

**United States Court of Appeals
for the Federal Circuit**

IN RE: APPLE INC.,
Petitioner

2020-135

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

ON PETITION AND MOTION

MELANIE L. BOSTWICK, Orrick, Herrington & Sutcliffe LLP, Washington, DC, argued for petitioner. Also represented by ABIGAIL COLELLA, New York, NY; MELANIE HALLUMS, Wheeling, WV; JOHN GUARAGNA, DLA Piper US LLP, Austin, TX.

CHRISTIAN JOHN HURT, The Davis Firm, P.C., Longview, TX, argued for respondent Uniloc 2017 LLC. Also represented by WILLIAM DAVIS.

Before PROST, *Chief Judge*, MOORE and HUGHES, *Circuit Judges*.

Order for the court filed by *Chief Judge* PROST.

Dissent filed by *Circuit Judge* MOORE.

PROST, *Chief Judge*.

O R D E R

Apple Inc. petitions this court for a writ of mandamus directing the United States District Court for the Western District of Texas (“WDTX”) to transfer the underlying patent infringement suit to the United States District Court for the Northern District of California (“NDCA”) pursuant to 28 U.S.C. § 1404(a). Uniloc 2017 LLC opposes. Uniloc also moves to file a sur-reply brief and to supplement the record.

We grant Uniloc’s motions to file a sur-reply and to supplement the record. For the reasons below, we grant Apple’s petition.

BACKGROUND

In September 2019, Uniloc sued Apple in the Waco Division of WDTX, alleging that several Apple products infringe U.S. Patent No. 6,467,088 (“the ’088 patent”). App. 16. According to Uniloc, “Apple’s software download functionality, including how Apple determines compatibility for application and operating system software updates through the App Store, infringes the ’088 patent.” Response Br. 4. The “Accused Products include Apple devices that run iOS and macOS-based operating systems.” *Id.*

In November 2019, Apple moved to transfer the case to NDCA on the basis that it would be clearly more convenient to litigate the case in that district. App. 84; *see also* 28 U.S.C. § 1404(a). To support its motion, Apple submitted a sworn declaration from Michael Jaynes, a senior finance manager at Apple. App. 105.

In January 2020, Apple moved to stay all activity in the case unrelated to its transfer motion pending a decision on the motion. App. 166–73. The district court denied the stay motion without explanation in a text entry on the docket. App. 7. The parties completed briefing and discovery on transfer in February 2020. App. 4–9.

The district court held a hearing on Apple’s motion on May 12, 2020, during which the court stated that it would deny the motion and issue a written order as soon as possible. App. 10, 296. After the hearing, but before issuing a written order, the court held a *Markman* hearing, issued its claim construction order, held a discovery hearing

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regarding the protective order in the case, and issued a corresponding discovery order. App. 11. In response to these advances in the case, on June 15, 2020, Apple filed this petition for a writ of mandamus. The district court issued its order denying transfer a week later, on June 22, 2020. S. App. 1–34.

DISCUSSION

The writ of mandamus is an extraordinary remedy available to correct a clear abuse of discretion or usurpation of judicial power. *Cheney v. U.S. Dist. Ct.*, 542 U.S. 367, 380 (2004). “In reviewing a district court’s ruling on a motion to transfer pursuant to § 1404(a) [on mandamus review], we apply the law of the regional circuit,” in this case the Fifth Circuit. *See In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014). “A district court abuses its discretion if it: (1) relies on clearly erroneous factual findings; (2) relies on erroneous conclusions of law; or (3) misapplies the law to the facts.” *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 310 (5th Cir. 2008) (en banc) (“*Volkswagen II*”) (quoting *McClure v. Ashcroft*, 335 F.3d 404, 408 (5th Cir. 2003)). As “the distinction between an abuse of discretion and a clear abuse of discretion cannot be sharply defined for all cases,” “[o]n mandamus review, we review for these types of errors, but we only will grant mandamus relief when such errors produce a patently erroneous result.” *Id.* “To determine whether a district court clearly abused its discretion in ruling on a transfer motion, some petitions for mandamus relief that are presented to us require that we ‘review[] carefully the circumstances presented to and the decision making process’ of the district court.” *Id.* at 312 (alteration in original) (quoting *In re Horseshoe Ent.*, 337 F.3d 429, 432 (5th Cir. 2003)).

In general, three conditions must be satisfied for a writ to issue: (1) the petitioner must demonstrate a clear and indisputable right to issuance of the writ; (2) the petitioner must have no other adequate method of attaining the desired relief; and (3) the court must be satisfied that the writ is appropriate under the circumstances. *Cheney*, 542 U.S. at 380–81. In the § 1404(a) transfer context, however, the test for mandamus essentially reduces to the first factor, given that “the possibility of an appeal in the transferee

forum following a final judgment . . . is not an adequate alternative,” and that “an erroneous transfer may result in judicially sanctioned irreparable procedural injury.” *In re McGraw-Hill Glob. Educ. Holdings LLC*, 909 F.3d 48, 56 (3d Cir. 2018) (internal quotation marks omitted); *see also In re TS Tech USA Corp.*, 551 F.3d 1315, 1322 (Fed. Cir. 2008). Accordingly, the issue on appeal is whether Apple has shown a clear and indisputable right to issuance of the writ.

I

Before addressing the merits of Apple’s petition, we first consider Uniloc’s argument that Apple waived a number of arguments by failing to raise them in its petition.

Apple filed its petition on June 15, 2020—one week before the district court issued its written order denying transfer and more than one month after the court held a hearing on the transfer motion and orally indicated that it would deny the motion. Apple’s reply brief, however, was filed after the district court issued its written order denying transfer. Uniloc moved to file a sur-reply on the basis that Apple’s reply brief raised “new points of error” not raised in the petition because Apple incorrectly guessed in its pre-order petition as to the bases on which the district court would support its order denying transfer. *See* Opposed Non-Confidential Motion of Respondent for Leave to File Sur-Reply Brief (July 13, 2020), ECF No. 39; *see also* Response Br. 11 (arguing that Apple “guessed wrong [in its petition] at how the [district court] would rule on a number of factors” and, as a result, failed “to challenge several findings at all” in the initial petition). In its sur-reply, Uniloc addresses the merits of the arguments it contends Apple first raised in its reply brief and further argues that Apple’s purportedly newly raised arguments are waived. *See* Sur-Reply Br. 1. Apple defends its pre-order filing, explaining that “[g]iven the rapid progression of this case, [it could not] wait any longer for a written order before seeking mandamus to prevent the case from moving forward in an inconvenient venue.” Pet. 10–11.

Ordinarily, an appellant waives issues or arguments not properly raised in its opening brief. *See Becton*

Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 800 (Fed. Cir. 1990). “This practice is, of course, not governed by a rigid rule but may as a matter of discretion not be adhered to where circumstances indicate that it would result in basically unfair procedure.” *Id.*; see also *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1251 (Fed. Cir. 2005) (“An appellate court retains case-by-case discretion over whether to apply waiver.”). To the extent Apple raises new arguments in its reply brief in response to the district court’s order, we exercise our discretion to not apply waiver because doing so would be unfair under the circumstances.

Although district courts have discretion as to how to handle their dockets, once a party files a transfer motion, disposing of that motion should unquestionably take top priority. *E.g.*, *In re Horseshoe*, 337 F.3d at 433 (explaining that transfer motions should take “top priority” in the handling of a case); *McDonnell Douglas Corp. v. Polin*, 429 F.2d 30, 30 (3d Cir. 1970) (“To undertake a consideration of the merits of the action is to assume, even temporarily, that there will be no transfer before the transfer issue is decided. Judicial economy requires that another district court should not burden itself with the merits of the action until it is decided that a transfer should be effected.”); *In re Nintendo Co.*, 544 F. App’x 934, 941 (Fed. Cir. 2013) (explaining that “a trial court must first address whether it is a proper and convenient venue before addressing any substantive portion of the case”); *In re EMC Corp.*, 501 F. App’x 973, 975 (Fed. Cir. 2013) (acknowledging the “importance of addressing motions to transfer at the outset of litigation”).

Instead, the district court barreled ahead on the merits in significant respects, prompting Apple to file its mandamus petition before the district court issued its transfer order. For example, the court held a *Markman* hearing, issued its claim construction order, held a discovery hearing, and issued a corresponding discovery order. App. 11. These are not merely rote, ministerial tasks. Indeed, a *Markman* hearing and claim construction order are two of the most important and time-intensive substantive tasks a district court undertakes in a patent case.

Given Apple's concern over the rapid progression of this case, Apple filed its petition before the district court issued its transfer order. In the petition, Apple addressed what it believed would be the court's likely reasons for its denial of the motion. Apple was first able to directly address the district court's order in its reply brief. On these facts, and because we grant Uniloc's motion to file a sur-reply, we decline to apply waiver.¹

II

As to the merits, under 28 U.S.C. § 1404(a), “[f]or the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought or to any district or division to which all parties have consented.” Under Fifth Circuit law, to prevail on its transfer motion before the district court, Apple bore the burden of demonstrating that “the transferee venue is clearly more convenient.” *Volkswagen II*, 545 F.3d at 314. The district court denied that motion. On mandamus review, Apple bears the burden of demonstrating that the court's denial amounted to a clear abuse of discretion. *Id.* at 308.

The Fifth Circuit assesses transfer requests using the well-established private and public interest factors. *Id.* at 315. “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 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.* (quoting *In re Volkswagen AG*,

¹ To the extent this order could be construed as condoning pre-order mandamus petitions, we take care to emphasize the particular circumstances of this case: namely, the district court heavily prioritized the merits of the case, and Uniloc was allowed a sur-reply. We also note that Apple's decision to file a pre-order petition was not without consequence to Apple. Indeed, Apple was only able to file one brief directly responding to the district court's arguments, and Uniloc, through its sur-reply, received both the last word and extra space for briefing.

371 F.3d 201, 203 (5th Cir. 2004) (“*Volkswagen I*”). And “[t]he public interest 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 [or in] the application of foreign law.’” *Id.* (alteration in original) (quoting *Volkswagen I*, 371 F.3d at 203).

The parties agree that the third and fourth public interest factors are neutral in this case but dispute whether the remaining factors weigh for or against transfer. *See* Pet. 34; Response Br. 11. We conclude that Apple has demonstrated that the district court clearly abused its discretion in denying transfer.² We discuss the relevant private and public interest factors in turn.

A. Relative ease of access to sources of proof

The district court concluded that the first private interest factor—the relative ease of access to sources of proof—“weighs slightly in favor of transfer.” S. App. 15; *see also* S. App. 22. The court divided its analysis between the location of witnesses and the location of relevant documents.

The district court determined that “the location of witnesses weighs in favor of transfer,” because “Apple provides sufficient argument that most relevant party witnesses are located in NDCA.” S. App. 21. Even after taking potential third-party witnesses into account, the

² The dissent states in its conclusion that Apple’s “petition itself does not raise many of the arguments the majority relies upon in its decision.” Dissent at 12. To the extent this statement might be misconstrued as suggesting that we have relied on arguments not advanced by Apple, that is not the case. For the reasons explained above, we have not applied waiver under the circumstances here. Therefore, we have considered all the arguments in the papers before us, including those in Apple’s reply brief and in the sur-reply we permitted Uniloc to file.

district court concluded that “the greater balance of witnesses . . . are located within NDCA.” S. App. 21–22.

The court concluded that “the location of relevant documents was neutral.” S. App. 22; *see also* S. App. 19. In reaching this conclusion, the court credited “Uniloc’s argument concerning the physical location of its documents” in a different Texas district as being closer to WDTX than NDCA. S. App. 19. With respect to Apple, the court noted that Apple’s campus in Austin, Texas houses revenue and accounting documents that the court concluded might be “relevant to ascertaining what damages Uniloc could argue at trial and Uniloc’s inducement claim.” S. App. 20. The court also highlighted that Apple’s Austin campus might house instruction documents relevant to Uniloc’s inducement claim. *Id.* The court further noted that Apple owns content delivery network (“CDN”) servers in the Northern District of Texas that might be relevant because Apple uses the CDN “to store and distribute apps and other content of the accused App Store.” *Id.* With respect to third parties located within WDTX, the district court explained that “Flextronics, the third-party manufacturer of an Accused Product, may have relevant documents,” but that such documents may be “duplicative” of what Apple will itself produce. *Id.* For these reasons, the court found “that there are documents relevant to this case located in this District, such that Apple has not shown it is clearly more convenient to transfer this case to NDCA.” *Id.*

The district court ultimately determined that because the location of witnesses weighs in favor of transfer, but the location of documents was neutral, the first private interest factor “weighs slightly in favor of transfer.” S. App. 15; *see also* S. App. 22.

The district court legally erred in considering witnesses as “sources of proof” for purposes of the first private interest factor. This factor relates to the ease of access to non-witness evidence, such as documents and other physical evidence; the third private interest factor—the cost of attendance for willing witnesses—relates to the convenience of each forum to witnesses. *See, e.g., Volkswagen II*, 545 F.3d at 316–18; *see also Duha v. Agrium, Inc.*, 448 F.3d 867, 876 (6th Cir. 2006) (“Access to non-witness sources of

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proof, including documents in particular, is properly considered as part of the ease-of-access factor.”); *In re Acer Am. Corp.*, 626 F.3d 1252, 1255–56 (Fed. Cir. 2010) (analyzing witness convenience under the third private interest factor and documentary and physical evidence under the first private interest factor). If witness convenience is considered when assessing both the first and third private interest factors, witness convenience will be inappropriately counted twice.

The district court also misapplied the law to the facts in analyzing the location of relevant documents. Notably, in its substantive analysis of this factor, the district court failed to even mention Apple’s sources of proof in NDCA, much less meaningfully compare them to proof in or nearer to WDTX. Rather, the district court concluded that the factor was neutral merely because there existed some “documents relevant to this case located in the District, such that Apple has not shown it is clearly more convenient to transfer this case to NDCA.” S. App. 20. The district court’s analysis confuses Apple’s burden of demonstrating that the transferee venue is clearly more convenient with the showing needed for a conclusion that a particular private or public interest factor favors transfer. Indeed, a factor can favor transfer even if that factor is, standing alone, insufficient to warrant transfer. *See, e.g., Volkswagen II*, 545 F.3d at 315; *Action Indus., Inc. v. U.S. Fidelity & Guar. Co.*, 358 F.3d 337, 340 (5th Cir. 2004). And although we credit the district court’s determination that some relevant documents are located in WDTX, the movant need not show that all relevant documents are located in the transferee venue to support a conclusion that the location of relevant documents favors transfer. Nor is this factor neutral merely because some sources of proof can be identified in the district. The district court erred in holding otherwise.

Even to the extent the district court’s order can be interpreted as attempting to conduct an appropriate comparison of the ease of access to sources of proof in the two forums, the court erred by overemphasizing the sources of proof in or nearer to WDTX and failing to meaningfully consider the sources of proof in NDCA. “In patent infringement cases, the bulk of the relevant evidence usually comes

from the accused infringer. Consequently, the place where the defendant's documents are kept weighs in favor of transfer to that location." *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009). In his sworn declaration, Mr. Jaynes stated that Apple stores a significant amount of relevant information in NDCA, including the relevant source code, Apple records relating to the research and design of the accused products, and marketing, sales, and financial information for the accused products. *See, e.g.*, App. 115–16 ¶¶ 23, 30; App. 119 ¶¶ 47, 48; App. 184; Pet. 29–30. Neither the district court nor Uniloc disputes that such records are located in NDCA. Mr. Jaynes also stated in his sworn declaration that he was unaware of any relevant documents in WDTX. App. 119 ¶ 49. Again, although we credit the district court's identification of some relevant proof located in or nearer to WDTX, the district court erred by failing to meaningfully consider the wealth of important information in NDCA.

While we note these errors, we need not reweigh the evidence (or, rather, weigh Apple's evidence in the first instance), or otherwise disturb the district court's ultimate conclusion that the location of relevant documents is neutral, because the remainder of the factors convince us that transfer is appropriate and that the court clearly abused its discretion in concluding otherwise.

B. The availability of compulsory process to secure the attendance of witnesses

The district court concluded that the second private interest factor—the availability of compulsory process to secure the attendance of witnesses—was neutral in this case. S. App. 23–24. On review, we see no reason to disturb the district court's conclusion on this factor.

C. The cost of attendance for willing witnesses

Next we turn to “an important factor, the convenience for and cost of attendance of witnesses.” *Genentech*, 566 F.3d at 1343. In analyzing this factor, the Fifth Circuit uses the “100-mile rule,” which provides that “[w]hen the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct

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relationship to the additional distance to be traveled.” *Volkswagen II*, 545 F.3d at 317 (quoting *Volkswagen I*, 371 F.3d at 204–05).

In *Genentech*, this court—applying Fifth Circuit law—held that “the ‘100-mile’ rule should not be rigidly applied” where “witnesses . . . will be required to travel a significant distance no matter where they testify.” 566 F.3d at 1344. *Genentech* specifically held that witnesses traveling from Europe, Iowa, and the East Coast would be only “slightly more inconvenienced by having to travel to California” than to Texas. *Id.* at 1348. This sensible holding stems from the observation that, regardless of the ultimately chosen venue, such witnesses will be required to travel a significant distance, will likely incur meal and lodging expenses, and will likely incur time away from home. *See id.* at 1344. *Genentech*’s interpretation of the 100-mile rule is consistent with the Fifth Circuit’s reasoning underlying the rule, which forcefully applies to witnesses who reside near one of the two districts but not to the circumstances presented here:

Additional distance means additional travel time; additional travel time increases the probability for meal and lodging expenses; and additional travel time with overnight stays increases the time which these fact witnesses must be away from their regular employment. Furthermore, the task of scheduling fact witnesses so as to minimize the time when they are removed from their regular work or home responsibilities gets increasingly difficult and complicated when the travel time from their home or work site to the court facility is five or six hours one-way as opposed to 30 minutes or an hour.

Volkswagen I, 371 F.3d at 205.

The district court concluded that this factor was neutral. S. App. 26–27. The court divided its analysis into the convenience to third-party witnesses and the convenience to party witnesses.

The court determined that “the location of third-party witnesses weighs against transfer.” S. App. 26; *see also* S. App. 27 (concluding that “the inventors being located

closer to WDTX is a *significant fact that weighs against transfer*” (emphasis added)). The court highlighted that Uniloc identified three important third-party witnesses believed to reside in New York: the attorney who prosecuted the asserted patent and the patent’s two named inventors. S. App. 25, 27. The court reasoned that because the inventors are likely to be two of the most important witnesses called at trial, and because these inventors live “much closer to WDTX than NDCA,” the location of third-party witnesses weighed against transfer. S. App. 26–27. The court also determined that “the location of party witnesses slightly weighs in favor of transfer to NDCA.” S. App. 26. In sum, the court concluded that the factor was neutral. S. App. 26–27.

The district court misapplied the law to the facts of this case by too rigidly applying the 100-mile rule. As a result, the district court gave too much significance to the fact that the inventors and patent prosecutor live closer to WDTX than NDCA. Although it might be true that these individuals will need to travel a greater distance to reach NDCA than WDTX, and although a flight from New York to WDTX might take a bit less time than from New York to NDCA, in either instance these individuals will likely have to leave home for an extended period of time and incur travel, lodging, and related costs. As expressed in *Genentech*, the 100-mile rule “should not be rigidly applied” where witnesses “will be required to travel a significant distance no matter where they testify.” 566 F.3d at 1344. These witnesses will only be “slightly more inconvenienced by having to travel to California” than to Texas.³ *See id.* at 1348.

³ The dissent argues that our determination reflects “mere disagreement with the district court[].” Dissent at 3. We are puzzled as to how our conclusion—that the district court misapplied the law by rigidly applying the law in a manner inconsistent with *Genentech*—amounts to a mere “disagreement” with the district court. We also do not understand how this conclusion disregards our standard of review, considering that we are obligated to review for

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In view of this misapplication of the law, and in view of the district court's findings that "most relevant party witnesses are located in NDCA" and "it is likely that both Apple and Uniloc will each have one or more potential trial witnesses from NDCA," S. App. 27, this factor weighs at least slightly in favor of transfer. *See Volkswagen II*, 545 F.3d at 317 (concluding that the district court "erred in applying this factor" when, contrary to the district court's conclusion, the factor weighed in favor of transfer).

D. All other practical problems that make trial of a case easy, expeditious, and inexpensive

The district court concluded that the fourth private interest factor—all other practical problems that make trial of a case easy, expeditious, and inexpensive—"weighs heavily against transfer." S. App. 30. The court reasoned that "significant steps" had already been taken in the case. S. App. 29. In particular, the court explained that the parties exchanged infringement and invalidity contentions, the parties "briefed and argued *Markman* claim terms," and the court held a *Markman* hearing and "issued a claim construction order." S. App. 29–30. Thus, wrote the court, "NDCA would have to duplicate this Court's efforts to construe the patent unless it merely chose to accept what this Court has already determined and entered." S. App. 30. The district court further remarked that because NDCA has more pending civil cases than WDTX, a transfer to NDCA, "a forum with a significantly higher level of case

clear misapplications of the law. *E.g.*, *Volkswagen II*, 545 F.3d at 310. Only by giving district courts unbounded discretion would we defer to this misapplication of law. Finally, we reject the dissent's apparent invitation to discard or otherwise ignore *Genentech*.

The dissent also appears to suggest that we have entirely dispensed with the 100-mile rule and that we "seek[] to eliminate the application of this rule to third-party witnesses residing a plane ride away from both districts." Dissent at 4. To the contrary, we merely follow *Genentech*'s sensible holding that the 100-mile rule should not be rigidly applied in circumstances such as these.

congestion,” would be “an act *against* judicial economy.” S. App. 29–30.

Apple argued that this factor “weighs in favor of transfer because of the twenty-one cases [presenting some overlapping issues] that have been transferred from districts in Texas to NDCA.” S. App. 28. The district court was unpersuaded, reasoning that many of those twenty-one cases were stayed, the active cases lacked set trial dates, and the cases related to different patents. S. App. 29–30. The court explained that it “disagrees that a case should be transferred when another case with the same parties and only some overlapping issues such as standing and subject matter jurisdiction are present in another district.” S. App. 30.

The district court legally erred in its analysis of this factor. Aside from the service of preliminary infringement contentions, *see* App. 32–34, all the “significant steps” that had been taken by the court and parties in the case were taken *after* Apple moved for transfer in November 2019, as well as *after* Apple moved to stay the case in January 2020. For example, the parties submitted *Markman* briefing in February and March 2020. What’s more, most of the “significant” steps the district court relied on were taken *after* the district court’s May 12, 2020 hearing on the transfer motion, during which the court explained that the motion would be denied. In particular, after the transfer hearing but before issuing a transfer order, the district court held a *Markman* hearing and issued its claim construction order. The court also held a discovery hearing and issued a corresponding discovery order.

As stated previously, once a party files a transfer motion, disposition of that motion should take top priority in the case. *E.g.*, *In re Horseshoe*, 337 F.3d at 433; *McDonnell Douglas Corp.*, 429 F.2d at 30; *In re Nintendo*, 544 F. App’x at 941; *In re EMC*, 501 F. App’x at 975. Setting aside the questionable prioritization of other proceedings over the pending transfer motion, the district court legally erred in concluding that the merits-related steps it had taken weighed heavily against transfer. A district court’s decision to give undue priority to the merits of a case over a party’s transfer motion should not be counted against that party in the venue transfer analysis.

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The district court also misapplied the law to the facts of this case in concluding that judicial economy weighed against transfer because NDCA has more pending cases than WDTX.⁴ “To the extent that court congestion matters, what is important is the speed with which a case can come to trial and be resolved.” *See In re Ryze Claims Sols., LLC*, 968 F.3d 701, 710 (7th Cir. 2020) (quoting *In re Factor VIII or IX Concentrate Blood Prods. Litig.*, 484 F.3d 951, 958 (7th Cir. 2007)); *see also Gates Learjet Corp. v. Jensen*, 743 F.2d 1325, 1337 (9th Cir. 1984) (concluding, in assessing the impact of court congestion on the § 1404(a) analysis, that “[t]he real issue is . . . whether a trial may be speedier in another court because of its less crowded docket”).

As the district court acknowledged, NDCA and WDTX have historically had comparable times to trial for civil cases (25.9 months for NDCA versus 25.3 months for WDTX), and, most relevantly, NDCA has historically had a *shorter* time to trial for patent cases. *See* S. App. 30. Although the district court noted that NDCA has more pending cases than WDTX, this fact is, without more, too tenuously related to any differences in speed by which these districts can bring cases to trial.

After accounting for the district court’s errors, we are left with nothing relevant to this factor weighing against transfer. However, there are judicial economy benefits on the other side of the ledger: namely, as the district court conceded, there are pending cases in NDCA with “some overlapping issues.” S. App. 30. Even crediting (as we do) each of the district court’s findings discounting the benefits of transfer to NDCA on this basis (e.g., many cases in NDCA are stayed and lack trial dates, and the cases differ in many respects), it is beyond question that the ability to transfer a case to a district with numerous cases involving some overlapping issues weighs at least slightly in favor of

⁴ We question whether such considerations of “judicial economy” might have been more appropriately assessed under the first public interest factor—the administrative difficulties flowing from court congestion.

such a transfer. Accordingly, this factor weighs at least slightly in favor of transfer.

E. The administrative difficulties flowing from court congestion

The district court concluded that the first public interest factor—the administrative difficulties flowing from court congestion—“weighs against transfer.” S. App. 30–31. The court acknowledged that NDCA historically “has a shorter time to trial for patent cases than WDTX.” S. App. 30. But, the district court concluded, “because the Court has already set the trial date in this case, the prospective time from filing to trial is 18.4 months,” which is “42.5 percent faster than previous WDTX cases” and faster than the historical time to trial in NDCA. S. App. 31.

The district court misapplied the law to the facts of this case by relying too heavily on the scheduled trial date. We have previously explained that a court’s general ability to set a fast-paced schedule is not particularly relevant to this factor. *See, e.g., In re Adobe Inc.*, 823 F. App’x 929, 932 (Fed. Cir. 2020). Indeed, a district court cannot merely set an aggressive trial date and subsequently conclude, on that basis alone, that other forums that historically do not resolve cases at such an aggressive pace are more congested for venue transfer purposes. This is particularly true where, like here, the forum itself has not historically resolved cases so quickly. Thus, this factor is neutral.⁵

⁵ We further note that this factor frequently calls for speculation. For example, scheduled trial dates are often subject to change, and the district court’s anticipated time to trial is significantly shorter than the district’s historical time to trial. Because this factor often calls for speculation, where “several relevant factors weigh in favor of transfer and others are neutral, then the speed of the transferee district court should not alone outweigh all of those other factors.” *See Genentech*, 566 F.3d at 1347.

F. The local interest in having localized interests decided at home

The district court concluded that the second public interest factor—the local interest in having localized interests decided at home—was “neutral in terms of transfer.” S. App. 33. The court reasoned that “Apple has substantial presences in both NDCA and WDTX, so both districts have a significant interest in this case.” S. App. 32. In addition, the court explained that “WDTX has a significant localized interest because of the state and local tax benefits received by and pledged to Apple to build a second campus in Austin.” *Id.* The district court concluded that “Uniloc’s presence in NDCA, but not in WDTX, weighs in favor of transfer.” S. App. 33. The district court further remarked that “Flextronics’ presence in this District weighs slightly against transfer,” but the court ultimately concluded that the factor was neutral irrespective of whether Flextronics was considered. *See* S. App. 33 (concluding that this factor is neutral “even if Flextronics was excluded from the Court’s analysis”).

The district court misapplied the law to the facts of this case in analyzing this factor. This factor most notably regards not merely the parties’ significant connections to each forum writ large, but rather the “significant connections between a particular venue and *the events that gave rise to a suit.*” *See In re Acer*, 626 F.3d at 1256 (emphasis added); *see also Volkswagen II*, 545 F.3d at 318 (explaining that this factor pertains to a forum’s “connections with the events that gave rise to th[e] suit”); *In re HP Inc.*, No. 2020-140, 2020 WL 5523561, at *1, *4 (Fed. Cir. Sept. 15, 2020) (concluding that the district court correctly recognized that the local interests factor weighed at least slightly in favor of transfer from the Eastern District of Texas (“EDTX”) to NDCA because “more of the events giving rise to this suit appear to have occurred in [NDCA] than in [EDTX]—specifically, the development of the accused products”). The district court thus misapplied the law to the facts by so heavily weighing Apple’s general contacts with the forum that are untethered to the lawsuit, such as Apple’s general presence in WDTX and the state and local tax

benefits it purportedly received from the district.⁶ The district court also misapplied the law to the facts by failing to give weight to the “significant connections between [NDCA] and *the events that gave rise to a suit.*” See *In re Acer*, 626 F.3d at 1256 (emphasis added). Because of Uniloc’s “presence in NDCA” and absence from WDTX; because the accused products were designed, developed, and tested in NDCA; and because the lawsuit “calls into question the work and reputation of several individuals residing” in NDCA, *In re Hoffman-La Roche Inc.*, 587 F.3d 1333, 1336 (Fed. Cir. 2009), this factor weighs in favor of transfer.⁷

The dissent argues that our analysis of this factor is “overblown.” Dissent at 8. It relies on the following facts as both relevant to the local interests factor and weighing against transfer: (1) Apple has a large presence, and is increasing its presence, in WDTX; (2) Apple maintains CDN servers in Dallas, Texas, and has “at least seven employees in WDTX with duties concerning Apple’s CDN”; (3) Apple

⁶ In addition, to the extent the district court relies on the fact that Apple’s presence in the district is expected to increase in the future, neither Uniloc nor the district court has explained how Apple’s future plans in WDTX relate in any way to this lawsuit.

⁷ The dissent states that “[e]ven Apple’s petition did not argue that it would be a clear abuse of discretion to find this factor neutral.” Dissent at 10. We decline to engage with this minor semantical point other than to say that Apple properly raised an argument that the district court erred in concluding that this factor did not favor transfer. See, e.g., Pet. at 34 (“The other two public-interest factors either weigh in favor of transfer or, at the very least, cannot weigh against it.”); *id.* (“The interest of the district where the accused technology was designed and developed is self-evidently stronger than that of a district with no tie to this case.”); *id.* at 34–37 (generally arguing that NDCA’s interest outweighs WDTX’s interest, and that “[e]ven accepting every speculation by Uniloc, the local interest factor would at most be neutral”); see also Reply Br. 19 (The local interests factor “should have weighed in favor of transfer.”).

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performs some relevant revenue reporting and accounting activities in WDTX; and (4) Apple contracts with Flextronics to manufacture one of the accused products in WDTX. Dissent at 8–9.

We have already discussed Apple’s presence, and increasing presence, in WDTX above but add that both the district court and the dissent improperly conflate the requirements for establishing venue under 28 U.S.C. § 1400(b) and the requirements for establishing transfer under § 1404(a). “The statutory rights under [§] 1400(b) . . . are independent of the convenience-based rights under § 1404(a).” *In re Oath Holdings Inc.*, 908 F.3d 1301, 1306 (Fed. Cir. 2018). Indeed, the entire premise of a § 1404(a) transfer motion is that a case, *although brought in a proper venue*, should nevertheless be transferred for the convenience of the parties. *See, e.g., HollyAnne Corp. v. TFT, Inc.*, 199 F.3d 1304, 1307 (Fed. Cir. 1999) (“Section 1404(a) allows a court where venue is proper to transfer a case to a more convenient forum.”).

As to the CDN servers in Dallas, Texas, it is unclear why these servers are entitled to any weight, particularly given that the district court neither mentioned nor gave weight to these CDN servers in its analysis, and considering that the servers are located in the Northern District of Texas, not WDTX.

As to Apple’s CDN employees in the district and the fact that Apple performs some relevant financial activity in WDTX, we are unclear as to why the dissent focuses exclusively on these employees and this activity to the exclusion of all other employees and activity. This is particularly perplexing considering that the district court did not discuss these employees or activity at all in its analysis of this factor, other than to merely acknowledge Uniloc’s argument that the “witnesses it identified” weigh against transfer. S. App. 32. Moreover, the district court did not otherwise provide any reason to give these employees and

this activity weight above and beyond other relevant employees and activity.⁸

Finally, as to Flextronics, as we note above, the district court itself gave Flextronics little weight with respect to this factor. We see no error in this conclusion.

III

We conclude our discussion by addressing two additional points from the dissent. First, on numerous occasions, the dissent criticizes us for applying what it refers to as “de novo” review. To the contrary, and as we have explained throughout the order, we properly reviewed the district court’s order only for reliance on clearly erroneous fact findings, erroneous conclusions of law, or misapplications of law to fact. *See Volkswagen II*, 545 F.3d at 310. District courts have no discretion to make these kinds of errors. *See id.* And when such errors accumulate to produce a patently erroneous result, as they have here, we are obliged to act. *See id.*; *see also id.* at 318 (“[W]e hold that the district court’s errors resulted in a patently erroneous result.”). To the extent the dissent believes otherwise, it is mistaken. A district court’s “exercise of its discretion is not unbounded; that is, a court must exercise its discretion within the bounds set by relevant statutes and relevant, binding precedents.” *Id.* at 310.

Even more troubling, the dissent says that our order will somehow invite mandamus petitions based “almost entirely” on what it refers to as “ad hominem attacks on esteemed jurists.” Dissent at 3. That is a baseless and counterproductive statement about our order. Notably, the dissent supports its assertion with citations to *Apple’s petition* that the dissent contends constitute such attacks. *Our order*, however, relies on Apple’s relevant arguments and the record in the case, not on anything the dissent refers to as “ad hominem attacks.” For this reason, we do not

⁸ And in any event, when discussing the private interest factors, the district court concluded that most relevant party witnesses resided in NDCA, which undercuts the dissent’s analysis.

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understand how our order could reasonably be construed as inviting such attacks. If anything, the fact that our order completely ignores what the dissent calls “ad hominem attacks” will discourage future litigants from wasting precious briefing space on such statements.

CONCLUSION

We have considered Uniloc’s remaining arguments but find them unpersuasive. For the foregoing reasons, we hold that “the district court’s errors resulted in a patently erroneous result” and grant Apple’s mandamus petition. *See Volkswagen II*, 545 F.3d at 318.

Accordingly,

IT IS ORDERED THAT:

- (1) The petition is granted.
- (2) The motion to file a sur-reply brief is granted.
- (3) The motion to supplement the record is granted.

(4) The motion by ACT | The App Association, The Computer & Communications Industry Association, Unified Patents, LLC, and Roku, Inc. for leave to file a brief *amici curiae* in support of Apple Inc. is granted.

FOR THE COURT

November 9, 2020
Date

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

United States Court of Appeals for the Federal Circuit

IN RE: APPLE INC.,
Petitioner

2020-135

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

MOORE, *Circuit Judge*, dissenting.

Our review on a petition for a writ of mandamus is supposed to be limited—we are to grant mandamus to overturn a transfer decision only when the district court has clearly abused its discretion, “produc[ing] a patently erroneous result.” *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 310 (5th Cir. 2008) (*Volkswagen II*). “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.” *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010). Our mandamus jurisdiction is not an invitation to exercise de novo dominion, as the majority does here, over the district court’s individual fact findings and the balancing determination that Congress has committed “to the sound discretion of the trial court.” *Id.* at 1346; 28 U.S.C. § 1404(a). Nor is it an invitation for us to criticize the way our district court

colleagues generally manage their dockets, or as the majority puts it, “barrel” ahead on the merits in any given case. Maj. at 5.

The district court here thoroughly considered each convenience factor on the record before it. It acknowledged that Apple had identified several party witnesses residing in the Northern District of California. It ultimately found, however, that Uniloc chose a venue in the district in which Apple maintains a large campus employing thousands of people, where one of the accused products is manufactured, where third-party information and potential witnesses are located, and which is convenient for potential witnesses and sources of proof and which would not impose a significant hardship on Apple. The district court therefore concluded that Apple has not shown that it is clearly more convenient for the parties and witnesses to transfer the instant case to the Northern District of California. S.A. 34. I do not agree with the majority in light of these facts that the district court clearly abused its discretion in refusing transfer.

We must recognize our limited role in this process—there is no more deferential standard of review than clear abuse of discretion. Under the clear abuse of discretion standard, our role is to defer to the broad discretion of the district court except as necessary to correct a usurpation of judicial power or a patently erroneous result. *Volkswagen II*, 545 F.3d at 312 (“But—and we stress—in no case will we replace a district court’s exercise of discretion with our own; we review only for clear abuses of discretion that produce patently erroneous results.”); *In re Volkswagen of Am., Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009) (*Volkswagen III*) (“A suggestion that the district court abused its discretion, which might warrant reversal on a direct appeal, is not a sufficient showing to justify mandamus relief.”); *In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014) (“Th[e] standard is an exacting one, requiring the petitioner to establish that the district court’s decision

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amounted to a failure to meaningfully consider the merits of the transfer motion.”). Rather than conducting this limited review, the majority usurps the district court’s role in the transfer process, disregards our standard of review and substitutes its judgment for that of the district court. I am concerned that the majority’s blatant disregard for the district court’s thorough fact findings and for our role in a petition for mandamus will invite further petitions based almost entirely on ad hominem attacks on esteemed jurists similar to those Apple wages here. *See, e.g.*, Petition at 12; *id.* at 14; *id.* at 14–15; *id.* at 15; *id.* at 16. First, parties should be mindful that personal attacks against judges such as those lodged in this case are not welcome, and at least in my opinion completely unwarranted. Second, I am not comfortable with the new role the majority has carved out for our court, and I believe it is inconsistent with the Fifth Circuit law that we are bound to follow.

I. The Cost of Attendance for Willing Witnesses

The majority’s mere disagreement with the district court’s determination that the cost of attendance for willing witnesses is neutral does not warrant the extraordinary remedy of mandamus. The majority feigns confusion regarding the suggestion that it merely disagrees with the district court’s weighing of this factor. Maj. at 12 n.3. But it does not contest the district court’s finding that the location of party witnesses only “slightly weighs in favor of transfer.” S.A. 26. Nor does it address the court’s finding that because “Apple is building its own hotel [in Austin], the cost of attending a trial in the Austin division of WDTX may also weigh against transfer.” S.A. 13. Nor does it contest, even under *Genentech*, the district court’s findings that the Northern District of California would be more inconvenient, time-consuming and costly for potential third-party witnesses residing in New York and within the Western District of Texas, or that these facts weigh against transfer. S.A. at 26–27; Maj. at 12 (expressly acknowledging that the third-party witnesses will be “more

inconvenienced by having to travel to California' than to Texas"). Try as it may to cast this as a "misapplication of the law to facts," the majority's criticism of the district court merely amounts to a belief that the district court "gave too much significance" to the inconvenience of the third-party witnesses. Maj. at 12. That criticism is inconsistent with our role in reviewing district court transfer decisions on mandamus, where the district court's decision must be upheld unless it is "patently erroneous."

To justify its appellate fact finding that the inconvenience to party witnesses outweighs the inconvenience to third-party witnesses, the majority strains to identify a legal error in the district court's application of the Fifth Circuit's 100-mile rule. The 100-mile rule is clear: "[w]hen the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled." *Volkswagen II*, 545 F.3d at 317. The majority seeks to eliminate the application of this rule to third-party witnesses residing a plane ride away from both districts. But the Fifth Circuit reaffirmed the 100-mile rule in 2008, clearly contemplating air travel, and yet imposed no air-travel limits on the rule. The majority contends that the district court applied the 100-mile rule "in a manner inconsistent with *Genentech*." Maj. at 12 n.3. But as the majority concedes, even in *Genentech*, which the majority cites for the proposition that the 100-mile rule "should not be rigidly applied," we applied the 100-mile rule to witnesses residing a plane ride away from both the transferee and transferor districts, and concluded that those third-party witnesses would more be inconvenienced by traveling to the Northern District of California than to the Eastern District of Texas. 566 F.3d 1338, 1348 (Fed. Cir. 2009); Maj. at 12. Contrary to the majority's suggestion, it is not a clear abuse of discretion to find the right facts, apply the right law and simply weigh a factor differently than an appellate judge

would. To the extent there is any dispute regarding the extent of inconvenience faced by all willing witnesses, it was Apple's burden to prove that the transferee forum is clearly more convenient. The district court found that Apple failed to carry that burden and we must defer to that finding absent a clear abuse of discretion.

II. All Other Practical Problems That Make Trial of a Case Easy, Expeditious and Inexpensive

The majority next criticizes the district court's analysis of the practical problems that make trial of a case easy, expeditious and inexpensive. Maj. at 13–16. The district court found that this factor weighed heavily in favor of denying transfer. S.A. 30. I agree that the district court erred in considering events (such as claim construction) occurring after Apple filed its motion to transfer, therefore the court's conclusion that this factor weighs heavily against transfer may be flawed. This error alone, however, does not mean that this factor flips from heavily against transfer to slightly in favor of transfer. *Volkswagen II*, 545 F.3d at 315 n.11 (emphasizing that “mandamus does not reach all erroneous rulings of the district court”). The district court considered factors of judicial economy separate and apart from its own case progress such as trial dates, case and docket congestion, and the similarity of other pending lawsuits and concluded that these factors also “indicate that keeping the case in WDTX would have a more positive impact.” S.A. 29. Setting aside the district court's consideration of its own progress in the case occurring after Apple filed its transfer motion, we must defer to the district court's finding that the separate judicial economy considerations also weigh in favor of denying transfer. To the extent the majority believes the district court's consideration of events occurring after Apple filed its motion undermines the entirety of the district court's remaining fact findings, the appropriate remedy would be to remand for reconsideration. See, e.g., *In re Nitro Fluids*, No. 2020-142, Slip op. at 8 (Fed. Cir. Oct. 28, 2020); *In re Dropbox*, 814 F. App'x

598, 599–600 (Fed. Cir. 2020). It is inappropriate for the majority to use a single legal error to justify resolving factual disputes and to reconsider this factor anew on a petition for mandamus.

The majority seizes on the fact that there are other cases between Apple and Uniloc that have already been transferred to the Northern District of California, and concludes “it is beyond question that the ability to transfer a case to a district with numerous cases involving some overlapping issues weighs at least slightly in favor of transfer.” Maj. at 15–16. This statement of law that is apparently beyond question (though without citation to anything) disregards all the carefully considered facts regarding NDCA and the cases themselves which the district court discussed over many pages of its opinion. The district court determined that judicial economy does not weigh in favor of transfer after carefully considering the transferred cases, noting that “the asserted patent” and “the documents and source code relevant to proving infringement” are “unique to this case.” S.A. 29. Given the limited overlap in the cases, the “lack of set trial dates and the number of stayed cases” between the parties in the Northern District of California, and the congestion of the transferee docket, the court found that keeping the case in the Western District of Texas would have “a more positive impact.” *Id.* The district court also noted that the other cases between these parties were spread among various Northern District of California judges, that the cases were not consolidated before the same trial judge, and the NDCA local rules would not steer towards consolidation. S.A. 28–30. In short, the court found the other NDCA cases significantly different and widely dispersed. The majority barely mentions these careful, thoughtful, thoroughly analyzed fact findings en route to its conclusion that it will grant transfer.

Moreover, the court extensively analyzed the congestion in both dockets, explaining that although WDTX historically had only a slightly quicker median time from

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filing to disposition (25.3 versus 25.9 months), NDCA currently had three times the number of civil cases as WDTX. S.A. 29–30. The court further held that its trial date for this case would result in a shorter time to trial of 18.4 months compared with the average time to trial of approximately 32 months for patent cases in NDCA. S.A. 31. The majority finds no flaws with these fact findings (and claims to credit them), but it nonetheless dismisses them out of hand as insufficient to support the district court’s analysis.

The majority cites our decision in *Adobe* for the proposition that the district court relied too heavily on the scheduled trial date. But in *Adobe*, we merely concluded that the district court erred in giving dispositive weight to the district court’s general ability to set a trial schedule. 823 F. App’x 929, 932 (Fed. Cir. 2020). Contrary to the majority’s suggestion, the court here did not conclude “on that basis alone” that NDCA is more congested than WDTX. Maj. at 16. The court instead considered the relative congestion in each district, number of pending cases, historical time to trial for each district and the projected time to trial in the instant case and found that there was an appreciable difference in court congestion. The majority does not refute these thoughtful, thorough fact findings or point to any evidence that NDCA would resolve this case faster than WDTX. Nor does the majority suggest a district court should not consider its time to trial. Instead, the majority cites *Genentech* in an attempt to distract from its de novo review. Maj. at 16 n.5. But as in *Genentech*, I do not see how we can disturb the district court’s finding that judicial economy favors denying transfer under a clear abuse of discretion standard. See *Genentech*, 566 F.3d at 1347 (“We do not disturb the district court’s suggestion that it could dispose of the case more quickly than if the case was transferred to the Northern District of California”). Setting aside the district court’s own post-transfer motion case progress, the facts still support the court’s conclusion that this factor favors denying transfer. This is true de novo (the

standard the majority seems to be applying), and certainly true under the actual standard—the clear abuse of discretion standard.

III. Local Interests in Having Localized Interests Decided at Home

Lastly, the majority criticizes the district court's weighing of the parties' local interests. This criticism is overblown and inconsistent with our role as an appellate court. As the district court found, even though Apple is headquartered in Cupertino, California, it has a campus of more than 8,000 employees in the Western District of Texas. S.A. 4. Apple has committed to expanding this presence in the district by adding 5,000 to 15,000 employees. S.A. 12. It also has multiple retail stores in the district and is building its own local hotel. This is not the same local interest as every other district where Apple happens to have a retail store. Apple performs some of its revenue reporting and accounting activities on its Austin campus and Uniloc alleges (and Apple does not dispute) that these accounting activities process revenue tied to the alleged infringing functionality. Apple maintains content delivery network (CDN) servers in Dallas that store and distribute apps and other content. S.A. 20. The district court found that Apple has at least seven employees in WDTX with duties concerning Apple's CDN (related to the actual alleged infringement in this case).

The majority does not dispute these facts. Instead, the majority contends that these facts should not be entitled to any weight based on a specious claim that the district court did not mention Apple's CDN servers, engineers or its financial activities "at all in its analysis of this factor." Maj. at 19. This is untrue. The district court referenced Apple's CDN servers, CDN engineers and Apple's financial accounting activities throughout its opinion:

Uniloc acknowledges the fact that Apple uses a content delivery network (CDN) to store and distribute

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apps and other content of the accused App Store. Because there are Apple-owned CDN servers located in Dallas, and at least seven Apple employees in the District have job duties pertaining to Apple's CDN, Uniloc makes a reasonable argument that these sources of proof are relevant and located in this District.

S.A. 20. The district court then expressly refers to these facts again in support of its conclusion that the local interest factor is neutral:

Additionally, Uniloc contends that between the witnesses it identified (*e.g.*, Ms. Titus, seven employees in Austin with duties concerning Apple's CDN, and others) and the fact that Flextronics is located in this District, this factor weighs against transfer or is at worst, neutral.

S.A. 32.

The district court also found that Apple contracts with Flextronics to manufacture one of the accused products in Austin (and that Flextronics has hundreds of employees in WDTX some of whom may be relevant witnesses). S.A. 33. Far from giving "Flextronics little weight" as the majority suggests, the district court found that Flextronics' presence in the district "also contribute[s] towards a higher localized interest in this case" and weighs against transfer.¹ *Id.* Finally, Apple has multiple retail stores with employees and customer support personnel to instruct and train users on

¹ The district court's conclusion that the local interest factor "would be neutral in terms of transfer" absent Flextronics' presence does not justify the majority's blatant disregard for the fact that Flextronics manufactures an accused product and "has a few hundred employees in the District—including some who may be potential witnesses." S.A. 33.

how to use the accused functionality. Weighing these facts, the district court determined that the local interest factor was neutral. S.A. 32–33.

Contrary to the majority’s suggestion, the district court did not “fail[] to give weight” to the connections between this case and NDCA. Maj. at 18. The district court expressly acknowledged that Apple alleges that the software was designed and developed in NDCA. S.A. 31–32. And, as the majority concedes, the district court addressed the “relevant party witnesses residing in NDCA,” and nonetheless concluded that this factor was neutral. That there are facts on both sides does not mean we grant mandamus. The majority may not agree with the district court’s fact findings or may have weighed them differently, but it is impossible to say (and the majority never does) that the district court clearly abused its discretion in its local interest analysis.

And while the majority would rather not “engage with th[e] minor semantical point” of what the parties actually argue, even Apple’s petition did not argue that it would be a clear abuse of discretion to find this factor neutral. Maj. at 18 n.7; Petition at 36 (“the local interest factor would at most be *neutral*”); *see also* Petition at 35 (“Any finding that the local-interest factor weighs against transfer would require legal error.”). It wasn’t until its reply brief when Apple for the first time alleged that this factor weighs in favor of transfer. I do not see how the majority can conclude that a district court clearly abused its discretion in finding this factor neutral where even the moving party argued that the facts support neutrality.

The majority dismisses Apple’s and its manufacturer’s significant presence in the district. Neither this court nor the Fifth Circuit has held that an accused infringer’s general presence in a district is irrelevant to the district’s local interest in resolving the case. *See, e.g., In re Acer Am. Corp.*, 626 F.3d 1252, 1255–56 (Fed. Cir. 2010) (considering

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as relevant to the local interest factor the fact that one of the parties alleged to have caused harm resided in the transferor district). Moreover, the manufacture of the accused product in the district and the maintenance of a campus that may house documents related to the development of the accused products is indisputably relevant to the instant case. And to the extent there is a dispute regarding whether Apple or Flextronics have may have information or witnesses in Austin relevant to this case, that is a fact-intensive matter left to the discretion of the district court, not the appellate court. *See In re Apple Inc.*, 818 F. App'x. 1001, 1004 (Fed. Cir. June 16, 2020) (“Whether individuals or organizations may have relevant information . . . are fact-intensive matters often subject to reasonable dispute. . . . Those determinations are generally entrusted to the discretion of the district court.”).

It is not for us to criticize the district court’s weighing of these facts. It is Apple’s burden to prove that the local interest factor weighs in favor of transfer. On this record, the district court did not clearly abuse its discretion in finding that Apple failed to meet that burden.

CONCLUSION

I do not believe the district court’s denial of Apple’s transfer motion reflects a clear abuse of discretion. The majority identifies a “misapplication of law to fact” in nearly every factor the district court analyzed. But looking beyond this label, which the Fifth Circuit notably has never relied on as a basis for granting a petition for mandamus, the majority’s criticism amounts merely to a disagreement with the district court’s weighing of its thorough fact findings. *See, e.g.*, Maj. at 12 (“The district court misapplied the law to the facts of this case” and “gave too much significance to the fact that the inventors and patent prosecutor live closer to WDTX than NDCA.”); *id.* at 16 (“The district court misapplied the law to the facts of this case by relying too heavily on the scheduled trial date.”); *id.* at 17 (“The

district court thus misapplied the law to the facts by so heavily weighing Apple's general contacts with the forum."); *id.* at 18 ("The district court also misapplied the law to the facts by failing to give weight" to the connections between NDCA and the suit.); *id.* at 19–20 ("Moreover, the district court did not otherwise provide any reason to give these employees and this activity weight above and beyond other relevant employees and activity."). Though the district court erred in considering events that occurred after the transfer motion was filed, the court cannot fairly be charged with having failed to "meaningfully consider the merits of the transfer motion." *See Barnes & Noble*, 743 F.3d at 1383. Nor can we say that the district court's well-reasoned decision amounts to a "a clear abuse of discretion or usurpation of judicial power." *In re Nintendo Co.*, 589 F.3d 1194, 1197 (Fed. Cir. 2009). The majority has simply substituted its judgment that transfer should be ordered for that of the district court. At most, the alleged errors identified by the majority would support a motion for reconsideration; they do not warrant the extraordinary remedy of mandamus. It is particularly troubling to grant mandamus here where the petition itself does not raise many of the arguments the majority relies upon in its decision. Under the proper standard of review, I believe the only patently erroneous result here is the one reached by the majority. I dissent from that result. Though the standard of review is not *de novo*, because the majority has approached the case as though it is, let me add—I agree with the district court and I would have denied transfer *de novo*.