No. ____

IN THE

Supreme Court of the United States

IKORONGO TECHNOLOGY LLC AND
IKORONGO TEXAS LLC,
Petitioners,

v.

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA,
INC., LG ELECTRONICS INC.,
LG ELECTRONICS USA, INC., AND UBER
TECHNOLOGIES, INC.
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Ikorongo Technology LLC and Ikorongo Texas LLC have separate ownership and geographically divided patent rights that were infringed by Samsung, LG, and Uber. Under 28 U.S.C. §§ 1404(a) and 1400(b), the only possible venues for these actions were the Eastern and Western Districts of Texas and the defendants' home venues of Delaware, New Jersey, and New York. The district court denied Samsung, LG, and Uber's motions to transfer this action to the Northern District of California both because the cases could not have been brought in the Northern District of California and because the Northern District of California was not clearly more convenient than the Western District of Texas. The Federal Circuit granted Samsung, LG, and Uber's petitions for writs of mandamus and ordered transfer, holding that (1) the district court was bound to disregard the geographic division of patent rights, and (2) the Northern District of California was clearly more convenient.

The questions presented are:

1) Can a district court transfer a matter to a statutorily proscribed district based on expressly disregarding undisputed facts creating the proscription; and

2) Should *Gulf Oil Corporation* v. *Gilbert*, 330 U.S. 501 (1946), be overruled, particularly in light of stronger technological abilities shifting the reasonable focus for determining what is convenient for parties and witnesses?

PARTIES TO THE PROCEEDINGS BELOW

The parties to the proceedings below were:

Plaintiffs/Petitioners Ikorongo Texas LLC and Ikorongo Technology LLC,

Defendants/Respondents Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., LG Electronics Inc., LG Electronics USA, Inc., and Uber Technologies, Inc., and

Defendants Lyft, Inc. and Bumble Trading Inc.

CORPORATE DISCLOSURE STATEMENT

Petitioners Ikorongo Texas LLC and Ikorongo Technology LLC have no parent corporations and no publicly held corporation owns more than 10% of either company.

RELATED PROCEEDINGS

Under Rule 14.1(b)(iii), Petitioners note the following proceedings directly related to this case:

U.S. Court of Appeals for the Federal Circuit:

In re SAMSUNG ELECTRONICS AMERICA, INC., LG ELECTRONICS INC., LG ELECTRONICS USA, INC., Nos. 2021-13 & 2021-140 (judgment entered June 30, 2021), and

In re UBER TECHNOLOGIES, INC., No. 2021-150 (judgment entered July 8, 2021)

U.S. District Court for the Western District of Texas (judgment has not been entered in any of these cases):

IKORONGO TEXAS LLC v. LG ELECTRONICS INC., No. 6:20-cv-257,

IKORONGO TEXAS LLC v. LYFT, INC., No. 6:20-cv-258,

IKORONGO TEXAS LLC v. SAMSUNG ELECTRONICS CO. LTD., No. 6:20-cv-259,

IKORONGO TEXAS LLC v. BUMBLE TRADING, LLC, No. 6:20-cv-256, and

IKORONGO TEXAS LLC v. UBER TECH., INC., No. 6:20-cv-843.

U.S. District Court for the Northern District of California (judgment has not been entered in any of these cases):

IKORONGO TEXAS LLC v. LYFT, INC., No. 21-cv-06820,

IKORONGO TEXAS LLC v. UBER TECHNOLOGIES, INC., No. 21-cv-07420,

IKORONGO TEXAS LLC v. SAMSUNG ELECTRONICS CO., LTD., No. 21-cv-07424, and

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INTRODUCTION

The Federal Circuit's decision here is the latest in its line of cases where it disregards statutory language to advance its own policy views. This Court's intervention is needed again to correct the ruling. Here, the Federal Circuit expressly admits that it is forcing litigation to a venue that is not statutorily allowed. Nonetheless it ordered transfer based on its belief that another statute (that it admits does not apply here) expresses a congressional policy allowing it to disregard pertinent facts.

28 U.S.C. § 1404(a) has a mandatory provision and a discretionary provision for determining whether to transfer a case to a particular venue. The court, in its discretion, may determine the convenience of the parties warrants transfer. But as a statutory mandate, it only can transfer the action to a district in which the case originally "might have been brought," that is, an eligible district under 28 U.S.C. § 1400(b) because this is a patent case.

The Federal Circuit acknowledged that the pleaded facts establish the Northern District of California is an ineligible district under Section 1400(b). One of the plaintiffs had patent rights limited to certain counties in Texas. So, under this Court's holding in *TC Heartland* v. *Kraft Foods Group Brands, LLC*. 137 S. Ct. 1514, 1518 (2017), the only eligible districts were the Eastern and Western districts of Texas and the districts in which the defendants reside. They did not move to transfer the actions to the districts where they reside, though—they moved to transfer to the Northern District of California.

Rather than apply the statutory mandates as written to the defendants' choices to move to transfer to an ineligible district (rather than available eligible districts), the Federal Circuit granted a writ of mandamus, ordering to transfer the cases to the Northern District of California. It found authorization to do so in Congress's choice to enact a statute requiring courts to disregard fraudulent joinder when *invoking jurisdiction* of a court, and cases allowing courts to disregard certain facts relating to the *discretionary* factors under Section 1404(b). Acknowledging the statute and case law do not refer to the mandatory provision of the venue statute, and turning the *expressio unius* canon upside-down, it ruled that this statute's expression of Congressional policy *required* the district court to disregard the limited geographic rights of one plaintiff and transfer the case to the Northern District of California. This Court's intervention is needed to rein in the Federal Circuit's most recent usurpation of Congressional power, and the petition for a writ of certiorari should be granted.

PETITION FOR A WRIT OF CERTIORARI

Petitioners Ikorongo Technology LLC and Ikorongo Texas LLC respectfully petition this Court for a writ of *certiorari* to the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The order of the Federal Circuit granting Samsung and LG's petitions for writs of mandamus is reported at 2 F.4th 1371 and is reproduced at page 1a of the appendix to this petition ("App."). The order of the Federal Circuit granting Uber's petition for a writ of mandamus is unpublished and reproduced at page

21a of the Appendix. The orders of the United States District Court for the Western District of Texas are currently unreported and are reproduced at Appendix pages 27a, 51a, and 75a.

JURISDICTION

The order of the Federal Circuit granting Respondents' petitions for writs of mandamus were entered on June 30, 2021. App. 1a. Petitioners filed timely petitions for rehearing *en banc*, which were denied on August 30, 2021 and September 1, 2021. App. 100a, 102a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

28 U.S.C. § 1400(b)

§1400. Patents and copyrights, mask works, and designs

. . .

(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

28 U.S.C. § 1404(a)

§1404. Change of venue

(a) For 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.

STATEMENT OF THE CASE

A. Ikorongo Texas sues Samsung, LG, Bumble, Uber, and Lyft in the Western District of Texas for violating four patents.

In 2020, Ikorongo Texas sued Samsung, LG, Bumble, Lyft, and Uber in the Western District of Texas for infringement of its patents relating to sharing computer usage experiences. Pet. App. 28a; *see also* Pet. App. 52a; *Ikorongo Texas LLC* v. *Bumble Trading, LLC*, No. 6:20cv256, Dkt. 1 (W.D. Tex. March 31, 2020); *Ikorongo Texas LLC* v. *Lyft, Inc.*, No. 6:20cv258, Dkt. 1 (W.D. Tex. March 31, 2020); *Ikorongo Texas LLC* v. *Uber Tech., Inc.*, No. 6:20cv843, Dkt. 1 (W.D. Tex. Sept. 15, 2020). It sued Samsung and LG for infringing four patents, and it sued Bumble, Lyft, and Uber for infringing two of those four. *Id*. The complaints were amended to add Ikorongo Technology one day later. *Id*. All of the cases, except the later-filed case against Uber, were placed on the same schedule for, among other things, motions to transfer, *Markman* hearings (which were later consolidated), pretrial conference, and trial. *Ikorongo Texas LLC* v. *Samsung Elecs. Co., Ltd*, No. 6:20cv259, Dkt. 23 (W.D. Tex. Aug. 24, 2020); *Ikorongo Texas LLC* v. *LG Elecs., Inc.*, No. 6:20cv257, Dkt. 24 (W.D. Tex. Aug. 24, 2020); *Lyft* Dkt. 28; *Bumble* Dkt. 28.

In the complaints, Ikorongo Texas established that it could not permissibly sue in the Northern District of California, stating its patent rights were limited to certain U.S. counties, including counties in the Western District of Texas. Samsung Appx. 14; LG Appx. 15. It cited the relevant authority, noting its

limited ownership existed "under the principles of *Waterman* v. *Mackenzie*, 138 U.S. 252 (1891) and 35 U.S.C. §261." *Id.*

B. Samsung and LG move to transfer the cases to the Northern District of California.

Samsung, LG, Lyft, and Bumble moved to transfer their cases to the Northern District of California. Pet. App. 28, 52; *Lyft* Dkt. 30; *Bumble* Dkt. 37. Bumble ultimately withdrew its motion to transfer because it did not have a place of business in the Northern District of California, ensuring that its case would go forward in the Western District of Texas regardless of other motions to transfer. *Bumble* Dkt. 37. Uber later filed a motion of its own. Pet. App. 75a.

Notably, Samsung did not move to transfer the case to New York, where it is incorporated, and Ikorongo could have filed this action. In its petition, Samsung noted contacts for this case with New York. Samsung Pet. 6-7. And LG did not move to transfer its case to Delaware, where it is incorporated. Delaware, of course, is much closer to LG's principal place of business in New Jersey and closer to the purported location of relevant evidence in New York. LG Pet. 5-7.

Samsung and LG also claimed that public and private interest factors render the Northern District of California "clearly more convenient."

C. In response, Ikorongo again establishes it could not have filed this suit in the Northern District of California.

Ikorongo again spelled out the district court's lack of discretion in its response. Samsung Appx. 154-56.

It noted that venue is only proper where the defendant resides or where it committed acts of infringement and has an "established place of business." *Id.* Regarding the Northern District of California, Ikorongo noted that the defendants did not reside there, and they did not engage in acts of infringement there, as Ikorongo Texas only had patent rights in Texas. *Id.* Ikorongo then discussed the private and public interest factors for the convenience of parties and witnesses, establishing that the Western District of Texas is the more convenient forum. Samsung Appx. 156-66. It noted that location of documents was irrelevant under newer technologies, and that locations of witnesses did not weigh in favor of transfer because witnesses were scattered all over the country. *Id.* And in any event, in light of Bumble's case going forward in the Western District of Texas under any circumstance, splitting the litigation between two districts would only inconvenience everyone. *Id.*

D. The district court denies transfer both based on statutory requirements and the court's discretionary weighing of the private and public interest factors.

On March 1, 2021, the district court denied the motions to transfer. Pet App. 50a, 74a. Initially, it found Samsung and LG failed to meet their burdens "to show that Ikorongo Texas's current action could have initially been brought in the Northern District of California." Pet. App. 30a. According to the district court, the defendants' only acts of alleged infringement occurred in Texas, and *Waterman* v. *Mackenzie*, 138 U.S. 252 (1891) and 35 U.S. C. § 261 establish that Ikorongo Technology had the unfettered right to convey a geographically limited

exclusive right to the patent. Pet. App. 32a. The court further noted Samsung and LG's claim that a patentee can force litigation to only one district is false. *Id.* "[A]ssignment cannot grant a plaintiff access to a forum it could not access already . . . [and] regardless of whether an entity's right to sue has been limited by a Specified Part, an action may always be brought in the judicial district where the defendant resides." Pet. App. 33a.

The district court further found the transfer motions would have been denied in any event based on the applicable private and public interest factors. Pet. App. 34a-50a. Regarding the private factors, the district court found ease of access to proof weighs slightly in favor of transfer based on the fiction that relevant documents exist in the Northern District of California, but it noted this is "at odds with modern patent litigation" because the relevant documents are, in reality, equally accessible anywhere. Pet. App. 37a. It further found the compulsory process factor neutral, and the convenience analysis weighed slightly in favor of transfer because very few third-party witnesses would need to attend trial, Ikorongo agreed to pay their expenses, and they likely would be willing to testify due to their employers' relationships with the defendants. Pet App. 40a-42a. And the court found ease of trial to weigh against transfer because it would force the litigation on the same patents to be split between two districts, as the Bumble matter would remain in the Western District of Texas. Pet. App. 44a-45a.

The district court next found that public interest factors did not favor transfer. Administratively, it would be better for the matter to proceed in whole in the Western District of Texas because it is less

congested than the Northern District of California. Pet. App. 47a. And the other public interest factors were neutral. Pet. App. 48a-49a. Thus, Samsung and LG had not met their "'heavy burden' to demonstrate that the Northern District of California is 'clearly more convenient.'" Pet. App. 50a. The Court subsequently denied Uber's motion for similar reasons. Pet. App. 99a.

E. The district court holds *Markman* hearings for Samsung, LG, Lyft, and Bumble and issues its *Markman* orders.

Exactly a month later, on April 1, 2021, the district court held a joint *Markman* hearing for Samsung, LG, Lyft, and Bumble. Samsung Appx. 10-11; LG Appx. 12; *Lyft* Dkt. 71; *Bumble* Dkt. 61. Samsung and LG had not notified the court or Ikorongo of any intent to file a petition for a writ of mandamus regarding transfer, nor had they requested that the court delay the *Markman* hearing.

F. Samsung and LG file their writ petitions raising new arguments over a month after the district court denied transfer, but shortly after the district court issued its *Markman* order.

A week after receiving the district court's *Markman* order, Samsung and LG filed nearly identical petitions for writs of mandamus. The Federal Circuit granted the petitions.[1] On the threshold requirement that the claims "might have

[1] Uber filed its petition shortly after Samsung and LG, Pet. App. 22a, and the panel granted its petition based on the reasoning expressed in its order on Samsung and LG's petitions, Pet. App. 22a-23a.

been brought" in the Northern District of California, the panel acknowledged that the geographic assignment of rights, if respected, would render venue in the Northern District of California improper. Pet. App. 11a. But the court ruled it was "not bound by a plaintiff's efforts to manipulate venue." *Id.*

Instead, the court ruled—admitting reliance on cases interpreting the discretionary part of the venue statute and *not* the mandatory threshold requirement—that the district court *is bound* to ignore the geographic assignment of rights here, regardless of its real legal consequences. Pet. App. 13a. In the process, the court relied on a factual error *no one* asserted—that ownership of Ikorongo Technology and Ikorongo Texas are identical. Pet. App. 14a. They are not. The court then incorrectly stated that "Ikorongo Texas is plainly recent, ephemeral, and artificial" without record evidence to support anything other than its recency. Pet. App. 15a.

The Federal Circuit also ruled the district court clearly erred by finding Samsung and LG had not met their burdens of proving the Northern District of California was clearly more convenient. The court started by deciding that the "district court here clearly assigned too little weight to the relative convenience of the Northern District of California." Pet. App. 16a. It gave no weight to the *absolute* convenience—the fact that neither venue, nor any other, was particularly convenient nor inconvenient given the inventors and parties were spread all over the country, and the infringement was not focused in the Northern District of California. The court also did not defer to the district court's finding—based on its experience trying patent cases—that few, if any, of the

"over a dozen third-party individuals with relevant and material information" living in the Northern California would actually testify at trial. Pet. App. 16a.

The Federal Circuit then found the district court "overstated" the inefficiencies of breaking up the litigation over these patents because, according to the Federal Circuit's speculation, there would be little overlap in the action brought against Bumble. The court's speculation failed to acknowledge that Bumble identified the same prior art defense, which would require several of the same witnesses. It relied on the fact that Bumble is a different application from Samsung's and LG's applications but offered no reason the difference in the application would result in any significantly greater difference in litigation than the differences among Samsung, LG, and Uber's applications. The court did not further address the private interest factors, and it found the public interest factors favored transfer based on "record evidence" purportedly showing a substantial *public* interest because some third-party witnesses reside in the Northern District of California. Pet. App. 17a. The Federal Circuit gave no reason why members of the public in Northern California would care even the slightest about whether Samsung and LG were found liable for infringing the patents.

Ikorongo then filed petitions for rehearing *en banc*, which the court denied. App. 100a-103a.

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit's disregard for a mandatory venue rule presents an issue of exceptional importance calling for an exercise of this Court's supervisory authority.

The Federal Circuit (1) stated that the facts here are like the facts in a case decided by this Court, *Miller & Lux, Inc.* v. *East Side Canal & Irrigation Co.*, 211 U.S. 293, 304 (1908), (2) acknowledged that the Court relied on a statutory mandate in *Miller & Lux*, (3) acknowledged the statutory mandate does not apply here, (4) recognized there is no statutory mandate for that conduct under the facts here, (5) and did what the Court did in *Miller & Lux* anyway. Pet. App. 14a ("This case is quite similar to *Miller & Lux*, a jurisdiction case arising under the version of 28 U.S.C. § 1359 then in force."). This usurpation of Congress's authority has become all-too-common, and this Court's intervention is needed *again* to rein in the Federal Circuit's overreach.

The Federal Circuit's mandate that district courts disregard statutory requirements for determining appropriate venue warrants exercise of this Court's supervisory authority to correct a conflict with the Court's precedent. The district court's interpretation of 28 U.S.C. §§ 1404(a) and 1400(b) was reasonable and correct. The Northern District of California is not an allowable venue. Under 28 U.S.C. § 1404(a), "for 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." A case "might have been brought" in a district only if federal

jurisdiction and venue statutes would have allowed the complaint to have been filed there. *Hoffman* v. *Blaski*, 363 U.S. 335, 342-43 (1960).

There is no dispute here that 28 U.S.C. § 1400(b) governs venue for this suit. It provides that "[a]ny civil action for patent infringement may be brought in the judicial district where the defendant resides or where the defendant has committed acts of infringement and has a regular and established place of business." 28 U.S.C. § 1400(b). The meaning is plain on its face, as the Federal Circuit acknowledged. Considering the section providing the venue requirement for "[a]ny civil action for patent infringement" and the provision's discussion later in the sentence of places "where the defendant has committed acts of infringement," the section necessarily refers to infringement for which the civil action was brought. So a plaintiff with geographically limited rights can only bring a suit for infringement that occurs within that geographic area. *The Federal Circuit agreed on the law*. Pet. App. 9a-10a.

The complaints here assert infringement of Ikorongo Texas's patent rights only in the place Ikorongo Texas has any patent rights to enforce—Texas, and they allege that Samsung resides in New York, LG resides in Delaware, and Uber resides in New Jersey. Samsung Appx. 12; LG Appx. 13. Thus, under Section 1400(b)'s plain language, Samsung could be sued in New York, LG could be sued in Delaware, Uber could be sued in New Jersey, and any of them could be sued in Texas *if* they had "established place[s] of business" there. Both do. *Id*. By statute, no other judicial district could have been a proper venue. *The Federal Circuit agreed on the facts*—it acknowledged that, as pleaded, the case cannot be

transferred to the Northern District of California. Pet. App. 8a-9a.

But the Federal Circuit ruled, based on inapplicable case law, that the district court *must disregard* the fact that Ikorongo Texas has limited rights. The panel acknowledged that the cases it relied on "involved 'the convenience of the parties and witnesses, in the interest of justice' factor," and not "the *requirement* that an action 'might have been brought' in the transferee district." Pet. App. 13a-14a (emphasis added). Without any explanation, the court asserted that these cases about the discretionary part of the statute are "no less applicable" to the *mandatory* part of the statute. *Id*. Of course they are less applicable. They are *in*applicable. *E.g. BP P.L.C.* v. *Mayor of Balt.*, 141 S. Ct. 1532, 1541 (2021) ("the fact that this Court deemed certain orders appealable under the statute's first clause simply does not settle, one way or another, the scope of appellate review under the statute's second clause"). "[T]ransfer may be ordered (1) '[f]or the convenience of parties and witnesses, in the interest of justice,' but only (2) 'to any other district or division where it might have been brought.' In making determination (1) the district court is vested with a large discretion. In making determination (2) the district court has a much narrower discretion, if indeed any exists." *Solomon* v. *Continental Am. Life Ins. Co.*, 472 F.2d 1043, 1045 (3d Cir. 1973).

Courts cannot ignore statutory mandates and create extra-textual exceptions. *See*, *e.g.*, *Ross* v. *Blake*, 136 S. Ct. 1850, 1856-57 (2016) (rejecting Fourth Circuit's "special circumstances" exception to PLRA exhaustion requirement); *see also Rotkiske* v. *Klemm*, 140 S. Ct. 355, 361 (2019) ("It is not our role to

second guess Congress' decision to include a 'violation occurs' provision, rather than a discovery provision, in §1692k(d).''). Congress—not the courts—determines the allowable venues for federal actions. And "by making it explicit in § 1404(a) that the transfer could only be made to a district or division where the action could have been brought, Congress made clear its intention not to confer on the transferor district court a power to . . . disregard other statutory venue requirements." *Solomon*, 472 F.3d at 1045.

Moreover, this Court stressed the importance of following the patent venue statutory language at issue in this case to its formal end, regardless of alternate considerations, in *TC Heartland* v. *Kraft Foods Group Brands, LLC*. 137 S. Ct. 1514, 1518 (2017). And it eschewed policy considerations of judicial efficiency and party maneuvering in favor of applying the statute as written in *Holmes Grp., Inc.* v. *Vornado Air Circulation Sys.*, 535 U.S. 826, 833 (2002) ("Our task here is not to determine what would further Congress's goal of ensuring patent-law uniformity, but to determine what the words of the statute must fairly be understood to mean.") and *Christianson* v. *Colt Indus. Operating Corp.*, 486 U.S. 800, 813-14 (1988) (Congress determined the relevant focus, however, when it granted jurisdiction to the Federal Circuit over 'an appeal from . . . a district court . . . if the jurisdiction of that court was based . . . on section 1338.'"). The Court provided further examples of applying the statute as written rather than imposing its own policy views last term. *E.g. HollyFrontier Cheyenne Ref., LLC* v. *Renewable Fuels Ass'n*, 141 S. Ct. 2172 (2021) ("our analysis only can be guided by the statute's text"); *BP*, 141 S. Ct. at 1541 ("As this Court has explained, 'even the most

formidable' policy arguments cannot 'overcome' a clear statutory directive.").

Meanwhile, the Federal Circuit here applied its own policy decision that blocking perceived "venue manipulation" has greater societal value than predictable and unambiguous statutorily prescribed venue requirements. This weighing of interests and policy concerns is a classic legislative, not judicial, function. The public holds elected officials accountable for decisions it disagrees with by its vote, but it has no such recourse for decisions by the judiciary. It is telling that the Federal Circuit asserts it is "not bound by a plaintiff's efforts to manipulate venue" and yet neither party nor the panel cited a single case where this Court, the Fifth Circuit, or the Federal Circuit ruled that a case can be transferred to a district where the filing plaintiff was barred by statute from bringing the action.

Indeed, the cases the Federal Circuit relies on offer no support for the proposition that a court can override a congressional venue mandate when it does not like the facts. Quite the contrary, this Court stated in *Miller & Lux,* 211 U.S. at 304: "We do not intend by what has been said to qualify the general rule, long established, that the jurisdiction of a Circuit Court, when based on diverse citizenship, cannot be questioned upon the ground merely that a party's motive in acquiring citizenship in the State in which he sues was to invoke the jurisdiction of a Federal court." But, as the Federal Circuit noted, 28 U.S.C. § 1359 provides a statutory requirement for courts to disregard certain arrangements to affect jurisdiction. This Court relied on the statute or its predecessor in *Miller & Lux*, 211 U.S. at 296-97, *Hertz Corp.* v.

Friend, 559 U.S. 77, 91 (2010), and other cases cited by the Federal Circuit here.

Section 1359's existence undermines the Federal Circuit's decision. It is expressly limited to invocation of jurisdiction, not limitation of venue. 28 U.S.C. § 1359. Yet the Federal Circuit divined a similar authority with respect to venue that the court admits does not exist in statute. Pet. App. 11a. But if Congress wants to apply a similar rule to venue decisions, Congress can legislate to that end. It has not. There are myriad reasons it may have chosen not to enact a concomitant venue rule, since there are strong constitutional and policy interests in limited subject matter jurisdiction of federal courts, but no constitutional interest and only questionable policy interests in expanding the power for defendants to dictate venue. Indeed, it runs contrary to the basic principle of a plaintiff being the master of its complaint.

Given "there is not an analogous statute for venue," Pet. App. 12a, a court's power to disregard plaintiffs' actions in pursuit of a venue where it might have its claims heard in a reasonable amount of time is limited to actions that affect discretionary aspects of the court's analysis. Thus, in *Van Dusen* v. *Barrack*, 376 U.S. 612, 622, (1964) this Court disregarded a state law impediment to transfer, but it "noted that the instant case, unlike *Hoffman*, involves a motion to transfer to a district in which both venue and jurisdiction are proper." Here, the district court was correct not to tread upon Congress's territory and properly respect the separation of powers. The Federal Circuit did the opposite. It ironically usurped its own authority while asserting the district court had done so in issuing its writs of mandamus. Thus,

this Court should grant the petition and vacate the Federal Circuit's order requiring the district court to transfer cases to a statutorily improper venue.

II. The Court should revisit *Gulf Oil Corporation* v. *Gilbert* and provide a standard for determining when the convenience of parties and witnesses warrants transfer based on current technological capabilities.

The Court also should grant the petition to provide guidance on the proper weighing of convenience factors in light of new technological advances in the 75 years since the Court laid out its analysis in *Gulf Oil Corporation* v. *Gilbert*, 330 U.S. 501 (1946). There, the Court observed that some plaintiffs chose particular forums to harass defendants, "resort[ing] to a strategy of forcing the trial at the most inconvenient place for an adversary, even at some inconvenience to himself." *Id*. at 507. Now, as here, many defendants have turned the tables, taking advantage of the outdated *Gulf Oil* factors to vexatiously force transfer to forums that will bog litigation down on bloated calendars.

In *Gulf Oil*, the Court provided factors for balancing the litigants' interests to determine whether dismissal under the *forum non conveniens* doctrine was appropriate. *Id* at 508. The "private interest" factors included: "the relative ease of access to sources of proof; availability of compulsory process for attendance of unwilling, and the cost of obtaining the attendance of willing, witnesses; possibility of view of premises, if view would be appropriate to the action; and all other practical problems that make trial of a case easy, expeditious and inexpensive." *Id*. The Court explained that "unless the balance [of

conveniences] is strongly in favor of the defendant, the plaintiff's choice of forum should rarely be disturbed." *Id*. at 508.

According to the Court, district courts also should consider the public interest because "[a]dministrative difficulties follow for courts when litigation is piled up in congested centers instead of being handled at its origin." *Id*. Further, the Court stated jury duty should not burden communities with no connection to the litigation. *Id*. at 508-09. Also, "[i]n cases which touch the affairs of many persons, there is reason for holding the trial in their view and reach rather than in remote parts of the country where they can learn of it by report only." *Id*. And "[t]here is a local interest in having localized controversies decided at home" with "an appropriateness, too, in having the trial of a diversity case in a forum that is at home with the state law that must govern the case."

The Court also noted states had promulgated transfer powers for their courts and observed that Congress had not done so. *Id*. Congress did not wait long after to remedy that. It enacted Section 1404(a) soon thereafter, and district courts could then transfer cases among each other. *Norwood* v. *Kirkpatrick*, 349 U.S. 29, 31-32 (1955). Section 1404(a) codified the *forum non conveniens* doctrine in the federal courts but also "intended to permit courts to grant transfers upon a lesser showing of inconvenience" than the extremely high bar required for dismissal under common law *forum non conveniens*. *Id*. at 32.

Even though Section 1404(a) lowered the bar, most circuits still recognized *Gulf Oil* as good law on the factors courts must consider when balancing the interests of the parties and witnesses. They still

placed a heavy burden (though no longer an extremely high bar) on defendants who wished to undo the plaintiff's choice of forum, and they adopted *Gulf Oil*'s public and private interest factors with small variations, unlike the "least inconvenient forum" standard the Federal Circuit apparently applies.[2]

One of *Gulf Oil*'s important underpinnings that courts—particularly the Federal Circuit—appear to have lost sight of, though: there must be some base significant inconvenience to a party to warrant transfer. 330 U.S. at 507. Section 1404(a) is not a search for the most convenient forum for the defendant—it is a remedy for when the plaintiff vexatiously chooses a forum that would cause undue hardship to the defendants. *Id*. Simply weighing one forum against another defeats the purpose of Section 1404 by allowing defendants to abusively move a case to a forum that is inconvenient for the plaintiff. This case presents a robust example. Only one of six key witness inventors will be subject to compulsory process in the Northern District of California at the time of trial, while none will be subject to compulsory process in the Western District of Texas. Pet. App.

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[2] See, e.g. *D.H. Blair & Co. v. Gottdiener*, 462 F.3d 95, 106 (2d Cir. 2006) (applying a version of the *Gulf Oil* factors); *Jumara v. State Farm Ins. Co.*, 55 F.3d 873, 879 (3d Cir. 1995) (same); *Trs. of the Plumbers & Pipefitters Nat'l Pension Fund v. Plumbing Servs.*, 791 F.3d 436, 444 (4th Cir. 2015) (same); *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (same); *Chi., R. I. & P. R. Co. v. Igoe*, 220 F.2d 299, 302 (7th Cir. 1955) (same); *Terra Int'l v. Miss. Chem. Corp.*, 119 F.3d 688, 696 (8th Cir. 1997) (same); *Jones v. GNC Franchising, Inc.*, 211 F.3d 495, 498 (9th Cir. 2000) (same); *Emplrs Mut. Cas. Co. v. Bartile Roofs, Inc.*, 618 F.3d 1153, 1167 (10th Cir. 2010) (same); *Manuel v. Convergys Corp.*, 430 F.3d 1132, 1135 n.1 (11th Cir. 2005) (same).

38a-40a. The Federal Circuit ignored that the five other witnesses are located closer to the Western District of Texas and will not be subject to compulsory process in either district, even though that establishes that either court will have to find alternatives if witnesses are unwilling to testify (all had committed to testifying voluntarily, though). *Id.*

Much has changed since *Gulf Oil*. More than eight years ago—the year Zoom first launched its software that is now ubiquitous—the Seventh Circuit observed that "in our age of advanced electronic communication, including high-quality video conferencing, changes of venue motivated by concerns with travel inconvenience should be fewer than in the past." *In re Hudson*, 710 F.3d 716, 719 (7th Cir. 2013) (deferring to district court's decision to transfer case by denying writ of mandamus and noting that "the plaintiff [did] not argue that the electronic revolution has erased the advantages that the Kansas venue would once undoubtedly have had under the facts of this case"). In 2013, "documents [could] be scanned and transmitted by email; witnesses [could] be deposed, examined, and cross-examined remotely and their videotaped testimony shown at trial." *Id.* Now, as in this case, most documents never exist in paper form and never need to be scanned. They are in the cloud, and they are as easily accessible in the Western District of Texas as they are in the Northern District of California. Witnesses can seamlessly appear live at trial remotely. And even whole civil trials can be held without setting foot in the courtroom. The time has come to update the analysis for when transfer is appropriate "for the convenience of witnesses or parties, or in the interests of justice."

Almost all of the private and public factors discussed by the Court in *Gulf Oil* are affected by the march of technology.

Private factors:

1. Relative ease of access to sources of proof—in cases where the proof almost all lies in electronic documents, this factor essentially is meaningless from a convenience standpoint. Documents existing in the cloud can be accessed from anywhere in the United States. Nonetheless, the Fifth Circuit, and by extension, the Federal Circuit in cases like this one, requires the district courts to engage in the kabuki of pretending documents are accessible only where they were created. App. 37a-38a n.2.

2. Availability of compulsory process for attendance of unwilling witnesses. Depositions can be recorded and played to juries, and witnesses now can appear remotely, subject to compulsory process from their home courts. Unless there is some indication that using a videotaped deposition or remote testimony would be particularly onerous or unjust, this factor should not be relevant to transfer. Particularly in a case where five of the six key witnesses are outside the subpoena power of the court, and all six key witnesses expressed they would attend trial voluntarily, it should have no weight that one court will have the power to subpoena one of the six witnesses.

3. Cost of obtaining willing witnesses. Similar to compulsory process, now there are many inexpensive alternatives to transporting witnesses. In any event, many cases, like this one, are national in scope and have key witnesses all over the country, rendering no one venue particularly convenient nor *in*convenient.

4. Possibility of view of premises, if relevant. In the rare case involving physical evidence on particular premises, like *Gulf Oil*, this factor may remain valuable. But given existing video technology, it, too should perhaps be revisited.

5. All other practical problems that make trial of a case easy, expeditious and inexpensive. This, of course, remains viable and is dependent on case specifics. Here, for instance, Ikorongo entered ample evidence that trial in the Western District of Texas would be more expedient and less expensive than trial in the Northern District of California. Nonetheless, the Federal Circuit addressed *none* of it as it re-weighed the interest factors with no deference to the district court. Pet. App. 17a.

Public factors:

1. Administrative difficulties from congested dockets. In light of new technologies but bloated district court dockets, this factor likely should *gain* weight. Defendants' ability to force litigation to district courts that cannot try a case for two years at best is its own form of venue abuse and vexatious venue choice to inconvenience the opponent.

2. Which community should bear the burden of jury duty. Now, so much litigation involves issues that are national in scope—particularly patent cases, that there is no issue of fairness with respect to whose citizens should engage in jury duty.

3 & 4. Two factors, (1) holding the trial in view of non-parties whose affairs are at issue so that they are not limited to learning of the trial "by report only," and (2) the "local interest in having localized controversies decided at home," have been folded by

lower courts into a community interest prong that ignores the key aspect that the local interest is triggered by a "localized controvers[y]." The mere fact that a defendant has more people in one location rather than another should be irrelevant to this "public" interest factor. And given attending court and trials is no longer the community activity it once was, there should be some evidence of actual local interest required for these factors to be relevant.

Here, there is no evidence—and no reason to speculate—that the Northern California community is rushing to the courthouse to watch patent litigation between Ikorongo and Samsung, LG, and Uber. If the controversy is national and not localized, like the patent case here, courts should not consider these factors. The district court here correctly noted that "it is generally a fiction that patent cases give rise to local controversy or interest," but the Federal Circuit found a local *public* interest based on the fact that *private* interests (non-party developers of applications) existed in Northern California. This misunderstanding of the localized controversy public interest factor should be corrected. This is not *Scopes* v. *Tennessee*, 154 Tenn. 105 (1927), and there is no sign that there are any particularly interested members of the public, or even third-party developers, who want to attend trial. The Federal Circuit's analysis was entirely speculative.

5. Having a local court decide issues of home state law. This factor has correctly been found irrelevant in patent cases because federal law governs the suit. But in cases where potential transfer involves the relevant choice of law, this factor should have lasting power to place matters in courts that have dealt with the

nuance of particular states' laws that are relevant to the matter before the court.

In addition to deemphasizing or eliminating some *Gulf Oil* factors, the Court should consider and introduce new factors that are more relevant to the convenience of the parties and witnesses in the modern age. For instance:

1. Consolidation of litigation should be a significant interest that helps determine whether transfer is appropriate. Here, litigation on two of the four patents against Bumble still will go forward in the Western District of Texas. Courts constantly and appropriately ask litigants whether there is related litigation to promote efficiency and fairness. Here, the cases clearly are related. For example, the parties agreed to consolidate the schedules through *Markman* hearings and presumably would have coordinated discovery. Avoiding break-up of related litigation is integral to making a matter most convenient for parties and witnesses in general, and the Western District of Texas indisputably moves on a much faster schedule than the Northern District of California. App 47a-48a. Each party witness and third-party witness the Federal Circuit purported to protect now must deal with two different discovery schedules, and there will be no benefit of consolidation.

2. Relatedly, courts should consider the risk of inconsistent rulings with dividing litigation. In the patent context, dividing the litigation often creates a risk of different *Markman* rulings construing the same patent in the same type of litigation in different ways. The same is true in myriad contexts, from privilege issues in discovery to determinations regarding design defects and failures to warn.

Consistency in rulings is an important benefit from consolidated litigation.

3. Additionally, the private convenience factors should consider the speed at which a court is capable of resolving the case. The Federal Circuit expressly rejected this rationale. Pet. App. 17. But except to the extent a party wishes to use delay as a vexatious litigation tactic, it is far more convenient for parties to litigation to reach resolution as soon as possible so they can order their affairs. At the very least, a court should consider a plaintiff's desire to choose a forum that can vindicate its rights sooner, rather than languish on a bloated docket. Litigation is inherently inconvenient, and extending litigation by transferring it to a bogged down court that cannot keep the case moving only exacerbates the inconvenience on everyone.

Seventy-five years after *Gulf Oil*, it is time to re-examine what factors should be considered for the convenience of the parties and the witnesses and the interests of justice in transferring a case away from the plaintiff's chosen forum, and the weight each factor should be given. This case presents the perfect example of how the existing guidance from this Court is outdated and encourages abuse by forcing litigation to an obviously *in*convenient forum.

CONCLUSION

For the foregoing reasons, the petition should be granted, the order below should be vacated, and the case should be remanded for further proceedings.

Respectfully submitted,

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