Code § 10A:4-4.1(a)(3)(xix). Appx78-80, 178-181. WDC argued, in essence, that Tormasi's alleged violation of prison regulations removed his suing capacity, permitting third parties to infringe Tormasi's patent without legal recourse. Id.

Tormasi opposed WDC's lack-of-standing and capacity-to-sue arguments. Id. at 113-125. He filed not only an opposition brief but also an extensive declaration detailing, among other things, the circumstances surrounding his invention, his formation of his Delaware holding company, and his current ownership of the patent-in-suit. Id. at 109-164.

The record, as developed by the parties, reveals that Tormasi is incarcerated at New Jersey State Prison (NJSP), an adult maximum-security penitentiary located in the City of Trenton. Id. at 133. Tormasi arrived at NJSP in September 2000 and has been confined at NJSP since then. Id.

During his imprisonment, Tormasi utilized available resources to educate, train, and improve himself. Id. For example, Tormasi enrolled in and completed numerous educational courses, including an exhaustive paralegal program offered by Blackstone School of Law. Id. He also read over 1000 books and periodicals covering diverse subjects and disciplines, including technology (such as electronics and computers), mathematics (such as trigonometry and calculus), science (such as physics and chemistry), business (such as finance and

management), medicine (such as biology and psychology), and philosophy (such as metaphysics and epistemology). Id.

During his imprisonment, and throughout the years preceding his lawsuit, Tormasi peacefully and constructively exercised his intellectual capabilities. Id. at 133-134. Pursuant thereto, Tormasi undertook the process of forming ideas, conceptualizing those ideas into novel and non-obvious devices, and memorializing his inventive thoughts in writing. Id.

In early 2003, at the age of 23, Tormasi invented an improvement in the technical field of magnetic storage and retrieval. Id. at 134. Tormasi's invention involved, among other things, improvements to the actuator mechanism upon which hard disk drives depend. Id. at 16. Tormasi took steps to protect his invention and, on May 3, 2004, filed U.S. Provisional Patent Application No. 60/568,346. Id. at 134.

Shortly after conceiving his invention, Tormasi decided to form an intellectual-property holding company. Id. Using the agency services of The Company Corporation, Tormasi caused an incorporation certificate to be drafted and filed with the State of Delaware. Id. Pursuant to that certificate, Tormasi formed Advanced Data Solutions Corp., an entity whose charter permitted perpetual existence. Id. at 101, 134.

In forming ADS, Tormasi intended that ADS function exclusively as his personal asset-holding vehicle. Id. at

134-144, 150. Consequently, during its entire existence, ADS had no tangible products or business operations. Id. Nor did ADS have any debt or creditors. Id. at 143.

In his capacity as an ADS director, Tormasi appointed himself to serve in key executive positions. Id. at 134. Those self-appointed positions included Chief Executive Officer, President, and Chief Technology Officer. Id.

Additionally, in his capacity as an ADS director, Tormasi adopted corporate resolutions in early 2004. Id. Such corporate resolutions provided that ADS issue to Tormasi all shares of common stock, doing so in exchange for Tormasi's transfer to ADS complete right, title, and interest in U.S. Provisional Patent Application No. 60/568,346 and in any related domestic and foreign applications and patents. Id.

Pursuant to the foregoing corporate resolutions, ADS and Tormasi entered into an assignment agreement. Id. at 134-135. The assignment agreement, dated May 17, 2004, memorialized and paralleled the aforementioned corporate resolutions. Id. at 135. Consequently, upon executing the assignment agreement, Tormasi became the sole ADS shareholder, with ADS owning all applications/patents stemming from U.S. Provisional Patent Application No. 60/568,346. Id.

Thereafter, on January 10, 2005, Tormasi filed U.S. Patent Application No. 11/031,878. Id. The following month, in

accordance with the intellectual-property assignment agreement, Tormasi executed an assignment conveying to ADS complete right, title, and interest in U.S. Patent Application No. 11/031,878. Id. The assignment was executed on February 7, 2005, and was recorded with the United States Patent and Trademark Office (USPTO). Id. at 92-98, 135.

The patent-acquisition process took three years (between 2005 and 2008). Id. at 34, 135. During that three-year period, on March 3, 2007, prison officials seized various legal documents from Tormasi. Id. at 135. Among the documents seized from Tormasi were ADS corporate files, which included, among other things, the corporate resolutions and the assignment agreement described above. Id. To date, prison officials continue to possess such documents. Id. at 135-136.

Eleven weeks after seizing the ADS files, on May 23, 2007, prison officials charged Tormasi with committing an institutional infraction for operating ADS without having administrative approval. Id. at 136, 146. Tormasi was found guilty of that charge and sanctioned to 7 days of solitary confinement and 90 days of administrative segregation. Id. at 136, 148. Tormasi was also warned, explicitly and unequivocally, that his continued involvement with ADS matters subjected him to further disciplinary action. Id. at 136.

Based on such conduct by prison officials, Tormasi feared

that his control and ownership over ADS (and thus his control and ownership over his intellectual property) were in jeopardy. Id. In response, Tormasi decided to take precautionary measures to ensure that his intellectual property remained enforceable, licensable, and sellable to the fullest extent possible. Id. at 136, 150-151, 153.

Accordingly, in his capacity as an ADS director, Tormasi adopted corporate resolutions on June 6, 2007, wherein ADS agreed to transfer to Tormasi ownership in U.S. Patent Application No. 11/031,878, including any ensuing patents, upon the occurrence of certain events. Id. at 136-137, 150-151. The ownership-transferring contingencies included the dissolution of ADS. Id. The ownership-transferring contingencies also included Tormasi's inability to discharge his duties as an ADS executive or director, Tormasi's inability to fully exercise his powers as an ADS shareholder, and Tormasi's inability to benefit from intellectual property held by ADS. Id.

Under authority of the foregoing corporate resolutions, Tormasi executed an assignment. Id. at 137, 153. The assignment, also dated June 6, 2007, memorialized Tormasi's contingent re-ownership described above. Id.

The patent-in-suit, Serial No. 7,324,301, was issued by USPTO in January 2008. Id. at 34, 137. Pursuant to Tormasi's previously recorded assignment executed on February 7, 2005, the

patent-in-suit listed ADS as the registered assignee. Id.

During the ensuing years, Tormasi expected his father and brother to pay yearly fees to Tormasi's Delaware agent (i.e., The Company Corporation) for the purpose of complying with corporate laws. Id. at 137. Tormasi also expected his father and brother to allow Tormasi to use their residential and commercial properties for ADS-related matters. Id. For those reasons, Tormasi believed that ADS was in good standing with Delaware officials and transacted ADS activities from properties owned or leased by family members. Id. at 137-138, 142.

Meanwhile, in late 2009 (about two years after the patent-in-suit had been issued), Tormasi encountered an article in Maximum PC. Appx138. The article discussed WDC's use of dual-stage actuator systems within its hard disk drives. Id. at 44, 138. The article led Tormasi to believe that WDC (among others) had committed patent infringement. Id. at 138.

Tormasi decided to defend his intellectual-property rights via civil litigation. Id. However, because corporations may appear in federal court only through an attorney, and because ADS lacked such legal representation, Tormasi took steps to acquire personal ownership in U.S. Patent No. 7,324,301. Id.

Specifically, on December 27, 2009, Tormasi adopted corporate resolutions and executed an assignment, wherein ADS transferred to Tormasi all right, title, and interest in the

patent-in-suit. Id. at 138, 155, 157. The purpose of the transfer in ownership was to permit Tormasi to personally pursue, and to personally benefit from, an infringement action against WDC and other entities. Id. at 138, 155.

Despite reclaiming title to the patent-in-suit, Tormasi did not immediately take civil action. Id. at 138. He instead attempted to perform technical research regarding WDC's hard disk drives. Id. Tormasi's research efforts, however, were greatly impeded due to his imprisonment, surrounding circumstances, and other factors. Id. at 138-139.

Having failed to make meaningful headway in his research efforts, Tormasi sent solicitation letters to numerous attorneys, requesting assistance for research and litigation purposes. Id. at 139. Tormasi received multiple responses over the years, with all such responses expressing inability or unwillingness to assist. Id. at 139, 159, 161, 163-164.

Meanwhile, during the ensuing years, Tormasi became preoccupied with litigating his criminal case and with unwinding prior lawsuits and appeals. Id. at 139. He thus temporarily suspended his infringement-related efforts. Id. Tormasi revived those efforts just recently. Id. That revival culminated with Tormasi's filing of his infringement lawsuit, in his individual capacity, in February 2019. Id. at 13-55.

To confirm his current ownership of the patent-in-suit,

Tormasi executed and appended to his complaint an assignment of recent vintage. Id. at 27, 139. That assignment, dated January 30, 2019, indicated that ADS "assign[ed] to Walter A. Tormasi all right, title, and interest in U.S. Patent No. 7,324,301." Id. at 27. The assignment further indicated that the transfer in legal title to Tormasi "ha[d] complete retroactive effect, permitting Walter A. Tormasi to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301." Id.

Tormasi's purpose for executing the 2019 assignment was to provide up-to-date evidence confirming his current ownership of the patent-in-suit and his express authority to sue for all acts of infringement occurring during the cause of action. Id. at 139-140. Thus, by executing the 2019 assignment, Tormasi had no intention of repudiating or supplanting his prior assignments from 2007 and 2009. Id. at 140. Those prior assignments, accordingly, remain outstanding and binding. Id.

Upon receiving WDC's ensuing motion to dismiss, Tormasi learned that his holding company, ADS, entered defunct status in 2008. Id. at 142. Apparently, Tormasi's father, due to debilitating health issues, had been prevented from paying yearly fees to Tormasi's Delaware agent, resulting in the nonpayment of corporate franchise taxes. Id. at 108, 142. The unintended tax delinquencies caused the State of Delaware to

place ADS on defunct status in 2008. Id. at 108.

During proceedings before the district court, Tormasi explained, under penalty of perjury, that "the 2008 default by ADS [was] entirely inadvertent." Id. at 142. Tormasi was "[s]urprised" by the default and "never intended for ADS to run afoul of the corporate laws of Delaware." Id. And because Tormasi had no previous knowledge of the 2008 default, Tormasi "believed that ADS remained in good standing with Delaware officials." Id. For that reason, Tormasi executed all post-default assignments "sincerely and honestly, i.e., in the absence of fraud, bad faith, or the like." Id. at 142-143.

As noted, WDC moved to dismiss Tormasi's complaint at the pleading stage. Id. at 56-86. In its moving papers, WDC advanced two primary arguments. Id. at 73-80 First, it asserted that Tormasi was incapable of proving his ownership of the patent-in-suit and therefore lacked standing to sue (meaning that no justiciable controversy existed, thereby depriving the district court of jurisdiction). Id. at 73-78. Second, it asserted that prison administrative regulations removed Tormasi's suing capacity under New Jersey law. Id. at 78-80.

The district court granted WDC's motion to dismiss. Id. at 1-5. In its five-page ruling, the district court assumed, but never decided, that Tormasi satisfied standing/jurisdictional requirements. Id. at 3. Given that assumption, the district

court turned to WDC's suing-capacity argument. Id. at 3-5. It then sided with WDC, ultimately concluding "that [Tormasi], as an inmate of the New Jersey Department of Corrections, lacks the capacity to sue for patent infringement." Id. at 5.

In making its lack-of-capacity finding, the district court explained that New Jersey prison regulations prevented inmates such as Tormasi from conducting businesses without having administrative approval. Id. at 3 (citing former version of N.J. Admin. Code § 10A:4-4.1(a)(3)(xix)). It further explained that Tormasi's infringement lawsuit may allow him to "benefit from his patent assets" through "compensatory damages." Id. at 4. By the district court's logic, Tormasi's potential recovery transformed his lawsuit into an unauthorized business activity "in contravention of New Jersey regulations." Id.

To rectify Tormasi's supposed violation of prison regulations, the district court permanently extinguished Tormasi's suing capacity concerning the patent-in-suit. Id. at 4-5. That is, the district court dismissed Tormasi's lawsuit with prejudice and thereby forever prevented Tormasi from asserting infringement against WDC and others. Id. at 5.

SUMMARY OF THE ISSUES

Two issues are raised in this appeal. Both issues, in essence, relate to justiciability. The issues, in particular, require this Court to determine: (1) whether the federal

judiciary is capable of exercising jurisdiction over the matter involved (that is, whether Tormasi has standing); and (2) whether Tormasi is capable of bringing suit (that is, whether Tormasi has requisite suing capacity). The law requires that both questions be resolved in Tormasi's favor.

First and foremost, Tormasi has standing to sue under the enabling statute, 35 U.S.C. § 281. That statute gives "patentee[s] . . . remedy by civil action for infringement." To sue under § 281, plaintiffs must hold "legal title" to the patent-in-suit. Arachnid, Inc. v. Merit Industries, Inc., 939 F.3d 1574, 1579 (Fed. Cir. 1991). The general rule is that legal title must be held at the time of infringement. Id. As an exception to that general rule, legal title may vest post-infringement where the assignment explicitly confers retroactive enforcement authority. Id. at 1579 n.7.

In this case, Tormasi is the legal title holder of the patent-in-suit. This is because one or more of the contingencies specified in the 2007 assignment were met; because the post-default assignments from 2009 and 2019 were authoritative or, at the very least, superfluous; because ADS and its stewardship properly exercised their asset-transferring powers at all times; and because of other reasons.

Moreover, aside from owning the patent-in-suit, Tormasi has authority to sue for all acts of infringement occurring during

the cause of action (between 2013 and 2019). This is because the assignments from 2007 and 2009 were executed prior to the cause of action, with the assignment from 2019 explicitly providing Tormasi with retroactive enforcement authority.

Given that Tormasi holds legal title to U.S. Patent No. 7,324,301, and given that the aforementioned assignments were executed before the cause of action and/or had express retroactive effect, Tormasi has standing to bring suit under 35 U.S.C. § 281. And given Tormasi's standing under § 281, an actual case or controversy exists under Article III of the United States Constitution -- thereby vesting the district court (as well as this Court) with jurisdiction.

In addition to satisfying standing/jurisdictional requirements, Tormasi met capacity-to-sue standards under state law. This is because Tormasi is an adult with mental competency. Thus, pursuant to N.J. Stat. Ann. § 2A:15-1, Tormasi has the capacity to pursue his infringement action.

This conclusion holds true notwithstanding Tormasi's imprisonment status and notwithstanding prison rules preventing inmates from operating unapproved businesses.

The New Jersey legislature has definitively spoken on the capacity-to-sue standard, declaring adulthood and mental competency the sole determining factors. N.J. Stat. Ann. § 2A:15-1. Imprisonment status and prison behavior are not among

the factors listed in N.J. Stat. Ann. § 2A:15-1, making those factors irrelevant in determining suing capacity.

Although N.J. Admin. Code § 10A:4-4.1(a)(3)(xix) prevents inmates from operating businesses without having administrative approval, that regulation is inapplicable to Tormasi's situation. Tormasi's lawsuit, filed in his individual capacity, seeks to enforce his personal intellectual-property rights and, for that reason, cannot be construed as an unpermitted business activity under § 10A:4-4.1(a)(3)(xix).

Above all, however, administrative regulations cannot supersede statutes. Because Tormasi is an adult with mental competency, the capacity-to-sue statute, N.J. Stat. Ann. § 2A:15-1, gives Tormasi suing capacity, irrespective of administrative regulations promulgated by prison officials.

LEGAL ARGUMENT

POINT I

TORMASI OWNS THE PATENT-IN-SUIT AND HAS FULL ENFORCEMENT AUTHORITY, GIVING HIM STANDING TO SUE UNDER 35 U.S.C. § 281; THUS, THE FEDERAL JUDICIARY HAS JURISDICTION UNDER ARTICLE III OF THE UNITED STATES CONSTITUTION.

As the Court is aware, federal courts may only adjudicate actual cases or controversies. U.S. Const. art. III. In addition, only "patentee[s]" (legal title holders) many sue for infringement. 35 U.S.C. § 281. Tormasi submits that such standing and jurisdictional requirements have been met, as

Tormasi owns the patent-in-suit and has authority to sue for all acts of infringement occurring during the cause of action.

Before addressing the foregoing issues, Tormasi acknowledges that the district court never decided whether § 281 and Article III requirements were met. Appx1-5. Rather than ruling on those justiciability issues, the district court assumed that Tormasi had standing under 35 U.S.C. § 281 and that jurisdiction existed under Article III. Appx3.

Despite the district court's sidestepping, Tormasi's standing and jurisdictional issues are now ripe for appellate consideration. Justiciability issues, for one thing, are "threshold" in nature. O'Shea v. Littleton, 414 U.S. 488, 493 (1974). Standing and jurisdictional issues must therefore be resolved at the outset, even if first considered or adjudicated on the appellate level. Juidice v. Vail, 430 U.S. 327, 331 (1977). Thus, as explained by the Supreme Court, every federal appellate court must "satisfy itself not only of its own jurisdiction[] but also [the jurisdiction] of the lower courts in [the] case under review." FW/PBS, Inc. v. Dallas, 493 U.S. 215, 231 (1990) (internal quotation marks omitted).

It follows, then, that the unadjudicated standing and jurisdictional issues (both of which were thoroughly argued below by the parties) are ripe for appellate review. So those issues must now be considered, notwithstanding the district

court's failure to rule in the first instance.

Title 35, as noted, affords "patentee[s] . . . remedy by civil action for infringement." 35 U.S.C. § 281. The term "patentee," as used in § 281, is synonymous with "legal title holder" and includes not only the person or entity "to whom the patent was issued but also the successors in title to the patentee." Arachnid, Inc. v. Merit Industries, Inc., 939 F.3d 1574, 1578 n.2 (Fed. Cir. 1991) (citing 35 U.S.C. § 100(d)).

Accordingly, in order "to recover money damages for infringement," the patent-asserting person or entity "must have held the legal title to the patent during the time of the infringement." Id. at 1579. Alternatively, if legal title vested post-infringement, the title-conferring instrument must have expressly authorized "right of action for past infringements." Id. at 1579 n.7 (citing cases).

The party invoking jurisdiction (here, Tormasi) bears the burden of establishing standing. Myers Investigative and Security Svs., Inc. v. United States, 275 F.3d 1366, 1369 (Fed. Cir. 2002). Questions of standing involve legal conclusions and, as such, are evaluated de novo. Drone Techs., Inc. v. Parrot S.A., 838 F.3d 1283, 1292 (Fed. Cir. 2016).

Because Tormasi's standing to sue "implicates the case-or-controversy requirement of Article III," id., Tormasi chooses to focus his justiciability argument on § 281

standards. Obviously, if Tormasi has standing under § 281, an actual case or controversy will exist under Article III. See Sprint Communications Co., L.P. v. APCC Services, Inc., 554 U.S. 269, 273 (2008). In such an event, Tormasi's lawsuit will be cognizable under both justiciability provisions.

With that said, it can be shown that Tormasi does, in fact, meet standing requirements under § 281. This is especially the case when considering not only Tormasi's verified factual allegations (as set forth in his complaint) but also relevant extrinsic evidence presented to the district court.

As alleged in his complaint, Tormasi "is the . . . patentee of U.S. Patent No. 7,324,301 and, as such, has the statutory authority to bring suit against [WDC] for infringement of said patent." Appx15 (citing 35 U.S.C. § 281). Additionally, as further alleged in his complaint, Tormasi "owns all right, title, and interest in the foregoing patent, with such ownership permitting [him] to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301." Id. (internal quotation marks omitted).

These allegations are entirely sufficient to establish standing. Significantly, pursuant to Arachnid, supra, Tormasi alleged not only current ownership but also express authority to sue for past infringement. These allegations, if true (which they are), afford Tormasi "remedy by civil action for

infringement of his patent." 35 U.S.C. § 281.

Assuming, arguendo, that Tormasi's allegations in his complaint fail to establish standing, Tormasi's extrinsic evidence resolves that issue in his favor. Such extrinsic evidence consists of Tormasi's declaration and exhibits. Those documents establish that Tormasi owns the patent-in-suit and has express retroactive enforcement authority.

Specifically, according to his declaration and exhibits, Tormasi was, and is, the sole shareholder of Advanced Data Solutions Corp. (ADS), an entity that previously owned the patent-in-suit. Appx134-135. While serving as an ADS director and ADS executive, Tormasi authorized and executed various intellectual-property assignments in 2007, 2009, and 2019. Id. at 27, 136-140, 150, 153, 155, 157. Those assignments, which included the assignment appended to Tormasi's complaint, conveyed to Tormasi complete right, title, and interest in the patent-in-suit. Id. at 27, 153, 157. Notably, the assignments from 2007 and 2009 were executed prior to the cause of action (i.e., before the six-year period preceding Tormasi's complaint), with the assignments from 2009 and 2019 giving him express retroactive enforcement authority. Id.

Like the allegations in his complaint, Tormasi's declaration and exhibits establish his standing to sue under 35 U.S.C. § 281. This is because, pursuant to Arachnid, supra,

Tormasi has proven his ownership of the patent-in-suit during the term of infringement or, at the very least, proven his authority to sue for pre-ownership acts of infringement.

In its motion to dismiss, WDC challenged Tormasi's ownership of the patent-in-suit. Appx73-78, 169-178. WDC postulated, in particular, that Tormasi was incapable of proving his status as an ADS owner, director, and executive. Id. at 73-75, 170-173. Relying on that premise, WDC contended that Tormasi lacked authority to execute ADS assignments. Id.

Contrary to WDC's premise, Tormasi's declaration and exhibits establish his formation of ADS; his service as an ADS director; his appointment to various executive positions, including President and Chief Executive Officer; and his ownership of all ADS common stock. Id. at 27, 134-138, 140-141, 150-151, 153, 155, 157. To WDC's point, Tormasi acknowledges his inability to produce certain ADS records due to seizure by prison officials. Id. at 135-136, 141-142. However, Tormasi's declaration, which is supported by corroborating evidence, see id. at 140-141, is entirely sufficient to prove his ADS ownership/stewardship. WDC is thus incorrect is arguing that Tormasi lacked authority to represent ADS and to execute intellectual-property assignments on its behalf.

WDC's motion to dismiss also took issue with the fact that the ADS assignments from 2007, 2009, and 2019 were never

recorded with USPTO. Id. at 171. The obvious explanation is that Tormasi was under scrutiny by prison officials, preventing him from freely communicating with USPTO. Id. at 136. Whatever the case, the foregoing assignments, although unrecorded, constituted "instrument[s] in writing." 35 U.S.C. § 261. The assignments therefore met statutory requirements.

In its motion to dismiss, WDC relied heavily on the fact that ADS entered defunct status in 2008. Appx75-78. WDC believed that such an irregularity prevented ADS from executing post-2008 assignments. Id. WDC therefore contended that ADS continued to hold title to the patent-in-suit and, consequently, that Tormasi lacked standing under 35 U.S.C. § 281. Appx75-78, 169-170. These arguments are entirely without merit.

First and foremost, long-standing Delaware law permits defunct corporations to enter into binding contracts under certain circumstances. See Krapf & Son, Inc. v. Gorson, 243 A.2d 713, 715 (Del. 1968). Those circumstances include situations where "the forfeiture of the [corporate] charter came about by inadvertence" and where the contract in question was executed "in the absence of fraud or bad faith." Id.

In arriving at its holding, the court in Krapf noted that void corporations are "not dead for all purposes following forfeiture." Id. (citing cases dating back to 1912). It also declared "that [the] failure to pay franchise taxes is an issue

solely between the corporation and the State [of Delaware] since the franchise tax statutes are for revenue-raising purposes alone." Id. These factors, according to Krapf, permitted inadvertently "proclaimed corporation[s]" to enter into "binding commitment[s]" -- provided that "no fraud or bad faith on the part of the corporate officers is involved." Id.

The post-2008 assignments fall within these parameters. As detailed in his declaration, Tormasi expected family members to pay yearly fees to The Company Corporation for purposes of regulatory compliance. Appx137, 142. Tormasi recently learned, however, that his father suffered medical disabilities and failed to make such payments, causing Delaware officials to place ADS on defunct status in 2008. Id. at 142. But because Tormasi did not learn about the corporate default until receiving WDC's motion to dismiss, Tormasi assumed that ADS remained in good standing and operated ADS accordingly. Id. at 142-143. Ultimately, Tormasi authorized and executed two post-2008 assignments, doing so in his capacity as an ADS director and executive. Id. at 27, 138-140, 155, 157.

These circumstances render Tormasi's assignments from 2009 and 2019 authoritative despite the 2008 default by ADS. In accordance with Krapf, supra, Tormasi has demonstrated that the corporate default was "inadvertent" and that the post-2008 assignments were executed "in the absence of fraud or bad

faith." 243 A.2d at 715. The assignments from 2009 and 2019 are therefore "binding on the corporation." Id.

This Court must, of course, abide by Krapf. Simply stated, federal courts are prohibited from overruling state courts on questions of state law. The ruling in Krapf is therefore controlling and must be followed and applied here.

In its motion papers, WDC appeared to argue that Krapf is inconsistent with certain Delaware statutes and is inapplicable to the facts of this case. Appx76-78, 174-175. That argument must be rejected. First, even if Krapf is somehow materially distinguishable, Tormasi relies on Krapf for its legal holding, not its factual similarity. Second, despite WDC's diverging views on the impact of certain Delaware statutes, Krapf constitutes final authority in interpreting Delaware law and, as noted, must be followed and applied by this Court.

It stands to reason that Krapf is controlling and cannot be sidestepped. See Parker v. Cardiac Science, Inc., 2006 U.S. Dist. LEXIS 90014, *7-9 (E.D. Mich. 2006) (following Krapf and upholding validity of assignment by defunct corporation where default was "inadvertent" and where no fraud or bad faith existed in executing assignment, notwithstanding that corporation was never retroactively revived, renewed, or reinstated under 8 Del. Code Ann. § 312). But even if Krapf is disregarded, WDC continues to be wrong in arguing that ADS

became incapacitated after its unintended default.

It is well established that improperly maintained corporations can exist de facto, with de facto corporations being equivalent to legally compliant corporations. See C.J.S. Corporations §§ 63-64, at pp. 336-39 (West Publishing Co. 1990). It is also well established that defunct corporations continue to maintain their corporate existence for asset-disposal purposes and, further, that executives and directors of defunct corporations are permitted to retain and exercise their corporate powers and duties. See id. §§ 859, 962-64, at pp. 514, 516-21; 8 Del. Code Ann. § 278.

Based on the circumstances outlined in Tormasi's declaration, it is clear that ADS assumed de facto corporate status after inadvertently defaulting with Delaware regulators in 2008. It is also clear that the subsequent assignments from 2009 and 2019 were undertaken by ADS for asset-disposal purposes. For those reasons, ADS and its stewardship had the power to authorize and execute post-2008 assignments.

WDC's invalidity arguments are flawed in other critical respects. Aside from incorrectly presuming that ADS became incapacitated after its 2008 default, WDC failed to recognize that assets of unindebted corporations are distributed to shareholders. See C.J.S. Corporations, supra, § 875, at pp. 533-34; 8 Del. Code Ann. § 281. In this case, Tormasi was, and

continues to be, the sole shareholder of ADS, with ADS having no debt or creditors. Appx134-135, 143. So even if WDC were correct that ADS evaporated in 2008 (something which Tormasi disputes), all ADS assets would have been transferred to Tormasi, making him the current owner of the patent-in-suit.

In any event, WDC's invalidity arguments have no bearing on the assignments from 2007 and 2009. This is because the 2007 assignment was executed before the 2008 default by ADS, with the 2009 assignment being executed within the three-year continuation period under 8 Del. Code Ann. § 278.

WDC, of course, cannot dispute the fact that the 2007 assignment had been executed pre-default. Nor can WDC dispute the fact that the ownership-transferring contingencies were satisfied. Pursuant to those contingencies, title to the patent-in-suit transferred to Tormasi in the event that ADS was "dissolved"; was "voided, nullified, or invalidated"; or was "inactive or inoperable." Appx153. The 2008 default, by WDC's characterization, met the above contingencies. Thus, the pre-default assignment vested Tormasi with ownership of the patent-in-suit, effective as of the day of the default.

The assignment from 2009, although executed after the 2008 default, is similarly authoritative. Under 8 Del. Code Ann. § 278, "corporations, whether they expire by their own terms or are otherwise dissolved, shall nevertheless be continued, for

the term of 3 years . . . to dispose of and convey their property . . . and to distribute to their stockholders any remaining assets." This three-year continuation period applies to corporations whose charters were voided for nonpayment of franchise taxes. See Krapf, supra, 243 A.2d at 715 (declaring 8 Del. Code Ann. § 278 applicable to tax-delinquent voided corporation); accord United States v. McDonald & Eide, Inc., 670 F. Supp. 1226, 1229-30 (D. Del. 1989) (so holding and citing historical Delaware case to that effect). The three-year continuation period therefore applies to ADS.

For the sake of completeness, Tormasi acknowledges that the Delaware Supreme Court, in Transpolymer Indus. v. Chapel Main Corp., 1990 Del. LEXIS 317 (Del. 1990), refused to apply 8 Del. Code Ann. § 278 to an incorporated entity whose charter had been forfeited for tax delinquencies. The Transpolymer ruling, however, is unpublished and thus lacks precedential value. It also constitutes dicta which, if enforced, would depart from long-standing Delaware corporate law. Not surprisingly, Delaware courts have refused to apply Transpolymer. See, e.g., First State Staffing Plus, Inc. v. Montgomery Mut. Ins. Co., 2005 Del. Ch. LEXIS 132, *7 (Del. Ch. 2005).

It follows, then, that the continuation window applies to ADS. Here, ADS was voided in 2008. Appx108. In accordance with 8 Del. Code Ann. § 278, ADS had until 2011 (three years) to

transfer its property. The assignment from 2009 fell within the three-year window, making that assignment valid.

In summary, based on the above circumstances, Tormasi "held enforceable title to the patent at the inception of the lawsuit." Paradise Creations, Inc. v. U V Sales, Inc., 315 F.3d 1304, 1309 (Fed Cir. 2003) (emphasis omitted). The 2007 and 2009 assignments were executed either prior to the corporate default or within the three-year continuation period. The 2019 assignment, although executed well after the three-year continuation window, was confirmatory in nature and, at the very least, superfluous to prior valid assignments. In terms of substance, the 2009 and 2019 assignments were non-contingent and absolute. Although the 2007 assignment was contingent, all ownership-transferring contingencies were met. All assignments, moreover, were approved/executed by Tormasi in his capacity as an ADS owner, director, and officer. Such assignments were therefore binding on ADS, on Tormasi, and on all others.

The upshot, of course, is that Tormasi currently owns the patent-in-suit. Equally important, Tormasi was the legal title holder during the cause of action and/or had retroactive enforcement authority. Tormasi, as such, has "remedy by civil action for infringement" pursuant to 35 U.S.C. § 281.

Given Tormasi's standing under § 281, the federal judiciary necessarily possesses Article III jurisdiction. As noted in

Drone, supra, standing is "jurisdictional" and "implicates the case-or-controversy requirement of Article III." 838 F.3d at 1292. Thus, given Tormasi's standing under 35 U.S.C. § 281, an actual case or controversy exists under Article III. This Court should rule accordingly, declaring Tormasi's lawsuit cognizable under both justiciability provisions.

POINT II

TORMASI IS OF FULL AGE AND SOUND MIND (I.E., AN ADULT WITH MENTAL COMPETENCY); THUS, TORMASI HAS REQUISITE SUING CAPACITY UNDER N.J. STAT. ANN. § 2A:15-1, IRRESPECTIVE OF PRISON ADMINISTRATIVE REGULATIONS.

There is no question that Tormasi is an adult. Nor is there any question that Tormasi is mentally competent. These facts establish Tormasi's suing capacity under the governing capacity-to-sue statute, N.J. Stat. Ann. § 2A:15-1.

In concluding that Tormasi lacked suing capacity, the district court relied on an administrative regulation, namely, N.J. Admin. Code § 10A:4-4.1(a)(3)(xix). Appx3-4. That regulation (formerly § 10A:4-4.1(a)(.705)) subjects inmates to disciplinary action for conducting unapproved businesses.

Tormasi submits that the district court erred by relying on N.J. Admin. Code § 10A:4-4.1(a)(3)(xix). For one thing, Tormasi's lawsuit, filed in his individual capacity, seeks to enforce his personal intellectual-property rights and, for that reason, cannot be construed as an unpermitted business

activity. More to the point, administrative regulations cannot supersede statutes. Because Tormasi is an adult with mental competency, the capacity-to-sue statute, N.J. Stat. Ann. § 2A:15-1, gives Tormasi suing capacity, irrespective of administrative regulations promulgated by prison officials.

It is well established that prospective plaintiffs must have requisite suing capacity. Fed. R. Civ. P. 17. For natural persons, capacity to sue is determined "by the law of the individual's domicile." Fed. R. Civ. P. 17(b)(1). Legal questions, including "capacity to sue," are reviewed "without deference" to the lower court. Paradise Creations, Inc. v. U V Sales, Inc., 315 F.3d 1304, 1307 (Fed Cir. 2003).

In this case, the district court concluded, and the parties agree, that Tormasi is domiciled in New Jersey, having lived there for decades. Appx1, 133. It is therefore undisputed that the laws of New Jersey govern the capacity-to-sue issue.

Significantly, according to New Jersey statute, "[e]very person who has reached the age of majority . . . and has the mental capacity may prosecute or defend any action in any court, in person or through another duly admitted to the practice of law." N.J. Stat. Ann. § 2A:15-1. Thus, to bring suit in New Jersey, either personally or through an attorney, Tormasi must have "reached the age of majority," which occurs at age 18 or age 21 (see N.J. Stat. Ann. § 9:17B-3); and must have possessed

"mental capacity." N.J. Stat. Ann. § 2A:15-1. The litigant's imprisonment status or prison behavior is irrelevant to the capacity-to-sue standard. N.J. Stat. Ann. § 2A:15-1.

It is beyond question that Tormasi is well over the ages of 18 or 21, especially considering that Tormasi has been imprisoned at an adult penitentiary for two decades and is now near mid-life. Appx133-134. It is also beyond question that Tormasi is intellectually capable, as evidenced by his educational and creative accomplishments. Id. Tormasi, in short, has met majority and competency requirements under N.J. Stat. Ann. § 2A:15-1. He therefore has the capacity to sue despite his imprisonment status or prison behavior.

In response to WDC's motion to dismiss, Tormasi discussed N.J. Stat. Ann. § 2A:15-1, making clear that both elements were met (i.e., adulthood and mental competency). Appx124. Yet the district court failed to cite and apply N.J. Stat. Ann. § 2A:15-1 in its dispositive ruling. Appx1-5. Ignoring that statute, it ultimately concluded "that [Tormasi], as an inmate of the New Jersey Department of Corrections, lacks the capacity to sue for patent infringement." Id. at 5.

In making its lack-of-capacity finding, the district court explained that New Jersey prison regulations prevented inmates such as Tormasi from conducting businesses without having administrative approval. Id. at 3 (citing former version of

N.J. Admin. Code § 10A:4-4.1(a)(3)(xix)). It further explained that Tormasi's infringement lawsuit may allow him to "benefit from his patent assets" through "compensatory damages." Id. at 4. By the district court's logic, Tormasi's potential recovery transformed his lawsuit into an unauthorized business activity "in contravention of New Jersey regulations." Id.

To rectify Tormasi's supposed rule violation, the district court permanently extinguished Tormasi's suing capacity concerning the patent-in-suit. Id. at 4-5. It thus dismissed Tormasi's lawsuit with prejudice, forever barring Tormasi from asserting infringement against WDC and others. Id. at 5.

Tormasi strenuously objects to the district court's adjudication, particularly its reliance on N.J. Admin. Code § 10A:4-4.1(a)(3)(xix). That regulation is inapplicable to Tormasi's situation, for numerous reasons.

To begin with, § 10A:4-4.1(a)(3)(xix) does not cover Tormasi's lawsuit. Patents have the status of "personal property." 35 U.S.C. § 261. Because Tormasi is the lawful owner of the patent-in-suit, his infringement action sought to redress personal injuries sustained from the violation of his property rights. Critically, Tormasi filed his lawsuit pro persona, not on behalf of his holding company, ADS. If Tormasi's lawsuit is successful, then Tormasi, not ADS, will be the beneficiary. Given those key distinctions, Tormasi's

lawsuit fell outside the scope of the anti-business rule.

It is worth noting that prison officials have not construed Tormasi's infringement lawsuit as an unauthorized business activity. The record reveals, sub silentio, that prison officials never took disciplinary action against Tormasi for filing and pursuing the present lawsuit. Prison officials, in other words, have no objection to Tormasi's litigation activities, nor have they deemed such litigation activities violative of N.J. Admin. Code § 10A:4-4.1(a)(3)(xix).

In justifying its invocation of N.J. Admin. Code § 10A:4-4.1(a)(3)(xix), the district court relied on an unpublished ruling, Tormasi v. Hayman, 443 Fed. Appx. 742 (3d Cir. 2011). Appx4. The most that can be said of the ruling in Tormasi is that prison officials will not be held liable under 42 U.S.C. § 1983 for seizing business-related documents from inmates. The issue here, however, is Tormasi's capacity to sue, not the civil liability of prison officials for enforcing their anti-business rule, § 10A:4-4.1(a)(3)(xix).

Aside from being inapposite, the Tormasi ruling is nonbinding in several respects. The ruling, being inter-Circuit and unpublished, lacks precedential value. What is more, the ruling has neither res judicata effect nor law-of-the-case influence, as it pertained to an unrelated civil action involving different parties. Under these circumstances, the

ruling in Tormasi is nonbinding and, even if somehow relevant to the suing-capacity issue, cannot be controlling.

Ultimately, in concluding that Tormasi's lawsuit constituted an unauthorized business activity, the district court invoked Tormasi's monetization efforts. Appx4. It found decisive the fact that Tormasi's lawsuit, if successful, will result in "compensatory damages." Id. However, the same can be said of any lawsuit involving property theft, personal injury, professional malpractice, and other torts. Taking the district court's logic at face value, all lawsuits seeking compensatory damages by inmates would constitute unauthorized business activities, depriving those inmates of suing capacity.

Given that unacceptable implication, and given the reasons expressed above, this Court should reject the district court's invocation of N.J. Admin. Code § 10A:4-4.1(a)(3)(xix). That regulation is inapplicable to Tormasi's lawsuit, which was filed in his individual capacity. Contrary to the district court's logic, no court has ever construed an inmate's pursuance of compensatory damages as an unauthorized business activity. The district court's application of § 10A:4-4.1(a)(3)(xix) is therefore unprecedented, to say the least.

Even assuming, arguendo, that N.J. Admin. Code § 10A:4-4.1(a)(3)(xix) applied to Tormasi's infringement action, the district court nevertheless erred in discounting the

supremacy of governing legislation. The district court, as noted, failed to cite N.J. Stat. Ann. § 2A:15-1 in its dispositive ruling, notwithstanding Tormasi's citation of that statute in his opposition papers. Appx1-5, 124.

It is hornbook law that statutes supersede administrative regulations. The anti-business rule is, of course, an administrative regulation. That rule was promulgated by the Department of Corrections (DOC), which is an agency within the Executive Branch of New Jersey Government. N.J. Stat. Ann. § 30:1B-2. So the anti-business rule, being an administrative regulation, cannot modify or supplant N.J. Stat. Ann. § 2A:15-1.

The legal community, particularly the New Jersey legislature, will be horrified if the district court's ruling is allowed to stand. The DOC commissioner, who is an appointed agency official (see N.J. Stat. Ann. § 30:1B-4), cannot be permitted to formulate rules having supremacy over legislative enactments. Obviously, endowing N.J. Admin. Code § 10A:4-4.1(a)(3)(xix) with the status of controlling authority will amount to administrative usurpation of duly elected lawmakers, turning the horror story into reality.

The district court's evisceration of New Jersey legislation cannot be justified by Tormasi's confinement and related circumstances. It is one thing for courts to give prison officials discretion over management issues. See Turner v.

Safley, 482 U.S. 78 (1987). It is another thing entirely for courts to act in the role of prison officials by exercising managerial discretion on their behalf; for courts to construe individual-capacity litigation as an unauthorized business activity (something which prison officials here never did); for courts to elevate administrative regulations over statutes; and for courts to remove an inmate's suing capacity in direct contravention of capacity-to-sue legislation.

The district court, needless to say, overstepped its bounds. It should have applied N.J. Stat. Ann. § 2A:15-1 despite Tormasi's imprisonment. Equally important, it should have recognized that N.J. Admin. Code § 10A:4-4.1(a)(3)(xix) cannot modify or supplant the capacity-to-sue statute.

With that said, it is understandable why some (like WDC) want to administratively overrule N.J. Stat. Ann. § 2A:15-1 by injecting imprisonment status and prison behavior. But the New Jersey legislature has spoken on the capacity-to-sue standard, declaring adulthood and mental competency the sole determining factors. N.J. Stat. Ann. § 2A:15-1. Imprisonment status and prison behavior are not listed in § 2A:15-1, making those factors irrelevant in determining suing capacity.

To be clear, Tormasi is not suggesting that the anti-business rule is invalid or unenforceable. Prison officials do, in fact, have the authority to punish Tormasi for

violating disciplinary rules. If Tormasi did indeed run afoul of the anti-business rule (which Tormasi denies), then prison officials may impose authorized sanctions, including 31 to 90 days of administrative segregation. N.J. Admin. Code § 10A:4-4.1(a)(3). The district court, however, went above and beyond authorized prison sanctions by removing Tormasi's suing capacity -- something that cannot be done absent legislative repeal or amendment of N.J. Stat. Ann. § 2A:15-1.

The bottom line is that Tormasi is an adult with mental competency. He therefore has suing capacity under N.J. Stat. Ann. § 2A:15-1, irrespective of administrative prison regulations. This Court should rule accordingly by confirming Tormasi's suing capacity and by condemning the district court's ultra vires abrogation of New Jersey legislation.

CONCLUSION

The issues in this appeal are simple. They involve two basic questions: (1) whether Tormasi met standing and jurisdictional requirements and (2) whether Tormasi has suing capacity. Those issues, however, go beyond the parties and therefore have wide-ranging impact. Specifically, this appeal impacts not only the property rights of all incarcerated individuals but also the United States patent system and, by extension, all current and future residents of this country.

To understand that wide-ranging impact, it must be

recognized that our patent system is designed to promote the progress of science and useful arts. U.S. Const. art. I, § 8, cl. 8. Such promotion occurs by providing inventors with an incentive to disclose their inventions to the public.

To receive patent protection, inventors must specify, in writing, their novel and non-obvious ideas. 35 U.S.C. § 102 (novelty requirement); 35 U.S.C. § 103 (non-obviousness requirement); 35 U.S.C. § 111(a) (written-application requirement); 35 U.S.C. § 112 (specification requirement). In exchange for that disclosure, inventors are granted the temporary right to exclude others from practicing the invention and to obtain monetary damages for infringement. 35 U.S.C. § 154(a)(2) (right to 20-year monopoly); 35 U.S.C. § 154(a)(1) (right to exclude); 35 U.S.C. § 284 (right to damages).

The patent system promotes science and useful arts by balancing competing interests. Whereas temporary market exclusion benefits the inventor, disclosure benefits the general public. Because the patent system involves an exchange of benefits, there is, in essence, an inherent quid pro quo between the inventor and general public. The inventor receives patent protection, while the public receives newfound knowledge.

The foregoing quid pro quo has served as the foundation of our patent system since the Patent Act of 1790. Although our patent system is not perfect, it has been effective in

stimulating innovation and disclosure for nearly 250 years.

Any person may seek patent protection, even those who are incarcerated. 35 U.S.C. § 111(a)(1) (allowing "inventor" to apply for patent, regardless of imprisonment status); David Pressman, Patent It Yourself, at pp. 1/3, 5/22, 5/23, 16/2 (10th ed. Nolo 2004) (confirming that applicant's "state of incarceration [is] irrelevant" and that imprisoned individuals may apply for patent). It seems that prison officials may restrict an inmate's access to USPTO under certain circumstances. See Tormasi v. Hayman, 443 Fed. Appx. 742 (3d Cir. 2011). Once issued, however, patents enjoy the rights conferred by Title 35. Those rights, as noted, include the right to market exclusion and the right to seek damages.

In this case, the district court construed Tormasi's infringement lawsuit as an unpermitted business activity in violation of his prison's anti-business rule. Appx3-5. To remedy that supposed rule violation, the district court permanently extinguished Tormasi's suing capacity, dismissing his infringement lawsuit with prejudice. Id. at 5.

All prison systems, including the Bureau of Prisons, have anti-business rules in one form or another. Consequently, if Tormasi loses his suing capacity by virtue of his supposed violation of institutional anti-business rules, then all inmates nationwide similarly lose their suing capacity. The district

court's ruling, in other words, categorically prevents every inmate from initiating patent-infringement litigation.

The district court's ruling has dire ramifications. When an inmate inventor becomes incarcerated, his or her patent will be rendered unenforceable. IP pirates can then do as they please, stealing inventions with no consequences whatsoever.

The district court's ruling will negatively impact the progress of science and useful arts. Although inmate inventors are rare, inmates do, in fact, have novel and non-obvious inventions. See, e.g., Tormasi, supra, 443 Fed. Appx. at 743 (documenting seizure of Tormasi's unrelated patent application); Pressman, supra, at pp. 5/22 to 5/23 (citing patent issued to "death row inventor"). The public will certainly benefit from the disclosure of inventions by inmates. The problem, however, is that inmates will not be reciprocated with corresponding privileges, as they will have no ability to enforce their patents via infringement actions. No reasonable inmate will expend substantial mental and financial resources seeking patent protection without having an enforcement mechanism.

If the district court's ruling is allowed to stand, patents by inmates will be worthless. And for that reason, inmates will keep their ideas locked within their brains, causing irreparable harm to the public by the lack of disclosure.

Many generations ago, the Supreme Court announced the

general rule that courts should abstain from taking judicial action amounting to the forfeiture of patents or rights incident thereto. See Empire Co. v. United States, 323 U.S. 386, 415 (1945). The district court failed to abide by that general rule, unhesitatingly preventing Tormasi from enforcing his patent. The patent system is now in jeopardy, and all current and future residents of this country are thereby impacted.

It is unclear what prompted the district court's improvident actions. Perhaps the district court was biased against prisoners, or perhaps it committed an honest legal blunder. Whatever the case, there can be no question that the district court's ruling inflicts widespread injustice.

If the district court's ruling is allowed to stand, inmates will no longer have enforceable patents, causing them to forgo patent protection. Ideas, whether big or small, will then be withheld from the public. Innovation will be stifled. The economy will suffer. Quality of life will be damaged. Other nations will inch forward. And society will be harmed.

These tragedies cannot be lightly dismissed. There are no limits to human ingenuity (even for inmates), and thus there are no limits to the deleterious effects of the suppression of thoughts and ideas. Although the deleterious effects of intellectual suppression cannot be precisely quantified, the foregoing tragedies are real and, if allowed to occur, will

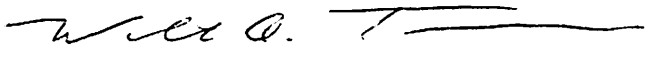
worsen over the ensuing years, decades, and centuries.

Fortunately, all tragedies can be avoided with careful and prudent appellate review. That review process necessarily requires the vacation of the district court's ruling, as Tormasi's underlying issues have substantial merit.

Despite his imprisonment status and prison behavior, Tormasi can establish his legal title to the patent-in-suit, thereby meeting standing and jurisdictional requirements (Point I). Tormasi can also establish his suing capacity under N.J. Stat. Ann. § 2A:15-1, irrespective of administrative regulations promulgated by prison officials. This Court should rule accordingly, in which event our patent system, and society, will continue to benefit from the ideas of inmate inventors.

Respectfully submitted,

PRO SE



Walter A. Tormasi

Dated: December 30, 2019

Addendum

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

WALTER A. TORMASI,

Plaintiff,

v.

WESTERN DIGITAL CORP.,

Defendant.

Case No. 19-cv-00772-HSG

ORDER GRANTING DEFENDANT'S MOTION TO DISMISS

Re: Dkt. Nos. 19, 27, 24, 29

Pending before the Court is Defendant Western Digital Corporation's motion to dismiss. Dkt. No. 19. Defendant argues that Plaintiff Walter A. Tormasi lacks standing to bring suit because he does not hold title to United States Patent Nos. 7,324,301 ("the '301 Patent") and lacks capacity to sue because he is an inmate prohibited from conducting business. Defendant also argues that Plaintiff fails to plausibly allege willful patent infringement. For the reasons explained below, the Court **GRANTS** the motion.

I. BACKGROUND

Plaintiff filed this action on February 12, 2019, alleging infringement of the '301 Patent. Dkt. No. 1 ("Compl."). The '301 Patent is titled "Striping Data Simultaneously Across Multiple Platter Surfaces" and "pertains to the field of magnetic storage and retrieval of digital information." *Id.* ¶ 1, Ex. C.

Independent claim 41 describes:

> 41. An **actuator mechanism,** said mechanism comprising at least two arms, said arms assigned to different circular carrier surfaces within an information storage and retrieval apparatus; and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to said carrier surfaces.

Id. Ex. C. at 12:5–11. Numerous claims depend from Claim 41, including, as relevant here Claim 61:

> 61. The mechanism of claim 41 wherein said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial positions; and in its operative mode, said secondary actuators execute means for providing precise independent secondary position by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

Id. Ex. C. at 12:61–13:9. Nine claims depend from Claim 61 and add further limitations such as (1) "wherein said secondary actuators are microactuators" (Claim 62) and (2) "wherein secondary actuators are microelectromechanisms" (Claim 63). *Id.* Ex. C. at 13:10–13. Plaintiff alleges that "Defendant manufactures, markets, sells, distributes and/or imports hard disk drives . . . containing dual-stage actuator systems comprising primary and secondary actuation devices," which "feature every structural element and limitation of claims 41, 61, 62, and 63" of the '301 Patent. *Id.* ¶ 21, 26.

On April 25, 2019, Defendant filed the pending motion to dismiss, for which briefing is complete. Dkt. No. 19 ("Mot."), 23 ("Opp."), and 26 ("Reply"). Plaintiff filed a related administrative motion for nunc pro tunc objection to evidence in Defendant's Reply, Dkt. No. 27, and a motion to strike Defendant's response to Plaintiff's administrative motion, Dkt. No. 29.

II. LEGAL STANDARD

Federal Rule of Civil Procedure 8(a) requires that a complaint contain "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). A defendant may move to dismiss a complaint for failing to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6). "Dismissal under Rule 12(b)(6) is appropriate only where the complaint lacks a cognizable legal theory or sufficient facts to support a cognizable legal theory." *Mendiondo v. Centinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th Cir. 2008). To survive a Rule 12(b)(6) motion, a plaintiff must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when a plaintiff pleads "factual content that allows the court to draw

the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

In reviewing the plausibility of a complaint, courts "accept factual allegations in the complaint as true and construe the pleadings in the light most favorable to the nonmoving party." *Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008). Nonetheless, Courts do not "accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences." *In re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir. 2008) (quoting *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001)). Even if the court concludes that a 12(b)(6) motion should be granted, the "court should grant leave to amend even if no request to amend the pleading was made, unless it determines that the pleading could not possibly be cured by the allegation of other facts." *Lopez v. Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc) (quotation omitted).

III. ANALYSIS

Defendant argues that Plaintiff lacks standing to bring suit because he does not hold title to the '301 Patent and lacks capacity to sue because he is prohibited from operating a business since he is an inmate in the New Jersey Department of Corrections. Mot. at 12–19. The Court need not reach the standing issue, since even if Plaintiff does have standing to assert these claims (which the Court does not now decide), Plaintiff lacks capacity to sue.

An individual's capacity to sue is determined "by the law of the individual's domicile." Fed. R. Civ. P. 17(b). Plaintiff is domiciled in New Jersey. Defendant argues that because New Jersey law prevents inmates from "commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator," Plaintiff lacks capacity to bring this patent infringement suit. N.J. Admin. Code § 10A:4-4.1(.705). The Court agrees.

Plaintiff argues that his personal right to access the courts is at issue, and that the New Jersey regulation cannot "supersede Plaintiff's right to file civil lawsuits in his personal capacity." Opp. at 11. However, Plaintiff's case materials and previous cases makes clear that what underlies this case is his purported right to conduct business, not his access to the courts. *See* Dkt. No. 1 ¶ 1

("Plaintiff is an innovator and entrepreneur"); Dkt. No. 23-1 at ¶ 14–15 (detailing that after being sanctioned for "operating [his company, Advanced Data Solutions Corp. ("ADS"),] without administrative approval," Tormasi did not cease such activities, but instead engaged in "ownership-transferring contingencies" to continue as a sole proprietor). *See also Tormasi v. Hayman*, 443 F. App'x 742, 745 (3d Cir. 2011) (holding that there was no 42 U.S.C. § 1983 violation because Tormasi's confiscated patent application "f[ell] within the ambit of" prohibited business activities).

That Plaintiff has filed this patent infringement case without ADS does not change this reality. Plaintiff previously represented that because he assigned ADS all of his interest in the patent, "he was 'unable to directly or indirectly benefit from his intellectual-property assets, either by selling all or part of ADS; by exclusively or non-exclusively licensing [the] patent to others; by using ADS or [the] patent as collateral for obtaining personal loans or standby letters of credit; or by engaging in other monetization transactions involving ADS or its intellectual-property assets." *Tormasi*, 443 F. App'x at 745. Thus, Plaintiff argued that he was not running afoul the New Jersey regulation for conducting business. *Id.* Now, however, Plaintiff includes an "Assignment of U.S. Patent No. 7,324,301" assigning "all right, title, and interest" in the '301 Patent from ADS back to him. Dkt. No. 1-1. This contradicts his previous representation, and suggests that he may now directly benefit from his patent assets. Indeed, this appears to be exactly what he seeks to do in this case by monetizing his patents and obtaining $5 billion in compensatory damages for patent infringement, in contravention of the New Jersey regulations. "Lawful incarceration brings about the necessary withdrawal or limitation of many privileges and rights, a retraction justified by the considerations underlying our penal system." *Stroud v. Swope*, 187 F.2d 850, 851 (9th Cir. 1951) (quoting *Price v. Johnston*, 334 U.S. 266, 285 (1948)). While the Fourteenth Amendment protects the right of access to the courts, *see Bounds v. Smith*, 430 U.S. 817, 828 (1977), it does not guarantee the right to freely conduct business, *see Stroud*, 187 F.2d at 851.[1] Accordingly, the

[1] Tormasi also cites the First Amendment as guaranteeing access to the courts. This right of access, however, does not grant "inmates the wherewithal to transform themselves into litigating engines capable of filing everything," but rather is limited to cases in which inmates "attack their sentences, directly or collaterally, and . . . challenge the conditions of their confinement. Impairment of any other litigating capacity is simply one of the incidental (and perfectly

Court finds that Plaintiff, as an inmate of the New Jersey Department of Corrections, lacks the capacity to sue for patent infringement.[2]

IV. CONCLUSION

Because Plaintiff lacks capacity to sue under Rule 17(b), the Court **GRANTS** Defendant's motion to dismiss with prejudice. As noted above, the Court **DENIES AS MOOT** docket numbers 27 and 29. The Court additionally **DENIES** docket number 24 and the clerk is directed to terminate the case.

IT IS SO ORDERED.

Dated: 11/21/2019

Haywood S. Gilliam, Jr.
HAYWOOD S. GILLIAM, JR.
United States District Judge

United States District Court
Northern District of California

[2] The Court need not reach Defendant's arguments that the complaint should be dismissed for failure to plausibly plead willful infringement or indirect infringement under Rule 12(b)(6). Mot. at 19–23.

constitutional) consequences of conviction and incarceration." *Lewis v. Casey*, 518 U.S. 343, 355 (1996); *see also Tormasi*, 443 F. App'x at 744 n.3.

Certificates

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CERTIFICATE OF SERVICE

I certify that I served a copy on counsel of record on January 10, 2020 by:

☒ U.S. Mail (addressed to appellee's principal attorney, Erica D. Wilson, Esq., at Walters Wilson LLP, 702 Marshall Street, Suite 611, Redwood City, California 94063)

☐ Fax

☐ Hand

☒ Electronic Means (by E-mail or CM/ECF) (through court staff via NDA)

Walter A. Tormasi (Pro Se) — Name of Counsel

Walter A. T — Signature of Counsel

Law Firm	Pro Se
Address	New Jersey State Prison, P.O. Box 861
City, State, Zip	Trenton, New Jersey 08625
Telephone Number	
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E-Mail Address	

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Form 19
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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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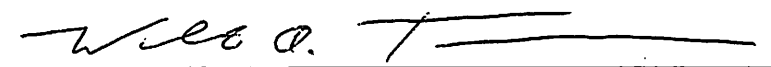

(Signature of Attorney)

Walter A. Tormasi (Pro Se)
(Name of Attorney)

Attorney for Appellant (Pro Se)
(State whether representing appellant, appellee, etc.)

December 30, 2019
(Date)

Walter A. Tormasi, #136062/268030C

New Jersey State Prison, P.O. Box 861, Trenton, New Jersey 08625

January 10, 2020

VIA REGULAR MAIL

Peter R. Marksteiner, Clerk
United States Court of Appeals
Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

Re: Walter A. Tormasi v. Western Digital Corp.
Case No. 2020-1265

Dear Mr. Marksteiner:

I have enclosed, for filing, six sets of my appellate brief and six sets of my separately bound appendix. I left one set of my brief and appendix unstapled to facilitate scanning.

Pursuant to the general and local rules of appellate practice, I appended to my brief and appendix proof of service upon appellee's principal attorney, Erica D. Wilson, Esq.

Very truly yours,

Walter A. Tormasi

cc: Erica D. Wilson, Esq. (via U.S. mail)
All ECF Registrants (via NDA)

Walter A. Tormasi, #136062
New Jersey State Prison
P.O. Box 861
Trenton, New Jersey 08625

Peter R. Marksteiner, Clerk
Court of Appeals - Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

No. 2020-1265

IN THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

WALTER A. TORMASI,

Plaintiff-Appellant,

v.

WESTERN DIGITAL CORPORATION,

Defendant-Appellee.

On Appeal From the United States District Court, Northern District of California, No. 4:19-cv-00772-HSG, Hon. Haywood S. Gilliam, Jr., U.S.D.J.

APPENDIX ON BEHALF OF APPELLANT WALTER A. TORMASI

Walter A. Tormasi, #136062/268030C
New Jersey State Prison
P.O. Box 861
Trenton, New Jersey 08625-0861
Attorney for Appellant (Appearing Pro Se)

TABLE OF CONTENTS

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

WALTER A. TORMASI,

Plaintiff,

v.

WESTERN DIGITAL CORP.,

Defendant.

Case No. 19-cv-00772-HSG

ORDER GRANTING DEFENDANT'S MOTION TO DISMISS

Re: Dkt. Nos. 19, 27, 24, 29

Pending before the Court is Defendant Western Digital Corporation's motion to dismiss. Dkt. No. 19. Defendant argues that Plaintiff Walter A. Tormasi lacks standing to bring suit because he does not hold title to United States Patent Nos. 7,324,301 ("the '301 Patent") and lacks capacity to sue because he is an inmate prohibited from conducting business. Defendant also argues that Plaintiff fails to plausibly allege willful patent infringement. For the reasons explained below, the Court **GRANTS** the motion.

I. BACKGROUND

Plaintiff filed this action on February 12, 2019, alleging infringement of the '301 Patent. Dkt. No. 1 ("Compl."). The '301 Patent is titled "Striping Data Simultaneously Across Multiple Platter Surfaces" and "pertains to the field of magnetic storage and retrieval of digital information." *Id.* ¶ 1, Ex. C.

Independent claim 41 describes:

> 41. An **actuator mechanism,** said mechanism comprising at least two arms, said arms assigned to different circular carrier surfaces within an information storage and retrieval apparatus; and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to said carrier surfaces.

Id. Ex. C. at 12:5–11. Numerous claims depend from Claim 41, including, as relevant here Claim 61:

> 61. The mechanism of claim 41 wherein said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial positions; and in its operative mode, said secondary actuators execute means for providing precise independent secondary position by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

Id. Ex. C. at 12:61–13:9. Nine claims depend from Claim 61 and add further limitations such as (1) "wherein said secondary actuators are microactuators" (Claim 62) and (2) "wherein secondary actuators are microelectromechanisms" (Claim 63). *Id.* Ex. C. at 13:10–13. Plaintiff alleges that "Defendant manufactures, markets, sells, distributes and/or imports hard disk drives . . . containing dual-stage actuator systems comprising primary and secondary actuation devices," which "feature every structural element and limitation of claims 41, 61, 62, and 63" of the '301 Patent. *Id.* ¶ 21, 26.

On April 25, 2019, Defendant filed the pending motion to dismiss, for which briefing is complete. Dkt. No. 19 ("Mot."), 23 ("Opp."), and 26 ("Reply"). Plaintiff filed a related administrative motion for nunc pro tunc objection to evidence in Defendant's Reply, Dkt. No. 27, and a motion to strike Defendant's response to Plaintiff's administrative motion, Dkt. No. 29.

II. LEGAL STANDARD

Federal Rule of Civil Procedure 8(a) requires that a complaint contain "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). A defendant may move to dismiss a complaint for failing to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6). "Dismissal under Rule 12(b)(6) is appropriate only where the complaint lacks a cognizable legal theory or sufficient facts to support a cognizable legal theory." *Mendiondo v. Centinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th Cir. 2008). To survive a Rule 12(b)(6) motion, a plaintiff must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when a plaintiff pleads "factual content that allows the court to draw

the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

In reviewing the plausibility of a complaint, courts "accept factual allegations in the complaint as true and construe the pleadings in the light most favorable to the nonmoving party." *Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008). Nonetheless, Courts do not "accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences." *In re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir. 2008) (quoting *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001)). Even if the court concludes that a 12(b)(6) motion should be granted, the "court should grant leave to amend even if no request to amend the pleading was made, unless it determines that the pleading could not possibly be cured by the allegation of other facts." *Lopez v. Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc) (quotation omitted).

III. ANALYSIS

Defendant argues that Plaintiff lacks standing to bring suit because he does not hold title to the '301 Patent and lacks capacity to sue because he is prohibited from operating a business since he is an inmate in the New Jersey Department of Corrections. Mot. at 12–19. The Court need not reach the standing issue, since even if Plaintiff does have standing to assert these claims (which the Court does not now decide), Plaintiff lacks capacity to sue.

An individual's capacity to sue is determined "by the law of the individual's domicile." Fed. R. Civ. P. 17(b). Plaintiff is domiciled in New Jersey. Defendant argues that because New Jersey law prevents inmates from "commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator," Plaintiff lacks capacity to bring this patent infringement suit. N.J. Admin. Code § 10A:4-4.1(.705). The Court agrees.

Plaintiff argues that his personal right to access the courts is at issue, and that the New Jersey regulation cannot "supersede Plaintiff's right to file civil lawsuits in his personal capacity." Opp. at 11. However, Plaintiff's case materials and previous cases makes clear that what underlies this case is his purported right to conduct business, not his access to the courts. *See* Dkt. No. 1 ¶ 1

("Plaintiff is an innovator and entrepreneur"); Dkt. No. 23-1 at ¶ 14–15 (detailing that after being sanctioned for "operating [his company, Advanced Data Solutions Corp. ("ADS"),] without administrative approval," Tormasi did not cease such activities, but instead engaged in "ownership-transferring contingencies" to continue as a sole proprietor). *See also Tormasi v. Hayman*, 443 F. App'x 742, 745 (3d Cir. 2011) (holding that there was no 42 U.S.C. § 1983 violation because Tormasi's confiscated patent application "f[ell] within the ambit of" prohibited business activities).

That Plaintiff has filed this patent infringement case without ADS does not change this reality. Plaintiff previously represented that because he assigned ADS all of his interest in the patent, "he was 'unable to directly or indirectly benefit from his intellectual-property assets, either by selling all or part of ADS; by exclusively or non-exclusively licensing [the] patent to others; by using ADS or [the] patent as collateral for obtaining personal loans or standby letters of credit; or by engaging in other monetization transactions involving ADS or its intellectual-property assets." *Tormasi*, 443 F. App'x at 745. Thus, Plaintiff argued that he was not running afoul the New Jersey regulation for conducting business. *Id.* Now, however, Plaintiff includes an "Assignment of U.S. Patent No. 7,324,301" assigning "all right, title, and interest" in the '301 Patent from ADS back to him. Dkt. No. 1-1. This contradicts his previous representation, and suggests that he may now directly benefit from his patent assets. Indeed, this appears to be exactly what he seeks to do in this case by monetizing his patents and obtaining $5 billion in compensatory damages for patent infringement, in contravention of the New Jersey regulations. "Lawful incarceration brings about the necessary withdrawal or limitation of many privileges and rights, a retraction justified by the considerations underlying our penal system." *Stroud v. Swope*, 187 F.2d 850, 851 (9th Cir. 1951) (quoting *Price v. Johnston*, 334 U.S. 266, 285 (1948)). While the Fourteenth Amendment protects the right of access to the courts, *see Bounds v. Smith*, 430 U.S. 817, 828 (1977), it does not guarantee the right to freely conduct business, *see Stroud*, 187 F.2d at 851.[1] Accordingly, the

[1] Tormasi also cites the First Amendment as guaranteeing access to the courts. This right of access, however, does not grant "inmates the wherewithal to transform themselves into litigating engines capable of filing everything," but rather is limited to cases in which inmates "attack their sentences, directly or collaterally, and . . . challenge the conditions of their confinement. Impairment of any other litigating capacity is simply one of the incidental (and perfectly

Court finds that Plaintiff, as an inmate of the New Jersey Department of Corrections, lacks the capacity to sue for patent infringement.[2]

IV. CONCLUSION

Because Plaintiff lacks capacity to sue under Rule 17(b), the Court **GRANTS** Defendant's motion to dismiss with prejudice. As noted above, the Court **DENIES AS MOOT** docket numbers 27 and 29. The Court additionally **DENIES** docket number 24 and the clerk is directed to terminate the case.

IT IS SO ORDERED.

Dated: 11/21/2019

Haywood S. Gilliam, Jr.
HAYWOOD S. GILLIAM, JR.
United States District Judge

United States District Court
Northern District of California

[2] The Court need not reach Defendant's arguments that the complaint should be dismissed for failure to plausibly plead willful infringement or indirect infringement under Rule 12(b)(6). Mot. at 19–23.

constitutional) consequences of conviction and incarceration." *Lewis v. Casey*, 518 U.S. 343, 355 (1996); *see also Tormasi*, 443 F. App'x at 744 n.3.

ADRMOP,AO279,APPEAL,CLOSED,ProSe

U.S. District Court
California Northern District (Oakland)
CIVIL DOCKET FOR CASE #: 4:19-cv-00772-HSG
Internal Use Only

Tormasi v. Western Digital Corp.
Assigned to: Judge Haywood S Gilliam, Jr
Demand: $15,000,000,000
Cause: 35:271 Patent Infringement

Date Filed: 02/12/2019
Date Terminated: 11/21/2019
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Hearings	Dates	Deadlines	Dates
		Appeal Record Deadline (37)	01/06/2020

Plaintiff

Walter A. Tormasi

represented by **Walter A. Tormasi**
New Jersey State Prison
#136062 / 268030C
P.O. Box 861
Trenton, NJ 08625
PRO SE

V.

Defendant

Western Digital Corp.

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408-717-6000
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ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
02/12/2019	1	COMPLAINT against Western Digital Corp. (Filing fee $ 400.) Filed by Walter A. Tormasi. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Exhibit C, # 4 Exhibit D, # 5 Exhibit E, # 6 Exhibit F, # 7 Exhibit G, # 8 Exhibit H, # 9 Civil Cover Sheet, # 10 Receipt)(rcsS, COURT STAFF) (Filed on 2/12/2019) (Entered: 02/13/2019)
02/12/2019	2	**Initial Case Management Scheduling Order with ADR Deadlines: Case Management Statement due by 5/7/2019. Initial Case Management Conference set for 5/14/2019 at 2:00 PM in Oakland, Courtroom 2, 4th Floor. (rcsS, COURT STAFF) (Filed on 2/12/2019) (Additional attachment(s) added on 2/15/2019: # 1 Disregard, see attachment 2 for corrected Standing Order Standing Order) (jjbS, COURT STAFF). (Additional attachment(s) added on 2/15/2019: # 2 CORRECTED Standing Order) (jjbS, COURT STAFF). Modified on 2/15/2019 (jjbS, COURT STAFF). (Entered: 02/13/2019)**
02/12/2019	3	MOTION for Order of Service filed by Walter A. Tormasi. (rcsS, COURT STAFF) (Filed on 2/12/2019) (Entered: 02/13/2019)
02/15/2019	4	REPORT on the filing or determination of an action regarding Patent Infringement (cc: form mailed to register). (Attachments: # 1 Complaint, # 2 Certificate/Proof of Service)(jjbS, COURT STAFF) (Filed on 2/15/2019) (Entered: 02/15/2019)

03/04/2019	5	Ex Parte Motion for Order Appointing U.S. Marshal to Serve Summons and Complaint filed by Walter A. Tormasi. (Attachments: # 1 Declaration, # 2 Proposed Order, # 3 Envelope)(jjbS, COURT STAFF) (Filed on 3/4/2019) (Entered: 03/05/2019)
03/04/2019	6	Letter from Walter A. Tormasi requesting documents. (Attachments: # 1 Envelope)(jjbS, COURT STAFF) (Filed on 3/4/2019) (Entered: 03/05/2019)
03/06/2019		Mailed one copy of Summons, the Local Rules, and ADR Handbook to Plaintiff re 6 Letter (jjbS, COURT STAFF) (Filed on 3/6/2019) Modified on 3/6/2019 (jjbS, COURT STAFF). (Entered: 03/06/2019)
03/11/2019	7	Certificate of Interested Entities by Walter A. Tormasi identifying Other Affiliate NASDAQ exchange for Walter A. Tormasi. (Attachments: # 1 Envelope)(jjbS, COURT STAFF) (Filed on 3/11/2019) (Additional attachment(s) added on 3/12/2019: # 2 Letter) (jjbS, COURT STAFF). (Entered: 03/12/2019)
03/26/2019	8	Letter from Walter A. Tomasi requesting ESI Guidelines, ADR Local Rules, and all ADR Forms. (Attachments: # 1 Envelope) (jjbS, COURT STAFF) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/26/2019	9	NOTICE of Appearance by Eric Stephen Walters (Walters, Eric) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/26/2019		Mailed copy of ESI Guidelines, the ADR Local Rules, and ADR Forms. (jjbS, COURT STAFF) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/26/2019	10	NOTICE of Appearance by Eric Stephen Walters *by Erica D. Wilson* (Walters, Eric) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/26/2019	11	****RE-FILED AT DOCKET NO. 16 **** NOTICE of Appearance by Eric Stephen Walters *by Rebecca L. Unruh* (Walters, Eric) (Filed on 3/26/2019) Modified on 3/28/2019 (jjbS, COURT STAFF). (Entered: 03/26/2019)
03/26/2019	12	****DISREGARD, RE-FILED AS DOCKET NO. 13 **** Certificate of Interested Entities by Western Digital Corp. identifying Other Affiliate Western Digital Technologies, Inc., Other Affiliate HGST, Inc. for Western Digital Corp.. (Walters,

		Eric) (Filed on 3/26/2019) Modified on 3/27/2019 (jjbS, COURT STAFF). (Entered: 03/26/2019)
03/26/2019	13	Certificate of Interested Entities by Western Digital Corp. identifying Other Affiliate Western Digital Technologies, Inc., Other Affiliate HGST, Inc. for Western Digital Corp.. *CORRECTION OF DOCKET # 12* (Wilson, Erica) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/26/2019	14	WAIVER OF SERVICE Returned Executed filed by Western Digital Corp.. Service waived by Western Digital Corp. waiver sent on 2/24/2019, answer due 4/25/2019. (Wilson, Erica) (Filed on 3/26/2019) (Entered: 03/26/2019)
03/27/2019	15	**ORDER by Hon. Haywood S. Gilliam, Jr. DENYING AS MOOT 3 Plaintiff's Motion for Order of Service and 5 Plaintiff's Ex Parte Motion for Order Appointing the U.S. Marshal to Serve Summons and Complaint, in light of 14 Defendant's waiver of service of summons.** ***(This is a text-only entry generated by the court. There is no document associated with this entry.)*** **(hsglc2S, COURT STAFF) (Filed on 3/27/2019) (Entered: 03/27/2019)**
03/27/2019	16	NOTICE of Appearance by Rebecca L Unruh *CORRECTION OF DOCKET # 11* (Unruh, Rebecca) (Filed on 3/27/2019) (Entered: 03/27/2019)
03/28/2019	17	MOTION Administrative Motion to Change Time Pursuant to Civil L.R. 6-3 filed by Western Digital Corp.. Responses due by 4/11/2019. Replies due by 4/18/2019. (Attachments: # 1 Declaration, # 2 Proposed Order)(Wilson, Erica) (Filed on 3/28/2019) (Entered: 03/28/2019)
04/01/2019	18	**ORDER by Judge Haywood S. Gilliam, Jr. Granting 17 MOTION Administrative Motion to Change Time Pursuant to Civil L.R. 6-3. (Attachments: # 1 Certificate/Proof of Service)(ndrS, COURT STAFF) (Filed on 4/1/2019) (Entered: 04/01/2019)**
04/25/2019	19	MOTION to Dismiss filed by Western Digital Corp.. Motion Hearing set for 8/22/2019 02:00 PM in Oakland, Courtroom 2, 4th Floor before Judge Haywood S Gilliam Jr.. Responses due by 5/9/2019. Replies due by 5/16/2019. (Attachments: # 1 Declaration of Erica Wilson, # 2 Proposed Order)(Wilson, Erica) (Filed on 4/25/2019) Modified on 4/26/2019 (jjbS, COURT STAFF). (Entered: 04/25/2019)

05/13/2019	20	MOTION for Extension of Time to File Response as to 19 MOTION to Dismiss filed by Walter A. Tormasi. (Attachments: # 1 Declaration, # 2 Proposed Order, # 3 Envelope)(cpS, COURT STAFF) (Filed on 5/13/2019) (Entered: 05/15/2019)
05/16/2019	21	**ORDER by Judge Haywood S. Gilliam, Jr. GRANTING 20 ADMINISTRATIVE MOTION TO EXTEND DEADLINE. Responses due by 6/6/2019 and Replies due by 6/13/2019. (Attachments: # 1 Certificate/Proof of Service)(ndrS, COURT STAFF) (Filed on 5/16/2019) (Entered: 05/16/2019)**
05/28/2019	22	Withdrawal of Ex Parte Motion to Appoint the United States Marshal by Walter A. Tormasi (Attachments: # 1 Envelope)(cpS, COURT STAFF) (Filed on 5/28/2019) (Entered: 05/29/2019)
05/28/2019	23	OPPOSITION (re 19 MOTION to Dismiss) filed byWalter A. Tormasi. (Attachments: # 1 Declaration Walter A. Tormasi, # 2 Envelope)(cpS, COURT STAFF) (Filed on 5/28/2019) (Entered: 05/29/2019)
05/28/2019	24	MOTION to Appoint Counsel for Settlement Purposes filed by Walter A. Tormasi. (Attachments: # 1 Declaration Walter A. Tormasi, # 2 Envelope)(cpS, COURT STAFF) (Filed on 5/28/2019) (Entered: 05/29/2019)
06/05/2019	25	OPPOSITION/RESPONSE (re 24 MOTION to Appoint Counsel) filed byWestern Digital Corp.. (Wilson, Erica) (Filed on 6/5/2019) Modified on 6/6/2019 (cpS, COURT STAFF). (Entered: 06/05/2019)
06/13/2019	26	REPLY (re 19 MOTION to Dismiss) filed byWestern Digital Corp.. (Attachments: # 1 Declaration of Erica D. Wilson in Support of Reply)(Wilson, Erica) (Filed on 6/13/2019) (Entered: 06/13/2019)
07/01/2019	27	ADMINISTRATIVE MOTION for nunc pro tunc acceptance of objection to reply evidence filed by Walter A. Tormasi. Responses due by 7/29/2019. Replies due by 8/12/2019. (Attachments: # 1 Objection to reply evidence, # 2 Envelope) (cpS, COURT STAFF) (Filed on 7/1/2019) (Entered: 07/02/2019)
07/23/2019	28	RESPONSE re 27 MOTION for nunc pro tunc acceptance of objection to reply evidence *Response to Plaintiff's Objection to Reply Evidence* by Western Digital Corp.. (Wilson, Erica) (Filed on 7/23/2019) (Entered: 07/23/2019)

08/09/2019	29	MOTION to Strike 28 Response filed by Walter A. Tormasi. Responses due by 8/23/2019. Replies due by 8/30/2019. (Attachments: # 1 Envelope)(jjbS, COURT STAFF) (Filed on 8/9/2019) (Entered: 08/09/2019)
08/13/2019	30	CLERK'S NOTICE Taking (19 and 29) Motions Under Submission.(ndrS, COURT STAFF) (Filed on 8/13/2019) (Entered: 08/13/2019)
08/13/2019	31	OPPOSITION/RESPONSE (re 29 MOTION to Strike 28 Response (Non Motion)) filed byWestern Digital Corp.. (Attachments: # 1 Declaration Declaration of Erica Wilson in Support of Opposition to Motion to Strike, # 2 Proposed Order) (Wilson, Erica) (Filed on 8/13/2019) (Entered: 08/13/2019)
08/13/2019	32	CORRECTED 30 CLERK'S NOTICE Taking (19 and 29) Motions Under Submission. (ndrS, COURT STAFF) (Filed on 8/13/2019) (Entered: 08/13/2019)
11/21/2019	33	**ORDER by Judge Haywood S. Gilliam, Jr. GRANTING DEFENDANT'S 19 MOTION TO DISMISS.(This order DENIES docket no. 24 and DENIES as moot docket nos. 27 and 29). (Attachments: # 1 Certificate/Proof of Service) (ndrS, COURT STAFF) (Filed on 11/21/2019) (Entered: 11/21/2019)**
11/22/2019	34	REPORT on the determination of an action regarding Patents. (Attachments: # 1 Order)(jjbS, COURT STAFF) (Filed on 11/22/2019) (Entered: 11/22/2019)
11/25/2019	35	CERTIFICATE OF SERVICE re 34 Patent Report. (jjbS, COURT STAFF) (Filed on 11/25/2019) (Entered: 11/25/2019)
12/06/2019	36	****DISREGARD, INCORRECT EVENT USED**** NOTICE OF APPEAL to the 9th Circuit Court of Appeals filed by Walter A. Tormasi. Appeal of 33 Order Granting Defendant's 19 Motion to Dismiss. (Appeal fee FEE NOT PAID.) (Attachments: # 1 Envelope)(jjbS, COURT STAFF) (Filed on 12/6/2019) Modified on 12/6/2019 (jjbS, COURT STAFF). Modified on 12/6/2019 (jjbS, COURT STAFF). (Entered: 12/06/2019)
12/06/2019	37	NOTICE OF APPEAL to the Federal Circuit as to 33 Order Granting Defendant's 19 Motion to Dismiss by Walter A. Tormasi. Appeal Record due by 1/6/2020. (Appeal Fee Due). (Attachments: # 1 Envelope)(jjbS, COURT STAFF) (Filed on 12/6/2019) (Entered: 12/06/2019)

12/06/2019	38	Mailed request for payment of docket fee to appellant (cc to USCA). (jjbS, COURT STAFF) (Filed on 12/6/2019) (Entered: 12/06/2019)
12/06/2019		Email appeal package to the Federal Circuit. (jjbS, COURT STAFF) (Filed on 12/6/2019) (Entered: 12/06/2019)

Walter A. Tormasi, #136062/268030C
New Jersey State Prison
Second & Cass Streets
P.O. Box 861
Trenton, New Jersey 08625
Attorney for Plaintiff (Appearing Pro Se)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

WALTER A. TORMASI,	:	CIVIL ACTION
Plaintiff,	:	CASE NO.: CV 19 0772 HSG
v.	:	COMPLAINT FOR PATENT INFRINGEMENT (with DEMAND FOR JURY TRIAL and VERIFICATION UNDER PENALTY OF PERJURY)
WESTERN DIGITAL CORP.,	:	
Defendant.	:	

Plaintiff Walter A. Tormasi (residing at Second & Cass Streets, Trenton, New Jersey 08625) complains against Defendant Western Digital Corp. (residing at 5601 Great Oaks Parkway, San Jose, California 95119), alleging as follows:

INTRODUCTION

1. Plaintiff is an innovator and entrepreneur, developing inventions in technology and other areas. One of Plaintiff's inventions resulted in the issuance of U.S. Patent No. 7,324,301. That patent pertains to the field of magnetic

storage and retrieval of digital information. Plaintiff alleges that Defendant infringed upon his patent (Count I) and that Defendant committed such infringement willfully (Count II).

2. Defendant is one of the largest vendors of hard disk drives. In its latest fiscal year, Defendant sold tens of millions of hard drives and generated over $20 billion in revenue. Defendant is publicly traded on the NASDAQ exchange, and its market presence in this country is ubiquitous. In fact, Defendant distributes hard drives in all 50 states, either by selling directly to consumers or by supplying third-party retailers, manufacturers, importers, and wholesalers.

3. As discussed herein, Defendant's hard drives contain, and depend on, dual-stage actuator mechanisms. Those particular actuator mechanisms fall within the scope of Plaintiff's patent. Thus, by circulating its hard drives within the jurisdiction of the United States, Defendant infringed upon Plaintiff's patent, contrary to 35 U.S.C. § 271.

4. To remedy Defendant's patent infringement, Plaintiff seeks the full measure of monetary damages. Plaintiff also seeks related relief, including an injunction preventing Defendant from continuing to circulate infringing devices.

JURISDICTION AND VENUE

5. This Court has original and exclusive jurisdiction over the subject involved, as Plaintiff's lawsuit concerns

patent infringement (see 28 U.S.C. § 1338(a)).

6. Venue properly lies in the Northern District of California, as Defendant's principal executive office is located therein (see 28 U.S.C. §§ 1391(b)(1) and 1400(b)).

PARTIES

7. Plaintiff Walter A. Tormasi is the registered inventor/patentee of U.S. Patent No. 7,324,301 and, as such, has the statutory authority to bring suit against Defendant for infringement of said patent (see 35 U.S.C. § 281).

8. In addition to his status as inventor/patentee, Plaintiff owns all right, title, and interest in the foregoing patent, with such ownership permitting Plaintiff "to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301" (Exhibit A).

9. Defendant Western Digital Corp. is an entity incorporated under the laws of the State of Delaware.

10. Defendant is publicly traded on NASDAQ's Global Select Market and has its principal executive office located at 5601 Great Oaks Parkway, San Jose, California 95119.

11. Defendant owns, operates, manages, directs, and/or controls over 100 foreign or domestic subsidiaries. Such subsidiaries are identified in an addendum to Defendant's 2017 annual 10-K report filed with the United States Securities and Exchange Commission, said addendum attached hereto and

incorporated herein by reference (Exhibit B).

12. Acting directly or through its subsidiaries (including through Western Digital Technologies, Inc.; Western Digital (Fremount), LLC; WD Media, LLC; HGST, Inc.; and HGST Technologies Santa Ana, Inc.), Defendant is in the business of, among other things, manufacturing, marketing, selling, distributing, and/or importing hard disk drives for use within the United States and its territories and possessions.

FACTUAL BACKGROUND

13. Plaintiff was issued U.S. Patent No. 7,324,301 in January 2008. That patent is attached hereto and incorporated herein by reference (Exhibit C). Plaintiff's patent is currently active and remains in effect until June 2025.

14. As explained in Plaintiff's patent, every hard disk drive features an actuator mechanism. The purpose of the actuator mechanism is to position the read/write heads over the appropriate tracks of the storage media. Plaintiff's patent encompasses, among other things, improvements to the actuator mechanism upon which hard disk drives depend.

15. One embodiment of Plaintiff's invention features an innovative dual-stage actuator system. That dual-stage actuator system comprises an ordinary primary actuation device in conjunction with miniature secondary actuation devices. The secondary actuation devices, in turn, are singularly mounted to

the arm tips of each primary actuation device. This configuration enables the read/write heads to be independently positioned over the media via dual-stage arm movement.

16. The foregoing dual-stage actuator system is described in the specification section of Plaintiff's patent. In particular, the relevant portion of Plaintiff's patent (Exhibit C, at column 6, lines 11-29) reads as follows:

> As another embodiment [to the invention], the independent-arm actuator may comprise a primary actuator mechanism and two or more secondary actuator mechanisms.. Under this embodiment, the primary actuator mechanism is an ordinary single-movement device, whereas the secondary actuator mechanisms are subdevices such as microactuators or microelectromechanisms. The microactuators or microelectromechanisms are individually affixed to the tip of each primary actuator arm, with each microactuator or microelectromechanism supporting one read/write head. The primary actuator mechanism provides initial general positioning by unitarily moving the microactuators or microelectromechanisms to an approximate radial position, whereupon the microactuators or microelectromechanisms provide precise independent secondary positioning by independently moving the read/write heads to specific tracks on corresponding platter surfaces. This embodiment accomplishes independent-arm actuation and is particularly useful to effectively combat adjacent electromagnetic interference.

17. The foregoing dual-stage actuator system (which, to reiterate, comprises primary and secondary actuation devices) is covered by Plaintiff's patent, including by independent claim

41; by dependent claims 61, 62, and 63; by various other independent and dependent claims; and by portions of the specification section of Plaintiff's patent.

18. Defendant manufactures, markets, sells, distributes, and/or imports hard disk drives featuring an actuator system comprising primary and secondary actuation devices, said actuator system enabling independent positioning of the read/write heads through dual-stage arm movement.

19. Defendant's dual-stage actuator system is described in several Maximum PC articles. One Maximum PC article (Exhibit D), dated December 2009, describes Defendant's Black series 2TB hard drives as featuring "a dual-stage actuator system that puts a fine-tuned piezoelectric actuator head at the end of the standard magnetic actuator." Another Maximum PC article (Exhibit E), dated February 2013, describes Defendant's Black series 4TB hard drives as featuring "dual-arm actuators."

20. Defendant's dual-stage actuator system is also described in its technical fliers. Two fliers (Exhibits F and G), issued in September 2011 and July 2015, respectively, reveal that Defendant's RE and Se series hard drives feature "[d]ual actuator technology," explaining: "The primary actuator provides coarse displacement using conventional electromagnetic principles. The secondary actuator uses piezoelectric motion to fine tune the head positioning to a higher degree of

accuracy." Another flier (Exhibit H), issued in August 2017, reveals that Defendant's Gold series hard drives feature "a dual-stage actuator," explaining that "[t]he primary stage provides co[a]rse displacement while the secondary stage uses piezoelectric motion to fine tune the head positioning."

21. Upon information and belief, Defendant manufactures, markets, sells, distributes, and/or imports hard drives in other models/capacities containing dual-stage actuator systems comprising primary and secondary actuation devices.

22. Upon information and belief, dual-stage actuator systems of the foregoing nature are contained within Defendant's entire line of WD-branded and HGST-branded hard drives, as well as within all other hard drives offered by Defendant having storage capacities of 2 terabytes or greater.

23. In addition to utilizing and integrating dual-stage actuator systems within its hard drives, Defendant manufactures, markets, sells, distributes, and/or imports dual-stage actuator systems as standalone units. Such standalone units, known as head stack assemblies or E-blocks, comprise primary and secondary actuation devices of the foregoing nature.

24. In circulating its dual-stage actuator systems, whether as standalone units or as integrated components of hard drives, Defendant acted in accordance with an established business model. Pursuant to that business model, Defendant

intended, knew, or reasonably should have known that its dual-stage actuator systems would enter the jurisdiction of the United States directly or through the stream of commerce.

COUNT I - GENERAL PATENT INFRINGEMENT

25. Defendant's dual-stage actuator system and tip-mounted actuators fall within the scope of U.S. Patent No. 7,324,301, either through their element-by-element structural correspondence or under the doctrine of equivalents.

26. Defendant's dual-stage actuator system and tip-mounted actuators feature every structural element and limitation of claims 41, 61, 62, and 63 of Plaintiff's patent.

27. Defendant's dual-stage actuator system and tip-mounted actuators, as structured, constitute "means for moving [the arm-mounted read/write heads] simultaneously and independently across corresponding carrier surfaces" in violation of claim 41 of Plaintiff's patent.

28. Defendant's tip-mounted actuators (whether or not piezoelectric in nature) constitute "secondary actuators" structured in violation of claim 61 of Plaintiff's patent.

29. Defendant's tip-mounted actuators (whether or not piezoelectric in nature) constitute "subdevices" structured in violation of claim 61 of Plaintiff's patent.

30. Defendant's tip-mounted actuators (whether or not piezoelectric in nature) constitute "microactuators" structured

in violation of claim 62 of Plaintiff's patent.

31. Defendant's tip-mounted actuators (whether or not piezoelectric in nature) constitute "microelectromechanisms" structured in violation of claim 63 of Plaintiff's patent.

32. In addition to literally falling within the scope of claims 41, 61, 62, and 63 of Plaintiff's patent, Defendant's dual-stage actuator system and tip-mounted actuators are substantially equivalent to Plaintiff's invention in material respects. Specifically, relative to Plaintiff's invention, Defendant's apparatus (1) performs the same function (namely, independent positioning of the read/write heads over the storage media); (2) implements that function the same way (namely, by utilizing tip-mounted secondary actuation devices); and (3) achieves the same result (namely, independent dual-stage arm movement). Given these similarities in function, way, and result, Defendant's apparatus falls within the scope of Plaintiff's invention under the doctrine of equivalents.

33. Defendant's dual-stage actuator system and tip-mounted actuators violate other claims of Plaintiff's patent in addition to claims 41, 61, 62, and 63, said violation occurring either through their literal structural correspondence or under the doctrine of equivalents.

34. During the preceding six years (that is, during the limitation period set forth in 35 U.S.C. § 286), Defendant,

acting either directly or through its subsidiaries, caused its dual-stage actuator system and tip-mounted actuators to enter the United States and its territories and possessions, notwithstanding that Defendant's dual-stage actuator system and tip-mounted actuators were protected by Plaintiff's patent.

35. By circulating said devices in the manner specified, and by doing so without Plaintiff's permission, Defendant violated U.S. Patent No. 7,324,301, thereby subjecting Defendant to liability for general patent infringement.

COUNT II - WILLFUL PATENT INFRINGEMENT

36. In infringing upon Plaintiff's patent as alleged above, Defendant acted willfully. That is, Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301. Despite such knowledge, Defendant intentionally circulated infringing devices.

37. Defendant's willful infringement of Plaintiff's patent is evidenced by the surrounding circumstances. One such circumstance concerns the publication date of Plaintiff's patent application and the timing of Defendant's adoption of the actuator improvements/innovations disclosed therein.

38. Plaintiff's patent application, No. 2005/0243661, was published on November 3, 2005 (see Exhibit C). At that point, Plaintiff's patent application was easily accessible to the general public, having been posted on the website of the United

States Patent and Trademark Office and having been included in various third-party databases. Such electronic availability permitted Plaintiff's patent application to be easily located via classification codes, keywords, and other techniques.

39. Upon information and belief, Defendant's legal and technology departments customarily and routinely review all published patent applications pertaining to the field of magnetic storage and retrieval. During the course of its review process, Defendant encountered, and therefore had actual knowledge of, Plaintiff's published patent application.

40. Prior to the publication of Plaintiff's patent application (i.e., before November 3, 2005), Defendant's hard disk drives did not feature dual-stage actuator systems or tip-mounted actuators. Subsequent to the publication of Plaintiff's patent application (i.e., after November 3, 2005), Defendant began employing dual-stage actuator systems and tip-mounted actuators in its hard disk drives.

41. Defendant began utilizing dual-stage actuator systems and tip-mounted actuators approximately two or three years after the publication of Plaintiff's patent application. That delayed implementation corresponds with the lead time needed to research and develop new technology (meaning that Defendant began researching and developing its dual-stage actuator system and tip-mounted actuators within weeks or months after having

actual knowledge of Plaintiff's published patent application).

42. In short, Defendant had actual knowledge of Plaintiff's patent application and began cultivating the underlying technology shortly thereafter. These circumstances are indicative of Defendant's willful infringement.

43. Other evidence exists, both direct and circumstantial, regarding Defendant's knowledge, belief, and intent. The discovery process is expected to expose such evidence.

44. Because Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301, Defendant willfully infringed on said patent during the cause of action, thereby warranting enhanced damages.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that the Court issue judgment against Defendant, as follows:

A. declaring that Plaintiff's patent, Serial No. 7,324,301, is valid, active, and enforceable;

B. declaring that Defendant committed general and willful patent infringement (Counts I and II, respectively);

C. enjoining Defendant from circulating infringing devices in the United States and its territories/possessions;

D. compensatory damages, in the amount of $5 billion, for general patent infringement (as alleged in Count I);

E. enhanced damages, equaling three times base damages,

for willful patent infringement (as alleged in Count II);

F. reasonable attorney fees, assuming that Plaintiff secures legal representation in the present action;

G. costs for bringing suit; and

H. such other relief as the Court deems proper.

Walter A. Tormasi

Dated: January 30, 2019

DEMAND FOR JURY TRIAL

Pursuant to Fed. R. Civ. P. 38(b)(1), Plaintiff hereby demands trial by jury regarding all triable issues.

Walter A. Tormasi

Dated: January 30, 2019

VERIFICATION UNDER PENALTY OF PERJURY

I hereby verify, under penalty of perjury pursuant to 28 U.S.C. § 1746, that the above facts are true to the best of my knowledge and that the attached exhibits are genuine.

Walter A. Tormasi

Dated: January 30, 2019

Exhibit A

ASSIGNMENT OF U.S. PATENT NO. 7,324,301

It is hereby RESOLVED, RATIFIED, and AGREED as follows:

1. Advanced Data Solutions Corp., acting under the authority of its President and Sole Shareholder, hereby assigns to Walter A. Tormasi all right, title, and interest in U.S. Patent No. 7,324,301.

2. Said assignment shall have complete retroactive effect, permitting Walter A. Tormasi to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301.

Walter A. Tormasi
President and Sole Shareholder
Advanced Data Solutions Corp.

January 30, 2019
Date

Exhibit B

WESTERN DIGITAL COPORATION
SUBSIDIARIES OF THE COMPANY

App.216a

Name of Entity	State or Other Jurisdiction of Incorporation or Organization
Amplidata N.V.	Belgium
Amplidata, Inc.	Delaware
EasyStore Memory Limited	Ireland
Fabrik, LLC	Delaware
Fusion Multisystems Ltd.	Canada
Fusion-io (Beijing) Info Tech Co., Ltd	China
Fusion-io GmbH	Germany
Fusion-io Holdings S.A.R.L.	Luxembourg
Fusion-io Limited	Hong Kong
Fusion-io Poland SP.Z.O.O.	Poland
Fusion-io Singapore Private Ltd	Singapore
Fusion-io LLC	Delaware
G-Tech LLC	California
HGSP (Shenzhen) Co., Ltd.	China
HGST (Shenzhen) Co., Ltd.	China
HGST (Thailand) Ltd.	Thailand
HGST Asia Pte. Ltd.	Singapore
HGST Consulting (Shanghai) Co., Ltd.	China
HGST Europe, Ltd.	United Kingdom
HGST Japan, Ltd.	Japan
HGST Malaysia Sdn. Bhd.	Malaysia
HGST Netherlands B.V.	Netherlands
HGST Philippines Corp.	Philippines
HGST Singapore Pte. Ltd.	Singapore
HGST Technologies India Private Limited	India
HGST Technologies Malaysia Sdn. Bhd.	Malaysia
HGST Technologies Santa Ana, Inc.	California
HGST, Inc.	Delaware
HICAP Properties Corp.	Philippines
Keen Personal Media, Inc.	Delaware
M-Systems (Cayman) Limited	Cayman Islands
M-Systems B.V.	Netherlands
M-Systems Finance Inc.	Cayman Islands
M-Systems Inc.	New York
P.P.S. Van Koppen Pensioen B.V.	Netherlands
Pacifica Insurance Corporation	Hawaii
Prestadora SD, S. de R.L. de C.V.	Mexico
Read-Rite Philippines, Inc.	Philippines
Sandbox Expansion LLC	Delaware
SanDisk (Cayman) Limited	Cayman Islands
SanDisk (Ireland) Limited	Ireland
SanDisk 3D IP Holdings Ltd	Cayman Islands

WESTERN DIGITAL COPORATION
SUBSIDIARIES OF THE COMPANY

App.217a

Name of Entity	State or Other Jurisdiction of Incorporation or Organization
SanDisk 3D LLC	Delaware
SanDisk B.V.	Netherlands
SanDisk Bermuda Limited	Bermuda
SanDisk Bermuda Unlimited	Bermuda
SanDisk BiCS IP Holdings Ltd	Cayman Islands
SanDisk Brasil Participações Ltda.	Brazil
SanDisk C.V.	Netherlands
SanDisk China Limited	Ireland
SanDisk China LLC	Delaware
SanDisk LLC	Delaware
SanDisk Enterprise Holdings, Inc.	Delaware
SanDisk Enterprise IP LLC	Texas
SanDisk Equipment Y.K.	Japan
SanDisk Flash B.V.	Netherlands
SanDisk France SAS	France
SanDisk G.K.	Japan
SanDisk GmBH	Germany
SanDisk Holding B.V.	Netherlands
SanDisk Holdings LLC	Delaware
SanDisk Hong Kong Limited	Hong Kong
SanDisk IL Ltd.	Israel
SanDisk India Device Design Centre Private Limited	India
SanDisk Information Technology (Shanghai) Co. Ltd.	China
SanDisk International Holdco B.V.	Netherlands
SanDisk International Limited	Ireland
SanDisk International Middle East FZE	United Arab Emirates
SanDisk Israel (Tefen) Ltd.	Israel
SanDisk Korea Limited	Korea
SanDisk Latin America Holdings LLC	Delaware
SanDisk Malaysia Sdn. Bhd.	Malaysia
SanDisk Manufacturing Americas, LLC	Delaware
SanDisk Manufacturing Unlimited Company	Ireland
SanDisk Operations Holdings Limited	Ireland
SanDisk Pazarlama Ve Ticaret Limited Sirketi	Turkey
SanDisk Scotland, Limited	United Kingdom
SanDisk Semiconductor (Shanghai) Co. Ltd.	China
SanDisk Spain, S.L.U.	Spain
SanDisk Storage Malaysia Sdn. Bhd.	Malaysia
SanDisk Sweden AB	Sweden
SanDisk Switzerland Sarl	Switzerland
SanDisk Taiwan Limited	Taiwan
SanDisk Technologies LLC	Texas
SanDisk Trading (Shanghai) Co. Ltd.	China

WESTERN DIGITAL COPORATION
SUBSIDIARIES OF THE COMPANY

App.218a

Name of Entity	State or Other Jurisdiction of Incorporation or Organization
SanDisk Trading Holdings Limited	Ireland
SanDisk UK, Limited	United Kingdom
SanDisk, Limited	Japan
SD International Holdings Ltd.	Cayman Islands
Secure Content Storage Association, LLC	Delaware
Shenzhen Hailiang Storage Products Co., Ltd.	China
Skyera, LLC	Delaware
SMART Storage Systems GmbH	Austria
STEC Bermuda, LP	Bermuda
STEC Europe B.V.	Netherlands
STEC Germany GmbH	Germany
STEC Hong Kong Ltd.	Hong Kong
STEC International Holding, Inc.	California
STEC Italy SRL	Italy
STEC R&D Ltd.	Cayman Islands
Suntech Realty, Inc.	Philippines
Virident Systems Private Limited	India
Virident Systems, LLC	Delaware
Virident Systems International Holdings Ltd.	Cayman Islands
Viviti Technologies Pte. Ltd.	Singapore
WD Media (Malaysia) Sdn.	Malaysia
WD Media (Singapore) Pte. Ltd.	Singapore
WD Media, LLC	Delaware
Western Digital (Argentina) S.A.	Argentina
Western Digital (France) SARL	France
Western Digital (Fremont), LLC	Delaware
Western Digital (I.S.) Limited	Ireland
Western Digital (Malaysia) Sdn. Bhd.	Malaysia
Western Digital (S.E. Asia) Pte Ltd	Singapore
Western Digital (Thailand) Company Limited	Thailand
Western Digital (UK) Limited	United Kingdom
Western Digital Canada Corporation	Ontario, Canada
Western Digital Capital Global, Ltd.	Cayman Islands
Western Digital Capital, LLC	Delaware
Western Digital Deutschland GmbH	Germany
Western Digital Do Brasil Comercio E Distribuicao De Produtos De Informatica Ltda.	Brazil
Western Digital Hong Kong Limited	Hong Kong
Western Digital Information Technology (Shanghai) Company Ltd.	China
Western Digital International Ltd.	Cayman Islands
Western Digital Ireland, Ltd.	Cayman Islands
Western Digital Japan Ltd.	Japan
Western Digital Korea, Ltd.	Republic of Korea
Western Digital Latin America, Inc.	Delaware

WESTERN DIGITAL COPORATION
SUBSIDIARIES OF THE COMPANY

App.219a

Name of Entity	State or Other Jurisdiction of Incorporation or Organization
Western Digital Netherlands B.V.	The Netherlands
Western Digital Taiwan Co., Ltd.	Taiwan
Western Digital Technologies, Inc.	Delaware

Exhibit C

US007324301B2

(12) **United States Patent**
Tormasi

(10) **Patent No.: US 7,324,301 B2**
(45) **Date of Patent: Jan. 29, 2008**

(54) **STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES**

(75) Inventor: **Walter A. Tormasi**, Somerville, NJ (US)

(73) Assignee: **Advanced Data Solutions Corp.**, Somerville, NJ (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 127 days.

(21) Appl. No.: 11/031,878

(22) Filed: Jan. 10, 2005

(65) **Prior Publication Data**

US 2005/0243661 A1 Nov. 3, 2005

Related U.S. Application Data

(60) Provisional application No. 60/568,346, filed on May 3, 2004.

(51) **Int. Cl.**
G11B 5/596 (2006.01)

(52) **U.S. Cl.** 360/78.12

(58) **Field of Classification Search** 360/55, 360/75, 53, 63, 51, 31, 66, 46, 68, 121, 264.4, 360/61, 78.04, 77.08, 78.12
See application file for complete search history.

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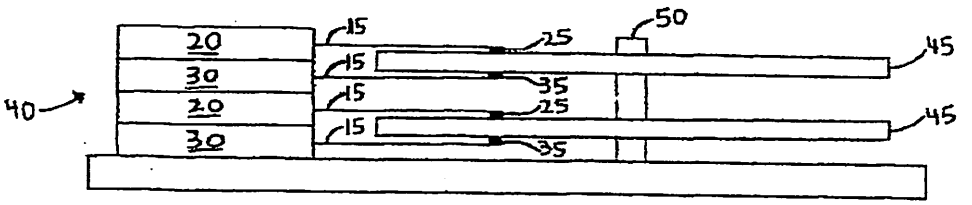
Primary Examiner—Fred F. Tzeng
(74) *Attorney, Agent, or Firm*—Sperry, Zoda & Kane

(57) **ABSTRACT**

A hard disk drive comprises an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. The drive also comprises one or more platters aggregating two or more platter surfaces whereupon data may be read from or written to by corresponding read/write heads. The independent-arm actuator and custom printed circuit board enable alternate or interleaving bits or blocks of data to be read or written simultaneously across a plurality of platter surfaces within the same physical drive.

77 Claims, 1 Drawing Sheet



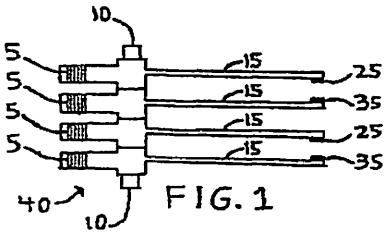


FIG. 1

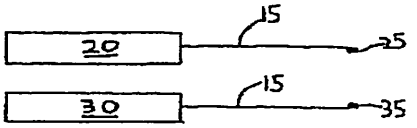


FIG. 2

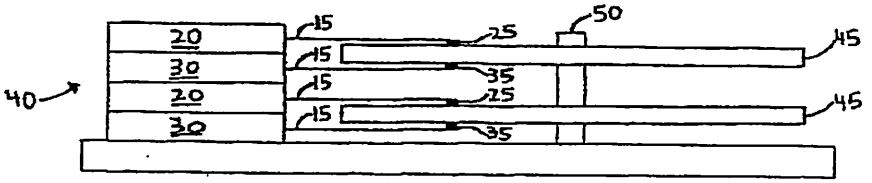


FIG. 3

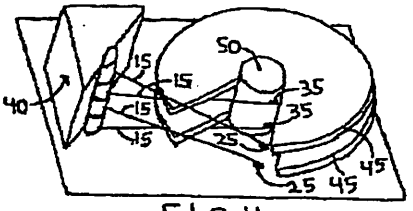


FIG. 4

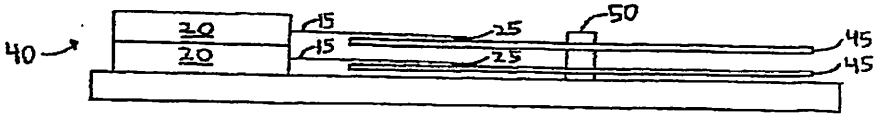


FIG. 5

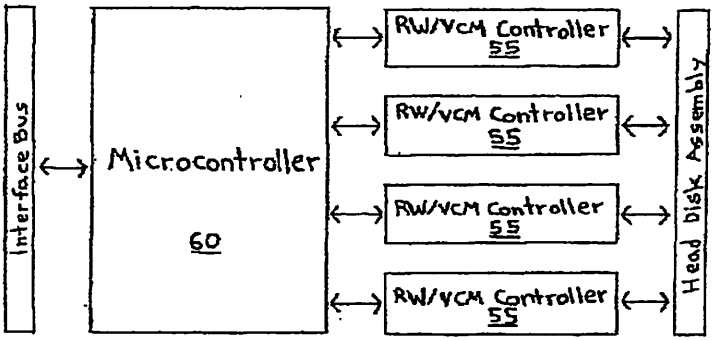


FIG. 6

STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES

CROSS-REFERENCE TO RELATED APPLICATIONS

This patent claims priority to U.S. Provisional Patent Application No. 60/568,346, said provisional application filed with the United States Patent and Trademark Office in Washington, D.C., on May 3, 2004.

FIELD OF THE INVENTION

The invention herein relates to the art of dynamically storing and retrieving information using nonvolatile magnetic random-access media, specifically hard disk drives or the like. In particular, the invention is directed toward increasing the read/write speed of a hard drive by striping data simultaneously across multiple platter surfaces within the same physical drive, thereby permitting high-speed parallel storage and retrieval of digital information.

BACKGROUND OF THE INVENTION

By way of background, the basic operation or construction of a hard disk drive has not changed materially since its introduction in the 1950s, although various individual components have since been improved or optimized. Hard drives typically contain one or more double-sided platters. These platters are mounted vertically on a common axle and rotated at a constant angular velocity by a spindle motor. During physical low-level formatting, the recording media are divided into tracks, which are single lines of concentric circles. There is a similar arrangement of tracks on each platter surface, with each vertical group of quasi-aligned tracks constituting separate cylinders. Each track is divided into sectors, which are arc-shaped segments having a defined data capacity.

Under the current iteration, each platter surface features a corresponding giant-magnetoresistive (GMR) read/write head, with the heads singly or dually attached by separate arms to a rotary voice-coil actuator. The arms are pivotably mounted to a vertical actuator shaft and connected to the shaft through a common carrier device. The common carrier device, or rack, functions as a single-movement mechanism, or comb. This actuator design physically prevents the arms from moving independently and only allows the arms to move radially across the platter surfaces in unison. As a consequence, the read/write heads are unable to simultaneously occupy different tracks or cylinders on separate platter surfaces.

A rotary actuator unitarily rotates its arms to particular tracks or cylinders using an electromagnetic voice-coil-motor system. In a typical voice-coil-motor system, an electromagnetic coil is affixed to the base of the head rack, with a stationary magnet positioned adjacent to the coil fixture. Actuation of the carrier device is accomplished by applying various magnitudes of current to the electromagnetic coil. In response to the application of current, the coil attracts or repels the stationary magnet through resulting electromagnetic forces. This action causes the arms to pivot unitarily along the axis of the actuator shaft and rotate radially across corresponding platter surfaces to particular tracks or cylinders.

A head disk assembly (HDA) houses the platters, spindle motor, and actuator mechanism. The head disk assembly is a sealed compartment containing an air-filtration system

comprising barometric and recirculation filters. The primary purpose of the head disk assembly is to provide a substantially contamination-free environment for proper drive operation.

The electronic architecture of the drive is contained on a printed circuit board, which is mounted to the drive chassis below the head disk assembly. The printed circuit board contains an integrated microcontroller, read/write (RW) controller, voice-coil-motor (VCM) controller, and other standard logic circuits and auxiliary chips. The microcontroller, RW controller, and VCM controller are typically application-specific integrated circuits, or ASICs, that perform a multitude of functions in cooperation with one another. The RW controller, for example, is connected to the read/write heads (through write-driver and preamplification circuitry) and is responsible for processing and executing read or write commands. The VCM controller is connected to the actuator mechanism (through the electromagnetic coil) and is responsible for manipulating and positioning the actuator arms during read or write operations. The microcontroller is interconnected to the foregoing circuitry and is generally responsible for providing supervisory and substantive processing services to the RW and VCM controllers under the direction of firmware located on an integrated or separate EEPROM memory chip.

Although industry standards exist, drive manufacturers generally implement custom logic configurations for different hard-drive product lines. Accordingly, notwithstanding the prevalent use of extendible core electronic architecture and common firmware and ASICs, such custom logic configurations prevent printed circuit boards from being substituted within drives across different brands or models.

Cylinders and tracks are numbered from the circumference of the platters toward the center beginning with 0. Heads and platter surfaces are numbered from the bottom head or platter surface toward the top, also beginning with 0. Sectors are numbered from the start of each track toward the end beginning with 1, with the sectors in different tracks numbered anew using the same logical pattern.

Although it is often stated that tracks within respective cylinders are aligned vertically, tracks within each cylinder are actually not aligned with such precision as to render them completely perpendicular. This vertical misalignment of the tracks occurs as a result of imprecise servo writing, latitudinal formatting differences, mechanical hysteresis, nonuniform thermal expansion and contraction of the platters, and other factors. Because these causes of track misalignment are especially influential given the high track densities of current drives, tracks are unlikely to be exactly vertically aligned within a particular cylinder. From a technical standpoint, then, it can accurately be stated that tracks within a cylinder are quasi-aligned; that is, different tracks within a cylinder can be accessed sequentially by the read/write heads without substantial radial movement of the carrier device, but, it follows, some radial movement (usually several microns) is frequently required.

As a result of its common-carrier and single-coil actuator design, core electronic architecture, and vertical track-alignment discrepancy, current drive configurations prevent data from being written simultaneously to different tracks within identical or separate cylinders. In contrast, current drives write data sequentially in a successive pattern generally giving preference to the lowest cylinder, head, and sector numbers. Pursuant to this pattern, for example, data are written sequentially to progressively ascending head and sector numbers within the lowest available cylinder number until that cylinder is filled, in which case the process begins

anew starting with the first head and sector numbers within the next adjacent cylinder. Because tracks within a given cylinder are quasi-aligned, this pattern has the primary effect of reducing the seek time required by the read/write heads for sequentially accessing successive data.

Hard disk-drives occupy a pivotal role in computer operation, providing a reliable means for nonvolatile storage and retrieval of crucial data. To date, while areal density (gigabits per square inch) continues to grow rapidly, increases in data transfer rates (megabytes per second) have remained relatively modest. Hard drives are currently as much as 100 times slower than random-access memory and 1000 times slower than processor on-die cache memory. Within the context of computer operation, these factors present a well-recognized dilemma: In a world of multi-gigahertz microprocessors and double-data-rate memory, hard drives constitute a major bottleneck in data transportation and processing, thus severely limiting overall computer performance.

One solution to increase the read/write speed of disk storage is to install two or more hard drives as a Redundant Array of Independent Disks, or RAID, using a Level 0 specification, as defined and adopted by the RAID Advisory Board. RAID 0 distributes data across two or more hard drives via striping. In a two-drive RAID 0 array, for example, the striping process entails writing one bit or block of data to one drive, the next bit or block to the other drive, the third bit or block to the first drive, and so on, with data being written to the respective drives simultaneously. Because half as much data is being written to (and subsequently accessed from) two drives simultaneously, RAID 0 doubles potential data transfer rates in a two-drive array. Further increases in potential data transfer rates generally scale proportionally higher with the inclusion into the array of additional drives.

Traditional RAID 0, however, presents numerous disadvantages over standard single-drive configurations. Since RAID 0 employs two or more separate drives, its implementation doubles or multiplies correspondingly the probability of sustaining a drive failure. Its implementation also increases to the same degree the amount of power consumption, space displacement, weight occupation, noise generation, heat production, and hardware costs as compared to ordinary single-drive configurations. Accordingly, RAID 0 is not suitable for use in laptop or notebook computers and is only employed in supercomputers, mainframes, storage subsystems, and high-end desktops, servers, and workstations.

SUMMARY OF THE INVENTION

It is an object of the invention to institute a single-drive striping configuration wherein the striping feature employed in RAID Level 0 is incorporated into a single physical hard disk drive (as opposed to two or more separate drives) through the use of particular embodiments and modes of implementation, operation, and configuration. By incorporating the striping feature into a single physical drive, it is an object of the invention to dramatically increase the read/write speed of the drive without suffering miscellaneous disadvantages customarily associated with traditional multi-drive RAID 0 implementation.

In particular, the invention as embodied consists of a hard disk drive comprising an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. The drive also comprises one or more platters aggregating two or more platter surfaces

whereupon data may be read from or written to by corresponding read/write heads. As explained in detail below, the independent-arm actuator and custom printed circuit board enable alternate or interleaving bits or blocks of data to be read or written simultaneously across a plurality of platter surfaces within the same physical drive, thereby accomplishing the primary objects of the invention.

Other objects and aspects of the invention will in part become obvious and will in part appear hereinafter. The invention thus comprises the apparatuses, mechanisms, and systems in conjunction with their parts, elements, and interrelationships that are exemplified in the disclosure and that are defined in scope by the respective claims.

BRIEF DESCRIPTION OF THE DRAWINGS

Six drawings accompany this patent. These drawings inclusively illustrate miscellaneous aspects of the invention and are intended to complement the disclosure by providing a fuller understanding of the invention and its constituents.

FIG. 1 depicts a side view of the internal components of an independent-arm actuator mechanism.

FIG. 2 depicts a side view of two one-arm actuators that compose an independent-arm actuator mechanism.

FIG. 3 depicts a side view of a head disk assembly containing an independent-arm actuator mechanism and two disk platters.

FIG. 4 depicts a perspective view of the head disk assembly featured in the previous figure.

FIG. 5 depicts a side view of another embodiment of the independent-arm actuator mechanism.

FIG. 6 depicts a block diagram of a printed circuit board containing custom core electronic architecture.

DETAILED DESCRIPTION OF THE INVENTION

As noted above, in order to effectuate the single-drive striping configuration, the invention embodies the utilization of an actuator with independently movable arms and a printed circuit board with custom core electronic architecture. These and other aspects of the invention are discussed in detail below, as well as particular modes of implementation, operation, and configuration.

Turning now to specific aspects of the invention, the independent-arm actuator features numerous distinct characteristics. In contrast to conventional actuator design, the arms to the independent-arm actuator are connected to one and the same actuator shaft through independent carrier devices. Separate electromagnetic coils are affixed within the proximity of the base of each arm, with one or more stationary magnets positioned between each coil fixture. The independent carrier devices and separate electromagnetic coils function collectively as a multi-movement mechanism. This multi-movement mechanism allows the arms to move radially across corresponding platter surfaces independently (as opposed to unitarily or in unison) and permits each read/write head to simultaneously occupy different tracks or cylinders on separate platter surfaces.

FIG. 1 depicts a side view of the internal components of an independent-arm actuator mechanism. The actuator mechanism 40 comprises horizontally suspended arms 15 mounted separately (through independent carrier devices) to a vertical actuator shaft 10. In accordance with the above embodiment, separate electromagnetic coils 5 are affixed to the base of each arm 15, with one or more stationary magnets (not shown) positioned between each coil fixture 5.

To the extent necessary, antimagnetic shielding (not shown) may be inserted between each coil fixture 5 to minimize or eliminate adjacent electromagnetic interference. Actual independent-arm actuation is accomplished by applying various magnitudes of current to the respective electromagnetic coils 5. In response to the application of current, the coils 5 independently attract or repel the stationary magnet (s) through resulting electromagnetic forces. This action causes the arms 15 to pivot independently along the axis of the actuator shaft 10 and rotate radially across corresponding platter surfaces (not shown) to particular tracks or cylinders.

Although FIG. 1 depicts the electromagnetic coils 5 as being actual large-scale wire windings, each electromagnetic coil 5 instead features a substantially flat profile and a generally annular, triangular, square, or rectangular dimension. The stationary magnets (not shown) are similarly plate-shaped members, with each such member comprising permanent magnets and optional soft-magnetic elements. The antimagnetic shielding (not shown), which typically takes the form of foil or plates, may comprise mu metal (nickel-molybdenum-iron-copper) or its functional equivalent. As a substitute for antimagnetic shielding, however, adjacent electromagnetic interference may be reduced appreciably by placing the electromagnetic coils and/or stationary magnets in an antipodal configuration (i.e., opposite polar relationship).

As an alternative embodiment, the independent-arm actuator may comprise numerous individual one-arm actuators mounted vertically. This embodiment combines preexisting submechanisms in a unique manner never before suggested in combination. By combining individual one-arm actuators to form the independent-arm actuator mechanism, complexity of the actuator mechanism may be reduced appreciably, thereby resulting in lower potential development and production expenses being incurred by the manufacturer.

FIG. 2 depicts a side view of two individual one-arm actuators that compose an independent-arm actuator mechanism under the alternative embodiment. Whereas the top actuator 20 has its read/write head 25 facing south, the bottom actuator 30 has its read/write head 35 facing north. Both actuators 20,30 have substantially low-height form factors.

FIG. 3 depicts a side view of a head disk assembly for a hard drive containing two double-sided platters. The head disk assembly contains an independent-arm actuator mechanism 40 and two disk platters 45 affixed to an upright axle 50. In accordance with the above embodiment, the independent-arm actuator 40 comprises four one-arm actuators 20,30 mounted vertically, with each one-arm actuator 20,30 assigned to different platter surfaces. Although the one-arm actuators 20,30 are depicted in the diagram as being separate and discrete submechanisms, it should be noted that the one-arm actuators may share the same mechanical housing, actuator shaft, stationary magnet, and other unifiable components.

FIG. 4 depicts a perspective view of the head disk assembly featured in the previous figure. To illustrate the independent nature of the actuator arms 15, the diagram depicts each head 25,35 in substantially different radial positions.

FIG. 5 depicts a side view of another embodiment of the independent-arm actuator mechanism for a hard drive containing two single-sided platters. The diagram depicts an independent-arm actuator 40 comprising two one-arm actuators 20 mounted vertically. In contrast to the previous embodiment, the head 25 to each one-arm actuator 20 faces south, although a northern polarity may just as easily be employed. This actuator configuration is less preferable to the one specified previously but is nonetheless useful where the one-arm actuators cannot be accommodated within the height allocated to each platter surface. Such a situation may occur where the drive contains numerous platters that are vertically spaced in close proximity. This problem, however, may be corrected by reducing the number of platters within the drive in order to increase the vertical space between the platters.

As another embodiment, the independent-arm actuator may comprise a primary actuator mechanism and two or more secondary actuator mechanisms. Under this embodiment, the primary actuator mechanism is an ordinary single-movement device, whereas the secondary actuator mechanisms are subdevices such as microactuators or microelectromechanisms. The microactuators or microelectromechanisms are individually affixed to the tip of each primary actuator arm, with each microactuator or microelectromechanism supporting one read/write head. The primary actuator mechanism provides initial general positioning by unitarily moving the microactuators or microelectromechanisms to an approximate radial position, whereupon the microactuators or microelectromechanisms provide precise independent secondary positioning by independently moving the read/write heads to specific tracks on corresponding platter surfaces. This embodiment accomplishes independent-arm actuation and is particularly useful to effectively combat adjacent electromagnetic interference.

Pursuant to the foregoing embodiment, it is preferable that the secondary actuators (e.g., microactuators or microelectromechanisms) feature significant ranges of independent radial movement. In other words, each secondary actuator, for example, should preferably permit its read/write head to access 10,000 or more adjacent tracks on the respective platter surfaces. The secondary actuators, however, may permit their respective read/write heads to access a lesser number of adjacent tracks (e.g., 5000, 2500, 1000, 100, or 10) in accordance with the invention. These smaller ranges of independent radial movement are especially preferable where such radial restriction appreciably reduces the complexity of the secondary actuators.

The printed circuit board comprises integrated RW/VCM (i.e., read/write and voice-coil-motor) controllers and microcontroller circuitry. As embodied, each RW/VCM controller comprises read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating the respective electromagnetic coils to the independent-arm actuator mechanism and positioning the respective actuator arms during read or write operations. The microcontroller comprises an application-specific integrated circuit, or ASIC, that performs a multitude of functions, including providing supervisory and substantive processing services to each RW/VCM controller. The RW/VCM controllers and microcontroller constitute the core electronic architecture of the printed circuit board. The printed circuit board, however, also comprises peripheral electronic architecture such as an integrated EEPROM memory chip containing supporting device drivers, or firmware, as well as standard logic circuits and auxiliary chips used to control the spindle motor and other elementary components.

The number of RW/VCM controllers on the printed circuit board is equivalent to the number of arms composing the independent-arm actuator mechanism, with each RW/VCM controller assigned to different actuator arms. The integrated microcontroller is shared among the RW/VCM

controllers using separate data channels, with the microcontroller connected singly to an interface bus, preferably using an SATA, SCSI, or other prevailing high-performance interface standard. The remaining peripheral logic circuits and auxiliary chips may be connected using a variety of standard or custom configurations.

FIG. 6 depicts a block diagram of the aforementioned printed circuit board for a hard drive containing two double-sided platters. The diagram illustrates the core electronic architecture of the printed circuit board but omits peripheral electronic architecture to promote clarity. In accordance with the above embodiment, the printed circuit board comprises four RW/VCM controllers 55, with each RW/VCM controller 55 assigned to common microcontroller circuitry 60 and different actuator arms (not shown). It should be noted that any electronic component on the printed circuit board may coexist either physically or logically or may be rearranged schematically, consolidated into a single multi-function chip, or replaced by software equivalents, among other things, as customarily occurs in an effort by manufacturers to simplify or optimize the electronic architecture of hard drives.

Similar to a RAID 0 controller or its software equivalent, the integrated microcontroller on the printed circuit board functions as an intermediary between a host system and the RW/VCM controllers. As embodied, the microcontroller intercepts read or write commands from the host system and responds pursuant to a predetermined shuffling algorithm. In executing write commands, the microcontroller apportions alternate or interleaving bits or blocks of data to each RW/VCM controller. In executing read commands, the above operation occurs in reverse sequence, with the microcontroller reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and transmitting the data to the host system in native sequential order.

The integrated RW/VCM controllers on the printed circuit board function as a massively parallel subsystem. In response to read or write commands issued by the microcontroller, each RW/VCM controller instructs its assigned actuator arm to perform the requested operation. Each RW/VCM controller and its corresponding actuator arm operate independently in relation to other similarly paired RW/VCM controllers and actuator arms. In reading or writing data, each RW/VCM controller causes its assigned actuator arm to read or write data across the respective platter surfaces, with all such read or write operations by the actuator arms occurring simultaneously in a parallel fashion.

The data that are read or written across each platter surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller. The result: Alternate or interleaving bits or blocks of data are read or written simultaneously across multiple platter surfaces within the drive. In a one-platter drive containing two platter surfaces, for example, one bit or block of data is written to (or read from) one platter surface, the next bit or block to the other platter surface, the third bit or block to the first platter surface, and so on, with data being written to (or read from) the respective platter surfaces simultaneously. This process is akin to incorporating the striping feature used in RAID 0 into a single physical drive.

To optimize data storage and retrieval, data are read or written across the respective platter surfaces in a pattern giving preference to the lowest track and sector numbers. This pattern is similar to the pattern employed in an ordinary drive with the exception that data are read or written simultaneously pursuant to the striping scheme outlined above. In addition to reducing the seek time required for simultaneously accessing pseudo-successive data, this pattern has the effect of providing consistency among the read/write pattern employed by each RW/VCM controller. As a result, although FIG. 4 depicts the heads 25,35 to the independent-arm actuator 40 in substantially different radial positions, the arms 15 actually move in near synchronization (albeit independently) in accordance with the identical read/write pattern common among the RW/VCM controllers.

From a conceptual standpoint, it can generally be stated that each platter surface and its corresponding RW/VCM controller and actuator arm function as discrete drive modules. Such artificial compartmentalization causes these drive modules to appear as separate physical drives to the microcontroller, thereby enabling the microcontroller to natively manipulate each module independently. Analogous to standard RAID 0 technology, these drive modules appear collectively as a single drive to the host system, with total data capacity of the drive being equal to the aggregate capacity of the individual platter surfaces.

The invention possesses several unique qualities in addition to those previously mentioned. Insofar as data are read or written simultaneously across the respective platter surfaces independently, each platter surface emulates separate drives in RAID 0 configuration. As a consequence, increases in potential data transfer rates generally scale proportionally higher with the inclusion into the drive of additional platter surfaces. Accordingly, a one-platter notebook drive, for example, would emulate two drives in RAID 0 configuration, while a five-platter desktop drive would emulate ten drives, also in RAID 0 configuration. Using the preceding example, the invention has the potential to double and decuple the read/write speeds of notebook and desktop drives, respectively, with maximum data transfer rates approaching or exceeding 500 megabytes per second.

These speed increases, it follows, are accomplished without the disadvantages associated with traditional multi-drive RAID 0 implementation. The invention as embodied consists of a single physical drive as opposed to two or more separate drives. Notwithstanding the incorporation into the drive of substitute actuator components and additional integrated logic circuits, the drive is comparable to an ordinary drive in reliability, power consumption, space displacement, weight occupation, noise generation, heat production, and hardware costs. These characteristics are not only in sharp contrast to the ramifications resulting from RAID 0 implementation, but such characteristics make the drive suitable for use in all classes of computer systems, particularly laptop and notebook computers and entry-level desktops, servers, and workstations.

Another notable quality of the invention is that it operates and functions identically to an ordinary drive from the perspective of a consumer or end user. The drive appears as a single drive to an operating system, with the internal striping process occurring surreptitiously. Because all of the necessary logic circuits are located on the printed circuit board, the drive constitutes a fully functional self-contained unit and is entirely compatible with existing technology. In addition, due to the auxiliary EEPROM memory chip containing supporting firmware, the drive is bootable and can thus serve as the primary storage medium for the operating system. These factors render the drive highly versatile, so much so, in fact, that the drive can be connected to a traditional RAID array (using a separate RAID controller or its software equivalent) to achieve additional performance and/or reliability increases beyond the already-high capability of the invention.

Although specific embodiments have been set forth, the invention is sufficiently encompassing as to permit other embodiments to be employed within the scope of the invention. The embodiments outlined above, however, provide numerous practical advantages insofar as they permit the invention to be implemented as inexpensively as possible while remaining compatible with existing technology. This has the effect of lowering development and production expenses, increasing product marketability, and promoting widespread use and adoption. The embodiments outlined above thus constitute the best modes of implementation, operation, and configuration.

What is claimed is:

1. An information storage and retrieval apparatus, said apparatus comprising: at least one circular substrate, said substrate or substrates aggregating at least two carrier surfaces capable of storing data whereupon data may be read from or written to by corresponding read/write members; and means for simultaneously and independently reading or writing alternate or interleaving bits or blocks of data across each of said plurality of carrier surfaces within said information storage and retrieval apparatus.

2. An information storage and retrieval apparatus, said apparatus comprising:

at least one circular substrate, said substrate or substrates aggregating at least two carrier surfaces capable of storing data whereupon data may be read from or written to by corresponding read/write members; an actuator mechanism with at least two arms, each of said arms assigned to different carrier surfaces; means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to the circular substrate or substrates defining the carrier surfaces; and a logic holder, said holder comprising electronic architecture for electronically controlling said information storage and retrieval apparatus, wherein in its operative mode, said information storage and retrieval apparatus executes means for permitting alternate or interleaving bits or blocks of data to be read or written simultaneously and independently across a plurality of carrier surfaces.

3. The apparatus of claim 2, wherein said apparatus comprises a plurality of circular substrates.

4. The apparatus of claim 2, wherein said circular substrate or substrates are nonremovable.

5. The apparatus of claim 2, wherein said apparatus is a hard disk drive.

6. The apparatus of claim 2, wherein said actuator mechanism comprises more than two arms.

7. The apparatus of claim 2, wherein said actuator mechanism is rotary in nature.

8. The apparatus of claim 2, wherein the arms to said actuator mechanism are pivotably connected to one and the same actuator shaft through independent racks and further comprising separate electromagnetic coils affixed within the proximity of the base of each arm and at least one stationary magnet positioned between each of said electromagnetic coils.

9. The apparatus of claim 8, wherein said electromagnetic coils each feature a substantially flat profile.

10. The apparatus of claim 8, wherein said electromagnetic coils each feature a generally annular dimension.

11. The apparatus of claim 8, wherein said electromagnetic coils each feature a generally triangular dimension.

12. The apparatus of claim 8, wherein said electromagnetic coils each feature a generally square dimension.

13. The apparatus of claim 8, wherein said electromagnetic coils each feature a generally rectangular dimension.

14. The apparatus of claim 8, wherein said stationary magnets are plate-shaped members.

15. The apparatus of claim 8, wherein said stationary magnets comprise permanent magnets.

16. The apparatus of claim 8, wherein said stationary magnets comprise soft-magnetic elements.

17. The apparatus of claim 8, further comprising antimagnetic shielding affixed between each coil fixture.

18. The apparatus of claim 17, wherein said antimagnetic shielding comprises mn metal.

19. The apparatus of claim 8, wherein said electromagnetic coils are placed in an antipodal configuration.

20. The apparatus of claim 8, wherein said stationary magnets are placed in an antipodal configuration.

21. The apparatus of claim 2, wherein said actuator mechanism comprises at least two individual actuator submechanisms, said submechanisms each having only one arm, wherein said submechanisms are mounted vertically within one and the same imaginary plane, with each submechanism assigned to different carrier surfaces.

22. The apparatus of claim 21, wherein said submechanisms share one and the same mechanical housing.

23. The apparatus of claim 21, wherein said submechanisms share one and the same actuator shaft.

24. The apparatus of claim 21, wherein said submechanisms share one and the same stationary magnet.

25. The apparatus of claim 2, wherein: said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial position; and in its operative mode, said secondary actuators execute means for providing precise independent secondary positioning by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

26. The apparatus of claim 25, wherein said secondary actuators are microactuators.

27. The apparatus of claim 25, wherein said secondary actuators are microelectromechanisms.

28. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to 10,000 or more adjacent concentric circular tracks on the respective carrier surfaces.

29. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 5000 and 10,000 adjacent concentric circular tracks on the respective carrier surfaces.

30. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 2500 and 5000 adjacent concentric circular tracks on the respective carrier surfaces.

31. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement per-

mitting access by the read/write members to between 1000 and 2500 adjacent concentric circular tracks on the respective carrier surfaces.

32. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 100 and 1000 adjacent concentric circular tracks on the respective carrier surfaces.

33. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 10 and 100 adjacent concentric circular tracks on the respective carrier surfaces.

34. The apparatus of claim 25, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1 and 10 adjacent concentric circular tracks on the respective carrier surfaces.

35. The apparatus of claim 2, wherein said electronic architecture comprises means for electronically intercepting read or write commands from a host system, means for electronically responding pursuant to a predetermined shuffling algorithm, and means for electronically manipulating said arms independently during read or write operations.

36. The apparatus of claim 2, wherein said electronic architecture comprises: two or more RW/VCM controllers, said RW/VCM controllers comprising read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating and positioning said arms during read or write operations; and a microcontroller for providing supervisory and substantive processing services to said RW/VCM controllers, wherein said microcontroller, RW/VCM controllers, RW circuitry, and VCM circuitry together coexist either physically or logically or in the form of integrated circuits, discrete electronic components, or software equivalents.

37. The apparatus of claim 36, wherein:

the number of RW/VCM controllers is equivalent to the number of arms composing said actuator mechanism, with each RW/VCM controller assigned to different of said arms; and the microcontroller is shared among the RW/VCM controllers, with the microcontroller connected to a communication channel interfacing the information storage and retrieval apparatus.

38. The apparatus of claim 36, wherein: the microcontroller is an intermediary between a host system and the RW/VCM controllers, said microcontroller comprising means for electronically intercepting read or write commands from said host system and means for electronically responding pursuant to a predetermined shuffling algorithm, wherein in executing write commands, the microcontroller implements means for electronically apportioning alternate or interleaving bits or blocks of data to each RW/VCM controller; and in executing read commands, the microcontroller implements means for electronically reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and means for electronically transmitting said data to said host system in native sequential order.

39. The apparatus of claim 36, wherein: in response to read or write commands issued by the microcontroller, each RW/VCM controller executes means for electronically causing its assigned arm to read or write data across the respective carrier surfaces, with all such read or write operations by said arms occurring simultaneously in a parallel fashion, wherein the data that are read or written across each carrier surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller.

40. The apparatus of claim 2, wherein said logic holder is a printed circuit board.

41. An actuator mechanism, said mechanism comprising at least two arms, said arms assigned to different circular carrier surfaces within an information storage and retrieval apparatus; and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to said carrier surfaces.

42. The mechanism of claim 41, wherein said actuator mechanism comprises more than two arms.

43. The mechanism of claim 41, wherein said actuator mechanism is rotary in nature.

44. The mechanism of claim 41, wherein: the arms to said actuator mechanism are pivotably connected to one and the same actuator shaft though independent racks; separate electromagnetic coils being affixed within the proximity of the base of each said arm; and at least one stationary magnet is positioned between each of said electromagnetic coils.

45. The mechanism of claim 44, wherein said electromagnetic coils each feature a substantially flat profile.

46. The mechanism of claim 44, wherein said electromagnetic coils each feature a generally annular dimension.

47. The mechanism of claim 44, wherein said electromagnetic coils each feature a generally triangular dimension.

48. The mechanism of claim 44, wherein said electromagnetic coils each feature a generally square dimension.

49. The mechanism of claim 44, wherein said electromagnetic coils each feature a generally rectangular dimension.

50. The mechanism of claim 44, wherein said stationary magnets are plate-shaped members.

51. The mechanism of claim 44, wherein said stationary magnets comprise permanent magnets.

52. The mechanism of claim 44, wherein said stationary magnets comprise soft-magnetic elements.

53. The mechanism of claim 44, further comprising antimagnetic shielding affixed between each of said electromagnetic coil.

54. The mechanism of claim 53, wherein said antimagnetic shielding comprises mu metal.

55. The mechanism of claim 44, wherein said electromagnetic coils are placed in an antipodal configuration.

56. The mechanism of claim 44, wherein said stationary magnets are placed in an antipodal configuration.

57. The mechanism of claim 41, wherein said actuator mechanism comprises at least two individual actuator submechanisms, said submechanisms each having only one arm, wherein said submechanisms are mounted vertically within one and the same imaginary plane, with each said submechanism assigned to different carrier surfaces.

58. The mechanism of claim 57, wherein said submechanisms share one and the same mechanical housing.

59. The mechanism of claim 57, wherein said submechanisms share one and the same actuator shaft.

60. The mechanism of claim 57, wherein said submechanisms share one and the same stationary magnet.

61. The mechanism of claim 41 wherein said actuator mechanism comprises a primary actuator and at least two secondary actuators, wherein the primary actuator comprises at least two primary arms, said primary arms being only unitarily movable; and the secondary actuators are subdevices that are individually affixed to the tip of each primary arm, with each said secondary actuator supporting one

read/write member, wherein in its operative mode, said primary actuator executes means for providing initial general positioning by unitarily moving said secondary actuators to an approximate radial position; and in its operative mode, said secondary actuators execute means for providing precise independent secondary positioning by independently moving said read/write members to specific radial positions corresponding to particular concentric circular tracks on the respective carrier surfaces.

62. The mechanism of claim 61, wherein said secondary actuators are microactuators.

63. The mechanism of claim 61, wherein said secondary actuators are microelectromechanisms.

64. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to 10,000 or more adjacent concentric circular tracks on the respective carrier surfaces.

65. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 5000 and 10,000 adjacent concentric circular tracks on the respective carrier surfaces.

66. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 2500 and 5000 adjacent concentric circular tracks on the respective carrier surfaces.

67. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1000 and 2500 adjacent concentric circular tracks on the respective carrier surfaces.

68. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 100 and 1000 adjacent concentric circular tracks on the respective carrier surfaces.

69. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 10 and 100 adjacent concentric circular tracks on the respective carrier surfaces.

70. The mechanism of claim 61, wherein said secondary actuators have ranges of independent radial movement permitting access by the read/write members to between 1 and 10 adjacent concentric circular tracks on the respective carrier surfaces.

71. A logic holder, said holder comprising: electronic architecture, said architecture implementing means for electronically controlling an information storage and retrieval apparatus, wherein said information storage and retrieval apparatus comprises at least one circular substrate, said substrate or substrates aggregating a plurality of carrier surfaces whereupon data may be read from or written to by corresponding read/write members simultaneously and independently; said information storage and retrieval apparatus further comprising an actuator mechanism with a plurality of arms and means for moving said arms simultaneously and independently across corresponding carrier surfaces with a component of movement in a radial direction with respect to the circular substrate or substrates defining the carrier surfaces.

72. The holder of claim 71, wherein said electronic architecture comprises means for electronically intercepting read or write commands from a host system, means for electronically responding pursuant to a predetermined shuffling algorithm, and means for electronically manipulating said arms independently during read or write operations.

73. The holder of claim 71, wherein said electronic architecture comprises: two or more RW/VCM controllers, said RW/VCM controllers comprising read/write (RW) circuitry for processing and executing read or write commands and voice-coil-motor (VCM) circuitry for manipulating and positioning said arms during read or write operations; and a microcontroller for providing supervisory and substantive processing services to said RW/VCM controllers, wherein said microcontroller, RW/VCM controllers, RW circuitry, and VCM circuitry together coexist either physically or logically or in the form of integrated circuits, discrete electronic components, or software equivalents.

74. The holder of claim 73, wherein: the number of RW/VCM controllers is equivalent to the number of arms composing said actuator mechanism, with each RW/VCM controller assigned to different arms; and the microcontroller is shared among the RW/VCM controllers, with the microcontroller connected to a communication channel interfacing the information storage and retrieval apparatus.

75. The holder of claim 73, wherein: the microcontroller is an intermediary between a host system and the RW/VCM controllers, said microcontroller comprising means for electronically intercepting read or write commands from said host system and means for electronically responding pursuant to a predetermined shuffling algorithm, wherein in executing write commands, the microcontroller implements means for electronically apportioning alternate or interleaving bits or blocks of data to each RW/VCM controller; and in executing read commands, the microcontroller implements means for electronically reconstituting previously apportioned data fragments received from the respective RW/VCM controllers and means for electronically transmitting said data to said host system in native sequential order.

76. The holder of claim 73, wherein: in response to read or write commands issued by the microcontroller, each RW/VCM controller executes means for electronically causing its assigned arm to read or write data across the respective carrier surfaces, with all such read or write operations by said arms occurring simultaneously in a parallel fashion, wherein the data that are read or written across each carrier surface are commensurate with the data apportioned to the respective RW/VCM controllers by the microcontroller.

77. The holder of claim 71, wherein said logic holder is a printed circuit board.

* * * * *

Exhibit D

Western Digital Caviar Black 2TB

Faster than a VelociRaptor, and six times the capacity

After months of making do with 5,400rpm and 5,900rpm 2TB drives and odd-bird 1.5TB drives, it's finally happening: 7,200rpm two-terabyte hard drives are coming to rigs near you. First out of the gate and into our greedy arms is Western Digital's 2TB Caviar Black, the performance cousin to the 2TB Caviar Green we reviewed in May (http://bit.ly/3wKLRl). And brother, it's just what we've been waiting for.

The 2TB Caviar Black is spec'd to impress, with four 500GB platters, two processors, 64MB of cache, and a dual-stage actuator system that puts a fine-tuned piezoelectric actuator head at the end of the standard magnetic actuator, enabling fine-tuned tracking for speedy seek times. The Caviar Black also comes with WD's standard No-Touch ramp loader, so the read/write head never comes in contact with the platters, increasing the drive's lifespan.

All these little extras add up, and the 2TB Caviar Black offers the speediest sustained reads and writes—exceeding 112MB/s each—of any consumer magnetic hard drive we've ever tested. That's 15 percent faster than the Seagate Barracuda 7200.11 1.5TB's read speeds. The 1.5TB Barracuda, previously our high-capacity speed champion, couldn't keep up in sustained writes, either—here the Caviar was nearly 30 percent faster. And thanks to the greater areal density of the Caviar drive, its random-access read and write times are just 7.6ms and 5.0ms, respectively. You won't find faster seeks short of a VelociRaptor or solid state drive. Of course, solid state drives offer the best performance—the $370 Patriot Torqx, our Best of the Best SSD, achieves sustained reads of over 200MB/s, sustained writes of over 175MB/s, and seek times measured in the tenths of milliseconds.

The 2TB Caviar Black has an MSRP of $300, the same price that low-powered 2TB drives like the Caviar Green and Barracuda LP debuted at earlier this year. Street prices, of course, will be lower, and keep falling—the first waves of 2TB drives, the "green" ones, are already selling for as low as $200. And the Caviar Black's sustained reads and writes trump the fastest of those green drives by 20MB/s.

The 1.5TB Barracuda held a spot on our Best of the Best list for more than a year, but now it's been firmly supplanted—the 2TB Caviar Black is officially our favorite hard drive.

Expect 7,200rpm 2TB drives from Hitachi, Seagate, and others in the next few months as well, with the aim of high performance. But if you buy a capacity hard drive today, next week, or even half a year from now, you can't go wrong with this Caviar Black. It has the fastest sustained read and write speeds of any consumer magnetic hard drive we've ever tested. It's faster in any benchmark than all standard hard drives save the WD VelociRaptor, which still holds the edge in burst speeds and random-access times—*barely*. Think about that for a second: You can get VelociRaptor-busting speed and six-and-a-half times the capacity for $300. We're sold.

—NATHAN EDWARDS

VERDICT **9**

WESTERN DIGITAL CAVIAR BLACK 2TB

LENNON	LENIN
Stupid-fast; heaps of cache; dual-action actuator arm.	Random-access writes; burst speeds still slightly slower than VelociRaptor.

$300, www.wdc.com

BENCHMARKS

	WD Caviar Black 2TB	Seagate Barracuda 7200.11 1.5TB	WD VelociRaptor 300GB	Patriot Torqx 128GB
h2benchw Average Sustained Transfer Rate Read (MB/s)	112.3	98.2	98.31	**205.4**
h2benchw Average Sustained Transfer Rate Write (MB/s)	112.2	85.7	98.22	**175.1**
h2benchw Random Access Read (ms)	7.6	12.5	7.24	**0.11**
h2benchw Random Access Write (ms)	5.0	5.3	3.42	**0.31**
HDTach Burst Read (MB/s)	213.7	209.3	**249.7**	163.0
PCMark Vantage Overall Score	6,452	5,241	6,082	**21,247**

Best scores are bolded. All drives were tested on our standard test bed using a 2.66GHz Intel Core 2 Quad Q6700, EVGA 680i SLI board. HDTach 3.0.1.0, h2benchw, and Premiere Pro CS3 scores were obtained in Windows XP; PCMark Vantage 2005 scores were obtained in Windows Vista Home Premium 32-bit.

Exhibit E

Despite its consumer branding, the Black drive comes with an enterprise-level, 5-year warranty.

WD 4TB Black

The one to get if you need 4TB in a single drive

AS CONSUMERS, we have only two options when it comes to 7,200rpm 4TB hard drives: the Hitachi 7K4000 (Verdict 8, Holiday 2012) and this bad boy right here—the WD 4TB Black drive. Seagate does not currently offer a 7,200rpm 4TB Barracuda, but it does offer a 3TB version. For the uninitiated, WD classifies its drive by color, and Black stands for "high performance," which means this is exactly the drive we've been waiting for WD to deliver, as speed is our primary concern with PC hardware. Its specs show all the signs of a high-performance drive, too, as it offers a 7,200rpm spindle speed, 4MB of cache, dual-arm actuators to increase precision when positioning the heads, and a five-platter design. It even offers the same 1.2-million-hour MTBF (Mean Time Between Failure) and 5-year warranty as the enterprise-level RE drive, which is outstanding for a consumer-level drive.

For testing, we compared the Black drive to its 4TB companions and also brought in the current price/performance champion, the Seagate 3TB Barracuda. When it comes to the 4TB 7,200rpm drives, you can pretty much throw a blanket over all of them when it comes to sequential read and write speeds, as they are all extremely close. In read speeds, the Black drive hit 127.9MB/s, the Hitachi drive upped it to 132.7MB/s, but the fastest drive was the Seagate 3TB at 155.8MB/s, thanks to its high-density terabyte-per-platter design. The Seagate was also fastest in sequential write speeds at 155MB/s. We did see some variation in our Premiere test though, which writes a 20GB raw AVI file to the target drive. The Hitachi 7K4000 was 16 seconds faster than the WD Black, and also faster than the WD RE drive, making it a clear favorite. In the PCMark Vantage test, the Seagate 3TB reigned supreme along with the WD RE drive, with the rest of the contenders scoring relatively low comparatively.

Finally, we considered price, as well, since for most people that would be the deciding factor in a drive's desirability. Interestingly, there's a large disparity here, making our final choice an easy one. The WD RE drive and the Hitachi 7K4000 are roughly $500 on Newegg as we go to press, with the WD Black selling for just $400. The Seagate 3TB Barracuda, however, is just $140. The WD Black 4TB gets our nod then for best 4TB drive for the money, but the best *overall* drive for the money is still the Seagate 3TB.

–JOSH NOREM

BENCHMARKS

	WD 4TB Black	WD 4TB RE	Hitachi 4TB 7K4000	Hitachi Deskstar 5K4000	Seagate Barracuda 3TB
HDTune 4					
Avg. Read (MB/s)	127.9	132.8	132.7	108.3	**155.8**
Random-Access Read (ms)	13.6	**12.5**	15.9	19.9	14.9
Burst Read (MB/s)	213.2	275.5	307.9	**378.3**	325.7
Avg. Write (MB/s)	129.9	131.9	131.1	105.6	**155**
Random-Access Write (ms)	13.2	**12.5**	15.9	18.5	14.9
Burst Write (MB/s)	336.2	291.6	317.3	335	335.5
Premiere Pro CS3 (sec)	269	259	**253**	267	263
PCMark Vantage	6,196	6,664	6,125	6,135	**6,766**

Best scores are bolded. All drives tested on our hard drive test bench: a stock-clocked Intel Core i5-2500K CPU on an Intel DZ77GA-70K motherboard with 4GB DDR3, running Windows 7 Professional 64-bit. All tests performed using native Intel 6Gb/s SATA chipset with IRST version 10.1 drivers.

WD 4TB Black

PURRFECT Spacious; lowest-priced 4TB drive yet.

CATASTROPHE Only average performance; can't beat value of 3TB drives.

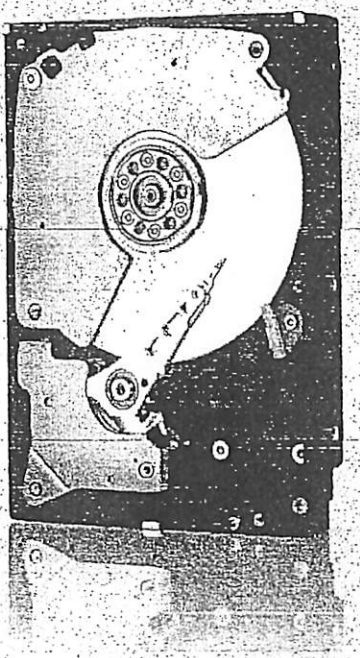
$400 (street), www.wd.com

Exhibit F

WD RE4

Enterprise SATA Hard Drives

Ideal for servers, video surveillance, and other demanding write-intensive applications, WD RE4 7200 RPM Enterprise SATA hard drives offer up to 2 TB capacity, 64 MB cache, 4th generation vibration tolerance and 5-year limited warranty.



INTERFACE	WIDTH/HEIGHT	ROTATIONAL SPEED	CAPACITIES
SATA 3 Gb/s	3.5-inch/1-inch	7200 RPM	250 GB to 2 TB

MODEL NUMBERS

WD2003FYYS WD5003ABYX
WD1003FBYX WD2503ABYX

Note: Not all products may be available in all regions of the world.

Product Benefits

Massive capacity

WD RE4 Enterprise SATA drives are available with up to 2 TB of cavernous capacity.

Dual processor

With double the processing power, WD RE4 boasts the highest performance of any drive in the WD RE family.

RAFF™

Enhanced RAFF technology includes sophisticated electronics to monitor the drive and correct both linear and rotational vibration in real time. The result is a significant performance improvement in high vibration environments over the previous generation of drives.

Dual actuator technology

A head positioning system with two actuators that improves positional accuracy over the data track(s). The primary actuator provides coarse displacement using conventional electromagnetic actuator principles. The secondary actuator uses piezoelectric motion to fine tune the head positioning to a higher degree of accuracy. (2 TB only)

StableTrac™

The motor shaft is secured at both ends to reduce system-induced vibration and stabilize platters for accurate tracking during read and write operations. (1 TB and larger drives only)

IntelliSeek™

Calculates optimum seek speeds to lower power consumption, noise, and vibration.

Multi-axis shock sensor

Automatically detects the subtlest shock events and compensates to protect the data.

RAID-specific, time-limited error recovery (TLER)

Prevents drive fallout caused by the extended hard drive error-recovery processes common to desktop drives.

NoTouch™ ramp load technology

The recording head never touches the disk media ensuring significantly less wear to the recording head and media as well as better drive protection in transit.

Thermal extended burn-in test

Each drive is put through extended burn-in testing with thermal cycling to ensure reliable operation.

Third generation dynamic fly height

Each read-write head's fly height is adjusted in real time for optimum reliability.

24x7 reliability

With 1.2 million hours MTBF (tested at 100% duty cycle), these drives have the highest available reliability rating on a high-capacity drive.

Applications

Ideal for servers, storage arrays, video surveillance, and other demanding applications.

PUT YOUR LIFE ON IT®

WD RE4

Specifications[1]	2 TB	1 TB	500 GB	250 GB
Model number	WD2003FYYS	WD1003FBYX	WD5003ABYX	WD2503ABYX
Interface	SATA 3 Gb/s	SATA 3 Gb/s	SATA 3 Gb/s	SATA 3 Gb/s
Formatted capacity	2 TB	1 TB	500 GB	251 GB
User sectors per drive	3,907,029,168	1,953,525,168	976,773,168	490,350,672
Native command queuing	Yes	Yes	Yes	Yes
SATA latching connector	Yes	Yes	Yes	Yes
Form factor	3.5-inch	3.5-inch	3.5-inch	3.5-inch
Performance				
Data transfer rate (max) Buffer to host Host to/from drive (sustained)	3 Gb/s 138 MB/s	3 Gb/s 128 MB/s	3 Gb/s 128 MB/s	3 Gb/s 128 MB/s
Cache (MB)	64	64	64	64
Rotational speed (RPM)	7200	7200	7200	7200
Average drive ready time (sec)	21	18	14	14
Configuration/Organization				
Heads/disks	8/4	4/2	2/1	1/1
Bytes per sector (STD)	512	512	512	512
Reliability/Data Integrity				
Load/unload cycles[2]	600,000	600,000	600,000	600,000
Non-recoverable read errors per bits read	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}
Limited warranty (years)[3]	5	5	5	5
Power Management				
12VDC (A, max)	1.8	1.6	2.25	2.25
Average power requirements (W) Read/Write Idle Standby Sleep	10.7 8.2 1.3 1.3	7.9 5.9 0.7 0.7	6.4 4.5 0.8 0.8	6.4 4.5 0.8 0.8
Environmental Specifications[4]				
Temperature (°C) Operating Non-operating	5 to 55 -40 to 70	5 to 55 -40 to 70	5 to 55 -40 to 70	5 to 55 -40 to 70
Shock (Gs) Operating (2 ms, read/write) Operating (2 ms, read) Non-operating (2 ms)	30 65 300	30 65 300	30 65 350	30 65 350
Average acoustics (dBA)[5] Idle mode Performance seek mode Quiet seek mode	29 34 30	28 33 29	27 30 29	27 30 29
Physical Dimensions				
Height (in./mm, max)	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1
Length (in./mm, max)	5.787/147	5.787/147	5.787/147	5.787/147
Width (in./mm, ± .01 in.)	4/101.6	4/101.6	4/101.6	4/101.6
Weight (lb./kg, ± 10%)	1.66/0.75	1.49/0.68	0.99/0.45	0.99/0.45

[1] As used for storage capacity, one megabyte (MB) = one million bytes, one gigabyte (GB) = one billion bytes, and one terabyte (TB) = one trillion bytes. Total accessible capacity varies depending on operating environment. As used for buffer or cache, one megabyte (MB) = 1,048,576 bytes. As used for transfer rate or interface, megabyte per second (MB/s) = one million bytes per second, and gigabit per second (Gb/s) = one billion bits per second. Effective maximum SATA 3 Gb/s transfer rate calculated according to the Serial ATA specification published by the SATA-IO organization as of the date of this specification sheet. Visit www.sata-io.org for details.

[2] Controlled unload at ambient condition

[3] The term of the limited warranty may vary by region. Visit support.wdc.com/warranty for details.

[4] No non-recoverable errors during operating tests or after non-operating tests.

[5] Sound power level.

Western Digital
3355 Michelson Drive, Suite 100
Irvine, California 92612
U.S.A.

For service and literature:
http://support.wdc.com
www.westerndigital.com

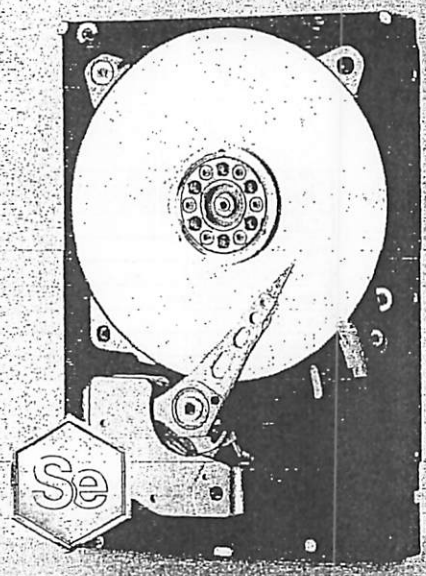
800.ASK.4WDC	North America
800.832.4778	Spanish
+800.6008.6008	Asia Pacific
00800.27549338	Europe (toll free where available)
+31.880062100	Europe/Middle East/Africa

Canada ICES-003 Class B / NMB-003 Classe B

2879-701338-A06 Sep 2011

Exhibit G

WD Se™
Datacenter Capacity HDD



High-performance, high-capacity storage for mid-intensity applications.

WD's Se datacenter capacity HDD is an ideal solution for scale-out datacenters, delivering a cost-effective combination of performance, capacity, and workload capability, while maintaining the hardiness of a true enterprise-class design. All WD datacenter storage devices are designed from the ground up to deliver optimal performance and maximum data integrity while running 24x7x365 in demanding multi-slot environments.

INTERFACE	FORM FACTOR	ROTATIONAL SPEED	CAPACITIES
SATA 6 Gb/s	3.5-inch	7200 RPM	1 TB to 6 TB

MODEL NUMBERS

WD6001F9YZ	WD3000F9YZ
WD5001F9YZ	WD2000F9YZ
WD4000F9YZ	WD1002F9YZ

Product Benefits

Cost effective enterprise-class storage
Get the right blend of performance, reliability and capacity and optimize your total cost of ownership.

24x7x365 reliability
Choose the storage foundation specifically designed for large-scale datacenter replication environments running 24x7x365.

High capacity for hyperscale environments
Build a massive data footprint with capacities up to 6 TB - 216 TB per square foot.

Designed for quality and reliability
Datacenter drives undergo at least 5 million hours of functional testing, and over 20 million hours of comprehensive interoperability testing in an extensive array of server and storage systems. Please see the product AVL list on our website for more information.

Dynamic fly height technology
Each read-write head's fly height is adjusted in real time for optimum reliability.

Vibration Protection
Enhanced RAFF™ technology includes sophisticated electronics to monitor the drive and correct both linear and rotational vibration in real time. The result is a significant performance improvement in high vibration environments over desktop drives.

Dual actuator technology (2 TB and above)
A head positioning system with two actuators that improves positional accuracy over the data track(s). The primary actuator provides coarse displacement using conventional electromagnetic actuator principles. The secondary actuator uses piezoelectric motion to fine tune the head positioning to a higher degree of accuracy.

StableTrac™
The motor shaft is secured at both ends to reduce system-induced vibration and stabilize platters for accurate tracking during read and write operations. (2 TB and above)

Multi-axis shock sensor
Automatically detects the subtlest shock events and compensates to protect the data.

RAID-specific, time-limited error recovery (TLER)
Reduces drive fallout caused by the extended hard drive error-recovery processes common to desktop drives.

NoTouch™ ramp load technology
The recording head never touches the disk media ensuring significantly less wear to the recording head and media as well as better drive protection in transit.

Thermal extended burn-in test
Each drive is put through extended burn-in testing with thermal cycling to ensure reliable operation.

Advanced Format (AF)
Technology adopted by WD and other drive manufacturers as one of multiple ways to continue growing hard drive capacities. AF is a more efficient media format that enables increased areal densities.

Applications

Ideal for bulk cloud storage, distributed file systems, replicated environments, cost-efficient RAID architectures, and content delivery networks (CDNs).

The WD Advantage

WD puts our datacenter products through extensive Functional Integrity Testing (F.I.T.) prior to any product launch. This testing ensures our products consistently meet the high quality and reliability standards of the WD brand. Following a FIT test the Enterprise System Group (ESG) testing validates interoperability with HBAs, operating systems and drivers to ensure an even greater level of quality, reliability and peace of mind.

WD also has a detailed Knowledge Base with helpful articles and software utilities. Our customer support lines have long operational hours to ensure you get the help you need when you need it. Our toll-free customer support lines are here to help or you can access our WD Support site for additional details.

WD Se™

Specifications	6 TB	5 TB	4 TB	3 TB	2 TB	1 TB
Model number[1]	WD6001F9YZ	WD5001F9YZ	WD4000F9YZ	WD3000F9YZ	WD2000F9YZ	WD1002F9YZ
Interface	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s
Formatted capacity[2]	6 TB	5 TB	4 TB	3 TB	2 TB	1 TB
User sectors per drive	11,721,045,168	9,767,541,168	7,814,037,168	5,860,533,168	3,907,029,168	1,953,525,168
Form factor	3.5-inch	3.5-inch	3.5-inch	3.5-inch	3.5-inch	3.5-inch
Advanced Format	Yes	Yes	Yes	Yes	Yes	Yes
Native command queuing	Yes	Yes	Yes	Yes	Yes	Yes
RoHS compliant[3]	Yes	Yes	Yes	Yes	Yes	Yes
Performance						
Data transfer rate (max) Buffer to host Host to/from drive (sustained)	6 Gb/s 214 MB/s	6 Gb/s 194 MB/s	6 Gb/s 171 MB/s	6 Gb/s 168 MB/s	6 Gb/s 164 MB/s	6 Gb/s 187 MB/s
Cache (MB)	128	128	64	64	64	128
Rotational speed (RPM)	7200	7200	7200	7200	7200	7200
Reliability/Data Integrity						
Load/unload cycles[4]	300,000	300,000	300,000	300,000	300,000	300,000
Non-recoverable read errors per bits read	<1 in 10^{14}	<1 in 10^{14}	<1 in 10^{14}	<1 in 10^{14}	<1 in 10^{14}	<1 in 10^{14}
MTBF (hours)[5]	1,000,000	1,000,000	1,000,000	1,000,000	1,000,000	800,000
MTBF (hours) for 1-5 bay NAS[6]	1,200,000	1,200,000	1,200,000	1,200,000	1,200,000	1,000,000
Limited warranty (years)[7]	5	5	5	5	5	5
Power Management						
Average power requirements (W) Sequential read Sequential write Random read/write Idle	9.2 9.1 8.7 7.4	9.2 9.1 8.7 7.4	9.5 9.5 9.5 8.1	9.5 9.5 9.5 8.1	7.2 7.2 7.3 5.9	6.2 6.2 7.1 4.6
Environmental Specifications[8]						
Temperature (°C) Operating Non-operating	5 to 60 -40 to 70	5 to 60 -40 to 70	5 to 55 -40 to 70	5 to 55 -40 to 70	5 to 55 -40 to 70	5 to 55 -40 to 70
Shock (Gs) Operating (2 ms, read/write) Operating (2 ms, read) Non-operating (2 ms)	30 65 300	30 65 300	30 65 300	30 65 300	30 65 300	30 65 300
Acoustics (dBA)[9] Idle Seek (average)	31 34	31 34	31 34	31 34	31 34	30 34
Physical Dimensions						
Height (in./mm, max)	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1
Length (in./mm, max)	5.787/147	5.787/147	5.787/147	5.787/147	5.787/147	5.787/147
Width (in./mm, ± .01 in.)	4/101.6	4/101.6	4/101.6	4/101.6	4/101.6	4/101.6
Weight (lb./kg, ± 10%)	1.58/0.72	1.58/0.72	1.66/0.75	1.66/0.75	1.55/0.70	0.99/0.45

[1] Not all products may be available in all regions of the world.

[2] As used for storage capacity, one megabyte (MB) = one million bytes, one gigabyte (GB) = one billion bytes, and one terabyte (TB) = one trillion bytes. Total accessible capacity varies depending on operating environment. As used for buffer or cache, one megabyte (MB) = 1,048,576 bytes. As used for transfer rate or interface, megabyte per second (MB/s) = one million bytes per second, and gigabit per second (Gb/s) = one billion bits per second. Effective maximum SATA 6 Gb/s transfer rate calculated according to the Serial ATA specification published by the SATA-IO organization as of the date of this specification sheet. Visit www.sata-io.org for details.

[3] WD hard drive products manufactured and sold worldwide after June 8, 2011, meet or exceed Restriction of Hazardous Substances (RoHS) compliance requirements as mandated by the RoHS Directive 2011/65/EU.

[4] Contactless unload at ambient condition.

[5] Product MTBF and AFR specifications are based upon a 40°C base casting and system workloads of up to 180 TB/year (workload is defined as the amount of user data transferred to or from the hard disk).

[6] Based on a typical 1-5 bay tabletop NAS product enclosure at under normal operating conditions.

[7] See http://support.wd.com/warranty for regional specific warranty details.

[8] No non-recoverable errors during operating tests or after non-operating tests.

Western Digital Technologies, Inc.
3355 Michelson Drive, Suite 100
Irvine, California 92612
U.S.A.

For service and literature:
http://support.wd.com
www.wd.com

800.ASK.4WDC (800.275.4932)	North America
800.832.4778	Spanish
+86.21.2603.7560	Asia Pacific
00800.27549338	Europe (toll free where available)
+31.880062100	Europe/Middle East/Africa

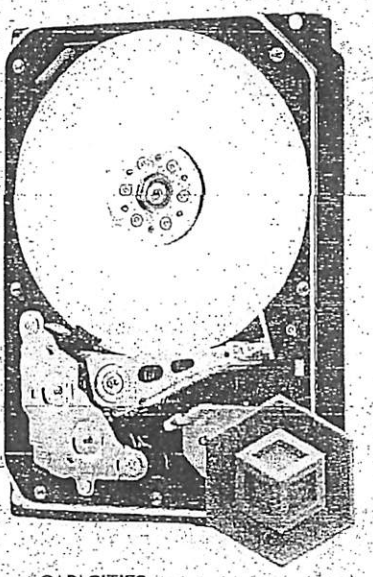
CAN ICES-3 (B) / NMB-3 (B)

28/9-800042-A01 July 2015

Exhibit H

WD Gold™

Enterprise-class Hard Drives



Drive to endure.

WD Gold hard drives feature up to ten times the workload rating[1] of desktop drives and employ advanced technologies for enterprise-class reliability, power efficiency and performance. Designed from the ground up to be an ultra-robust storage device, WD Gold drives are the perfect solution for your business.

INTERFACE	WIDTH/HEIGHT	PERFORMANCE CLASS	CAPACITIES
SATA 6 Gb/s	3.5-inch /1-inch	7200 RPM Class	1TB to 12TB

MODEL NUMBERS

WD121KRYZ
WD101KRYZ
WD8003FRYZ
WD6002FRYZ
WD4002FYYZ
WD2005FBYZ
WD1005FBYZ

Product Benefits

High workload rating
Delivering dependable performance to any storage environment, WD Gold™ hard drives are designed with a workload rating up to 550TB per year[1], among the highest of any 3.5-inch hard drive.

Enterprise-class storage to rely on
With up to 2.5 million hours MTBF, WD Gold hard drives deliver reliability and durability, are built for yearly operation (24x7x365) within the most demanding storage environments, and are backed with a 5 year limited warranty.

HelioSeal™ Technology
Featured in over 15 million Western Digital hard drives shipped[2], HelioSeal™ technology allows for higher capacities and less turbulence on large storage arrays. And now on its 4th generation design, HelioSeal™ technology is field-tested and proven to deliver high capacity, reliability, and power *efficiency you can trust.*

Vibration protection
Enhanced RAFF™ technology uses sophisticated electronics to monitor the drive and correct linear and rotational vibrations in real time for improved performance versus WD's desktop drives in high-vibration environments.

RAID-specific, time-limited error recovery (TLER)
Reduces drive fallout caused by the extended hard drive error-recovery processes common to desktop drives.

Dynamic fly height technology
Each read-write head's fly height is adjusted in real time to ensure consistent performance for reduced errors and optimized reliability.

Dual-stage actuator technology
WD Gold drives feature a dual-stage actuator head positioning system for a high degree of accuracy. The primary stage provides course displacement while the secondary stage uses piezoelectric motion to fine tune the head positioning to a higher degree of precision.

Compatibility testing
All WD Gold hard drives are extensively tested across a variety of popular OEM storage systems, SATA controllers, and host bus adapters to ensure ease of integration for a plug and play solution.

7200RPM-Class
This 7200RPM-class hard drive delivers the fastest performance with the highest workload rating of any HDD in WD's lineup. Ensure you have the most capable hard drive regardless of the application with WD Gold.

Applications

Enterprise servers and storage systems; mission-critical applications needing reliable, robust high capacity storage; high-end surveillance and industrial applications; long product life cycle and managed PCN.

The WD Advantage

WD puts products through extensive Functional Integrity Testing (F.I.T.) prior to any product launch. This testing ensures our products consistently meet the high quality and reliability standards of the WD brand. Following a FIT test the Enterprise System Group (ESG) testing validates interoperability with HBAs, operating systems, and drivers, to ensure an even greater level of quality, reliability, and peace of mind.

WD also has a detailed Knowledge Base with helpful articles and software utilities.

WD Gold™

Specifications	12TB	10TB	8TB	6TB	4TB	2TB	1TB
512 emulation model number[3]	WD121KRYZ	WD101KRYZ	WD8003FRYZ	WD6002FRYZ			
512 native model number[3]					WD4002FYYZ	WD2005FBYZ	WD1005FBYZ
Logical/Physical bytes per sector	512 / 4096	512 / 4096	512 / 4096	512 / 4096	512 / 512	512 / 512	512 / 512
Formatted capacity[4]	12TB	10TB	8TB	6TB	4TB	2TB	1TB
512n/512e user sectors per drive	23,437,770,752	19,532,873,728	15,628,053,168	11,721,045,168	7,814,037,168	3,907,029,168	1,953,525,168
Interface[4]	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s	SATA 6 Gb/s
Native Command Queuing	Yes	Yes	Yes	Yes	Yes	Yes	Yes
Form Factor	3.5-inch	3.5-inch	3.5-inch	3.5-inch	3.5-inch	3.5-inch	3.5-inch
RoHS compliant[5]	Yes	Yes	Yes	Yes	Yes	Yes	Yes
Performance							
Data transfer rate (max)[4]							
Buffer to host	6 Gb/s	6 Gb/s	6 Gb/s	6 Gb/s	6 Gb/s	6 Gb/s	6 Gb/s
Host to/from drive (sustained)	255 MB/s	249 MB/s	225 MB/s	226 MB/s	201 MB/s	200 MB/s	184 MB/s
Cache (MB)	256	256	256	128	128	128	128
Performance Class	7200 RPM Class	7200 RPM Class	7200 RPM Class	7200 RPM Class	7200 RPM Class	7200 RPM Class	7200 RPM Class
Reliability/Data Integrity							
Load/unload cycles[6]	600,000	600,000	600,000	600,000	600,000	600,000	600,000
Non-recoverable read errors per bits read	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}	<1 in 10^{15}
MTBF (hours)	2,500,000 [7]	2,500,000 [7]	2,500,000 [7]	2,000,000 [7]	2,000,000 [7]	2,000,000 [7]	2,000,000 [7]
AFR (%)	0.35 [7]	0.35 [7]	0.35 [7]	0.44 [7]	0.44 [7]	0.44 [7]	0.44 [7]
Limited warranty (years)[8]	5	5	5.	5	5	5	5
Power Management							
Average power requirements (W)							
Sequential read	7.0	7.1	7.1	9.3	9.0	7.4	7.4
Sequential write	6.8	6.7	6.7	8.9	8.7	7.4	7.4
Random read/write	6.9	6.8	6.8	9.1	8.8	8.1	8.1
Idle	5.0	5.0	5.0	7.1	7.0	5.9	5.9
Environmental Specifications [9]							
Temperature (°C)							
Operating	5 to 60	5 to 60	5 to 60	5 to 60	5 to 60	5 to 60	5 to 60
Non-operating	-40 to 70	-40 to 70	-40 to 70	-40 to 70	-40 to 70	-40 to 70	-40 to 70
Shock (Gs)							
Operating (half-sine wave, 2 ms)	70G	70G	70G	70G	70G	65G	65G
Non-operating (half-sine wave)	300 (2ms)/150 (11ms)	300 (1ms)/150 (11ms)	300 (1ms)/150 (11ms)	300 (1ms)/150 (11ms)	300 (1ms)/150 (11ms)	300 (2ms)	300 (2ms)
Acoustics (dBA) [10]							
Idle	20	20	20	29	29	25	25
Seek (average)	36	36	36	36	36	28	28
Physical Dimensions							
Height (in./mm, max)	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1	1.028/26.1
Length (in./mm, max)	5.787/147	5.787/147	5.787/147	5.787/147	5.787/147	5.787/147	5.787/147
Width (in./mm, ± .01 in.)	4/101.6	4/101.6	4/101.6	4/101.6	4/101.6	4/101.6	4/101.6
Weight (lb/kg, ± 10%)	1.46/0.66	1.46/0.66	1.46/0.66	1.58/0.715	1.58/0.715	1.41/0.641	1.41/0.641

[1] Workload Rate is defined as the amount of user data transferred to or from the hard drive. Workload Rate is annualized (TB transferred X (8760 / recorded power-on hours)). Workload Rate will vary depending on your hardware and software components and configurations.

[2] As of April 2017.

[3] Not all products may be available in all regions of the world.

[4] As used for storage capacity, one megabyte (MB) = one million bytes, one gigabyte (GB) = one billion bytes, and one terabyte (TB) = one trillion bytes. Total accessible capacity varies depending on operating environment. As used for buffer or cache, one megabyte (MB) = 1,048,576 bytes. As used for transfer rate or interface, megabyte per second (MB/s) = one million bytes per second, and gigabit per second (Gb/s) = one billion bits per second. Effective maximum SATA 6 Gb/s transfer rate calculated according to the Serial ATA specification published by the SATA-IO organization as of the date of this specification sheet. Visit www.sata-io.org for details.

[5] WD hard drive products manufactured and sold worldwide after June 8, 2011, meet or exceed Restriction of Hazardous Substances (RoHS) compliance requirements as mandated by the RoHS Directive 2011/65/EU.

[6] Controlled unload at ambient condition.

[7] Product MTBF and AFR specifications are based upon a 40°C base casting temperature and typical system workload rate of 219TB/year. Product is designed for workload rates up to 550TB/year.

[8] See http://support.wd.com/warranty for regional specific warranty details.

[9] No non-recoverable errors during operating tests or after non-operating tests.

[10] Sound power level.

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http://support.wd.com
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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

WALTER A. TORMASI, Plaintiff, v. WESTERN DIGITAL CORPORATION, Defendant.	Case Number: 4:19-CV-00772-HSG **DEFENDANT WESTERN DIGITAL CORPORATION'S MOTION TO DISMISS [FRCP 12(B)1, FRCP 12(B)(6) AND FRCP 17(B)]** Date: August 22, 2019 Time: 2:00 p.m. Judge: Hon. Haywood S. Gilliam, Jr. Courtroom: 2, 4th Floor

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NOTICE OF MOTION

Defendant Western Digital Corporation ("WDC") hereby gives notice that on August 22, 2019, at 2:00 p.m., in Courtroom 2, 4th Floor, 1301 Clay Street, Oakland, CA 94612, before the Honorable Haywood S. Gilliam, Jr., WDC will and hereby does move under Rule 12(b)(1) of the Federal Rules of Civil Procedure ("FRCP") for an order dismissing the February 12, 2019 Complaint ("Complaint") (ECF 1) filed by Walter A. Tormasi ("Plaintiff" or "Tormasi") based on Tormasi's lack of standing to sue. WDC will and does further move under FRCP 17(b) for an order dismissing the Complaint based on Tormasi's lack of capacity to sue. WDC will and does further move for an order pursuant to FRCP 12(b)(6) for an order dismissing the claims of willful infringement and indirect infringement (if Tormasi contends the Complaint makes such claims).

RELIEF SOUGHT

WDC seeks dismissal of this action pursuant to FRCP 12(b)(1) and or FRCP 17(b) due to Tormasi's lack of standing and lack of capacity to sue. If the Court concludes that Tormasi *does* have standing and capacity, WDC seeks dismissal of Tormasi's willful infringement claim, and any claims for indirect infringement Tormasi contends were pled under Fed.R.Civ.P. 12(b)(6) for failure to state a claim.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Tormasi's suit for infringement of U.S. Patent No. 7,324,301 ("the '301 Patent") should be dismissed because Tormasi lacks both standing and capacity to bring this suit. Tormasi filed the instant action *pro se* from the New Jersey State Prison where he is serving a life sentence. Tormasi purports to have assigned the '301 Patent from Advanced Data Solutions Corporation ("ADS") – a Delaware corporation that per the patent office's records is the current owner of the '301 Patent – to himself in his capacity as ADS's "President" and "Sole Shareholder." The assignment, however, is invalid because there is not a scrap of evidence that Tormasi is President or sole shareholder of ADS or that Tormasi had the authority to assign the '301 Patent from ADS

to himself. And, by Tormasi's own admission in prior lawsuits, he does not possess the documents necessary to prove his ownership of ADS. The patent office's records show that ADS, not Tormasi, owns the '301 Patent. Tormasi, therefore, lacks standing to bring this patent infringement suit.

While this issue alone bars Tormasi's lawsuit, there are at least two additional, independent reasons why Tormasi lacks standing or capacity to sue. First, ADS has been in a void status since March 1, 2008 and was in a void status when Tormasi purported to assign the '301 Patent from ADS to himself. Thus, under Delaware law, ADS has been stripped of all of the powers previously conferred on it by Delaware, which include the power to "sell, convey, lease, exchange, transfer or otherwise dispose of, or mortgage or pledge, all or any of its property and assets." *See* 8 Del. C. § 122(4). Accordingly, even if Tormasi could show that he had the authority to assign ADS's patent to himself, because ADS lacked the power to transfer its property, the January 30, 2019 assignment is invalid.

Second, "it is a prohibited act in New Jersey state prisons for an inmate to operate a business or a nonprofit enterprise without the approval" of the prison administrator. *Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2009 U.S. Dist. LEXIS 50560, at *22 (D.N.J. June 16, 2009) ("Tormasi I") (citing N.J.A.C. 10A:4-4.1, .705) (Ex. 1). [1] In view of this law, in March 2007, prison officials confiscated as contraband documents in Tormasi's possession concerning ADS, the '301 Patent, and an unfiled provisional application. In suits filed by Tormasi seeking their return, the New Jersey federal court and the Third Circuit, affirming New Jersey's prohibition against inmates operating businesses, approved the seizure of these documents.

Tormasi's patent infringement suit – in which he claims to be an "entrepreneur" and is seeking $15 billion in damages (ECF 1 at 1, ¶ 1 & 12-13 "Prayer for Relief" ¶¶ (D-E)) – is plainly in furtherance of his efforts to monetize the '301 Patent. The New Jersey federal court and the Third Circuit have already found that Tormasi's patent licensing and monetization efforts

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[1] "Ex. __" refers to Exhibits to the Declaration of Erica D. Wilson in Support of WDC's Motion to Dismiss ("Wilson Decl.") filed concurrently herewith.

constitute prohibited business operations. Tormasi's attempt to circumvent these findings by pursuing his patent monetization business as an individual rather than under the auspices of ADS does not alter the fact that this litigation is in furtherance of his business interests and is prohibited under New Jersey law. Tormasi's Complaint, therefore, should be dismissed for the additional reason that he lacks the capacity to sue since he is prohibited from conducting a business while incarcerated.

If the lawsuit is not dismissed in its entirety, Tormasi's claims of willful infringement should be dismissed because Tormasi's Complaint fails to plausibly allege that (1) WDC had pre-suit knowledge of the '301 Patent and its alleged infringement, and (2) the requisite "egregious" behavior to support such a claim. Instead, of plausibly pleading facts, Tormasi relies on rank speculation, unwarranted deductions of fact and unreasonable inferences that fall far short of plausibly pleading willful infringement. It is unclear whether Tormasi alleges indirect infringement. To extent he does, Tormasi's indirect infringement claims should also be dismissed for failure to state a claim

II. STATEMENT OF ISSUES TO BE DECIDED

1. Whether Tormasi's Complaint should be dismissed pursuant to FRCP 12(b)(1) for lack of standing to sue under Article III of the U.S. Constitution.

2. Whether Tormasi's Complaint should be dismissed because he lacks the capacity to sue.

3. Whether Tormasi's claim for willful infringement of the '301 Patent should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

4. Whether Tormasi's claims for indirect infringement of the '301 Patent (to the extent Tormasi contends the Complaint makes such claims) should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

III. FACTUAL BACKGROUND

A. The Patent-in-Suit

Plaintiff Tormasi is an inmate at the New Jersey State Prison in Trenton, New Jersey where he has been serving a life sentence since 1998. *See State v. Tormasi,* 443 N.J. Super 146, 149 (App.Div. 2015). Tormasi filed this suit for infringement of the '301 Patent against WDC on February 12, 2019. ECF 1. Tormasi's Complaint asserts that he is an "innovator and entrepreneur" and that "one of [his] inventions resulted in the issuance of U.S. Patent No. 7,324,301." ECF 1, ¶1 & Ex. C.

The face page of the '301 Patent states that it issued on January 29, 2008 and lists Walter A. Tormasi as Inventor. *Id.* It also states that the application for the '301 patent, U.S. Patent Application Ser. No. 11/031,878, was filed on January 10, 2005, and claims priority to Provisional application No. 60/568,346 (the "Provisional Application.") *Id.*

B. Tormasi Assigned the Application for the '301 Patent and Its "Progeny" to Advanced Data Solutions Corporation ("ADS")

On February 7, 2005, "[f]or consideration received," Tormasi assigned, transferred and conveyed "complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny" to "ADVANCED DATA SOLUTIONS CORP." Ex. 2. The assignment document was notarized and recorded (twice) in the United States Patent and Trademark Office ("PTO"). *Id.* The face page of the '301 Patent lists ADS as the patent's Assignee (ECF 1, Ex. C.) and the PTO's assignment records currently list ADS as the owner of the '301 Patent. Ex. 2.

C. ADS is A Delaware Corporation

In a December 1, 2008 Complaint ("2008 Complaint") filed by Tormasi against prison officials, Tormasi alleged ADS was a Delaware corporation. Ex. 3 ¶6. The Delaware Secretary of State's records show ADS was incorporated on April 19, 2004 by Angela Norton whose address is listed as that of an entity called The Company Corporation. Ex. 4. The Delaware Secretary of State also has two records of Franchise Tax Payments for ADS made in 2004 and 2005. Ex. 5.

These documents do not identify any officer, director or stockholder of ADS, and do not identify Tormasi as having any interest in ADS. *See* Exs. 4 & 5.

The February 7, 2005 assignment recorded with the PTO lists ADS's address as 105 Fairview Avenue, Somerville, New Jersey 08876 ("Fairview Avenue"). Ex. 2. Fairview Avenue is a property that was owned by Attila Tormasi or Tormasi Housing Somerville, LLC (of which Attila Tormasi was the sole member) prior to ADS's formation and until Attila Tormasi's death. Exs. 7 (deed conveying Fairview Avenue to TDKH and showing chain of title on sixth page), Ex. 8. Fairview Avenue was subsequently transferred to TDKH, LLC whose members include Kuldip Dhillon and Tejinder Dhillon. Exs. 7, 9.

In the 2008 Complaint, Tormasi alleged ADS was "an intellectual-property holding company," and that he was "the sole shareholder of ADS" and its "agent." Ex. 3 ¶¶6-7. Tormasi, however, provided no documents to support his contentions concerning ownership of ADS.

The 2008 Complaint also alleges that ADS had a "principal office and mailing address at 1828 Middle Road, Martinsville, New Jersey 08836" ("Middle Road"). Ex. 3 ¶6. Middle Road is a single-family home that was owned by Tormasi's father, Attila Tormasi, prior to ADS's incorporation until his death, when it was transferred on January 25, 2011 to Matthew Northrup. Ex. 6 (deed conveying Middle Road to Northrup and showing title chain on first page).

D. ADS is and Has Been In a "Void" Status Since March 2008

The Delaware Secretary of State's records show that ADS has been in a "void" status, and thus prohibited from transacting business since March 1, 2008. Ex. 10.

E. Tormasi's Civil Lawsuits

1. Tormasi's December 2008 Lawsuit for Alleged Violations of His Constitutional Rights

On December 1, 2008, Tormasi filed the 2008 Complaint on behalf of himself and ADS against prison officials alleging various civil rights and constitutional violations stemming from the March 3, 2007 seizure by prison officials of Tormasi's personal property. *See, e.g.*, Ex. 3 ¶¶8, 13-15. Tormasi alleged the confiscated property included *inter alia* ADS corporate paperwork,

patent prosecution documents for the '301 Patent, "an unfiled provisional patent application" and "various legal correspondence." Ex. 3 ¶ 15, 19-35.

In particular, Tormasi alleged that, while confined at New Jersey State Prison, he filed the Provisional Application with the PTO (*id.* ¶¶19-20(a)), and on May 17, 2004, assigned his entire interest in the Provisional Application to ADS in exchange for all outstanding shares of ADS common stock (the "2004 Assignment"). *Id.* ¶20(b). Tormasi alleged that due to this transaction he was "the sole owner of ADS, and ADS correspondingly owns all applications and patents stemming from [the Provisional Application]." *Id.*

Tormasi alleged the confiscated documents included the 2004 Assignment, "corporate resolutions authorizing, ratifying, and adopting" the 2004 Assignment, "stock certificates; shareholder ledgers; minutes of shareholder meetings; tax information and forms; and other related legal documents." *Id.* ¶21. Tormasi claimed that absent such documents he "cannot prove his ownership of ADS to the satisfaction of interested third parties," and stated:

> Absent such proof of ownership of ADS, plaintiff Tormasi is unable to directly or indirectly benefit from his intellectual-property assets, either by selling all or part of ADS; by exclusively or non-exclusively licensing his '301 patent to others . . . or by engaging in other monetization transactions involving ADS or its intellectual-property assets. *Id.* ¶22(a)

Tormasi further alleged the confiscation of his corporate documents prevented him from filing tax returns with the Internal Revenue Service on behalf of ADS. *Id.* ¶22(b). And, Tormasi alleged the confiscation of patent prosecution documents injured him and ADS because they "intend[ed] to enforce their rights under their '301 patent by filing infringement actions . . ." (*id.* ¶27(a)), and absent these documents they could not do so, thus preventing him and ADS from benefiting from the '301 Patent. *Id.* ¶27(a)-(b).

2. The New Jersey District Court *Sua Sponte* Dismissed Tormasi's Claims *Inter Alia* Because New Jersey Inmates are Prohibited From Operating Businesses

On June 15, 2009, the district court dismissed ADS's claims *sua sponte* finding "that a corporation may appear in the federal courts only through licensed counsel," and thus Tormasi could not pursue claims on behalf of ADS. Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *11-12.

The district court also dismissed Tormasi's claims *sua sponte*, with the exception of a claim involving documents Tormasi alleged he required to file an action for post-conviction relief. *Id.* at *28. In considering Tormasi's claims, the district court noted "it is a prohibited act in New Jersey state prisons for an inmate to operate a business or a nonprofit enterprise without the approval of the Administrator." *Id.* at *22 (citing N.J.A.C. 10A:4-4.1, .705.) The district court also confirmed that Tormasi had no federal or state constitutional right to conduct a business from prison and "had no constitutional right to file tax returns or engage in litigation in connection with the business of ADS." *Id.* at *21-22.

The court further found, "the provisions of the New Jersey Administrative Code prohibiting prisoners from operating a business, considered in conjunction with Plaintiff Tormasi's failure to allege that he was given permission to conduct a business, is as likely a motivation for the confiscation of Plaintiff Tormasi's business records." *Id.* at *23.

The Court dismissed:

> Plaintiff Tormasi's claim that he had been deprived of a constitutional right to conduct a business while incarcerated (including all related claims such as the related claims that he has a constitutional right to communicate with the U.S. Office of Patents and Trademarks regarding patent applications, and to communicate with counsel regarding the conduct of the business, and to conduct litigation with respect to the business, and to prepare and submit tax returns on behalf of the business) . . . .

Tormasi v. Hayman, Civil Action No. 08-5886 (JAP), 2011 U.S. Dist. LEXIS 25849, at *15 (D.N.J. Mar. 14, 2011) ("Tormasi II") (Ex. 11) (summarizing holding in Tormasi I).

The Court also noted that despite Tormasi's desire to pursue patent infringement litigation, he failed to state a claim for denial of access to courts because "impairment of the capacity to litigate with respect to personal business interests is 'simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration.'" Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *14-15 (quoting *Lewis v. Casey*, 518 U.S. 343, 355 (1996)).

3. Tormasi's July 24, 2009 Amended Complaint

On July 24, 2009 Tormasi filed a "1st Amended Complaint" on behalf of himself and ADS largely reiterating the allegations and claims of the December 2008 Complaint, and

including a new claim for violation of his First Amendment free speech rights. Ex. 12. On Defendants' Motion to Dismiss, the court dismissed – again – Tormasi's claims. *See* Tormasi II, 2011 U.S. Dist. LEXIS 25849, at *39.

The court also dismissed Tormasi's claim that the confiscation of his documents "violat[ed] his rights to freedom of speech under the First Amendment." *Id.* at *28, *34. In so doing, the court reiterated that Tormasi had no federal constitutional right to conduct a business in prison (*id.* at *31) and reiterated New Jersey's "no-business" rule. *Id.* at *28-29 (citing N.J.A.C. 10A:4-4.1, .705). The court highlighted the "rational connection between the no-business rule and the legitimate penological objective of maintaining security and efficiency at state correctional institutions," noting *inter alia* that "operating a business inside a correctional facility would seriously burden operation of incoming and outgoing mail procedures," and "could result in the introduction of contraband into prisons." *Id.* at *32.

4. The Third Circuit Affirmed the New Jersey's Application of the No-Business Rule to Tormasi's Unfiled Patent Application

Tormasi appealed the district court's judgment concerning his unfiled patent application, arguing that the confiscation of the application interfered with his statutory right to file to apply for a patent and violated his First Amendment rights to free speech. *See Tormasi v. Hayman*, 443 F. App'x. 742, 744-45 (3d Cir. 2011) (Ex. 13). The Third Circuit recognized that prison officials "confiscated Tormasi's patent application pursuant to a prison regulation that prohibited 'commencing or operating a business or group for profit or commencing or operating a nonprofit enterprise without the approval of the Administrator.' N.J.A.C. 10A:4-4.1(.705)." *Id.* at 745.

The Court confirmed the propriety of the prison's actions finding that in Tormasi's case his intentions with respect to the unfiled application, as stated in his Complaints, showed that Tormasi intended to file the patent application in furtherance of operating a business. *Id.* The Court focused on Tormasi's allegations in his complaints that: (1) he had filed two patent applications entitled "Striping data simultaneously across multiple platter services" and assigned to ADS his entire interest in the applications; and (2) due to the confiscation of paperwork pertaining to the '301 Patent and ADS, he could not benefit from the intellectual-property assets

– *e.g.*, by selling ADS or licensing the patents, using ADS or the '301 patent as collateral, or by engaging in other monetization transactions involving ADS or its intellectual-property assets. *Id.*

The Third Circuit found it notable that Tormasi stated that he "intends to assign his confiscated provisional application and any derivate patents to plaintiff ADS . . .." *Id.* The Court held that "[u]nder these circumstances . . . the District Court did not err in holding that Tormasi's intentions regarding the unfiled patent application qualified under the regulation as 'commencing or operating a business or group for profit,'" and concluded that "the confiscation of the unfiled patent application did not violate his statutory or constitutional rights." *Id.*

F. Tormasi's Alleged Assignment of the '301 Patent From ADS to Himself

On January 30, 2019, Tormasi purported to assign the '301 Patent from ADS to himself in his supposed capacity as ADS's "President" and "Sole Shareholder" ECF 1 Ex. A. Tormasi alleges that he has standing to sue as the named inventor on the '301 Patent and by virtue of this alleged assignment. ECF 1 ¶¶7-8, Ex. A.

IV. LEGAL STANDARDS

A. Standing Challenges are Properly Brought Under FRCP 12(b)(1)

"A suit brought by a plaintiff without Article III standing is not a 'case or controversy,' and an Article III federal court therefore lacks subject matter jurisdiction over the suit." *Cetacean Cmty. v. Bush*, 386 F.3d 1169, 1174 (9th Cir. 2004) (citationsomitted). "In that event, the suit should be dismissed under Rule 12(b)(1)." *Id*; *see also White v. Lee*, 227 F.3d 1214, 1242 (9th Cir. 2000) (finding that standing "pertain[s] to a federal court's subject-matter jurisdiction under Article III" and thus is "properly raised in a motion to dismiss under Federal Rule of Civil procedure 12(b)(1), not Rule 12(b)(6)") (citations omitted).

B. On a "Factual" Challenge to Jurisdiction under Rule 12(b)(1) the Court Resolves Disputed Factual Issues Relevant to Jurisdiction

Pursuant to Rule 12(b)(1), a jurisdictional challenge may be "facial" or "factual." *Leite v. Crane Co.*, 749 F.3d 1117, 1121 (9th Cir. 2014). "A 'facial' attack accepts the truth of the plaintiff's allegations but asserts that they are insufficient on their face to invoke federal jurisdiction." *Id.* (internal citations and quotations omitted). "A 'factual' attack, by contrast,

contests the truth of the plaintiff's factual allegations, usually by introducing evidence outside the pleadings." *Id.* (citations omitted).

Significantly, where a defendant factually attacks jurisdiction, "the Court need not presume the truthfulness of the plaintiff's allegations." *White*, 227 F.3d at 1242. On the contrary, "[i]n resolving a factual attack on jurisdiction, the district court may review evidence beyond the complaint without converting the motion to dismiss into a motion for summary judgment." *Safe Air For Everyone v. Meyer*, 373 F.3d 1035, 1039 (9th Cir. 2004) (citing *Savage v. Glendale Union High Sch.*, 343 F.3d 1036, 1039 n.2 (9th Cir. 2003)).

The plaintiff bears the burden of proving by a preponderance of the evidence that each of the requirements for subject-matter jurisdiction has been met. *Leite,* 749 F.3d at 1121. Thus, where the moving party makes a factual attack on jurisdiction "'by presenting affidavits or other evidence properly brought before the court,'" the party opposing a factual challenge to jurisdiction "'***must*** furnish affidavits or other evidence necessary to satisfy its burden of establishing subject matter jurisdiction.'" *Safe Air*, 373 F.3d at 1039 (quoting *Savage*, 343 F.3d at 1039 n.2) (emphasis added). "[I]f the existence of jurisdiction turns on disputed factual issues, the district court may resolve those factual disputes itself" (*Leite,* 749 F.3d at 1121-22) unless "the issue of subject-matter jurisdiction is intertwined with an element of the merits of the plaintiff's claim." *Id.*, fn.3 (citations omitted).

C. Standing in a Patent Infringement Suit Requires that the Plaintiff Show that He Had Title to the Patent at the Time the Suit Was Filed

Standing in a patent infringement suit requires possession of title for the patent at issue at the time the suit is brought. *Filmtec Corp. v. Allied*-Signal. *Inc.*, 939 F.2d 1568, 1571 (Fed. Cir. 1991). "[T]o assert standing for patent infringement, the plaintiff must demonstrate that it held enforceable title to the patent ***at the inception of the lawsuit.*** *Paradise Creations, Inc. v. UV Sales, Inc.*, 315 F.3d 1304, 1309 (Fed.Cir.2003) (emphasis in original); *see also Lans v. Digital Equip. Corp.*, 252 F.3d 1320 (Fed.Cir.2001) (affirming dismissal of plaintiff-inventor's complaint and denial of motion to amend pleadings to substitute patent assignee as plaintiff when plaintiff-inventor assigned the patent prior to filing the action).

D. Federal Rule of Civil Procedure 12(b)(6)

Under Federal Rule of Civil Procedure 12(b)(6), a district court must dismiss a complaint if it fails to state a claim upon which relief can be granted. To survive a Motion to Dismiss, a complaint must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible when a party pleads "factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *see also Twombly*, 550 U.S. at 555 ("Factual allegations must be enough to raise a right to relief above the speculative level."). Conclusory allegations or "formulaic recitation of the elements of a cause of action will not do." *Iqbal*, 556 U.S at 678 (citations and internal quotations omitted).

While courts generally "accept factual allegations in the complaint as true and construe the pleadings in the light most favorable to the nonmoving party" (*Manzarek v. St. Paul Fire & Marine Ins. Co.*, 519 F.3d 1025, 1031 (9th Cir. 2008)), "courts do ***not*** 'accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences.'" *Hypermedia Navigation v. Google LLC*, No. 18-cv-06137-HSG, 2019 U.S. Dist. LEXIS 56803, at *2-3 (N.D. Cal. Apr. 2, 2019) (Ex. 14) (quoting *Hartman v. Gilead Scis., Inc. (In re Gilead Scis. Sec. Litig.)*, 536 F.3d 1049, 1055 (9th Cir. 2008)) (emphasis added). Moreover, if the facts alleged do not support a reasonable inference of liability, stronger than a mere possibility, the claim must be dismissed. *Iqbal*, 556 U.S. at 678-79.

E. Willful Infringement

Willful infringement is reserved for "egregious infringement behavior," which is typically described as "willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or –indeed—characteristic of a pirate." *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016). To state a claim for willful infringement, a plaintiff must plead (1) defendant had knowledge of the asserted patents at the time of the alleged wrongdoing, and (2) the defendant's conduct rises to the level of egregiousness described in *Halo*. *Hypermedia,* U.S. Dist. LEXIS 56803, at *8-10 (finding "[k]nowledge of the patent alleged to be willfully infringed

continues to be a prerequisite to enhanced damages," and dismissing complaint for willful infringement where "the complaint fails to plead egregious conduct").

Furthermore, the plaintiff must plausibly plead that defendant knew that it was allegedly infringing the asserted patents at the time the defendant's conduct is alleged to have been willful. *See, e.g., NetFuel, Inc. v. Cisco Sys. Inc.*, No. 5:18-CV-02352-EJD, 2018 U.S. Dist. LEXIS 159412, at *7-8 (N.D.Cal. Sep. 18, 2018) (Ex. 16) ("This district has recognized that there can be no infringement of a patent, willful or otherwise, until the patent issues and the defendant learns of its existence and alleged infringement") (internal citation and quotation omitted).

V. ARGUMENT

A. Tormasi Lacks Standing to Sue Because ADS Owns the '301 Patent

1. There Is No Evidence That Tormasi Had the Authority to Make the January 30, 2019 Assignment from ADS to Himself

Tormasi lacks standing to bring this patent infringement suit because he has not and cannot demonstrate that he holds title to the '301 Patent. Indeed, the only competent evidence of record – the February 7, 2005 assignment, notarized and recorded with the PTO – shows that "for consideration received," Tormasi assigned all of his rights in the '301 Patent to ADS years ago. Ex. 2. Thus, it is ADS *not* Tormasi, that holds title to the '301 Patent, and Tormasi has no standing to sue for its alleged infringement. *See Lans,* 252 F.3d at 1328 (holding the sole inventor on the patent-in-suit had no standing to sue for its infringement where prior to filing the lawsuit he had assigned the patent to his company).

"[T]he plaintiff must demonstrate that it held enforceable title to the patent ***at the inception of the lawsuit***." *Paradise* Creations, 315 F.3d at 1309 (citing *Lans,* 252 F.3d at 1328) (emphasis in original). Tormasi bears the burden of proving by a preponderance of the evidence that each of the requirements for subject matter jurisidiction, including standing, have been met. *Leite,* 749 F.3d at 1121.

Tormasi's claim that as the named "inventor/patentee" of the '301 Patent he has "statutory authority to bring suit against Defendant for infringement of said patent" (ECF 1 ¶7) is legally incorrect since he assigned his rights in the '301 Patent to ADS in February 2005. And,

the lone document provided by Tormasi – a January 30, 2019 writing in which Tormasi purported to assign the '301 Patent from ADS to himself in his alleged capacities as ADS's "President" and "Sole Shareholder" (ECF 1 Ex. A) – falls far short of meeting his burden of proving standing. This is because there is not a shred of evidence that Tormasi is either the President or sole shareholder of ADS, or that Tormasi had any right whatsoever to assign the '301 Patent from ADS to himself.

Significantly, Tormasi is not listed on ADS's incorporation document or franchise tax payment documents as an officer, director, or shareholder. Exs. 4 & 5. Moreover, Tormasi's February 7, 2005 assignment of his interest in the '301 Patent to ADS does not identify Tormasi as having an ownership interest in ADS, but rather states the assignment to ADS was for unspecified "consideration received." Ex. 2.

The February 7, 2005 assignment lists ADS's address as Fairview Avenue (Ex. 2), a property that at that time was owned by Tormasi Housing Somerville, LLC of which Tormasi's father, Attila Tormasi, was the sole member. Exs. 7 & 8. Ownership of this property was transferred in 2012 to TDKH, LLC. Ex. 7. Tormasi is not listed as a member of TDKH and it appears that he has no relationship to TDKH. Ex. 9.

In his 2008 Complaint and 1st Amended Complaint discussed above, Tormasi alleged (with no supporting documentation) that ADS's address was Middle Road. Ex. 3 ¶6 & Ex. 12 ¶6. This property, too, was owned by Tormasi's father until it was transferred to a third-party – Matthew Northrup – after Tormasi's father passed away. Ex. 6.

Lacking any evidence that Tormasi had the authority to assign ADS's '301 Patent from ADS to himself, the January 30, 2019 alleged assignment is not valid and no assignment of the '301 Patent from ADS to Tormasi was effectuated.

This case is on all fours with the facts of *Raniere v. Microsoft Corp.*, 887 F.3d 1298 (Fed. Cir. 2018). In *Raniere*, Plaintiff Keith Raniere sued Defendants for infringement of patents he allegedly owned. In 1995, however, Raniere and the other named inventors of the patents-in-suit assigned their rights to the patents to Global Technologies, Inc. ("GTI"). *Id.* at 1300. Raniere was

"not listed on GTI's incorporation documents as an officer, director or shareholder," and "GTI was administratively dissolved in May 1996." *Id.* Nearly twenty (20) years later in December 2014, "Raniere executed a document on behalf of GTI, claiming to be its 'sole owner,' that purportedly transferred the asserted patents from GTI to himself." *Id.* "Raniere's suits against [the Defendants] identified himself as the owner of the patents at issue." *Id.*

Defendants "moved to dismiss Raniere's suit for lack of standing, noting that the PTO's records indicated that Raniere did not own the patents at issue." *Id.* Raniere's counsel represented that Raniere owned GTI (and thus the December 2014 assignment was valid), but when ordered by the Court to produce documents confirming this representation, Raniere was unable to do so. *Id.* Ultimately, after Raniere was provided with multiple opportunities to produce documents evidencing his ownership of GTI but did not do so, the district court dismissed Raniere's suit for lack of standing. *Id.* at 1301. The Federal Circuit affirmed the district court's dismissal for lack of standing. *Id.* at 1307 n.2 (citing *Raniere v. Microsoft Corp.*, 673 F. App'x. 1008 (Fed. Cir. 2017)).

Where, as here, WDC makes a factual attack on jurisdiction, Tormasi "'must furnish affidavits or other evidence necessary to satisfy [his] burden of establishing subject matter jurisdiction.'" *Safe Air*, 373 F.3d at 1039 (quoting *Savage*, 343 F.3d at 1039 n.2). Tormasi's own prior own pleadings, however, confirm he cannot do so. Tormasi previously alleged that over twelve years ago prison officials confiscated as contraband ADS corporate documents, including the 2004 Assignment which he alleges gave him an ownership interest in ADS, and without such documents he "cannot prove his ownership of ADS to the satisfaction of interested third parties." Ex. 3 ¶22(a) & Ex. 12 ¶22(a).

Tormasi's Complaint must be dismissed for lack of standing.

2. The January 30, 2019 Assignment is Invalid Because ADS was in a Void Status When the Assignment Purportedly Was Made

The January 30, 2019 assignment is further invalid because ADS was in a "void" status when Tormasi purported to assign the '301 Patent from ADS to himself and has been since March 1, 2008. Ex. 10. Under Delaware law, when a company is in a "void" status, "all powers

conferred by law upon the corporation are declared inoperative." 8 Del. C. § 510 (effective Jan. 1, 2008). The powers that are conferred, and thus lost when the corporate status is void, include the power to "deal in and with real or personal property, or any interest therein, wherever situated, and to sell, convey, lease, exchange, transfer or otherwise dispose of, or mortgage or pledge, all or any of its property and assets, or any interest therein, wherever situated." 8 Del. C. § 122(4).

It is indisputable that the '301 Patent is an intangible corporate asset. Thus, due to its void status, ADS lacked (and still lacks) the power to "sell, convey, lease, exchange, transfer or otherwise dispose of" the '301 Patent. And, the attempted assignment of the '301 Patent from ADS to Tormasi is invalid.

Notably, while a void corporation may continue to hold property, and it is only in "a state of coma from which it can be easily resuscitated," until it is resuscitated (by *inter alia* paying back taxes and penalties owed (8 Del. C. § 312)) "its powers as a corporation are inoperative, and the exercise of these powers is a criminal offense." *Wax v. Riverview Cemetery Co.*, 24 A.2d 431, 436 (Del.Super.Ct. 1942)).

While the Delaware code unambiguously supports WDC's contentions regarding the invalidity of the January 30, 2019 assignment, the Court's attention is respectfully directed to *Parker v. Cardiac Sci., Inc.*, No. 04-71028, 2006 U.S. Dist. LEXIS 90014 (E.D. Mich. Nov. 27, 2006) (Ex. 17). In *Parker*, citing the Delaware Supreme Court's decision in *Krapf & Son, Inc. v. Gorson*, 243 A.2d 713 (Del. 1968), the court found that a writing ratifying a Delaware corporation's prior oral assignment of a patent was valid even though the writing was executed when the corporation was in a void status. The facts of *Krapf* and *Parker*, however, are readily distinguishable from those presented in this case.

In *Krapf*, a company's president entered into a contract on behalf of a corporation which, unbeknownst to him, had been declared void (*i.e.*, forfeited its charter) for failure to pay franchise taxes. 243 A.2d at 714. The corporation was subsequently revived pursuant to 8 Del. C. §312. *Id.* The question before the Court was whether the corporation's president could be held

personally liable for a contract he entered into on behalf of the corporation after the company was declared void and before it was revived under Delaware law. *Id.* at 714.

In holding that the president was not personally liable, the Delaware Court found that since the corporation had been properly revived, the contract was "validated." *Id.* at 715 (citing 8 Del. C. §312 (e)). The Court explained:

> The result of the reinstatement of the [corporation] was, therefore, to validate the contract with [Appellant] as a binding contract with the corporation for breach of which it could be sued.

Id. The Court also rejected Appellant's argument that 8 Del. C. § 513, which makes it a criminal offense for a person to exercise corporate powers when the corporation is in a void status, precluded the company's president from entering into a binding commitment on behalf of the corporation while it was in a void. *Id.* In so doing, the *Krapf* Court noted this criminal statute had "no bearing in a contest between private parties," but rather was "a remedy given the state against a corporation, the officers of which persist in exercising its corporate powers after the charter forfeiture." *Id.*

The *Krapf* Court also found significant the facts that the forfeiture of the company's charter was inadvertent and there was no fraud or bad faith on the part of the company president in entering into the contract. *Id.* at 715.

Similarly, in *Parker,* the Michigan court found it significant that an oral patent assignment (which was ratified by a writing executed after the company's charter was forfeited) was entered into before the company was in a void status, the forfeiture of the company's charter was inadvertent, and the company could be revived under Delaware law. 2006 U.S. Dist. LEXIS 90014, at *5-8.

The holdings of *Krapf* and *Parker* thus rest squarely on the notion that a void company can be revived under 8 Del. C. §312, and contracts entered into during this void period can ultimately be validated. Tormasi, however, cannot revive ADS. To do so would require Tormasi to take a number of actions on behalf of ADS (*see* 8 Del. C. §312) – *i.e.,* it would require Tormasi to operate a business, which as explained in Section III.E and V.B, he is prohibited from

doing as an inmate in a New Jersey prison. Thus, unlike the contracts in *Krapf* and *Parker*, Tormasi's purported assignment of the '301 Patent from ADS to himself ***cannot*** be validated.

Moreover, Tormasi's alleged assignment lacks the hallmarks of good faith and inadvertence that were present in *Krapf* and *Parker*. ADS's void status is not "inadvertent," and Tormasi's purported assignment of ADS's patent to himself is an obvious bad faith (albeit failed) effort to do an end-run around the New Jersey prison's "no-business" rule. Indeed, by bringing this patent infringement suit, Tormasi is using the courts in an effort to monetize the '301 Patent, and thus in furtherance of his business interests as an individual, which he is barred from doing under New Jersey law.[2]

B. Tormasi Lacks the Capacity to Sue Because as an Inmate in the New Jersey Prisons he is Prohibited from Operating a Business

Tormasi lacks the capacity to sue for patent infringement because doing so constitutes operating a business which is prohibited under New Jersey law. A party's capacity to sue is determined by the law of the party's domicile. FRCP 17(b). In this case, Tormasi has been incarcerated in New Jersey correctional facilities since 1998 and was a resident of New Jersey prior to his incarceration. New Jersey law, therefore, is controlling.

As discussed, N.J.A.C. 10A:4-4.1(.705) prohibits Tormasi from running a business without the approval of the Administrator. As was also discussed, in Tormasi's case, the New Jersey federal court and the Third Circuit have found that his efforts at patent monetization and enforcement run afoul of New Jersey's "no-business rule," and pursuant to this rule approved the confiscation as contraband documents that Tormasi alleges were a patent application assignment, ADS corporate documents, prosecution documents for the '301 Patent and an unfiled patent application. *See* Section II.E, above.

The fact that Tormasi is once again attempting to pursue his business interests while an inmate in a New Jersey correctional facility is evident from Tormasi's Complaint itself. In

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[2] To the extent *Parker* can be read as finding that an assignment made by a Delaware corporation in a void status is effective, it is directly contrary to 8 Del. Ch. § 510 and should not be followed.

Paragraph 1 of the Complaint, Tormasi alleges that he is "an innovator and ***entrepreneur***, developing inventions in technology and other areas." ECF 1 ¶1 (emphasis added). While Tormasi's prior efforts at patent monetization were under the auspices of ADS, and his current attempts to pursue his business interests are as a sole proprietor, that is a distinction without a difference. *See e.g.*, *Kadonsky v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 2508, at *1, 21 (N.J.Super.A.D. Oct. 30, 2015) (Ex. 18) (Court upheld finding of .705 prohibited act violation stemming from legal work inmate Kadonsky, an individual, performed on behalf of another inmate); *Helm v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 1062 (N.J.Super.A.D. May 8, 2015) (Ex. 19) (Inmate Helm found guilty of .705 prohibited act because he signed paperwork regarding the sales of his artwork and taxes to be paid from those sales and because attorneys assisting him were compensated from income generated by the sales); *Stanton v. New Jersey Dept. of Corrections*, 2018 N.J. Super. Unpub. LEXIS 2106, at*9-10 (N.J.Super.A.D. Sep. 21, 2018) (Ex. 20) (Inmate Stanton found guilty of .705 violation where evidence showed he was selling magazines, received letters from inmates asking how they might be published, and sought price quote from publisher in his purported capacity as CEO of Starchild Publishing).

The "rational connection between the no-business rule and the legitimate penological objective of maintaining security and efficiency at state correctional institutions," articulated by the Tormasi II court – *e.g.*, "operating a business inside a correctional facility would seriously burden operation of incoming and outgoing mail procedures," and "could result in the introduction of contraband into prisons" (Tormasi II, at *32) – are particularly compelling here.

Indeed, Tormasi was previously found to have attempted to "subvert the security and safety of the facility" by attempting to mail "fourteen legal briefs that had been hollowed out to create hidden compartments" that "can easily be used to traffic contraband to and from the facility." *Tormasi v. New Jersey Dept. of Corrections*, 2007 N.J. Super. Unpub. LEXIS 1216, at *1-4 (N.J.Super.A.D. Mar. 22, 2007) (Ex. 21). The New Jersey Court found unpersuasive

Tormasi's self-serving declaration that "another inmate's documents were intermingled with [his] or that the documents were planted to fabricate charges against [him]." *Id.* at *2.

Tormasi's Complaint should be dismissed for lack of capacity to sue.

C. Tormasi Fails to Plausibly Plead Willful Infringement

Tormasi's willful infringement claim should be dismissed under Fed. R. Civ. P. 12(b)(6) because (1) Tormasi fails to plead facts plausibly supporting WDC's pre-suit knowledge of the '301 Patent and its alleged infringement; and (2) Tormasi fails to plead facts plausibly supporting that WDC's conduct was "egregious."

1. Tormasi Fails to Plausibly Plead WDC's Pre-Suit Knowledge of the '301 Patent and its Alleged Infringement

Willful infringement requires knowledge of the patent. *Hypermedia,* U.S. Dist. LEXIS 56803, at *8-9 (citations and internal quotations omitted). In this case, Tormasi pleads no ***facts*** to support the notion that WDC had pre-suit knowledge ***of the '301 Patent***, much less its alleged infringement. Indeed, Tormasi's allegations on these points consist entirely of the conclusory and unsupported statements that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." ECF 1, ¶¶36, 44. Such conclusory allegations, however, "will not do" *Iqbal*, 556 U.S at 678; *see also, e.g., Elec. Scripting Prods. v. HTC Am. Inc.*, No. 17-cv-05806-RS, 2018 U.S. Dist. LEXIS 43687, at *19-20 (N.D. Cal. Mar. 16, 2018) (Ex. 22) (Plaintiff's "conclusory statement" that its patents "were well known to defendants" because defendants had "written notice of the Patents" insufficient to plead pre-suit knowledge because it provided "no information as to what the written notice entailed or when it was delivered to, or received by [Defendant] such that [Defendant's] knowledge could reasonably be inferred.")

a) Pleading Knowledge of a Patent Application is Insufficient

Tormasi speculates that WDC was aware of the ***application*** that led to the '301 Patent. ECF 1, ¶¶37-42. Such speculation, however, falls far short of the showing required to plausibly plead pre-suit knowledge of ***the '301 Patent*** itself. Pleading "knowledge of the patent application is insufficient, without more, plausibly to support an allegation that the infringer had knowledge

of the patent-in-suit." *Adidas Am., Inc. v. Skechers USA, Inc.*, No. 3:16-cv-1400-SI, 2017 U.S. Dist. LEXIS 89752, at *9 (D. Or. June 12, 2017) (Ex. 23); *see also NetFuel,* 2018 U.S. Dist. LEXIS 159412, at *5 ("The general rule in this district is that knowledge of a patent application alone is insufficient to meet the knowledge requirement for either a willful or induced infringement claim.") Indeed, "[t]o willfully infringe ***a patent***, the patent must exist and one must have knowledge of it." *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985) (emphasis in original) "Filing an application is no guarantee any patent will issue and a very substantial percentage of applications never result in patents. What the scope of claims in patents that do issue will be is something totally unforeseeable." *Id.*

b) In Any Event, Tormasi Fails to Plausibly Plead WDC's Knowledge of the Application that Led to the '301 Patent

Even if Tormasi could plausibly plead the "knowledge" element of willfulness by pleading knowledge of the '301 ***application*** (he cannot), Tormasi's claim still fails because he does not plead ***facts*** leading to the reasonable inference that WDC had pre-suit knowledge of the '301 application. Instead, Tormasi relies entirely on rank speculation couched as "information and belief" (ECF 1 ¶¶36-44) and a mosaic of "unwarranted deductions of fact" and "unreasonable inferences" which the Court need not credit. *See Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *2-3 ("[C]ourts do not accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences") (citation omitted).

Tormasi baldly asserts "upon information and belief" – with no factual basis or any attempt at identifying the "information" on which he purportedly relies – that WDC's "legal and technology departments customarily and routinely review ***all*** published patent applications pertaining to the field of magnetic storage and retrieval." *Id.* ¶39 (emphasis added). Tormasi then unreasonably infers that since the '301 application was published in November 2005 and available in electronic databases, WDC "encountered" and "had actual knowledge of" it. *Id.*

Such a conclusory allegation falls far short of plausibly pleading WDC's knowledge of the '301 application. *See, e.g., Electronic Scripting*, 2018 U.S. Dist. LEXIS 43687, at *19-20 (Plaintiff's "allegations regarding 'defendant's exercise of due diligence pertaining to intellectual

property affecting its Devices,'" insufficient to establish knowledge of the patent-in-suit); *Nanosys, Inc v. QD Visions, Inc.*, No. 16-cv-01957-YGR, 2016 U.S. Dist. LEXIS 126745, at *4-8 (N.D. Cal. Sep. 16, 2016) (Ex. 24) (allegations that defendant's "founders and key employees were, at least, aware of and knowledgeable about developments and advances in the field and patent filings through their activities conducted through industry conferences, research, and development" insufficient to support an inference of pre-suit knowledge of patent).

Indeed, Tormasi's allegations provide no information about who at WDC supposedly "encountered" the '301 application, when this occurred or how "such an "encounter" could possibly put WDC on notice that it was infringing the claims of a patent that had not yet issued. In essence, Tormasi proposes that WDC be presumed to have actual knowledge of every published application in the field of "magnetic storage and retrieval" and, and thus every patent that issues from such patent applications, a proposition that stands the requirement of plausibly pleading knowledge of the patent-in-suit on its head.

c) Tormasi Fails to Plausibly Plead WDC's Knowledge of Alleged Infringement of the '301 Patent

Courts in this District have held that claims of willful patent infringement require an allegation not only that the defendant knew of the asserted patents, but also that the defendant knew of its alleged infringement during the relevant time period. *See, e.g., NetFuel,* 2018 U.S. Dist. LEXIS 159412, at *7-8 (N.D. Cal. Sept. 18, 2018) ("This district has recognized that 'there can be no infringement of a patent, willful or otherwise, until the patent issues and the defendant learns of its existence and ***alleged infringement***") (emphasis added);

Tormasi's complaint, however, does not allege any facts that would support that WDC had pre-suit knowledge that it infringed any claim of the '301 Patent. Tormasi's pleading in this regard consists only of the conclusory and plainly insufficient statement that "Defendant knew that its [accused devices] violated U.S. Patent No. 7,324,301." ECF 1 ¶36, 44.

Tormasi alleges that WDC began using the accused infringing devices "two or three years" after the '301 application was published – a period of time which Tormasi baldly asserts (with no factual support whatsoever) "corresponds with the lead time needed to research and

develop new technology." ECF 1, ¶41. From this Tormasi draws the unreasonable inference that WDC began "researching and developing its [accused devices] within weeks or months after having actual knowledge of Plaintiff's published patent application." *Id.* Tormasi's conclusory allegations, unwarranted factual deductions and unreasonable inferences are not well-pled, and thus do not plausibly plead WDC's knowledge of the '301 Patent and its infringement.

2. Tormasi Fails to Allege Egregious Conduct

Following the *Halo* decision, courts in this District have required plaintiffs to plead facts sufficient to demonstrate "egregious" conduct to sustain a willful infringement claim. *See, e.g., Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *10 (Dismissing willfulness claim where "the complaint fails to plead egregious conduct"); *Finjan, Inc. v. Cisco Sys. Inc.*, No. 17-CV-00072-BLF, 2017 U.S. Dist. LEXIS 87657, at *9 (N.D. Cal. June 7, 2017). (Ex. 25) (same).

In *Hypermedia,* prior to filing suit, Plaintiff sent a letter to Defendant "regarding licensing of [Plaintiff's] intellectual property." 2019 U.S. Dist. LEXIS 56803, at *3. The letter referenced a potential "non-litigation business discussion" between Plaintiff and Defendant, identified patents in Plaintiff's portfolio, and included figures from one of the patents and a chart identifying Plaintiff's patents allegedly relevant to Defendant's products. *Id.* at *3-4. Plaintiff pled that after receiving the letter, Defendant did not investigate to form a good faith basis that the patents were invalid or not infringed but continued its allegedly infringing conduct. *Id.* at *9.

This Court found that Plaintiff failed to plausibly plead "egregiousness" because "[n]othing in the complaint provide[d] specific factual allegations about [Defendant's] subjective intent or details about the nature of [Defendant's] conduct to render a claim of willfulness plausible, and not merely possible." *Id.* at *10 (citing *Slot Speaker Techs., Inc. v. Apple, Inc.*, No. 13-cv-01161-HSG, 2017 U.S. Dist. LEXIS 161400, at *8 (N.D. Cal. Sep. 29, 2017) (Ex. 15) ("Defendant's ongoing [operations], on their own, are equally consistent with a defendant who subjectively believes the plaintiff's patent infringement action has no merit."). This Court found that "Plaintiff cites no case for the broad proposition that a defendant who receives a letter asking if they are 'interested in [a] non-litigation business discussion,' must cease operations

immediately to avoid a willful infringement claim." *Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *10. (internal citations and quotations omitted).Similarly, in *Finjan v. Cisco*, the Court found Plaintiff had not plausibly plead egregiousness where Plaintiff made only conclusory assertions that "[d]espite knowledge of Finjan's patent portfolio, Defendant has sold and continues to sell the accused products and services." 2017 U.S. Dist. LEXIS 87657, at *3.

Here, Tormasi's complaint is completely devoid of any allegations suggesting any "egregious" conduct. Moreover, the conduct that Tormasi speculates occurred all centers on the publication of the ***application*** leading to the '301 and not the '301 ***Patent*** itself. Such conduct, even if true, simply could not rise to the level of egregious behavior – "[t]o willfully infringe ***a patent***, the patent must exist and one must have knowledge of it." *State Indus.*, 751 F.2d at 1236 (emphasis in original). Thus, Tormasi fails to plead "specific factual allegations about [WDC's] subjective intent or details about the nature of [WDC's] conduct to render a claim of willfulness plausible, and not merely possible." *Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *10.

Tormasi's claim for willful infringement must be dismissed.

D. Tormasi Fails to Plausibly Plead Indirect Infringement

Tormasi's Complaint alleges "General Infringement" but does not cite the sections of 35 U.S.C. §271 under which he is proceeding. ECF 1, ¶¶25-35. WDC understands Tormasi's claim to be one for direct infringement only, however, to the extent Tormasi asserts that his causes of action are also for indirect infringement – either induced infringement under §271(b) or contributory infringement under §271(c) – such claims must be dismissed under Fed. R. Civ. P. 12(b)(6) for failure to state a claim.

Liability for inducement infringement "only attach[es] if the defendant knew of the patent and knew as well that 'the induced acts constitute patent infringement.'" *Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *4 (citing *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1926 (2015) (quoting *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011)). Here, Tormasi's Complaint does not plausibly plead a cause of action for induced infringement because: (1) as discussed in Section V.C.1 above, Tormasi does not plausibly plead WDC's

knowledge of the '301 Patent; and (2) the Complaint is utterly devoid of any factual allegations from which the Court could "reasonably infer" that WDC had the specific intent to encourage any third-party to infringe the '301 Patent. *See Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *4-8 (dismissing Plaintiff's claim for induced infringement where Plaintiff failed to plausibly plead the requisite "specific intent" to encourage others to infringe).

Liability for contributory infringement under 35 U.S.C. §271(c) requires a showing that the alleged contributory infringer ***knew*** "that the combination for which [its accused infringing] component was especially designed was both patented and infringing." *Global-Tech,* 563 U.S. at 763 (citations and quotations omitted). Thus, to state a claim for contributory infringement, Tormasi must allege facts plausibly showing that (1) WDC had the requisite knowledge and (2) the accused products have "no substantial non-infringing uses." *In re Bill of Lading Transmission & Processing Sys. Patent Litig.*, 681 F.3d 1323, 1337 (Fed. Cir. 2012) (citation omitted); *see also Superior Indus. LLC v. Thor Global Enters. Ltd.*, 700 F.3d 1287, 1295-96 (Fed. Cir. 2013) (affirming dismissal of contributory infringement claim where plaintiff failed to plausibly allege lack of substantial non-infringing uses).

In this case, Tormasi fails to plausibly plead WDC's knowledge of the '301 Patent and pleads ***no*** facts to support the reasonable inferences that (a) WDC knew that any of its devices were patented and infringing, and (b) that WDC's accused infringing devices have no substantial non-infringing uses. Thus, to the extent Tormasi asserts that his cause of action for "General Infringement" includes claims for induced and/or contributory infringement, those claims must be dismissed under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim.

VI. CONCLUSION

For the foregoing reasons, Defendant Western Digital Corporation respectfully requests that its Motion to Dismiss be granted.

Dated: April 25, 2019

Respectfully submitted,

/s/ Erica D. Wilson
Erica D. Wilson

Erica D. Wilson (SBN 161386)
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San Jose, CA 95119
Telephone: 408-717-8016

Attorneys for Defendant
Western Digital Corporation

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

WALTER A. TORMASI, Plaintiff, v. WESTERN DIGITAL CORPORATION, Defendant.	Case Number: 4:19-CV-00772-HSG **DECLARATION OF ERICA D. WILSON IN SUPPORT OF DEFENDANT WESTERN DIGITAL CORPORATION'S MOTION TO DISMISS** Date: August 22, 2019 Time: 2:00 p.m. Judge: Hon. Haywood S. Gilliam, Jr. Courtroom: 2, 4th Floor

I, Erica D. Wilson, declare as follows:

1. I am a partner at Walters Wilson LLP, and am counsel for defendant Western Digital Corporation ("WDC"). I make this declaration of my own personal knowledge and if called to testify I could and would testify to the facts stated herein.

2. Attached hereto as **Exhibit 1** is a true and correct copy of *Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2009 U.S. Dist. LEXIS 50560 (D.N.J. June 16, 2009) ("Tormasi I").

3. Attached hereto as **Exhibit 2** is a true and correct copy of United States Patent and Trademark Office assignment records for U.S. Patent No. 7,324,301 downloaded on April 23, 2019 from https://assignment.uspto.gov.

4. Attached hereto as **Exhibit 3** is a true and correct copy of excerpts of the Complaint filed December 1, 2008 in the matter of *Walter A. Tormasi v. George W. Hayman, et al.*, U.S.D.C. District of New Jersey Case No. 3:08-cv-05886-JAP-DEA obtained from www.pacer.gov.

5. Attached hereto as **Exhibit 4** is a true and correct certified copy of the State of Delaware Certificate of Incorporation of Advanced Data Solutions Corp. dated April 19, 2004.

6. Attached hereto as **Exhibit 5** is a true and correct copy of the State of Delaware 2004 and 2005 Annual Franchise Tax Reports for Advanced Data Solutions Corp.

7. Attached hereto as **Exhibit 6** is a true and correct certified copy of a Deed for real property located at 1828 Middle Road, Martinsville, NJ 08836 dated January 25, 2011.

8. Attached hereto as **Exhibit 7** is a true and correct certified copy of a Deed for real property located at 105 Fairview Avenue, Somerville, New Jersey dated March 15, 2012.

9. Attached hereto as **Exhibit 8** is a true and correct certified copy of the State of New Jersey Department of the Treasury Filing Certificate for Tormasi Housing Somerville, LLC filed August 17, 2009.

10. Attached hereto as **Exhibit 9** is a true and correct certified copy of the State of New Jersey Department of the Treasury Filing Certificate for TDKH LLC filed February 21, 2011.

11. Attached hereto as **Exhibit 10** is a true and correct copy of the Delaware Secretary of State Certification of void status of Advanced Data Solutions Corp. as of March 1, 2008.

12. Attached hereto as **Exhibit 11** is a true and correct copy of *Tormasi v. Hayman*, Civil Action No. 08-5886 (JAP), 2011 U.S. Dist. LEXIS 25849 (D.N.J. Mar. 14, 2011) ("Tormasi II").

13. Attached hereto as **Exhibit 12** is a true and correct copy of excerpts of the First Amended Complaint filed July 24, 2009 in the matter of *Walter A. Tormasi v. George W. Hayman, et al.*, U.S.D.C. District of New Jersey Case No. 3:08-cv-05886-JAP-DEA obtained from www.pacer.gov.

14. Attached hereto as **Exhibit 13** is a true and correct copy of *Tormasi v. Hayman*, 443 F. App'x 742 (3d Cir. 2011).

15. Attached hereto as **Exhibit 14** is a true and correct copy of *Hypermedia Navigation v. Google LLC*, No. 18-cv-06137-HSG, 2019 U.S. Dist. LEXIS 56803 (N.D. Cal. Apr. 2, 2019).

16. Attached hereto as **Exhibit 15** is a true and correct copy of *Slot Speaker Techs., Inc. v. Apple, Inc.*, No. 13-cv-01161-HSG, 2017 U.S. Dist. LEXIS 161400 (N.D. Cal. Sep. 29, 2017).

17. Attached hereto as **Exhibit 16** is a true and correct copy of *NetFuel, Inc. v. Cisco Sys. Inc.*, No. 5:18-CV-02352-EJD, 2018 U.S. Dist. LEXIS 159412 (N.D. Cal. Sep. 18, 2018).

18. Attached hereto as **Exhibit 17** is a true and correct copy of *Parker v. Cardiac Sci., Inc.* Case No. 04-71028, 2006 U.S. Dist. LEXIS 90014 (E.D. Mich. Nov. 27, 2006),

19. Attached hereto as **Exhibit 18** is a true and correct copy of *Kadonsky v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 2508 (N.J. Super. A.D. Oct. 30, 2015).

20. Attached hereto as **Exhibit 19** is a true and correct copy of *Helm v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 1062 (N.J. Super. A.D. May 8, 2015).

21. Attached hereto as **Exhibit 20** is a true and correct copy of *Stanton v. New Jersey Department of Corrections*, 2018 N.J. Super. Unpub. LEXIS 2106 (N.J. Super. A.D. Sep. 21, 2018).

22. Attached hereto as **Exhibit 21** is a true and correct copy of *Tormasi v. New Jersey Dept. of Corrections*, 2007 N.J. Super. Unpub. LEXIS 1216 (N.J. Super. A.D. Mar. 22, 2007).

23. Attached hereto as **Exhibit 22** is a true and correct copy of *Elec. Scripting Prods. v. HTC Am. Inc*, No. 17-cv-05806-RS, 2018 U.S. Dist. LEXIS 43687 (N.D. Cal. Mar. 16, 2018).

24. Attached hereto as **Exhibit 23** is a true and correct copy of *Adidas Am., Inc. v. Skechers USA, Inc.*, No. 3:16-cv-1400-SI, 2017 U.S. Dist. LEXIS 89752 (D. Or. June 12, 2017).

25. Attached hereto as **Exhibit 24** is a true and correct copy of *Nanosys, Inc v. QD Visions, Inc.*, No. 16-cv-01957-YGR, 2016 U.S. Dist. LEXIS 126745 (N.D. Cal. Sept. 16, 2016).

26. Attached hereto as **Exhibit 25** is a true and correct copy of *Finjan, Inc. v. Cisco Sys. Inc.*, No. 17-CV-00072-BLF, 2017 U.S. Dist. LEXIS 87657 (N.D. Cal. June 7, 2017).

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 25th day of April, 2019 in Redwood City, California.

/s/ Erica D. Wilson
Erica D. Wilson

Exhibit 2

UNITED STATES PATENT AND TRADEMARK OFFICE

2 results for "Patent number: "7324301""

Reel/frame	Execution date	Conveyance type	Assignee (Owner)	Patent	Publication	Properties
018892/0313	Feb 7, 2005	ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).	ADVANCED DATA SOLUTIONS CORP.	7324301	20050243661	1
016299/0034	Feb 7, 2005	ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).	ADVANCED DATA SOLUTIONS CORP.	7324301	20050243661	1

UNITED STATES
PATENT AND TRADEMARK OFFICE

Patent assignment 016299/0034

ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Date recorded
Feb 17, 2005

Reel/frame
016299/0034

Pages
2

Assignors
TORMASI, WALTER A.

Execution Date
Feb 07, 2005

Assignee
ADVANCED DATA SOLUTIONS CORP.
105 FAIRVIEW AVENUE
SOMERVILLE, NEW JERSEY 08876

Correspondent
WALTER A. TORMASI
1828 MIDDLE ROAD
MARTINSVILLE, NEW JERSEY 08836

Properties (1 of 1 total)

Patent	Publication	Application	PCT	International registration
1. STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES Inventors: Walter A. Tormasi				
7324301 Jan 29, 2008	20050243661 Nov 03, 2005	11031878 Jan 10, 2005		

Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

03-01-2005

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

REC

2/17/15

102950537

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

1. Name of conveying party(ies)/Execution Date(s):

Walter A. Tormasi

Execution Date(s) FEB 07 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Advanced Data Solutions Corp.

Internal Address:

Street Address: 105 Fairview Avenue

City: Somerville

State: New Jersey

Country: United States Zip: 08876

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☐ Other

4. Application or patent number(s):

☐ This document is being filed together with a new application.

A. Patent Application No.(s)

11/031,878

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

OPR/FINANCE
FEB 17 PM 12:04

5. Name and address to whom correspondence concerning document should be mailed:

Name: Walter A. Tormasi

Internal Address:

Street Address: 1828 Middle Road

City: Martinsville

State: New Jersey Zip: 08836

Phone Number: 732-560-1665

Fax Number: 732-560-3939

Email Address:

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 1.21(h) & 3.41) $ 40

☐ Authorized to be charged by credit card
☐ Authorized to be charged to deposit account
☒ Enclosed
☐ None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number

Authorized User Name

9. Signature: Walter A. Tormasi FEB 07 2005

Signature Date

Walter A. Tormasi

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 2

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

02/24/2005 DBYRNE 00000192 11031878
01 FC:8021 40.00 OP

PATENT
REEL: 016299 FRAME: 0034

For consideration received, WALTER A. TORMASI (Assignor), 1828 Middle Road, Martinsville, New Jersey 08836, hereby assigns, transfers, and conveys to ADVANCED DATA SOLUTIONS CORP. (Assignee), 105 Fairview Avenue, Somerville, New Jersey 08876, complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny.

Walter A. Tormasi, Assignor

FEB 07 2005

Date

I hereby certify that the above individual duly acknowledged the execution of the foregoing instrument and the powers vested in him, said acknowledgment and affirmation occurring on the below date in the State of New Jersey, County of Mercer.

Notary Public

Sworn to and Subscribed Before Me This
7th Day of Jan 2005

MILDRED D. STREBLING
Notary Public Of New Jersey
My Commission Expires May 9, 2008

UNITED STATES
PATENT AND TRADEMARK OFFICE

Patent assignment 018892/0313

ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Date recorded
Feb 07, 2007

Reel/frame
018892/0313

Pages
2

Assignors
TORMASI, WALTER A.

Execution Date
Feb 07, 2005

Assignee
ADVANCED DATA SOLUTIONS CORP.
105 FARIVIEW AVENUE
SOMERVILLE, NEW JERSEY 08876

Correspondent
WALTER A. TORMASI
1828 MIDDLE ROAD
MARTINSVILLE, NEW JERSEY 08836

Properties (1 of 1 total)

Patent	Publication	Application	PCT	International registration
1. STRIPING DATA SIMULTANEOUSLY ACROSS MULTIPLE PLATTER SURFACES Inventors: Walter A. Tormasi				
7324301 Jan 29, 2008	20050243661 Nov 03, 2005	11031878 Jan 10, 2005		

Form PTO-1595 (Rev. 03/01)
OMB No. 0651-0027 (exp. 6/30/2005)

02-12-2007

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

FEB 05 2007

103372043

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

2.07.07

1. Name of conveying party(ies)/Execution Date(s):

Walter A. Tormasi

Execution Date(s): FEB 07 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Advanced Data Solutions Corp.

Internal Address:

Street Address: 105 Fairview Avenue

City: Somerville

State: New Jersey

Country: United States Zip: 08876

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger

☐ Security Agreement ☐ Change of Name

☐ Government Interest Assignment

☐ Executive Order 9424, Confirmatory License

☐ Other

4. Application or patent number(s): ☐ This document is being filed together with a new application.

A. Patent Application No.(s)

11/031,878

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address to whom correspondence concerning document should be mailed:

Name: Walter A. Tormasi

Internal Address:

Street Address: 1828 Middle Road

City: Martinsville

State: New Jersey Zip: 08836

Phone Number: 732-560-1665

Fax Number: 732-560-3939

Email Address:

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 1.21(h) & 3.41) $ 40

☐ Authorized to be charged by credit card

☐ Authorized to be charged to deposit account

☒ Enclosed

☐ None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers

Expiration Date

b. Deposit Account Number

Authorized User Name

9. Signature: Walter A. Tormasi FEB 07 2005

Signature Date

Walter A. Tormasi

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 2

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

Assignment of Patent Application

For consideration received, WALTER A. TORMASI (Assignor), 1828 Middle Road, Martinsville, New Jersey 08836, hereby assigns, transfers, and conveys to ADVANCED DATA SOLUTIONS CORP. (Assignee), 105 Fairview Avenue, Somerville, New Jersey 08876, complete right, title, and interest in United States Patent Application No. 11/031,878 and its foreign and domestic progeny.

Walter A. Tormasi, Assignor

FEB 07 2005

Date

I hereby certify that the above individual duly acknowledged the execution of the foregoing instrument and the powers vested in him, said acknowledgment and affirmation occurring on the below date in the State of New Jersey, County of Mercer.

Notary Public

Sworn to and Subscribed Before Me This 7th Day of Jan 2005

MILDRED D. STRIBLING
Notary Public Of New Jersey
My Commission Expires May 9, 2008

Exhibit 4

Delaware

The First State

I, JEFFREY W. BULLOCK, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY THE ATTACHED IS A TRUE AND CORRECT COPY OF THE CERTIFICATE OF INCORPORATION OF "ADVANCED DATA SOLUTIONS CORP.", FILED IN THIS OFFICE ON THE NINETEENTH DAY OF APRIL, A.D. 2004, AT 2:11 O`CLOCK P.M.

Jeffrey W. Bullock, Secretary of State

3791936 8100
SR# 20193008615

Authentication: 202677196
Date: 04-19-19

You may verify this certificate online at corp.delaware.gov/authver.shtml

CERTIFICATE OF INCORPORATION

FIRST: The name of this corporation shall be: ADVANCED DATA SOLUTIONS CORP.

SECOND: Its registered office in the State of Delaware is to be located at 2711 Centerville Road, Suite 400, in the City of Wilmington, County of New Castle and its registered agent at such address is THE COMPANY CORPORATION.

THIRD: The purpose or purposes of the corporation shall be:

To engage in any lawful act or activity for which corporations may be organized under the General Corporation Law of Delaware.

FOURTH: The total number of shares of stock which this corporation is authorized to issue is: One Thousand Five Hundred (1,500) shares of common stock with no par value

FIFTH: The name and address of the incorporator is as follows:

Angela Norton
2711 Centerville Road
Suite 400
Wilmington, Delaware 19808

SIXTH: The Board of Directors shall have the power to adopt, amend or repeal the by-laws.

SEVENTH: No director shall be personally liable to the Corporation or its stockholders for monetary damages for any breach of fiduciary duty by such director as a director. Notwithstanding the foregoing sentence, a director shall be liable to the extent provided by applicable law, (i) for breach of the director's duty of loyalty to the Corporation or its stockholders, (ii) for acts or omissions not in good faith or which involve intentional misconduct or a knowing violation of law, (iii) pursuant to Section 174 of the Delaware General Corporation Law or (iv) for any transaction from which the director derived an improper personal benefit. No amendment to or repeal of this Article Seventh shall apply to or have any effect on the liability or alleged liability of any director of the Corporation for or with respect to any acts or omissions of such director occurring prior to such amendment.

IN WITNESS WHEREOF, the undersigned, being the incorporator herein before named, has executed signed and acknowledged this certificate of incorporation this 19th day of April 2004.

Name: Angela Norton
Incorporator

State of Delaware
Secretary of State
Division of Corporations
Delivered 02:46 PM 04/19/2004
FILED 02:11 PM 04/19/2004
SRV 040283802 - 3791936 FILE

DE BC D-CERTIFICATE OF INCORPORATION - SHORT SPECIMEN 09/00-1 (DESHORT)

Exhibit 5

002849
SOSTC

STATE OF DELAWARE

2004 ANNUAL FRANCHISE TAX REPORT

DO NOT ALTER FILE NUMBER

FILE NUMBER	CORPORATION NAME	PHONE NUMBER
3791936	ADVANCED DATA SOLUTIONS CORP.	732-560-1665

FEDERAL EMPLOYER ID NO.	INCORPORATION DATE	RENEWAL/REVOCATION DATE	DATE OF INACTIVITY FROM / / TO / /
55-0872479	APRIL 19, 2004	January 1, 2005	

AUTHORIZED STOCK BEGIN DATE	AUTHORIZED STOCK ENDING DATE	DESIGNATION OR STOCK CLASS	NO. OF SHARES	PAR VALUE/SHARE	NO. SHARES ISSUED	TOTAL GROSS ASSETS	ASSET DATE	ASSETS FOR REGULATED INVESTMENT CORPS JAN. 1st / DEC. 31st
04-19-2004	12-31-2004	COMMON	1,500					
1,500	1,500			None	1,500	$1	5-17-04	

FRANCHISE TAX	$100.00 PENALTY	1.5% MONTHLY INTEREST	ANN. FILING FEE	PREV CREDIT OR BALANCE	PREPAID QRTY. PAYMENTS
$ 35.00	$ N/A	$ N/A	$ 25.00	$ 0	$ 0

AMOUNT DUE
$ 60.00

REGISTERED AGENT 9018442
THE COMPANY CORPORATION
2711 CENTERVILLE ROAD
SUITE 400
WILMINGTON, DE 19808

MAKE CHECK PAYABLE TO:
DELAWARE SECRETARY OF STATE

CHECK NO.	AMOUNT ENCLOSED
	$60.00

$100.00 PENALTY if not Received on or before
MAR 1, 2005 Plus 1.5% interest per month.

2 030105 3791936 000006000 0 8

NATURE OF BUSINESS

PRINCIPAL PLACE OF BUSINESS OUTSIDE OF DELAWARE

DIRECTORS	NAME	STREET/CITY/STATE/ZIP	DATE TERM EXPIRES
1.			
2.			
3.			
4.			
5.			
6.			

DO NOT WRITE IN THIS SPACE - FOR BANK USE ONLY

350 7755363 35 1 1115A 12
SBT 02/22/95

OFFICERS	NAME	STREET/CITY/STATE/ZIP	DATE TERM EXPIRES
1.			
2.			

ORIGINAL SIGNATURE (OFFICER, DIRECTOR OR INCORPORATOR) TITLE DATE

X

004356
SOSTC

STATE OF DELAWARE
2005 ANNUAL FRANCHISE TAX REPORT

DO NOT ALTER FILE NUMBER

FILE NUMBER	CORPORATION NAME	PHONE NUMBER
3791936	ADVANCED DATA SOLUTIONS CORP.	

FEDERAL EMPLOYER ID NO.	INCORPORATION DATE	RENEWAL/REVOCATION DATE	DATE OF INACTIVITY	FROM	TO
	APRIL 19, 2004			/ /	/ /

AUTHORIZED STOCK BEGIN DATE	ENDING DATE	DESIGNATION OR STOCK CLASS	NO. OF SHARES	PAR VALUE/SHARE	NO. SHARES ISSUED	TOTAL GROSS ASSETS	ASSET DATE	ASSETS FOR REGULATED INVESTMENT CORPS
04-19-2004		COMMON	1,500					JAN. 1st / DEC. 31st

FRANCHISE TAX	$100.00 PENALTY	1.5% MONTHLY INTEREST	ANN. FILING FEE	PREV CREDIT OR BALANCE	PREPAID QRTY. PAYMENTS
$ 35.00	$	$	$ 25.00	$	$

AMOUNT DUE
$ 60.00

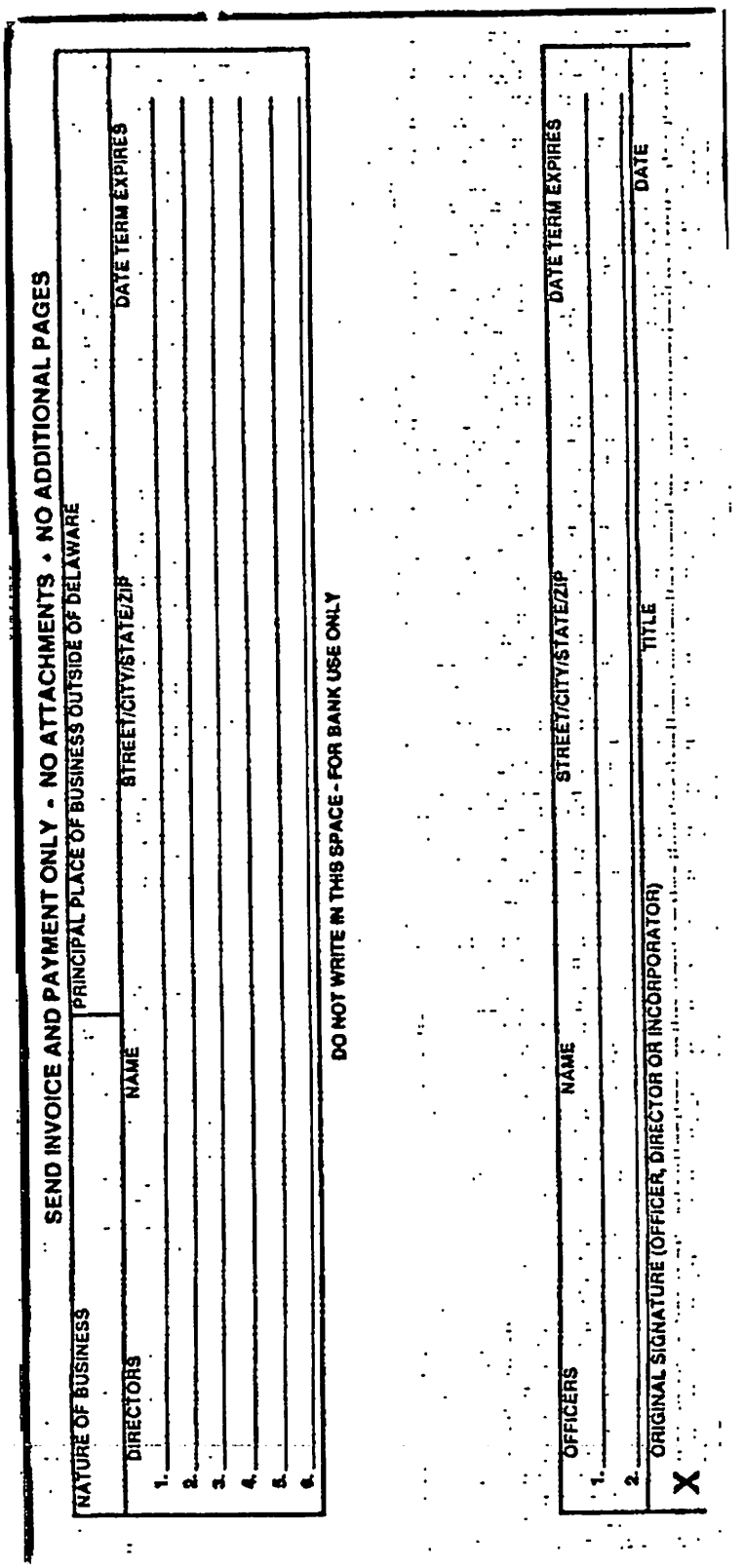
REGISTERED AGENT 9018442
THE COMPANY CORPORATION
2711 CENTERVILLE ROAD
SUITE 400
WILMINGTON, DE 19808

MAKE CHECK PAYABLE TO:
DELAWARE SECRETARY OF STATE

CHECK NO.	AMOUNT ENCLOSED
368	162.40

$100.00 PENALTY If not Received on or before
MAR 1, 2006 Plus 1.5% interest per month.

2 030106 3791936 000006000 0 7


SEND INVOICE AND PAYMENT ONLY • NO ATTACHMENTS • NO ADDITIONAL PAGES
NATURE OF BUSINESS
PRINCIPAL PLACE OF BUSINESS OUTSIDE OF DELAWARE
DIRECTORS
NAME
STREET/CITY/STATE/ZIP
DATE TERM EXPIRES
1.
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6.
DO NOT WRITE IN THIS SPACE - FOR BANK USE ONLY
OFFICERS
NAME
STREET/CITY/STATE/ZIP
DATE TERM EXPIRES
1.
2.
ORIGINAL SIGNATURE (OFFICER, DIRECTOR OR INCORPORATOR)
TITLE
DATE
X

Exhibit 10

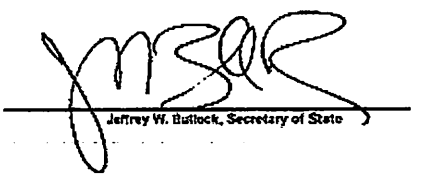
Delaware

The First State

I, JEFFREY W. BULLOCK, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY THAT THE CERTIFICATE OF INCORPORATION OF "ADVANCED DATA SOLUTIONS CORP.", WAS RECEIVED AND FILED IN THIS OFFICE THE NINETEENTH DAY OF APRIL, A.D. 2004.

AND I DO HEREBY FURTHER CERTIFY THAT THE AFORESAID CORPORATION IS NO LONGER IN EXISTENCE AND GOOD STANDING UNDER THE LAWS OF THE STATE OF DELAWARE HAVING BECOME INOPERATIVE AND VOID THE FIRST DAY OF MARCH, A.D. 2008 FOR NON-PAYMENT OF TAXES.

AND I DO HEREBY FURTHER CERTIFY THAT THE AFORESAID CORPORATION WAS SO PROCLAIMED IN ACCORDANCE WITH THE PROVISIONS OF GENERAL CORPORATION LAW OF THE STATE OF DELAWARE ON THE TWENTY-SIXTH DAY OF JUNE, A.D. 2008 THE SAME HAVING BEEN REPORTED TO THE GOVERNOR AS HAVING NEGLECTED OR REFUSED TO PAY THEIR ANNUAL TAXES.



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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WALTER A. TORMASI,	:	CASE NO. 4:19-cv-00772-HSG
Plaintiff,	:	HEARING DATE: AUG. 22, 2019
v.	:	ASSIGNED JUDGE: HON. HAYWOOD S. GILLIAM, JR., U.S.D.J.
WESTERN DIGITAL CORP.,	:	
Defendant.	:	

BRIEF IN OPPOSITION TO DEFENDANT'S MOTION TO DISMISS

WALTER A. TORMASI, PLAINTIFF
ATTORNEY PRO PERSONA
OF COUNSEL AND ON THE BRIEF

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RELIEF SOUGHT

Plaintiff Walter A. Tormasi categorically opposes Defendant Western Digital Corp.'s Motion to Dismiss and respectfully requests that said motion be denied in its entirety.

STATEMENT OF ISSUES TO BE DECIDED

In its Motion to Dismiss, Defendant advances three primary arguments. The first argument asserts that Plaintiff lacks standing to bring suit. The second argument asserts that prison regulations removed Plaintiff's suing capacity. The third argument asserts that Plaintiff failed to satisfy pleading standards regarding his willful-infringement claim. Plaintiff addresses these arguments in the order listed.

STATEMENT OF FACTS

The relevant facts are detailed in Plaintiff's Complaint and accompanying Declaration and exhibits, which Plaintiff incorporates herein by reference. With that antecedent factual basis, the below discussion proceeds accordingly.

LEGAL ARGUMENT

POINT I

PLAINTIFF OWNS THE PATENT-IN-SUIT AND HAS FULL ENFORCEMENT AUTHORITY, GIVING PLAINTIFF STANDING TO SUE UNDER 35 U.S.C. § 281.

Defendant is incorrect in asserting lack of standing. This is because Plaintiff was the legal title holder of the patent-in-suit during the period of infringement. Plaintiff,

moreover, had express authority to sue for prior acts of infringement. These circumstances, among others, provided Plaintiff with standing under 35 U.S.C. § 281.

As the Court is aware, plaintiffs must have standing to sue for damages in federal court. Crown Die & Tool Co. v. Nye Tool & Mach. Works, 261 U.S. 24 (1923). This requirement applies equally to patent-infringement cases. Id. at 40-41.

The United States Code gives "patentee[s] . . . remedy by civil action for infringement." 35 U.S.C. § 281. The term "patentee," as used in § 281, is synonymous with "legal title holder" and includes not only the person or entity "to whom the patent was issued but also the successors in title to the patentee." Arachnid, Inc. v. Merit Industries, Inc., 939 F.3d 1574, 1578 n.2 (Fed. Cir. 1991) (citing 35 U.S.C. § 100(d)).

Accordingly, in order "to recover money damages for infringement," the patent-asserting person or entity "must have held the legal title to the patent during the time of the infringement." Id. at 1579. Alternatively, if legal title vested post-infringement, the title-conferring instrument must have expressly authorized "right of action for past infringements." Id. at 1579 n.7 (citing cases).

Plaintiff submits that the foregoing standards provide him with standing to sue. This is especially the case when considering not only Plaintiff's factual allegations (as set

forth in his Complaint) but also relevant extrinsic evidence (namely, his accompanying Declaration and exhibits).

As alleged in his Complaint, Plaintiff "is the . . . patentee of U.S. Patent No. 7,324,301 and, as such, has the statutory authority to bring suit against Defendant for infringement of said patent." (Compl. ¶ 7 (citing 35 U.S.C. § 281).) Plaintiff, moreover, "owns all right, title, and interest in the foregoing patent, with such ownership permitting Plaintiff 'to pursue all causes of action and legal remedies arising during the entire term of U.S. Patent No. 7,324,301.'" (Compl. ¶ 8 (quoting Compl. Exh. A).)

These allegations are entirely sufficient to establish standing. Significantly, pursuant to Arachnid, supra, Plaintiff alleged not only current ownership but also express authority to sue for past infringement. These allegations, if true (which they are), give Plaintiff "remedy by civil action for infringement of his patent." 35 U.S.C. § 281.

Assuming, arguendo, that Plaintiff's allegations in his Complaint fail to establish standing, this Court should turn to the extrinsic evidence proffered by Plaintiff. Such extrinsic evidence consists of Plaintiff's accompanying Declaration and exhibits. Those documents confirm that Plaintiff owns the patent-in-suit and has retroactive enforcement authority.

Specifically, according to his proffered Declaration and

exhibits, Plaintiff was, and is, the sole shareholder of Advanced Data Solutions Corp. (ADS), an entity that previously owned the patent-in-suit. (Tormasi Decl. ¶¶ 7-10.) While serving as an ADS director and ADS executive, Plaintiff authorized and executed various intellectual-property Assignments in 2007, 2009, and 2019. (Tormasi Decl. ¶¶ 16-17, 23, 28-30; Tormasi Decl. Exhs. C, D, G, H, L.) Those Assignments, which included the Assignment appended to Plaintiff's Complaint, conveyed to Plaintiff all right, title, and interest in the patent-in-suit. (Tormasi Decl. Exhs. D, H, L.) Notably, the Assignments from 2007 and 2009 were executed prior to the cause of action (i.e., before the six-year period preceding Plaintiff's Complaint), with the Assignments from 2009 and 2019 giving Plaintiff express retroactive enforcement authority. (Tormasi Decl. Exhs. D, H, L.)

Like the allegations in his Complaint, Plaintiff's Declaration and exhibits establish his standing to sue under 35 U.S.C. § 281. This is because, pursuant to Arachnid, supra, Plaintiff has proven his ownership of the patent-in-suit during the term of infringement or, at the very least, proven his authority to sue for pre-ownership acts of infringement.

In challenging Plaintiff's ownership of the patent-in-suit, Defendant postulates that Plaintiff cannot present evidence establishing his status as an ADS shareholder, director, and

executive. Relying on that premise, Defendant contends that Plaintiff lacked authority to execute ADS assignments.

Contrary to Defendant's premise, Plaintiff's Declaration establishes his formation of ADS; his service as an ADS director; his appointment to various executive positions, including President and Chief Executive Officer; and his ownership of all ADS stock. (Tormasi Decl. ¶¶ 7-10, 16-17, 23, 32-33; Tormasi Decl. Exhs. C, D, G, H, L.) To Defendant's point, Plaintiff acknowledges his inability to produce certain ADS records due to seizure by prison officials. (Tormasi Decl. ¶¶ 13, 35.) However, Plaintiff's Declaration, which is supported by corroborating evidence (see Tormasi Decl. ¶ 33), is sufficient to prove his ADS ownership/stewardship. Defendant is thus incorrect is arguing that Plaintiff lacked authority to represent ADS and execute assignments on its behalf.

In its Motion to Dismiss, Defendant relies heavily on the fact that ADS entered defunct status in 2008. Defendant believes that such an irregularity prevented ADS from executing any post-2008 assignments, particularly the Assignment from 2019. Defendant therefore argues that ADS continues to hold legal title to the patent-in-suit and, consequently, that Plaintiff lacks standing to sue under 35 U.S.C. § 281. These arguments are without merit for multiple reasons.

First and foremost, long-standing Delaware law permits

defunct corporations to enter into binding contracts under certain circumstances. See Krapf & Son, Inc. v. Gorson, 243 A.2d 713, 715 (Del. 1968). Those circumstances include situations where "the forfeiture of the [corporate] charter came about by inadvertence" and where the contract was executed "in the absence of fraud or bad faith." Id. Both circumstances were present here, making the post-2008 Assignments valid.

As detailed in his Declaration, Plaintiff expected his family members to pay yearly fees to The Company Corporation for purposes of maintaining regulatory compliance. (Tormasi Decl. ¶¶ 19, 37.) Plaintiff recently learned, however, that his father suffered medical disabilities and failed to make such payments, causing Delaware officials to place ADS on defunct status in 2008. (Tormasi Decl. ¶ 37.) But because Plaintiff did not learn about the corporate default until receiving Defendant's Motion to Dismiss, Plaintiff assumed that ADS remained in good standing with Delaware officials and operated ADS accordingly. (Tormasi Decl. ¶¶ 37-39.) Ultimately, Plaintiff authorized and executed two post-2008 Assignments in his capacity as an ADS director and executive. (Tormasi Decl. ¶¶ 23, 28, 32; Tormasi Decl. Exhs. G, H, L.)

These circumstances render Plaintiff's Assignments from 2009 and 2019 authoritative despite the 2008 default by ADS. In accordance with Krapf, supra, Plaintiff has demonstrated that

the corporate default was "inadvertent" and that the post-2008 Assignments were executed "in the absence of fraud or bad faith." 243 A.2d at 715. The Assignments from 2009 and 2019 are therefore "binding on the corporation." Id.

This Court must, of course, abide by Krapf. Simply stated, federal courts are prohibited from overruling state courts on questions of state law. The ruling in Krapf is therefore controlling and must be followed and applied here.

In its Motion to Dismiss, Defendant appears to argue that Krapf is inconsistent with certain Delaware statutes and is inapplicable to the facts of this case. That argument must be rejected. First, even if Krapf is somehow materially distinguishable, Plaintiff relies on Krapf for its legal holding, not its factual similarity. Second, despite Defendant's diverging views on the impact of certain Delaware statutes, Krapf constitutes final authority in interpreting Delaware law and, as noted, must be followed and applied.

It stands to reason that Krapf is controlling and cannot be sidestepped. But even if Krapf is disregarded, Defendant continues to be wrong in arguing that ADS became incapacitated after defaulting with Delaware officials in 2008.

It is well established that improperly maintained corporations can exist de facto, with de facto corporations being equivalent to legally compliant corporations. See

C.J.S. Corporations §§ 63-64, at pp. 336-39 (West Publishing Co. 1990). It is also well established that defunct corporations continue to maintain their corporate existence for asset-disposal purposes and, further, that executives and directors of defunct corporations are permitted to retain and exercise their corporate powers and duties. See id. §§ 859, 962-64, at pp. 514, 516-21; 8 Del. Code Ann. § 278.

Based on the circumstances outlined in Plaintiff's Declaration, it is clear that ADS assumed de facto corporate status after inadvertently defaulting with Delaware regulators in 2008. It is also clear that the subsequent Assignments from 2009 and 2019 were undertaken by ADS for asset-disposal purposes. For those reasons, ADS and its stewardship had the power to authorize and execute post-2008 assignments.

Defendant's invalidity arguments are flawed in other respects. Aside from incorrectly presuming that ADS became incapacitated after its 2008 default, Defendant fails to recognize that assets of unindebted corporations are distributed to shareholders. See C.J.S. Corporations, supra, § 875, at pp. 533-34; 8 Del. Code Ann. § 281. In this case, Plaintiff was, and continues to be, the sole shareholder of ADS, with ADS having no debt/creditors. (Tormasi Decl. ¶¶ 9-10, 41.) So even if Defendant were correct that ADS instantly evaporated in 2008, all ADS assets would have been transferred to Plaintiff,

making him the current owner of the patent-in-suit.

In any event, Defendant's invalidity arguments have no bearing on Plaintiff's pre-2019 Assignments. As explained above, Plaintiff, in his capacity as an ADS director and executive, authorized and executed Assignments in June 2007 and December 2009. (Tormasi Decl. ¶¶ 16-17, 23; Tormasi Decl. Exhs. C, D, G, H.) Those Assignments remain outstanding and binding, even after ADS defaulted with regulators in 2008.

With that said, Plaintiff acknowledges that the Assignment from December 2009 was executed after the 2018 corporate default. That post-2008 Assignment, however, continues to be authoritative under Delaware law. Pursuant to 8 Del. Code Ann. § 278, "corporations, whether they expire by their own terms or are otherwise dissolved, shall nevertheless be continued, for the term of 3 years . . . to dispose of and convey their property . . . and to distribute to their stockholders any remaining assets." Here, ADS was voided in 2008. In accordance with 8 Del. Code Ann. § 278, ADS had until 2011 (three years) to transfer its property. The Assignment from 2009 fell within the three-year window, making that Assignment valid.

The upshot, of course, is that Plaintiff currently owns the patent-in-suit. Equally important, Plaintiff was the title holder during the cause of action and/or had retroactive enforcement authority. Because these conclusions survive

Defendant's evidentiary and legal challenges, Plaintiff has standing to sue under 35 U.S.C. § 281. Defendant's arguments to the contrary are without merit, mandating rejection.

POINT II

ADMINISTRATIVE PRISON REGULATIONS DO NOT, AND CANNOT, TAKE AWAY PLAINTIFF'S CAPACITY TO BRING THE PRESENT INFRINGEMENT ACTION.

Defendant asserts that Plaintiff lacks the capacity to sue under state law. Defendant bases its argument on prison regulations prohibiting inmates from operating businesses while imprisoned. Defendant's lack-of-capacity argument must be rejected, as prison regulations do not, and cannot, prevent Plaintiff from personally suing for patent infringement.

It is well established that prisoners retain the right of access to the courts under the First and Fourteenth Amendments. Bounds v. Smith, 430 U.S. 817 (1977). Pursuant to that right, prison officials must allow prisoners to file civil lawsuits and, conversely, are prohibited from "frustrat[ing] or . . . imped[ing]" any "nonfrivolous legal claim." Lewis v. Casey, 518 U.S. 343, 349, 353 (1996).

Judging from its Motion to Dismiss, Defendant seeks to lay aside Plaintiff's First and Fourteenth Amendment rights by preventing Plaintiff from filing suit while imprisoned. That incapacitation effort is untenable, to say the least.

Defendant is certainly correct that New Jersey inmates are

prohibited from operating businesses without administrative approval. N.J. Admin. Code § 10A:4-4.1(a)(3)(xiv). That prohibition, however, was never intended to supersede Plaintiff's right to file civil lawsuits in his personal capacity. In fact, prison regulations recognize that "[i]nmates have [the] constitutional right of access to the courts," going so far as requiring "[c]orrectional facility authorities [to] assist inmates in the preparation and filing of meaningful legal papers." N.J. Admin. Code § 10A:6-2.1.

To Plaintiff's knowledge, no court has ever invoked an administrative regulation to prevent inmates from suing. Nor has any court ever deemed personal litigation by an inmate tantamount to conducting prohibited business operations.

In support of its lack-of-capacity argument, Defendant cites various nonbinding cases, including Tormasi v. Hayman, 443 Fed. Appx. 742 (3d Cir. 2011). The most that can be said of such nonbinding cases is that prison officials will not be held liable under 42 U.S.C. § 1983 for seizing business-related documents from inmates. The issue here, however, is Plaintiff's capacity to sue, not the liability of prison officials. The cases cited by Defendant are therefore inapposite.

To its credit, Defendant correctly observes that Plaintiff's capacity to sue must be determined by the laws of his domicile. Fed. R. Civ. P. 17(b). Plaintiff resides in New

Jersey, making the laws thereof controlling.

Significantly, according to New Jersey statute, "[e]very person who has reached the age of majority . . . and has the mental capacity may prosecute or defend any action in any court, in person or through another duly admitted to the practice of law." N.J. Stat. Ann. § 2A:15-1. Thus, to bring suit in New Jersey, either personally or through an attorney, Plaintiff must have "reached the age of majority," which occurs at age 18 or age 21 (see N.J. Stat. Ann. § 9:17B-3); and must have possessed "mental capacity." N.J. Stat. Ann. § 2A:15-1. The litigant's imprisonment status or prison behavior is irrelevant to the capacity-to-sue standard. N.J. Stat. Ann. § 2A:15-1.

It cannot be disputed that Plaintiff is well over the ages of 18 or 21, especially considering that Plaintiff has been imprisoned at an adult penitentiary for two decades and is now near mid-life. (Tormasi Decl. ¶¶ 3, 6.) It also cannot be disputed that Plaintiff is intellectually capable, as evidenced by his educational and creative accomplishments. (Tormasi Decl. ¶¶ 4-6.) Plaintiff, in short, has met majority and competency requirements under N.J. Stat. Ann. § 2A:15-1. He therefore has the capacity to sue despite his imprisonment status.

For the sake of completeness, it must be mentioned that legislation previously existed preventing New Jersey inmates from suing while imprisoned. N.J. Stat. Ann. § 59:5-3 (repealed

by L. 1988, c. 55, § 1). Such legislation was deemed unconstitutional 37 years ago. Holman v. Hilton, 542 F. Supp. 913 (D.N.J. 1982), aff'd, 712 F.2d 854 (3d Cir. 1983).

Now, in 2019, there are no laws on the books in New Jersey declaring imprisonment status or prison behavior an incapacity for filing lawsuits. And even if such laws existed, those laws would certainly run afoul of the First and Fourteenth Amendments. Needless to say, Defendant's lack-of-capacity argument is legally unsupportable and must be rejected.

POINT III

PLAINTIFF ADEQUATELY ALLEGED DEFENDANT'S LIABILITY FOR WILLFUL INFRINGEMENT, THEREBY COMPLYING WITH PLEADING REQUIREMENTS.

Also without merit is Defendant's objection to Plaintiff's willful-infringement claim (Count II). Plaintiff had alleged willful infringement for the purpose of seeking "enhanced damages." (Compl. ¶ 44; Compl., Prayer for Relief, ¶ E, at pp. 12-13.) As discussed below, Plaintiff's willful-infringement claim meets pleading standards under Rule 8(a)(2).

It is well established that plaintiffs must do more than allege the violation of law. See Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (finding inadequate "labels and conclusions" or mere "formulaic recitation of the [claim] elements") (internal quotation marks omitted). Instead, plaintiffs must demonstrate entitlement to relief by pleading circumstances supporting civil

liability. Id. Where such circumstances "ha[ve] facial plausibility" and "allow[] the court to draw the reasonable inference that the defendant is liable for the misconduct," then the pleading passes muster under Rule 8(a)(2). Id.

In his Complaint (which must be accepted as true at this juncture), Plaintiff alleged that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301" but nevertheless "intentionally circulated infringing devices." (Compl. ¶ 36.) In support of that willful-infringement contention, Plaintiff recounted various "surrounding circumstances." (Compl. ¶ 37.)

The first circumstance concerned Defendant's process of "review[ing] all published patent applications pertaining to the field of magnetic storage and retrieval." (Compl. ¶ 39.) In conducting that review process, Defendant personally "encountered, and therefore had actual knowledge of, Plaintiff's published patent application." (Compl. ¶ 39.)

The second circumstance concerned "the timing of Defendant's adoption of [Plaintiff's disclosed] actuator improvements/innovations." (Compl. ¶ 37.) As alleged in Plaintiff's Complaint, "Defendant began utilizing dual-stage actuator systems and tip-mounted actuators approximately two or three years after the publication of Plaintiff's patent application." (Compl. ¶ 41.) Significantly, "[t]hat delayed

implementation correspond[ed] with the lead time needed to research and develop new technology." (Compl. ¶ 41.) The import is that "Defendant began researching and developing its dual-stage actuator systems and tip-mounted actuators within weeks or months after having actual knowledge of Plaintiff's published patent application." (Compl. ¶ 41.)

The third circumstance concerned the sine qua non of this civil action, namely, that Defendant "infring[ed] upon Plaintiff's patent as alleged." (Compl. ¶ 36.) In that regard, Plaintiff recounted seven instances of infringement. (Compl. ¶¶ 26-32.) He alleged that such infringement occurred via "element-by-element structural correspondence" or, at the very least, "under the doctrine of equivalents" given "similarities in function, way, and result." (Compl. ¶¶ 25, 32-33.)

In his Complaint, Plaintiff alleged that the foregoing circumstances were "indicative of Defendant's willful infringement." (Compl. ¶ 42.) Accordingly, by virtue of Defendant's alleged willful infringement, Plaintiff demanded "enhanced damages" totaling "three times base damages." (Compl. ¶ 44; Compl., Prayer for Relief, ¶ E, at pp. 12-13.)

These circumstances, all of which have "facial plausibility," demonstrate Plaintiff's entitlement to relief on his willful-infringement claim. To qualify for enhanced damages under 35 U.S.C. § 284, the defendant's alleged

willfulness need only exist on the subjective level, i.e., "without regard to whether [the] infringement was objectively reasonable." Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1933 (2016). Where such subjective willfulness is established, the defendant's behavior will generally be deemed "egregious" and warrant "enhanced damages under patent law." Id. at 1934. Plaintiff's allegations meet these standards, opening the door for enhanced damages.

Defendant, to reiterate, is accused of having actual knowledge of Plaintiff's patent application and of cultivating the underlying technology shortly thereafter. (Compl. ¶¶ 39-42.) Defendant is also accused of "intentionally circulating infringing devices" and, more specifically, of having actual knowledge "that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." (Compl. ¶¶ 36, 44.) These allegations demonstrate that Defendant possessed the requisite mens rea (subjective willfulness) under Halo.

Defendant advances three grounds in disputing Plaintiff's willful-infringement allegations. Those grounds, however, do not establish the inadequacy of Plaintiff's allegations.

Defendant first contends that Plaintiff failed to plead Defendant's knowledge of the patent-in-suit. That contention is simply untrue. Although Plaintiff focused his allegations on Defendant's discovery of the application disclosing Plaintiff's

invention, Plaintiff did indeed allege actual knowledge of the patent-in-suit. Specifically, in two paragraphs of his Complaint, Plaintiff alleged that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." (Compl. ¶¶ 36, 44.) That allegation, when construed in Plaintiff's favor, unequivocally accuses Defendant of having actual knowledge of the patent-in-suit, thereby complying with governing law.

In its second ground of attack, Defendant argues that Plaintiff's willful-infringement allegations do not arise to the level of "egregious misconduct" necessary for awarding enhanced damages. This contention is similarly baseless. The Court in Halo made clear that "egregious cases [of infringement are] typified by willful misconduct." 136 S. Ct. at 1934. Thus, by alleging willful infringement, Plaintiff alleged, by implication, that Defendant acted egregiously. Enhanced damages are therefore permitted under 35 U.S.C. § 284.

Also with merit is Defendant's argument that Plaintiff's willful-infringement claim fails to meet the pleading standards set forth in Iqbal. Perhaps Defendant would be correct had Plaintiff recounted implausible events or merely alleged willful infringement without detailing any supporting facts. In this case, Plaintiff went one step farther by pleading specific circumstances, all of which were plausible. Plaintiff's

allegations are therefore sufficient under Iqbal.

With that said, Plaintiff acknowledges that his allegations of willful infringement must ultimately be proven. That issue, however, is premature. For present purposes, it suffices to say that Plaintiff met governing pleading standards. Plaintiff's willful-infringement claim should therefore proceed to the discovery stage, at which time Plaintiff intends to substantiate his current allegations and to uncover "[o]ther evidence . . . regarding Defendant's knowledge, belief, and intent." (Compl. ¶ 43.) Such an opportunity should be afforded to Plaintiff given his well-pleaded allegations of willful infringement.

Finally, assuming, arguendo, that Defendant's miscellaneous pleading-related attacks have merit, Plaintiff respectfully requests leave to amend his Complaint. As the Court is aware, leave to amend should be freely granted when "justice so requires." Fed. R. Civ. P. 15(a)(2). The interest-of-justice condition is typically satisfied in situations where the pleading deficiency is capable of being cured. See Lopez v. Smith, 203 F.3d 1122, 1127 (9th Cir. 2000) (en banc).

In this case, Plaintiff contingently qualifies for leave to amend. Defendant argues, among other things, that Plaintiff failed to plead pre-suit knowledge of the patent and failed to satisfy pleading standards under Iqbal. Although Plaintiff disagrees with Defendant's arguments, Plaintiff can, if

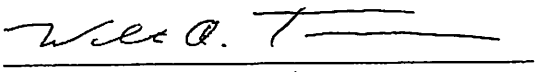
necessary, cure all pleading deficiencies asserted. Under these circumstances, leave to amend is entirely appropriate and, frankly, mandated in the interest of justice.

CONCLUSION

For the above reasons, Plaintiff has standing to sue (Point I) and has requisite suing capacity (Point II), making the present lawsuit cognizable. Additionally, Plaintiff adequately pled his willful-infringement claim (Point III). This Court should therefore deny Defendant's Motion to Dismiss in its entirety. Finally, insofar as Plaintiff's willful-infringement claim is deficient, leave to amend should be granted.

Respectfully submitted,

PRO SE



Walter A. Tormasi

Dated: May 15, 2019

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WALTER A. TORMASI,	:	CASE NO. 4:19-cv-00772-HSG
Plaintiff,	:	DECLARATION OF WALTER A. TORMASI IN OPPOSITION TO DEFENDANT'S MOTION TO DISMISS
v.	:	
WESTERN DIGITAL CORP.,	:	
Defendant.	:	

WALTER A. TORMASI, under penalty of perjury in lieu of oath, pursuant to 28 U.S.C. § 1746, declares as follows:

1. I am the Plaintiff in the above-captioned matter and am making this Declaration, based on personal knowledge, in opposition to Defendant's Motion to Dismiss.

2. Through this Declaration, and through the exhibits attached hereto, I can establish my ownership of the patent-in-suit, Serial No. 7,324,301. Specifically, as detailed below, I can establish that I am the sole shareholder of

Advanced Data Solutions Corp. (ADS) and, in my capacity as an ADS director and executive, had authorized and executed various intellectual-property Assignments in 2007, 2009, and 2019 (see Exhibits D, H, and L). Those Assignments, all of which are demonstrably valid, vested me with full ownership of the patent-in-suit. Thus, pursuant to 35 U.S.C. § 281, I have standing to bring the present infringement action.

3. By way of background, I am incarcerated at New Jersey State Prison (NJSP), an adult maximum-security penitentiary located in the City of Trenton. I arrived at NJSP in September 2000 and have been confined at NJSP since then.

4. During my imprisonment, I strove mightily to utilize available resources to educate, train, and improve myself. For example, I enrolled in and completed numerous educational courses, including an exhaustive paralegal program offered by the Blackstone School of Law. I also read well over 1000 books and periodicals covering diverse subjects and disciplines, including technology (such as electronics and computers), mathematics (such as trigonometry and calculus), science (such as physics and chemistry), business (such as finance and management), medicine (such as biology and psychology), and philosophy (such as metaphysics and epistemology).

5. During my imprisonment, and throughout the years preceding my lawsuit, I have been peacefully and constructively

exercising my intellectual capabilities by forming ideas, conceptualizing those ideas into novel and non-obvious devices, and memorializing my inventive thoughts in writing.

6. In early 2003, at the age of 23, I invented an improvement in the field of magnetic storage and retrieval. I took steps to protect my invention and, on May 3, 2004, filed U.S. Provisional Patent Application No. 60/568,346.

7. Shortly after conceiving my invention, I decided to form an intellectual-property holding company. Accordingly, using the agency services of The Company Corporation, I caused an incorporation Certificate to be drafted and filed with the State of Delaware. Pursuant to that Certificate (see Wilson Decl. Exh. 4), I formed Advanced Data Solutions Corp., an entity whose corporate charter permitted perpetual existence.

8. In my capacity as an ADS director, I appointed myself to serve in various executive positions, including Chief Executive Officer, President, and Chief Technology Officer.

9. Additionally, in my capacity as an ADS director, I adopted Corporate Resolutions in early 2004. Those Resolutions provided that ADS issue to me all shares of stock in exchange for my transferring to ADS complete right, title, and interest in U.S. Provisional Patent Application No. 60/568,346 and in any related domestic and foreign applications and patents.

10. Pursuant to the foregoing Corporate Resolutions,

ADS and I executed an Assignment of Patent Application Agreement. The Agreement, dated May 17, 2004, memorialized and paralleled the aforementioned Corporate Resolutions. Thus, with the execution of the Agreement, I became the sole ADS shareholder, with ADS owning all applications/patents stemming from U.S. Provisional Patent Application No. 60/568,346.

11. Thereafter, on January 10, 2005, I filed U.S. Patent Application No. 11/031,878. The following month, in accordance with my Assignment of Patent Application Agreement, I executed an Assignment conveying to ADS all right, title, and interest in U.S. Patent Application No. 11/031,878. The Assignment was dated February 7, 2005, and was recorded with the United States Patent and Trademark Office (USPTO) under Reel/Frame Nos. 016299/0034 and 018892/0313 (see Wilson Decl. Exh. 2).

12. The patent-acquisition process took three years. The process began on January 10, 2005 (which constitutes the filing date of my application), and ended on January 29, 2008 (which constitutes the issuance date of the patent-in-suit).

13. During the patent-acquisition process, on March 3, 2007, prison officials removed from my possession various legal documents. Among the documents seized by prison officials were my ADS corporate files, which included, among other things, the Corporate Resolutions and the Assignment of Patent Application Agreement described above. To date, prison

officials continue to possess such legal documents.

14. Eleven weeks after seizing my ADS corporate files, on May 23, 2007, prison officials charged me with committing an institutional infraction for operating ADS without having administrative approval (see Exhibit A). I was found guilty of that charge and sanctioned to 7 days of solitary confinement, 90 days of administrative segregation, and 60 days of loss of commutation time (see Exhibit B). I was also warned, explicitly and unequivocally, that my continued involvement with ADS matters subjected me to further disciplinary action.

15. Based on such conduct by prison officials, I feared that my control and ownership over ADS (and thus my control and ownership over my intellectual property) were in jeopardy. I therefore decided to take precautionary measures to ensure that my intellectual property remained enforceable, licensable, and sellable to the fullest extent possible.

16. Accordingly, in my capacity as an ADS director, I adopted Corporate Resolutions on June 6, 2007, wherein ADS agreed to transfer to me ownership in U.S. Patent Application No. 11/031,878, including any ensuing patents, upon the occurrence of certain events (see Exhibit C). The specified ownership-transferring contingencies included the dissolution of ADS, as well as my inability to discharge my duties as an ADS executive or director, my inability to fully exercise my powers

as an ADS shareholder, and my inability to benefit from intellectual property held by ADS (see Exhibit C).

17. Under authority of the foregoing Corporate Resolutions, I executed an Assignment, also dated June 6, 2007, memorializing the transfer in ownership (see Exhibit D).

18. The patent-in-suit, Serial No. 7,324,301, was issued by USPTO in January 2008 (see Exhibit E). Pursuant to my previously recorded Assignment executed on February 7, 2005, the patent-in-suit listed ADS as the registered assignee.

19. During the ensuing years, I entrusted my father, Attila Istvan Tormasi, to pay yearly fees to my Delaware agent (i.e., The Company Corporation) for the purpose of complying with the corporate laws of the State of Delaware. I expected my father to pay such yearly fees until his death in November 2010, after which time I expected my brother, as an executor of my father's estate, to assume payment responsibility.

20. It is worth noting that I also expected my father and brother to allow me to use their residential and commercial properties for ADS-related matters. Consequently, upon its formation until present, ADS had offices located at 105 Fairview Avenue in Somerville, New Jersey; at 1828 Middle Road in Martinsville, New Jersey; at 1602 Sunny Slope Road in Bridgewater, New Jersey; and at other addresses. Those properties were owned or leased by my father or brother, both of

whom had given me permission to use such properties during my pursuance of ADS-related activities over the years.

21. Meanwhile, in late 2009 (about two years after issuance of the patent-in-suit), I encountered an article in Maximum PC. The article discussed Defendant's use of dual-stage actuator systems within its hard disk drives. The article in question (Exhibit F) led me to believe that Defendant, and perhaps its competitors, had committed patent infringement.

22. I decided to defend my intellectual-property rights via civil litigation. However, because corporations may appear in federal court only through an attorney, and because ADS did not have such legal representation, I took steps to acquire personal ownership in U.S. Patent No. 7,324,301.

23. Specifically, on December 27, 2009, I adopted Corporate Resolutions (Exhibit G) and executed an Assignment (Exhibit H), wherein ADS transferred to me all right, title, and interest in the patent-in-suit, Serial No. 7,324,301. The purpose of the transfer in ownership was to permit me to personally pursue, and to personally benefit from, an infringement action against Defendant and others.

24. Despite reclaiming title to the patent-in-suit, I did not immediately take civil action. I instead attempted to perform technical research regarding Defendant's hard disk drives. My research efforts, however, were greatly impeded due

to my imprisonment and surrounding circumstances.

25. Having failed to make meaningful headway in my research efforts, I sent letters to numerous attorneys seeking assistance for research and litigation purposes. I received multiple responses over the years, with all such responses expressing inability or unwillingness to assist.

26. For illustrative purposes, I have attached three responses to my solicitation requests (see Exhibits I, J, and K). Those responses confirm my unsuccessful efforts to secure legal assistance. I received other responses, but I cannot locate those responses given the passage of time and given intervening cell searches by prison officials.

27. Meanwhile, during the ensuing years, I became preoccupied with litigating my criminal case and with unwinding previously filed lawsuits and civil appeals. I therefore had no choice but to temporarily suspend my infringement-related efforts. I revived those efforts just recently.

28. I filed the current lawsuit on February 12, 2019 (see Docket Entry No. 1), doing so in my individual capacity. In support of my ownership of the patent-in-suit and thus my standing to sue, I appended to my Complaint an Assignment dated January 30, 2019 (resubmitted herewith as Exhibit L).

29. The Assignment appended to my Complaint was intended to serve as confirmatory evidence. That is, my purpose for

executing the Assignment dated January 30, 2019, was to provide up-to-date evidence confirming that I did indeed own the patent-in-suit and had express authority to sue for all acts of infringement occurring during the cause of action.

30. As noted above, prior Assignments had been executed on June 6, 2007, and December 27, 2009 (see Exhibits D and H, respectively). By executing and appending to my Complaint the confirmatory Assignment dated January 30, 2019, I had no intention of repudiating or supplanting the Assignments from June 2007 and December 2009. Those prior Assignments, accordingly, remain outstanding and binding.

31. In its Motion to Dismiss, Defendant postulates that no evidence exists proving that I am an ADS shareholder, director, and executive. Relying on that premise, Defendant contends that I lacked authority to execute ADS assignments.

32. In response to Defendant's postulation, I now proffer this Declaration, and I now verify, under penalty of perjury, that I am the sole shareholder of ADS and served as an ADS director and executive in approving and executing the Assignments from June 2007, December 2009, and January 2019.

33. For the sake of completeness, I must mention that my status as an ADS owner, executive, and director is supported by corroborating evidence. Such evidence includes: (1) my Corporate Resolutions from 2007 and 2009, which verified my ADS

ownership and management roles (see Exhibits C and G); (2) my institutional disciplinary charge from 2007, which verified my "possess[ion] [of ADS] paperwork [and ADS] legal documents pertaining to [its] initial start up &/or operation" (see Exhibit A); (3) my civil-rights complaints from 2008 and 2009, which verified that I was "the sole shareholder of ADS and function[ed] as its authorized agent" and which detailed the circumstances leading to my ADS ownership (see Wilson Decl. Exh. 3, at pp. 3, 6-8; Wilson Decl. Exh. 12, at pp. 3, 6-8); and (4) various deeds and other legal documents from 2009-2012, which verified that the postal addresses from which I conducted ADS-related activities (including the Fairview Avenue and Middle Road addresses) were associated with properties owned by my brother or father (see Wilson Decl. Exhs. 6, 7, 8).

34. In short, Defendant is incorrect in postulating my inability to prove my ADS ownership and stewardship. The present Declaration, which is supported by corroborating evidence, constitutes such proof of ownership/stewardship.

35. Insofar as Defendant takes issue with my failure to produce the Assignment of Patent Application Agreement and related Corporate Resolutions from 2004 (pursuant to which I became the sole ADS shareholder), those documents were seized by prison officials in 2007 and are therefore no longer in my possession. Thus, despite my willingness to produce all

relevant ADS records demanded by Defendant, I am prevented from doing so due to the conduct of prison officials.

36. In its Motion to Dismiss, Defendant notes that ADS had been defunct since 2008. Defendant contends that such defunct status prevented ADS from executing post-2008 assignments, particularly the Assignment appended to my Complaint.

37. For the record, I did not learn about the 2008 corporate default of ADS until receiving Defendant's Motion to Dismiss. Surprised by that revelation, I conducted follow-up inquiries, at which point I discovered that my father had been experiencing debilitating health issues during the years preceding his death. Those health issues, from what I discovered, prevented my father from paying yearly fees to my Delaware agent. That unexpected nonpayment apparently resulted in tax delinquencies, causing the State of Delaware to place ADS on defunct status in 2008 (see Wilson Decl. Exh. 10).

38. Between my formation of ADS until present, I never intended for ADS to run afoul of the corporate laws of Delaware, making the 2008 default by ADS entirely inadvertent.

39. In executing the Assignments from 2009 and 2019, I believed that ADS remained in good standing with Delaware officials. Additionally, in executing the Assignments from 2009 and 2019, I intended to effectuate, confirm, and/or memorialize lawful intellectual-property transfers. In other words, I

executed all post-2008 Assignments sincerely and honestly, i.e., in the absence of fraud, bad faith, or the like.

40. For those reasons, among others, I disagree with the premise that the post-2008 Assignments were invalid or that ADS became incapacitated upon entering defunct status in 2008.

41. Now, for the sake of completeness, I note that ADS had no debt/creditors during its existence. I also stress that I was, and continue to be, the sole ADS shareholder. Thus, even assuming that ADS instantly disintegrated upon defaulting in 2008, all ADS assets would have been distributed to me in accordance with established dissolution procedures.

42. In light of the foregoing circumstances, I consider myself having current ownership of the patent-in-suit. This is because one or more of the contingencies specified in the Assignment from June 2007 were met; because the post-default Assignments from December 2009 and January 2019 were authoritative or, at the very least, superfluous; because ADS and its stewardship properly exercised their asset-transferring powers at all times; and because of other reasons.

43. Additionally, aside from owning the patent-in-suit, I consider myself having authority to sue for all acts of infringement occurring during the six-year period preceding my Complaint (that is, for acts of infringement occurring since February 12, 2013). This is because the Assignments from June

2007 and December 2009 were executed prior to the cause of action, with the Assignment from January 2019 explicitly providing me with retroactive enforcement authority.

44. In summary, given that I hold legal title to U.S. Patent No. 7,324,301, and given that the aforementioned Assignments were executed before the cause of action and/or had express retroactive effect, I have standing to bring the present infringement action pursuant to 35 U.S.C. § 281.

DECLARATION IN LIEU OF OATH

I declare, under penalty of perjury, that the foregoing facts are true. I also declare, under penalty of perjury, that the documentary exhibits attached hereto are genuine.

Walter A. Tormasi

Dated: May 15, 2019

Exhibit A

1L
92/3

STATE OF NEW JERSEY
DEPARTMENT OF CORRECTIONS

259 (p.3) (new 3/77)
Revised 8/80
Disciplinary Report
361306

A. DISCIPLINARY REPORT – INSTITUTION'S COPY

PRINT CLEARLY

1. NAME OF INMATE (Last, First): Tormassi, Walter NO. 136062

INSTITUTION: NJSP WING: 1L JOB ASSIGNMENT: n/a

2. PROHIBITED ACT (with code number): .705 - commencing/operating a business w/o prior Administrative approval.

3. REPORTING EMPLOYEE'S NAME: W. Maginnis TITLE: S/I SID

DATE: 5/23/07 SIGNATURE: W. Maginnis

4. PLACE OF ALLEGED INFRACTION: NJSP DATE: VARIOUS TIME: n/a

5. ANY IMMEDIATE SPECIAL ACTION TAKEN: NONE

AUTHORIZED BY: [signature] DATE: 23 May 07 TIME: 0902hrs

6. WITNESS(ES), NAME(S) AND NUMBER(S):

7. PHYSICAL EVIDENCE – DESCRIPTION AND DISPOSITION: confidential information on file

8. DESCRIPTION OF ALLEGED INFRACTION: An ongoing investigation has determined that inmate Tormassi - possessed paperwork/forms/legal documents pertaining to the initial start up &/or operation of an unauthorized business. Inmate Tormassi by this act - circumvented the procedural safeguards against inmates operating a business without prior approval.

9. COPY OF THIS REPORT DELIVERED TO ABOVE INMATE BY: [signature] Printed Name

SIGNATURE: [signature] DATE: 5/24/07 TIME: 0905hrs

INMATE READ "USE IMMUNITY" RIGHTS: [X] YES [ ] NO

THERE ARE 4 NUMBER OF ADDITIONAL PAGES ATTACHED TO THIS REPORT.

A. DISCIPLINARY REPORT – INSTITUTION'S COPY
B. INVESTIGATION (reverse side of this sheet)

Exhibit B

01/15/2019 18:29
COIFLET

State of New Jersey
Department of Corrections
Inmate Management
PROGRESS NOTES REPORT

NEW JERSEY STATE PRISON
BATCH: 202 OF 231

INM#	SBI#	Last Name	First Name	Init	Sfx	Location	Status
136062	000268030C	TORMASI	WALTER	A		NJSP-WEST-2 LEFT-FLATS-CELL 58;	MAX

Original
03/22/2007 09:00 356766
Heard By: MANISCALCO, SALVATORE
[redacted]
Reported By: DOLCE, R
Hearing Date: 03/26/2007
OBJ# 5

Appeal
Heard By: KANDELL, ALFRED

Sanctions: CMB Days ACT Comment: COMBINED WITH 009 CMB Days

Original
05/14/2007 09:00 360654
Heard By: RUGGIERO, MATTHEW
[redacted]
Reported By: SIERRA, V
Hearing Date: 05/30/2007
OBJ# 5

Appeal
Heard By:

Sanctions:				
DTN	Days 15	ACT	Comment:	
CRTS	Days	ACT	Comment:	
RCSEG	Days 365	ACT	Comment:	
RELCT	Days 365	ACT	Comment:	

Original
05/23/2007 09:00 361306
Heard By: RUGGIERO, MATTHEW
705 OPER.BUS./GROUP W/O APPROVAL
Reported By: MAGINNIS, W
Hearing Date: 05/30/2007
OBJ# 3

Appeal
Heard By:

Sanctions:				
DTN	Days 7	ACT	Comment:	C/S TO 102
RCSEG	Days 90	ACT	Comment:	C/S TO 102
RELCT	Days 60	ACT	Comment:	C/S TO 102

Exhibit C

Corporate Resolutions

WHEREAS Walter A. Tormasi (Tormasi) is the one and only shareholder of Advanced Data Solutions Corp. (ADS) and serves as an ADS director and ADS executive officer; and

WHEREAS Tormasi formed ADS for the purpose of functioning as an intellectual-property holding company; and

WHEREAS Tormasi previously assigned to ADS ownership in U.S. Provisional Patent Application No. 60/568,346, ownership in U.S. Patent Application No. 11/031,878, and ownership in all patents stemming from said applications; and

WHEREAS Tormasi is incarcerated at New Jersey State Prison and, due to his incarceration, is subject to the whims, restrictions, and conduct of prison officials; and

WHEREAS officials at New Jersey State Prison recently seized from Tormasi various ADS-related documents; and

WHEREAS officials at New Jersey State Prison recently took disciplinary action against Tormasi for ADS-affiliated activities, said disciplinary action consisting of 7 days of solitary confinement, 90 days of administrative segregation, and 60 days of loss of commutation credits; and

WHEREAS officials at New Jersey State Prison recently threatened Tormasi with further disciplinary action for his continued involvement with ADS operations; and

WHEREAS Tormasi fears that his property rights are now in jeopardy, particularly Tormasi's ability to exercise control over ADS and, by extension, benefit from the above patent applications, including any patents stemming therefrom; and

WHEREAS Tormasi and ADS desire that any patents stemming from the above patent applications remain enforceable, licensable, and sellable to the fullest extent possible;

NOW, THEREFORE, IT IS AGREED, RESOLVED, AND RATIFIED, ON THIS 6TH DAY OF JUNE 2007, AS FOLLOWS:

1. In the event that Tormasi is unable to discharge his duties as an ADS director or executive, then all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications shall be automatically assigned/transferred to Tormasi.

2. In the event that Tormasi is unable to fully exercise

his powers as an ADS shareholder/owner, then all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications shall be automatically assigned/transferred to Tormasi.

3. In the event that ADS is dissolved or its corporate existence or status otherwise voided, nullified, or invalidated, then all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications shall be automatically assigned/transferred to Tormasi.

4. In the event that ADS becomes inactive or inoperable, then all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications shall be automatically assigned/transferred to Tormasi.

5. In the event that Tormasi, in his capacity as sole shareholder of ADS, is unable to directly or indirectly benefit from intellectual property held by ADS, then all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications shall be automatically assigned/transferred to Tormasi.

Walter A. Tormasi
Director and Sole Shareholder
Advanced Data Solutions Corp.

Dated: June 6, 2007

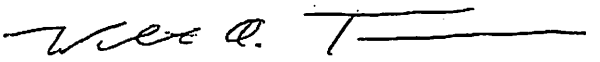
Exhibit D

Assignment of U.S. Patent Applications

Pursuant to the Corporate Resolutions of Advanced Data Solutions Corp. (ADS) issued on June 6, 2007,

1. ADS assigns to Walter A. Tormasi (Tormasi) all right, title, and interest in U.S. Provisional Patent Application No. 60/568,346, in U.S. Patent Application No. 11/031,878, and in all patents stemming from said applications.

2. Said assignment shall take effect upon the occurrence of any of the following events: (a) Tormasi is unable to discharge his duties as an ADS director or executive; or (b) Tormasi is unable to fully exercise his powers as an ADS shareholder/owner; or (c) ADS is dissolved or its corporate existence or status otherwise voided, nullified, or invalidated; or (d) ADS becomes inactive or inoperable; or (e) Tormasi, in his capacity as sole shareholder of ADS, is unable to directly or indirectly benefit from intellectual property held by ADS.



Walter A. Tormasi
CEO and Sole Shareholder
Advanced Data Solutions Corp.

Dated: June 6, 2007

Exhibit G

Corporate Resolutions

WHEREAS Walter A. Tormasi (Tormasi) is the one and only shareholder of Advanced Data Solutions Corp. (ADS) and serves as an ADS director and ADS executive officer; and

WHEREAS Tormasi intends to pursue patent-infringement litigation regarding U.S. Patent No. 7,324,301; and

WHEREAS Tormasi's wholly owned company, ADS, is the registered assignee of U.S. Patent No. 7,324,301; and

WHEREAS corporations many appear in federal court only through an attorney, something which ADS lacks; and

WHEREAS Tormasi and ADS desire that ownership in U.S. Patent No. 7,324,301 be transferred to Tormasi, said transfer intended to permit Tormasi to litigate patent-infringement proceedings in connection with said patent and to benefit therefrom;

NOW, THEREFORE, IT IS AGREED, RESOLVED, AND RATIFIED, ON THIS 27TH DAY OF DECEMBER 2009, AS FOLLOWS:

1. ADS shall assign to Tormasi all right, title, and interest in U.S. Patent No. 7,324,301.

2. Said assignment shall have retroactive effect.

3. Said assignment shall permit Tormasi, in his individual capacity, to pursue and financially benefit from any claims and remedies relating to U.S. Patent No. 7,324,301.

4. Said assignment shall permit Tormasi, in his individual capacity, to sue any and all third parties for any and all prior, current, and future acts of patent infringement.

5. As consideration for said assignment, Tormasi shall, at his option, either: (a) pay ADS the sum of $1 (one dollar); (b) return to ADS all shares of common stock previously issued to Tormasi; (c) forfeit all compensation to which Tormasi is entitled for serving as an ADS director and executive; or (d) waive reimbursement of expenses personally incurred by Tormasi in connection with his performance of ADS-related activities.

Walter A. Tormasi
Director and Sole Shareholder
Advanced Data Solutions Corp.

Dated: December 27, 2009

Exhibit H

Assignment of U.S. Patent No. 7,324,301

Pursuant to the Corporate Resolutions of Advanced Data Solutions Corp. (ADS) issued on December 27, 2009,

1. ADS assigns to Walter A. Tormasi (Tormasi) all right, title, and interest in U.S. Patent No. 7,324,301.

2. Said assignment shall have retroactive effect.

3. Said assignment shall permit Tormasi, in his individual capacity, to pursue and financially benefit from any claims and remedies relating to U.S. Patent No. 7,324,301.

4. Said assignment shall permit Tormasi, in his individual capacity, to sue any and all third parties for any and all prior, current, and future acts of patent infringement.

5. Regarding said assignment, ADS acknowledges receiving from Tormasi valuable consideration in exchange therefor.

Walter A. Tormasi
CEO and Sole Shareholder
Advanced Data Solutions Corp.

Dated: December 27, 2009

Exhibit I

SPERRY, ZODA & KANE
PATENT ATTORNEYS
SUITE D
ONE HIGHGATE DRIVE
TRENTON, NEW JERSEY 08618-2098

JOHN J. KANE
NEW JERSEY BAR

OF COUNSEL
FREDERICK A. ZODA
DISTRICT OF COLUMBIA BAR

ALBERT SPERRY
(1900-1997)

TELEPHONE
(609) 882-7575

FAX
(609) 882-5815

E-MAIL
johnkane@comcast.net

September 17, 2010

Walter A. Tormasi, ID No. 136062
New Jersey State Prison
P. O. Box 861
Trenton, NJ 08625

Re: Our File TORM-1-M
U.S. Patent No. 7,324,301

Dear Mr. Tormasi:

I have received your letter of September 8, 2010. At the present time I am not in the position to accept the extensive workload that is involved in regard to any infringement action. In any case, our firm has a policy of not accepting any litigation on a contingency fee basis as is similar with many patent law firms.

The maintenance fee that is reference in the last paragraph of your letter cannot be paid until after January 29, 2011. We will call this to your attention most likely at the end of January or early February to address the issue of payment. Best of luck in your endeavors.

Very truly yours,

John J. Kane

JJK:sam

Exhibit J

McCARTER &ENGLISH
ATTORNEYS AT LAW

Michael Friscia
Partner
T. 973.639.8493
F. 973.297.6627
mfriscia@mccarter.com

McCarter & English, LLP
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102-4056
T. 973.622.4444
F. 973.624.7070
www.mccarter.com

September 24, 2010

Mr. Walter A. Tormasi
ID Nos. 136062 and 268030C
New Jersey State Prison
P.O. Box 861
Trenton, NJ 08625

Re: U.S. Patent No. 7,324,301

Dear Mr. Tormasi:

Thank you for you inquiry. However, we will not take your case on a contingent fee arrangement. Accordingly, we do not and will not represent you in connection with your potential patent infringement matter.

Very truly yours,

Michael Friscia

MRF/dmb

ME1 10629648v.1

Exhibit K

NIRO, HALLER & NIRO

181 WEST MADISON STREET - SUITE 4600

CHICAGO, ILLINOIS 60602

TELEPHONE (312) 236-0733

FACSIMILE (312) 236-3137

RAYMOND P. NIRO
TIMOTHY J. HALLER
WILLIAM L. NIRO
JOSEPH N. HOSTENY, III
ROBERT A. VITALE, JR.
PAUL K. VICKREY
DEAN D. NIRO
RAYMOND P. NIRO, JR.
PATRICK F. SOLON
ARTHUR A. GASEY
CHRISTOPHER J. LEE
DAVID J. SHEIKH
VASILIOS D. DOSSAS
SALLY WIGGINS
RICHARD B. MEGLEY, JR.
MATTHEW G. McANDREWS
PAUL C. GIBBONS

GREGORY P. CASIMER
DINA M. HAYES
FREDERICK C. LANEY
DAVID J. MAHALEK
KARA L. SZPONDOWSKI
ROBERT A. CONLEY
LAURA A. KENNEALLY
TAHITI ARSULOWICZ
BRIAN E. HAAN
JOSEPH A. CULIG
ANNA B. FOLGERS
CHRISTOPHER W. NIRO
DANIEL R. FERRI
GABRIEL I. OPATKEN
OLIVER D. YANG

OF COUNSEL:
JOHN C. JANKA

November 11, 2010

Walter A. Tormasi
ID Nos. 136062 and 268030C
New Jersey State Prison
P.O. Box 861
Trenton, New Jersey 08625

Re: U.S. Patent No. 7,324,301

Dear Mr. Tormasi:

I did receive your letter of September 8. I have had number of deadlines as well as several trips since then, hence the delay.

I looked at your patent and the article about the Western Digital hard drive. I don't think there is enough information in the article to conclude that the device satisfies independent claim 2 or dependent claims 25-27, or independent claim 41 or dependent claims 61-63. The Caviar drive may very well have those features; there simply is not enough information in the article to so conclude. If you have further information regarding the drive, you can forward that to me and I will take a look at it. At that point we would have to run a formal conflicts check. I am virtually certain we've never represented any of these companies, but the conflicts check is required to be sure.

You need to consider whether you would be able to pay disbursements in the event there is litigation. Disbursements include court fees, travel expenses, depositions, experts, trial preparation, etc. They can be substantial, especially against companies that are of the size of those mentioned in your letter. When I say substantial, I mean that the costs can be hundreds of thousands of dollars. We do not advance costs. The client must either pay them or pursue a patent investor who would advance the costs in exchange for a share in the recovery.

Thanks for contacting us, and please get back to me at your convenience.

Sincerely,

Joseph N. Hosteny

JNH/mk

Erica D. Wilson (SBN 161386)
ericawilson@walterswilson.com
Eric S. Walters (SBN 151933)
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Western Digital
5601 Great Oaks Parkway
San Jose, CA 95119
Telephone: 408-717-8016

Attorneys for Defendant
Western Digital Corporation

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

WALTER A. TORMASI,

Plaintiff,

v.

WESTERN DIGITAL CORPORATION,

Defendant.

Case Number: 4:19-CV-00772-HSG

DEFENDANT WESTERN DIGITAL CORPORATION'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS

Date: August 22, 2019
Time: 9:00 am
Judge: Hon. Haywood S. Gilliam, Jr.
Courtroom: 2, 4th Floor

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Defendant Western Digital Corporation ("Defendant" or "WDC") hereby submits its Reply in support of its Motion to Dismiss (ECF 19) and in response to Plaintiff Walter A. Tormasi's ("Plaintiff" or "Tormasi") Opposition to Defendant's Motion to Dismiss (ECF 23).

I. Statement of Issues to Be Decided

1. Whether Tormasi's Complaint should be dismissed pursuant to FRCP 12(b)(1) for lack of standing to sue under Article III of the U.S. Constitution.

2. Whether Tormasi's Complaint should be dismissed because he lacks capacity to sue.

3. Whether Tormasi's claim for willful infringement of the '301 Patent should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim.

4. Whether Tormasi's claims for indirect infringement of the '301 Patent (to the extent Tormasi contends the Complaint makes such claims) should be dismissed pursuant to FRCP 12(b)(6) for failure to state a claim upon which relief can be granted.

II. Tormasi Lacks Standing to Sue Because ADS, Not Tormasi, Holds Legal Title to the '301 Patent

Tormasi does not dispute that the application leading to the '301 Patent was assigned to Advanced Data Solutions Corp. ("ADS") in 2005, that the assignment was notarized and recorded – twice—in the United States Patent and Trademark Office ("PTO"), that ADS was the assignee at issue of the '301 Patent, and that PTO records still reflect that ADS holds legal title to the '301 Patent. Although unclear, Tormasi appears to assert that regardless of whether ADS holds legal title to the '301 Patent, as the named inventor he retains standing to sue for its infringement. ECF 23 at 3. That proposition is wrong as a matter of law, and the case law that Tormasi cites – *Arachnid, Inc. v. Merit Industries, Inc.*, 939 F.2d 1574, 1578 n.2 (Fed. Cir. 1991) – does not so hold. On the contrary, *Arachnid* makes clear that only a patent's legal title holder has standing to sue for money damages for its infringement. *Arachnid,* 939 F.3d at 1581. And, as discussed in WDC's opening brief (ECF 19 at 10, 12) where a named inventor assigns all of his right, title and interest in and to his patent he is divested of standing to sue for its infringement. *See Lans v. Digital Equip. Corp.*, 252 F.3d 1320 (Fed. Cir. 2001).

Tormasi has no standing to sue for the '301 Patent's infringement.

III. Tormasi Proffers No Competent Evidence to Show That He Is (or Ever Was) ADS's Sole Shareholder Or Had Any Authority To Assign The '301 Patent From ADS to Himself

In response to WDC's factual challenge to Tormasi's standing, Tormasi fails to produce a single document corroborating his assertion that he is (or ever was) ADS's sole shareholder, an ADS director or officer, or had any authority whatsoever to transfer ADS's ownership of the '301 Patent to himself. And, as discussed in WDC's opening brief, the competent evidence of record is to the contrary. ECF 19 at 12-14. Thus, Tormasi's arguments in favor of his standing to sue ***all*** fail because they are premised on the unsupported notion that he is and was ADS's "sole shareholder" or otherwise had authority to assign the '301 Patent from ADS to himself.

To support his standing argument, Tormasi offers a self-serving and uncorroborated declaration, a May 24, 2007 prison disciplinary report, and never-before-seen contingent assignments, assignments and alleged "corporate resolutions" (signed only by Tormasi allegedly in 2007 and 2009) in which Tormasi purports to transfer the '301 Patent from ADS to himself. *See* Declaration of Walter A. Tormasi In Opposition to Defendant's Motion to Dismiss (ECF 23-1) ("Tormasi Decl."), Exs. A, C, D, G, & H. None of these documents corroborates Tormasi's assertions concerning his status as "sole shareholder," "director" and/or "CEO" of ADS.

The prison disciplinary report states only that Tormasi possessed unspecified "paperwork/forms/legal documents pertaining to the initial start up &/or operation of an unauthorized business" and that "Tormasi by this act – circumvented the procedural safeguards against inmates operating a business without prior approval." *Id.*, Ex. A. The report says nothing about the ***content*** of these documents or Tormasi's supposed roles in ADS; it ***does not even mention ADS.*** The report cannot corroborate Tormasi's claims about his alleged roles at ADS.

Tormasi's declaration and purported assignment documents likewise are entirely uncorroborated and are signed only by Tormasi himself in his supposed capacity as ADS's "Director," "CEO" or "Sole Shareholder." *Id.*, Exs. C, D, G, & H. Tormasi's declaration and

attached exhibits thus do nothing to corroborate Tormasi's claims concerning his roles in ADS and his alleged authority to assign the '301 Patent from ADS to himself.

Tormasi's statement in his declaration that it was he who caused ADS to be formed, (*id.*, ¶ 7), is likewise unsupported. The Certificate to which he points (*See* Declaration of Erica D. Wilson in Support of Defendant Western Digital Corporation's Motion to Dismiss (ECF 19-1) ("Wilson Decl."), Ex. 4) in no way identifies Tormasi as having any interest whatsoever in ADS. Indeed, it does not mention Tormasi at all. Similarly, his statements regarding his role as an ADS director, officer and sole shareholder (*Id.*, ¶¶ 8-10) are entirely uncorroborated by any contemporaneous documentary evidence or third-party declarations.

Furthermore, the 2007 and 2009 "assignments" and "resolutions" have no indicia of reliability and authenticity. They are not witnessed or notarized and are not self-authenticating. Nor do they contain any contextual information to support their purported dates of execution. Neither of the alleged assignments was recorded with the PTO. In short, Tormasi has provided no evidence, other than his own self-serving declaration, to support the authenticity of those documents. Tormasi, however, is simply not credible.

In fact, Tormasi has admitted, including in statements under penalty of perjury, that ADS was the assignee of the '301 Patent in exactly the same time frame for which he now claims to have assigned the patent from ADS to himself. In a Complaint Tormasi filed on December 1, 2008 on behalf of ADS and himself for alleged civil rights violations stemming from the prison's confiscation of Tormasi's business-related documents, Tormasi stated that ADS was the "registered assignee of [the '301] patent." Wilson Decl. Ex. 3, ¶¶ 20(a)-(e) ("ADS correspondingly owns all applications and patents stemming from Plaintiff Tormasi's '346 provisional application"); *see also id.* ¶ 27(a) (stating that ADS is the "assignee" of the '301 Patent); *id.* at 25 (Tormasi's verification under penalty of perjury that the statements in the Complaint are "true and correct to the best of my knowledge"). In a "1st Amended Complaint" filed July 24, 2009 Tormasi reiterated (again under penalty of perjury) that ADS was the assignee of the '301 Patent. Wilson Decl., Ex. 12, ¶¶ 20(a)-20(e), 27 (a) and p. 27 (verification).

Tormasi made no mention of corporate resolutions or assignment documents that he allegedly executed in June 2007, well prior to the filing dates of his 2008 Complaint and 2009 amended complaint. Instead, throughout the pendency of his civil rights action, he steadfastly maintained that ADS was the assignee of the '301 Patent, and without the paperwork prison officials had confiscated as contraband he could not "prove his ownership of ADS to the satisfaction of interested third parties," and was thus unable to "directly or indirectly benefit from his intellectual-property assets." Wilson Decl., Ex. 3, ¶¶20 (a)-(e), 22(a), 27, Ex. 12, ¶¶20(a)-(e), ¶22(a), 27.

Furthermore, in appellate briefing to the Third Circuit in August ***2011*** Tormasi unequivocally asserted ADS's ownership of the '301 Patent, stating "While ADS does own Patent No. 7,324,301 (including its related applications) . . ." *See* Declaration of Erica D. Wilson in Support of Defendant Western Digital Corporation's Reply In Support of Its Motion to Dismiss ("Wilson Reply Decl."), Ex. 26 at 3; *see also id.* at 1 ("Defendants are correct that Tormasi had assigned to ADS all rights regarding Patent No. 7,324,301 (including Provisional Patent Application No. 60/568,346 and Non-Provisional Patent Application No. 11/031,878).)."

Tormasi ***now*** takes the exact opposite position in this Court, claiming that he actually assigned the '301 Patent back to himself in 2007 and/or 2009. In light of his prior statements to the New Jersey federal court and the Third Circuit, such assertions are simply not believable.[1]

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[1] This would not be the first time evidence submitted by Tormasi has been found lacking credibility. A New Jersey state court found an unsigned "affidavit" allegedly prepared years earlier by Tormasi's deceased father and presented by Tormasi after his father's death in support of a petition for post-conviction relief, to be "not believable," "inherently suspect" and "untrustworthy." *State v. Tormasi*, No. A-4261-16T4, 2018 N.J. Super. Unpub. LEXIS 2417, at *1-4 (Super. Ct. App. Div. Oct. 31, 2018) (Wilson Reply Decl., Ex. 27). Similarly, Tormasi was previously found to have attempted to "subvert the security and safety of the facility" by attempting to mail "fourteen legal briefs that had been hollowed out to create hidden compartments" that "can easily be used to traffic contraband to and from the facility." *Tormasi v. New Jersey Dept. of Corrections*, 2007 N.J. Super. Unpub. LEXIS 1216, at *1-4 (N.J. Super.A.D. Mar. 22, 2007) (Wilson Decl., Ex. 21). The New Jersey Court found unpersuasive Tormasi's self-serving declaration that "another inmate's documents were intermingled with [his] or that the documents were planted to fabricate charges against [him]." *Id.* at *2.

As the plaintiff in this action Tormasi "has the burden of proving the existence of Article III standing at all stages of the litigation." *Ctr. for Biological Diversity v. United States Fish & Wildlife Serv.*, 807 F.3d 1031, 1043 (9th Cir. 2015). Tormasi's uncorroborated claims regarding his alleged ownership of the '301 Patent – which are diametrically opposed to what he previously told various federal courts – fall far short of meeting his burden of proving that he has standing to sue for infringement of the '301 Patent.

IV. The Alleged 2007 and 2009 Assignments Are Ineffective

Even if Tormasi could somehow show that he is and was someone with authority to transfer ADS's assets to himself and could show that the June 2007 and December 2009 "corporate resolutions" and "assignment agreements" were not post-hoc litigation-inspired documents, but rather were executed on the dates stated, the assignment agreements would still be ineffective for multiple reasons. First, Tormasi states that on May 23, 2007 prison officials disciplined him for operating a business and he was "warned, explicitly and unequivocally, that [his] continued involvement with ADS matters subjected [him] to further disciplinary action." Tormasi Decl., ¶14. The 2007 and 2009 resolutions and assignment agreements reflect activities taken on behalf of ADS and thus constitute conducting a business, something Tormasi is expressly prohibited from doing. *See also* ECF 19 at 17-18; *infra* Section V.

Second, the 2007 assignment purports to be a contingent assignment and effective only on the happening of certain events. *Id.*, Ex. D. Tormasi states that "one or more of the contingencies specified in the Assignment from June 2007 were met" (*Id.*, ¶42), but fails to identify to ***which*** contingency he refers and ***when*** the unspecified contingency supposedly arose. Moreover, at all relevant times, including into 2019, Tormasi behaved as though ADS was still an operating business and holding the '301 Patent as evidenced by: (1) Tormasi's statements to the New Jersey federal court and the Third Circuit in the 2008-2011 timeframe that ADS was the assignee of the '301 Patent; (2) Tormasi's January 30, 2019 assignment of the '301 Patent to himself in his alleged capacities as ADS's sole shareholder and President (*Id.*, Ex. L); (3) Tormasi's declaration that he believed his family members were paying ADS's Delaware

franchise taxes (*Id.*, ¶¶ 19, 37); and (4) Tormasi's declaration that at all relevant times, including 2019, he "believed that ADS remained in good standing with Delaware officials." *Id.*, ¶39.

Third, the 2009 assignment is ineffective for the additional reason that it was allegedly entered into when ADS was in a void status. As discussed in WDC's opening brief (ECF 19 at 14-17), although ADS could continue to hold assets while in a void status, during the period in which it was void, it had no power to assign its assets to Tormasi or anyone else.

Citing *Krapf & Son, Inc. v. Gorson*, 243 A.2d 713, 715 (Del. 1968), Tormasi argues that the 2009 and 2019 assignments of the '301 Patent from ADS to himself are valid, even though executed while ADS was in a void status, because ADS's lapse into a void status was inadvertent and the assignments were executed without fraud or bad faith. ECF 23 at 6.

In *Krapf*, however, the question before the Court was whether a corporation's president could be held personally liable for a contract he entered into on behalf of the corporation after the company was declared void and before it was revived under Delaware law. *Krapf*, 243 A.2d at 714. In holding that the president was not personally liable, the Delaware Court found that since the corporation had been properly revived under 8 Del. C. § 312(e), the contract was "validated." *Id.* at 715 (citing 8 Del. C. §312(e)). *Krapf* does not stand for the broad proposition that a contract entered into while a corporation is in a void status is valid, even if the corporation is never revived.

In this case, Tormasi proffers no evidence that ADS has been revived pursuant to §312; the alleged 2009 assignment and the 2019 assignment, therefore, cannot have been validated as was the case in *Krapf*. Moreover, ADS's void status can hardly be said to have been inadvertent, nor were the alleged assignments made in good faith. Tormasi's claim that he thought for the past 15 years that his father and brother were paying ADS's Delaware franchise taxes on his behalf is not credible. Notably, although claiming to be ADS's sole shareholder, Tormasi proffers no evidence that he provided either his father or brother with the funds with which to pay ADS's Delaware franchise taxes. And, he provides no explanation of why his father or brother, who supposedly had no interest in ADS, would pay ADS's franchise taxes for him.

Tormasi also states that he expected his brother and father would house ADS on their properties (ECF 23 at 6-7), which raises further questions concerning the ownership of ADS. Tormasi proffers no third-party declaration or documentation corroborating his assertion that his family members were to pay ADS's Delaware franchise taxes and house ADS on Tormasi's behalf.

Moreover, in his December 2008 complaint and July 24, 2009 amended complaint, Tormasi complained that the prison officials' seizure of his corporate paperwork prevented Tormasi from paying ADS's federal taxes. Wilson Decl., Ex. 3, ¶22(b), Ex. 12, ¶22(b). Tormasi thus inconsistently claims that (1) the seizure of his corporate paperwork prevented him from paying ADS's federal taxes, but (2) he believed (and never once confirmed in 15 years) that his brother and/or father were readily able to pay ADS's Delaware franchise taxes.

Tormasi claims he only learned of ADS's void status when WDC filed its April 25, 2019 Motion to Dismiss. Tormasi Decl., ¶37. Tormasi further claims that "[s]urprised by that revelation" he "conducted follow-up inquiries," and only just now discovered in 2019 that prior to his death in 2010, Tormasi's father experienced debilitating health issues that prevented him from paying the Delaware taxes. *Id.* Notably, however, Tormasi does not submit documents or a declaration from any third-party with whom he made such inquiries corroborating these supposed findings. Nor does Tormasi offer any explanation of why his brother was prevented from making the payments.

As discussed in WDC's opening brief, Tormasi's alleged assignments also lack the hallmarks of good faith that were present in *Krapf*. Tormasi's purported assignment of ADS's patent to himself is an obvious bad faith (albeit failed) effort to do an end-run around the New Jersey prison's "no-business" rule. Indeed, by bringing this patent infringement suit, Tormasi is using the courts in an effort to monetize the '301 Patent which he is barred from doing under New Jersey law.

In a last-ditch effort to claim ownership of the '301 Patent, Tormasi argues that because ADS was in a void status as of March 2008, under section 278 of the Delaware code the December 2009 assignment of the '301 Patent from ADS to himself is valid. Tormasi's argument

fails for multiple reasons. First, as discussed above, Tormasi has provided no competent evidence other than his own self-serving declaration to support the notion that he is ADS's sole shareholder and executive.

Second, §278 entitled "Continuation of corporation after dissolution for purposes of suit and winding up affairs" provides:

> All corporations, whether they expire by their own limitation or are otherwise dissolved, shall nevertheless be continued, for the term of 3 years from such expiration or dissolution . . . for the purpose of prosecuting and defending suits. . . and of enabling them gradually to settle and close their business, to dispose of and convey their property, to discharge their liabilities and to distribute to their stockholders any remaining assets, ***but not for the purpose of continuing the business for which the corporation was organized.*** (emphasis added).

Section 278 does not address whether a corporation that is void for failure to pay franchise taxes is "otherwise dissolved" within the meaning of the code, and "[c]ourts interpreting Delaware law disagree as to whether a Delaware corporation whose charter has been forfeited or declared void for failure to pay its franchise taxes is dissolved." *V.E.C. Corp. v. Hilliard,* No. 10 cv 2542 (VB), 2011 U.S. Dist. LEXIS 152759, at *16-17 (S.D.N.Y Dec. 13, 2011) (Wilson Reply Decl., Ex. 28) (comparing cases). In at least one case, the Delaware Supreme Court did not apply § 278 to a void corporation. *See Transpolymer Indus. v. Chapel Main Corp.*, No. 284, 1990, 1990 Del. LEXIS 317, at *2 (Del. 1990) (unpublished) (Wilson Reply Decl., Ex. 29) (finding void corporation's powers "inoperative" and corporation thus lacked standing to pursue an appeal). It is therefore questionable whether §278 is even applicable here.

The better view is that a void corporation is not "otherwise dissolved" within the meaning of §278 because pursuant to 8 Del. C. §312 it can be revived by payment of the past due taxes. As the Delaware state court has clearly recognized, a corporation that has had its certificate of incorporation revoked for failure to pay franchise taxes "is not completely dead." *Wax v. Riverview Cemetery Co.,* 24 A.2d 431, 436 (Del. Super. 1942). It is instead merely "in a state of coma from which it can be easily resuscitated." *Id*; *see also In re Apple iPod iTunes Antitrust Litig.*, No. 05-CV-0037 YGR, 2014 U.S. Dist. LEXIS 165254, at *14-15 (N.D. Cal. Nov. 25,

2014) (Wilson Reply Decl., Ex. 30)("While authority is split on whether ***voided*** corporations fall under section 278, the Court finds more persuasive the approach followed by the Delaware Supreme Court—that void corporations lose their standing to pursue legal actions until the corporate status is restored") (emphasis in original) (citations omitted).

Even if ADS were considered to be "otherwise dissolved" within the meaning of §278, §278 cannot render the 2009 assignment valid. It is well-settled that §278 is specifically directed to winding up a business, not to carrying on the purposes for which it was established. *See, e.g., Gamble v. Penn Valley Crude Oil Corp.*, 104 A.2d 257, 260 (Del.Ch. 1954); *McBride v. Murphy*, 124 A. 798, 801 (Del. Ch. 1924).

In this case, Tormasi's statements and conduct show that the 2009 assignment – even if found to be authentic and executed on the date stated on the document – was not effectuated for the purpose of winding up ADS's business affairs. In his declaration, Tormasi states that he wanted to pursue patent infringement litigation with respect to the '301 Patent, and since ADS must be represented in federal court by an attorney but did not have one, Tormasi "took steps" to acquire the '301 Patent. Tormasi Decl., ¶ 22. Indeed, referring to the December 27, 2009 assignment, Tormasi explicitly states, "[t]he purpose of the transfer in ownership was to permit me to personally pursue, and to personally benefit from, an infringement action against Defendant and others." *Id.*, ¶23. And, at all relevant times, including through 2019, Tormasi claims that he "believed that ADS remained in good standing with Delaware officials." *Id.*, ¶ 39. Section 278 is inapplicable.

Tormasi also argues that if ADS were dissolved, as sole shareholder the ADS assets – *i.e.*, the '301 Patent – would automatically transfer to him. ECF 23 at 8. Again, Tormasi has adduced no competent evidence that he is the sole shareholder of ADS. Moreover, Section 277 of the Delaware General Corporation Law states that "[n]o corporation shall be dissolved . . . under this chapter" until all franchise taxes have been paid and all annual franchise tax reports have been filed by the corporation. 8 Del. Code § 277. Thus, ADS could not be dissolved and its

assets distributed to its shareholders until all of the franchise taxes have been paid and all annual franchise tax reports have been filed by ADS. To date, that has not occurred.

V. Tormasi Lacks the Capacity to Sue

Tormasi's patent infringement suit is in furtherance of his personal business interests – *i.e.*, monetization of the '301 Patent – and is thus prohibited under New Jersey's law precluding inmates from operating businesses. Tormasi admits that "New Jersey inmates are prohibited from operating businesses without administrative approval." ECF 23 at 10-11 (citing N.J.A.C. 10A:4-4.1). And, Tormasi does not deny that he does *not* have the authorization of prison officials to operate any business.

Instead, Tormasi – while proclaiming himself an "entrepreneur" (ECF 1, ¶ 1) and seeking $15 billion in damages for alleged infringement of the '301 Patent (*id.*, "Prayer for Relief," ¶¶ D & E) – implies that because he is operating in his "personal capacity" his patent infringement suit cannot be deemed in furtherance of prohibited business operations. ECF 23 at 11. Tormasi cites nothing supporting the notion that the ***form*** of a business is in any way relevant to New Jersey's prohibition on inmates operating a business. Nor does Tormasi make any effort to distinguish the cases cited in WDC's opening brief in which New Jersey inmates operating in their individual capacities were found to have violated New Jersey's "no business" rule. *See* ECF 19 at 17-18.

Tormasi does not meaningfully address the opinions of the New Jersey federal court and the Third Circuit finding that his patent monetization and enforcement efforts conducted under the auspices of ADS ran afoul of New Jersey's "no-business rule" but rather declares them "inapposite." ECF 23 at 11.

Tormasi's concurrently filed request for appointment of *pro bono* counsel for settlement purposes (ECF 24), underscores that this patent infringement action is part of an overall patent monetization strategy. In his accompanying declaration, Tormasi explains that *pro bono* counsel's assistance is required *inter alia* "to determine and apply reasonable royalty rates to [WDC's] revenue." ECF 24-1, ¶11. Tormasi further notes that any settlement likely will include licensing or sale of the '301 Patent and that *pro bono* counsel's assistance is needed to assist him

with valuing the patent. ECF 24-1, ¶14. And, Tormasi's declaration in support of his opposition to WDC's Motion to Dismiss states that the alleged assignments of the '301 Patent from ADS to Tormasi were done to ensure the '301 Patent "remained enforceable, licensable, and sellable to the fullest extent possible." Tormasi Decl., ¶15.

This is precisely the sort of conduct that the New Jersey court has found runs afoul of New Jersey's "no business" rule. *See Helm v. New Jersey Dept. of Corrections*, 2015 N.J. Super. Unpub. LEXIS 1062 (N.J.Super. A.D. May 8, 2015) (Wilson Decl., Ex. 19) (Inmate Helm found guilty of operating a business without authorization where he signed paperwork regarding the sales of his artwork and taxes to be paid from those sales and because attorneys assisting him were compensated from income generated by the sales).

Tormasi ***knowingly*** misstates the law regarding an inmate's right of access to the courts under the First and Fourteenth Amendments when he argues that New Jersey's "no-business" rule cannot prevent him from suing for patent infringement. ECF 23 at 10. Tormasi argues that *Bounds v. Smith*, 430 U.S. 817 (1977) established an inmate's right of access to the courts and that under the Supreme Court's holding in *Lewis v. Casey*, "prison officials must allow prisoners to file civil lawsuits and, conversely, are prohibited from 'frustrat[ing] or . . . imped[ing]' any 'nonfrivolous legal claim.'" ECF 23 at 10 (citing *Lewis v. Casey,* 518 U.S. 343, 349, 353 (1996)).

Lewis, however, says no such thing, and, in fact holds the precise opposite. In holding that a claim for denial of the right of access to courts requires a showing of "actual injury," the *Lewis* court explained that "***the injury requirement is not satisfied by just any type of frustrated legal claim.***" 518 U.S. at 354 (emphasis added). Rather, an inmate's constitutional right of access to the courts is limited to inmate suits "attack[ing] their sentences" or "conditions of their confinement" and ***"[i]mpairment of any other litigating capacity is simply one of the incidental (and perfectly constitutional) consequences conviction and incarceration.***" *Id.* at 355 (emphasis in original and added).

Tormasi is well-aware of these limits on an inmate's right of access to the courts; he was apprised of this by both the New Jersey federal district court and the Third Circuit in a prior civil rights lawsuit he brought based *inter alia* on his alleged inability to bring patent infringement litigation. Citing the Supreme Court's decisions in *Bounds* and *Lewis*, the New Jersey federal court emphasized that an inmate's "right of access to the courts is not, however, unlimited" and does not extend to patent infringement litigation. *Tormasi v. Hayman*, No. 08-5886 (JAP) 2009 U.S. Dist. LEXIS 50560, at *13-15 (D.N.J. Jun. 16, 2009) ("Tormasi I") (Wilson Decl., Ex. 1). The New Jersey court stated:

> Here, the Complaint fails to state a claim with respect to Plaintiff Tormasi's desire to pursue patent violation litigation, as impairment of the capacity to litigate with respect to personal business interests is "simply one of the incidental (and perfectly constitutional) consequences of conviction and incarceration."

Tormasi I, 2009 U.S. Dist. LEXIS 50560, at *14-15 (quoting *Lewis v. Casey*, 518 U.S. at 355).

The court reiterated the *Lewis* court's limitations on an inmate's right of access to the courts in *Tormasi v. Hayman*, No. 08-5886, 2011 U.S. Dist. LEXIS 25849, at *21-22 (D.N.J. March 14, 2011) ("Tormasi II") (Wilson Decl., Ex. 11).

And, on appeal, the Third Circuit likewise cited *Lewis* for the proposition that an inmate's right of access to the courts is limited to attacking their sentences or conditions of confinement, and stated "[b]ecause Tormasi's complaints about his ability to pursue patent matters do not fall into one of these categories, we agree that he failed to state an access to the courts claims." *Tormasi v. Hayman*, 443 Fed. Appx. 742, 744, n.3 (3d Cir. 2011) (Wilson Decl., Ex. 13).

In August 2011 briefing to the Third Circuit, Tormasi acknowledged under *Lewis* he had no constitutional right to bring patent infringement litigation. Indeed, Tormasi wrote,

> Defendants, for example, cite Lewis v. Casey, 518 U.S. 343, 116 S. Ct. 2174, 135 L. Ed. 2d 606 (1996), for the proposition that Tormasi has no right to pursue "patent violation litigation." ***While defendants are technically correct***, Tormasi does not seek "access to the courts" to litigate infringement actions against patent violators.

Wilson Reply Decl., Ex. 26 at 3-4 (emphasis added).

Tormasi's reliance on *Holman v. Hilton*, 542 F. Supp. 913 (D.N.J. 1982), *aff'd* 712 F.2d 854 (3d Cir. 1983) is misplaced. *Holman* does not, as Tormasi suggests, stand for the proposition that preventing inmates from bringing whatever sort of lawsuit they choose is unconstitutional. Rather, in *Holman* the court found a state statute prohibiting New Jersey inmates from bringing suit in New Jersey state court against ***"public entit[ies] or public employee[s]"*** (*i.e.*, prison officials) while incarcerated violated Plaintiff's (an inmate serving a life sentence who alleged prison officials wrongfully took his personal property) constitutional rights to due process. *Holman*, 542 F. Supp. at 914-15 & n.3 (emphasis added).

Here, Tormasi attempts to bring a patent infringement suit in furtherance of his personal business interests, something he is not entitled to do. In any event, the Supreme Court's ruling in *Lewis* – handed down 13 years ***after*** *Holman* – is binding precedent. To the extent the district court or Third Circuit opinions in *Holman* can be said to be in conflict with *Lewis*, the Supreme Court's ruling is controlling.

Tormasi lacks the capacity to bring suit in furtherance of his personal business interests.

VI. Tormasi Fails To State a Claim For Willful Infringement

As discussed fully in WDC's opening brief (ECF 19 at 19-23) Tormasi's complaint fails to state a claim for willful infringement. Tormasi does not plausibly plead WDC's knowledge of the '301 Patent or knowledge of its infringement. Tormasi admits that the entirety of his allegations concerning WDC's knowledge of the '301 ***Patent*** and alleged infringement of the ***patent*** consist of his conclusory statement that "Defendant knew that its dual-stage actuator system and tip-mounted actuators violated U.S. Patent No. 7,324,301." ECF 23 at 17. As discussed in WDC's opening brief, such conclusory allegations, "will not do." *Ashcroft v. Iqbal*, 556 U.S 662, 678 (2009); *see also* ECF 19 at 19-20.

Tormasi's claim for willful infringement likewise fails because he pleads no facts to support the notion that WDC's conduct was "egregious" as required to state a claim for willfulness. *See, e.g., Hypermedia Navigation v. Google LLC*, No. 18-cv-06137-HSG, 2019 U.S. Dist. LEXIS 56803, at *10 (N.D. Cal. April 2, 2019) (Wilson Decl., Ex. 14). Tormasi argues that

by alleging WDC's conduct was willful he has "by implication" alleged "egregiousness." ECF 23 at 17. That is a backwards analysis, and Tormasi's bare allegation of willfulness utterly fails to meet the pleading standard of this Court. Tormasi fails to plead "specific factual allegations about [WDC's] subjective intent or details about the nature of [WDC's] conduct to render a claim of willfulness plausible, and not merely possible." *Hypermedia,* 2019 U.S. Dist. LEXIS 56803, at *10.

Tormasi does not dispute that the "surrounding circumstances" he alleges give rise to his willfulness claim center on the publication of the ***application*** leading to the '301 and not the '301 ***Patent*** itself. Nor does Tormasi dispute that he lacks any basis whatsoever for the allegations, made upon information and belief, concerning WDC's supposed knowledge and use of the application leading to the '301 Patent. *See* ECF 1, ¶¶ 36-44. Instead, Tormasi argues that all allegations in the complaint must be accepted as true. ECF 23 at 14-15. However, "courts do not accept as true allegations that are merely conclusory, unwarranted deductions of fact, or unreasonable inferences." *Hypermedia*, 2019 U.S. Dist. LEXIS 56803, at *2-3 (citations and internal quotations omitted). Tormasi's baseless allegations need not be accepted as true.[2]

VII. Conclusion

For the foregoing reasons and the reasons set forth in WDC's opening brief (ECF 19), WDC respectfully requests that its Motion to Dismiss be granted.

Dated: June 13, 2019

Respectfully submitted,

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[2] Tormasi does not appear to contend that he pled causes of action for indirect infringement. To the extent he does, however, such causes of action should be dismissed for failure to state a claim for the reasons set forth in WDC's opening brief. *See* ECF 19 at 23-24.

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WALTER A. TORMASI,	:	CASE NO. 4:19-cv-00772-HSG
Plaintiff,	:	OBJECTION TO REPLY EVIDENCE
v.	:	HEARING DATE: AUG. 22, 2019
WESTERN DIGITAL CORP.,	:	ASSIGNED JUDGE: HON. HAYWOOD S. GILLIAM, JR., U.S.D.J.
Defendant.	:	

Pursuant to Civil L.R. 7-3(d)(1), Plaintiff Walter A. Tormasi objects to three items of reply evidence submitted by Defendant in connection with its Motion to Dismiss.

First, Plaintiff objects to the admission of his Third Circuit brief. (See Wilson Reply Decl. Exh. 26.) Defendant seeks to use the statements therein to impugn Plaintiff's Assignment from December 2009. Plaintiff acknowledges that his Third Circuit brief, filed in August 2011, indicated that ADS owned the patent-in-suit. However, as explained on page 3 of

the Third Circuit brief, Plaintiff's factual representations were "drawn from [his July 2009] amended complaint."

In other words, Plaintiff's statements in his Third Circuit brief were outdated by at least two years. This is because Plaintiff was required to cull his facts from "the original papers and exhibits filed in the district court." Fed. R. App. P. 10(a)(1). For that reason, Plaintiff's Third Circuit brief, although filed in August 2011, did not account for the existence or impact of the December 2009 Assignment.

The bottom line is that Plaintiff drafted his Third Circuit brief based on the frozen record, which predated his December 2009 Assignment. To the extent that Defendant seeks to use Plaintiff's comments in his Third Circuit brief as "party admissions" or "prior inconsistent statements," those comments are nonprobative and immaterial, making them irrelevant under Fed. R. Evid. 401. Those comments are also prejudicial and misleading, warranting exclusion under Fed. R. Evid. 403.

Second, Plaintiff objects to the admission of the appellate ruling in State v. Tormasi, No. A-4261-16T4, 2018 WL 5623953, 2018 N.J. Super. Unpub. LEXIS 2417 (App. Div. 2018). (See Wilson Reply Decl. Exh. 27.) In its Reply, Defendant contends that the appellate ruling demonstrates that Plaintiff's Declaration (Docket Entry No. 23-1) lacks credibility.

Insofar as the appellate ruling constitutes "evidence,"

such evidence is irrelevant under Fed. R. Evid. 401. This is because the appellate ruling evaluated the credibility of an affidavit executed by Plaintiff's father. In this case, however, the credibility of Plaintiff's father is not at issue, making the appellate ruling entirely irrelevant.

Third and finally, Plaintiff objects to Defendant's use of the appellate ruling in Tormasi v. New Jersey Dept. of Corrections, No. A-4043-05T3, 2007 WL 845921, 2007 N.J. Super. Unpub. LEXIS 1216 (App. Div. 2007). (See Reply Memo., at p. 4.) That ruling stemmed from an internal disciplinary matter having nothing in common with the present lawsuit. The ruling, as such, lacks relevancy under Fed. R. Evid. 401.

To justify injecting the disciplinary ruling into the present lawsuit, Defendant argues that the ruling proves that Plaintiff "attempted to subvert the security and safety of the facility" and that his explanatory "self-serving declaration" was regarded as "unpersuasive." (Reply Memo., at p. 4 (internal quotation marks omitted).) Based on that premise, Defendant contends that the appellate ruling demonstrates that Plaintiff "simply [is not] believable." (Reply Memo., at p. 4.)

Defendant's basis for admission must be rejected. Even if Defendant can somehow meet relevancy standards under Fed. R. Evid. 401, the appellate ruling remains inadmissible on multiple grounds. Defendant, in essence, seeks to use the appellate

ruling as specific evidence of Plaintiff's bad character or reputation for untruthfulness. Such evidence, however, cannot be admitted for those purposes under Fed. R. Evid. 404(a) and Fed. R. Evid. 608(b). Exclusion is therefore mandated.

For the above reasons, Plaintiff requests that the Court deem the foregoing evidence inadmissible and disregard such evidence in adjudicating Defendant's Motion to Dismiss.

Respectfully submitted,

PRO SE

Walter A. Tormasi

Dated: June 25, 2019

Walter A. Tormasi, #136062/268030C
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Attorney for Plaintiff (Appearing Pro Se)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WALTER A. TORMASI,	:	CASE NO. 4:19-cv-00772-HSG
Plaintiff,	:	NOTICE OF APPEAL
v.	:	
WESTERN DIGITAL CORP.,	:	
Defendant.	:	

TO: Susan Y. Soong, Clerk
United States District Court
1301 Clay Street
Oakland, California 94612

Plaintiff, Walter A. Tormasi, hereby appeals the Court's Order entered on November 21, 2019 (Docket Entry No. 33), to the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

PRO SE

Walter A. Tormasi

Dated: November 27, 2019

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CERTIFICATE OF SERVICE

I certify that I served a copy on counsel of record on January 10, 2020 by:

☒ U.S. Mail (addressed to appellee's principal attorney, Erica D. Wilson, Esq., at Walters Wilson LLP, 702 Marshall Street, Suite 611, Redwood City, California 94063)

☐ Fax

☐ Hand

☒ Electronic Means (by E-mail or CM/ECF) (through court staff via NDA)

Walter A. Tormasi (Pro Se) — Name of Counsel

Walter A. T — Signature of Counsel

Law Firm	Pro Se
Address	New Jersey State Prison, P.O. Box 861
City, State, Zip	Trenton, New Jersey 08625
Telephone Number	
Fax Number	
E-Mail Address	

NOTE: For attorneys filing documents electronically, the name of the filer under whose log-in and password a document is submitted must be preceded by an "/s/" and typed in the space where the signature would otherwise appear. Graphic and other electronic signatures are discouraged.

Walter A. Tormasi, #136062/268030C

New Jersey State Prison, P.O. Box 861, Trenton, New Jersey 08625

January 10, 2020

VIA REGULAR MAIL

Peter R. Marksteiner, Clerk
United States Court of Appeals
Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

Re: Walter A. Tormasi v. Western Digital Corp.
Case No. 2020-1265

Dear Mr. Marksteiner:

I have enclosed, for filing, six sets of my appellate brief and six sets of my separately bound appendix. I left one set of my brief and appendix unstapled to facilitate scanning.

Pursuant to the general and local rules of appellate practice, I appended to my brief and appendix proof of service upon appellee's principal attorney, Erica D. Wilson, Esq.

Very truly yours,

Walter A. Tormasi

cc: Erica D. Wilson, Esq. (via U.S. mail)
All ECF Registrants (via NDA)

Walter A. Tormasi, #136062
New Jersey State Prison
P.O. Box 861
Trenton, New Jersey 08625

Peter R. Marksteiner, Clerk
Court of Appeals - Federal Circuit
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