

## Judge Albright Grants Defendant Box's Motion To Transfer Venue When Only Practical Considerations and Court Congestion Weighed Against Transfer

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*Topia Tech, Inc. v. Box Inc., et al.*, W-21-CV-01372-ADA, is a case brought by Topia alleging that Box infringes several patents related to sharing electronic files between multiple devices. After responding to Topia's Complaint, Box moved to transfer venue to the Northern District of California (NDCA), and emphasized that potential witnesses and relevant records would be located in its headquarters there. On January 3, Judge Albright granted Defendant's Motion to Transfer Venue to the Northern District of California.

In patent cases, motions to transfer under 28 U.S.C. § 1404(a) are governed by the law of the regional circuit. In the Fifth Circuit, "the preliminary question under § 1404(a) is whether a civil action 'might have been brought' in the [transfer] destination venue." If the destination venue would have been a proper venue, then "[t]he determination of 'convenience' turns on a number of public and private interest factors, none of which can be said to be of dispositive weight."

Box argued that the case could have been brought in the NDCA, but Topia argued that it could not have because Box failed to show whether venue would be proper for its co-defendants. However, because the Court severed the claims against the co-defendants, the Court found that venue would have been proper there. The Court then proceeded to its analysis of the public and private factors.

The private factors include: "(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."

The public factors include: "(1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws of the application of foreign law.

The Court first examined the private factors. The cost of attendance and convenience for willing witnesses is "[t]he most important factor in the transfer analysis." Here, Box argued that most of the relevant witnesses were located in the NDCA, and the only other relevant Box employees were located in Boston, Colorado, New York, Seattle, and outside the United States. Box also argued that Topia's witnesses were located in Washington and Nevada, and were therefore closer to the NDCA than the Western District of Texas (WDTX). Topia argued that relevant witnesses

from the co-defendants were located in the WDTX, but the Court held that because it severed the claims against the co-defendants, it would consider potential witnesses from those entities under the compulsory witness factor.

The Court found that the presence of Box employees in the NDCA weighed in favor of transfer, but that the presence of Box employees in Washington only weighed “slightly in favor of transfer” because Box did not identify these employees with any specificity and failed to identify the relevant knowledge they had. The Court found that the presence of employees in Colorado, Boston, New York, and outside the United States did not weigh in favor of transfer because, “regardless if this case remains in this District or is transferred to the NDCA, Box’s employees [in these locations] will have to travel a significant distance, incur meal and lodging expenses, and incur time away from home to testify at trial.” Therefore, these employees did not affect the outcome of this factor. The Court then found that the Box employees in the WDTX did not weigh against transfer because “Topia failed to connect the identified employees to the accused products.” Finally, the Court found that the Topia employee in Washington weighed in favor of transfer because the cost of travel to the NDCA would be much less than travel to the WDTX. Overall, the Court found that this factor weighed in favor of transfer.

The Court likewise found that the relative access to sources of proof factor weighed in favor of transfer because even though some relevant documentation may be stored with Box’s customers in WDTX, both Topia’s and Box’s relevant documents are likely located in or near the NDCA.

The Court also found that the availability of compulsory process to secure the attendance of witnesses factor favored transfer because Box identified a significant number of witnesses located in the NDCA. While Topia identified witnesses from Box customers, including from the severed co-defendants, in Texas that they may want to call, Box customers are available in both districts.

For the final private factor, the Court held that practical considerations weighed against transfer because there was co-pending litigation in the WDTX involving the same patents. Box argued that because both cases were in their early stages of litigation and involved different defendants and different accused products, this factor should not weigh against transfer. The Court disagreed, holding that judicial economy would favor keeping related cases together in the same court, and that a court’s familiarity with the technology would expedite the cases, even though they involved different products and defendants.

The Court then examined the public factors. First, the Court held that the administrative difficulties factor weighed against transfer because the median time to trial in the WDTX was only 28.3 months, while it was 34.7 months in the NDCA. The Court held that the local interests factor weighed slightly in favor of transfer because most of the events giving rise to the litigation took place in the NDCA. The Court held that the familiarity of the forum with the law that will govern the case and avoidance of unnecessary problems with conflicts of law factors would be neutral.

The Court continued its recent trend of summarizing its holdings regarding each factor in a table in its conclusion:

FACTOR	THE COURT’S FINDING
Relative ease of access to sources of proof	In favor of transfer
Cost of attendance for willing witnesses	In favor of transfer
Availability of compulsory process to secure the attendance of witnesses	In favor of transfer

FACTOR	THE COURT'S FINDING
All other practical problems that make trial of a case easy, expeditious and inexpensive	Against transfer
Administrative difficulties flowing from court congestion	Slightly against transfer
Local interest	Slightly in favor of transfer
Familiarity of the forum with law that will govern case	Neutral
Problems associated with conflict of law	Neutral

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