Miscellaneous Docket No. 20-127

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. 1:20-cv-00351-ADA, Hon. Alan D Albright

APPLE INC.'S PETITION FOR REHEARING EN BANC

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 20-127

Short Case Caption In re Apple Inc.

Filing Party/Entity Apple Inc.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box**. Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 07/16/2020

Signature: /s/ Melanie L. Bostwick

Name: Melanie L. Bostwick

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.
☐ None/Not Applicable	☐ None/Not Applicable	☐ None/Not Applicable
Apple Inc.	Apple Inc.	None

☐ Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☑ None/Not Applicable ☐ Additional pages attached

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☑ None/Not Applicable ☐ Additional pages attached

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to at least the following decision of the Supreme Court of the United States and the precedents of this Court: *New Hampshire v. Maine*, 532 U.S. 742 (2001); *In re Link_A_Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011); *In re Acer America Corp.*, 626 F.3d 1252 (Fed. Cir. 2010); *In re Nintendo Co.*, 589 F.3d 1194 (Fed. Cir. 2009); *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008).

Based on my professional judgment, I believe this appeal requires an answer to at least the following precedent-setting questions of exceptional importance: (1) whether a district court's mere application of each § 1404(a) factor precludes mandamus even in the face of multiple clear legal errors in the analysis; and (2) whether a petitioner is barred from obtaining mandamus relief from a denial of transfer under 28 U.S.C. § 1404(a) to the clearly most convenient forum because that petitioner has received lesser alternative relief in the form of transfer to a clearly less convenient forum.

/s/Melanie L. Bostwick
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Counsel for Petitioner

INTRODUCTION

Apple sought mandamus after the Western District of Texas denied § 1404(a) transfer in a patent case brought by a New Mexico plaintiff accusing technology supplied by non-party Broadcom from its Northern District of California headquarters and incorporated into Apple products. A panel of this Court recognized that the district court committed two legal errors in denying transfer to the Northern District of California: (1) The district court resolved factual "conflicts" in favor of the plaintiff, deferring to unsupported assertions over sworn evidence; and (2) the district court gave "little weight" to party-witness convenience, contrary to this Court's and the Fifth Circuit's precedent.

The panel nonetheless refused to grant mandamus to remedy these clear errors, citing two reasons. Each was error warranting intervention by this Court en banc. First, the panel stated that because the district court granted intradistrict transfer from Waco to Austin, which Apple acknowledged was less inconvenient than Waco, Apple could not show that the district court's decision was patently erroneous. That misapplies § 1404(a). Apple has consistently maintained that the Northern District of California is the clearly more convenient venue;

any relative convenience of Austin over Waco does not change that as a matter of logic or of law.

Second, the panel cited the district court's recitation of each § 1404(a) factor. That extreme bar for mandamus relief—requiring a petitioner to show that the district court openly flouted the law—is not the test this Court or the Fifth Circuit has historically applied. Nor is it correct. If this Court does not use its mandamus authority to curb the district court's acknowledged legal errors, the district court will persist in making those errors—as it has already done since the panel opinion here—and plaintiffs will continue the forum- and judge-shopping that has positioned the Western District of Texas to become this country's busiest patent venue. Plaintiffs can be assured that at most they will face transfer to Austin, where they will be kept on their chosen judge's docket—no matter how strong the case for the superior convenience of another forum.

This Court should grant rehearing.

BACKGROUND

STC.UNM, a New Mexico entity without Texas ties, sued Apple in the Waco Division of the Western District of Texas, asserting

infringement of patents it acquired from a Taiwanese entity. STC.UNM accuses several Apple products; it intends to demonstrate infringement by showing compliance with the IEEE's 802.11ac wireless networking standard. Pet. 4, 8-9. Apple's accused products support that standard using semiconductor chips designed and supplied by non-party Broadcom. Appx139. All of Apple's and Broadcom's work regarding the accused technology took place in California—nearly all of it in the Northern District—so all the relevant evidence and witnesses are there. *See* Pet. 4-6, 16; Reply 13.

Because this litigation has strong connections to the Northern District of California and none to Texas, Apple sought transfer under 28 U.S.C. § 1404(a). Appx121-137. Apple provided sworn testimony that the Apple and Broadcom witnesses likely to testify, as well as relevant documentation, are in the Northern District of California; showed that STC.UNM has no Texas presence; demonstrated that the Northern District of California has a faster time to trial than the Western District of Texas; and established that no practical problems or local interests disfavor transfer.

In opposition, STC.UNM did not try to connect the litigation to its chosen Waco forum, offering only alleged ties to the distinct Austin Division. It did not identify a single witness or document *anywhere* in Texas, nor did it seek discovery to do so. Instead, STC.UNM focused on two things: (1) Apple's substantial presence in Austin—though not STC.UNM's chosen forum of Waco—and attorney conjecture that there *must* be knowledgeable engineers there despite sworn statements to the contrary; and (2) a newfound argument that STC.UNM would somehow show infringement by relying not on the IEEE 802.11ac standard cited in its infringement contentions, but on interoperability testing certified by the Austin-based Wi-Fi Alliance. *See* Pet. 8-9, 17-21; Appx188-189; Appx196-198. STC.UNM did not name any Wi-Fi Alliance witness or acknowledge that interoperability testing is conducted not by the Alliance itself but by independent laboratories outside Texas. *See* Appx250-251; *see also* Pet. 17-20. Indeed, STC.UNM has now conceded that it cannot identify any Austin witnesses. *See* Opp. 20; Reply 8.

The district court concluded that STC.UNM's conjecture defeated transfer to the Northern District of California. It reached this result by stating that it had to resolve "factual conflicts" in favor of STC.UNM,

Appx3; the district court therefore deferred to STC.UNM's unsupported attorney argument over Apple's and Broadcom's sworn declarations and overlooked that STC.UNM had not identified a single witness in Texas. It instead credited the notions that some future potential Apple employee in Austin might have relevant information and that an unidentified Wi-Fi Alliance representative might testify. Appx7-8; Appx10. The district court's opinion was also predicated on other clear errors, including its determination that party-witness convenience receives "little weight" under § 1404(a) and its reliance on Apple's general presence in Austin to constitute a "local interest." Appx10-11; Appx14-16.

The district court granted intradistrict transfer to the Austin Division, keeping the case on the same judge's docket. Appx17. This reflected the fact that even STC.UNM's flawed arguments about supposed Texas connections all involved Austin, not Waco. Indeed, nowhere in the district court's analysis did it even consider Waco connections. *See* Appx1-17. Apple—recognizing the district court's demonstrated aversity to interdistrict transfer—had asked that the case at least be sent to Austin, solely so the out-of-state witnesses could fly

directly to the venue for trial, because Waco's airport offers only in-state flights. Appx132 n.8; Appx256 n.6.

Apple sought mandamus. It demonstrated the district court's numerous legal errors, including (among others) its conclusion that party-witness convenience warrants "little weight." Pet. 21-23; *see also* Pet. 15-39. Apple further demonstrated that every aspect of the § 1404(a) analysis was infected by the resolution of all purported factual conflicts in STC.UNM's favor. Pet. 39-41.

A panel of this Court denied Apple's petition. The panel recognized two legal errors Apple identified: the district court's deference to the plaintiff on all factual conflicts and its statement that party-witness convenience warrants "little weight." Order 4-5. The panel nonetheless denied Apple's petition, citing two reasons: (1) that "the district court's grant of the alternative relief that Apple requested counsels against" mandamus, and (2) that the district court purported to "consider[] all the relevant transfer factors." Order 4. The panel also replicated the district court's error of deference, accepting some of the same unsupported assertions the district court relied upon in denying transfer. *See* Order 6-7 (finding no abuse of discretion in crediting

STC.UNM's attorney argument that unidentified Wi-Fi Alliance witnesses might testify).

ARGUMENT

I. The Panel Erroneously Suggested That Apple Should Be Precluded From Seeking Mandamus Because It Received Lesser Alternative Relief.

Rehearing en banc is warranted because the panel improperly barred Apple from obtaining mandamus to reverse the denial of transfer to the Northern District of California since it received lesser alternative relief of transfer to Austin. STC.UNM claimed Apple was "estopped" from seeking mandamus "[b]ecause Apple argued throughout the underlying proceeding that Austin was 'clearly more convenient' than Waco (and thus not an *inconvenient* venue)." Opp. 30-32. The panel seemed to accept this contention, stating that Apple could not "take back its previous assertion to the district court that the Austin Division is 'clearly more convenient' than the Waco Division," and suggesting that "the district court's grant of the alternative relief that Apple requested counsels against the extraordinary remedy of mandamus." Order 4. The panel's analysis reflects a fundamental misapprehension of the relevant facts, the applicable law, and this

Court's role in overseeing § 1404(a) transfer rulings. The panel's statements, left uncorrected, will result in parties being deprived of their statutory rights. En banc review is necessary.

Apple did not agree that Austin was a "convenient" forum in any sense, and certainly not under the governing § 1404(a) factors. *See* Reply 16-20. Apple argued that Austin was marginally less inconvenient than Waco, but only because "all of the likely witnesses would be traveling by air from outside of Texas" and Austin's airport (unlike Waco's) offers out-of-state flights. Appx132 & n.8. Every likely witness would still be inconvenienced, but at least they'd be spared the additional inconvenience of a 100-mile drive from Austin-Bergstrom to the Waco courthouse. Beyond that, Apple's transfer briefing focused exclusively on why the Northern District of California was "the clearly more convenient venue for this dispute" and demonstrated that the case had no connections "to Texas as a whole," Appx121; *see* Appx117-135; Reply 17. Indeed, Apple devoted its arguments to showing why STC.UNM was *wrong* to suggest the case had any connection to Austin.

The district court "understood" Apple to have consistently argued "that the Northern District of California is the clearly more convenient

venue for this dispute … as opposed to Austin or Waco," and that "as between Waco and Austin, [Apple] believe[d] that Austin [was] the more convenient of the two." Appx311; *see* Reply 16-18. And STC.UNM offered no justification for keeping the case in Waco. STC.UNM expressed a preference for Waco (Appx306) and asserted that "there would be little if any impact on the inconvenience to any witnesses given the short distance between Waco and Austin," Appx201, but it otherwise focused exclusively on why Austin was supposedly more convenient than the Northern District of California, Appx187-201. In other words, the only meaningful dispute was Austin versus the Northern District of California—Waco was never a legitimate contender.

Contrary to the panel's suggestion, Apple need not "take back its previous assertion to the district court that the Austin Division is 'clearly more convenient' than the Waco Division." Order 4. This assertion might affect the binary (and waivable) inquiry about whether venue is *proper*. But § 1404(a) focuses on "relative convenience." *In re Toa Techs., Inc.*, 543 F. App'x 1006, 1009 (Fed. Cir. 2013). It requires balancing multiple factors, each one of which may contain competing

considerations. If the mere acknowledgement that one potential venue had *something* to recommend it under that multifactor test precluded transfer, parties could not obtain transfer to a substantially more convenient venue overall, and § 1404(a) would be a nullity. And Apple didn't even go that far. It consistently maintained that both Austin and Waco were inconvenient across the board, notwithstanding one slight difference in convenience between the two, and that the Northern District of California was substantially and clearly more convenient on every relevant dimension. *See* Appx121-122; Appx135; Appx250; Appx256; Appx311.

There is no logical or legal inconsistency in saying that one venue (the Northern District of California) is by far the most convenient under the § 1404(a) factors; that one venue (Waco) has no arguable connection to the case and is the least convenient suggested venue; and that a third venue (Austin) likewise has no connection but would require marginally less travel time. Where there is no "asserted inconsistency with regard to the convenience of trial in the state of Texas as a whole," a defendant's pursuit of lesser alternative relief does not "preclude transfer to a venue that is far more convenient and fair" than the

alternative venue. *In re Microsoft Corp.*, 630 F.3d 1361, 1365 (Fed. Cir. 2011). Rather, a "motion to transfer venue should be granted upon a showing that the transferee venue 'is clearly more convenient'" than the plaintiff's chosen venue, *In re Genentech, Inc.*, 566 F.3d 1338, 1342 (Fed. Cir. 2009), regardless of whether some other venue might also be relatively more convenient than the transferor venue. And there is no reasonable basis for denying a mandamus petition on that basis when the petitioner shows that the denial of transfer to the preferred venue was a clear abuse of discretion. *See infra* Part IIA.

To the extent the panel accepted STC.UNM's argument that Apple is judicially estopped from seeking transfer to the Northern District of California, that was improper for the reasons Apple explained in its mandamus reply (at 16-20). *See also* Reh'g Pet. 17-20, Dkt. 37, *In re Apple Inc.*, No. 20-104 (Fed. Cir. Jan. 21, 2020), available at Appx521-524.[1] Judicial estoppel prevents a party from taking "plainly inconsistent" positions during litigation. *Reed v. City of Arlington*, 650 F.3d 571, 574 (5th Cir. 2011) (en banc). Throughout this dispute, Apple

[1] Apple reproduced certain filings from case number 20-104 at Appx418-533.

has maintained that the Northern District of California is clearly more convenient than either Austin or Waco and that Austin is marginally less inconvenient than Waco. That is perfectly consistent with requesting transfer to California, particularly given § 1404(a)'s focus on "relative convenience." *Toa Techs.*, 543 F. App'x at 1009. The threshold inconsistency required for estoppel is not present.

It is inequitable to punish a defendant for offering alternative, but legally and logically consistent, theories of convenience. It also encourages bad behavior by plaintiffs: They will continue to file in the Waco Division—without even pretending it has ties to their case—confident that they will be able to force the defendant to choose between accepting transfer to still-inconvenient Austin or seeking *only* interdistrict transfer, which is virtually certain to be denied. *See* Pet. 12-16, Dkt. 2-1, *In re Apple Inc.*, No. 20-135 (Fed. Cir. June 16, 2020). There is no basis, in either § 1404(a) or the estoppel doctrine, for limiting defendants to this Hobson's choice. Rehearing is warranted to correct the panel's error.

II. The Panel Acknowledged That Legal Errors Infected The District Court's Analysis But Improperly Declined To Grant Mandamus To Correct Those Errors.

The panel acknowledged that the district court made at least two errors of law in its § 1404(a) analysis, which should have been enough to warrant mandamus. The panel's basis for excusing those errors—essentially, that the district court recited and addressed each § 1404(a) factor—is contrary to this Court's historical treatment of mandamus petitions in transfer cases. The Court should grant en banc rehearing to harmonize this case with its precedent.

A. The panel correctly identified two legal errors in the district court's order denying transfer, warranting mandamus relief.

1. The panel "question[ed] the propriety of the district court's reliance on *Weatherford* to hold that a court must draw all reasonable inferences and resolve all factual conflicts in favor of the non-moving party when assessing a § 1404(a) transfer for convenience," because it was "not convinced that this standard, which sounds like summary judgment, should apply to a transfer motion." Order 4-5. This skepticism was justified: The district court's resolution of factual conflicts in favor of STC.UNM was a clear abuse of discretion.

That approach—referred to as the *Weatherford* principle from a district court case that recited it—has no legal foundation and is at odds with all indicators from the Supreme Court and appellate courts of how § 1404(a) works. Apple has previously explained why the evidentiary principle applicable to motions to dismiss and summary-judgment motions is utterly inappropriate for the § 1404(a) context. *See* Appx441-448; Appx477-481; Appx512-521.

In brief, a district court must make factual findings in applying § 1404(a). *See, e.g.*, *In re LimitNone, LLC*, 551 F.3d 572, 577 (7th Cir. 2008); *Hustler Mag., Inc. v. U.S. Dist. Ct.*, 790 F.2d 69, 71 (10th Cir. 1986). A "motion to transfer under § 1404(a) calls upon the trial court to weigh a number of case-specific factors based on the individualized facts." *In re Verizon Bus. Network Servs. Inc.*, 635 F.3d 559, 561 (Fed. Cir. 2011). Trial courts are well-suited to do so. *See In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010). And a district court abuses its discretion when it "fail[s] to fully consider the facts in the record." *In re Apple, Inc.*, 581 F. App'x 886, 888 (Fed. Cir. 2014). Presumptions and default rules are no substitute for an individualized assessment of evidence, and district courts err when they "accept[] … without

scrutiny" factual contentions made by a plaintiff opposing a § 1404(a) motion. *Microsoft*, 630 F.3d at 1364-65.

The panel seemed to recognize that the district court erred in accepting STC.UNM's bare assertions, even those contradicted by Apple's and Broadcom's sworn declarations. Order 4-5. And it is indisputable that this legal error infected the underlying analysis. The district court could not otherwise have credited STC.UNM's arguments that Apple's Austin operations are a relevant source of proof, that Broadcom's Northern California employees are unlikely witnesses, that the Wi-Fi Alliance has any plausibly relevant information, or that any interoperability evidence (even if relevant) would be sourced from Austin. *See* Pet. 17-18, 20-21, 33-34. Those findings were crucial to the district court's treatment of the witness-convenience, compulsory-process, sources-of-proof, and local-interest factors.[2] Without them, the

[2] Indeed, the panel cited these same improper factual "findings" to justify the district court's reasonableness—failing to recognize that those findings were possible only by crediting STC.UNM's bare assertions over Apple's sworn statements. *See* Order 6-7 (crediting STC.UNM's contradicted positions regarding the Wi-Fi Alliance and the location of likely Broadcom witnesses).

Court could not have weighed the § 1404(a) factors in a way that led to denying transfer.

2. The panel also correctly expressed "concern with the district court's reliance on … the discordant proposition that the convenience of party witnesses is given 'little weight.'" Order 5. As the panel recognized, that notion contradicts Fifth and Federal Circuit precedent recognizing the significance of convenience to party and non-party witnesses alike and hinting at no differentiation. *Id.*; *see, e.g.*, *In re Acer Am. Corp.*, 626 F.3d 1252, 1255 (Fed. Cir. 2010); *In re Nintendo Co.*, 589 F.3d 1194, 1198-99 (Fed. Cir. 2009); *Genentech*, 566 F.3d at 1343-45; *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 317 (5th Cir. 2008) (en banc).

Discounting party-witness convenience is also inconsistent with the rationale underlying this factor and its preeminence in the transfer analysis: As Fifth Circuit precedent establishes, "[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). These concerns apply equally to all witnesses, even those employed by a party. This error, too, unquestionably affected the transfer outcome. Although it recognized that witness convenience is "the single most important factor in the transfer analysis," Appx10, and further found that "the cost of attendance of party witnesses weighs generally in favor of transfer," Appx11, the district court gave no special weight to this factor, undoubtedly informed by its improper discounting of party witnesses.

3. That multiple errors infected the district court's analysis warrants mandamus. "The right to the issuance of the writ is necessarily clear and indisputable if the district court clearly abused its discretion." *In re Itron, Inc.*, 883 F.3d 553, 568 (5th Cir. 2018) (internal quotation marks omitted). And, "[b]y definition, a district court abuses its discretion when it makes an error of law or applies an incorrect legal standard." *Klier v. Elf Atochem N. Am., Inc.*, 658 F.3d 468, 474 (5th Cir. 2011); *see Koon v. United States*, 518 U.S. 81, 100 (1996). The panel correctly identified clear legal errors in the district court's order, but declined to do anything about them.

B. The panel's justification for overlooking the district court's errors was contrary to precedent.

The panel's justification for refusing to grant mandamus notwithstanding the district court's legal errors is contrary to law and warrants en banc review. The panel's conclusion rested on the faulty notion that it could not disturb the district court's decision because it purported to "consider[] all the relevant transfer factors." Order 4. That formulation sets an unduly high bar for mandamus. As explained (at 14-18), the district court committed multiple clear legal errors in applying § 1404(a). That the court purported to address each factor cannot undo those errors.

Nor has this Court historically held petitioners to this high bar. It has readily granted mandamus where the district court recited and applied the § 1404(a) factors but nonetheless patently erred in analyzing them.

For instance, this Court granted mandamus for a clear abuse of discretion where a district court applied each § 1404(a) factor but placed undue weight on party convenience, while undervaluing the extent to which several factors favored transfer. *See Acer*, 626 F.3d at 1255-56. Similarly, this Court granted mandamus where "the district court failed

to balance [the § 1404(a)] factors fairly and instead elevated two considerations to overriding importance." *In re Link_A_Media Devices Corp.*, 662 F.3d 1221, 1223 (Fed. Cir. 2011). These decisions are not aberrations. *See, e.g.*, *Nintendo*, 589 F.3d at 1200 (granting mandamus where district court "applied too strict of a standard to allow transfer" and "misapplied the [§ 1404(a)] factors"); *Verizon*, 635 F.3d at 561-62 (granting mandamus because of the "stark contrast in convenience and fairness" for "the identified witnesses"); *In re TS Tech USA Corp.*, 551 F.3d 1315, 1320-22 (Fed. Cir. 2008) (granting mandamus because the district court gave "too much weight" to certain factors and denied transfer "from a venue with no meaningful ties"); *cf. In re Radmax, Ltd.*, 720 F.3d 285, 288-90 (5th Cir. 2013) (granting mandamus because the district court gave insufficient weight to the access-to-proof factor; improperly discounted the inconvenience of the transferor venue; erroneously considered "garden-variety delay"; and erred by finding the local interest of the transferee district was only "slightly" greater than that of the transferor district when that factor "solidly" favored transfer).

This Court's precedent plainly authorizes mandamus where the district court clearly misstates and misapplies the law. And that is what is happening, repeatedly, in the Waco Division.[3] The district court's repeated erroneous transfer denials—still uncorrected by this Court—are making that division a haven for judge-shopping, flooding the court with hundreds of patent cases with no asserted connection to Waco. *See* Reply 1-4, 15-17, Dkt. 37, *In re Apple Inc.*, No. 20-135 (Fed. Cir. July 6, 2020). Mandamus is an extraordinary remedy, but it is the only effective tool for addressing § 1404(a) errors, and thus the only way to correct this ongoing misapplication of that statute. *See In re HTC Corp.*, 889 F.3d 1349, 1352 (Fed. Cir. 2018). Raising the bar for mandamus still higher, as the panel did here, is not only contrary to this Court's precedent, but will also serve as an invitation to eviscerate § 1404(a) altogether.

CONCLUSION

The Court should grant en banc rehearing.

[3] Even after the panel's order explained the legal error, the district court issued another transfer denial "stand[ing] by … giving little weight" to party-witness convenience. *Uniloc 2017 LLC v. Apple Inc.*, No. 19-CV-532 (ADA), Dkt. No. 72, at 26 n.13 (W.D. Tex. June 22, 2020).

Respectfully submitted,

/s/Melanie L. Bostwick

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CERTIFICATE OF COMPLIANCE

The petition complies with the type-volume limitation of Fed. R. App. P. 35(b)(2)(A) because this petition contains 3789 words, excluding the parts of the petition exempted by Fed. Cir. R. 32(b)(2).

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

ADDENDUM

Order in In re Apple Inc., No. 20-127 (Fed. Cir. June 16, 2020)

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: APPLE INC.,
Petitioner

2020-127

On Petition for Writ of Mandamus to the United States District Court for the Western District of Texas in No. 1:20-cv-00351-ADA, Judge Alan D. Albright.

ON PETITION

Before O'MALLEY, WALLACH, and STOLL, *Circuit Judges*.

STOLL, *Circuit Judge*.

O R D E R

Apple Inc. petitions for a writ of mandamus directing the United States District Court for the Western District of Texas to direct transfer of this action to the United States District Court for the Northern District of California. STC.UNM opposes the petition. Apple replies. For the following reasons, we deny Apple's petition.

BACKGROUND

This petition arises out of a complaint filed by STC.UNM in the Waco Division of the Western District of

Texas, alleging that STC.UNM's asserted patents are infringed by various Apple products supporting the IEEE 802.11ac wireless networking standard. According to STC.UNM, the asserted patents "read on" that wireless network standard and the accused devices infringe by being compliant with the standard. Resp. at 4. Apple indicates that its accused products support the wireless standard via semiconductor chips developed by Broadcom Inc., a company with offices in San Jose, Irvine, and San Diego, California, as well as in the Western District in Austin, Texas.

The district court granted Apple's motion to transfer this case pursuant to 28 U.S.C. § 1404(a) in part, holding that Apple had demonstrated trial in the Austin Division of the Western District of Texas was clearly more convenient than the Waco Division, but that Apple had not clearly established that the Northern District of California was more suitable for trial than Austin, Texas. In doing so, the district court relied on *Weatherford Tech. Holdings, LLC v. Tesco Corp.*, No. 2:17-CV-00456-JRG, 2018 WL 4620636 (E.D. Tex. May 22, 2018) for the proposition that a court must draw all reasonable inferences and resolve all factual conflicts in favor of the non-moving party when assessing a § 1404(a) transfer for convenience.

The district court acknowledged that the Northern District of California would be more convenient for the Apple employees and Broadcom employees who were specifically identified in the declarations in support of Apple's motion and that it would be easier to access or transfer any documentary sources from Apple or Broadcom that were located in the Northern District of California or other parts of California. However, the district court found that the presence of the Wi-Fi Alliance in the Western District of Texas mitigated against weighing the pertinent convenience factors strongly in favor of transfer, because it was "possible—if not likely—that STC.UNM could require the Wi-Fi Alliance as a significant source of proof." A. 7. The district

court also weighed against transfer a pending suit in the same district in which STC.UNM asserted the same claims of the same patents against another defendant, determining that there was a shorter time to trial in the Western District of Texas on the current schedule for this case as compared to the median time to trial in the Northern District of California.

The district court also found that the local interest factor did not weigh in favor of Northern California. The district court explained that, like the Northern District of California, the Western District of Texas had a significant interest because Apple was likely "one of the largest employers in each District." A. 14. Despite Apple's assertions that only its employees in Northern California had relevant and material information, the district court noted that Apple had issued a job posting for engineers with knowledge of the 802.11ac standard for its Austin campus, which the court found showed that "business Apple conducts within this District will be affected" by the case. *Id.* The court added that one of the accused products is made in Austin, Texas, "giving those involved with its manufacture a localized interest in determinations made regarding the infringement—or lack thereof—found in this case." A. 15.

The court, moreover, concluded that the localized interests of third parties weighed in favor of Western Texas. The court noted that the Wi-Fi Alliance, an organization that promotes, certifies, and ensures uniform adoption of Wi-Fi standards, including the 802.11ac standard, was located in Austin, Texas and had "a heavy localized interest in this case because infringement based on compliance with the 802.11ac standard would affect the Wi-Fi [A]lliance[']s promotions and certifications" and hinder its "goal of spreading use and adoption of the standard." *Id.* The court added that Broadcom also had a significant presence in Austin. The court acknowledged that Broadcom was headquartered in the Northern District of California.

However, it found that it was "more reasonable to assume that the chips [that were at issue in this case] were designed in the Central or Southern Districts of California." *Id.*

DISCUSSION

Apple now seeks for this court to issue a writ of mandamus to compel transfer to the Northern District of California. Such a request requires a showing of a clear abuse of discretion that produced a patently erroneous result. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1318–19 (Fed. Cir. 2008); *see also Cheney v. U.S. Dist. Ct. for Dist. of Columbia*, 542 U.S. 367, 381 (2004) (requiring that a petitioner seeking mandamus establish that the right to relief is "clear and indisputable" (internal quotation marks and citations omitted)). We issue such relief sparingly and only in "extraordinary" circumstances. *Cheney,* 542 U.S. at 380 (quoting *Ex parte Fahey*, 332 U.S. 258, 259–260 (1947)) (internal quotation marks omitted). Apple has not met that demanding standard here.

Apple does not dispute that the district court considered all the relevant transfer factors. Nor can Apple now take back its previous assertion to the district court that the Austin Division is "clearly more convenient" than the Waco Division. A. 121. Instead, Apple primarily complains that in not transferring to the Northern District of California, the district court erred in assessing and weighing the relevant transfer factors. But the district court's grant of the alternative relief that Apple requested counsels against the extraordinary remedy of mandamus. Given that Apple received a transfer to its second-most convenient venue, it is difficult to accept Apple's assertion that the result here is patently erroneous.

We do question the propriety of the district court's reliance on *Weatherford* to hold that a court must draw all reasonable inferences and resolve all factual conflicts in favor of the non-moving party when assessing a § 1404(a)

transfer for convenience. We are not convinced that this standard, which sounds like summary judgment, should apply to a transfer motion. The plaintiff's choice of forum is already protected by the elevated "clearly more convenient" standard that the movant must meet. Nonetheless, whatever may be said about the validity of drawing inferences and resolving factual disputes in favor of the nonmoving party in the context of a transfer motion, we cannot say that Apple's right to relief here is indisputably clear.

Apple has not clearly and indisputably established the right to transfer to Northern California based on the convenience of witnesses. We agree with Apple that "[t]he convenience of the witnesses is probably the single most important factor in transfer analysis." *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009) (internal quotation marks and citation omitted). We also share Apple's concern with the district court's reliance on *ADS Security* for the discordant proposition that the convenience of party witnesses is given "little weight." A. 10 (citing *ADS Sec. L.P. v. Advanced Detection Sec. Servs., Inc.*, No. A-09-CA-773-LY, 2010 WL 1170976, at *4 (W.D. Tex. Mar. 23, 2010)); *see also, e.g., Genentech*, 566 F.3d at 1343–45 (considering convenience of party and non-party witnesses alike). Nevertheless, Apple's right to relief is not clear and indisputable here. The district court held that, as a whole, the convenience of party and non-party witnesses weighed in favor of transfer. In support of its holding, the district court determined that the convenience of the identified non-party witnesses was neutral overall. Thus, it is not as if the district court applied *ADS Security* to tip the scales in favor of non-party witnesses while giving party witnesses little weight. Instead, the convenience of the party witnesses was the determinative consideration here—and indeed, determinative in Apple's favor.

Nor has Apple clearly and indisputably established the right to transfer to Northern California based on countervailing convenience or localized interest considerations.

Whether individuals or organizations may have relevant information and whether a certain forum has a localized connection to the relevant conduct and activities in a case are fact-intensive matters often subject to reasonable dispute. *Cf. Van Cauwenberghe v. Biard*, 486 U.S. 517, 528 (1988). Those determinations are generally entrusted to the discretion of the district court. *See Vistaprint*, 628 F.3d at 1346 ("Our reluctance to interfere is not merely a formality, but rather a longstanding recognition that a trial judge has a superior opportunity to familiarize himself or herself with the nature of the case and the probable testimony at trial, and ultimately is better able to dispose of these motions."). When those factors are meaningfully considered by the district court, and the court's balancing of all the relevant factors is "reasonable," its decision is entitled to "substantial deference." *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 257 (1981) (citations omitted).

The district court did not clearly abuse that discretion here. The court's conclusion that the Wi-Fi Alliance's location in Austin, Texas could be a source of relevant information in this case does not seem unreasonable in light of STC.UNM's stated theory of infringement. In that regard, the court fairly could find that a test or certification that the Wi-Fi Alliance has in its possession concerning whether the products comply or are interoperable with the 802.11ac standard could be relevant even if, as Apple contends, some of the features targeted by the patents are considered optional under the standard. Although Apple contends that STC.UNM is likely unable to demonstrate infringement here merely by showing compliance or interoperability with the wireless standard, the question of whether it has committed infringement is a merits issue, not one that should be decided on mandamus review in the context of a motion to transfer venue.

Nor has Apple shown that Northern California has a clearly more compelling local concern in adjudicating the issues. Although Broadcom is headquartered in the

Northern District of California, the affidavit from Broadcom's employee that Apple submitted in support of the motion to transfer merely stated that the Broadcom chips at the center of this dispute were developed "in California," within a business unit that "has members located in San Jose, Irvine, and San Diego, California" with "[s]ome engineering support . . . provided by Broadcom employees in India." A. 139, ¶8. Indeed, the Broadcom executive who submitted the declaration, and who is presumably most likely to be asked by Apple to testify, works outside the Northern District of California in San Diego, California. Thus, any suggestion by Apple that the Northern District of California has a unique connection to the accused products in this case is not clearly convincing. Under these circumstances, the district court's decision to try this case in the Austin Division over Northern California did not amount to a clear abuse of discretion.

Accordingly,

IT IS ORDERED THAT:

The petition is denied.

FOR THE COURT

June 16, 2020
Date

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

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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 July 16, 2020.

I certify that all counsel of record in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

A copy of the foregoing was served upon the district court judge via UPS:

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