Miscellaneous Docket No. ___

IN THE

United States Court of Appeals for the Federal Circuit

IN RE APPLE INC.,

Petitioner.

On Petition for Writ of Mandamus to the
United States District Court for the
Western District of Texas
No. 6:19-cv-00532-ADA, Hon. Alan D Albright

APPLE INC.'S PETITION FOR WRIT OF MANDAMUS

John M. Guaragna
DLA PIPER
401 Congress Avenue
Suite 2500
Austin, TX 78701

Abigail Colella
ORRICK, HERRINGTON & SUTCLIFFE LLP
51 West 52nd Street
New York, NY 10019

Melanie L. Bostwick
ORRICK, HERRINGTON & SUTCLIFFE LLP
1152 15th Street NW
Washington, DC 20005
(202) 339-8400

Melanie R. Hallums
ORRICK, HERRINGTON & SUTCLIFFE LLP
2121 Main Street
Wheeling, WV 26003

Counsel for Petitioner

FORM 9. Certificate of Interest **Form 9**
Rev. 10/17

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Apple Inc. **v.** _____

Case No. _____

CERTIFICATE OF INTEREST

Counsel for the:
■ (petitioner) ☐ (appellant) ☐ (respondent) ☐ (appellee) ☐ (amicus) ☐ (name of party)

Apple Inc.

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Apple Inc.	Apple Inc.	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court **(and who have not or will not enter an appearance in this case)** are:

DLA Piper LLP: Brian K. Erickson, Christine K. Corbett, Erik R. Fuehrer, Larissa Bifano, Mark D. Fowler, Michael Van Handel, Summer Torrez

Orrick, Herrington & Sutcliffe LLP: Jeffrey T. Quilici

FORM 9. Certificate of Interest **Form 9**
Rev. 10/17

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

None

6/15/2020
Date

/s/ Melanie L. Bostwick
Signature of counsel

Please Note: All questions must be answered

Melanie L. Bostwick
Printed name of counsel

cc: _____

Reset Fields

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Other Authorities

INTRODUCTION

Once again, a non-Texas plaintiff has sued Apple for patent infringement in the Waco Division of the Western District of Texas in a case having no connections to that venue. And once again, the district court has denied Apple's request to transfer under 28 U.S.C. § 1404(a) to the forum that serves "the convenience of parties and witnesses" and "the interest of justice"—the Northern District of California.

The case for transfer is especially compelling here. It's not just that Apple is headquartered in the Northern District of California, where every employee knowledgeable about the accused technology (and every relevant document) is located. Nor is it just that Uniloc itself has substantial California connections, and that even its own witnesses are located there. It's also that, but for Uniloc's strategic behavior, this case already would have been transferred to the Northern District of California.

This is one of 24 actions involving 35 patents that Uniloc has filed against Apple in the Eastern or Western District of Texas. Judge Gilstrap and Judge Yeakel transferred 21 of those cases, finding that Apple had shown the Northern District of California to be clearly more

convenient and, in the case of Judge Gilstrap, that Uniloc had misrepresented its Texas connections for venue purposes. Two cases remain in the Eastern District because they are stayed pending appeals from inter partes review proceedings.

This is the twenty-fourth case. It was originally pending before Judge Yeakel, but Uniloc voluntarily dismissed it during transfer briefing, then refiled it the following year in the Waco Division, where it was assigned to Judge Albright. Apple moved to transfer. And Uniloc (despite receiving additional venue discovery) couldn't come up with any valid reason to keep the case in Texas.

But immediately after hearing the parties' arguments, and without offering any explanation, Judge Albright stated he was denying transfer and promised to issue a written decision soon. Apple has waited over a month for that decision, and none has issued (even as the district court has held hearings and issued other written rulings in the case). There is simply no rational basis for refusing to transfer this case to the Northern District of California to be litigated with the rest of the parties' ongoing disputes and in a forum convenient for every expected party and non-party witness. The Court should grant mandamus.

RELIEF SOUGHT

Apple respectfully requests that the Court grant this petition for a writ of mandamus, vacate the district court's decision to deny Apple's transfer motion, and remand the case with instructions to transfer this action to the United States District Court for the Northern District of California.

ISSUE PRESENTED

Whether the district court clearly abused its discretion in refusing to transfer this case to the Northern District of California, where the clear weight of the § 1404(a) convenience factors points and 21 other cases between the same parties are currently pending after being transferred from Texas.

FACTUAL BACKGROUND AND PROCEDURAL HISTORY

In 2017 and 2018, Texas Courts Transfer Twenty-One Uniloc Cases Against Apple to the Northern District of California.

Uniloc 2017 LLC is a Delaware company with no connection to Waco or the Western District of Texas. It is part of a web of Uniloc entities, including Uniloc Luxembourg and Uniloc USA. Appx88.

This is one of 24 patent-infringement cases that Uniloc entities filed against Apple, all in the Eastern or Western District of Texas.

Over Uniloc's objections, all of the other cases that were not stayed or voluntarily dismissed—21 total—were transferred to the Northern District of California under § 1404(a) and are pending there. *See* Appx85-87.

Uniloc's first dozen cases were filed between 2016 and 2017 in the Eastern District of Texas. Judge Gilstrap transferred ten of those cases to the Northern District of California, concluding that it would be the more convenient venue for disputes between the two parties under Fifth Circuit precedent. Appx144. Notably, after seeing the results of venue discovery, Judge Gilstrap found that Uniloc had repeatedly made "contradictory representations" about its Texas presence and, in fact, had substantial connections to California. Appx138-139. The two other cases before Judge Gilstrap were stayed pending inter partes review and therefore were not included in the transfer. Appx85-87. The Patent Trial and Appeal Board found all asserted claims unpatentable in those proceedings, and the appeals are pending before this Court. *See generally* Nos. 19-1151, 19-2389 (Fed. Cir.).

In 2018, Uniloc filed twelve more cases against Apple, this time in the Western District of Texas. Judge Yeakel transferred eleven of those

cases to the Northern District of California. Appx86-87. Uniloc had ample opportunity to challenge Apple's representations that all relevant witnesses and documents were located in the Northern District of California—including written discovery, document discovery, and the right to depose up to ten Apple employees. Uniloc could not and did not do so. Appx84.

The final case before Judge Yeakel—No. 1:18-cv-00296-LY—asserted the exact same patent and claims at issue here. Uniloc voluntarily dismissed that case during the transfer briefing, thereby escaping transfer. Appx86.

After Voluntarily Dismissing the Previous Version of This Suit to Avoid Transfer, Uniloc Refiles in the Waco Division of the Western District of Texas.

In September 2019, Uniloc refiled this suit in the Waco Division of the Western District of Texas, where Judge Albright sits as the only district judge. As in the prior version of this case, Uniloc accuses Apple of infringing claims 1-4, 6-8, 10-14, 16-18, and 20-21 of U.S. Patent No. 6,467,088, titled "Reconfiguration Manager For Controlling Upgrades of Electronic Devices," which expired on June 30, 2019. *See* Appx14-16; Appx24.

According to Uniloc, the '088 patent "describes in detail and claims in various ways inventions in systems and devices for improved management and control of reconfiguring electronic devices." Appx15. Uniloc asserts various Apple products that run the iOS or macOS operating systems—including iPhones, iPads, and desktop and notebook computers—infringe the '088 patent. *See* Appx15. Notably, these products directly overlap with the products accused in other Uniloc cases that were transferred to California. Appx88. Uniloc's infringement contentions target the software update functionality in iOS and macOS, "for example, the installation or update of an App Store application on the device." Appx16.

Apple Seeks Transfer to the Northern District of California.

Because of the strong connections between this case and the Northern District of California, and given the lack of connections to the Western District of Texas, Apple promptly moved to transfer under 28 U.S.C. § 1404(a). Appx78-104. Apple also moved to stay all case activity pending a decision on its motion to transfer. Appx166-173. The district court denied the stay. Appx7.

Apple supported its transfer motion with documentation and with a sworn declaration from Michael Jaynes, a Senior Finance Manager at Apple. Appx105. That evidence showed that nearly all the sources of proof regarding the accused products and the accused technology are in the Northern District of California. Appx92-94; Appx110-111; Appx115-116; Appx119. Apple also showed that all of the Apple employees likely to be witnesses in this case are located in that district. Appx96-98; Appx116-119; Appx108. And several third-party witnesses would be subject to compulsory process in the Northern District of California as well. Appx95-96; Appx152-154. Finally, Apple demonstrated that the Northern District of California has a strong local interest in this matter because it is the location of Apple's headquarters, where the accused products were designed and developed, and where all of Apple's relevant employees are based. Appx101-102; Appx107-108; Appx110-111; Appx115-119.

Uniloc opposed. Rather than relying on evidence, however, Uniloc relied on speculation and irrelevant arguments that had already been rejected by courts in the Eastern and Western Districts of Texas. As described in more detail below (at 18-24), Uniloc was unable to identify

any relevant witnesses in the district or show any other connection between the Western District of Texas and this dispute—despite having two rounds of document discovery, two rounds of written discovery, depositions of Austin-based Apple employees in January 2019, and a deposition of Apple's witness, Mr. Jaynes, in January 2020. Appx84; Appx210. Instead, Uniloc relied on attorney argument and speculation about potential witnesses that have no relevance to the case.

For instance, Uniloc suggested that certain Apple employees working in Austin might be trial witnesses; but Apple demonstrated that its employees in Austin do not have any relevant knowledge. Appx99; Appx107-108. Uniloc also relied on the fact that a third-party in Austin physically assembles the Mac Pro desktop computer—but Uniloc failed to show why those manufacturing employees would have any knowledge about the accused software functionality. Appx203. In addition, Uniloc did not (nor could it) dispute that all the likely trial witnesses from both Apple and Uniloc are in California. Appx88-90; Appx95-98; Appx107-108; Appx116-119; Appx204-207.

The District Court Denies Apple's Transfer Motion.

The district court conducted a telephonic hearing on the transfer motion on May 12, 2020. Appx10. At the hearing, it discounted arguments about the convenience of party witnesses, even though that is a significant factor in the § 1404(a) analysis, and instead showed deference to Uniloc's choice of venue, which is not a factor. *See* Appx250; Appx252. The district court also emphasized that its default scheduling order aims to get cases to trial "in a more expeditious manner" than other districts, and suggested that its docket-management practices distinguish this case from the 21 similar cases in which Judges Gilstrap and Yeakel determined that the Northern District of California is clearly more convenient. Appx245-246.

At the end of the hearing, the district court stated without explanation that it would be denying the transfer motion and that it would issue a written order "as soon as we can." Appx296. Over a month has passed, but the district court's order has not issued. During that time, the court has held a *Markman* hearing, issued claim constructions (a few weeks after the hearing), held a discovery hearing, and issued a decision on a protective order (two days after the hearing),

but has yet to issue an order explaining its rationale for refusing to transfer. Appx11.

Given the rapid progression of this case, Apple cannot wait any longer for a written order before seeking mandamus to prevent the case from moving forward in an inconvenient venue. Under the governing law and based on the facts presented to the district court, there is no rationale for denying transfer that would amount to anything other than a clear abuse of discretion.

REASONS FOR ISSUING THE WRIT

A petitioner seeking mandamus relief must (1) show a "clear and indisputable" right to the writ; (2) have "no other adequate means to attain the relief he desires"; and (3) demonstrate that "the writ is appropriate under the circumstances." *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 311 (5th Cir. 2008) (en banc) ("*Volkswagen II*") (quoting *Cheney v. U.S. Dist. Ct.*, 542 U.S. 367, 380-81 (2004)).[1] The first and third prongs are satisfied where a district court reaches a "patently

[1] In reviewing issues related to § 1404(a), "this court applies the laws of the regional circuit in which the district court sits, in this case the Fifth Circuit." *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008).

erroneous result" by relying on clearly erroneous factual findings, erroneous conclusions of law, or misapplications of law to fact. *Id.* at 310-12, 318-19. The second prong is necessarily satisfied where a district court improperly denies transfer under § 1404(a). *See id.* at 319; *see also In re Radmax, Ltd.*, 720 F.3d 285, 287 n.2 (5th Cir. 2013).

This case meets that high standard. Everyone recognizes that this case "featur[es] most witnesses and evidence closer to the transferee venue with few or no convenience factors favoring the venue chosen by the plaintiff," which means that "the trial court should grant a motion to transfer." *In re Nintendo Co.*, 589 F.3d 1194, 1198 (Fed. Cir. 2009). But the district court denied Apple's transfer motion—and Apple has been waiting more than a month for the district court to explain why. For the reasons explained below, there is no possible analysis of the § 1404(a) factors that could support the district court's outcome. And the district court's steadfast refusal to transfer patent cases out of the Western District of Texas—even when another forum is unquestionably and significantly more convenient—is inviting plaintiffs to do exactly what Uniloc did here: intentionally file in a venue that has no connection to the case but which guarantees assignment to a judge

that the plaintiff views as desirable. That is judge-shopping plain and simple, and this Court should not permit it to continue.

I. Mandamus Is Warranted Because Transfer Under § 1404(a) Has Become Effectively Unavailable In The Waco Division Of The Western District Of Texas, Allowing Unabashed Forum- And Judge-Shopping.

This case is part of a trend. In his nearly two years on the bench, Judge Albright has never granted a § 1404(a) transfer motion that would send a patent case outside of the Western District of Texas. The only transfer motions he has granted were for intradistrict transfer to the Austin Division, where the cases remain on Judge Albright's docket. *See* Appx482.

This track record does not reflect a lack of merit in the transfer motions the district court has entertained. Apple's own cases illustrate the increasing extremity of circumstances in which the court is denying interdistrict transfer. In each case, the district court has denied transfer to the Northern District of California even though virtually all evidence and witnesses are located there. In the first case, the court inflated the plaintiffs' Texas presence and deferred to implausible allegations—contradicted by sworn testimony—suggesting that Apple and third-party employees in Austin would have relevant information.

Fintiv, Inc. v. Apple Inc., No. 6:18-cv-00372-ADA, 2019 WL 4743678 (W.D. Tex. Sept. 13, 2019); *see* Petition at 22-40, Dkt. 2, *In re Apple Inc.*, No. 20-104 (Fed. Cir. Oct. 16, 2019) (Appx377-395). In the second, the plaintiff had no Texas connection, and the district court deferred to mere speculation that a non-party trade organization headquartered in Austin—as opposed to the chipmaker headquartered in California—would have information relevant to infringement. Order, Dkt. 59, *STC.UNM v. Apple Inc.*, No. 1:20-cv-00351-ADA (W.D. Tex. Apr. 1, 2020) (Appx400-416); *see* Petition at 16-39, Dkt. 2-1, *In re Apple Inc.*, No. 20-127 (Fed. Cir. May 14, 2020) (Appx441-464).

Now, in this latest case, there is not even an arguable Texas connection to the dispute. Uniloc had every opportunity to show one, and it could not. *See infra* 18-24. Two other Texas district judges have recognized that similarly situated patent-infringement disputes between these parties have no connection to Texas and have transferred 21 other cases to the Northern District of California because it is "clearly a more convenient forum for the parties and witnesses." *Uniloc USA, Inc. v. Apple Inc.*, No. A-18-CV-990-LY, 2019 WL 2066121, at *4 (W.D. Tex. Apr. 8, 2019); *see also* Appx144. Yet the district court

announced at the conclusion of the transfer hearing that it was "going to deny the motion to transfer," Appx296—and Apple continues to wait for the district court's explanation.

As Apple and others have demonstrated to this Court, the district court's transfer rulings turn on clear legal errors and unjustifiable factual analyses that warp the § 1404(a) analysis and do not serve "the convenience of parties and witnesses" or "the interest of justice." *See generally* Nos. 20-104 (Apple), -126 (Adobe), -127 (Apple), -130 (Dropbox), -132 (Dropbox) (Fed. Cir.). Left unchecked, the district court's flawed approach will encourage and reward forum- and judge-shopping by plaintiffs eager to litigate in a venue that has nothing to do with the lawsuit, but which they view (rightly or wrongly) as favorable to their side.

Because Texas has no divisional venue rules, plaintiffs are free to file in the Waco Division of the Western District—guaranteeing that Judge Albright, the only Waco Division district judge, will be assigned to their case. *See* Alex Botoman, Note, *Divisional Judge-Shopping*, 49 Colum. Hum. Rts. L. Rev. 297, 298 (2018) (describing ability to judge-shop within Texas). Judge Albright has publicly invited plaintiffs to file

their patent cases in Waco. *See, e.g.*, Michelle Casady, *Waco's New Judge Primes District for Patent Growth*, Law360 (Feb. 12, 2019), https://tinyurl.com/Law360Waco. And plaintiffs have heeded the call. *See, e.g.*, Mark Curriden, *"User friendly" approach means Texas has new high-stakes patent litigation hotspot*, Dallas Bus. J., 2019 WLNR 35169859 (Nov. 21, 2019) ("Prior to Judge Albright taking the federal bench in September 2018, less than a dozen patent infringement cases had been filed in Waco. Ever. More than 250 patent lawsuits have been filed there during the past 14 months.").

Encouraging patent litigation in a particular district is not objectionable. Encouraging that litigation, and then misapplying the law to prevent § 1404(a) transfer where it is clearly warranted, is an invitation to judge-shopping. This case is a stark example. Uniloc originally filed this very case in the Austin Division, where it was assigned to Judge Yeakel. *See supra* 5. During the transfer briefing—and while Judge Albright's confirmation was pending—Uniloc voluntarily dismissed, then refiled the same case in the Waco Division after the others had been transferred and after Judge Albright had been confirmed. *Id.*

The maneuver worked. Where Judge Yeakel had recognized that transfer to the Northern District of California was clearly warranted, Judge Albright (for unstated reasons) decided to keep this case in the Western District of Texas. The district court's clear aversion to interdistrict transfer will encourage plaintiffs like Uniloc to continue filing lawsuits in the Waco Division; even with zero ties to the forum, they can be sure their case will remain before Judge Albright.

"The Supreme Court has long urged courts to ensure that the purposes of jurisdictional and venue laws are not frustrated by a party's attempt at manipulation." *In re Microsoft Corp.*, 630 F.3d 1361, 1364 (Fed. Cir. 2011); *see also* Jonas Anderson, *Judge Shopping in the Eastern District of Texas*, 48 Loy. U. Chi. L.J. 539, 543 (2016) ("Should the concentration of almost one-third of the nation's patent decision making be in one man's hands, regardless of how skilled that judge is?") (focusing on Judge Gilstrap). This Court should grant mandamus to correct the clear abuse of discretion in the denial of transfer here, and to discourage plaintiffs from continuing to engage in blatant forum- and judge-shopping that defeats the purpose of § 1404(a).

II. Any Analysis Of The § 1404(a) Factors That Leads To A Denial Of Transfer Would Be Patently Erroneous.

The § 1404(a) factors weigh strongly in favor of transfer to the Northern District of California. It is not even a close call—there is a "stark contrast in relevance, convenience, and fairness between the two venues." *Nintendo*, 589 F.3d at 1198.

The Fifth Circuit conducts the § 1404(a) transfer analysis using well-established private- and public-interest factors. The private-interest factors include: "(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315.

The public-interest factors include: "(1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws [or in] the application of foreign law." *Id.* (alteration in original).

The district court has not yet provided its assessment of how those factors apply in this case. But any fair weighing of them must lead to the conclusion that the Northern District of California is clearly more convenient.

A. The private-interest factors all favor transfer.

1. All likely trial witnesses are in California and none are in Texas.

The convenience for willing witnesses is the most important factor in the § 1404(a) analysis. *See, e.g.*, *In re Google Inc.*, No. 2017-107, 2017 WL 977038, at *3 (Fed. Cir. Feb. 23, 2017); *In re Genentech, Inc.*, 566 F.3d 1338, 1342 (Fed. Cir. 2009). Apple made a strong showing here, equivalent to the one that two other Texas courts found weighed "strongly" in favor of transfer. *Uniloc*, 2019 WL 2066121, at *4; *see* Appx142. Because Apple identified numerous witnesses in the Northern District of California and there are no identified witnesses in the Western District of Texas, this factor strongly favors transfer in this case as well. *See In re HP Inc.*, No. 2018-149, 2018 WL 4692486, at *3 (Fed. Cir. Sept. 25, 2018).

Every identified potential witness is in California—most in the Northern District. Apple worked to identify which of its employees

would have relevant information about the accused technology; all are in the Northern District of California. And Apple carefully explained the relevance of each person's testimony in a sworn declaration. Appx107-108; Appx118-119. Numerous likely Uniloc witnesses also live and work in California, including several managers of Uniloc 2017, who are based in San Francisco; a software engineer, Mr. Ford, who lives and works in Northern California; Uniloc's CEO, Mr. Etchegoyen, who maintains a residence in Newport Beach, California; and Uniloc's CFO, Mr. Turner, who resides and works in California. Appx152-153; Appx156-159; Appx163; Appx127.

Meanwhile, Uniloc identified no likely witnesses in the Western District of Texas. The most it could do was speculate about possible witnesses with some connection to Texas. For example, it relied on the presence of Flextronics, a third party based in Austin, which assembles the Mac Pro desktop computer. As an initial matter, the Mac Pro is just one of various accused Apple products, which include iPhones, iPads, and desktop and notebook computers. Appx15. More importantly, the information Uniloc purports to seek from Flextronics is irrelevant to its infringement claim. This case concerns software functionality, not any

manufacturing processes. So the fact that Flextronics employees are involved in assembling Mac Pro computers in Texas does not mean they have any knowledge about the issues to be tried. Uniloc made no effort to show otherwise; it declined to pursue discovery on whether any Flextronics witnesses have relevant knowledge, and it never identified any specific Flextronics witnesses it might call.

The district court appeared to incorrectly weigh Apple's general presence in Austin against transfer. The court remarked at the hearing that "Apple now has its … essentially second headquarters and is about to add 15,000 employees" in the Western District of Texas. Appx250. But Apple's employees in Austin do not have any relevant knowledge and will not be witnesses in this case. Appx107-108. Again, Uniloc made no contrary showing, despite having every opportunity to do so through venue discovery in both the prior and current iterations of this case.

For example, Uniloc referred to potential witnesses from Apple who have responsibility for content delivery network (CDN) servers and who have "CDN" in their job title. Appx185. But Uniloc's infringement contentions—for good reason—do not mention CDN servers. Appx32-

77. This is because CDNs have no bearing on determining infringement in this case, and Uniloc made no showing otherwise. Appx205. Generously read, the claimed technology relates to logic for determining the compatibility of applications, operating systems, and hardware; it has nothing to do with CDNs that optimize how to geographically distribute software, without any role in determining what compatible software to deliver.

Uniloc also cited an unspecified and equally irrelevant Apple server node in Dallas, but a server is not a witness, and discovery revealed no Apple employees there (which, in any case, is in Dallas, in the *Northern* District of Texas). Appx217; Appx219. Apple's witness confirmed in deposition that all the team members who work on the accused technology are in the Northern District of California. Appx213; Appx215; Appx218-219. Uniloc also pointed to an employee in the Austin AppleCare department, which provides customer service and technical support. Appx261-262. Customer service is not an issue in this case, and it is implausible to suggest that people who respond to the customer support line are likely to testify at a patent-infringement trial.

There can be no dispute that the California-based witnesses, whether they be Apple or Uniloc witnesses, will be less inconvenienced by traveling to trial in San Francisco or San Jose than they would be traveling to Texas. The district court even acknowledged that California was more convenient for Uniloc's witnesses: "[I]f Uniloc was concerned about the convenience of its party witnesses, they would not have filed here. *They would have filed originally in the Northern District of California for purposes of convenience*." Appx252 (emphasis added).

But the court avoided this fact by suggesting (contrary to Fifth Circuit law) that it was irrelevant: "Why would a court take into consideration the convenience of the plaintiff's witnesses who—when they clearly made the decision to file in this court. I just—I couldn't find a case and it doesn't make sense to me." Appx250 ("Apple appeared to rely somewhat substantially on the fact that the Uniloc folks are in the Northern District of California, and I'm wondering why that should matter.").

Disregarding the convenience of party witnesses runs contrary to Fifth and Federal Circuit precedent, which recognizes the significance

of convenience to party and nonparty witnesses alike and indicates no difference between them. For example, in *In re Acer America Corp.*, this Court's analysis depended on the location of "[a] substantial number of *party witnesses*" and the expense and loss of productivity entailed in requiring those party employees to travel for trial. 626 F.3d 1252, 1255 (Fed. Cir. 2010) (emphasis added). And the Court specifically called out the convenience of the *plaintiff's* employee witnesses. *Id.* at 1255 n.2; *see also In re Apple, Inc.*, 581 F. App'x 886, 889 (Fed. Cir. 2014).

The district court here clearly erred in suggesting that the convenience of plaintiff's witnesses should not be considered. Indeed, the rationale underlying the witness-convenience factor strongly supports considering the venue that will be most convenient for all party witnesses. As the Fifth Circuit explained, "[a]dditional distance means additional travel time; additional travel time increases the probability for meal and lodging expenses; and additional travel time with overnight stays increases the time which these fact witnesses must be away from their regular employment." *In re Volkswagen AG*, 371 F.3d 201, 205 (5th Cir. 2004) ("*Volkswagen I*").

That is why the Fifth Circuit has established its "100-mile rule," which applies to *all* witnesses. "Because it generally becomes more inconvenient and costly for witnesses to attend trial the further they are away from home," the 100-mile rule requires that "[w]hen the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled." *TS Tech*, 551 F.3d at 1320 (quoting *Volkswagen I*, 371 F.3d at 204-05); *Apple*, 581 F. App'x at 889 (same).

In this case, there is no evidence of a single relevant witness within 100 miles of the Western District of Texas, and most of the likely witnesses live more than 1,700 miles from Waco, Texas. For every identified witness, a trial in the Western District of Texas would mean multiple long flights, extended hotel stays, days apart from their families, and time spent away from their ordinary jobs. The district court was wrong to discount these costs simply because some of those witnesses are affiliated with a company (Uniloc) that chose to file suit in Texas.

2. Plaintiff's choice of forum is not a distinct factor.

"Fifth Circuit precedent clearly forbids treating the plaintiff's choice of venue as a distinct factor in the § 1404(a) analysis." *TS Tech*, 551 F.3d at 1320. Nevertheless, the district court appeared to weigh Uniloc's choice of venue as a strong factor against transfer and afford its choice considerable deference. At the hearing, the court asked: "[I]f a plaintiff wants to say, as opposed to being in the Northern District of California, I'm going to make an argument to a judge in a division that has a set practice that is getting my case to court in an efficient manner and will get it there in a more expeditious manner than I believe can be done in the Northern District of California … *why wouldn't a plaintiff do that*?" Appx245-246 (emphasis added).

A plaintiff certainly may choose to file in any appropriate venue under the general venue statute, and its choice should be given "some weight." *Atl. Marine Constr. Co. v. U.S. Dist. Ct.*, 571 U.S. 49, 62 n.6 (2013). But the Fifth Circuit affords that weight by requiring a defendant to show that the transferee venue is "clearly more convenient"; it forbids a district court from giving "inordinate weight" to the plaintiff's choice. *Volkswagen II*, 545 F.3d at 313. It also recognizes

that "§ 1404(a) tempers the effects of the [plaintiff's] exercise of this privilege." *Id.* "The underlying premise of § 1404(a) is that courts should prevent plaintiffs from abusing their privilege under § 1391 by subjecting defendants to venues that are inconvenient under the terms of § 1404(a)." *Id.* By apparently considering Uniloc's choice of venue as a factor against transfer and giving substantial deference to that choice, "the court erred in giving inordinate weight to the plaintiff's choice of venue." *TS Tech.*, 551 F.3d at 1320.

3. Compulsory process for critical witnesses is available only in California.

Because compulsory process for critical third-party witnesses is available only in the Northern District of California, this factor clearly favors transfer. Indeed, at the transfer hearing, the district court agreed, telling Apple: "Yeah … I'm with you on that one for sure." Appx254.

Apple identified several third-party witnesses in the Northern District of California, including employees from the investment firm

Fortress, who serve as Uniloc's Board of Directors.[2] Appx85; Appx95-96; Appx189; Appx254. The Northern District of California therefore would have subpoena power over those individuals, whereas the Western District of Texas would not. Appx95-96. Although Uniloc incorrectly argued that its board members were not relevant to this factor, it conceded that "those folks geographically live closer to particularly the Northern District of California." Appx278. Meanwhile, Uniloc has not identified *any* likely third-party witness who would be within the subpoena power of the Western District of Texas, and Apple is not aware of any. Appx204.

Uniloc argued that this factor does not favor transfer because its board members have provided statements that they are willing to appear at trial in Texas. That these witnesses may be willing to accept inconvenience, however, does not make the Western District of Texas an

[2] As one district court recently explained, "Fortress Investment Group is a Northern California entity that incorporated and formed both Uniloc and Uniloc's parent, CF Uniloc Holdings LLC, funded Uniloc's patent assertion strategies, and appointed its own employees as officers and board members of Uniloc and CF Uniloc, many of whom reside and work in the Northern District." *Uniloc 2017 LLC v. Google LLC*, No. 2:18-cv-00504-JRG-RSP, 2020 WL 3064460, at *2 n.5 (E.D. Tex. June 8, 2020) (transferring venue to Northern District of California).

affirmatively convenient forum, and therefore does not weigh against transfer. Nor does it change the fact that no third-party witnesses are within the subpoena power of the Western District of Texas. *See, e.g. Genentech*, 566 F.3d at 1345 (concluding that compulsory-process factor "weighs in favor of transfer" where "there is a substantial number of witnesses within the subpoena power of the Northern District of California and no witness who can be compelled to appear in the Eastern District of Texas").

Likewise, the geographic diversity of third-party witnesses does not weigh against transfer. Uniloc argued that some potential third-party witnesses were located farther from California than Texas. Appx276 (citing inventors and prosecuting attorneys in New York, and original patent owner in Netherlands and Massachusetts).

As an initial matter, "[a]ttorney argument is not evidence," and therefore should not be considered. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017). In any event, because none of these potential witnesses are in either the Western District of Texas or the Northern District of California, they are not relevant to the analysis. *See HP Inc.*, 2018 WL 4692486, at *3 ("[T]he

comparison between the transferor and transferee forums is not altered by the presence of other witnesses ... in places outside both forums.") (quoting *In re Toyota Motor Corp.*, 747 F.3d 1338, 1340 (Fed. Cir. 2014)); *Genentech*, 566 F.3d at 1344-45 (rejecting district court's reliance on geographic diversity of witnesses in denying transfer).

4. All relevant sources of proof are in or around the Northern District of California.

Because all relevant documentary evidence and party witnesses in this case are in or around the Northern District of California, this factor also strongly favors transfer. First, as the accused infringer, Apple will have the bulk of the relevant documents. *See Genentech*, 566 F.3d at 1345. The district court recently recognized in another Apple case that this fact favors transfer. *See Fintiv*, 2019 WL 4743678, at *3 ("[B]ecause Apple is the accused infringer, it is likely that it will have the bulk of the documents that are relevant in this case.").

There is no dispute that all the relevant Apple documents are in the Northern District of California. The accused technology was designed and developed by Apple employees there; the primary research, design, development, facilities, and engineers for the accused products are there; and Apple's records related to the research and

design of the accused products are there. Appx92. All the documents concerning the marketing, sales, and financial information for the accused products also are in the Northern District of California, as is the relevant source code. Appx92; Appx204.

Uniloc also has numerous sources of proof in California, including several managers and a software engineer, all of whom are based in Northern California. Appx152-153; Appx156-159; Appx163. Uniloc maintains an office in Newport Beach, California, that hosted "around 100 top-level strategy meetings" during a three-year period, and Uniloc Luxembourg's CEO holds monthly meetings in California with Uniloc's CFO. Appx129. In addition, Uniloc's CEO has maintained a residence in Newport Beach, California, since 2010, and Uniloc's CFO resides and works in California. Appx127.

By contrast, there are no relevant sources of proof in the Western District of Texas. Uniloc has no physical presence in the district, and Apple is not aware of any likely third-party witnesses who reside there. Appx93; Appx203. Apple has no relevant employees and does not maintain any relevant documents in the district. Appx93; Appx204-205.

Although the parties may be able to access certain documents remotely, this does not mitigate the convenience of accessing them from the place where they are physically located (and where the employees who routinely work with the documents are). The district court questioned whether relying on the capability for "remote access of relevant documents [would] require us to sort of stretch Fifth Circuit precedent." Appx273. It would.

The Fifth Circuit and this Court have repeatedly confirmed that the location of documentary evidence remains a relevant factor notwithstanding the technical capability for remote electronic access. *See Volkswagen II*, 545 F.3d at 316; *TS Tech*, 551 F.3d at 1321. The fact "[t]hat access to some sources of proof presents a lesser inconvenience now than it might have absent recent developments does not render this factor superfluous." *Volkswagen II*, 545 F.3d at 316. And the fact that an employee in Apple's Austin office could theoretically access electronic files that employee knows nothing about does not change the fact that it is far more convenient for the California-based employees who actually work with those files to do so.

5. Judicial economy strongly favors transfer.

This factor is about "practical problems that make trial of a case easy, expeditious and inexpensive." *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508 (1947). Here, because all identifiable witnesses and evidence are in California, a trial there will be much easier and more efficient than a trial in Texas.

In addition, 21 Uniloc patent cases against Apple have already been transferred from Texas to the Northern District of California and are currently being litigated there. *See supra* 3-5; Appx85-87. This case involves many of the same accused products at issue in those cases. *See supra* 5-6; Appx88. The parties overlap, so the Northern District of California will already have developed an understanding of their respective business activities, including licensing, marketing, and sales issues. Appx100. And judges in the Northern District of California are already familiar with the background of the dispute between Uniloc and Apple and have considered and coordinated on overlapping issues, such as jurisdiction, assignments, licensing, motions to compel, motions for protective orders, and confidentiality claims, among others. Appx100; Appx207; *see e.g.*, Appx475-476; Appx417; Appx299-327; Appx328-342.

It would be highly inefficient to litigate 21 patent cases between Uniloc and Apple in the Northern District of California and a single case in the Western District of Texas.[3]

Even Uniloc conceded that "judicial economy could potentially be served if there was some guarantee that this case would end up in front of the same judge." Appx285. While there is no guarantee of getting a particular judge in the Northern District of California, there would be efficiency gains even if the cases are not assigned to the same judge. For example, transfer would enable coordinated mediation, since all of the Apple-Uniloc cases in the Northern District of California have been referred to Chief Magistrate Judge Joseph C. Spero for mediation purposes. Appx207; Appx343-346. The parties attended a settlement conference on January 29, 2020, and the next one is scheduled for October 8, 2020. *See, e.g.*, *Uniloc 2017 LLC v. Apple Inc.*, No. 19-cv-1905, Dkt. 97, 99 (N.D. Cal. Feb. 6, 2020) (Appx340).

[3] Such efficiency does not carry the same weight where plaintiffs have filed multiple suits against multiple parties in the same district. There, this Court has cautioned against allowing "co-pending litigation to dominate the analysis," because it "would automatically tip the balance in non-movant's favor." *Google*, 2017 WL 977038, at *2.

B. The public-interest factors clearly favor transfer.

The parties agree that two of the public-interest factors—familiarity with the governing law and conflicts of law—are neutral in this case. Appx102; Appx198. The other two public-interest factors either weigh in favor of transfer or, at the very least, cannot weigh against it. The district court could not properly have relied on those factors to deny transfer, particularly since public-interest factors should "rarely" operate to "defeat a transfer motion." *Atl. Marine*, 571 U.S. at 64.

1. The interest of the district where the accused technology was designed and developed is self-evidently stronger than that of a district with no tie to this case.

The first public-interest factor considers the "local interest in having localized interests decided at home." *Volkswagen II*, 545 F.3d at 317. For this factor to apply, there must be "significant connections between a particular venue and the events that gave rise to a suit." *Acer*, 626 F.3d at 1256. Here, the local interest of the Northern District of California is "self-evident," since Apple's headquarters are in that district, the accused technology was "developed and tested" entirely within that district, and the suit "calls into question the work and

reputation of several individuals residing" in that district. *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333, 1336, 1338 (Fed. Cir. 2009).

Any finding that the local-interest factor weighs against transfer would require legal error. Courts that come to that conclusion do so based on a genuine connection between the dispute and the forum, such as the residence of the patent inventor. *See, e.g., In re Telebrands Corp.*, 773 F. App'x 600, 604 (Fed. Cir. 2016). No such connection exists here. As explained above (at 3, 18-24, 26-28), Uniloc is a Delaware company with no presence in the Western District of Texas; the inventors of the '088 patent appear to be in New York; and Apple's presence in the district is irrelevant to the "local interest" analysis, since its Austin activities are entirely unrelated to "the events that gave rise to [this] suit." *Acer*, 626 F.3d at 1256.

Uniloc's "local interest" arguments simply rehashed the private-interest factors, including witness convenience and the parties' general presence in Texas. Appx197. As explained above (at 18-24), Uniloc's contentions regarding those factors are wrong and unsupported by the record. Moreover, premising the local-interest factor on the same considerations as the private-interest factors would be contrary to law.

See Hoffmann-La Roche, 587 F.3d at 1338 (faulting district court for "essentially render[ing] this factor meaningless" by reducing it to be redundant with private-interest factors).

Uniloc also relied on Flextronics' assembly of the Mac Pro in Austin, suggesting that this is an act of infringement creating a local interest in the district. Appx197. But Uniloc's infringement allegations have nothing to do with the hardware assembly of the Mac Pro (or, for that matter, the hardware assembly of the other accused products, which does not take place in Texas). They relate to Apple's design of software functionalities common across all the accused products. Appx15-17. That design took place exclusively in the Northern District of California—and that is where the local interest lies. *See, e.g.*, *DataQuill, Ltd. v. Apple Inc.*, No. 13-CA-706-SS, 2014 WL 2722201, at *4 (W.D. Tex. June 13, 2014) (recognizing that local interest weighed in favor of transfer notwithstanding Apple's Austin presence because "this case is about Apple's actions in designing and developing [the accused products], all of which happened in Cupertino").

Even accepting every speculation by Uniloc, the local interest factor would at most be neutral. This factor focuses on relative

interests, *Volkswagen II*, 545 F.3d at 318, and it is simply not plausible that tenuous Apple connections to the Western District of Texas render that forum's interest in the outcome of this specific case greater than the interest of the Northern District of California, where Apple is headquartered and where all of the employees with an actual connection to the alleged infringement work.

2. The district court's speculation about its untested trial plan cannot outweigh the factors heavily favoring transfer.

The final factor, court congestion, cannot possibly preclude transfer. Patent cases in the Northern District of California have a slightly shorter time to trial than in the Western District of Texas—since 2008, a median of 2.39 versus 2.62 years. Appx484; Appx101. The district court's default scheduling order aims to accelerate that historical timeline and move patent cases from case management conference to trial in approximately 18 months.[4] *See* Appx197. But the district court's decision to set an unusually aggressive pace does not mean that every other district court in the country is "congested" for

[4] *See Order Governing Proceedings – Patent Case,* U.S. District Court for the Western District of Texas (Feb. 26, 2020), https://tinyurl.com/ybcamrwe.

purposes of the § 1404(a) analysis. That would treat this factor as a pure race-to-the-finish, when it is actually designed to account for "administrative difficulties flowing from court congestion." *Volkswagen II*, 545 F.3d at 315. And here, there is simply no evidence of administrative difficulties or court congestion in the Northern District of California.

Moreover, the district court's scheduling order has yet to be followed through to trial, so there is no actual data to compare against the time-to-trial statistics from the California court. This Court has cautioned that case congestion analysis can sometimes tip into "speculat[ion]." *See Genentech*, 566 F.3d at 1347. And here, it is entirely speculative—indeed, unrealistic—to assume that all of the patent cases pending in Waco will proceed to trial on the default scheduling order's ambitious pace.

That is particularly true given the large (and rapidly increasing) number of patent cases currently pending in the division. Judge Albright presently has 355 patent cases pending before him, with 260 filed just this year. Appx479; Appx486. In contrast, judges in the Northern District of California, including those presiding over Uniloc

cases, have far fewer. Judge Davila has 16 active cases, two of which were filed this year. Appx479-480; Appx500. Judge Alsup has 16 active cases, three of which were filed this year. Appx479; Appx498. If anything, this shows that the Northern District of California is not "congested" but that the Waco Division of the Western District of Texas is rapidly becoming so.[5] *See also* Appx248-249. Counting the court-congestion factor as a reason to deny transfer would get things exactly backward and would be an abuse of discretion.

At a minimum, even if it were true that the Northern District of California were "congested," that alone cannot tip the balance against transfer since "several relevant factors weigh in favor of transfer and

[5] Notably, Judge Albright stated during the transfer hearing that "[t]he heaviest [patent] docket … we all would agree, would be in Delaware. [B]y numbers, that's impossible to debate. Each of those judges has three or four times … the number of cases most other judges in America have by a lot." Appx245.

In fact, Judge Albright now has more active patent cases than any judge in the District of Delaware. Judge Stark, who has the heaviest patent docket in Delaware, has 306 compared to Judge Albright's 355. Appx480; Appx502-512; *see also Q1 2020 Patent Dispute Report*, Unified Patents (Mar. 31, 2020), https://tinyurl.com/y7md9go5 (noting that, as of March 31, 2020, the number of patent disputes in the Western District of Texas has increased 700% in the past four years and is set to overtake Delaware).

others are neutral." *Genentech,* 566 F.3d at 1347. That is particularly true because relative times to trial are not "of particular significance" in cases like this, where the plaintiff "does not make or sell any product that practices the claimed invention." *In re Morgan Stanley*, 417 F. App'x 947, 950 (Fed. Cir. 2011). Uniloc is a non-practicing entity, the asserted patent is expired, and there is no particular reason why speed would be critical, so the court congestion factor should not be "assigned significant weight." *Id.* Indeed, if speed were critical, then presumably Uniloc would not have voluntarily dismissed the previous incarnation of this case to avoid transfer back in 2018.

CONCLUSION

The Court should grant the petition, vacate the district court's decision denying Apple's motion to transfer, and direct the district court to transfer the case to the Northern District of California.

June 15, 2020

Respectfully submitted,

/s/ Melanie L. Bostwick

Melanie L. Bostwick
ORRICK, HERRINGTON & SUTCLIFFE LLP
1152 15th Street NW
Washington, DC 20005
(202) 339-8400

John M. Guaragna
DLA PIPER
401 Congress Avenue
Suite 2500
Austin, TX 78701

Abigail Colella
ORRICK, HERRINGTON & SUTCLIFFE LLP
51 West 52nd Street
New York, NY 10019

Melanie R. Hallums
ORRICK, HERRINGTON & SUTCLIFFE LLP
2121 Main Street
Wheeling, WV 26003

Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system on June 15, 2020.

A copy of the foregoing was served upon the following counsel of record and district court judge via UPS:

William E. Davis, III
Christian J. Hurt
Edward Chin
Debra Coleman
Ty Wilson
THE DAVIS FIRM, PC
213 N. Fredonia Street, Suite 230
Longview, Texas 75601
Telephone: (903) 230-9090
bdavis@davisfirm.com
churt@davisfirm.com
echin@davisfirm.com
dcoleman@davisfirm.com
twilson@davisfirm.com

Hon. Alan D Albright
United States District Court for the Western District of Texas
800 Franklin Avenue, Room 301
Waco, Texas 76701
Telephone: (254) 750-1510

ORRICK, HERRINGTON & SUTCLIFFE LLP

/s/ Melanie L. Bostwick
Melanie L. Bostwick
Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

The petition complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this petition contains 7726 words.

This petition complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this petition has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Century Schoolbook 14-point font.

ORRICK, HERRINGTON & SUTCLIFFE LLP

/s/ Melanie L. Bostwick
Melanie L. Bostwick
Counsel for Petitioner