2021-144

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

In re: GOOGLE LLC,
Petitioner

On Petition for Writ of Mandamus to the United States District Court for the Western District of Texas in No. 6:20-cv-0075-ADA, Judge Alan D. Albright

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ECOFACTOR, INC.'S RESPONSE TO PETITION FOR WRIT OF MANDAMUS

May 21, 2021

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4(a)(1) and Federal Rule of Appellate Procedure 26.1, counsel for Cross-Appellant EcoFactor, Inc. certifies the following:

1. The full name of the party represented by us is:

   - EcoFactor, Inc.

2. The name of the real parties in interest represented by us:

   - Not applicable. EcoFactor, Inc. is a real party in interest.

3. All parent corporations and publicly held companies that own 10 percent or more of the stock of the party represented by us are as follows:

   - Not Applicable.

4. The names of all law firms and the partners or associates that appeared for EcoFactor, Inc. in the trial court, or are expected to appear in this Court are:

   - Reza Mirzaie, Robert Gajarsa, Marc A. Fenster, Kristopher Davis, Paul A. Kroeger, Philip X. Wang, C. Jay Chung, and Shani Williams of Russ August & Kabat

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 are:

   - Not applicable.

6. Information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees):

- Not applicable.

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INTRODUCTION

In order to meet its "heavy burden" of proving a "clear and indisputable" right to the "extraordinary remedy" of mandamus, Google LLC ("Google") must demonstrate that the district court's decision amounted to a clear abuse of discretion. *In re Google LLC*, 823 F. App'x 982, 983 (Fed. Cir. 2020) (citations omitted). Google's petition falls far short of this standard.

For example, Google argues that the district court erred in determining that the Western District of Texas has a significant interest in the case. But this finding was more than reasonable in light of the undisputed evidence regarding Google's substantial presence in the district dating back 14 years, including an office in Austin with over 1,400 employees (which Google plans to significantly expand). And Google expressly admitted that among those 1,400 employees are ones with knowledge about the accused products. The district court reasonably weighed this evidence against Google's contacts with the Northern District of California and determined this factor to be neutral.

Google also argues that the district court improperly found the convenience of the witnesses factor to be neutral. According to Google, all of the relevant witnesses are in the Northern District of California. But they are not. Again, Google admitted that it has employees in Texas with relevant knowledge. Indeed, in Google's supplemental declaration, Google reconfirmed that Google has *additional*

potential witnesses in Texas with knowledge about the accused products. In light of this evidence showing that there are potential witnesses in both districts, the district court was well within its discretion to find this factor to be neutral.

The district court also reasonably determined that judicial economy concerns strongly weighed against transfer in light of EcoFactor's other lawsuits concerning the same patents in the Western District of Texas. When that fact is considered in light of Google's admission that trial would occur sooner in the Western District of Texas than the Northern District of California (regardless of the number of cases in each district), there can be no legitimate dispute that this factor weighs heavily against transfer.

At the end of the day, each of Google's arguments boils down to its disagreement with the district court's weighing of the facts. But the transfer analysis involves "fact-intensive matters often subject to reasonable dispute," the resolution of which is "entrusted to the discretion of the district court." *In re Apple Inc.*, 818 F. App'x 1001, 1004 (Fed. Cir. 2020) ("*Apple I*"). Where, as here, the transfer factors were "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." *Id.*

Google's petition should be denied.

REASONS WHY THE WRIT SHOULD NOT ISSUE

I. Legal Standard For Mandamus And § 1404(a) Transfer

"The legal standard for mandamus relief is demanding." *In re W. Digital Techs., Inc.*, No. 2021-137, 2021 WL 1853373, at *1 (Fed. Cir. May 10, 2021) . A party seeking a writ of mandamus bears the "heavy burden of demonstrating to the court that it has no 'adequate alternative' means to obtain the desired relief, and that the right to issuance of the writ is 'clear and indisputable.'" *Google*, 823 F. App'x at 983 (citations omitted). "And even when those requirements are met, the court must still be satisfied that the issuance of the writ is appropriate under the circumstances." *Id.* As emphasized by this Court, mandamus relief should be issued "sparingly and ***only in 'extraordinary' circumstances***." *Apple I*, 818 F. App'x at 1003; *see also Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (A writ of mandamus is a "drastic and extraordinary remedy reserved for really extraordinary causes." (quotation marks omitted)).[1]

In the context of a motion to transfer, a request for mandamus requires a showing of a "clear abuse of discretion that produced a patently erroneous result." *Apple I*, 818 F. App'x at 1003. And when considering transfers under Fifth Circuit law, mandamus ***must be denied*** "unless it is clear 'that the facts and circumstances are without any basis for a judgment of discretion.'" *In re SK hynix Inc.*, No. 2021-

[1] All emphases added unless otherwise noted.

114, 2021 WL 733390, at *3 (Fed. Cir. Feb. 25, 2021); *see also In re True Chem. Sols., LLC*, 841 F. App'x 240, 241 (Fed. Cir. 2021) (Under the "exacting standard [of mandamus in the context of a transfer ruling], we ***must deny mandamus*** unless it is clear 'that the facts and circumstances are without any basis for a judgment of discretion.'").

To prevail on a motion to transfer under 28 U.S.C. § 1404(a) in the Fifth Circuit, there is a "***significant burden*** on the movant to show good cause for the transfer." *In re Volkswagen of America, Inc.*, 545 F.3d 304, 314 n.10 (5th Cir. 2008); *Texas Data Co., LLC v. Target Brands, Inc.*, 771 F. Supp. 2d 630, 638 (E.D. Tex. 2011) ("[T]he Court, in accordance with the Fifth Circuit, recognizes the significance of the burden and does not take it lightly"). Absent a showing that the transferee venue is "***clearly more convenient***" than the venue chosen by plaintiff, the plaintiff's choice "should be respected." *Volkswagen*, 545 F.3d at 315.

In determining whether the moving party has met this significant burden, courts consider various private and public interest factors (discussed further below), none of which are alone dispositive. *Id.* The private factors are: (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. *Id.* The public factors are: (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 of the application of foreign law. *Id*.

II. Google Has Failed To Meet Its Heavy Burden To Show A "Clear and Indisputable" Right To Relief

A. The District Court Reasonably Determined That Google Failed To Meet Its Burden To Show That The Northern District Of California Is Clearly More Convenient

The district court reasonably found that the Northern District of California is not the ***clearly more convenient*** forum for this suit. There was no "clear abuse of discretion" in that factual finding or "patently erroneous result" here. *Apple I*, 818 F. App'x at 1003. The district court carefully considered the facts and evidence before it, weighed each of the relevant transfer factors in accordance with the applicable law, and determined that each factor was either neutral or strongly weighed against transfer. And the court issued a detailed order with its analysis and reasons explaining a clear basis for its judgment of discretion.

Google simply disagrees with the district court's ***weighing*** of the facts. But that is not enough. The transfer analysis involves "fact-intensive matters often subject to reasonable dispute." *Apple I,* 818 F. App'x at 1004. And absent a "clear abuse of discretion" and "patently erroneous result," the resolution of that dispute is "***entrusted to the discretion of the district court.***" *Id.*; *see also In re Vistaprint Ltd.*,

628 F.3d 1342, 1346 (Fed. Cir. 2010) ("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."); *True Chem.*, 841 F. App'x at 241 ("Section 1404(a) gives district courts broad discretion to determine when party and witness 'convenience' or 'the interest of justice' make a transfer appropriate.").

Where, as here, the transfer 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." *Apple I*, 818 F. App'x at 1004 (quotation marks omitted); *True Chem.*, 841 F. App'x at 241 (denying mandamus where the "district court meaningfully analyzed the transfer factors"); *In re Apple Inc.*, 456 F. App'x 907, 909 (Fed. Cir. 2012) ("*Apple II*") ("[T]his court has importantly granted mandamus only where the district court has denied a transfer motion without so much as considering the merits or the court blatantly deviates from [the relevant legal] principles.").

For instance, the district court properly found that this suit and Google have strong ties to the Western District of Texas in light of Google's admission that "there are [] employees in Texas with knowledge about the accused products." Appx9. EcoFactor also identified several Google personnel in Texas via publicly available

online sources, whom Google confirmed to be knowledgeable about the accused products. SAppx9–19. For example, Google's supplemental declaration confirmed that Google's "Software Engineer manager in Austin," Peter Grabowski, "worked on [the accused product] Nest from 2014 to 2017, and that Google's "Head of Energy Industry Partnership" involved in "sales of [the accused] Nest Learning Thermostat works within the Western District of Texas (Austin, Texas)." Appx349 ¶¶ 4, 7. Further, it is undisputed that "Google has had a substantial presence in Austin[, Texas] for nearly 14 years," having "leased significant square feet in office space and currently employ[ing] over 1,400 employees in Austin, with plans to expand its presence in Texas even further." Appx12.[2]

The district court also reasonably found that other factors favored the Western District of Texas. For example, the district court rightly concluded that judicial economy concerns strongly weighed against transfer because there were multiple other lawsuits concerning the same patents pending before it. Appx10. And the administrative difficulties flowing from court congestion strongly weighed against

[2] Google's petition states that "Google also ***had*** an office in Austin, Texas" (Pet. at 4), suggesting that Google no longer has an office there. Not so. Google currently has over 1,400 employees in Austin, with plans to significantly expand its presence there. *See* Appx19–47; Appx154; *see also* https://careers.google.com/locations/ (last visited May 21, 2021) (showing Google offices in multiple locations throughout Texas, including Austin, San Antonio, Midlothian, and Dallas).

transfer because (as Google admitted) the time to trial in the Western District of Texas is lower than the Northern District of California. Appx11.

The district court did not give undue weight to any particular factor in denying Google's motion, but rather carefully considered and balanced all of the factors together in accordance with Fifth Circuit law, as discussed in detail below. And in light of Google's failure to demonstrate that the factors considered together strongly weighed in favor of transfer, the district court reasonably determined that "Google has not met its significant burden to demonstrate that the NDCA is 'clearly more convenient' than [the Western District of Texas]." Appx12.

B. The Facts In This Case Against Transfer Align With Other Mandamus Petitions That This Court Have Denied

The district court's decision is consistent with this Court's decisions upholding denials of discretionary transfer motions and denying mandamus. For example, in *Apple I,* this Court denied mandamus when the same district court denied transfer after determining that there was a shorter time to trial in the Western District of Texas as compared to the Northern District of California, and that the Western District of Texas had a significant interest in the case because Apple was one of the largest employers in the District. 818 F. App'x at 1002. *Id.* Therefore, the local interest did not weigh in favor of Northern District of California despite the fact that both defendant Apple and its supplier relevant to that case, Broadcom Inc., were headquartered in Northern California. *Id.* And while Apple asserted that only

its employees in Northern California had relevant and material information (as Google does here), a job posting by Apple for engineers for its Austin campus showed that the "business Apple conducts within [the Western District of Texas] will be affected" by the case. *Id.* On these facts, where it was undisputed that "the district court considered all the relevant transfer factors," and even found that some factors, including the convenience of the witnesses, weighed in favor of transfer, this Court held that the district court's decision to deny transfer "did not amount to an abuse of discretion." *Id.* at 1002, 1004.

Similarly, in *In re Western Digital Technologies, Inc.*, No. 2021-137, 2021 WL 1853373 (Fed. Cir. May 10, 2021), the district court found that the movant had failed to identify relevant physical documents with particularity, that the Western District of Texas had a local interest in the case based on the movant's offices in the district, and that the Western District of Texas was likely to be faster in adjudicating the matter than the Northern District of California. *Id.* at *1. In denying mandamus, this Court held that, while it "may have evaluated some of the factors differently," the district court's ultimate conclusion that the transferee venue was not clearly more convenient did not amount to a clear abuse of discretion. *Id.*

The same result should follow here. Like in *Apple I* and *Western Digital*, though headquartered elsewhere, Google is a large employer in the Western District of Texas. Indeed, Google directly "admits that there are also employees in Texas

with knowledge about the accused products." Appx9. And like in *Western Digital*, Google has failed to state with particularity what documents are located outside the district, and it does not dispute that the Western District of Texas would be faster in adjudicating the matter than the Northern District of California.

Though Google, like the petitioners in *Apple I* and *Western Digital*, disagrees with the weight the district court assigned to those facts, that does not amount to a clear ***abuse of*** discretion. That is the very ***nature of*** discretion itself. The transfer analysis involves highly fact-intensive matters, and the district court's findings and balancing of the relevant factors are entitled to "substantial deference." *Apple I*, 818 F. App'x at 1004. Because Google has not met the "exacting" standard to demonstrate that the "district court's decision amounted to a failure to meaningfully consider the merits of the transfer motion," its petition should be denied. *In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014); *In re Apple Inc.*, No. 2020-115, slip op. at 2 (Fed. Cir. Apr. 22, 2020) (same).[3]

[3] That the district court ruled on the transfer motion here "nearly 10 months after it was fully briefed" (Pet. at 10) is irrelevant and does not support granting the Petition. *See, e.g.*, *Apple II*, 456 F. App'x at 908 (denying mandamus where the district court took nearly 15 months to rule on the motion, noting that petitioner "failed to employ any strategy to pressure the district court to act, such as seeking mandamus to direct the district court to rule on the motion"); *Google*, 823 F. App'x at 983 (denying mandamus despite the Court's "concern[] that the district court did not move more quickly to resolve Google's motion").

C. The District Court's Analysis Of The Relevant Public And Private Interest Factors Is Consistent With Precedent Of The Fifth Circuit And This Court

As set forth below, the district court carefully considered each of the relevant public and private interest factors, made factual determinations based on the evidence before it that are entitled to substantial deference, and reasonably exercised its discretion in weighing the factors. That Google disagrees with the district court's weighing of the factors does not satisfy the heavy burden to establish a clear and indisputable right to relief.

1. The District Court Properly Considered The Location Of The Parties' Electronic And Physical Documents And Reasonably Determined That The Relative Ease Of Access To Sources Of Proof Is Neutral

The district court's analysis of this factor was reasonable and in accordance with precedent. The district court considered that the bulk of relevant evidence in patent cases typically comes from the accused infringer, and thus focused primarily on the location of Google's evidence. Appx4–6 (citing *In re Apple Inc.*, 979 F.3d 1332, 1340 (Fed. Cir. 2020), *In re Genentech, Inc*., 566 F.3d 1338, 1345 (Fed. Cir. 2009)). The district court properly rejected Google's attempt to count witnesses under this factor, and instead considered the location of Google's (1) physical and (2) electronic documents. Appx4–5. As to the first, the district court reasonably exercised its discretion and gave little weight to Google's "vague and conclusory argument regarding physical documents." Appx5. And as to the second, the district

court correctly observed that Google failed to explain why its electronic documents "cannot be accessed from its Austin, Texas office." Appx6.

Regarding source code, the district court considered Google's allegations that the review of its source code for the pending ITC investigation between the parties took place in the Northern District of California. *Id.* But as the district court reasoned and found as a matter of fact, Google failed to identify where the source code is actually stored. *Id.* The district court also considered the undisputed evidence that Google voluntarily tried to move its source code review from Palo Alto to Washington, D.C., which showed that Google has the "capability to make the source code available at another location, such as in Austin, Texas." *Id.*; Appx249–250. In any event, review of Google's source code for this case need not take place in Texas even if trial occurs there. The district court thus reasonably determined that this factor is neutral. *Id.*

Google does not dispute any of the facts underlying the district court's analysis, namely, that all of Google's documents, as well as source code, are available electronically and can be just as easily accessed from its Austin office as those in Northern California. Rather, Google argues that the district court misapplied the law by failing to consider the physical location of its documents. Pet. at 15. Not so. The district court *first* considered the location of Google's physical documents, and reasonably gave little weight to Google's conclusory assertion that any such

evidence is "likely in Palo Alto, California." Appx4–5. That is a factual finding entitled to deference. *See In re Tesco Corp. (US)*, 179 Fed. App'x 2, 3 (Fed. Cir. 2006) (citing *Peteet v. Dow Chem. Co.*, 868 F.2d 1428, 1436 (5th Cir. 1989)). And while it is true that the district court has criticized focusing on the physical location of electronic documents as being "out of touch with modern patent litigation," the district court nonetheless recognized that "*the physical location of electronic documents does affect the outcome of this factor under current Fifth Circuit precedent*," and considered those facts. Appx5 (citing *Volkswagen*, 545 F.3d at 316).

Contrary to Google's assertions, none of the cases cited in its Petition hold that district courts are categorically prohibited from considering the realities of transporting electronic documents, particularly where, as here, it is undisputed that those documents can just as easily be made available in the plaintiff's chosen forum. Rather, those cases simply stand for the proposition that, despite advances in technology, the physical location of documents, particularly physical documents, should still be the primary focus. In other words, courts cannot simply assume that this factor is neutral, otherwise it would be rendered "superfluous." *See, e.g.*, *Volkswagen*, 545 F.3d at 316 ("That access to some sources of proof presents a lesser inconvenience now than it might have absent recent developments does not render this factor superfluous. All of the documents and ***physical evidence*** relating to the accident are located in the Dallas Division, as is the collision site."); *In re TS Tech*

USA Corp., 551 F.3d 1315, 1321 (Fed. Cir. 2008) ("Because ***all of the physical evidence***, including the headrests and the documentary evidence, are far more conveniently located near the Ohio venue, the district court erred in not weighing this factor in favor of transfer."). The district court here did not just assume this factor is neutral. Rather, the district court provided reasoned analysis regarding the location of the documents and provided context regarding the electronic nature of them to conclude that, on balance, they do not weigh significantly in favor of either side.

Moreover, in contrast with the foregoing cases, Google merely offered vague assertions about its documents and evidence without providing specifics, which the district court reasonably afforded little weight. Appx4-5 ("Google asserts in conclusory fashion that any such evidence is 'likely in Palo Alto, California.'"); *see Western Digital*, 2021 WL 1853373 (denying mandamus where the district court found that the movant failed to identify relevant physical documents with particularity).

And contrary to Google's assertion, EcoFactor's acknowledgment, in an email exhibit, that Google had previously agreed to make its source code available in Silicon Valley (Appx249) did not somehow establish that such source code is physically stored there. It was Google's burden to establish where its evidence is located, and it failed to do so. Further, Google's generalized assertions about the

purported "complexities" of transporting source code (Pet. at 16–17) are directly contradicted by its own attempt to move its source code across the country—voluntarily and without being requested to do so—to Washington, D.C., as noted in the district court's order. Appx249, Appx6.

Google's argument about transporting product "prototypes" (Pet. at 16-17) is also without merit. As an initial matter, it is unclear whether any prototype would need to be transported anywhere, as infringement analysis involves comparing the patent claims with the actual products being sold by Google throughout the country, including in Texas. Nor does Google assert that it would be inconvenient to transport such prototypes to Texas. Indeed, the products at issue here are smart thermostat devices that can easily be shipped anywhere at extremely low cost. In any event, contrary to Google's assertions, the district court *did* consider Google's argument regarding "prototypes," and properly weighed those facts with the rest of the parties' arguments and evidence. *See* Appx4.

Finally, Google's vague, generalized assertion (at 15) that "any relevant third-party evidence is also likely in NDCA" should be rejected, as Google failed to specifically identify any such evidence in its motion below (and still fails to do so here).

Simply put, Google failed to meet its burden to show that the relevant sources of proof are more easily accessible in the Northern District of California than in the

Western District of Texas. The district court thus reasonably concluded that this factor is neutral.

2. The District Court Properly Weighed The Identified Third-Party Witnesses And Reasonably Determined That The Availability Of Compulsory Process Is Neutral

In evaluating the availability of compulsory process, the district court properly considered this Court's relevant precedents and applied them to the facts of the case. Appx7. The district court considered Google's allegation that "relevant third-party witnesses include the named inventors and possibly researchers who collaborated with EcoFactor," and reasonably discounted the weight of this factor in light of Google's failure to establish that any of the purported third-party witnesses would be unwilling to attend trial. *Id.* The district court further noted the undisputed fact—which Google fails to mention in its Petition—that EcoFactor has a consulting agreement with the only named inventor residing in the Northern District of California, and thus compulsory process would not be necessary for this witness. Appx7–8.

As to the "possibl[e] researchers," the district court correctly observed that Google failed to identify the relevant knowledge that these alleged individuals may have, and reasonably determined that "Google cannot rely on cherry-picked 'possibl[e]' witnesses who might live in NDCA to support its argument—especially when Google cannot specifically identify those individuals, the nature of the

information those individuals have, and how any such information relates to this case." *Id.* at 8. In light of these findings, the district court reasonably determined this factor is neutral. *Id.*

Google's arguments that the district court erred under this factor are without merit. First, Google argues that the district court was required to presume the third-party witnesses to be unwilling. Pet. at 18. That is not right. The sole case cited by Google for this purported proposition simply states, in a footnote, that in the *Eastern* District of Texas, third-party witnesses are presumed to be unwilling when there is no indication otherwise. *In re HP Inc.*, No. 2018-149, 2018 WL 4692486, at *3 n. 1. (Fed. Cir. Sept. 25, 2018). But decisions from the Eastern District of Texas are not binding on courts in the Western District of Texas. And unlike the Eastern District, courts in the Western District of Texas require affirmative evidence of unwillingness. *See, e.g.*, Appx7 (citing *Turner v. Cincinnati Ins. Co.*, No. 6:19-cv-642-ADA-JCM, 2020 WL 210809, at *3 (W.D. Tex. Jan. 14, 2020) ("This private interest factor carries far less weight when the movant has not alleged or shown that any witnesses are unwilling to testify.")). Google cites no Fifth Circuit case holding otherwise. The district court thus reasonably exercised its discretion in discounting the identified third-party witnesses under this factor. *See Barnes & Noble*, 743 F.3d at 1383 (denying mandamus where petitioner cited no binding circuit court case

suggesting that the district court erred in requiring it to demonstrate the witnesses would be unwilling or unable to testify if the case were tried there).

Google next argues that the district court erred in discounting the weight of the "possibl[e] researchers" because it was not required to identify individual employees and was not required to indicate the nature of their testimony. Pet. at 19. This, too, fails. The *HP* case cited by Google expressly states: "To be sure, ***it is reasonable*** to reject vague and unsupported statements regarding the location of potential witnesses or sources of proof." *In re HP Inc.*, 826 F. App'x 899, 903 (Fed. Cir. 2020). And while the Court stated that there was no basis to discount the identified entities "just because individual employees were not identified," the Court nonetheless found that such failure to identify individual employees would justify weighing this factor as *neutral* (as opposed to against transfer)—which is precisely what the district court did here. *Id.*

Moreover, that is not the sole reason the district court discounted the "possibl[e] researchers" here. The district court discounted those purported witnesses for many reasons, including because Google failed to demonstrate unwillingness and failed to even generally describe what relevant knowledge they might have. The cases cited by Google hold only that there is no rule requiring "affidavit evidence" indicating what *specific* testimony the witnesses might offer and why such testimony is relevant or important. *Volkswagen*, 545 F.3d at 317 n.12;

Genentech, 566 F.3d at 1344. But that does not relieve Google from the reasonable predicate to at least explain how the potential witnesses have relevant and material information. *Genentech*, 566 F.3d at 1343. Google did not do so. Further, Google did not dispute EcoFactor's assertion in its opposition that Google has no intention of calling these witnesses at trial (and likely has no intention of even deposing them), which further supports the district court's factual finding that these witnesses were cherry-picked by Google in its effort to artificially tip the scales in favor of transfer.

Finally, Google argues that the district court erred in observing that, to the extent that any of Google's out-of-district unidentified third-party witnesses would be necessary for trial, Google did not assert it would be inconvenienced by presenting such testimony by video. Appx8. According to Google, this was a "non-sequitur" because Google would still need a subpoena to compel the witnesses to give deposition testimony by video. Pet. at 19. But this argument fails to recognize that the district court has "nationwide subpoena power to compel a nonparty witness's attendance at a deposition within 100 miles of where the witness lives or works." *Weatherford Tech. Holdings, LLC v. Tesco Corp.*, No. 2:17-CV-00456-JRG, 2018 WL 4620636, at *4 (E.D. Tex. May 22, 2018); Fed. R. Civ. P. 45(c)(1)(A); *see also Battle ex rel. Battle v. Mem'l Hosp. at Gulfport*, 228 F.3d 544, 554 (5th Cir. 2000) (holding that a video deposition is an "acceptable substitute for oral testimony").

None of Google's arguments regarding purported legal error hit their mark. The district court reasonably exercised its discretion in finding this factor to be neutral.

3. The District Court Properly Weighed The Identified Willing Witnesses And Reasonably Determined That This Factor Is Neutral

The district court's analysis of this factor was also reasonable. The district court correctly noted, in accord with this Court's precedent, that the "convenience of witnesses is the single most important factor in the transfer analysis." Appx9; *Apple I*, 818 F. App'x at 1003. And though Google specifically identified three witnesses located in the Northern District of California, the district court also weighed Google's competing admission that ***there are Google employees in Texas with knowledge about the accused products***. *See* Appx9. Further, the district court reasonably discounted Google's reliance on EcoFactor's potential party witnesses in the Northern District of California in light of the declaration of EcoFactor's representative, and likely Rule 30(b)(6) witness, expressly stating that he is willing to attend trial in the Western District of Texas and that it will not be inconvenient for him. Appx10, Appx343 ¶ 3.

Google also insists that the district court erred in discounting a purported high number of potential witnesses located in the Northern District of California "on the ground that these individuals are only 'potential' witnesses." Pet. at 22. That is not

right. The district court only noted, as a "preliminary matter," that "given typical time limits at trial, the Court does not assume that all of the party and third-party witnesses listed in Section 1404(a) briefing will testify at trial." Appx9. That is a reasonable conclusion, and Google has never refuted it with any contrary facts. Put simply, the district court did not discount the witnesses simply because they were identified as "potential" witnesses, as Google contends. The district court made a "preliminary" observation based on its extensive experience presiding over cases and holding trials. Indeed, Google did not provide a "long list" of potential witnesses for trial—it only specifically identified three employee witnesses and one named inventor within the Northern District of California, who is willing to attend trial in Texas pursuant to his consulting agreement with EcoFactor. The district court properly considered and weighed Google's alleged potential witnesses.

Google's argument that the district court improperly gave party witnesses little weight also fails. The district court properly considered the convenience of both party and non-party witnesses in its analysis, and it correctly noted that the "convenience of witnesses is the single most important factor in the transfer analysis." Appx9. The district court reasonably exercised its discretion in affording the convenience of party witnesses less weight than non-party witnesses. *See, e.g.*, *Empty Barge Lines II, Inc. v. Dredge Leonard Fisher*, 441 F. Supp. 2d 786, 793 (E.D. Tex. 2006) ("Where the key witnesses are employees of the party seeking a

transfer, their convenience is entitled to less weight because the party is able to compel their attendance."). Google cites no authority holding that to be error. Indeed, in *Apple I,* this Court denied mandamus despite "concerns" about the district court's reliance on the proposition that the convenience of party witnesses is given "little weight." *Apple I*, 818 F. App'x at 1003. As in *Apple I*, the district court weighed the relevant witnesses and did not "tip the scales in favor of non-party witnesses" to deny transfer (indeed, the district court only assigned less weight, not ***no*** weight, to party witness convenience). *Id.* Accordingly, Google "has not clearly and indisputably established the right to transfer to Northern California based on the convenience of witnesses." *Id.*

Google's argument that the district court improperly relied on EcoFactor's identification of additional potential Google witnesses with knowledge about the accused products is equally unavailing. Contrary to Google's assertions, its supplemental declaration did not "definitively refute" anything. Pet. at 24. To the contrary, the supplemental declaration *confirmed* that there are several witnesses in Texas with relevant knowledge regarding the accused products. For example, Google's supplemental declaration confirmed that Google's "Software Engineer manager in Austin" Peter Grabowski "worked on [the accused product] Nest from 2014 to 2017." Appx349 ¶ 7; *see also* SAppx15–16. The supplemental declaration also confirmed that Google's "Head of Energy Industry Partnership" involved in

"sales of [the accused] Nest Learning Thermostat works within the Western District of Texas (Austin, Texas)." Appx349 ¶ 4.

The fact that some of the witnesses no longer work for Google, thus making them third-party witnesses, does not somehow make them irrelevant, as Google contends. And in fact, Google's supplemental declaration did not deny that the personnel identified by EcoFactor have relevant knowledge regarding the accused Nest product. For instance, EcoFactor identified Justin Walker in Austin, Texas as being the "Support Engineering Program Manager" for the accused product Nest who "[e]stablished Nest Support customer and agent facing messaging." *See* SAppx13–14. Google's supplemental declaration does not deny this and merely states that he was a contractor and that "[h]is contract ended on February 11, 2020." Appx349 ¶ 6. EcoFactor also identified Michael Ladner in Austin, Texas as being "Support Quality Program Manager" working as "Nest Program Manager – Support Process, Engineering, & Program Manager." SAppx17–18. Google's supplemental declaration does not deny this and merely states that "[h]e left Google on August 28, 2018." Appx349 ¶ 8.

Accordingly, the only thing Google's supplemental declaration refutes is its own assertion that "there are no witnesses with relevant information in or near WDTX." Pet. at 21.

That the district court did not expressly mention the supplemental declaration in its order does not amount to a clear abuse of discretion, particularly given that the supplemental declaration confirms there are multiple witnesses with relevant information in the Western District of Texas. Google cites no authority supporting its position that courts are required to specifically identify in writing every single piece of evidence and argument considered. Indeed, unlike the *Apple* case cited by Google, the district court addressed all identified witnesses with relevant knowledge. *See In re Apple, Inc.*, 581 F. App'x 886, 888 (Fed. Cir. 2014).

Finally, Google's assertion that the five additional employees in the Western District of Texas would not make that district "just as convenient" as the Northern District of California (Pet. at 24) also fails. As an initial matter, that is not what the district court held. Rather, the district court reasonably weighed Google's admission that there are Texas employees with knowledge about the accused products, together with the evidence provided by EcoFactor (and confirmed by Google's supplemental declaration) indicating that there are additional Texas witnesses with relevant knowledge. *Genentech*, 566 F.3d at 1343 (parties not required to show that potential witnesses have "more than relevant and material information"); *Apple I*, 818 F. App'x at 1004 (the determination of "[w]hether individuals or organizations may have relevant information" is a "fact-intensive matter[] often subject to reasonable dispute" and "entrusted to the discretion of the district court").

Further, Google's generic reference to Nest's 1,500 employees in Northern California should be given no weight. The district court was only required to consider those witnesses specifically identified by the parties. *See HP*, 826 F. App'x at 903 ("To be sure, it is reasonable to reject vague and unsupported statements regarding the location of potential witnesses or sources of proof."). And in any event, there is a nearly equal amount of Google employees (1,443) in Austin, Texas. Appx154. The district court reasonably concluded that on balance, this factor is neutral. Appx10.

4. The District Court Properly Considered The Other Related Cases Pending Before It And Reasonably Determined That This Factor Strongly Weighs Against Transfer

This Court has held that "the existence of multiple lawsuits involving the same issues is a ***paramount consideration*** when determining whether a transfer is in the interest of justice." *In re Volkswagen of Am., Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009). "[T]o permit a situation in which two cases involving precisely the same issues are simultaneously pending in different District Courts leads to the wastefulness of time, energy and money that § 1404(a) was designed to prevent." *Id.* (quoting *Cont'l Grain Co. v. The FBL-585*, 364 U.S. 19, 26 (1960)); *see also In re Google Inc.*, 412 Fed. Appx. 295, 296 (Fed. Cir. 2011) ("Courts have consistently held that judicial economy plays a paramount role in trying to maintain an orderly,

effective, administration of justice and having one trial court decide all of these claims clearly furthers that objective.").

Consistent with this precedent, the district court properly weighed EcoFactor's other lawsuits pending in the Western District of Texas involving the same patents, recognizing that such cases will "involve overlapping issues, such as claim construction, invalidity, prior art, conception, and reduction to practice." Appx10. The district court thus reasonably concluded that, in light of this "paramount consideration," this factor strongly weighs against transfer. *See In re Canrig Drilling Tech., Ltd.*, No. 2015-139, 2015 WL 10936672, at *1 (Fed. Cir. Aug. 7, 2015) ("This court has repeatedly noted that judicial economy may play a prominent role in a district court's transfer analysis."; finding no abuse of discretion in denial of transfer and denying mandamus where three complaints filed on the same day alleged infringement of the same patent); *Apple I*, 818 F. App'x at 1002 (denying mandamus where the district court weighed against transfer a pending suit in the same district concerning the same patents).

Contrary to Google's assertions, the district court's decision was not based merely on the co-pendency of related suits or on the adoption of a purported automatic rule favoring the non-movant in such suits, in conflict with *In re Google*

Inc., No. 2017-107, 2017 WL 977038, at *2 (Fed. Cir. Feb. 23, 2017).[4] Rather, the district court fully evaluated the merits of each transfer motion, and separately considered *all* of the relevant factors for *each* defendant—not merely the other practical considerations factor—in concluding that transfer was not warranted for any of the defendants.

Moreover, the portion of *Google* relied on in the Petition (Pet. at 2 & 25) is now inapposite anyway because the transfer motions filed in the co-pending cases are no longer "pending." The district court properly denied transfer motions filed by ecobee and Vivint. Even if motions of ecobee and Vivint were still pending (contrary to fact), they should not be entitled to any weight, as neither ecobee nor Vivint are based in California, and they could not identify any relevant witness knowledgeable about the accused products in California.[5]

[4] If there were an "automatic rule" (and there is not), automatically discounting the practical considerations factor just because multiple defendants move to transfer would be "equally problematic." *Id.* at *4 (Linn, J., dissenting).

[5] *See EcoFactor, Inc. v. Ecobee, Inc.*, No. 6:20-cv-00078-ADA, ECF No. 57 (W.D. Tex. Apr. 16, 2021) (denying transfer motion by ecobee—a Canadian company based in Toronto—based on a full analysis of the relevant factors, and noting, among other reasons, ecobee's failure to disclose where its relevant evidence is located and to "identify where any of its witnesses with relevant knowledge or material information are located"); *EcoFactor, Inc. v. Vivint, Inc.*, No. 6:20-cv-00080-ADA, ECF No. 55 (W.D. Tex. Apr. 16, 2021) (denying transfer motion by Vivint—a Utah corporation with its principal place of business in Utah—based on a full analysis of the relevant factors, and noting, among other reasons, Vivint's failure to "identify a single witness who lives in or near California, much less the NDCA").

In sum, the district court's conclusion that this factor weighs against transfer was reasonable, and certainly did not amount to a clear abuse of discretion. And even if the district court had determined this factor to be neutral, as Google argues it should have (Pet. at 26), this still would not demonstrate a ***clear and indisputable*** right to transfer the case to the Northern District of California.

5. Given Google's Admission That This Case Would Proceed To Trial Faster In The Western District Of Texas, The District Court Reasonably Determined That The Administrative Difficulties Flowing From Court Congestion Strongly Weighs Against Transfer

The district court correctly recognized that the "relevant inquiry under this factor is actually '[t]he speed with which a case can come to trial and be resolved[.]'" Appx11 (quoting *Genentech*, 566 F.3d at 1347). In light of Google's admission that the "[Western District of Texas]'s default schedule would lead to a trial date sooner than the average time to trial in NDCA," the district court reasonably determined that this factor weighs heavily against transfer. Appx11.

Unable to escape this admission, Google tries to downplay this factor as "speculative" and the "least important." Pet. at 29. But several decisions from this Court make clear that court congestion is a legitimate consideration in denying transfer. *See, e.g.*, *Apple I*, 818 F. App'x at 1002 (denying mandamus where the district court weighed against transfer a shorter time to trial as compared to the Northern District of California); *Western Digital*, 2021 WL 1853373 at *1 (same);

True Chem., 841 F. App'x at 241 (same). Plus, there is no need to rely on purportedly "speculative" statistics to determine which district will get this case to trial faster, as the district court has set trial for December 6, 2021—less than 7 months away.[6] Appx 19. Google's petition simply ignores this fact.

Google's reliance on statistics indicating that the Northern District of California has "substantially fewer patent cases" than the Western District of Texas is also misplaced. Pet. at 30. Under this Court's precedent, what matters is time to trial, not the number of patent cases. *See Genentech*, 566 F.3d at 1347.

Google's various arguments that the district court erred in considering certain facts related to the COVID-19 pandemic simply because they occurred after the filing of its transfer motion (Pet. at 30–31) also fail. In considering Google's argument that the "COVID-19 pandemic makes trial schedules even more speculative" (Appx11), the district court explained that the Western District of Texas has "demonstrated its capability of conducing in-person jury trials in a safe and efficient manner in the COVID-19 pandemic," whereas the Northern District of California had suspended all jury trials into 2021. Appx11. Google's position that the district court was not allowed to consider these undisputed facts ***in responding to Google's own argument about the pandemic*** is illogical.

[6] The parties have jointly moved to continue the trial to January 2022—still only 8 months away.

In any event, it is clear from the district court's order that the primary basis for its determination under this factor was Google's admission that the case would proceed to trial faster in the Western District of Texas—that is what matters. *See id.* Whether the Northern District of California has since resumed jury trials is irrelevant in light of this admission and the current trial date. There is no material dispute that this case would be at trial sooner in the Western District of Texas than in the Northern District of California. Google has thus failed to establish a clear and indisputable right to relief under this factor.

6. The District Court Reasonably Determined That Both Districts Have A Significant Interest In This Case And That This Factor Is Therefore Neutral

In evaluating this factor, the district court balanced Google's "substantial presence in Austin," Texas (dating back 14 years, including over 1,400 employees, and plans to expand its Texas presence even further) against Google's contacts with the Northern District of California. Appx12. That was proper. While general contacts with a forum may be given less weight, as found by the district court, several of Google's Texas employees have relevant knowledge regarding the accused products. Appx9. Google's "supplemental declaration" confirmed this fact, as explained above.

Moreover, while the accused products might not have been developed in Texas, there is no dispute that the accused products are marketed and sold throughout

Texas and the Western District. In light of these facts, the district court reasonably determined that "both districts have a significant interest in this case," and that this factor is therefore neutral. Appx12; *see Western Digital*, 2021 WL 1853373, at *1 (denying mandamus where the district court found that the Western District of Texas had a local interest in the case based on the movant's offices in the district). The Court should not reweigh the evidence to conclude otherwise. *See Apple I,* 818 F. App'x at 1002 ("Whether a certain forum has a localized connection to the relevant conduct and activities in a case" is a "fact-intensive matter[] often subject to reasonable dispute," and thus the district court's determinations are entitled to "substantial deference").

D. EcoFactor's Agreements With Third Parties Are Irrelevant

Google's assertion that "EcoFactor has previously indicated that it prefers to litigate in NDCA" (Pet. at 7) is without merit. As an initial matter, Google did not make this argument in the proceeding below, the point is waived, and it is improper to raise it for the first time in a petition for writ of mandamus. In any event, Google's assertion is based solely on two agreements that have nothing to do with this case—they were agreements, not lawsuits, and they were the result of specific negotiations between the contracting parties based on the facts and circumstances relevant to each agreement. *See id.* (citing Appx224, Appx244). And even if the agreements were somehow equivalent to lawsuits (they are not), that still would not be enough to

indicate a purported "preference" for a forum. *See SK hynix*, 2021 WL 733390, at *5 (rejecting argument that a plaintiff's conduct regarding other actions, including the filing of lawsuits in the proposed transferee forum, established an inference of consent to litigate in that forum). Indeed, EcoFactor has never filed a lawsuit in the Northern District of California, directly undermining Google's theory. Regardless, even if the two agreements could somehow establish a general preference to litigate in a particular district, that would be irrelevant to the issue here—whether it would be clearly more convenient for the parties to litigate *this particular case* in that district. *Id.* The agreements are legally and logically irrelevant.

CONCLUSION

As set forth above, Google has failed to meet its heavy burden to warrant mandamus. While Google may have weighed the factors differently, "the mandamus standard does not give [the Court] license to substitute [its] own judgment for that of a district court." *Google*, 2017 WL 977038, at *3. To the contrary, where, as here, the district court meaningfully considered and balanced all of the relevant transfer factors, its decision is "entitled to substantial deference." *Apple I,* 818 F. App'x at 1004. Google's petition should be denied.

May 21, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on May 21, 2021, I electronically filed the foregoing with the Clerk of the Court of the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system and all parties are represented by attorneys registered with that system.

In addition, a copy will be sent by first class mail to the following United States District Judge: Hon. Alan D. Albright, U.S. District Judge, U.S. District Court for the Western District of Texas, 800 Franklin Avenue, Room 301, Waco, Texas 76701.

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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(g), the undersigned hereby certifies that this response complies with the type-volume limitation of Federal Rule of Appellate Procedure 21(d)(1) and Federal Circuit Rule 32(a).

This response contains 7,760 words, excluding the parts exempted under Federal Rule of Appellate Procedure 21(a)(2)(C), Federal Rule of Appellate Procedure 32(f), and Federal Circuit Rule 32(b).

This response complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word in 14-point Times New Roman font.

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