2022-140, -141, -142

United States Court of Appeals

for the

Federal Circuit

In re: GOOGLE LLC,
Petitioner

2022-140

On Petition for Writ of Mandamus to the United States District Court
For the Eastern District of Texas in No. 2:19-cv-00361-JRG,
Chief Judge J. Rodney Gilstrap

In re: WAZE MOBILE LIMITED,
Petitioner

2022-141

On Petition for Writ of Mandamus to the United States District Court
For the Eastern District of Texas in Nos. 2:19-cv-00359-JRG
Chief Judge J. Rodney Gilstrap

In, re: SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners

2022-142

On Petition for Writ of Mandamus to the United States District Court
for the Eastern District of Texas in
Nos. 2:19-cv-00359-JRG, Chief Judge J. Rodney Gilstrap

CORRECTED RESPONDENT AGIS SOFTWARE DEVELOPMENT LLC'S COMBINED PETITION FOR REHEARING AND REHEARING *EN BANC*

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June 7, 2022

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CERTIFICATE OF INTEREST

Counsel for AGIS Software Development LLC certifies the following:

1. Provide the full names of all entities represented by undersigned counsel in this case:

AGIS Software Development LLC

2. 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:

AGIS Software Development LLC

3. Provide the full names of all parent corporations for the entities and all publicly held companies that own 10 percent or more of the stock in the entities:

AGIS Holdings, Inc.

4. List the names of 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):

McKOOL SMITH, P.C., 104 East Houston Street, Suite 300, Marshall, Texas 75670: Samuel F. Baxter and Jennifer M. Truelove

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FABRICANT LLP, 411 Theodore Fremd Avenue, Suite 206 South, Rye, New York 10580: Jacob Ostling and Amy Park

5. 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).

***AGIS Software Development LLC v. Google LLC*, Case No. 2:19-cv-00361-JRG (E.D. Tex.)**

***AGIS Software Development LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 2:19-cv-00362-JRG (E.D. Tex.)**

***AGIS Software Development LLC v. Waze Mobile Limited*, Case No. 2:19-cv-00359-JRG (E.D. Tex.)**

6. 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

Dated: June 7, 2022

By: */s/ Alfred R. Fabricant*
Alfred R. Fabricant
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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the Panel decision is contrary to at least the following decisions of this Court: *In re LG Elecs. Inc.*, No. 2019-107, Dkt. 14 (Fed. Cir. 2018); *In re Apple Inc.*, No. 2018-151, Dkt. 20 (Fed. Cir. 2018); *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021); *In re Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008); *In re Volkswagen AG*, 371 F.3d 201 (Fed. Cir. 2004).

Pursuant to Rule 40 of the Federal Rules of Appellate Procedure and this Court's rules, the following points of law or fact were misapplied by the Panel's order: (1) the Panel incorrectly applied the "center of gravity" factor rather than the binding Fifth Circuit private and public factors under *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004).

Dated: June 7, 2022

By: */s/ Alfred R. Fabricant*
Alfred R. Fabricant
Fabricant LLP

I. INTRODUCTION

The district court appropriately denied Petitioner Waze Mobile Limited's ("Waze") motion to transfer from the Eastern District of Texas, where Waze is an Israeli company**,** whose products were developed in Israel. Respondent AGIS Software Development LLC ("AGIS") is a Texas limited liability company**,** organized and existing in Texas years prior to filing suit against Waze, with its office and data center in the Eastern District of Texas. The Panel erred in its determination that the *Waze* case should be transferred because the "center of gravity" is in the Northern District of California. In reaching this conclusion, the Panel misapplied the law by using the "center of gravity" rather than the binding Fifth Circuit *Volkswagen* factors.

AGIS respectfully asks this Panel to reconsider its ruling in light of the clarifications provided. By granting mandamus and ordering transfer with less than two weeks until the commencement of a Jury trial on June 6, 2022, the Panel essentially denied the 83-year-old inventor, Mr. Malcolm K. Beyer, Jr., his day in court. However, under the proper *Volkswagen* analysis, the Panel would have found that AGIS's physical presence in Texas is longstanding and entitled to weight, whereas Waze's presence in Israel does not merit transfer to the Northern District of California under either the public or private interest factors—this is not the type of extraordinary relief required for mandamus.

In the alternative, AGIS seeks review by the *en banc* Court. Different panels of this Court declined to grant mandamus petitions requesting transfer of AGIS's cases to the Northern District of California where the district court correctly applied the *Volkswagen* factors in its 28 U.S.C. § 1404(a) analysis.

II. BACKGROUND

AGIS is a Texas limited liability company formed two years prior to the initiation of this lawsuit, with its principal place of business in Marshall, Texas. Appx240; Op. at 17. AGIS's documents, including the patents, file histories, assignment records, prosecution records, formation documents, licenses, agreements, corporate records, and documents related to its data center are physically located in the Eastern District of Texas and AGIS does not maintain any documents in the Northern District of California. Op. at 17. AGIS's data center, which houses servers practicing the claims of the Asserted Patents and which are necessary to provide the services to Ukraine for the AGIS, Inc. LifeRing product, are also located in and maintained from the Eastern District of Texas. Op. at 17. AGIS filed suit against Waze in the Marshall Division of the Eastern District of Texas, asserting two patents related to location-sharing and communication technology used in Waze's products, such as the Waze and Waze Carpool applications.

Waze is an Israeli company with offices in Tel Aviv, Israel. Appx220. Waze's accused technology was researched, designed, and developed in Israel. Waze's only technical witness, knowledgeable about the accused technology, Mr. Yuval Shmuelevitz, is located in Israel. Appx367. As such, most of the electronic records and paper documents concerning the accused technology reside in Israel. Appx225.

Waze sought transfer to the Northern District of California under 28 U.S.C. § 1404. Order at 4. The district court denied transfer. *Id.* The district court's decision was based on analysis of the *Volkswagen* factors, the well-established precedent of the Fifth Circuit.

A panel of this Court granted Waze's petition and directed transfer. Order at 11. In its Order, the Panel stated that "the 'center of gravity' is in Northern California," contrary to Fifth Circuit precedent. *Id.*; *see infra* Section III. AGIS seeks rehearing on this ground.

III. ARGUMENT

A. The Panel Should Rehear the Case to Correct its Misapplication of Fact and Law

The Panel's Order suggests that it erred in misapplication of binding Fifth Circuit precedent. The Panel should grant rehearing to reconsider its Order in view of the correct understanding of the facts and law. *See* Fed. R. App. P. 40(a)(2).

Under the proper *Volkswagen* analysis, the Panel should have found that AGIS's longstanding physical presence in Texas is entitled to considerable weight. While the Panel stated that it followed regional circuit law on transfer motions under 28 U.S.C. § 1404(a), in applying the "center of gravity" factor, it did not appropriately apply the *Volkswagen* factors.

AGIS's CEO, Malcolm K. Beyer, Jr., has longstanding ties to the Eastern District of Texas. Mr. Beyer has 2,000 acres of land in Bowie Country for the better part of the last century—well before Google LLC or Waze even existed. AGIS's genesis began from a collaboration between Mr. Beyer and Mr. Sandel Blackwell during their tenure at Mr. Beyer's former company, Advanced Programming Concepts ("APC"), which was based in Austin, Texas throughout the 1990s. After leaving APC and forming AGIS, Inc., Mr. Beyer maintained AGIS, Inc.'s business connections to Texas and held an office in Austin, Texas, where AGIS's contract work was negotiated and performed. At that time, AGIS, Inc. also had an office in Lenexa, Kansas, where numerous employees resided. This is in addition to AGIS, Inc.'s Jupiter, Florida office and presence. In 2016, AGIS, Inc. consolidated aspects of its business and opened a more centrally located office in Marshall, Texas (located conveniently between its Austin and Lenexa offices). AGIS regularly conducted business meetings out of Marshall and moved its server farm to a Marshall facility in 2018. This server farm currently supplies AGIS, Inc.'s patented software and

services to Ukraine, in its efforts to combat the Russian incursion. Waze has challenged the validity of AGIS's patents, which protect these products, and which are served from the Eastern District of Texas.

Contrary to the Panel's decision, AGIS's presence in the Eastern District of Texas should be entitled to substantial weight. Order at 8 ("AGIS therefore has no presence in Texas that should be given significant weight in this analysis."). AGIS has maintained its offices in the Eastern District of Texas since 2017. The Panel incorrectly determined that "the relationship between the forum and AGIS and its materials served no meaningful purpose," where AGIS's offices store documents relevant to this litigation, including patent-related documents and corporate records, and where AGIS's Marshall data center (which is a separate facility) hosts servers which keep and maintain documentation and source code relevant to the operation of AGIS LifeRing solutions (which Waze alleged to be prior art in its invalidity contentions and which AGIS alleged to be a practicing product). *Id.*

The Panel's decision is contrary to prior Federal Circuit decisions denying mandamus. In *LG Elecs., Inc.*, the Federal Circuit denied LG Electronics, Inc.'s petition for mandamus on its motion for transfer, stating that it "cannot say that a denial of transfer under these circumstances was such an abuse," "[t]he case also was assigned to the same district judge who is overseeing another action filed by AGIS involving the same patents, suggesting that the court system as a whole could

benefit from adjudicating this case in plaintiff's chosen forum," and did not give weight to LG Electronics, Inc.'s argument that "AGIS's principals were conducting business and enforcing these patents largely from Florida under a related corporate entity just weeks before incorporating in Texas and commencing this infringement suit, doing so only in hopes of a favorable venue." *In re LG Elecs., Inc.*, No. 2019-107, Dkt. 20 at 2-4 (Fed. Cir. 2019). Similarly, in *Apple*, Apple Inc. made the argument that "AGIS Software's connections to the Eastern District of Texas should be disregarded, given it only registered to do business and rented office space a month before filing this suit. *In re Apple Inc.*, No. 2018-151, Dkt. 20 at 4. However, the Federal Circuit denied Apple's petition and held that no clear abuse of discretion occurred in denying Apple's motion to transfer to the Northern District of California. *Id.*

In contrast, Waze is an Israeli company whose accused technologies were developed in Israel, not the Northern District of California. Appx220. The district court correctly held that the private interest factors, including the cost of attendance of willing witnesses, do not favor transfer. Appx13-17. While Waze identified a single witness available in the Northern District of California, Waze's primary and only technical witness, Mr. Yuval Shmuelevitz, is located in Israel, and AGIS had to secure his deposition through the Israeli Administration of Courts and conducted his remote deposition via video teleconference through the Israeli Administration of

Courts. Appx367. In addition, Waze conceded that its documents and sources of proof were created and maintained in locations outside of the Northern District of California, including Israel and New York. Appx13-14.

The district court also correctly held that other practical problems strongly disfavor transfer, where judicial economy strongly disfavored transfer. Appx16-17. The district court has extensive experience with the plaintiff, the asserted patents, and the underlying technology, in addition to claim construction. Appx17. Further, the district court held that Waze's argument that "the potential transfer of the Samsung and Google cases" does not weigh in favor of transfer and it would be "equally unfair and improper for the Court to weigh this factor in favor of transfer by assuming the same motions will be granted." Appx18. The Panel improperly held that judicial economy supports transfer "given our decision that overlapping cases against Google and Samsung are to be transferred." Order at 11. The Panel failed to consider that the products at issue in the Waze case are completely different from the products at issue in the Google case. Specifically, there is no overlap between the products accused against Google and Samsung, and Waze. Order at 3-4. Whether the Samsung and Google cases are to be transferred should not shift the district court's analysis of the judicial economy factor in favor of transfer.

The district court also correctly found that the local interest in having localized interests decided at home also does not favor transfer where "Waze is not located in

the NDCA." Appx18. The district court also stated that "while Waze is a subsidiary of Google, Google is not a party to this case." Appx19. While Waze attempted to argue the transfer of the Google case warrants transfer of its own case, as the district court correctly found, Waze has not identified the relevance of third-party Google to the Waze case. Other than now being owned by Google, Waze has no connection to the Northern District of California. Waze did not identify any documents that were accessible only from the Northern District of California, and its primary technical witness who possesses knowledge and information regarding the accused Waze products is not located in the Northern District of California, but rather is located in Israel. Indeed, a foreign company whose documents and witnesses are located in Israel, cannot necessitate a mandamus of transfer.

Under Fifth Circuit precedent, the appropriate inquiry is whether the "locus of the events that gave rise to the dispute" is the relevant inquiry. *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021) ("The problem with the court's analysis is that it relies on Google's general presence in the judicial forum, not on the locus of the events that gave rise to the dispute."). Here, the events that gave rise to the dispute occurred either in Texas or outside of the Northern District of California, such as in Israel. None of the relevant events transpired in California, and thus, transfer here is improper.

The Accused Products and damages models in the Google, Samsung, and Waze cases are substantively different. The Google and Samsung cases involve devices, such as smartphones and tablets, and applications. In contrast, the Waze case involves the Waze and Waze Carpool applications which are not at issue in the Google or Samsung cases which involve Google and Samsung applications and devices. Accordingly, judicial economy does not favor trying the cases together where the accused products and damages models differ.

In granting mandamus and transferring the Waze case, the Panel erred in applying the "center of gravity" factor rather than the precedential *Volkswagen* factors, which amounted to a clear abuse of discretion which significantly deviates from this Court's precedent. The misapplication of the law and facts by the Panel undoubtedly affected the outcome of this case, and rehearing is warranted.

B. The Court Should Rehear the Case *En Banc* Because the Panel's Decision is Inconsistent with the Federal Circuit's Prior Decisions

If the Panel declines to reconsider its ruling in view of the misapplication of the facts and law discussed above, then this Court should grant rehearing *en banc* to address the Panel's decision which is inconsistent with the Federal Circuit's prior decisions regarding § 1404(a) transfer cases.

The Panel's decision applies the "center of gravity" analysis that has no place in the Fifth Circuit's *Volkswagen* analysis to be applied in § 1404(a) transfer cases.

In other cases, this Court has not incorrectly applied the "center of gravity" analysis. The application of "center of gravity" is not only erroneous, but outcome determinative. The Panel's ruling here is a clear legal error, and to permit other panels of this Court to apply this analysis would result in inconsistent and erroneous rulings.

The Panel's decision to depart from the Fifth Circuit's standards and analysis led to clear error. It is critical that litigants and district courts have a clear understanding of the standards governing § 1404(a) transfer in the Fifth Circuit. When panels of this Court reach different results in very similar circumstances—as was done here—it undermines the predictability and results in increased costs to litigants in attempts to determine how to proceed, both at the district court and before this Court. *See Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1149 (Fed. Cir. 2011) ("Discretion is not whim, and limiting discretion according to legal standards helps promote the basic principle of justice that like cases should be decided alike." (quoting *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006)). If the Panel does not correct its deviations from prior rulings, the *en banc* Court should grant rehearing to provide a uniform view of how this Court will address the analysis of § 1404(a) transfer cases in applying the Fifth Circuit *Volkswagen* factors.

IV. CONCLUSION

The Court should grant rehearing, either for the Panel to reconsider the points it misapplied, or for the *en banc* Court.

Dated: June 7, 2022

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I certify that RESPONDENT'S COMBINED PETITION FOR REHEARING AND REHEARING *EN BANC* complies with the type-volume limitation of Fed. R. App. P. 21(d). The Brief contains 2,523 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f). This Brief 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). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in 14-point Times New Roman font.

Dated: June 7, 2022

Respectfully submitted,

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CERTIFICATE OF SERVICE

In accordance with Fed. R. App. P. 25 and Fed. Cir. R. 25, I certify that I caused the foregoing brief to be filed with the Court electronically using the CM/ECF system, which will send a notification to all counsel of record.

Dated: June 7, 2022

Respectfully submitted,

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ADDENDUM

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: GOOGLE LLC,
Petitioner

2022-140

On Petition for Writ of Mandamus to the United States District Court for the Eastern District of Texas in No. 2:19-cv-00361-JRG, Chief Judge J. Rodney Gilstrap.

In re: WAZE MOBILE LIMITED,
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2022-141

On Petition for Writ of Mandamus to the United States District Court for the Eastern District of Texas in No. 2:19-cv-00359-JRG, Chief Judge J. Rodney Gilstrap.

In re: SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners

2022-142

On Petition for Writ of Mandamus to the United States District Court for the Eastern District of Texas in No. 2:19-cv-00362-JRG, Chief Judge J. Rodney Gilstrap.

ON PETITION

Before LOURIE, TARANTO, and HUGHES, *Circuit Judges*.

LOURIE, *Circuit Judge*.

O R D E R

In these consolidated cases, Google LLC, Waze Mobile Limited, and Samsung Electronics Co., Ltd. et al. (collectively, "Petitioners") seek writs of mandamus directing the United States District Court for the Eastern District of Texas to transfer these cases to the United States District Court for the Northern District of California. AGIS Software Development, LLC ("AGIS") opposes. For the reasons below, we grant the petitions and direct transfer.

I

A

AGIS is a subsidiary of Florida-based AGIS Holdings, Inc. AGIS was assigned AGIS Holdings' patent portfolio and incorporated in the state of Texas shortly before AGIS started to file infringement suits in the Eastern District of Texas in 2017. AGIS shares an office in Marshall, Texas with another subsidiary of AGIS Holdings where AGIS maintains copies of its patents, assignment records, prosecution records, license agreements, and corporate records. No employee of AGIS or a related AGIS entity works regularly from that location.

In the complaints underlying Appeal Nos. 2022-140 and 2022-142, AGIS has accused: (1) Google's software applications that enable users of its products to form groups, view the locations of other users on a map, and communicate together, of infringing U.S. Patents 8,213,970; 9,408,055; 9,445,251; 9,467,838; 9,749,829 ("the '829 patent"); and 9,820,123 ("the '123 patent"); and (2) Samsung of infringing the '829 and '123 patents for selling devices that run Google's accused applications and that use Samsung's messaging functionality in conjunction with those applications.

Google and Samsung moved under 28 U.S.C. § 1404(a) to transfer AGIS's infringement actions to the Northern District of California. They argued that the accused software applications at the center of the cases were designed and developed at Google's headquarters within the Northern District of California; that potential witnesses and sources of proof were in the Northern District of California (including Google's source code and technical documents, Google's employees that were knowledgeable of the accused products, and prior art witnesses); and that, as a matter of judicial economy, the cases should be transferred together to be decided by the same trial judge.

The district court denied the motions. The court noted that the Northern District of California had a comparative advantage in being able to compel unwilling witnesses. On the other hand, the court determined that court congestion, judicial economy considerations, and local interest factors all weighed against transfer. In particular, the court weighed against transfer the fact that AGIS had previously litigated the asserted patents before the same trial judge up to the pretrial conference. The remaining factors, the court determined, favored neither of the two possible forums. On balance, the court determined that Google and Samsung had each failed to demonstrate that the Northern District of California was clearly more convenient and accordingly denied transfer.

B

In the third case before us, AGIS has accused Waze (a wholly-owned subsidiary of Google) of similarly infringing the '829 and '123 patents based on the Waze Carpool mobile applications. The Waze case was actually initially consolidated with the Samsung and Google cases. Like Google and Samsung, Waze moved to transfer to the Northern District of California. Waze argued that its employees responsible for the accused applications, including its Managing Director, are in the Northern District of California (as well as Israel and New York) and that Waze does not have any offices or employees in the Eastern District of Texas. Waze also identified the same prior art witnesses as identified by Google and Samsung in Northern California. Waze added that its documents are physically present and/or electronically accessible from Northern California.

As with Samsung's and Google's motions, the district court denied Waze's transfer request. The district court found that the compulsory process factor favored transfer. But, as in the Samsung and Google cases, the court weighed against transfer its prior familiarity with AGIS's patents and that it could likely hold a trial sooner. The district court found that the remaining factors were neutral. On balance, the district court similarly found that Waze had failed to show that the Northern District of California was a clearly more convenient forum for the litigation than the Eastern District of Texas. Waze, Google, and Samsung then each filed identical petitions seeking writs of mandamus, and we consolidated the petitions for purposes of briefing and resolution.

II

A

We follow regional circuit law on transfer motions under 28 U.S.C. § 1404(a). *See In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). In deciding whether the

district court should have granted transfer under § 1404(a), we ask whether "the movant demonstrate[d] that the transferee venue is clearly more convenient" such that the district court's contrary determination was a clear abuse of discretion. *In re Radmax, Ltd.*, 720 F.3d 285, 288 (5th Cir. 2013) (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) (internal quotation marks omitted)).

The Fifth Circuit has identified private and public interest factors relevant to determining whether a case should be transferred under § 1404(a). The public interest factors are: (1) the administrative difficulties flowing from court congestion; (2) the local interest in having disputes regarding activities occurring principally within a particular district decided in that forum; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws or in the application of foreign law. *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1317 (Fed. Cir. 2021). The private interest factors are: (1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of non-party witnesses whose attendance may need to be compelled by court order; (3) the relative convenience of the two forums for potential witnesses; and (4) all other practical problems that make the trial of a case easy, expeditious, and inexpensive. *Id.* at 1316–17.

Mindful that the district court is generally better positioned to evaluate the evidence, we review a transfer ruling for a clear abuse of discretion. *See In re Vistaprint Ltd.*, 628 F.3d 1342, 1344–46 (Fed. Cir. 2010); *TS Tech*, 551 F.3d at 1319 (noting that a petitioner must demonstrate that the denial was a "clear" abuse of discretion such that refusing transfer produced a "patently erroneous result" (quoting *Volkswagen*, 545 F.3d at 310 (internal quotation marks omitted)); *see also Juniper*, 14 F.4th at 1318 (explaining that "when a district court's denial of a motion to transfer amounts to a clear abuse of discretion under governing

legal standards, we have issued mandamus to overturn the denial of transfer" and collecting cases granting mandamus).

Petitioners argue that the district court's failure to find that the convenience factors strongly favor transfer in all three cases was a clear abuse of discretion. They contend that Northern California is far more easily accessible for potential witnesses and sources of proof. Petitioners also contend that the transferee venue has a strong local interest in these cases while the Eastern District has no cognizable interest. In this regard, Petitioners emphasize that AGIS's connections to the Eastern District are entitled to minimal consideration because they are litigation-driven. Petitioners further contend that any judicial economy considerations that favor keeping these cases in a district in which AGIS previously litigated its patents are insufficient to outweigh the clear convenience of the transferee forum.

AGIS responds that the district court correctly denied transfer in all three cases. AGIS argues that its own witnesses either reside in, or would prefer to travel to, the Eastern District of Texas. AGIS further contends that the Eastern District is more convenient for accessing AGIS's patent-related documents and license agreements stored at its offices in Marshall. AGIS further asserts that the district court was correct to not weigh the local interest factor in favor of transfer in the cases because of AGIS's connections to the Eastern District. AGIS also contends that the Eastern District has a comparative advantage both with regard to the court congestion factor and with regard to judicial economy considerations given its prior handling of AGIS's patent infringement suits.

B

We agree with Petitioners that the Northern District of California is clearly the more convenient forum in the Google and Samsung cases. Given that Google's accused functionality is at the center of the allegations in both

cases, it is not surprising that witnesses reside in Northern California—the location of Google's headquarters where the accused technology was developed. Google and Samsung each identified at least 5 Google employees in the transferee forum with relevant and material information. Samsung and Google further identified five prior art witnesses in the Northern District of California. Transfer would ensure not only that the forum would be more convenient for the balance of the witnesses, but also that a court could compel their testimony if necessary.

The district court weighed against transfer the presence of an AGIS consultant, Eric Armstrong, in the Eastern District as a potential witness on whether AGIS Holdings' own products constituted invalidating prior art.[1] But Mr. Armstrong appears to have disclaimed material knowledge of those products before the applicable priority dates. Appx547–550. And even accounting for Mr. Armstrong, Samsung and Google identified far more witnesses in Northern California. Moreover, while AGIS notes that several of its potential witnesses in Austin, Colorado, Virginia, and Florida would prefer to travel to Eastern Texas, the district court here correctly recognized that these witnesses were not entitled to significant weight because these witnesses "would require hours of travel regardless." Appx006.

We also agree with Petitioners that the sources of proof factor weighs in favor of transfer. Google explains, without dispute from AGIS, that the technical documents and source code relating to the accused functionality "are physically present and/or electronically accessible" in the Northern District of California. Appx229. The district court discounted the convenience of litigating these cases

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[1] The district court treated the presence of AGIS's expert witness in the Eastern District as entitled to little weight.

close to that evidence on the ground that Google could produce the information electronically in the Eastern District. *See, e.g.,* Appx004. But "while electronic storage of documents makes them more widely accessible than was true in the past, that does not make the sources-of-proof factor irrelevant." *Juniper*, 14 F.4th at 1321.

The district court also weighed against transfer the fact that AGIS stores its patent-related documents and corporate records at its office space in Marshall, Texas. However, it appears that the relationship between the forum and AGIS and its materials served no meaningful purpose, not even to secure application of Texas substantive law to AGIS, except to attempt to establish a presence for forum selection for patent cases. AGIS leased its office just prior to commencing litigation in the Eastern District. And the company's Texas office, where it stores the above-identified documents, does not appear to be a place of regular business; AGIS's principals and employees do not work from that office. AGIS therefore has no presence in Texas that should be given significant weight in this analysis. *See In re Verizon Bus. Network Servs. Inc.*, 635 F.3d 559, 562 (Fed. Cir. 2011) (rejecting the argument that documents that were nothing more than artifacts of litigation were entitled to weight).[2]

Turning to the public interest factors, we agree with Petitioners that the district court failed to give full weight to the Northern District of California's comparative local interest in resolving the claims against Google and Samsung. These cases are analogous to the situation in *Juniper* where the accused products were designed and developed in the transferee forum and plaintiff's only connections to the transferor forum were largely tied to

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[2] The court also pointed to potential documents from Mr. Armstrong, but that witness testified that "all documents are on AGIS, I don't have any." Appx462.

bringing patent lawsuits in that district. We explained that because the events forming the basis for the infringement claims occurred mainly in the transferee forum, it had a substantial local interest in resolving the dispute, whereas plaintiff's patent-litigation-inspired connections to its chosen forum were "not entitled to significant weight" and "insubstantial compared to" defendant's relevant connections to the transferee forum. 14 F.4th at 1320. Similarly here, the locus of events giving rise to AGIS's infringement suits occurred in the transferee forum where Google designed and developed the accused functionality. In contrast, AGIS's minimal presence, apparently tied to filing suit in the Eastern District where no AGIS employees usually work, is insufficient to establish a comparable interest in the transferor forum.[3] Thus, the court clearly abused its discretion in weighing this factor as neutral.

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[3] The district court also weighed against transfer that Samsung has "direct and substantial ties to this District," Appx029, and "Google has several ties to this District," namely, its facilities in Flower Mound, Texas where Google says certain devices are repaired by an independent company. Appx009–10. The problem with this analysis is that it relies on Google's and Samsung's "general presence in the [transferor] forum, not on the locus of the events that gave rise to the dispute." *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021). We have held that a party's "general presence" in a particular district is "not enough to establish a local interest" that weighs against another forum's local interest tied to events giving rise to the particular suit. *Juniper*, 14 F.4th at 1320; *see Google*, 2021 WL 4592280, at *5. Rather, what is required for a relevant local interest to weigh in this factor is that there be "significant connections between a particular venue and *the events that gave rise to a suit*." *In re Apple,*

As for the remaining factors, we also agree with Petitioners. While a court may consider its prior familiarity with the asserted patents in assessing judicial economy considerations for transfer, *see Vistaprint*, 628 F.3d at 1344, we have at the same time made clear that just because "a patent is litigated in a particular[forum]" does not mean "the patent owner will necessarily have a free pass to maintain all future litigation involving that patent in that [forum]," *id.* at 1347 n.3; *see also Verizon*, 635 F.3d at 562 ("To interpret § 1404(a) to hold that any prior suit involving the same patent can override a compelling showing of transfer would be inconsistent with the policies underlying § 1404(a)."). Here, any judicial economy gained in having the district court preside over this case based on its prior familiarity with some of the issues, from a prior claim construction in a different case brought by AGIS, is clearly insufficient in this case to outweigh the other factors that clearly favor transfer.

Furthermore, while the Eastern District appears likely to be able to schedule a trial in these cases faster than the Northern District of California, that seems to rest not so much on significant differences in docket congestion but, in significant part, on the considerable delay in resolving the transfer motions, which resulted in progress in the cases in the interim. That progress hardly need go to waste upon transfer. In any event, neither the district court nor AGIS has identified any reason why a more rapid disposition of the cases should be assigned such significant weight here to outweigh the clear convenience of the transferee forum.

Under these circumstances, we conclude that the district court clearly abused its discretion, leading to a patently erroneous result, when it denied Petitioners'

Inc., 979 F.3d 1332, 1345 (Fed. Cir. 2020) (citation omitted); *see Google*, 2021 WL 4592280, at *5.

motions to transfer to the clearly more convenient forum, the Northern District of California.

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We reach the same conclusion in Waze's case, in which the district court's analysis was materially the same. Like the Google and Samsung cases, the "center of gravity" is in Northern California. *Juniper*, 14 F.4th at 1323. Waze identified more witnesses in the Northern District of California who would be less inconvenienced by a trial in that district and/or could be compelled to testify there. The district court also recognized that Waze had identified sources of proof in the Northern District of California but made the same error, described above, in discounting that convenience on the ground that the information could potentially be made electronically accessible in the Eastern District. Judicial economy considerations also do not override the clear convenience of the transferee venue in this case; indeed, they support transfer given our decision that overlapping cases against Google and Samsung are to be transferred. And Petitioners persuasively argue that economy favors all three of these cases being decided together.

Accordingly,

IT IS ORDERED THAT:

The petitions are granted. The district court's orders denying transfer are vacated, and the district court is directed to grant Google's, Waze's, and Samsung's motions to transfer to the Northern District of California.

FOR THE COURT

May 23, 2022
Date

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