

Judge Albright Grants Defendant's Motion To Transfer When Witnesses, Evidence, And Events Giving Rise To Suit Are Located In Transfer Destination Venue

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On May 26, 2023, Judge Albright granted Defendant Adobe Inc.'s (Adobe) motion to transfer venue to the Northern District of California (NDCA). Plaintiff Silent Communication, LLC (Silent) alleged that Adobe's product "Adobe Connect" infringed a patent directed to a system and method for telephone communication.

28 U.S.C. § 1404(a) provides in part that "[f]or the convenience of parties and witnesses, . . . a district court may transfer any civil action to any other district or division where it might have been brought." Section 1404(a) places discretion in the district court to adjudicate motions for transfer according to an "individualized, case-by-case consideration of convenience and fairness."

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 yes, then the determination of "convenience" turns on several public and private interest factors, none of which is of dispositive weight.

The court first noted that the parties did not dispute that the case could have been brought in the NDCA. Therefore, the Court proceeded to its analysis of the public and private interest factors.

The private interest 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 interest 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 interest factors, beginning with the convenience of the witnesses, which is the most important factor in the transfer analysis. Adobe argued that most of its relevant witnesses, including employees with knowledge of the accused product, are in the NDCA, and no relevant Adobe employee is located in Texas. The Court noted that Silent did not identify any witnesses in or near the Western District of Texas (WDTX). Therefore, the Court concluded that the NDCA is a more convenient forum for the willing witnesses.

The court also found that the “access to sources of proof” factor weighed in favor of transfer because Adobe’s physical and electronic evidence is located or maintained in or near the NDCA and no evidence is located or maintained in or near the WDTX. And the Court held that the compulsory process factor weighed in favor of transfer because relevant former Adobe employees and potentially relevant prior art witnesses are in the NDCA. However, the Court noted that “Adobe has not alleged or shown that any of these witnesses are unwilling,” and that “under the Fifth Circuit’s recent guidance, the weight of this factor is diminished.” *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th at 630–31.

In evaluating other practical problems that make trial of a case easy, expeditious, and inexpensive, the Court noted two other matters involving the same patent remain pending in the Waco Division of the WDTX. The Court agreed that keeping three actions involving the asserted patent in the same court would prevent duplicative suits and determined that this factor weighed against transfer.

Next, the Court considered the public interest factors. The Court found that the “local interest in having localized interests decided at home” factor weighed in favor of transfer because Adobe’s briefing showed that there was a factual connection between the events that gave rise to the suit and the NDCA. The Court concluded that the other three public interest factors were neutral.

In conclusion, the Court found that four factors favored transfer to the NDCA, one disfavored transfer, and three were neutral. The relative ease of access to sources of proof, cost of attendance for willing witnesses, availability of compulsory process, and local interest factors favored transfer, so the Court found that Adobe met its burden of showing that the NDCA is clearly a more convenient forum.

FACTOR	THE COURT’S FINDING
Relative ease of access to sources of proof	Favors transfer
Cost of attendance for willing witnesses	Favors transfer
Availability of compulsory process to secure the attendance of witnesses	Favors transfer
All other practical problems that make trial of a case easy, expeditious, and inexpensive	Against transfer
Administrative difficulties flowing from court congestion	Neutral
Local interest	Favors transfer
Problems associated with conflict of law	Neutral

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