APPENDIX

APPENDIX A

United States Court of Appeals for the Federal Circuit

IN RE: SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., LG ELECTRONICS INC., LG ELECTRONICS USA, INC.,

Petitioners

2021-139, 2021-140

On Petitions for Writs of Mandamus to the United States District Court for the Western District of Texas in Nos. 6:20-cv-00257-ADA, 6:20-cv-00259-ADA, Judge Alan D. Albright.

ON PETITION

BRADLEY GARCIA, O'Melveny & Myers LLP, Washing- ton, DC, for petitioners. Also represented by DAVID ALMELING, DANIEL SILVERMAN, DARIN W. SNYDER, San Francisco, CA; NICHOLAS WHILT, Los Angeles, CA.

KARL RUPP, Nix Patterson, LLP, Dallas, TX, for respondents Ikorongo Texas LLC, Ikorongo Technology LLC. Also represented by DEREK TOD GILLILAND, Sorey Law Firm, Longview, TX; HOWARD N. WISNIA, Wisnia PC, San Diego, CA.

JOSHUA S. LANDAU, Computer & Communications Industry Association, Washington, DC, for amicus curiae Computer & Communications Industry Association.

Before LOURIE, DYK, and REYNA, *Circuit Judges*. DYK, *Circuit Judge*.

ORDER

In these patent infringement suits, which have been consolidated for purposes of these mandamus petitions, Samsung Electronics Co., Ltd. et al. (collectively, "Samsung") and LG Electronics Inc. et al. (collectively, "LG") seek writs of mandamus ordering the United States District Court for the Western District of Texas to transfer the underlying actions to the United States District Court for the Northern District of California. For the following reasons, we grant the writs of mandamus.

BACKGROUND

A.

Ikorongo Texas LLC ("Ikorongo Texas") filed the initial complaints in these cases against Samsung and LG in the Western District of Texas on March 31, 2020—a month after Ikorongo Texas was formed as a Texas limited liability company. Although Ikorongo Texas claims to be unrelated to Ikorongo Technology LLC ("Ikorongo Tech"), a North Carolina limited liability company, the operative complaints indicate that Ikorongo Texas and Ikorongo Tech are run out of the same Chapel Hill, North Carolina office. Additionally, as of March 20, 2020, the same five individuals "own[ed] all of the issued and outstanding

membership interests" in both Ikorongo entities. Assignments of Patent Rights at 4, *Ikorongo Texas LLC v. LG Elecs. Inc.*, No. 6:20-cv-00257-ADA (W.D. Tex. Jan. 5, 2021), ECF Nos. 57-4, 57-5 (exhibits to Ikorongo entities' brief in opposition to LG's motion to transfer).

Ikorongo Tech owns the four patents that are asserted in the suits. Approximately ten days before the initial complaints were filed in these cases, Ikorongo Tech assigned to Ikorongo Texas exclusive rights to sue for infringement and collect past and future damages for those patents within certain specified parts of the state of Texas, including certain counties in the Western District of Texas, while retaining the rights to the patents in the rest of country.

The day after the initial complaints were filed, Ikorongo Texas and Ikorongo Tech filed first amended complaints, this time naming both Ikorongo Tech and Ikorongo Texas as co-plaintiffs, noting that "[t]ogether Ikorongo TX and Ikorongo Tech own the entire right, title and interest in the Asserted Patents, including the right to sue for past, present and future infringement and damages thereof, throughout the entire United States and world."

The amended complaints assert generally that Samsung and LG had infringed at least one claim of the asserted patents by making, using, testing, selling, offering for sale, or importing into the United States devices that perform certain functionality. The complaints do not distinguish between infringement in the Western District of Texas and infringement elsewhere in the United States. It appears undisputed

that Ikorongo Texas and Ikorongo Tech's infringement contentions are directed at functionality in third-party applications (Google Maps, Google+, Google Play Music, YouTube Music, and AT&T Secure Family) that run on the accused mobile products sold by Samsung and LG.

B.

In September 2020, Samsung and LG separately moved under 28 U.S.C. § 1404(a) to transfer the suits to the Northern District of California. They argued that three of the five accused third-party applications were developed in Northern California where those third parties conduct significant business activities and that no application was developed or researched in Western Texas. Samsung and LG further argued that potential witnesses and sources of proof were in the Northern District of California, including two of the named inventors, and that no source of proof or potential witness was in the Western District of Texas.

On March 1, 2021, the district court denied LG's and Samsung's motions. The court first concluded that LG and Samsung failed to establish the threshold requirement that the complaints "might have been brought" in the Northern District of California. § 1404(a). The court acknowledged that there was no dispute that the defendants would be subject to venue in the Northern District of California based on Ikorongo Tech's allegations. However, because Ikorongo Texas's rights under the asserted patents could not have been infringed in the Northern District of California, the court held that venue over the

entirety of the actions was improper under 28 U.S.C. § 1400(b).

Alternatively, the court analyzed the traditional public- and private-interest factors. As to the private-interest factors, the district court acknowledged that "the location of the documents relevant in [these] case[s] tilts [the sources of proof] factor towards transfer," citing LG and Samsung's argument that "the greatest volume of evidence is with key third parties located in the Northern District of California," including "technical documents and source code," and that Ikorongo Texas and Ikorongo Tech failed to identify any sources of proof in the Western District of Texas.

With regard to potential witnesses, the district court noted that Samsung and LG had identified potential witnesses in Northern California and no potential witness in or near the Western District of Texas. However, the district court weighed the willing witness factor "only very slightly in favor of transfer" and the compulsory process factor "neutral." The court explained that it "gives the convenience of party witnesses little weight" generally. And while recognizing that "the Northern District of California is the more convenient forum for a high percentage" of third-party employees "who may be relevant witnesses," the court stated generally its view that "only a few party witnesses and even fewer non-party witnesses will likely testify at trial," and weighed against transfer plaintiffs' willingness to cover the expenses of third parties.

As to the local interest factor, the district court noted and rejected Samsung and LG's argument that

the Northern District of California had a greater local interest in this case because the third-party applications were developed there, at least LG integrated the accused applications in the proposed transferee district, and no party had any meaningful connection to the Western District of Texas. The district court explained that "it is generally a fiction that patent cases give rise to local controversy or interest" and "Ikorongo Texas's claims do specifically relate to infringement in this District."

The district court weighed the "practical problems" factor against transfer. The court noted that Ikorongo Texas and Ikorongo Tech had separately filed suit against Bumble Trading, LLC in the Western District of Texas "for infringing on patents asserted in this action, and Bumble withdrew its motion to transfer." The court explained that "judicial economy and the possibility of inconsistent rulings causes the Court to find this factor weighs against transfer, given that at least one of the co-pending cases will remain in this District." In addition, the court added that it could likely hold a trial sooner than the Northern District of California, citing in part its patent-specific Order Governing Proceedings that "ensures efficient administration[.]" The court therefore concluded that defendants had not met their burden to demonstrate cause for transfer.

These petitions followed, which were consolidated in our court, and raise the same two challenges: First, whether the district court erred in concluding that venue in the Northern District of California under § 1400(b) is improper; and second, whether the district court clearly erred in its assessment of the traditional

transfer factors and in its ultimate conclusion that the transferee venue was not clearly more convenient for trial.

DISCUSSION

We "may issue all writs necessary or appropriate in aid of [our] jurisdiction[] and agreeable to the usages and principles of law" under the All Writs Act. 28 U.S.C. § 1651(a). Three conditions must be met before a writ may issue: (1) the petitioner "[must] have no other adequate means to attain . . . relief," (2) the petitioner must show that the right to mandamus is "clear and indisputable," and (3) the court "must be satisfied that the writ is appropriate under the circumstances." *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380–81 (2004) (first alteration in original) (internal quotation marks and citations omitted).

We apply the law of the regional circuit—in this case the Fifth Circuit—in mandamus review of a district court's ruling on a motion to transfer pursuant to § 1404(a). *In re Apple, Inc.*, 979 F.3d 1332, 1336 (Fed. Cir. 2020) (citing *In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014)). We thus review a district court's decision to deny transfer for an abuse of discretion. *See In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008) (applying Fifth Circuit law). "A district court would necessarily abuse its discretion if it based its ruling on an erroneous view of the law or on a clearly erroneous assessment of the evidence." *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 405 (1990). Errors of judgment in weighing relevant factors are also a ground for finding an abuse of discretion. *See TS Tech*, 551 F.3d at 1320. We may grant mandamus when the denial of transfer was a

clear abuse of discretion under governing legal standards. *See In re Genentech, Inc.*, 566 F.3d 1338, 1348 (Fed. Cir. 2009) (also applying Fifth Circuit law); *TS Tech*, 551 F.3d at 1318–19.

A.

Under § 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." A case may be transferred under § 1404(a) only to a court that has venue over the civil action. *See In re SK hynix Inc.*, 847 F. App'x 847 (Fed. Cir. 2021). Whether the two cases could be transferred under § 1404(a) turns on whether venue in the Northern District of California would have been proper under § 1400(b) had these cases been filed in that district. That statutory provision provides, in relevant part, that "[a]ny civil action for patent infringement may be brought . . . where the defendant has committed acts of infringement and has a regular and established place of business."[1]

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[1] There is no dispute here that the "established place of business" requirement is satisfied in both cases. LG Electronics U.S.A, Inc. has offices in Santa Clara and San Francisco, California, where it has about 120 employees. Samsung Electronics America, Inc. has offices in the Northern District of California from which more than 300 employees work. And Samsung Electronics Co., Ltd., and LG Electronics Inc. are also subject to venue in Northern California given their status as foreign corporations. *See In re HTC Corp.*, 889 F.3d 1349, 1359 (Fed. Cir. 2018) (foreign corporations are subject to venue in any district).

As an initial matter, we reject Ikorongo Texas and Ikorongo Tech's argument that the initial complaint filed only by Ikorongo Texas governs this inquiry. Once the respondents filed their amended complaints, the original complaints were "dead letter[s]" and "no longer perform[ed] any function in the case[s]." *ConnectU LLC v. Zuckerberg*, 522 F.3d 82, 91 (1st Cir. 2008) (internal quotation marks and citations omitted). That understanding has been uniformly applied in a variety of contexts, including for purposes of venue. *See, e.g.*, *Eason v. Holt*, 73 F.3d 600, 603 (5th Cir. 1996) ("The amended complaint . . . supersede[s] the original complaint[.]"); *Fawzy v. Wauquiez Boats SNC*, 873 F.3d 451, 455 (4th Cir. 2017); *Fullerton v. Maynard,* 943 F.2d 57, 1991 WL 166400, at *2 (10th Cir. Aug. 29, 1991) ("Because the amended complaint supersedes the original complaint, proper venue . . . must be established from facts alleged in the amended complaint.").

Contrary to Ikorongo Texas and Ikorongo Tech's contention, *Hoffman v. Blaski*, 363 U.S. 335 (1960), does not support a different rule for transfer under § 1404(a). *Hoffman* indicated that the "where it might have been brought" language of § 1404(a) "directs the attention of the judge who is considering a transfer to the situation which existed when suit was instituted," but it did so in the context of holding a defendant could not expand jurisdiction through acts of waiver. *Id.* at 343 (internal quotation marks and citation omitted). The Court interpreted the statute to bar a defendant from creating venue in a new district "between the bringing of the action and the filing of a motion to transfer it"—for example, by moving residence or beginning to transact business. *Id.* at 342. *Hoffman*

did not involve the circumstances here, and did not involve or address the filing of an amended complaint. We are unaware of any instance, and none has been called to our attention, in which a court has denied transfer based on the original complaint despite an amended complaint establishing proper venue.

We therefore look to the amended complaints to determine whether venue would have been proper had these suits initially been filed in Northern California. Although the district court correctly focused on those complaints, it erred when analyzing whether venue was proper.

The district court reasoned that the plaintiffs' agreement "allows Ikorongo Texas to protect its rights to the patent within the prescribed geographic region," including the right to sue for infringement. The district court further explained that the proper inquiry was "where [defendants] committed any alleged acts of infringement as to Ikorongo Texas," because "[a]ny alleged infringement by Samsung [and LG] could have only occurred within the geographic locations described in the specialized part." Because "Ikorongo Texas's current action could [not] have initially been brought in the Northern District of California," the court found that the transfer motions had to be denied. This conclusion was erroneous because the district court disregarded the pre-litigation acts by Ikorongo Tech and Ikorongo Texas aimed at manipulating venue.

Typically, "venue must be proper for each claim," *Beattie v. United States*, 756 F.2d 91, 101 (D.C. Cir. 1984) (citing 15 Charles Alan Wright, Alan R. Miller & Edward H. Cooper, Federal Practice and Procedure

§ 3808 (1976)). On the face of the complaint, the Northern District of California could not be a proper venue for Ikorongo Texas's claims because no act of infringement of Ikorongo Texas's rights took place there. But in ascertaining proper venue, we are not bound by a plaintiff's efforts to manipulate venue.

In the context of jurisdiction, 28 U.S.C. § 1359 provides: "A district court shall not have jurisdiction of a civil action in which any party, by assignment or otherwise, has been improperly or collusively made or joined to invoke the jurisdiction of such court." Under this statute (and its predecessors), in cases similar to this one, the Supreme Court and other courts have rejected litigants' attempts to manipulate jurisdiction, disregarding property transfers among entities under common ownership designed to create jurisdiction. *See, e.g.*, *Hertz Corp. v. Friend*, 559 U.S. 77, 97 (2010) (urging courts to disregard a party's "attempts at manipulation" of jurisdiction); *Kramer v. Caribbean Mills, Inc.*, 394 U.S. 823, 824, 827–28 (1969) (rejecting diversity jurisdiction predicated on a pretextual, collusive transfer of an agreement, because the transferee had been previously unconnected to the matter and simultaneously reassigned 95% of his interest in the cause of action back to the transferor); *Miller & Lux, Inc. v. E. Side Canal & Irrigation Co.*, 211 U.S. 293, 305–06 (1908) (holding that a California corporation could not "collusively" create federal diversity jurisdiction by forming a new Nevada corporation and transferring thereto the property at issue in the litigation); *Lehigh Mining & Mfg. Co. v. Kelly*, 160 U.S. 327, 339–40 (1895) (holding that a Virginia corporation could not create diversity jurisdiction by organizing a Pennsylvania corporation

for no other purpose than to receive the lands at issue and create a federal case); *McSparran v. Weist*, 402 F.2d 867, 875–76 (3d Cir. 1968) (en banc) (expounding plaintiff's burden to demonstrate that a transaction purportedly creating diversity jurisdiction is "real," with "significance beyond establishment of diversity jurisdiction"); *Greater Dev. Co. of Conn., Inc. v. Amelung*, 471 F.2d 338, 339 (1st Cir. 1973) (limiting diversity jurisdiction based on a transfer of corporate citizenship to cases in which "a corporation conducting an on-going business transfers all its assets and its business to another corporation, and the transferor is dissolved"); *see also O'Brien v. AVCO Corp.*, 425 F.2d 1030, 1033–34 (2d Cir. 1969).

Although there is not an analogous statute for venue, in similar situations, the Supreme Court and this court have repeatedly assessed the propriety of venue by disregarding manipulative activities of the parties. In *Van Dusen v. Barrack*, 376 U.S. 612 (1964), for example, the Supreme Court addressed whether § 1404(a) allowed "parties opposed to transfer, by means of their own acts or omissions, to prevent a transfer otherwise proper and warranted by convenience and justice." *Id.* at 623. The Court rejected that interpretation and explained as follows:

> § 1404(a) should be construed to prevent parties who are opposed to a change of venue from defeating a transfer which, but for their own deliberate acts or omissions, would be proper, convenient and just. The power to defeat a transfer to the convenient federal forum should derive from rights and privileges conferred by federal law and not

> from the deliberate conduct of a party favoring trial in an inconvenient forum.

Id. at 624.

We have similarly rejected parties' attempts to manipulate venue. In *In re Microsoft Corp.*, 630 F.3d 1361 (Fed. Cir. 2011), the plaintiff, a Texas corporation, maintained an office in the Eastern District of Texas, where it kept its documents. While the plaintiff operated from the United Kingdom and had no employees anywhere in the United States, it pointed to its presence in Texas to argue that the Eastern District of Texas would be a convenient forum. *Id.* at 1362–64. We disagreed, holding that the plaintiff's incorporation, office, and documents in Texas "were recent, ephemeral, and a construct for litigation and appeared to exist for no other purpose than to manipulate venue . . . in anticipation of litigation." *Id.* at 1365; *see also In re Zimmer Holdings, Inc.*, 609 F.3d 1378, 1381 (Fed. Cir. 2010) (citation omitted) (finding that transfer of documents to a Texas office space was "recent, ephemeral, and an artifact of litigation," and therefore "entitled to no weight in the court's venue analysis"); *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333, 1337 (Fed. Cir. 2009) (characterizing pre-litigation transfer of documents as "a fiction which appears to have been created to manipulate the propriety of venue" and concluding that the denial of transfer "ha[d] no legally rational basis" as a result).

Although our previous cases addressing venue manipulation by plaintiffs involved "the convenience of parties and witnesses, in the interest of justice" factor, longstanding principles against manipulation

are no less applicable to the requirement that an action "might have been brought" in the transferee district.

These cases present just such a manipulation under § 1404(a). Ikorongo Texas was created and assigned its targeted geographic rights in counties in the Western District of Texas in the month leading up to these suits. The same group of five individuals owns all membership interests in both Ikorongo entities. Ikorongo Texas and Ikorongo Tech share the same office in North Carolina, and the same person signed the relevant agreement documents on behalf of both companies. Nothing would prevent the Ikorongo entities from undoing the assignment if they so desired. Moreover, it does not appear that Ikorongo Texas conducts any other business—rather, it seems to exist for the sole purpose of limiting venue to the Western District of Texas.

This case is quite similar to *Miller & Lux*, a jurisdiction case arising under the version of 28 U.S.C. § 1359 then in force. There, a California corporation sought to sue another California corporation. *See* 211 U.S. at 298. To create diversity jurisdiction, the plaintiff California corporation organized an eponymous Nevada corporation; the two corporations had the same directors, and all of the stock in the Nevada corporation was issued to its California counterpart. *Id.* at 299–300. The California corporation transferred to the Nevada corporation "the property rights which the California corporation had asserted," on which basis the Nevada corporation invoked diversity jurisdiction in the Southern District of California. *Id.* at 296, 306. The California

transferor, meanwhile, was never dissolved, and could therefore control the Nevada corporation's suit and reacquire any potential gains awarded in the litigation. *Id.* at 300, 305. The Supreme Court rejected this attempt to "collusively" create jurisdiction. *Id.* at 306.

Thus—here as in *Miller & Lux*—the presence of Ikorongo Texas is plainly recent, ephemeral, and artificial—just the sort of maneuver in anticipation of litigation that has been routinely rejected. In the venue analysis, therefore, we need not consider separately Ikorongo Texas's geographically bounded claims. And disregarding this manipulation, Ikorongo Tech could have filed suit in the Northern District of California.

Under the proper construction of § 1404(a), then, these cases "might have been brought" in the Northern District of California.

B.

We now turn to Samsung and LG's arguments concerning the merits of their transfer motions. In general, we give substantial deference to how a district court balances conveniences and fairness factors that favor transfer against practical and public concerns if the cases were transferred. However, we have explained that "a clear abuse of discretion in balancing convenience against judicial economy under § 1404 is not outside the scope of correctible error on mandamus review." *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010); *In re Google Inc.*, No. 2017-107, 2017 WL 977038 at *2 (Fed. Cir. Feb. 23, 2017); *In re Apple, Inc.*, 581 F. App'x 886, 889–90 (Fed.

Cir. 2014). Here, we find that the court's conclusions were such an abuse.

To begin with, the district court here clearly assigned too little weight to the relative convenience of the Northern District of California. Given the relevant events and circumstances giving rise to these infringement claims, it is unsurprising that many identified sources of proof and likely witnesses are in Northern California and none in the Western District of Texas. Indeed, petitioners submitted undisputed affidavits identifying over a dozen third-party individuals with relevant and material information as residing in Northern California. Moreover, at least two of the inventors also reside in Northern California. In addition, LG indicated that its relevant party witnesses also reside in the Northern District of California. By contrast, not a single witness has been identified as residing in or near the Western District of Texas.

In weighing the willing witness factor only slightly favoring transfer to the Northern District of California, the district court provided no sound basis to diminish these conveniences. It gave no weight to the presence of possible party witnesses in Northern California despite this court holding that the district court must consider those individuals. *See In re Apple Inc.*, 818 F. App'x 1001, 1003 (Fed. Cir. 2020). The court also erroneously discounted the convenience of third-party witnesses by presuming that "only a few . . . non-party witnesses will likely testify at trial." Even if not all witnesses testify, with nothing on the other side of the ledger, the factor strongly favors transfer. Moreover, because these potential witnesses

reside in Northern California, transfer ensures that the transferee court could compel these individuals to appear.

At the same time, the district court overstated the concern about waste of judicial resources and risk of inconsistent results in light of plaintiffs' separate infringement suit against Bumble in the Western District of Texas. Only two of the patents in these cases overlap with those in the action brought against Bumble. In addition, the Bumble case involves an entirely different underlying application. Accordingly, it is "likely that these cases will result in significantly different discovery, evidence, proceedings, and trial." *See In re Zimmer*, 609 F.3d at 1382. And importantly, to the extent that there are remaining overlapping invalidity or infringement issues, "the MultiDistrict Litigation Procedures exist to effectuate this sort of efficiency." *In re EMC Corp.*, 501 F. App'x 973, 976 (Fed. Cir. 2013). Thus, the incremental gains in keeping these cases in the Western District of Texas simply are not sufficient to justify overriding the inconvenience to the parties and witnesses.

Moreover, other public interest factors favor transfer. The Supreme Court has long held that there is "a local interest in having localized controversies decided at home." *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 509 (1947). The district court, however, declares that "it is generally a fiction that patent cases give rise to local controversy or interest, particularly without record evidence suggesting otherwise." Local interests are not a fiction, and the record evidence here shows a substantial local interest.

The relevant events leading to the infringement claims here took place largely in Northern California, and not at all in the Western District of Texas. Both petitioners are accused of infringing the asserted patents based on third-party applications running on LG's and Samsung's accused products. It is undisputed that those third parties researched, designed, and developed most of those applications in Northern California. These are significant factors that give the Northern District of California a legitimate interest in adjudicating the cases "at home." *See In re Apple Inc.*, 979 F.3d 1332, 1344–45 (Fed. Cir. 2020) ("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.'" (quoting *In re Acer Am. Corp*, 626 F.3d 1252, 1256 (Fed. Cir. 2010)) (emphasis omitted)).

The district court's weighing of the local interest factor as neutral on the ground that "Ikorongo Texas's claims do specifically relate to infringement in this District . . . regardless of when the entity formed" is error. The fact that infringement is alleged in the Western District of Texas gives that venue no more of a local interest than the Northern District of California or any other venue. *See Hoffmann-La Roche*, 587 F.3d at 1338 (concluding that "the sale of an accused product offered nationwide does not give rise to a substantial interest in any single venue"); *In re TOA Techs., Inc.*, 543 F. App'x 1006, 1009 (Fed. Cir. 2013) (stating that "in cases where there is a significant connection between a particular venue and a suit[,] the sale of a product in the plaintiff's preferred forum should not negate this factor being

weighed in favor of transfer"). The facts of this case indicate that the local interest factor weighs in favor of Samsung and LG.

Ikorongo Texas and Ikorongo Tech urge that the district court's conclusions can be upheld on the court congestion factor. But we cannot say that the prospective speed with which this case might be brought to trial is of particular significance in these cases. The district court found that this factor weighed against transfer in part based on considerations that have no bearing on whether the Northern District of California has a more congested docket. *See Apple*, 979 F.3d at 1344 ("We have previously explained that a court's general ability to set a fast-paced schedule is not particularly relevant to this factor."). And even if the court's speculation is accurate that it could more quickly resolve these cases based on the transferee venue's more congested docket, neither respondents nor the district court pointed to any reason that a more rapid disposition of the case that might be available in the Western District of Texas would be important enough to be assigned significant weight in the transfer analysis here.

Accordingly,

IT IS ORDERED THAT:

The petitions for writs of mandamus are granted. The district court's March 1, 2021 orders denying transfer are vacated, and the district court is directed to grant Samsung's and LG's motions to the extent that the cases are transferred to the United States District Court for the Northern District of California under 28 U.S.C. § 1404(a).

FOR THE COURT

June 30, 2021
Date

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

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APPENDIX B

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: UBER TECHNOLOGIES, INC.,
Petitioner

2021-150

On Petition for Writ of Mandamus to the United States District Court for the Western District of Texas in No. 6:20- cv-00843-ADA, Judge Alan D. Albright.

ON PETITION

Before LOURIE, DYK, and REYNA, Circuit Judges.

DYK, *Circuit Judge*.

ORDER

In this patent infringement case brought by Ikorongo Technology LLC and Ikorongo Texas LLC (collectively, "Ikorongo"), the United States District Court for the Western District of Texas denied Uber Technologies, Inc.'s motion to transfer to the United States District Court for the Northern District of

California under 28 U.S.C. § 1404(a). Uber seeks a writ of mandamus directing transfer.

In its order denying transfer, the district court determined that Uber had failed to establish that this action "might have been brought" originally in Northern California as required under section 1404(a). Specifically, the district court found that the California forum would not be a proper venue under 28 U.S.C. § 1400(b) over Ikorongo Texas's claims, which were limited to its geographic rights under the asserted patents to certain counties in Texas. In doing so, the district court rejected Uber's argument that Ikorongo Texas's recent formation and acquisition of those specified rights from Ikorongo Tech (which shares offices in Northern California and the same ownership and management team as Ikorongo Texas) should be disregarded as mere tactics to avoid transfer. In the alternative, the district court found that Uber had failed to show the Northern District of California was clearly more convenient for trial.

We recently granted mandamus to direct the Western District of Texas to transfer to the Northern District of California two other actions of Ikorongo asserting infringement of two of the same patents against different defendants. *See In re Samsung Electronics Co.*, Nos. 2021- 139, -140, __ F.4th __, 2021 WL 2672136 (Fed. Cir. June 30, 2021). *Samsung* rejected the district court's determination that Ikorongo's actions could not have been brought in the transferee venue. *Samsung* observed that "the presence of Ikorongo Texas is plainly recent, ephemeral, and artificial" and "the sort of maneuver in anticipation of litigation that has been routinely

rejected" by the Supreme Court and this court in related contexts. 2021 WL 2672136, at *5–6. As a result, this court in *Samsung* held that it did not need to "consider separately Ikorongo Texas's geographically bounded claims" for purposes of assessing whether the Northern District of California had venue over the case under section 1400(b). *Id.*

The district court itself recognized "that the issues present here are identical to those" in Ikorongo's other cases. Appx6. As in *Samsung*, the Western District of Texas erred in this case in concluding that Uber had failed to satisfy the threshold requirement for transfer of venue.

The district court's analysis of the traditional public and private factors in this case is also virtually the same to its analysis in the cases in *Samsung*. As in this case, *Samsung* involved cases where the accused technology was researched, designed, and developed in the Northern District of California and the defendants identified several party and non-party witnesses, including two inventors, as residing in the Northern District of California, while no party identified a single witness as residing in or close to the Western District of Texas. Here, Uber is headquartered in the Northern District of California and below submitted a declaration identifying over a dozen witnesses residing in the transferee venue that were linked to the development of the accused technology. *See* Appx161–63.

In *Samsung*, we rejected the district court's conclusion that the willing witness factor weighed only slightly in favor of transfer. *See* 2021 WL 2672136, at *6. We explained that the court had

erroneously diminished the relative convenience of the Northern District of California by: (1) giving little weight to the presence of identified party witnesses in the Northern District of California despite no witness being identified in or near the Western District of Texas and (2) simply presuming that few, if any, party and non-party identified witnesses will likely testify at trial despite the defendants' submitting evidence and argument to the contrary. *Id.* At the same time, *Samsung* rejected the district court's view that there was a strong public interest in retaining the case in the district based on Ikorongo's other pending infringement action against Bumble Trading, LLC. Because "the Bumble case involves an entirely different underlying application," we explained, it was unlikely the cases would result in inconsistent judgments. *Id. Samsung*, moreover, explained that multidistrict litigation procedures could efficiently resolve overlapping invalidity or infringement issues. *Id*. Accordingly, we said that "the incremental gains in keeping these cases in the Western District of Texas simply are not sufficient to justify overriding the inconvenience to the parties and witnesses." *Id*.

Samsung bolstered that conclusion by finding that other public interest considerations favored transfer. Specifically, we rejected the district court's conclusion that the local interest factor was neutral despite the district court itself recognizing that the underlying accused functionality was researched, designed, and developed in the transferee venue. *Id.* at *7. We concluded that the district court had erred in minimizing that local interest in relying merely on the fact that Ikorongo Texas's claims specifically related to infringement in the Western District of Texas. *Id.*

Those infringement allegations, we explained, gave plaintiffs' chosen forum no more of a local interest than the Northern District of California or any other venue. *Id*.

In this case, we see no basis for a disposition different from the ones reached in *Samsung*. The district court here relied on the same improper grounds as in *Samsung* to diminish the clear convenience of the Northern District of California. The reasons for not finding judicial economy considerations to override the clear convenience of the transferee venue also apply with even more force here. Though the district court in this case relied on the co-pending case against Lyft, Inc. as well as Bumble, both of those litigations involve entirely different underlying functionality and the Samsung Electronics Co., Ltd. et al. and LG Electronics Inc. et al. litigations have now been directed to be transferred to Northern California. In addition, the district court clearly erred in negating the transferee venue's strong local interest by relying merely on the fact that plaintiffs alleged infringement in the Western District of Texas.

Accordingly,

IT IS ORDERED THAT:

The petition for a writ of mandamus is granted. The district court's May 26, 2021 order denying transfer is vacated, and the district court is directed to grant Uber's motion to the extent that the case is transferred to the United States District Court for the Northern District of California under 28 U.S.C. § 1404(a).

FOR THE COURT

July 08, 2021
Date

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

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APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

IKORONGO TEXAS LLC and IKORONGO TECHNOLOGY LLC,	§	**CAUSE NO. 6:20-cv-00259-ADA**
Plaintiffs,	§	
v.	§	
SAMSUNG ELECTRONICS CO. LTD., and SAMSUNG ELECTRONICS AMERICA, INC	§	**JURY TRIAL DEMANDED**
Defendants.	§	

ORDER DENYING DEFENDANTS' MOTION TO TRANSFER

Before the Court is Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc's (collectively, Samsung) Opposed Motion to Transfer (ECF No. 27), Plaintiffs Ikorongo Texas LLC and Ikorongo Technology LLC's (collectively, Ikorongo) Response (ECF No. 54), and Defendants' Reply (ECF No. 58). After having reviewed the parties' briefs, case file, and applicable law, the Court has determined that Defendants' Motion to Transfer should be **DENIED**.

I. Background

Ikorongo Texas filed this action on March 31, 2020, pursuant to the Court's original jurisdiction under 28 U.S.C. §§ 1331 and 1338(a). ECF No. 1. Ikorongo Texas and Ikorongo Technologies then filed an amended complaint on April 1, 2020. ECF No. 2. Plaintiffs allege patent infringement claims against Samsung relating to four U.S. Patents, Nos. RE 41,450; RE 45,543; RE 47,704; and 8,874,554. *Id.* at 3.

On September 11, 2020, Samsung filed an opposed Motion to Transfer under 28 U.S.C. § 1404(a). Defendants' Opposed Mot. to Transfer to the Northern District of California Under 28 U.S.C. § 1404(a) (hereinafter "Mot. to Transfer"), ECF No. 27. In Samsung's Motion to Transfer, Samsung argues transfer to the Northern District of California is proper because: (1) Ikorongo could have originally filed suit in the proposed transferee venue and (2) the convenience of the parties and interests of justice weigh in favor of transfer. *Id.* at 8–13. On January 5, 2021, Ikorongo filed a response to Samsung's Motion. Pls.' Resp. in Opp'n to Defs.' Mot. to Transfer Venue and Br. in Supp. (hereinafter "Resp."), ECF No. 54. On January 19, 2021, Samsung filed a reply. Defs.' Reply in Supp. of Defs.' Opposed Mot. to Transfer to the Northern District of California Under 28 U.S.C. § 1404(a) (hereinafter "Reply"), ECF No. 58.

II. Legal Standard

In patent cases, motions to transfer under 28 U.S.C. § 1404(a) are governed by the law of the regional circuit. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). Under § 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." 28 U.S.C. § 1404(a). Section 1404(a)'s threshold inquiry is whether the case could initially have been brought in the proposed transferee forum. *In re Volkswagen AG*, 371 F.3d 201, 202–03 (5th Cir. 2004) [*Volkswagen I*]. If that inquiry is satisfied, the Court determines whether transfer is proper by analyzing and weighing various private and public interest factors. *Humble Oil & Ref. Co. v. Bell Marine Serv.*, 321 F.2d 53, 56 (5th Cir. 1963); *In re Apple Inc.*, 979 F.3d 1332, 1338 (Fed. Cir. 2020) (applying Fifth Circuit law). 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." *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) [*Volkswagen II*] (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original). The factors are neither exclusive nor exhaustive, and no one factor is dispositive. *Id.* In applying these factors, the court enjoys considerable discretion and assesses the case "on an 'individualized, case-by-case consideration of

convenience and fairness.'" *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010) (quotation omitted). The burden to prove that a case should be transferred for convenience falls squarely on the moving party. *See id.* Although the plaintiff's choice of forum is not a separate factor entitled to special weight, respect for the plaintiff's choice of forum is encompassed in the movant's elevated burden to "clearly demonstrate" that the proposed transferee forum is "clearly more convenient" than the forum in which the case was filed. *Id.* at 314–15. While "clearly more convenient" is not necessarily equivalent to "clear and convincing," the moving party "must show materially more than a mere preponderance of convenience, lest the standard have no real or practical meaning." *Quest NetTech Corp. v. Apple, Inc.*, No. 2:19-cv-118, 2019 WL 6344267, at *7 (E.D. Tex. Nov. 27, 2019).

III. Discussion

The Court now turns to examine Samsung's § 1404(a) arguments. Samsung argues the Northern District of California is both a proper and more convenient venue for this action. Mot. To Transfer at 8–13.

A. Samsung Has Not Met the Threshold Requirement as to Ikorongo Texas LLC, But It Has Met the Threshold Requirement as to Ikorongo Technology LLC.

Samsung has not met its burden to show that Ikorongo Texas's current action could have initially been brought in the Northern District of California. Under 28 U.S.C. § 1400(b), a patent infringement action "may be brought" in any judicial district "where

the defendant has committed acts of infringement and has a regular and established place of business." 28 U.S.C. § 1400(b). Ikorongo alleges Samsung committed acts of infringement in the Northern District of California and does not dispute it has a regular and established place of business in the Northern District of California. However, Ikorongo argues that this case could not have been brought in the Northern District because Ikorongo Texas owns exclusive rights under the Asserted Patents only in a geographic location that includes this District. Resp. at 5. According to Ikorongo, this ownership only permits Ikorongo Texas to file suit in this geographic location because Samsung's alleged acts of infringement with respect to Ikorongo Texas only occur within this geographic location. *Id.* at 8.[1]

The Court agrees. *Waterman v. Mackenzie*, 138 U.S. 252 (1891) and 35 U.S.C. § 261, which Ikorongo references in support of its argument, provide the principles that an applicant, patentee, or the individual's assigns or legal representatives can convey an exclusive right under his application to the whole or any specified part of the United States. These rights include the right to sue infringers. *Waterman*, 138 U.S. at 255. The Specified Part allows Ikorongo Texas to protect its rights to the patent within the prescribed geographic region.

Samsung argues that Ikorongo alleges Samsung committed acts of infringement in the Northern

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[1] Because neither party argues that Samsung cannot satisfy this issue as to Ikorongo Technology LLC, the Court will simply state the threshold issue has been satisfied for Ikorongo Technology.

District of California and that the Court should focus on a defendant's contacts with the transferee forum when determining the threshold issue rather than if a plaintiff can sue in the transferee forum based on contractual permissions. Reply at 2, 3. As to the first argument, Samsung presumes far too much from Ikorongo's complaint. Ikorongo merely alleges that Samsung infringed and continues to infringe in the United States in each paragraph cited by Samsung. First Am. Compl. for Patent Infringement, ECF No. 2, at ¶¶ 21, 31, 41, 51. The Court does not read these paragraphs as allegations that infringement occurred in the Northern District of California for each plaintiff's claims just as the Court would not read these paragraphs as allegations that infringement occurred in this District for each plaintiff's claims.

Samsung's second argument incorrectly casts Ikorongo Texas's Specified Part as incidental to Samsung's contacts with the proposed transferee forum. Of course, a defendant's mere contacts with the proposed forum does not satisfy the threshold question's test. As noted above, a plaintiff can bring an action in any district where the defendant has a regular and established place of business *and* where the defendant has committed acts of infringement. 28 U.S.C. § 1400(b). While Samsung protests that the Specified Part cannot fix venue, it misses the fact that infringement itself is not fixed in one venue. Indeed, the Supreme Court recognized as far back as *Waterman* that assignment of an exclusive right to make, use, and vend a patented machine within a district gives the grantee the right to sue for infringement within that district because the assignment excludes all others, even the patentee,

from making, using, or vending like machines within that particular district. *Waterman*, 138 U.S. at 256. Thus, the focus turns not to where Samsung committed any alleged acts of infringement but to where Samsung committed any alleged acts of infringement as to Ikorongo Texas. Any alleged infringement by Samsung of Ikorongo Texas's Specified Part could have only occurred within the geographic locations described in the specialized part. As with the hypothetical grantee in *Waterman*, Ikorongo Texas only has the right to sue for infringement that occurred within the districts included in its assignment.

Samsung argues that the Court should not endorse Ikorongo's "gamesmanship" because any patent holder could defeat § 1404 by simply creating a new entity and assigning that new entity the right to sue only in a particular district. Reply at 2–3. The Court does not agree. First, a suit brought on any Specified Part still must satisfy the venue requirements of § 1400(b). An assignee cannot simply avoid transfer by pointing to its geographically limited right. The district still must be either the district where the defendant resides or where the defendant has committed acts of infringement and has a regular and established place of business. In other words, assignment cannot grant a plaintiff access to a forum it could not access already. Second, 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. 28. U.S.C. 1400(b). A § 1404 motion to transfer to that district will always satisfy the threshold issue. Thus, Samsung has not met the threshold issue as to

Ikorongo Texas. However, even assuming, *arguendo*, that Samsung has met the threshold issue as to Ikorongo Texas, the *Volkswagen* private and public interest factors do not support transfer.

B. The *Volkswagen* Private and Public Interest Factors Disfavor Transfer

In order to determine whether Samsung has demonstrated good cause, the Court must weigh the private and public interest factors catalogued in *Volkswagen II*. 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." *Volkswagen II*, 545 F.3d at 315 (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original). If, when added together, the relevant private and public interest factors are in equilibrium, or even if they do not clearly lean in favor of the transferee venue, the motion must be denied. *Volkswagen II*, 545 F.3d at 315. Once again, the Court's ultimate inquiry is which forum will best serve the convenience of the parties and the interests of justice. *Koster v. Am. Lumbermens Mut. Cas. Co.*, 330 U.S. 518, 527 (1947).

In this case, the relevant factors do not support Samsung's motion to transfer this case. Samsung has not shown that the Northern District of California is "clearly more convenient" than the Western District of Texas when weighing the *Volkswagen* private and public interest.

1. The Private Interest Factors Do Not Clearly Establish that the Northern District of California is a More Convenient Venue

In considering private factors, the Court necessarily engages in a comparison between the hardships the defendant would suffer through the retention of jurisdiction and the hardships the plaintiff would suffer from transferring the action to the transferee venue. *Cf. Iragorri v. United Technologies Corp.*, 274 F.3d 65, 74 (2d Cir. 2001) (stating courts engage in such a comparison for *forum non conveniens* analyses). The Court will assess each of these factors in turn.

i. The Relative Ease of Access to Sources of Proof

A court looks to where documentary evidence, such as documents and physical evidence, is stored when considering the first private interest factor. *Volkswagen II*, 545 F.3d at 316. "To properly consider this factor, parties must "describe with specificity the evidence they would not be able to obtain if trial were held in the [alternate forum]." *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 258 (1981).

Samsung claims the ease of access to sources of proof compared across venues weighs heavily in favor

of transfer, stating that the greatest volume of evidence is with key third parties located in the Northern District of California. Mot. to Transfer at 9. Specifically, Samsung argues that technical documents and source code relating to the accused technology are in Mountain View and Emeryville, California. *Id.* Additionally, Samsung alleges that Ikorongo has not identified any evidence in this District, but to the extent such evidence does it exist, far more relevant evidence exists in the Northern District of California. *Id.* at 10.

Ikorongo responds to Samsung's contentions by advancing two arguments. First, Ikorongo argues this factor weighs against transfer because Samsung could access sources of proof just as easily in this District as in the proposed transferee district and that certain sources of proof are not even accessible in the proposed transferee district. Resp. at 9–10. According to Ikorongo, key third-party documents from Google are electronically accessible from anywhere and are not physically present in the Northern District of California. *Id.* Ikorongo also argues that Samsung has not identified any Samsung documents that are located in the Northern District of California. *Id.* at 11–12. Additionally, Ikorongo challenges the competence of Samsung's evidence on this factor; Ikorongo has filed a separate motion on this point. *See* Ikorongo Evidentiary Objs. to and Mot. to Strike Friedland Decl., ECF No. 53.

In its reply, Samsung reiterates that key third-party sources of proof are located in the Northern District of California. Reply at 4. Essentially, Samsung maintains that no Texas-based third-party

locations can access relevant source code or technical documents, and all such sources of proof are created, maintained, and accessed by engineers and other third parties in the Northern District of California. *Id.* Samsung also argues that Ikorongo has not identified any relevant sources of proof in or around this District. *Id.*

The Court determines the ease of access to sources of proof factor weighs in favor of transfer. Given that Samsung is the accused infringer, it will likely have the bulk of the documents that are relevant in this case. *See, e.g., In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009) ("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."). Therefore, the Court finds that the location of the documents relevant in this case tilts this factor towards transfer.[2]

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[2] Although the Court wishes to make clear that it has followed Fifth Circuit precedent regarding this factor, the Court believes that the factor itself is at odds with the realities of modern patent litigation. In patent disputes like the one now before the Court, relevant documents are typically located on a server, which may or may not be in the transferee district (or given the use of cloud-based storage, may be located on multiple servers in multiple districts, or even multiple countries) and are equally accessible from both the transferee and transferor districts. Therefore, in this Court's view, there is no difference in the relative ease of access to sources of proof from the transferor district as compared to the transferee district when the vast bulk of documents are electronic. District courts — particularly those with patent-heavy dockets that have very significant document productions — have recently begun to acknowledge this reality. *Uniloc USA Inc. v. Samsung Elecs. Am.*, No. 2:16-cv-00642-JRG, ECF No. 216

ii. The Availability of Compulsory Process to Secure the Attendance of Witnesses

When balancing this factor, the Court considers the availability of compulsory process to secure the attendance of witnesses whose attendance may require a court order. *Volkswagen II*, 545 F.3d at 316.

In its initial brief, Samsung asserts this factor weighs in favor of transfer because the majority of third-party witnesses who it expects to testify are located in the Northern District of California. Mot. to Transfer at 11. Ikorongo responds to Samsung's

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at 8-9 (E.D. Tex. Apr. 19, 2017) ("Despite the absence of newer cases acknowledging that in today's digital world computer stored documents are readily moveable to almost anywhere at the click of a mouse, the Court finds it odd to ignore this reality in favor of a fictional analysis that has more to do with early Xerox machines than modem server forms."). The Court emphasizes that this factor was meant to be one of convenience, developed in a now antiquated world where hauling hundreds of boxes of physical documents across the country was most impractical. Indeed, it seems odd that, despite the likely relative ease of access to all kinds of relevant documents in today's digital world, a party (and a technologically savvy one at that) can automatically tilt a private factor in this analysis in its favor and away from a plaintiff's selected forum simply by raising its hand and acknowledging its status as the alleged infringer. However, under current Fifth Circuit precedent, the physical location of electronic documents affects this factor's outcome. *See, e.g., Volkswagen II*, 545 F.3d at 316. Even though it would not have changed the outcome of this motion, this Court expresses its hope that the Fifth Circuit will consider addressing and amending its precedent to explicitly give district courts the discretion to fully consider the ease of accessing electronic documents.

arguments by stating the factor weighs against transfer. Resp. at 12–13. Ikorongo argues Samsung has not provided evidentiary support that the majority of third-party witnesses reside in the proposed transferee district and that the Court should not credit this argument. *Id.* at 12. Ikorongo also argues that the factor weighs against transfer because Google is not a true third-party in this case. *Id.* at 13. Finally, Ikorongo alleges that third-party end users reside in this District, and it might need to subpoena those individuals for trial. *Id.* In response, Samsung simply points out that compulsory process would exist over non-party engineers and inventors and that Ikorongo has not specifically identified witnesses likely to testify at trial who are subject to the Court's compulsory process. Reply at 4–5.

After considering the parties' arguments, the Court finds that this factor neutral. First, as to Samsung's arguments that third-party engineers are not within the Court's subpoena power, this Court has previously held that certain third parties with locations within this District and their employees do fall within the Court's subpoena power. *Parkervision, Inc. v. Intel Corp.*, No. 6:20- cv-00108, 2021 WL_, at *7 (W.D. Tex. Jan. 26, 2021).

Second, and perhaps more to the point, Samsung has not shown any potential witness is unwilling to testify. When no party has alleged or shown any witness's unwillingness, a court should not attach much weight to the compulsory process factor. *Duha v. Agrium, Inc.*, 448 F.3d 867, 877 (6th Cir. 2006); *CloudofChange, LLC v. NCR Corp.*, No. 6:19-cv-00513, 2020 WL 6439178, at *4 (W.D. Tex. Mar. 17,

2020). Here, neither Samsung nor Ikorongo have identified any unwilling witnesses. Indeed, while Samsung points to Google and Avast employees as witnesses within the subpoena power of the Northern District of California, the Court is reluctant to give these witnesses weight because these parties collaborate with Samsung to implement their technology into Samsung products, which makes it unlikely that the employees would be unwilling to testify at a trial concerning Samsung. *Parus Holdings Inc. v. LG Elecs. Inc.*, No. 6:19-cv-00432, 2020 WL 4905809, at *4 (W.D. Tex. Aug. 20, 2020). Absent any showing of unwillingness, the Court will not attach much weight to this factor. Consequently, the Court finds this factor neutral.

iii. The Cost of Attendance for Willing Witnesses

The convenience of witnesses is the most important factor in a § 1404(a) analysis. *Genentech, Inc.*, 566 F.3d at 1342. While a court should not consider the significance of identified witnesses' testimonies, it should consider whether the witnesses may provide materially relevant evidence. *Id.* at 1343.

To assist in analyzing this factor, the Fifth Circuit adopted a "100-mile rule." *Volkswagen I*, 371 F.3d at 204–205; *see also Volkswagen II*, 545 F.3d at 317. "When 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 I*, 371 F.3d at 204–05. Consequently, the threshold question is whether the movant's proposed venue and a

plaintiff's chosen venue are more than 100 miles apart. *See Volkswagen II*, 545 F.3d at 317. If the distance is greater, then a court will consider the distances between the witnesses and the two proposed venues. *See id.* Importantly, the venue need not be convenient for *all* witnesses. *Genentech, Inc.*, 566 F.3d at 1345. If a substantial number of witnesses reside in one venue and no witnesses reside in another, the factor will weigh in favor of the venue where witnesses reside. *See id.*

As previously stated by this Court, "given typical time limits at trial, the Court does not assume that all of the party and third-party witnesses listed in 1404(a) briefing will testify at trial." *Fintiv, Inc.*, 2019 WL 4743678, at *6. Indeed, the Court assumes only a few party witnesses and even fewer non-party witnesses (if any) will testify at trial. *Id.* Consequently, long lists of potential party and non-party witnesses do not affect the Court's analysis for this factor. *Id.*

Samsung argues that this factor weighs in favor of transfer because its relevant party witnesses and third-party witnesses are either closer to or within the Northern District of California than this District. Mot. to Transfer at 11–12. In response, Ikorongo argues that Samsung has not carried its burden to show that the proposed transferee district is clearly more convenient because relevant witnesses are scattered across the country. Resp. at 13–14. According to Ikorongo, the varied locations of these witnesses make this District more convenient than the proposed transferee district. *Id.* Additionally, Ikorongo also argues Samsung failed to carry its burden on this

factor because the cost of bringing witnesses to the Northern District of California far exceeds the cost of bringing them to this District. *Id.* at 15–16. Finally, Ikorongo stated it would cover the costs for the attendance of any live witness other than Samsung corporate representatives. *Id.* at 16. Samsung replies by stating it expects key testimony from third-party witnesses who are located in the Northern District of California. Reply at 5. Samsung also argues that Ikorongo has not identified any relevant witnesses in this District. *Id.* Finally, Samsung states that any cost savings due to the difference in food and lodging costs between the two districts would likely balance out because more witnesses would have to travel to this District. *Id.*

The Court finds that this factor weighs only very slightly in favor of transfer. First, the convenience of party witnesses is typically given little weight because the witnesses' employer could compel their testimony at trial. *Turner v. Cincinnati Ins. Co.*, 6:19-cv-642-ADA-JCM, 2020 WL 210809, at *4 (W.D. Tex. Jan. 14, 2020); *Freehold Licensing, Inc. v. Aequitatem Capital Partners, LLC*, A-18-cv-413 LY, 2018 WL 5539929, at *7 (W.D. Tex. Oct. 29, 2018). Some courts have considered how far these witnesses would need to travel if few or no witnesses reside within the current district. *See, e.g., Genentech, Inc.*, 566 F.3d at 1345 (determining the convenience factor favored transfer, and not only slightly, in part because the defendants' employees and managers would not have to travel as far and the foreign plaintiff had no connection to the current venue); *contra Fintiv, Inc.*, 2019 WL 4743678, at *6 (stating the cost of attendance for party witnesses did not weigh for or against transfer

because there were several potential witnesses in both potential venues). However, because courts give the convenience of party witnesses little weight, the Court finds this consideration neutral irrespective of where these individuals may reside.

The Court agrees with Samsung that Ikorongo's failure to identify specific third-party witnesses in this District should factor into the analysis of this factor. The Court also recognizes that Samsung has established that Google and Avast would have few potential witnesses in this District and that it would be more convenient for these third-party witnesses to testify in the Northern District of California. This Court has recognized that the Northern District of California is the more convenient forum for a high percentage of Google's employees who may be relevant witnesses. *Parus Holdings Inc.*, 2020 WL 4905809, at *6. However, as mentioned above, this Court has previously recognized that only a few party witnesses and even fewer non-party witnesses will likely testify at trial. *Fintiv, Inc.*, 2019 WL 4743678, at *6. Moreover, given this reality, the Court finds the difference in cost of food and lodging somewhat relevant. Perhaps if every third-party witness were to testify, the cost-savings between the two districts would offset. Given the likelihood that not every identified third-party witness will testify and that Ikorongo has stated a willingness to cover those expenses for non-party witnesses, the Court finds these considerations not insignificant when evaluating this factor. Consequently, this factor weighs only slightly in favor of transfer.

iv. Other Factors That Make Trial Easy, Expeditious, and Inexpensive

In considering a transfer motion, the court considers "all other practical problems that make trial of a case easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315. Samsung initially asserted that this factor weighs neutrally because the case is still in early stages and transfer would not cause delays. Mot. to Transfer at 12. Ikorongo responded by arguing that transferring the case would actually be less expeditious because Ikorongo has filed suit against other entities, such as Bumble, in this District on some of the same patents Resp. at 16–17. Ikorongo also claims that transfer would make the case more expensive and hinder the progress of the case. *Id.* at 17–18. Samsung counters by now arguing the factor favors transfer because the case is still in its early stages. Reply at 5–6. Samsung also argues that the co-pendency of related suits does not automatically tip this factor in Ikorongo's favor. *Id.*

The Court finds this factor weighs against transfer. Even if transfer may not cause delay as Samsung argues, the Court notes such a finding would not weigh for or against transfer. The fact that a transfer would not cause a delay does not mean it rises to the level of a practical problem that clearly shows the proposed transferee venue is more convenient. It simply shows transfer is feasible.

While cases involving the same patents but different defendants, products, and witnesses will not necessarily be expedited by being in the same court, judicial economy may be served by having the Court try cases that involve the same patents. *See*

Hammond Dev. Int'l, Inc. v. Google LLC, 1:20-cv-00342-ADA, 2020 WL 3452987 (W.D. Tex. June 24, 2020) (denying motion to transfer venue and finding that judicial economy was served by having the same district court try cases involving the same patents due to consolidation of the cases). As Ikorongo correctly points out, it has filed suit against Bumble in this District for infringing on patents asserted in this action, and Bumble withdrew its motion to transfer. Samsung's argument that the co-pendency of related suits should not play a role in the Court's analysis does not apply here. Granted, the co-pendency of suits does not automatically tip this factor in favor of the non-movant. *In re Google Inc.*, No. 2017-107, 2017 WL 977038, at *2 (Fed. Cir. Feb. 23, 2017). However, this simply means that the mere existence of co-pending cases does not weigh against transfer. It does not mean co-pending cases should never affect the weight of this factor.

An examination of the case cited by Samsung proves instructive. In *Google*, there were co- pending cases against Walmart, Google, and Amazon. *Id.* All three filed motions to transfer to the same venue. *Id.* at *1. The district court denied Walmart's motion to transfer and found this factor weighed against transfer in large part because of the co-pending cases against Google and Amazon. *Id.* at *2. The district court then denied Google's motion to transfer and found this factor weighed against transfer in large part because of the co-pending cases against Walmart and Amazon. *Id.* The Court of Appeals held that the district court incorrectly analyzed this factor because "[b]ased on the district court's rationale . . . the mere co-pendency of related suits in a particular district

would automatically tip the balance in non-movant's favor regardless of the existence of co- pending transfer motions and their underlying merits." *Id.* The outcome of the district court's analysis of this factor would, at best, depend on which transfer motion the court ruled on first. *Id.* In other words, mere co-pendency cannot weigh against transfer; it must implicate issues of judicial economy, potentially inconsistent rulings, or expeditious litigation.

Here, co-pendency does raise these concerns. Ikorongo has a co-pending case against Bumble implicating the same patents in this District. That case will continue in this District. The Court emphasizes it does not find this factor weighs against transfer merely because Ikorongo has filed suits against multiple defendants in this District. Rather, judicial economy and the possibility of inconsistent rulings causes the Court to find this factor weighs against transfer, given that at least one of the co-pending cases will remain in this District.

2. The Public Interest Factors Do Not Clearly Establish the Northern District of California is a More Convenient Venue

The relevant public-interest factors also do not favor transfer. As previously noted, these 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 governing the case; and (4) the avoidance of unnecessary problems of conflict of laws or the application of foreign law. *Volkswagen II*, 545 F.3d at 315. The Court will also consider each of these factors in turn.

i. Administrative Difficulties

Administrative difficulties manifest when litigation accumulates in congested centers instead of being handled at its origin. *Gulf Oil*, 330 U.S. at 508. This factor concerns "whether there is an appreciable difference in docket congestion between the two forums." *Parsons v. Chesapeake & Ohio Ry. Co.*, 375 U.S. 71, 73 (1963); *Koehring Co. v. Hyde Constr. Co.*, 324 F.2d 295, 296 (5th Cir. 1963). The relevant inquiry under this factor is the speed with which a case comes to trial and is resolved. *Genentech, Inc.*, 566 F.3d at 1347.

Samsung states that, while this Court may be able to try this case earlier than the Northern District of California, time-to-trial is the most speculative of factors in this analysis. Mot. to Transfer at 13. Ikorongo, on the other hand, argues against transfer because the Court has set a trial date of January 2022 and surmises that the Northern District of California will suffer from more congestion than usual given the continued suspension of in-person proceedings due to the current COVID-19 pandemic. Resp. at 18. Samsung responds by simply stating this factor is neutral because time-to-trial is speculative. Reply at 6.

This Court recently had reason to analyze the difference in congestion between the Northern District of California and this District. *Parus Holdings Inc.*, 2020 WL 4905809, at *7. At that time, this Court's time-to-trial was 25% faster than the Northern District of California. *Id.* Further, the comparison of time-to-trial throughout the Western District of Texas may overlook a faster time-to-trial

within the Waco Division. Importantly, the Waco Division has its own patent- specific Order Governing Proceedings ("OGP") that ensures efficient administration of patent cases. In fact, a trial date has already been set in January 2022, which is roughly 11 months away. These facts indicate a greater efficiency of bringing cases, especially patent cases, to trial in the Western District of Texas than in the Northern District of California. This factor weighs against transfer.

ii. Local Interests

There is "a local interest in having localized controversies decided at home." *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 511 (1947); *Piper Aircraft*, 454 U.S. 235, 260 (1981).

Samsung argues that the Northern District of California has a stronger local interest in this litigation than the Western District of Texas because three of the applications were developed there. Mot. to Transfer at 13. To further bolster this position, Samsung points out that Ikorongo Texas formed only a few weeks before it filed suit against Samsung and has a North Carolina address. *Id.* In response, Ikorongo argues that Samsung has not provided competent evidence that no Austin-based Google employees work on relevant functions. Resp. at 19. Ikorongo alleges Samsung ignores the fact that Ikorongo Texas's claims relate to infringement in Texas and this District. *Id.* Samsung replies by stating nothing about Ikorongo Texas's infringement claim is distinct from an infringement claim in any other district or the specific interests of the proposed transferee forum given the development of "nearly

every Accused Application" in the Northern District of California. Reply at 6.

The Court finds this factor weighs neutrally for the reasons that follow. First, Samsung rightly argues that the infringement of an accused product offered nationwide does not allow for any venue to claim a substantial interest. *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009). Such arguments in this regard typically speak more to whether an entity could reasonably expect to be hailed into court in this District, not whether this District is more convenient for parties, witnesses, and in the interest of justice. The localized interest of a district exists when "the cause of action calls into question the work and reputation of several individuals residing in or near that district who presumably conduct business in that community." *Id.* at 1336. Such a situation presents itself here.

However, these interests are mitigated because a company's presence in a particular district weighs only slightly in favor of transfer because "it is generally a fiction that patent cases give rise to local controversy or interest, particularly without record evidence suggesting otherwise." *Found. Med., Inc.*, 2017 WL 590297, at *4. Along with this fiction, Ikorongo Texas's claims do specifically relate to infringement in this District. This fact holds true regardless of when the entity formed because Ikorongo Texas has the exclusive right to assert infringement claims that arise within this District. Accordingly, the Court finds that the local interest in having localized interests decided at home weighs neutrally.

iii. Familiarity of the Forum with the Law That Will Govern the Case

Both parties agree that this factor is neutral. Mot. to Transfer at 13; Resp. at 19. The Court also agrees.

iv. Avoiding Conflict of Laws and the Application of Foreign Laws Factors

Both parties agree that this factor is neutral. Mot. to Transfer at 13; Resp. at 19. The Court also agrees.

IV. Conclusion

Having found that Samsung has not met the threshold issue as to Ikorongo Texas and, even if it has satisfied the threshold issue, that the access to proof and the cost of attendance for willing witnesses weigh in favor or only slightly in favor of transfer while other practical problems that make trial of a case easy, expeditious and inexpensive, and administrative difficulties weigh against transfer with the other factors being neutral, the Court finds that Samsung has not met its "heavy burden" to demonstrate that the Northern District of California is "clearly more convenient." *Volkswagen II*, 545 F.3d at 314 n.10, 315.

IT IS THEREFORE ORDERED that Defendants' Motion to Transfer (ECF No. 27) is **DENIED**. It is further **ORDERED** that the above-styled case remain on the docket of United States District Judge Alan D Albright.

SIGNED this 1st day of March, 2021.

ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

IKORONGO TEXAS LLC and IKORONGO TECHNOLOGY LLC,	§	**CAUSE NO. 6:20-cv-00257-ADA**
Plaintiffs,	§	
v.	§	
LG ELECTRONICS INC., and LG ELECTRONICS U.S.A., INC.,	§	**JURY TRIAL DEMANDED**
Defendants.	§	

ORDER DENYING DEFENDANTS' MOTION TO TRANSFER

Before the Court is Defendants LG Electronics Inc. and LG Electronics U.S.A., Inc.'s (collectively, LG) Opposed Motion to Transfer (ECF No. 27), Plaintiffs Ikorongo Texas LLC and Ikorongo Technology LLC's (collectively, Ikorongo) Response (ECF No. 56), and Defendants' Reply (ECF No. 60). After having reviewed the parties' briefs, case file, and applicable law, the Court has determined that Defendants' Motion to Transfer should be **DENIED**.

I. Background

Ikorongo Texas filed this action on March 31, 2020, pursuant to the Court's original jurisdiction under 28

U.S.C. §§ 1331 and 1338(a). ECF No. 1. Ikorongo Texas and Ikorongo Technologies then filed an amended complaint on April 1, 2020. ECF No. 2. Plaintiffs allege patent infringement claims against LG relating to four U.S. Patents, Nos. RE 41,450; RE 45,543; RE 47,704; and 8,874,554. *Id.* at 3.

On September 11, 2020, LG filed an opposed Motion to Transfer under 28 U.S.C. § 1404(a). Defendants' Opposed Mot. to Transfer to the Northern District of California (hereinafter "Mot. to Transfer"), ECF No. 27. In LG's Motion to Transfer, LG argues transfer to the Northern District of California is proper because: (1) Ikorongo could have originally filed suit in the proposed transferee venue and (2) the convenience of the parties and interests of justice

weigh in favor of transfer. *Id.* at 8–13. On January 5, 2021, Ikorongo filed a response to LG's Motion. Pls.' Resp. in Opp'n to Defs.' Mot. to Transfer Venue and Br. in Supp. (hereinafter "Resp."), ECF No. 56. On January 19, 2021, LG filed a reply. Defs.' Reply in Supp. of Defs.' Mot. to Transfer to the Northern District of California Under 28 U.S.C. § 1404(a) (hereinafter "Reply"), ECF No. 60.

II. Legal Standard

In patent cases, motions to transfer under 28 U.S.C. § 1404(a) are governed by the law of the regional circuit. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). Under § 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." 28 U.S.C. § 1404(a). Section 1404(a)'s threshold inquiry is whether the case could initially have been brought in the proposed transferee forum. *In re Volkswagen AG*, 371 F.3d 201, 202–03 (5th Cir. 2004) [*Volkswagen I*]. If that inquiry is satisfied, the Court determines whether transfer is proper by analyzing and weighing various private and public interest factors. *Humble Oil & Ref. Co. v. Bell Marine Serv.*, 321 F.2d 53, 56 (5th Cir. 1963); *In re Apple Inc.*, 979 F.3d 1332, 1338 (Fed. Cir. 2020) (applying Fifth Circuit law). 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." *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) [*Volkswagen II*] (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original). The factors are neither exclusive nor exhaustive, and no one factor is dispositive. *Id.* In applying these factors, the court enjoys considerable discretion and assesses the case "on an 'individualized, case-by-case consideration of convenience and fairness.'" *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010) (quotation omitted).

The burden to prove that a case should be transferred for convenience falls squarely on the moving party. *See id.* Although the plaintiff's choice of forum is not a separate factor entitled to special weight, respect for the plaintiff's choice of forum is encompassed in the movant's elevated burden to "clearly demonstrate" that the proposed transferee forum is "clearly more convenient" than the forum in which the case was filed. *Id.* at 314–15. While "clearly more convenient" is not necessarily equivalent to "clear and convincing," the moving party "must show materially more than a mere preponderance of convenience, lest the standard have no real or practical meaning." *Quest NetTech Corp. v. Apple, Inc.*, No. 2:19-cv-118, 2019 WL 6344267, at *7 (E.D. Tex. Nov. 27, 2019).

III. Discussion

The Court now turns to examine LG's § 1404(a) arguments. LG argues the Northern District of California is both a proper and more convenient venue for this action. Mot. to Transfer at 8–13.

A. LG Has Not Met the Threshold Requirement as to Ikorongo Texas LLC, But It Has Met the Threshold Requirement as to Ikorongo Technology LLC.

LG has not met its burden to show that Ikorongo Texas's current action could have initially been brought in the Northern District of California. Under 28 U.S.C. § 1400(b), a patent infringement action "may be brought" in any judicial district "where the defendant has committed acts of infringement and has a regular and established place of business." 28 U.S.C. § 1400(b). Ikorongo alleges LG committed acts

of infringement in the Northern District of California and does not dispute it has a regular and established place of business in the Northern District of California. However, Ikorongo argues that this case could not have been brought in the Northern District because Ikorongo Texas owns exclusive rights under the Asserted Patents only in a geographic location that includes this District. Resp. at 5. According to Ikorongo, this ownership only permits Ikorongo Texas to file suit in this geographic location because LG's alleged acts of infringement with respect to Ikorongo Texas only occur within this geographic location. *Id.* at 8. [1]

The Court agrees. *Waterman v. Mackenzie*, 138 U.S. 252 (1891) and 35 U.S.C. § 261, which Ikorongo references in support of its argument, provide the principles that an applicant, patentee, or the individual's assigns or legal representatives can convey an exclusive right under his application to the whole or any specified part of the United States. These rights include the right to sue infringers. *Waterman*, 138 U.S. at 255. The Specified Part allows Ikorongo Texas to protect its rights to the patent within the prescribed geographic region.

LG argues that Ikorongo alleges LG committed acts of infringement in the Northern District of California and that the Court should focus on a defendant's contacts with the transferee forum when determining the threshold issue rather than if a

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[1] Because neither party argues that LG cannot satisfy this issue as to Ikorongo Technology LLC, the Court will simply state the threshold issue has been satisfied.

plaintiff can sue in the transferee forum based on contractual permissions. Reply at 2, 3. As to the first argument, LG presumes far too much from Ikorongo's complaint. Ikorongo merely alleges that LG infringed and continues to infringe in the United States in each paragraph cited by LG. First Am. Compl. for Patent Infringement, ECF No. 2, at ¶¶ 21, 31, 41, 51. The Court does not read these paragraphs as allegations that infringement occurred in the Northern District of California for each plaintiff's claims just as the Court would not read these paragraphs as allegations that infringement occurred in this District for each plaintiff's claims.

LG's second argument incorrectly casts Ikorongo Texas's Specified Part as incidental to LG's contacts with the proposed transferee forum. Of course, a defendant's mere contacts with the proposed forum does not satisfy the threshold question's test. As noted above, a plaintiff can bring an action in any district where the defendant has a regular and established place of business *and* where the defendant has committed acts of infringement. 28 U.S.C. § 1400(b). While LG protests that the Specified Part cannot fix venue, it misses the fact that infringement itself is not fixed in one venue. Indeed, the Supreme Court recognized as far back as *Waterman* that assignment of an exclusive right to make, use, and vend a patented machine within a district gives the grantee the right to sue for infringement within that district because the assignment excludes all others, even the patentee, from making, using, or vending like machines within that particular district. *Waterman*, 138 U.S. at 256. Thus, the focus turns not to where LG committed any alleged acts of infringement but to

where LG committed any alleged acts of infringement as to Ikorongo Texas. Any alleged infringement by LG of Ikorongo Texas's Specified Part could have only occurred within the geographic locations described in the specialized part. As with the hypothetical grantee in *Waterman*, Ikorongo Texas only has the right to sue for infringement that occurred within the districts included in its assignment.

LG argues that the Court should not endorse Ikorongo's "gamesmanship" because any patent holder could defeat § 1404 by simply creating a new entity and assigning that new entity the right to sue only in a particular district. Reply at 2–3. The Court does not agree. First, a suit brought on any Specified Part still must satisfy the venue requirements of § 1400(b). An assignee cannot simply avoid transfer by pointing to its geographically limited right. The district still must

be either the district where the defendant resides or where the defendant has committed acts of infringement and has a regular and established place of business. In other words, assignment cannot grant a plaintiff access to a forum it could not access already. Second, 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. 28. U.S.C. 1400(b). A § 1404 motion to transfer to that district will always satisfy the threshold issue. Thus, LG has not met the threshold issue as to Ikorongo Texas. However, even assuming, *arguendo*, that LG has met the threshold issue as to Ikorongo Texas, the *Volkswagen* private and public interest factors do not support transfer.

B. The *Volkswagen* Private and Public Interest Factors Disfavor Transfer

In order to determine whether LG has demonstrated good cause, the Court must weigh the private and public interest factors catalogued in *Volkswagen II*. 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." *Volkswagen II*, 545 F.3d at 315 (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original). If, when added together, the relevant private and public interest factors are in equilibrium, or even if they do not clearly lean in favor of the transferee venue, the motion must be denied. *Volkswagen II*, 545 F.3d at 315. Once again, the Court's ultimate inquiry is which forum will best serve the convenience of the parties and the interests of justice. *Koster v. Am. Lumbermens Mut. Cas. Co.*, 330 U.S. 518, 527 (1947).

In this case, the relevant factors do not support LG's motion to transfer this case. LG has not shown that the Northern District of California is "clearly more convenient" than the Western District of Texas

when weighing the *Volkswagen* private and public interest.

1. The Private Interest Factors Do Not Clearly Establish that the Northern District of California is a More Convenient Venue

In considering private factors, the Court necessarily engages in a comparison between the hardships the defendant would suffer through the retention of jurisdiction and the hardships the plaintiff would suffer from transferring the action to the transferee venue. *Cf. Iragorri v. United Technologies Corp.*, 274 F.3d 65, 74 (2d Cir. 2001) (stating courts engage in such a comparison for *forum non conveniens* analyses). The Court will assess each of these factors in turn.

i. The Relative Ease of Access to Sources of Proof

A court looks to where documentary evidence, such as documents and physical evidence, is stored when considering the first private interest factor. *Volkswagen II*, 545 F.3d at 316. "To properly consider this factor, parties must "describe with specificity the evidence they would not be able to obtain if trial were held in the [alternate forum]." *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 258 (1981).

LG claims the ease of access to sources of proof compared across venues weighs heavily in favor of transfer, stating that the greatest volume of evidence is with key third parties located in the Northern District of California. Mot. to Transfer at 9. Specifically, LG argues that technical documents and

source code relating to the accused technology are in Mountain View and Emeryville, California. *Id.* Additionally, LG alleges that Ikorongo has not identified any evidence in this District, but to the extent such evidence does it exist, far more relevant evidence exists in the Northern District of California. *Id.* at 10.

Ikorongo responds to LG's contentions by advancing two arguments. First, Ikorongo argues this factor weighs against transfer because LG could access sources of proof just as easily in this District as in the proposed transferee district and that certain sources of proof are not even accessible in the proposed transferee district. Resp. at 9–10. According to Ikorongo, key third- party documents from Google are electronically accessible from anywhere and are not physically present in the Northern District of California. *Id.* Ikorongo also argues that LG has not identified any LG documents that are located in the Northern District of California. *Id.* at 11–12. Additionally, Ikorongo challenges the competence of LG's evidence on this factor; Ikorongo has filed a separate motion on this point. *See* Ikorongo Evidentiary Objs. to and Mot. to Strike Friedland Decl., ECF No. 55.

In its reply, LG reiterates that key third-party sources of proof are located in the Northern District of California. Reply at 4. Essentially, LG maintains that no Texas-based third-party locations can access relevant source code or technical documents, and all such sources of proof are created, maintained, and accessed by engineers and other third-parties in the Northern District of California. *Id.* LG also argues

that Ikorongo has not identified any relevant sources of proof in or around this District. *Id.*

The Court determines the ease of access to sources of proof factor weighs in favor of transfer. Given that LG is the accused infringer, it will likely have the bulk of the documents that are relevant in this case. *See, e.g., In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009) ("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."). Therefore, the Court finds that the location of the documents relevant in this case tilts this factor towards transfer.[2]

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[2] Although the Court wishes to make clear that it has followed Fifth Circuit precedent regarding this factor, the Court believes that the factor itself is at odds with the realities of modern patent litigation. In patent disputes like the one now before the Court, relevant documents are typically located on a server, which may or may not be in the transferee district (or given the use of cloud-based storage, may be located on multiple servers in multiple districts, or even multiple countries) and are equally accessible from both the transferee and transferor districts. Therefore, in this Court's view, there is no difference in the relative ease of access to sources of proof from the transferor district as compared to the transferee district when the vast bulk of documents are electronic. District courts — particularly those with patent-heavy dockets that have very significant document productions — have recently begun to acknowledge this reality. *Uniloc USA Inc. v. Samsung Elecs. Am.*, No. 2:16-cv-00642-JRG, ECF No. 216 at 8-9 (E.D. Tex. Apr. 19, 2017) ("Despite the absence of newer cases acknowledging that in today's digital world computer stored documents are readily moveable to almost anywhere at the click of a mouse, the Court finds it odd to ignore this reality in favor of a fictional analysis that has more to do with early Xerox machines than modem server forms."). The Court

ii. The Availability of Compulsory Process to Secure the Attendance of Witnesses

When balancing this factor, the Court considers the availability of compulsory process to secure the attendance of witnesses whose attendance may require a court order. *Volkswagen II*, 545 F.3d at 316.

In its initial brief, LG asserts this factor weighs in favor of transfer because the majority of third-party witnesses who it expects to testify are located in the Northern District of California. Mot. to Transfer at 11. Ikorongo responds to LG's arguments by stating the factor weighs against transfer. Resp. at 12–13. Ikorongo argues LG has not provided evidentiary support that the majority of third-party witnesses reside in the proposed transferee district and that the Court should not credit this argument. *Id.* at 12.

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emphasizes that this factor was meant to be one of convenience, developed in a now antiquated world where hauling hundreds of boxes of physical documents across the country was most impractical. Indeed, it seems odd that, despite the likely relative ease of access to all kinds of relevant documents in today's digital world, a party (and a technologically savvy one at that) can automatically tilt a private factor in this analysis in its favor and away from a plaintiff's selected forum simply by raising its hand and acknowledging its status as the alleged infringer. However, under current Fifth Circuit precedent, the physical location of electronic documents affects this factor's outcome. *See, e.g., Volkswagen II*, 545 F.3d at 316. Even though it would not have changed the outcome of this motion, this Court expresses its hope that the Fifth Circuit will consider addressing and amending its precedent to explicitly give district courts the discretion to fully consider the ease of accessing electronic documents.

Ikorongo also argues that the factor weighs against transfer because Google is not a true third-party in this case. *Id.* Finally, Ikorongo alleges that third-party end users reside in this District, and it might need to subpoena those individuals for trial. *Id.* at 13. In response, LG simply points out that compulsory process would exist over non-party engineers and inventors and that Ikorongo has not specifically identified witnesses likely to testify at trial who are subject to the Court's compulsory process. Reply at 5.

After considering the parties' arguments, the Court finds that this factor neutral. First, as to LG's arguments that third-party engineers are not within the Court's subpoena power, this Court has previously held that certain third parties with locations within this District and their employees do fall within the Court's subpoena power. *Parkervision, Inc. v. Intel Corp.*, No. 6:20-cv-00108, 2021 WL_, at *7 (W.D. Tex. Jan. 26, 2021).

Second, and perhaps more to the point, LG has not shown any potential witness is unwilling to testify. When no party has alleged or shown any witness's unwillingness, a court should not attach much weight to the compulsory process factor. *Duha v. Agrium, Inc.*, 448 F.3d 867, 877 (6th Cir. 2006); *CloudofChange, LLC v. NCR Corp.*, No. 6:19-cv-00513, 2020 WL 6439178, at *4 (W.D. Tex. Mar. 17, 2020). Here, neither LG nor Ikorongo have identified any unwilling witnesses. Indeed, while LG points to Google and Avast employees as witnesses within the subpoena power of the Northern District of California, the Court is reluctant to give these witnesses weight because these parties collaborate with LG to

implement their technology into LG products, which makes it unlikely that the employees would be unwilling to testify at a trial concerning LG. *Parus Holdings Inc. v. LG Elecs. Inc.*, No. 6:19-cv-00432, 2020 WL 4905809, at *4 (W.D. Tex. Aug. 20, 2020). Absent any showing of unwillingness, the Court will not attach much weight to this factor. Consequently, the Court finds this factor neutral.

iii. The Cost of Attendance for Willing Witnesses

The convenience of witnesses is the most important factor in a § 1404(a) analysis. *Genentech, Inc.*, 566 F.3d at 1342. While a court should not consider the significance of identified witnesses' testimonies, it should consider whether the witnesses may provide materially relevant evidence. *Id.* at 1343.

To assist in analyzing this factor, the Fifth Circuit adopted a "100-mile rule." *Volkswagen I*, 371 F.3d at 204–205; *see also Volkswagen II*, 545 F.3d at 317. "When 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 I*, 371 F.3d at 204–05. Consequently, the threshold question is whether the movant's proposed venue and a plaintiff's chosen venue are more than 100 miles apart. *See Volkswagen II*, 545 F.3d at 317. If the distance is greater, then a court will consider the distances between the witnesses and the two proposed venues. *See id.* Importantly, the venue need not be convenient for *all* witnesses. *Genentech, Inc.*, 566 F.3d at 1345. If a substantial number of witnesses reside in

one venue and no witnesses reside in another, the factor will weigh in favor of the venue where witnesses reside. *See id.*

As previously stated by this Court, "given typical time limits at trial, the Court does not assume that all of the party and third-party witnesses listed in 1404(a) briefing will testify at trial." *Fintiv, Inc.*, 2019 WL 4743678, at *6. Indeed, the Court assumes only a few party witnesses and even fewer non-party witnesses (if any) will testify at trial. *Id.* Consequently, long lists of potential party and non-party witnesses do not affect the Court's analysis for this factor. *Id.* LG argues that this factor weighs in favor of transfer because its relevant party witnesses and third-party witnesses are either closer to or within the Northern District of California than this District. Mot. to Transfer at 11–12. In response, Ikorongo argues that LG has not carried its burden to show that the proposed transferee district is clearly more convenient because relevant witnesses are scattered across the country. Resp. at 13–14. According to Ikorongo, the varied locations of these witnesses make this District more convenient than the proposed transferee district. *Id.* Additionally, Ikorongo also argues LG failed to carry its burden on this factor because the cost of bringing witnesses to the Northern District of California far exceeds the cost of bringing them to this District. *Id.* at 14–16. Finally, Ikorongo stated it would cover the costs for the attendance of any live witness other than LG corporate representatives. *Id.* at 16. LG replies by stating it intends to call key third-party witnesses who are located in the Northern District of California. Reply at 5. LG also argues that Ikorongo has not

identified any relevant witnesses in this District. *Id.* Finally, LG states that any cost savings due to the difference in food and lodging costs between the two districts would likely balance out because more witnesses would have to travel to this District. *Id.* The Court finds that this factor weighs only very slightly in favor of transfer. First, the convenience of party witnesses is typically given little weight because the witnesses' employer could compel their testimony at trial. *Turner v. Cincinnati Ins. Co.*, 6:19-cv-642-ADA-JCM, 2020 WL 210809, at *4 (W.D. Tex. Jan. 14, 2020); *Freehold Licensing, Inc. v. Aequitatem Capital Partners, LLC*, A-18-cv-413 LY, 2018 WL 5539929, at *7 (W.D. Tex. Oct. 29, 2018). Some courts have considered how far these witnesses would need to travel if few or no witnesses reside within the current district. *See, e.g., Genentech, Inc.*, 566 F.3d at 1345 (determining the convenience factor favored transfer, and not only slightly, in part because the defendants' employees and managers would not have to travel as far and the foreign plaintiff had no connection to the current venue); *contra Fintiv, Inc.*, 2019 WL 4743678, at *6 (stating the cost of attendance for party witnesses did not weigh for or against transfer because there were several potential witnesses in both potential venues). However, because courts give the convenience of party witnesses little weight, the Court finds this consideration neutral irrespective of where these individuals may reside.

The Court agrees with LG that Ikorongo's failure to identify specific third-party witnesses in this District should factor into the analysis of this factor. The Court also recognizes that LG has established that Google and Avast would have few potential

witnesses in this District and that it would be more convenient for these third-party witnesses to testify in the Northern District of California. This Court has recognized that the Northern District of California is the more convenient forum for a high percentage of Google's employees who may be relevant witnesses. *Parus Holdings Inc.*, 2020 WL 4905809, at *6. However, as mentioned above, this Court has previously recognized that only a few party witnesses and even fewer non-party witnesses will likely testify at trial. *Fintiv, Inc.*, 2019 WL 4743678, at *6. Moreover, given this reality, the Court finds the difference in cost of food and lodging somewhat relevant. Perhaps if every third-party witness were to testify, the cost-savings between the two districts would offset. Given the likelihood that not every identified third-party witness will testify and that Ikorongo has stated a willingness to cover those expenses for non-party witnesses, the Court finds these considerations not insignificant when evaluating this factor. Consequently, this factor weighs only slightly in favor of transfer.

iv. Other Factors That Make Trial Easy, Expeditious, and Inexpensive

In considering a transfer motion, the court considers "all other practical problems that make trial of a case easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315. LG initially asserted that this factor weighs neutrally because the case is still in early stages and transfer would not cause delays. Mot. to Transfer at 13. Ikorongo responded by arguing that transferring the case would actually be less expeditious because Ikorongo has filed suit

against other entities, such as Bumble, in this District on some of the same patents Resp. at 16–17. Ikorongo also claims that transfer would make the case more expensive and hinder the progress of the case. *Id.* at 17–18. LG counters by now arguing the factor favors transfer because the case is still in its early stages. Reply at 6. LG also argues that the co-pendency of related suits does not automatically tip this factor in Ikorongo's favor. *Id.*

The Court finds this factor weighs against transfer. Even if transfer may not cause delay as LG argues, the Court notes such a finding would not weigh for or against transfer. The fact that a transfer would not cause a delay does not mean it rises to the level of a practical problem that clearly shows the proposed transferee venue is more convenient. It simply shows transfer is feasible.

While cases involving the same patents but different defendants, products, and witnesses will not necessarily be expedited by being in the same court, judicial economy may be served by having the Court try cases that involve the same patents. *See Hammond Dev. Int'l, Inc. v. Google LLC*, 1:20-cv-00342-ADA, 2020 WL 3452987 (W.D. Tex. June 24, 2020) (denying motion to transfer venue and finding that judicial economy was served by having the same district court try cases involving the same patents due to consolidation of the cases). As Ikorongo correctly points out, it has filed suit against Bumble in this District for infringing on patents asserted in this action, and Bumble withdrew its motion to transfer. LG's argument that the co-pendency of related suits should not play a role in the Court's analysis does not

apply here. Granted, the co-pendency of suits does not automatically tip this factor in favor of the non-movant. *In re Google Inc.*, No. 2017-107, 2017 WL 977038, at *2 (Fed. Cir. Feb. 23, 2017). However, this simply means that the mere existence of co-pending cases does not weigh against transfer. It does not mean co-pending cases should never affect the weight of this factor.

An examination of the case cited by LG proves instructive. In *Google*, there were co- pending cases against Walmart, Google, and Amazon. *Id.* All three filed motions to transfer to the same venue. *Id.* at *1. The district court denied Walmart's motion to transfer and found this factor weighed against transfer in large part because of the co-pending cases against Google and Amazon. *Id.* at *2. The district court then denied Google's motion to transfer and found this factor weighed against transfer in large part because of the co-pending cases against Walmart and Amazon. *Id.* The Court of Appeals held that the district court incorrectly analyzed this factor because "[b]ased on the district court's rationale . . . the mere co-pendency of related suits in a particular district would automatically tip the balance in non-movant's favor regardless of the existence of co- pending transfer motions and their underlying merits." *Id.* The outcome of the district court's analysis of this factor would, at best, depend on which transfer motion the court ruled on first. *Id.* In other words, mere co-pendency cannot weigh against transfer; it must implicate issues of judicial economy, potentially inconsistent rulings, or expeditious litigation.

Here, co-pendency does raise these concerns. Ikorongo has a co-pending case against Bumble implicating the same patents in this District. That case will continue in this District. The Court emphasizes it does not find this factor weighs against transfer merely because Ikorongo has filed suits against multiple defendants in this District. Rather, judicial economy and the possibility of inconsistent rulings causes the Court to find this factor weighs against transfer, given that at least one of the co-pending cases will remain in this District.

2. Factors Do Not Clearly Establish the Northern District of California is a More Convenient Venue

The relevant public-interest factors also do not favor transfer. As previously noted, these 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 governing the case; and (4) the avoidance of unnecessary problems of conflict of laws or the application of foreign law. *Volkswagen II*, 545 F.3d at 315. The Court will also consider each of these factors in turn.

i. Administrative Difficulties

Administrative difficulties manifest when litigation accumulates in congested centers instead of being handled at its origin. *Gulf Oil*, 330 U.S. at 508. This factor concerns "whether there is an appreciable difference in docket congestion between the two forums." *Parsons v. Chesapeake & Ohio Ry. Co.*, 375 U.S. 71, 73 (1963); *Koehring Co. v. Hyde Constr. Co.*,

324 F.2d 295, 296 (5th Cir. 1963). The relevant inquiry under this factor is the speed with which a case comes to trial and is resolved. *Genentech, Inc.*, 566 F.3d at 1347.

LG states that, while this Court may be able to try this case earlier than the Northern District of California, time-to-trial is the most speculative of factors in this analysis. Mot. to Transfer at 13. Ikorongo, on the other hand, argues against transfer because the Court has set a trial date of January 2022 and surmises that the Northern District of California will suffer from more congestion than usual given the continued suspension of in-person proceedings due to the current COVID-19 pandemic. Resp. at 18–19. LG responds by simply stating this factor is neutral because time-to-trial is speculative. Reply at 6.

This Court recently had reason to analyze the difference in congestion between the Northern District of California and this District. *Parus Holdings Inc.*, 2020 WL 4905809, at *7. At that time, this Court's time-to-trial was 25% faster than the Northern District of California. *Id.* Further, the comparison of time-to-trial throughout the Western District of Texas may overlook a faster time-to-trial within the Waco Division. Importantly, the Waco Division has its own patent- specific Order Governing Proceedings ("OGP") that ensures efficient administration of patent cases. In fact, a trial date has already been set in January 2022, which is roughly 11 months away. These facts indicate a greater efficiency of bringing cases, especially patent cases, to trial in the Western District of Texas than in the Northern

District of California. This factor weighs against transfer.

ii. Local Interests

There is "a local interest in having localized controversies decided at home." *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 511 (1947); *Piper Aircraft*, 454 U.S. 235, 260 (1981).

LG argues that the Northern District of California has a stronger local interest in this litigation than the Western District of Texas because LG integrates the accused applications in the proposed transferee district and three of the applications were developed there. Mot. to Transfer at 13. To further bolster this position, LG points out that Ikorongo Texas formed only a few weeks before it filed suit against LG and has a North Carolina address. *Id.* In response, Ikorongo argues the Western District of Texas has a localized interest because LG does not actually integrate the applications in the proposed transferee district. Resp. at 19. Ikorongo also argues that LG has not provided competent evidence that no Austin-based Google employees work on relevant functions. *Id.* Finally, Ikorongo alleges LG ignores the fact that Ikorongo Texas's claims relate to infringement in Texas and this District. *Id.* LG replies by stating nothing about Ikorongo Texas's infringement claim is distinct from an infringement claim in any other district or the specific interests of the proposed transferee forum given the development of "nearly every Accused Application" in the Northern District of California. Reply at 6.

The Court finds this factor weighs neutrally for the reasons that follow. First, LG rightly argues that the infringement of an accused product offered nationwide does not allow for any venue to claim a substantial interest. *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009). Such arguments in this regard typically speak more to whether an entity could reasonably expect to be hailed into court in this District, not whether this District is more convenient for parties, witnesses, and in the interest of justice. The localized interest of a district exists when "the cause of action calls into question the work and reputation of several individuals residing in or near that district who presumably conduct business in that community." *Id.* at 1336. Such a situation presents itself here.

However, these interests are mitigated because a company's presence in a particular district weighs only slightly in favor of transfer because "it is generally a fiction that patent cases give rise to local controversy or interest, particularly without record evidence suggesting otherwise." *Found. Med., Inc.*, 2017 WL 590297, at *4. Along with this fiction, Ikorongo Texas's claims do specifically relate to infringement in this District. This fact holds true regardless of when the entity formed because Ikorongo Texas has the exclusive right to assert infringement claims that arise within this District. Accordingly, the Court finds that the local interest in having localized interests decided at home weighs neutrally.

iii. Familiarity of the Forum with the Law That Will Govern the Case

Both parties agree that this factor is neutral. Mot. to Transfer at 13; Resp. at 19. The Court also agrees.

iv. Avoiding Conflict of Laws and the Application of Foreign Laws Factors

Both parties agree that this factor is neutral. Mot. to Transfer at 13; Resp. at 19. The Court also agrees.

IV. Conclusion

Having found that LG has not met the threshold issue as to Ikorongo Texas and, even if it has satisfied the threshold issue, that the access to proof and the cost of attendance for willing witnesses weigh in favor or only slightly in favor of transfer while other practical problems that make trial of a case easy, expeditious and inexpensive, and administrative difficulties weigh against transfer with the other factors being neutral, the Court finds that LG has not met its "heavy burden" to demonstrate that the Northern District of California is "clearly more convenient." *Volkswagen II*, 545 F.3d at 314 n.10, 315.

IT IS THEREFORE ORDERED that Defendants' Motion to Transfer (ECF No. 27) is **DENIED**. It is further **ORDERED** that the above-styled case remain on the docket of United States District Judge Alan D Albright.

SIGNED this 1st day of March, 2021.

ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

APPENDIX E

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

IKORONGO TEXAS LLC and IKORONGO TECHNOLOGY LLC,	§	**CAUSE NO. 6:20-cv-00843-ADA**
Plaintiffs,	§	
v.	§	
UBER TECHNOLOGIES, INC.,	§	
Defendant.	§	

ORDER DENYING DEFENDANT'S MOTION TO TRANSFER

Before the Court is Defendant Uber Technologies, Inc.'s Opposed Motion to Transfer (ECF No. 26), Plaintiffs Ikorongo Texas LLC and Ikorongo Technology LLC's (collectively "Ikorongo") Response (ECF No. 41), and Uber's Reply (ECF No. 44). After careful consideration of the Motion, the Parties' briefs, and the applicable law, the Court **DENIES** Defendant Uber's Motion to Transfer.

I. BACKGROUND

Plaintiff Ikorongo Texas LLC is a Texas limited liability company. Pls.' Resp., ECF No. 41 at 2. Plaintiff Ikorongo Technology LLC is a North Carolina limited liability company. *Id.* Ikorongo Texas

LLC is the owner of exclusive rights under RE 45,543 and RE 47,704 (collectively the "Asserted Patents") only in a specified geographic region limited to certain Texas counties, including counties located in this District (the "Specified Part"). *Id;* Pls.' Second Am. Compl., ECF No. 23 at ¶ 11. Ikorongo Technology LLC owns the entirety of the exclusive rights for the Asserted Patents except for the Specified Part. Pls.' Resp., ECF No. 41 at 2. Ikorongo Technology LLC assigned to Ikorongo Texas LLC full and exclusive rights under the Asserted Patents within the Specified Part. Pls.' Second Am. Compl., ECF No. 23 at ¶ 8. This assignment included the right to sue for patent infringement within the Specified Part. *Id.*

Defendant Uber is a Delaware corporation with its principal place of business in San Francisco, California. Def.'s Mot. to Transfer, ECF No. 26 at 2.[1]

Ikorongo Texas LLC filed this action on September 15, 2020, pursuant to the Court's original jurisdiction under 28 U.S.C. §§ 1331 and 1338(a). Pl.'s Compl., ECF No. 1. Ikorongo Texas LLC and Ikorongo Technology LLC then filed an amended complaint on September 16, 2020. Pls.' Am. Compl., ECF No. 2. Ikorongo Texas and Ikorongo Technology filed a second amended complaint on December 22, 2020. Pls.' Second Am. Compl., ECF No. 23. Plaintiffs accuse Uber of infringing the Asserted Patents based on three primary alleged Uber features: (1) rider pickup

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[1] While Defendant's Motion states that Uber Technologies, Inc. is a "limited liability company," the Court notes that Uber Technologies, Inc. is a corporation as indicated by utilization of "Inc." in its entity name.

assisted by geographic location transmission; (2) locational information sharing; and (3) "Uber Eats" courier location sharing (together, the "Accused Functionalities"). Def.'s Mot. at 3. On January 15, 2021, Uber filed this Motion to Transfer pursuant to 28 U.S.C. § 1404(a), seeking transfer from the Western District of Texas ("WDTX") to the Northern District of California ("NDCA"). *Id.* at 1. In Uber's Motion, Uber argues that transfer to the NDCA is proper because: (1) Ikorongo could have originally filed suit in the proposed transferee venue, and (2) the convenience of the parties and interests of justice weigh in favor of transfer. Def.'s Mot. at 1, 8. On April 7, 2021, Ikorongo filed its Response. Pls.' Resp. On April 14, 2021, Uber filed its Reply. Def.'s Reply, ECF No. 44.

II. LEGAL STANDARD

A. Section 1404 Transfer

In patent cases, motions to transfer under 28 U.S.C. § 1404(a) are governed by the law of the regional circuit. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). Under § 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." 28 U.S.C. § 1404(a). The party moving for transfer carries the burden of showing good cause. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 314 (5th Cir. 2008) [*Volkswagen II*] ("When viewed in the context of § 1404(a), to show good cause means that a moving party, in order to support its claim for a transfer, must . . . clearly demonstrate that

a transfer is '[f]or the convenience of parties and witnesses, in the interest of justice.'") (quoting 28 U.S.C. § 1404(a)).

The threshold inquiry under § 1404(a) is whether the case could initially have been brought in the proposed transferee forum. *In re Volkswagen AG*, 371 F.3d 201, 202–03 (5th Cir. 2004) [*Volkswagen I*]. If that inquiry is satisfied, the Court determines whether transfer is proper by analyzing and weighing various private and public interest factors. *Humble Oil & Ref. Co. v. Bell Marine Serv., Inc.*, 321 F.2d 53, 56 (5th Cir. 1963); *In re Apple Inc.*, 979 F.3d 1332, 1338 (Fed. Cir. 2020) (applying Fifth Circuit law).

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." *Volkswagen II*, 545 F.3d at 315 (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original).

The factors are neither exclusive nor exhaustive, and no one factor is dispositive. *Id.* In applying these factors, the court enjoys considerable discretion and assesses the case "on an 'individualized, case-by-case

consideration of convenience and fairness.'" *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010) (quotation omitted).

Although the plaintiff's choice of forum is not a separate factor entitled to special weight, respect for the plaintiff's choice of forum is encompassed in the movant's elevated burden to "clearly demonstrate" that the proposed transferee forum is "clearly more convenient" than the forum in which the case was filed. *Id.* at 314–15. While "clearly more convenient" is not necessarily equivalent to "clear and convincing," the moving party "must show materially more than a mere preponderance of convenience, lest the standard have no real or practical meaning." *Quest NetTech Corp. v. Apple, Inc.*, No. 2:19-cv-00118-JRG, 2019 WL 6344267, at *7 (E.D. Tex. Nov. 27, 2019); *see QR Spex, Inc. v. Motorola, Inc.*, 507 F. Supp. 2d 650, 664 (E.D. Tex. 2007) (stating that "[i]n a motion to transfer venue under § 1404(a) the moving party bears a *heavy burden* of demonstrating why the factors 'clearly favor such a change.'") (emphasis added); *see also TV-3, Inc. v. Royal Ins. Co. of Am.*, 28 F. Supp. 2d 407, 411 (E.D. Tex. 1998) (stating that "before this Court can order a transfer of this action, the defendants must carry a *strong burden* to prove that these factors clearly favor such a change.")(emphasis added); *see also Stephens v. W. Pulp Prod.*, No. CIV.A. 104-CV-152, 2005 WL 3359746, at *1 (E.D. Tex. Dec. 8, 2005) (stating that in a § 1404 motion, the "[d]efendant must carry a *heavy burden* to prove that these factors clearly favor such a change.")(emphasis added).

Additionally, when deciding a § 1404 motion to transfer, the Court "must draw all reasonable

inferences and resolve factual conflicts in favor of the non-moving party." *United States ex rel. Hernandez v. Team Fin., L.L.C.*, No. 2:16-CV-00432-JRG, 2020 WL 731443, at *4 (E.D. Tex. Feb. 13, 2020).

III. ANALYSIS

The Court now turns to Uber's § 1404(a) arguments. Uber argues that the NDCA is both a proper and more convenient venue for this action. Def.'s Mot. at 1, 8.

A. Uber Has Not Met the Threshold Requirement to Show That NDCA is a Proper Venue as to Ikorongo Texas LLC.

To determine whether a venue is proper for transfer, "[t]he preliminary question under § 1404(a) is whether a civil action 'might have been brought' in the destination venue." *Volkswagen II*, 545 F.3d at 312. Here, the Court finds that venue is not proper as to Ikorongo Texas LLC and, therefore, the Court cannot transfer the instant action to NDCA as requested by Defendant Uber.

Under 28 U.S.C. § 1400(b), a patent infringement action "may be brought" in any judicial district "[1] where the defendant resides, or [2] where the defendant has committed acts of infringement and has a regular and established place of business." 28 U.S.C. § 1400(b). For venue purposes, a corporation "resides" in its state of incorporation. *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 581 U.S._, 137 S. Ct. 1514, 1517 (2017). Venue in the NDCA is not established under the first clause of § 1400(b) because Uber is incorporated in the state of Delaware. Def.'s Mot. at 2. Additionally, Uber has not met its burden

to show that Ikorongo's current action could have initially been brought in the NDCA under the second clause of § 1400(b) because no acts of infringement occurred in the NDCA, with respect to Ikorongo Texas.

Ikorongo alleges that Uber committed acts of infringement throughout the United States. Pl.'s Compl., ECF No. 1 ¶¶ 16, 18, 26, 28. However, Ikorongo argues that the current action could not have been brought in the NDCA because Ikorongo Texas owns the exclusive right to sue for patent infringement under the Asserted Patents only in the Specified Part that includes counties in this District. Pls.' Resp. at 4. According to Ikorongo, this ownership only permits Ikorongo Texas to file suit in the WDTX because Uber's alleged acts of infringement with respect to Ikorongo Texas could only occur within the Specified Part. *Id.* at 4–5. Uber argues that the Ikorongo Complaint alleges nationwide infringement and thus, venue is proper in the NDCA. Def.'s Reply at 1. Uber also argues that the "strategic pre-suit corporate machinations and assignments" relating to the formation of Ikorongo Texas are a litigation tactic that this Court should not give merit to. *Id.* at 2–3.

The Court notes that the issues presented here are identical to those addressed by the Court's order denying transfer in *Ikorongo Texas LLC v. Lyft, Inc.* 6:20-cv-00258-ADA, Order Denying Lyft's Mot. to Transfer, ECF No. 68. The Court further notes that Uber now raises many of the same arguments raised by Lyft in the prior case. For the same reasons detailed in our previous order and expounded upon

below, the Court finds that venue is not proper as to Ikorongo Texas in NDCA.

Waterman v. Mackenzie, 138 U.S. 252 (1891) and 35 U.S.C. § 261 provide the principles that a patentee or his assigns can assign, grant, and convey an exclusive right under a patent to the whole or any specified part of the United States. *Waterman v. Mackenzie*, 138 U.S. 252, 255 (1891); 35 U.S.C. § 261. By assignment, Ikorongo Texas has the exclusive right to enforce the Asserted Patents only within the Specified Part. Pls.' Second Am. Compl., ECF No. 23 at ¶ 8.

Uber argues that the Amended Complaint, which names both Ikorongo Texas and Ikorongo Technology, is the operative complaint. Def.'s Reply at 1–2. Uber further asserts that the Amended Complaint alleges nationwide infringement and, therefore, venue is proper in NDCA as to both Ikorongo Texas and Ikorongo Technology under 28 U.S.C. § 1400(b). *Id.* The

Court agrees that the "amended complaint . . . supersede[s] the original complaint under the well-settled law of this circuit." *See Eason v. Holt*, 73 F.3d 600, 603 (5th Cir. 1996); *King v. Dogan*, 31 F.3d 344, 346 (5th Cir. 1994). Additionally, venue is determined based upon the parties and allegations at the time the operative complaint is filed. *Bose Corp. v. Sunshine Elecs. of New York, Inc.*, 2006 WL 1027684, at *2 n.4 (N.D. Tex. Apr. 12, 2006); *In re Rearden LLC*, 841 F.3d 1327, 1332 n.2 (Fed. Cir. 2016). However, the Court disagrees with Uber's assertion that the Amended Complaint establishes proper venue in NDCA with respect to Ikorongo Texas. As previously stated,

Ikorongo Texas only has the right to enforce its patent rights within the Specified Part, which includes certain counties within this District.

With respect to Ikorongo Texas, venue cannot be established under 28 U.S.C. § 1400(b) in NDCA because Ikorongo Texas does not have patent rights to enforce in NDCA, notwithstanding the alleged nationwide infringement.

Importantly, venue is proper in this District with respect to both Ikorongo Texas and Ikorongo Technology because each Plaintiff has the right to enforce the Asserted Patents in certain counties within this District. Pls.' Resp. at 4. This Court finds that venue is proper with respect to both Plaintiffs within this District but is improper with respect to Ikorongo Texas in the NDCA. Thus, the Defendant fails the threshold inquiry of 28 U.S.C. § 1404(a) because this action, even in view of the operative Amended Complaint, could not have initially been brought in the proposed transferee venue.

Lastly, Uber asserts that this Court should disregard the formation of Ikorongo Texas and its acquisition of patent rights to a specified part because of a purported ploy to defeat transfer. Def.'s Reply at 2–3. The Court already rejected this "gamesmanship" argument in the previous

order denying Lyft's motion to transfer. *Ikorongo Texas LLC v. Lyft, Inc. Ikorongo Texas LLC v. Lyft, Inc.*, 6:20-cv-00258-ADA, Order Denying Lyft's Mot. to Transfer, ECF 68 at 5.

Because Uber has not met the threshold inquiry of the § 1404(a) analysis to show that the NDCA is a

proper venue as to Ikorongo Texas, transfer to NDCA is improper. However, even assuming, *arguendo*, that Uber has met the threshold issue as to Ikorongo Texas, the *Volkswagen* private and public interests factors do not support transfer, because Uber has not shown that the NDCA is a "clearly more convenient" venue. *See Volkswagen II*, 545 F.3d at 315.

B. The *Volkswagen* Private and Public Interest Factors Weigh Against Transfer.

In the Fifth Circuit, the determination of "convenience" turns on a number of public and private interest factors, none of which can be said to be of dispositive weight. *Action Indus., Inc. v. U.S. Fid. & Guar. Co.*, 358 F.3d 337, 340 (5th Cir. 2004). 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." *Volkswagen II*, 545 F.3d at 315 (quoting *Volkswagen I*, 371 F.3d at 203). The 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.* (quoting *Volkswagen I*, 371 F.3d at 203) (alterations in original). If, when added together, the relevant private and public interest factors are in equilibrium, or even if they do not clearly lean in favor of the transferee venue, the motion must be denied.

Volkswagen II, 545 F.3d at 315. Once again, the Court's ultimate inquiry is which forum will best serve the convenience of the parties and the interests of justice. *Koster v. Am. Lumbermens Mut. Cas. Co.*, 330 U.S. 518, 527 (1947).

In the instant case, the *Volkswagen* private and public interest factors do not support Uber's Motion to Transfer. Uber has not "clearly demonstrated" that the NDCA is a "clearly more convenient venue" than the WDTX. *See Volkswagen II*, 545 F.3d at 315.

1. The Private Interest Factors Do Not Clearly Demonstrate that the Northern District of California is a More Convenient Venue.

i. The Relative Ease of Access to Sources of Proof

A court looks to where documentary evidence, such as documents and physical evidence, is stored when considering the first private interest factor. *Volkswagen II*, 545 F.3d at 316. To properly consider this factor, parties must "describe with specificity the evidence they would not be able to obtain if trial were held in the [alternate forum]." *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 258 (1981).

Uber claims that the sources of proof factor weighs in favor of transfer, stating that the NDCA is the nexus for the Accused Functionalities' research, design, and development. Def.'s Mot. at 8. Additionally, Uber states that the Accused Functionalities rely on integrated services provided by Google and Apple, and that evidence related to

those services would also be located in the NDCA. *Id.* at 9.

Ikorongo responds that this factor weighs against transfer. Pls.' Resp. at 5. In its Response, Ikorongo states that Uber stores its documents on Google Drive, a cloud-based storage system. *Id.* at 6. According to Ikorongo, Google Drive stores data across Google's multiple data centers, of which, one data center is located less than 90 miles from Waco, and none are located in California. *Id.* Additionally, Ikorongo states that Uber presented no argument that Google or Apple possess documentary evidence in NDCA. *Id.* While Google and Apple are headquartered in NDCA, Ikorongo points to Google and Apple having offices and personnel located within this District. *Id.* at 7.

In its Reply, Uber states that Ikorongo has no evidence that Uber's documents are stored on Google data centers located within Texas, as opposed to data centers located outside of Texas. Def.'s Reply at 3. With respect to the third-party sources of proof, Uber states that Ikorongo has no evidence that Google or Apple employees within this District possess any relevant documentary evidence. *Id.*

The Court finds that the ease of access to sources of proof factor is neutral. Uber's documents are not physically located in either this District or NDCA, but rather exist persistently across Google's multiple data center locations. Pls.' Resp. at 6. Uber's documents stored on Google Drive are not physically located in the NDCA because there are no Google data centers in NDCA or California in general. Pls.' Resp. at 6.[2]

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2 *See* https://cloud.google.com/docs/compare/data-centers;

While Uber's documents are also not physically stored in this District, Google does have a data center in Midlothian, Texas, less than 90 miles away in the Northern District of Texas. *Id.* Nevertheless, because Uber's documentary evidence is not physically located in either District, the Court will not attach much weight to its location.

Uber points to precedent stating that the court should be mindful of the location of research, design, and development in determining ease of access to sources of proof. Def.'s Mot. at 8–9; s*ee XY, LLC v. Trans Ova Genetics, LC*, 2017 WL 5505340, at *13 (W.D. Tex. Apr. 5, 2017); *Affinity Labs of Texas, LLC v. Blackberry Ltd.*, 2014 WL 10748106, at *6 (W.D. Case 6:20-cv-00843-ADA Document 26 Filed 01/15/21 Page 12 of 219 Tex. June 11, 2014). Uber notes that the majority of the Accused Functionalities research, design, and development occurred in the NDCA. Def.'s Mot. at 8–9. While the court should be mindful of the location where the Accused Functionalities were researched, designed, and developed, this should not serve as to substitute the actual location of documentary evidence if that evidence is physically stored elsewhere. *See Volkswagen II*, 545 F.3d at 316. Although Uber has provided evidence that the Uber employees who researched, designed, and developed the Accused Functionalities are located in the NDCA, Uber has not provided evidence that documentary evidence related to research, design, and development is located in the NDCA. Def.'s Mot. at 3, 8–9. If Uber's documents related to research and development are

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www.google.com/about/datacenters/locations/ (last visited April 5, 2021).

physically stored on Google servers located elsewhere, then the Court should not give much weight to the location of research and development, with regards to this factor. *See Volkswagen II*, 545 F.3d at 316.

Uber argues that the location of evidence relating to Google and Apple's integrated services tips this factor in favor of transfer. Def.'s Mot. at 9. Uber points to this Court's previous case, *Parus Holdings Inc.*, to assert that the majority of evidence relating to the integrated services provided by Google and Apple likely resides in the NDCA. *Id.; see Parus Holdings Inc. v. LG Elecs. Inc.*, 2020 WL 4905809, at *3 (W.D. Tex. Aug. 20, 2020) (noting "it is likely that LG and Google will have the bulk of the documents relevant to this case in NDCA"). However, the Court's finding in *Parus Holdings Inc.* was specific to documents relevant to *that case*. While Uber is correct that Ikorongo has not provided specific evidence showing that documentary evidence relevant to *this case* from Apple and Google reside in the WDTX, neither has Uber provided specific evidence showing that Apple and Google's documents relevant to *this case* reside in the NDCA. Def.'s Reply at 3; Def.'s Mot. at 9. Because Uber has not provided evidence that documents from Apple and Google relevant to the instant case are physically located in the NDCA, this factor weighs neutrally as to third-party documentary evidence.[3]

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[3] Ikorongo counters by pointing to this Court's subpoena power over Google and Apple through their Austin locations. Pls.' Resp. at 7. However, this subpoena power is irrelevant to the ease of access factor and says nothing about the physical location of documentary evidence.

While there is a lack of documentary evidence located in this District, the physical location of Uber's documents and the lack of evidence as to the physical location of relevant third-party evidence causes this factor to weigh neutrally.[4]

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[4] This Court, having made its determination of this factor solely on the basis of binding precedent, wishes to reiterate the concern it outlined in *Fintiv* as to the Fifth Circuit's precedent on this factor. *See Fintiv, Inc. v. Appl Inc.*, 6:18- cv-00372-ADA, 2019 WL 4743678, at *4 (W.D. Tex. Sep. 13, 2019). In this Court's experience, the vast majority of produced documents in patent litigation cases are electronic documents pulled from a party's server. Documents stored on a server in Mountain View, California can be as easily accessed by a court in Alexandria, Virginia as they can be by a Court in San Jose, California. Thus, in this Court's opinion the physical location of electronic documents bears little weight in the determination of a convenient venue. Consequently, the Fifth Circuit inserts a rigid test into an otherwise flexible analysis. Retaining the present framework subverts rather than promotes the stated goals of motions to transfer venue. In close cases, the relative ease of access to sources of proof may serve as the deciding factor in a Court's analysis. Thus, a transferee venue that is in fact no more convenient than the transferor venue, nonetheless, may appear on paper to be clearly more convenient. This thumbs the scales in the movant's favor as to a motion that purportedly defers to the plaintiff's choice of venue when the two venues are comparably convenient. *See In re Volkswagen of Am., Inc.*, 545 F.3d 304, 314 (5th Cir. 2008) (noting that the plaintiff's choice of venue should be respected when the transferee venue is not clearly more convenient that the transferor venue). Although this Court would not decide this case differently were the standard for this factor changed, this Court restates its hope that the Fifth Circuit will consider revisiting and amending its precedent to explicitly give courts the discretion to take into consideration the ease of accessing electronic documents in modern times.

ii. The Availability of Compulsory Process to Secure the Attendance of Witnesses

When determining this factor, the Court considers the availability of compulsory process to secure the attendance of witnesses whose attendance may require a court order. *Volkswagen II*, 545 F.3d at 316. The Court focuses particularly on non-party witnesses whose attendance may need to be secured by a court order. *ParkerVision, Inc. v. Intel Corp.*, No. 6:20-cv-00108-ADA, 2021 WL 401989, at *3 (W.D. Tex. Jan. 26, 2021).

In its Motion, Uber asserts that that this factor weighs in favor of transfer because relevant third-party witnesses from Google and Apple, two named inventors, and various prior art witnesses are located in the NDCA. Def.'s Mot. at 10. Ikorongo responds that the factor weighs against transfer. Pls.' Resp. at 9. Ikorongo argues that Uber provided no evidence that the "cherry-picked" Google employees in the NDCA have actual knowledge or are likely to be picked as witnesses over the Google employees located in this District. *Id.* at 7, 8. Ikorongo also argues that the two named inventors currently residing in the NDCA are paid Ikorongo consultants who are willing to travel to Texas for trial, and two other inventors live in states closer to the WDTX than the NDCA. *Id.* at 8. Additionally, Ikorongo states that alleged underlying direct infringers, including Uber passengers located within this District, may be subpoenaed to testify. *Id.* at 9.

The Court finds the availability of compulsory process factor to be neutral. With regard to third-

party witnesses such as Apple and Google, this Court previously held that certain third parties with locations within this District and their employees do fall within the Court's subpoena power. *ParkerVision, Inc. v. Intel Corp.*, No. 6:20-cv-00108-ADA, 2021 WL 401989, at *3 (W.D. Tex. Jan. 26, 2021). Because both Districts have subpoena power over Apple and Google, the factor remains neutral. Def.'s Mot. at 10; Pls.' Resp. at 7. Additionally, with regard to third- party prior art witnesses, this Court has noted that prior art witnesses are generally unlikely to testify at trial, and the weight afforded to their presence in this transfer analysis is minimal. *CloudofChange, LLC v. NCR Corp.*, No. 6:19-cv-00513, 2020 WL 6439178, at *4 (W.D. Tex. Mar. 17, 2020); *Fintiv, Inc.*, 2019 WL 4743678, at *5; *East Tex. Boot Co., LLC v. Nike, Inc.*, No. 2:16-cv-0290-JRG-RSP, 2017 WL 28559065 at *4 (E.D. Tex. Feb. 15, 2017).

Finally, with regards to the two inventors' "willingness" and this factor, when no party has alleged or shown any witness's unwillingness, the court should not attach much weight to the compulsory process factor. *Duha v. Agrium, Inc.*, 448 F.3d 867, 877 (6th Cir. 2006); *CloudofChange, LLC*, 2020 WL 6439178, at *4. Neither party has asserted that either of the two inventors are unwilling to travel to the WDTX. Pls.' Resp. at 8; Def.'s Mot. at 10. However, Ikorongo's assertion that the other two inventors live in states closer to this District is irrelevant to this factor because neither District has subpoena power over them. Given these considerations, the Court finds the availability of compulsory process factor neutral.

iii. The Cost of Attendance for Willing Witnesses

The convenience of witnesses is the most important factor in a § 1404(a) analysis. *In re Genetech, Inc.*, 566 F.3d 1338, 1342 (Fed. Cir. 2009). While a court should not consider the significance of identified witnesses' testimonies, a court should consider whether the witnesses may provide materially relevant evidence. *Id.* at 1343.

The Fifth Circuit's 100-mile rule states that "[w]hen the distance between an existing venue for trial of a matter and a proposed venue § 1404(a) is more than 100 miles, the factor of inconvenience of witnesses increases in direct relationship to the additional distance to be traveled." *In re TS Tech USA Corp.*, 551 F.3d at 1320 (quoting *Volkswagen I*, 371 F.3d at 204– 05). Additionally, the Federal Circuit has rejected courts giving more weight to the fact that witnesses "need to travel a greater distance to reach" a venue, noting that non-party witnesses "will likely have to leave home for an extended period" whether or not the case was transferred, and thus such witnesses would only be slightly more inconvenienced by having to travel to an extra distance. *In re Apple Inc.,* 979 F.3d at 1342. Importantly, the venue need not be convenient for *all* witnesses. *Genetech, Inc.*, 566 F.3d at 1345. If a substantial number of witnesses reside in one venue and no witnesses reside in another, the factor will weigh in favor of the venue where witnesses reside. *See id.*

As previously stated by this Court, "given typical time limits at trial, the Court does not assume that all of the party and third-party witnesses listed in

1404(a) briefing will testify at trial." *Fintiv, Inc. v. Apple Inc.*, No. 6:18-cv-00372-ADA, 2019 WL 4743678, at *6 (W.D. Tex. Sept. 13, 2019). Indeed, the Court assumes only a few party witnesses and even fewer non-party witnesses (if any) will testify at trial. *Id.* Consequently, long lists of potential party and non-party witnesses do not affect the Court's analysis for this factor. *Id.*

Uber argues that this factor strongly favors transfer. Def.'s Mot. at 11. Uber asserts that the majority of its relevant party witnesses and third-party witnesses are located in the NDCA. *Id.* Uber also asserts that none of its few employees located in this District are related to the merits of this litigation. *Id.* at 12.

Ikorongo responds that Uber did not provide reliable evidence that knowledgeable Uber employees are located in the NDCA. Pls.' Resp. at 9. Ikorongo also states that North Carolina, where its CEO and employees reside, is closer to this District than the NDCA. *Id.* at 10. Additionally, Ikorongo argues that the relative meal and lodging costs in Waco are less expensive compared to San Francisco. *Id.* at 11.

First, based on the Court's experience, inventor testimony is one of the most critical witnesses that will testify live at trial. *Uniloc 2017 LLC v. Apple Inc.,* 6-19-CV-00532-ADA, 2020 WL 3415880, at *6 (W.D. Tex. June 22, 2020). The Federal Circuit has explained that out- of-state witnesses "will likely have to leave home for an extended period of time and incur travel, lodging, and related costs" regardless of the venue. *In re Apple Inc.*, 979 F.3d at 1342. Although two of the inventors currently live in the NDCA, these

inventors are paid consultants of Ikorongo who are willing to attend trial in Waco. Pls.' Resp. at 8. As these two inventors would not incur any travel, lodging, or related costs by attending trial in Waco, but would still experience the inconvenience of traveling to Waco from the NDCA, the inconvenience to these inventors negligibly favors transfer.

Second, the convenience of party witnesses is typically given little weight because the witnesses' employer could compel their testimony at trail. *Turner v. Cincinnati Ins. Co.*, 6:19-cv- 642-ADA-JCM, 2020 WL 210809, at *4 (W.D. Tex. Jan. 14, 2020); *Freehold Licensing, Inc. v. Aequitatem Capital Partners, LLC*, A-18-cv-413 LY, 2018 WL 5539929, at *7 (W.D. Tex. Oct. 29, 2018). Some courts have considered how far these witnesses would need to travel if few or no witnesses reside within the current district. *See, e.g., Genetech, Inc.*, 566 F.3d at 1345 (determining the convenience factor favored transfer, and not only slightly, in part because the defendants' employees and managers would not have to travel as far and the foreign plaintiff had no connection to the current venue); *contra Fintiv, Inc.*, 2019 WL 4743678, at *6 (stating the cost of attendance for party witnesses did not weigh for or against transfer because there were several potential witnesses in both venues). The NDCA is more convenient than the WDTX for Uber employees knowledgeable about the Accused Functionalities, who are located in the NDCA. *See* Def.'s Mot. at 11. However, the NDCA is "slightly less convenient" than the WDTX for Ikorongo's members located in North Carolina. *See id.*; *see In re Genentech, Inc.*, 566 F.3d at 1348. Therefore, the inconvenience to party-witnesses slightly favors transfer.

Considering the NDCA's slight convenience to the two paid inventors and the slight net convenience to the party-witnesses, the Court finds that the cost of attendance factor only slightly favors transfer.

iv. Other Factors That Make Trial Easy, Expeditious, and Inexpensive

When considering a motion to transfer, the court considers "all other practical problems that make trial of a case, easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315. Uber argues that mere co-pendency of related suits does not automatically preclude transfer to a more convenient venue. Def.'s Reply at 4–5. Ikorongo responded that Bumble, LG, Samsung, and Lyft all have cases pending before this Court, and judicial economy would be best served by having this Court handle each of these similar cases. Pls.' Resp. at 12.

The Court finds this factor weighs against transfer. While cases involving the same patents with different defendants, products, and witnesses will not *necessarily* be expedited by being in the same court, judicial economy may be served best by having the same court try similar cases involving the same patents. *See Hammond Dev. Int'l, Inc. v. Google LLC*, 1:20-cv- 00342-ADA, 2020 WL 3452987 (W.D. Tex. June 24, 2020) (denying motion to transfer venue and finding that judicial economy was served by having the same district court try cases involving the same patents due to consolidation of the cases). As Ikorongo correctly points out, it has filed suit against Bumble in this District for infringing on patents asserted in this action, and Bumble withdrew its motion to transfer. Pls.' Resp. at 12–13. This Court also recently

denied a motion to transfer by Lyft in a suit brought by Ikorongo alleging infringement of the same patents asserted in this action. 6:20-cv-00258-ADA, Order Denying Lyft's Mot. to Transfer, ECF 68. Notably, the Court does not find this factor weighs against transfer merely because Ikorongo has filed suits against multiple defendants in this District. Rather, judicial economy and the possibility of inconsistent rulings causes the Court to find this factor weighs against transfer, given that at least two of the co-pending cases will remain in this District.

2. The Public Interest Factors Do Not Clearly Demonstrate that the Northern District of California is a More Convenient Venue.

i. Administrative Difficulties

Administrative difficulties manifest when litigation accumulates in congested centers instead of being handled at its origin. *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508 (1947). This factor concerns "whether there is an appreciable difference in docket congestion between the twoforums." *Parsons v. Chesapeake & Ohio Ry. Co.*, 375 U.S. 71, 73 (1963); *Koehring Co. v. Hyde*

Constr. Co., 324 F.2d 295, 296 (5th Cir. 1963). The relevant inquiry under this factor is the speed with which a case comes to trial and is resolved. *Genetech, Inc.*, 566 F.3d at 1347.

Uber argues that this factor is neutral if it is relevant at all. Def.'s Mot. at 14. Ikorongo argues that this factor favors retention because this Court has a substantially faster time to trial compared to the

NDCA, and the NDCA has experienced extended delays due to the Covid-19 pandemic. Pls.' Resp. at 14.

The Court finds this factor weighs against transfer. This Court has previously analyzed the difference in congestion between the NDCA and the WDTX. *Parus Holdings Inc.*, 2020 WL 4905809, at *7. At that time, this Court's time-to-trial was 25% faster than the NDCA. *Id.* Additionally, the Waco Division of the Western District of Texas has its own patent-specific Order Governing Proceedings ("OGP") that ensures efficient administration of patent cases. These facts indicate a greater efficiency of bringing cases, especially patent cases, to trial in the WDTX over the NDCA. As such, this factor weighs against transfer.

ii. Local Interests

There is "a local interest in having localized controversies decided at home." *Gulf Oil Corp.*, 330 U.S. at 511; *Piper Aircraft*, 454 U.S. at 260.

Uber argues that the NDCA has a powerful local interest in this matter because Uber's headquarters is located in the NDCA and the Accused Functionalities were designed and developed in that District. Def.'s Mot. at 14. Uber also asserts that Ikorongo has no real presence in this District. *Id.* at 15. Ikorongo argues that this District has a local interest in this matter because Ikorongo Texas only has exclusive rights to the Asserted Patents in the Specified Part, including counties in this District. Pls.' Resp. at 15. Ikorongo also points to the fact that Uber earns a significant amount of money in this District. *Id.* Uber replies by

stating that Ikorongo's argument regarding Uber's revenue in Texas is irrelevant. Def.'s Reply at 5.

The Court finds this factor weighs neutrally. Uber correctly argues that the sale of an accused product offered nationwide does not give rise to a substantial interest in any single venue. *Id.; In re Acer Am. Corp.*, 626 F.3d 1252, 1256 (Fed. Cir. 2010); *see also In re Hoffmann- La Roche Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009) (stating that infringement of an accused product offered nationwide does not allow for any venue to claim a substantial interest). The localized interest of a district exists when "the cause of action calls into question the work and reputation of several individuals residing in or near that district who presumably conduct business in that community." *In re Hoffmann-La Roche Inc.*, 587 F.3d at 1336. Such a situation presents itself here as Uber suggests.

However, theses interests are mitigated and a company's presence in a particular district weighs only slightly in favor of transfer because "it is generally a fiction that patent cases give rise to local controversy or interest, particularly without record evidence suggesting otherwise." *Found. Med., Inc. v. Guardant Health, Inc.*, No. 2:16-CV-00523-JRG-RSP, 2017 WL 590297, at *4 (E.D. Tex. Feb. 14, 2017). Along with this fiction, Ikorongo Texas's claims do specifically relate to infringement in this District, because Ikorongo Texas has the exclusive right to assert infringement claims that arise within this District. Pls.' Resp. at 4. Accordingly, the Court finds this factor weighs neutrally.

iii. Familiarity of the Forum with the Law That Will Govern the Case

Both parties agree that this factor is neutral. Pls.' Resp. at 15; Def.'s Mot. at 15. The Court also agrees.

iv. Avoiding Conflict of Laws and the Application of Foreign Laws Factors

Both parties agree that this factor is neutral. Pls.' Resp. at 15; Def.'s Mot. at 15. The Court also agrees.

IV. CONCLUSION

Having found that Uber failed to meet the threshold requirement for proper venue, and even if it has satisfied the threshold requirement, that the cost of attendance for willing witnesses weighs only slightly in favor of transfer, other practical problems that make trial of a case easy, expeditious, and inexpensive, and administrative difficulties weigh against transfer, and ease of access to sources of proof, availability of the compulsory process, local interest in having localized interests decided at home, familiarity of the forum with governing law, and avoidance of conflict of laws are neutral, the Court finds that Uber has not "clearly demonstrated" that the Northern District of California is "clearly more convenient." *Volkswagen II*, 545 F.3d at 314 n.10, 315.

IT IS THEREFORE ORDERED that Defendant Uber's Motion to Transfer (ECF No. 26) is **DENIED**. It is further **ORDERED** that the above-styled case remain on the docket of United States District Judge Alan D Albright.

SIGNED this 26th day of May, 2021.

ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

APPENDIX F

United States Court of Appeals for the Federal Circuit

IN RE: SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., LG ELECTRONICS INC., LG ELECTRONICS USA, INC.,

Petitioners

2021-139, 2021-140

On Petitions for Writs of Mandamus to the United States District Court for the Western District of Texas in Nos. 6:20-cv-00257-ADA, 6:20-cv-00259-ADA, Judge Alan D. Albright.

ON PETITION FOR REHEARING EN BANC

Before MOORE *Chief Judge*, NEWMAN, LOURIE, DYK, PROST, O'MALLEY, REYNA, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

O R D E R

Respondents Ikorongo Technology LLC and Ikorongo Texas LLC filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that issued the order, and

thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

FOR THE COURT

August 30, 2021
Date

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

APPENDIX G

United States Court of Appeals for the Federal Circuit

IN RE: UBER TECHNOLOGIES, INC.,

Petitioner

2021-150

On Petitions for Writs of Mandamus to the United States District Court for the Western District of Texas in No. 6:20-cv-00843-ADA, Judge Alan D. Albright.

ON PETITION FOR REHEARING EN BANC

Before MOORE *Chief Judge*, NEWMAN, LOURIE, DYK, PROST, REYNA, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.[1]

PER CURIAM.

O R D E R

Respondents Ikorongo Technology LLC and Ikorongo Texas LLC filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that issued the order, and thereafter the petition for rehearing en banc was

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[1] Circuit Judge Kathleen M. O'Malley did not participate.

referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

FOR THE COURT

September 1, 2021
Date

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