

**UNITED STATES JUDICIAL PANEL**  
**on**  
**MULTIDISTRICT LITIGATION**

**IN RE: MAXIM INTEGRATED PRODUCTS,  
INC., PATENT LITIGATION**

MDL No. 2354

**ORDER VACATING CONDITIONAL TRANSFER ORDER**

**Before the Panel:** Defendants<sup>1</sup> in three Southern District of New York actions and five Western District of Texas actions listed on Schedule A move under Panel Rule 7.1 to vacate our order conditionally transferring their respective actions to the Western District of Pennsylvania for inclusion in MDL No. 2354.

All responding parties concede that these actions are factually related to the MDL proceedings, given that they involve three patents assigned to Maxim that are at issue in the MDL—specifically, the ‘095, ‘013 and ‘510 patents. *See In re: Maxim Integrated Prods., Inc., Pat. Litig.*, 867 F. Supp. 2d 1333 (J.P.M.L. 2012). Despite this factual overlap, defendants oppose transfer, arguing that the MDL is at an advanced stage and that transfer would pose significant inconvenience to the parties. We agree that the MDL proceedings appear to be nearing conclusion. A claim construction order has issued, and fact and expert discovery is now closed. *Daubert* motions are being resolved, and summary judgment briefing soon will commence. In addition to the advanced stage of the MDL proceedings, the parties are unanimous in their opposition to transfer. While not dispositive of the issue, a “nearly unanimous opposition of the parties to transfer, coupled with the absence of any party’s affirmative support for transfer,” is a “persuasive factor ... to deny transfer.” *In re: “Lite Beer” Trademark Litig.*, 437 F. Supp. 754, 755-56 (J.P.M.L. 1977).

In these circumstances we conclude that inclusion of these eight actions in MDL No. 2354 is not necessary to achieve the just and efficient conduct of the litigation. *See* 28 U.S.C. § 1407(a). As we have observed, “multidistrict litigation is not static.” *See* MDL No. 1769, *In re: Seroquel Prods. Liab. Litig.*, Order Vacating Conditional Transfer Order, at 1 (Feb. 5, 2010) (J.P.M.L. doc. no. 344). The relative merits of transferring new tag-along actions to an MDL can change over time as the transferee court completes its primary tasks, and the point at which the advantages of continuing to transfer tag-along actions outweigh the disadvantages is never absolutely clear. *See id.* After a certain point, however, the benefits of transfer should not be assumed to continue. *Id.* We are of the opinion that this MDL has now reached that point. Though we are denying transfer,

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<sup>1</sup> M&T Bank Corporation; HSBC Bank USA, N.A.; HSBC Technology & Services (USA), Inc.; Santander Bank, National Association; American Express Company; American Express Travel Related Services Company, Inc.; Compass Bank d/b/a BBVA Compass; Discover Financial Services; State Farm Mutual Automobile Insurance Company; and USAA Federal Savings Bank.

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we note that, should the need arise, the judges presiding over these cases may find useful guidance concerning the patents-in-suit in the numerous rulings of the transferee court.

IT IS THEREFORE ORDERED that the Panel's conditional transfer order designated as "CTO-5" is vacated.

PANEL ON MULTIDISTRICT LITIGATION

A handwritten signature in black ink, reading "Sarah S. Vance", is positioned above a horizontal line.

Sarah S. Vance

Chair

Marjorie O. Rendell

Lewis A. Kaplan

R. David Proctor

Charles R. Breyer

Ellen Segal Huvelle

Catherine D. Perry

**IN RE: MAXIM INTEGRATED PRODUCTS,  
INC., PATENT LITIGATION**

MDL No. 2354

**SCHEDULE A**

Southern District of New York

MAXIM INTEGRATED PRODUCTS, INC. v. M&T BANK CORPORATION,  
C.A. No. 1:15-02167

MAXIM INTEGRATED PRODUCTS, INC. v. HSBC BANK USA, NATIONAL  
ASSOCIATION, ET AL., C.A. No. 1:15-02168

MAXIM INTEGRATED PRODUCTS, INC. v. SANTANDER BANK, NATIONAL  
ASSOCIATION, C.A. No. 1:15-02169

Western District of Texas

MAXIM INTEGRATED PRODUCTS, INC. v. THE AMERICAN EXPRESS  
COMPANY, ET AL., C.A. No. 5:14-01027

MAXIM INTEGRATED PRODUCTS, INC. v. COMPASS BANK, D/B/A BBVA  
COMPASS, C.A. No. 5:14-01028

MAXIM INTEGRATED PRODUCTS, INC. v. DISCOVER FINANCIAL  
SERVICES, C.A. No. 5:14-01029

MAXIM INTEGRATED PRODUCTS, INC. v. STATE FARM MUTUAL  
AUTOMOBILE INSURANCE COMPANY, C.A. No. 5:14-01030

MAXIM INTEGRATED PRODUCTS, INC. v. USAA FEDERAL SAVINGS BANK,  
C.A. No. 5:14-01031