

Mandamus Granted Transferring Case to NDCA

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The Federal Circuit held that it was a clear abuse of discretion for Judge Alan Albright to refuse to transfer the lawsuit between Jenam and Google from the Western District of Texas to the Northern District of California. The Federal Circuit granted Google's mandamus petition directing Judge Albright to transfer the lawsuit. The Federal Circuit's review of Judge Albright's order denying transfer focused on four disputed transfer factors.

Convenience to Witnesses

The most hotly disputed factor was the relative convenience of the forums to the potential witnesses. Judge Albright held that this factor did not support transfer for two reasons: (1) the convenience of non-party witnesses receives more weight than party witnesses; and (2) inconvenience to the patent inventor receives more weight than inconvenience to other non-party witnesses. The Federal Circuit disagreed.

First, the Federal Circuit has repeatedly stated in cases like *In re Hulu* and *In re Samsung* that the convenience of party witnesses cannot be disregarded just because they are affiliated with a party. Contrary to Judge Albright's order, the Federal Circuit held that the inconvenience to Google's party witnesses must be considered. Judge Albright held that the inconvenience to each party's witnesses cancels out, because one party will have witnesses who are forced to travel, regardless of the chosen forum. While Google identified multiple party witnesses in the Northern District of California, Jenam identified only one in the Western District of Texas. Judge Albright also assumed that few party witnesses will be called to testify. The Federal Circuit recently rejected this assumption in *In re Juniper Networks*. Thus, the Federal Circuit decided that Judge Albright should have given more weight favoring transfer under this factor.

Second, the Federal Circuit held that Judge Albright was wrong to lend more weight to the inventor's convenience. Although the inventor, located in Atlanta, is geographically closer to Waco than San Francisco, the main metric considered should be travel time, rather than distance travelled. Travelling from Atlanta to Waco would only take "marginally less" time than travelling to San Francisco. Moreover, relying on *In re Genentech*, the Federal Circuit noted that it is inappropriate to weigh the convenience of a witness outside either proposed forum when there are several witnesses in the transferee forum, and none in the transferor forum. 566 F.3d 1338, 1345 (Fed. Cir. 2009). As a result, the Federal Circuit found that the convenience factor "strongly" favors transfer.

Local Interest

The Federal Circuit next considered the local interest in having disputes about activities occurring mainly within a particular district decided by a local court. Judge Albright held that this factor weighs against transfer, as Google possesses facilities in both forums. But the Federal Circuit found that Judge Albright's analysis incorrectly looked at Google's general presence in the forum, instead of where the events underlying the claim occurred. Although Google maintains a facility in the Western District of Texas, no underlying event occurred there. On the contrary, most events giving rise to the infringement claim occurred in the Northern District of California. Jenam argued that Google's sale of a disputed product in the Western District of Texas weighs against transfer. But the Federal Circuit held in *In re Hoffmann-La Roche Inc.* that such sales do not create a substantial local interest. 587 F.3d 1333, 1338 (Fed. Cir. 2009). As a result, the Federal Circuit weighed the local interest factor in favor of transfer.

Court Congestion

The Federal Circuit noted that the court congestion factor is about the "difference in docket congestion between the forums." In ruling that this factor weighed against transfer, Judge Albright did not consider docket congestion. Rather, he considered the delay that would be caused by scheduling the case with a new court. The Federal Circuit held that delay is generally an inappropriate consideration under this factor. Under *In re Horseshoe Ent.*, delay caused by transfer may only be considered in "rare and special circumstances," such as when the party seeking transfer failed to act in a reasonable timeframe. 337 F.3d 429, 434 (5th Cir. 2003). Because Judge Albright did not identify any special or unique circumstance justifying the consideration of delay, the Federal Circuit found this factor wrongly decided.

Sources of Proof

The Federal Circuit also considered the access to sources of proof in each forum. Judge Albright weighed this factor against transfer because: (1) Jenam possessed sources of proof in the Eastern District of Texas, and (2) Google documents in the Northern District of California could be electronically accessed from their office in the Western District of Texas. The Federal Circuit was not persuaded by these justifications. As to Jenam's documents in the Eastern District of Texas, such documents are outside the transferor forum. Also, Jenam's documents constitute only a small fraction of the total evidence, which will mostly be provided by Google. In analyzing Google's sources of proof, the Federal Circuit observed that the ability to access the documents electronically in the Western District of Texas does not weigh against transfer. Thus, the Federal Circuit held that this factor does not counsel against transfer.

In total, the Federal Circuit held that no factor suggests keeping the case in the Western District of Texas and that the "center of gravity" is in the Northern District of California. As a result, the Federal Circuit granted Google's petition for writ of mandamus to transfer the case.

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