RECENT DEVELOPMENTS IN PATENT LAW (Fall 2022)

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PRACTICE AND PROCEDURE

Personal Jurisdiction

Apple Inc. v. Zipit Wireless, Inc., 30 F. 4th 1368 (Fed. Cir. Apr. 18, 2022)

In this appeal from the Northern District of California, the Federal Circuit reversed a dismissal of a declaratory judgment action for lack of personal jurisdiction.[3] Zipit, a Delaware corporation located in South Carolina, communicated with Apple over some wireless instant messaging patents. They met at Apple's headquarters in Cupertino (in the Northern District), and exchanged several rounds of correspondence.[4] Negotiations failed, and four years later Zipit sued Apple in the Northern District of Georgia.[5] It's not entirely clear why, but Zipit voluntarily dismissed the case without prejudice two weeks later. Apple then filed a declaratory judgement action in the Northern District of California.[6] The district court dismissed for lack of personal jurisdiction, holding that while there were sufficient minimum contacts, and the jurisdiction would not be unreasonable, it saw the Federal Circuit's opinion in *Breckenridge Pharm. v. Metabolite Labs* as establishing a bright-line rule that when contacts were in the form of a demand letter, they were insufficient to establish personal jurisdiction.[7]

The Federal Circuit reversed and held that minimum contacts were satisfied via the notice letters directed to California.[8] The Court favorably cited *Xilinx*, where two notice letters and travelling to the forum state to discuss allegations of infringement were sufficient to establish minimum contacts, and distinguished *Autogenomics*, where a notice letter and flying to the forum state to discuss allegations of infringement were insufficient to establish minimum contacts.[9] The factual distinctions from *Autogenomics*

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[3] Apple Inc. v. Zipit Wireless, Inc., 30 F. 4th 1368 (Fed. Cir. 2022)
[4] *Id.* at 1375.
[5] *Id.* at 1373.
[6] *Id.*
[7] *Id.* at 1374.
[8] *Id.* at 1376.
[9] *Id.*

included that Zipit kept Apple apprised of the status of IPRs, and that it escalated threats of infringement as willful, but more importantly held that the totality of the precedent argued that cease and desist letters alone can provide minimum contacts.[10]

After finding minimum contacts, the Court held that exercising jurisdiction was not unreasonable, noting there is no bright-line rule that demand letters cannot create specific jurisdiction.[11] While there is a policy consideration to encourage settlement by allowing patentees to not subject themselves to a wide variety of jurisdictions by merely sending demand letters, that is but one factor to consider under *Burger King*.[12] Applying those other factors, the burden on Zipit of litigating in California was inconvenient, but not unconstitutionally so, given that Zipit was able to travel to California to discuss infringement earlier.[13] The Court also held California has defined interests in protecting its companies and advancing science, and that Apple had an interest in convenient relief.[14] The fourth factor, the judicial system's interest in efficient resolution of controversies, is where the settlement-promoting factor arises, and weighed for Zipit.[15] Lastly, there was no conflict between states.[16] In total, California's and Apple's interests were sufficient for jurisdiction to not be unreasonable, irrespective of the settlement-promoting rationale and the burden on Zipit.[17]

Venue and Transfer

***In re: Volkswagen Group of America*, 28 F.4th 1023 (Fed. Cir. Mar. 9, 2022)**

The Federal Circuit granted Volkswagen's and Hyundai's writs of mandamus to dismiss or transfer for lack of venue in the Western District of Texas.[18] The district court had found proper venue by finding that independent car dealerships in the Western District gave petitioners sufficient control to establish a regular and established place of business despite a Texas law prohibiting auto manufacturers from directly operating or controlling a dealership, as the dealerships were agents of the manufacturers.[19]

The Federal Circuit reversed, holding that Stratos failed to demonstrate the dealerships were agents.[20] First, the court noted that there is a distinction between interim control that evidences agency (e.g. step by step directions for maintenance and

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[10] *Id.* at 1376, n. 3.
[11] *Id.* at 1378.
[12] *Id.*
[13] *Id.* at 1379-80.
[14] *Id.* at 1380.
[15] *Id.* at 1380-81.
[16] *Id.* at 1381.
[17] *Id.*
[18] In re: Volkswagen Group of America, 28 F.4th 1023 (Fed. Cir. 2022)
[19] *Id.* at 1206.
[20] *Id.* at 1205.

installation), and control that provides constraints and standards.[21] Second, agency in one aspect of activity does not create an agency relationship for all purposes.[22] The Federal Circuit held that the manufacturers lacked interim control over car sales or warranty work, as once the cars leave their possession they have no authority over the manner in, or price for, cars are sold.[23] While there are constraints of displaying the logo, providing sales reports, and keeping minimum inventory, these didn't rise to the level of control creating an agency relationship.[24] The Court also noted the parties themselves, in their franchise agreements, disclaimed an agency relationship, and cited to other circuits agreeing that dealerships are not agents.[25] As such, the Court held that the Western District's declining to dismiss or transfer based on these dealerships was an abuse of discretion.[26]

***In re Monolithic Power Sys., Inc.*, 50 F.4th 157 (Fed. Cir. Sept. 30, 2022)**

The Federal Circuit denied a petition for a writ of mandamus to transfer the case from the Western District of Texas to the Northern District of California.[27] The district court had found venue proper due to Monolithic's hiring of employees to service Austin clients, the living of several employees in the district, and its giving of lab equipment and products to employees in the district.[28] It then rejected transfer.[29]

The Federal Circuit refused to grant a writ of mandamus, holding that the district court's venue ruling did not implicate a basic unsettled legal issue or require immediate intervention.[30] While Monolithic argued that the question of using the residences of employees to determine venue was becoming more relevant due to the rise of remote work, the Court did not believe that question was broad enough on this set of facts—the shipping of highly technical equipment to employees in the district was enough in this case to make it idiosyncratic and not fit for the creation of a broad rule.[31] On the transfer motion, the Court held that there was not a clear abuse of discretion—the district court had weighed the proper factors, and given that the events underlying the suit largely took place outside either the N.D. Cal. or the W.D. Tex., there was little reason to disturb the district court's findings.[32]

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[21] *Id.* at 1209.
[22] *Id.* at 1210.
[23] *Id.* at 1211.
[24] *Id.*
[25] *Id.* at 1212-14.
[26] *Id.* at 1214.
[27] In re Monolithic Power Sys., Inc., 50 F.4th 157 (Fed. Cir. 2022).
[28] *Id.* at 159.
[29] *Id.*
[30] *Id.* at 159-60.
[31] *Id.* at 160-61.
[32] *Id.* at 161.

***In re Apple Inc.*, 52 F.4th 1359, 2022 WL 16753325 (Fed. Cir. Nov. 8, 2022)**

The Federal Circuit granted Apple's petition for writ of mandamus and directed Judge Albright to promptly rule on Apple's pending transfer motion and stay all proceedings until the transfer is resolved.[33] Aire sued Apple in October 2021, Apple moved to transfer in April 2022, and Judge Albright ordered that he would not rule on the transfer motion until the close of fact discovery (30 weeks from then) and six more weeks of re-briefing.[34] Apple filed a petition for a writ of mandamus, and the Federal Circuit granted it.[35] The Court noted that while a district court has discretion in managing its docket, an appellate court can correct a clearly arbitrary refusal to act on a longstanding pending transfer motion.[36] It further emphasized that venue motions should be prioritized, and that by the time the motion would be considered here it would have been a full year, with invalidity and infringement contentions having already been served after the close of discovery.[37] It also noted that both parties here agreed that no additional discovery or briefing was necessary, and that Aire consented to resolving the motion at any time.[38] Because transfer motions are the first order of business, the Court granted Apple's petition and ordered Judge Albright to promptly rule.[39]

***In re Tracfone Wireless, Inc.*, No. 2021-136, 2021 U.S. App. LEXIS 11388 (Fed. Cir. Apr. 20, 2021)**

In this decision, the Federal Circuit found the Western District of Texas had abused its discretion in denying a motion to transfer venue to the Southern District of Florida.

Precis filed a patent infringement suit against TracFone in the Western District of Texas.[40] TracFone later moved to dismiss for improper venue or, alternatively, transfer the case to the Southern District of Florida.[41] The district court continued proceedings without addressing this motion until the Federal Circuit ordered it to do so upon a

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[33] In re Apple Inc., 52 F.4th 1359 (Fed. Cir. 2022).
[34] *Id.* at *1.
[35] *Id.*
[36] *Id.*
[37] *Id.*
[38] *Id.* at *2.
[39] *Id.* at *3.
[40] *Id.*
[41] Id.

petition for a writ of mandamus from TracFone.[42] The district court denied the motion three days later, concluding the "willing witness" factor weighed against transfer despite there being no identified witnesses in the Western District of Texas.[43]Relying on the Fifth Circuit's "100-mile" rule, the court reasoned "doubling the distance traveled would double the inconvenience to the non-party witnesses" who lived in Arizona and Minnesota.[44] Again, TracFone petitioned for a writ of mandamus.[45]

The Federal Circuit found the district court had abused its discretion.[46] The court found the district court had misapplied the "100-mile" rule by being too rigid.[47] Despite Arizona and Minnesota being closer Texas than Florida, the witnesses would need to travel a great distance to testify either way.[48] Following the reasoning in *Genentech* and *Apple*, the court concluded "the district court clearly abused its discretion in concluding that the willing witness factor did not weigh in favor of transfer."[49] Because the district court had ruled the other transfer factors as being either neutral or in favor of transfer, the Federal Circuit granted the petition.[50]

***In re ADTRAN, Inc.*, 840 F. App'x 516 (Fed. Cir. March 19, 2021)**

In this decision, the Federal Circuit denied a petition for writ of mandamus but nonetheless directed the Western District of Texas to act quickly.[51]
Correct Transmission filed a patent infringement suit against ADTRAN in the Western District of Texas.[52] On September 14, 2020, ADTRAN moved to dismiss the case for proper venue or, alternatively, transfer the case to the Northern District of Alabama.[53] In October 2020, the district court set several deadlines for future filings in the case and set a date for a Markman hearing.[54] The court had not yet, however, addressed ADTRAN's motion.[55] ADTRAN motioned the district court to stay all deadlines

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[42] *Id.* (citing *In re Tracfone Wireless, Inc.*, No. 2021-118, 2021 U.S. App. LEXIS 6689 (Fed. Cir. Mar. 8, 2021)).
[43] *Id.* at *3.
[44] *Id.* at *6.
[45] *Id.*at *2
[46] *Id.* at *6.
[47] *Id.* at *7.
[48] Id.
[49] *Id.* at *8. (citing In re Genentech, Inc., 566 F.3d 1338, 1344 (Fed. Cir. 2009); In re Apple Inc., 979 F.3d 1332, 1342 (Fed. Cir. 2020)).
[50] *Id.* at *10.
[51] *In re Tracfone Wireless, Inc.*, No. 2021-136, 2021 U.S. App. LEXIS 11388 (Fed. Cir. Apr. 20, 2021).
[52] Id.
[53] Id.
[54] Id.
[55] *Id.*

unrelated to the venue issue until that issue had been resolved.[56] The district court indicated it would not address the stay motion until after the venue issue was briefed.[57] ADTRAN subsequently petitioned for a writ of mandamus.[58]

The Federal Circuit denied the petition.[59] The court held mandamus is "reserved for extraordinary situations" and that ADTRAN had "identified no authority establishing a clear legal right to a stay of all non-venue-related deadlines under circumstances where the venue-related motion is still in briefing and the Markman hearing is months away."[60] The court reasoned the district court still plausibly had time to address the issue before the Markman hearing or postpone the hearing.[61] However, the court noted it fully expected the district court to give the stay and venue motions top priority.[62] Otherwise, it could still turn to mandamus upon a future petition.[63]

***In re Tracfone Wireless, Inc.*, No. 2021-118, 2021 U.S. App. LEXIS 6689 (Fed. Cir. Mar. 8, 2021)**

In this decision, the Federal Circuit ordered the Western District of Texas to stay proceedings until it ruled on an unaddressed motion to transfer venue.[64]
Precis filed a patent infringement suit against TracFone in the Western District of Texas.[65] TracFone later moved to dismiss for improper venue or, alternatively, transfer the case to the Southern District of Florida in June 2020.[66] In December 2020, the district court scheduled and held a Markman hearing despite having not ruled on TracFone's petition.[67] Tracfone filed a petition for write of mandamus to direct the district court either transfer the case or stay proceedings until it ruled on the motion to transfer.[68]
The Federal Circuit granted the petition for mandamus for staying proceedings.[69] The court identified well-established Fifth Circuit precedent requiring district courts "give promptly filed transfer motions 'top priority' before resolving the substantive issues in

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[56] Id.
[57] Id.
[58] Id.
[59] *Id.*
[60] Id.
[61] Id.
[62] *Id.*
[63] Id.
[64] *In re Tracfone Wireless, Inc.*, No. 2021-118, 2021 U.S. App. LEXIS 6689 (Fed. Cir. Mar. 8, 2021).
[65] *Id.*
[66] Id.
[67] *Id.* at *3.
[68] *Id.* at *1.
[69] *Id.* at *3.

the case."[70] The court thus ordered the district court to stay proceedings until it ruled on the motion to transfer.[71]

***In re SK Hynix Inc.*, No. 2021-114, 2021 U.S. App. LEXIS 5674 (Fed. Cir. Feb. 25, 2021)**

In this decision, the Federal Circuit denied a petition for writ of mandamus to transfer venue because the district court had not clearly abused its discretion.[72] Netlist sued SK Hynix in the Western District of Texas for allegedly infringing two of its patents.[73] SK Hynix filed a motion to transfer venue to the Central District of California, which the district court denied.[74] SK Hynix then filed a petition for writ of mandamus to compel the transfer.[75]

The Federal Circuit denied the petition because SK Hynix had not shown the district court abused its discretion.[76] Netlist and SK Hynix had previously taken part in two pending, but inactive, lawsuits in the Central District of California involving patents of the same family as the instant case.[77] SK Hynix argued the "first to file" rule and 28 U.S.C. § 1404(a) required the case be transferred to the Central District of California.[78] The Federal Circuit agreed with the district court's reasoning that SK Hynix had not met the threshold requirements for § 1404(a) that the action "might have been brought" against SK Hynix in the Central District of California or that "all parties have consented" to the transfer.[79] The court later held SK Hynix had not shown a right to transfer under the "first to file" rule without meeting the threshold requirements of § 1404(a).[80] Furthermore, SK Hynix had not shown any error in the district court's conclusion that the Central District of California was in improper venue because SK Hynix neither resides in that district not has established a place of business there.[81]

***In re: Samsung Eelctronics Co.*, 2 F.4th 1371 (Fed. Cir. June 30, 2021)**

In this consolidated appeal of denied motions to transfer from Judge Albright in the Western District of Texas to the Northern District of California, the Federal Circuit

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[70] *Id.* (citing In re Horseshoe Entm't, 337 F.3d 429, 433 (5th Cir. 2003)).
[71] Id.
[72] *In re SK hynix Inc.*, No. 2021-114, 2021 U.S. App. LEXIS 5674 (Fed. Cir. Feb. 25, 2021).
[73] *Id.* at *1.
[74] *Id.* at *2.
[75] Id.
[76] *Id.*
[77] *Id.* at *3.
[78] Id.
[79] *Id.* at *11.
[80] *Id.* at *13.
[81] *Id.* at *12.

held that Judge Albright clearly abused his direction by concluding that N.D. Cal. was not more convenient.[82] Ikorongo had sued Samsung and LG in W.D. Tex. a month after forming as a Texas LLC, despite the relevant individuals being from North Carolina.[83] Samsung and LG moved to transfer to N.D. Cal., noting that that was the location of the majority of the development of the accused applications, and that no application was developed or researched in Western Texas.[84] The district court denied the transfer motions, holding that LG and Samsung failed to establish that the complaints could have been brought in N.D. Cal.—Ikorongo had originally (before amending a day later) filed the complaint as Ikorongo Texas, an entity which owned the rights to the patents only in the Western District of Texas, so argued that infringement was impossible outside of Texas.[85] The District Court also analyzed the private and public interest factors, and noted that while the location of documents and witnesses were primarily in the Northern District of California, party witnesses were given little weight and that relatively few non-party witnesses would be impacted.[86] The Court continued to find no higher local interest in California, as it rejected the idea that patent cases give rise to local controversy, and that the practical problems of Ikorongo having active suits in multiple jurisdictions outweighed the small private interest rationale for transfer.[87]

The Federal Circuit reversed.[88] First, it found that because Ikorongo Technology (which owned the rights outside of Texas) joined the suit, the amended complaint could have been brought in California, and that the plaintiff was clearly trying to manipulate its venue.[89] On the merits of the motions, the Federal Circuit found clear abuse of discretion in the lack of weight given to the convenience of the N.D. Cal., because of the dozens of sources of evidence in Northern California, the lack of a single relevant witness in Texas, and the local interest of the apps being developed in Northern California.[90] The Court held that the judicial economy point was less relevant, as relatively few patents overlapped, multidistrict litigation solves, and there was a completely different underlying technology.[91]

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[82] In Re: Samsung Eelctronics Co., Ltd., 2F.4th 1371 (Fed. Cir. 2021).
[83] *Id.* at 1373.
[84] *Id.* at 1374.
[85] *Id.*
[86] *Id.*
[87] *Id.* at 1374-75.
[88] *Id.* at 1381.
[89] *Id.* at 1376.
[90] *Id.* at 1379-80.
[91] *Id.*

***In re: Dish Network LLC*, 856 Fed.Appx. 310 (Mem) (Fed Cir. Aug. 13, 2021)**

The Federal Circuit denied a petition for a writ of mandamus to transfer the case from Judge Albright in the Western District of Texas to the District of Colorado.[92] The court denied the petition on the grounds that a writ of mandamus requires demonstrating no adequate alternative, but noted that the lower court needed to reconsider the motion.[93] The district court had held that the local interest factor was neutral because of call centers, warehouses, and service centers in the district, but the Federal Circuit noted that general corporate presence isn't sufficient and it must be tied to the events underlying the suit, while also noting that as in *Samsung*, witnesses were much more prominent in the target venue.[94] The Court strongly implied that if the district court denied the petition, a future petition would be successful.[95]

Judge Renya concurred, expressing concern with the decision to deny a petition while instructing a judge to reconsider his views, and worried that this risked creating a new form of relief.[96]

On remand, the district court reentered a similar decision despite the Federal Circuit's "confidence" that it would reconsider the question on remand. DISH petitioned for mandamus again, and this time the court granted the petition, transferring the case to Colorado.

***In re: Apple Inc.*, 855 Fed.Appx. 766 (Mem) (Fed. Cir. Aug. 4, 2021)**

The Federal Circuit denied a petition seeking a writ of mandamus directing transfer from Judge Albright in the Western District of Texas to the Northern District of California.[97] The Court held that Apple had failed to demonstrate that the right to relief was clear and indisputable, as the plaintiff had demonstrated two potential W.D. Tex. witnesses who were unwilling to travel to California to testify, while Apple had relied on employee witnesses who were unlikely to be called to trial.[98] Judicial economy considerations because of co-pending lawsuits in W.D. Tex. also gave reason against transfer.[99]

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[92] In Re: Dish Network LLC, 856 Fed.Appx. 310 (Mem) (Fed Cir. 2021).
[93] *Id.* at 310-11.
[94] *Id.* at 311.
[95] *Id.*
[96] *Id.*
[97] In Re: Apple Inc., 855 Fed.Appx. 766 (Mem) (Fed. Cir. 2021).
[98] *Id.* at 766-67.
[99] *Id.* at 767.

***In re: Google LLC*, 855 Fed.Appx. 767 (Mem) (Fed. Cir. Aug. 4, 2021)**

The Federal Circuit denied Google's petition for a write of mandamus to transfer the action from Judge Albright in the Western District of Texas to the Northern District of California.[100] The district court had refused to transfer on the grounds of co-pending cases, that the Texas courts were open, that Google employees in the Western District of Texas had material information, that Google had failed to demonstrate anyone was unwilling to travel to Texas/use video to testify, that Google failed to demonstrate specific documents in N.D. Cal, and that Google had a substantial presence in Austin.[101] The Federal Circuit disagreed on that last factor, as the events in the case need to be connected to the local interest, but still found Google had not made a clear and indisputable showing that transfer was required given the efficiency benefits of keeping it in Texas.[102]

***In re: Hulu LLC*, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021)**

The Federal Circuit granted Hulu's writ of mandamus to transfer the case from Judge Albright in the Western District of Texas to the Central District of California.[103] The plaintiff, SITO Mobile, is a Delaware company with principal place of business in New Jersey.[104] Hulu demonstrated that the vast majority of witnesses would be based in California, but the district court had held that this factor weighed against transfer because some of the witnesses could be summoned to Texas and that prior art witnesses are unlikely to testify a trial.[105] The Federal Circuit held that this discounting was an abuse of discretion without more case-specific analysis, and that this factor weighed for transfer.[106] On willing witnesses, the district court discounted the convenience of party witnesses and held that Hulu had failed to identify relevant third party witnesses—the Federal Circuit disagreed, noting that employee convenience while still discounted is a factor, and that not a single significant witness was in the Western District of Texas or would find it more convenient.[107] The Federal Circuit found court congestion to be neutral, and found that the balance of factors clearly weighed towards transfer and that the district court had abused its discretion. [108]

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[100] In Re: Google LLC, 855 Fed.Appx. 767 (Mem) (Fed. Cir. 2021).
[101] *Id.* at 768.
[102] *Id.*
[103] In re: Hulu LLC, 2021 WL 3278194 (Fed. Cir. 2021).
[104] *Id.* at *1.
[105] *Id.* at *3.
[106] *Id.*
[107] *Id.* at *4-*5.
[108] *Id.* at *5.

***In re: Bose Corp.*, 848 Fed.Appx. 426 (Mem) (Fed. Cir. May 25, 2021)**

The Federal Circuit rejected a writ of mandamus to stay all non-venue related proceedings in the Western District of Texas until the district court ruled on its motion to transfer to the District of Massachusetts—the Federal Circuit held that Bose had failed to show that the district court would conduct its Markman hearing or other substantive procedures before deciding on the venue issue, nor did Bose show a clear legal right to stay its deadlines to file its Markman briefs.[109]

***In re: Western Digital Technologies, Inc.*, 846 Fed.Appx. 925 (Mem) (Fed. Cir. May 10, 2021)**

The federal circuit denied a petition for mandamus directing Judge Albright to transfer the case to the Northern District of California.[110] The plaintiff is a Swiss resident, and the Defendant has two offices in the Western District of Texas, but is headquartered in San Jose.[111] The district court denied a motion to transfer because WDT failed to identify physical documents in the NDCA, and that three non-party witnesses resided in or close to the W.D. Tex. The Federal Circuit denied the petition on the grounds that the W.D. Tex. had a local interest, a less congested docket, and could compel the testimony of more likely non-party witnesses, for whom it was also a more convenient destination.[112]

***Andra Group, LP v. Victoria's Secret Stores, LLC*, 6 F.4th 1283 (Fed. Cir. Aug 3, 2021)**

In this appeal from the Eastern District of Texas, the Federal Circuit affirmed a motion to dismiss for improper venue.[113] L Brands, Inc. is the corporate parent for defendants, which are divided into a subsidiary to manage retail stores, one to manage the website and application, and one that owns the brand.[114] All defendants are incorporated in Delaware, and only the retail subsidiary has any employees or physical presence in the Eastern District of Texas.[115] When the plaintiff sued, the magistrate judge recommended that the non-store defendants be dismissed for improper venue, and the district court divided the case and adopted the recommendations, leading to the

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[109] In re: Bose Corporation, 848 Fed.Appx. 426 (Mem) (Fed. Cir. 2021).
[110] In re: Western Digital Technologies, Inc., 846 Fed.Appx. 925 (Mem) (Fed. Cir. 2021).
[111] *Id.* at 926.
[112] *Id.* at 926-27.
[113] Andra Group, LP v. Victoria's Secret Stores, LLC, 6 F.4th 1283 (Fed. Cir. 2021).
[114] *Id.* at 1286.
[115] *Id.*

plaintiff voluntarily dismissing the case against the retail subsidiary without prejudice and appealed the decision for the non-retail defendants.[116]

The Federal Circuit affirmed, noting that the plaintiff needed to show that each defendant committed acts of infringement and maintains a regular and established place of business in the E.D. Tex.[117] Andra argued that the retail locations were a regular and established place of business of the other defendants because the employees were agents of the defendants or because the defendants had ratified the locations as their place of business.[118] Andra's agency argument relied on the facts that the parent controlled the hiring and firing of employees, the website subsidiary could direct the handling of returns purchased on the website, and the brand subsidiary's products were distributed there.[119] The Court held that none of these were sufficiently proven—the parent didn't directly control hiring and didn't approve hires, there was no evidence that the internet subsidiary controlled returns, and that the brand's control of its products didn't prove control of employees.[120]

Andra's ratification theory relied not on proving a lack of corporate separateness, but by the same actions as the agency argument demonstrating the company holding themselves out as doing business there.[121] The court dismissed this argument, on the grounds that the defendants must also actually do business there, which they didn't, and also that none of the other defendants owned the physical locations or displayed their corporate names there.[122]

***In re: Juniper Networks, Inc.*, 2021 WL 4343309 (Fed. Cir. Sept. 24, 2021)**

The Federal Circuit granted a petition for writ of mandamus to direct Judge Albright in the Western District of Texas to transfer six actions to the Northern District of California.[123] WSOU Investments, a Patent Assertion Entity whose CEO and president live in California but whose office is in Waco Texas, filed seven complaints against Juniper Networks, a Delaware Corporation headquartered in Sunnyvale, California and with a small office in Austin.[124] Juniper moved to transfer to the N.D. Cal., which Judge Albright rejected.[125] On sources of proof, Judge Albright found that the majority of Juniper's documents were in California, but that information was stored in multiple other locations, so Juniper had failed to differentiate what documents would

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[116] *Id.*
[117] *Id.* at 1287.
[118] *Id.*
[119] *Id.* at 1288.
[120] *Id.* at 1288-89.
[121] *Id.* at 1289.
[122] *Id.* at 1290.
[123] In re: Juniper Networks, Inc., 2021 WL 4343309 (Fed. Cir. Sept. 24, 2021).
[124] *Id.* at *1.
[125] *Id.* at *2.

be more available in N.D. Cal.[126] On compulsory process, neither party identified any witness who would be unable to testify in either location, so the district court held that this was a factor against transferring, for somewhat opaque reasons.[127] On relative convenience for witnesses, Juniper had identified 15 witnesses in the N.D. Cal. while WSOU could only demonstrate one employee in W.D. Tex., so Judge Albright found this weighed slightly for transfer.[128] On local interest, the district court found that Juniper's office in Austin and WSOU's headquarters being in W.D. Tex. was sufficient to give it a greater local interest, as Juniper had not shown that development was done entirely within N.D. Cal.[129] Lastly, the district court held that the W.D. Texas would be able to try the case more quickly, and taking into account these factors found against transfer.[130]

The Federal Circuit reversed, noting the massive difference in convenience for witnesses, and holding that Juniper's small office in Austin which had no connection to the events of the case and WSOU's nominal existence in Texas were not enough to give rise to a local interest compared to Juniper's headquarters in California where the majority of development was done and where the Plaintiffs resided.[131] The Court also noted that the vast majority of evidence was more accessible in N.D. Cal., and the existence of evidence in other locations (but not in W.D. Tex.) was not a reason that N.D. Cal. was not more convenient, and that a lack of need for compulsory process in either venue made that factor neutral.[132] Lastly, the Court disputed the time to trial statistics, emphasizing it was improper to weigh W.D. Tex.'s aggressive scheduling orders and that this factor should be given little weight.[133] Because the "center of gravity" was clearly in California, the Court granted the petition.[134]

***In re: Google LLC*, 2021 WL 4592280 (Fed. Cir. Oct. 6, 2021)**

The Federal Circuit granted Google's writ of mandamus to transfer the case from Judge Albright in the Western District of Texas to the Northern District of California.[135] Jenam Tech., whose only employee is in the E.D. Tex. where it is incorporated but who licenses its IP through an affiliate in the N.D. Cal, sued Google relating to the Quick UDP Internet Connections Protocol.[136] Google filed a motion to transfer and asserted

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[126] *Id.*
[127] *Id.*
[128] *Id.*
[129] *Id.* at *3.
[130] *Id.*
[131] *Id.* at *4-*5.
[132] *Id.* at *5-*6.
[133] *Id.* at *6-*7.
[134] *Id.* at *7.
[135] In re: Google LLC, 2021 WL 4592280 (Fed. Cir. Oct. 6, 2021).
[136] *Id.* at *1.

that the vast majority of the research occurred in either Mountain View or Cambridge, and that the source code and technical documents were stored there.[137] Jenam argued to keep the case in W.D. Tex., noting that Google has an office in Austin, claiming that the inventor was likely unwilling to travel to either location but would prefer Texas because he could drive there rather than having to fly during COVID, and asserting that it would be more convenient for Jenam's one employee and its patent attorney, both of whom resided in Texas.[138]

The district court denied the motion to transfer.[139] On sources of proof, the district court held that Google could easily access documents electronically from either place, whereas it would be more convenient for plaintiffs' employee residing in Eastern Texas to transfer documents to the W.D. Tex.[140] On compulsory process, Google identified five third party witnesses who could be compelled in N.D. Cal. but not in W.D. Tex. The district court discounted this because only one of them was likely unwilling to testify.[141] On convenience of witnesses, the lower court emphasized that few witnesses would testify live, that convenience was not important for party witnesses, and that the importance of convenience for the inventor outweighed the importance of convenience for Google's ex-employees, who were less critical.[142] On local interest, the lower court found it to be against transfer because Google had employees and customers in both districts, while Jenam is a Texas entity.[143] On court congestion, the district court emphasized that a transfer would cause delay.[144]

The Federal Circuit granted the petition, finding a clear abuse of discretion.[145] First, the Court held the witness convenience factor greatly favored transfer by noting that party witness convenience still matters, that no witness lived in the W.D. Tex., that a great number lived in N.D. Cal., and that the inventor having to travel a longer distance was irrelevant because in either case he'd have to leave home for a long time, and that the inventor's stated aversion to flying because of COVID will hopefully have abated by the trial in ~2023.[146] The Court then held that the local interest factor strongly favored transfer, as Google's general presence in Austin bore no relationship to where events that gave rise to the suit occurred—this was indisputably Northern California—and that Jenam's connection to W.D. Tex. is a single office in a different district within Texas.[147]

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[137] *Id.*
[138] *Id.*
[139] *Id.* at *2.
[140] *Id.*
[141] *Id.*
[142] *Id.* at *2-*3.
[143] *Id.* at *3.
[144] *Id.*
[145] *Id.* at *7.
[146] *Id.* at *4-*5.
[147] *Id.* at *5-*6.

The Court next held that the court congestion factor was neutral, as there was comparable congestion, and that Google's motion to transfer was prompt enough that the possibility of delay for new scheduling orders was minimal.[148] Moving to sources of proof, while Google can access information electronically, the fact that there were no documents within the Western District whatsoever weighed in favor of transfer.[149] The Court held that there was nothing tying the case to the W.D. Tex., nor any factor that favored retention, so denying transfer was clearly an abuse of discretion.[150]

***In re: Pandora Media, LLC*, 2021 WL 4772805 (Fed. Cir. Oct. 13, 2021)**

The Federal Circuit granted Pandora's writ of mandamus to transfer the case from Judge Albright in the Western District of Texas to the Northern District of California.[151] Bluebonnet, a patent assertion entity based in the N.D. Tex., sued Pandora in W.D. Tex.[152] Pandora filed a motion to transfer to N.D. Cal., relying on the fact that Bluebonnet's predecessor in interest, Friskit, developed the technology at issue in San Francisco and as such multiple non-party witnesses resided there, along with Pandora's own engineers.[153] Bluebonnet noted that multiple Pandora employees with potentially relevant information were located in Austin, two were elsewhere in Texas, and one was in Boulder, Colorado.[154] Bluebonnet also noted that Waco was closer to the residences of the inventors in Israel and Maryland, and that Waco was more convenient for witnesses in New York and Philadelphia.[155]

The district court denied the transfer motion.[156] The Court weighed the location of documents in favor of transfer, noting that the key source code and other documents were in N.D. Cal.[157] Availability of compulsory process to secure attendance of witnesses was neutral, as Pandora had failed to show that any witnesses would be unwilling to testify.[158] On willing witnesses, N.D. Cal. was more convenient for a party witnesses, which was given little weight compared to the non-party witnesses for whom Pandora failed to identify residences and Bluebonnet had noted that Texas was more convenient for witnesses in Israel, New York, and Philadelphia.[159] The district

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[148] *Id.*
[149] *Id.* at *6-*7.
[150] *Id.* at *7.
[151] In re: Pandora Media, LLC, 2021 WL 4772805 (Fed. Cir. Oct. 13, 2021)
[152] *Id.* at *1.
[153] *Id.*
[154] *Id.*
[155] *Id.*
[156] *Id.* at *2.
[157] *Id.*
[158] *Id.*
[159] *Id.*

court held that local interest was slightly in favor of transfer, and that all other factors were neutral, so N.D. Cal. was not clearly the more convenient forum.[160]

The Federal Circuit granted the petition for mandamus.[161] First, the Court emphasized that the compulsory process factor weighed significantly in favor of N.D. Cal., as witnesses should be presumed to be unwilling absent a showing by the opposing party.[162] Next, the Court held that the district court erred by not giving weight to party witnesses and by weighing so highly the difference in distance between Texas and California for witnesses located far from either location.[163] Finding that no factor favored keeping the case in Texas while several of the most important ones favored it being transferred, the Court granted the motion.[164]

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[160] *Id.*
[161] *Id.* at *7.
[162] *Id.* at *3.
[163] *Id.* at *4-5.
[164] *Id.* at *7.