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

SURFCAST, INC., Plaintiff, v. **MICROSOFT CORPORATION,** Defendant.	**6:21-cv-01018-ADA**

MEMORANDUM OPINION & ORDER

Came on for consideration this date is Defendant Microsoft Corporation's ("Microsoft" or "Defendant") Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a) to the Western District of Washington filed on April 22, 2022. ECF No. 33 (the "Motion"). Plaintiff SurfCast, Inc. ("SurfCast" or "Plaintiff") filed an opposition on August 5, 2022, ECF No. 50, to which Microsoft filed a reply on August 19, 2022. ECF No. 51. After careful consideration of the Motion, the parties' briefs, and the applicable law, the Court **GRANTS** Microsoft's Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a).

I. BACKGROUND

On July 22, 2021, SurfCast filed its complaint against Microsoft, alleging infringement of U.S. Patent Nos. 9,032,317 (the "'317 patent"), 9,043,712 (the "'712 patent"), 9,363,338 (the "'338 patent"), and 9,946,434 (the "'434 patent") (collectively, the "Asserted Patents"). ECF No. 1 (the "Complaint"). SurfCast is a Delaware corporation with its principal place of business in Lincolnville, Maine. *Id.* ¶ 2. Microsoft is a Washington Corporation with its principal place of business in Redmond, Washington. *Id.* ¶ 3. According to SurfCast's Complaint, Microsoft's products infringe the Asserted Patents by employing a display with a user interface that provides

"Live Tiles." *Id.* ¶¶ 18, 42. For all of the Asserted Patents, SurfCast identifies the following various products: the Microsoft Surface; the Xbox One; products with the Windows Phone 7 Operating System; products with the Windows RT Operating System; products with the Microsoft Windows 8, Microsoft Windows 8 Pro, and Microsoft Windows 8 Enterprise Operating Systems; products with the Microsoft Windows 8.1, Microsoft Windows 8.1 Pro, and Microsoft Windows 8.1 Enterprise Operating Systems; and products with the Microsoft Windows 10, Microsoft Windows 10 Pro, and Microsoft Windows 10 Enterprise Operating Systems. *Id.* ¶ 17. The Court will refer to all these products as the "Accused Products."

On April 22, 2022, Microsoft filed its Motion under 28 U.S.C. § 1404(a), seeking transfer to the Western District of Washington (the "WDWA"). ECF No. 33. That Motion is now ripe for judgement.

II. LEGAL STANDARD

In patent cases, regional circuit law governs motions to transfer under § 1404(a). *In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008). Section 1404(a) provides that, "[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." "Section 1404(a) is intended to place discretion in the district court to adjudicate motions for transfer according to an 'individualized, case-by-case consideration of convenience and fairness.'" *Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 29 (1988) (quoting *Van Dusen v. Barrack*, 376 U.S. 612, 622 (1964)).

"The preliminary question under § 1404(a) is whether a civil action 'might have been brought in the [transfer] destination venue." *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 312 (5th Cir. 2008) ("*Volkswagen II*"). If the destination venue would have been a proper venue, then "[t]he determination of 'convenience' turns on a number of public and private interest factors, none of

which can be said to be of dispositive weight." *Action Indus., Inc. v. U.S. Fid. & Guar. Co.*, 358 F.3d 337, 340 (5th Cir. 2004). The private factors include: "(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious[,] and inexpensive." *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) ("*Volkswagen I*") (citing *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 241 n.6, 102 S. Ct. 252, 70 L. Ed. 2d 419 (1981)). The public factors include: "(1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws of the application of foreign law." *Id.* The weight the Court gives to each of these assorted convenience factors will necessarily vary from case to case. *See Burbank Int'l Ltd. v. Gulf Consol. Int'l Inc.*, 441 F. Supp. 819, 821 (N.D. Tex. 1977). A court should not deny transfer where "only the plaintiff's choice weighs in favor of denying transfer and where the case has no connection to the transferor forum and virtually all of the events and witnesses regarding the case . . . are in the transferee forum." *In re Radmax, Ltd.*, 720 F.3d 285, 290 (5th Cir. 2013).

The moving party has the burden to prove that a case should be transferred for convenience. *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010). The burden that a movant must carry is not that the alternative venue is more convenient, but that it is *clearly* more convenient. *Volkswagen II*, 545 F.3d at 314 n.10. While "clearly more convenient" is not explicitly 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). Yet, the Federal Circuit has clarified that, for a court to hold that a factor favors transfer, the movant need not show an individual factor *clearly* favors transfer. *In re Apple Inc.*, 979 F.3d 1332, 1340 (Fed. Cir. 2020).

III. ANALYSIS

A. Venue and Jurisdiction in the Transferee Forum

The threshold determination in the § 1404(a) analysis is whether this case could initially have been brought in the destination venue—the Western District of Washington. *See Monolithic Power Sys., Inc. v. Meraki Integrated Cir. (Shenzhen) Tech., Ltd.*, No. 6:20-CV-00876-ADA, 2022 WL 958384, at *5 (W.D. Tex. Mar. 25, 2022). Microsoft asserts that this case could have been brought in the WDWA because "Microsoft is headquartered in the Western District of Washington." ECF No. 33 at 4. SurfCast does not dispute this contention. *See generally*, ECF No. 50. This Court finds that venue would have been proper in WDWA had SurfCast filed this case there. Thus, the Court proceeds with its analysis of the private and public interest factors to determine if the WDWA is clearly more convenient than the Western District of Texas ("WDTX").

B. Private Interest Factors

1. Relative Ease of Access to Sources of Proof

"In considering the relative ease of access to proof, a court looks to where documentary evidence, such as documents and physical evidence, is stored." *Fintiv, Inc. v. Apple Inc.*, No. 6:18-cv-00372-ADA, 2019 U.S. Dist. LEXIS 171102, at *5 (W.D. Tex. Sep. 10, 2019). This factor relates to the relative—not absolute—ease of access to non-witness evidence. *See In re Radmax*, 720 F.3d at 288; *In re Apple*, 979 F.3d at 1339. "[T]he movant need not show that all relevant documents are located in the transferee venue to support a conclusion that the location of relevant documents favors transfer." *In re Apple*, 979 F.3d at 1340; *In re Juniper Networks*, 14 F.4th 1313,

1321 (Fed. Cir. 2021) ("We have held that the fact that some evidence is stored in places other than either the transferor or the transferee forum does not weigh against transfer.").

The Fifth Circuit has held that, even in the context of electronic documents that can be accessed anywhere on earth, this factor is not superfluous. *See Volkswagen II*, 545 F.3d at 316; *In re Dish Network L.L.C.*, No. 2021-182, 2021 U.S. App. LEXIS 31759, at *6 (Fed. Cir. Oct. 21, 2021). Though having consistently characterized that holding as antiquated in the setting of a modern patent dispute, this Court will continue to analyze this factor with a focus on the location of: physical documents and other evidence; and the hardware storing the relevant electronic evidence. *See Def. Distributed v. Bruck*, 30 F.4th 414, 434 & n.25 (5th Cir. 2022) (giving weight to the location of servers hosting the electronic documents in dispute); *Bluebonnet Internet Media Servs., LLC v. Pandora Media, LLC*, No. 6-20-CV-00731-ADA, 2021 U.S. Dist. LEXIS 137400, at *7 & n.1 (W.D. Tex. July 22, 2021). The Federal Circuit has held, however, that it is error not to also consider: "the location of document custodians and location where documents are created and maintained, which may bear on the ease of retrieval." *In re Google LLC*, No. 2021-178, 2021 U.S. App. LEXIS 33789, at *7 (Fed. Cir. Nov. 15, 2021); *see also Def. Distributed*, 30 F.4th at 434 & n.25 (considering, under this factor, where the "research, design, development, manufacturing, and publishing" of the allegedly offending files occurred). Finally, evidence located at a party's office that is not a "place of regular business" may be discounted. Activities. *In re Google LLC*, No. 2022-140, 2022 WL 1613192, at *4 (Fed. Cir. May 23, 2022).

Microsoft represents that the "accused products were designed, developed, supported, marketed, and sold from Microsoft's headquarters in Redmond, Washington and its nearby Bellevue, Washington offices, in the Western District of Washington." ECF No. 33 at 4 (citing ECF Nos. 33-3 ¶13, 33-2 ¶ 13). It further contends that "evidence — including records relating to

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