

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

In re: GOOGLE LLC,
Petitioner

2021-171

On Petition for Writ of Mandamus to the United States District Court for the Western District of Texas in No. 6:20-cv-00453-ADA, Judge Alan D. Albright.

ON PETITION

Before LOURIE, BRYSON, and TARANTO, *Circuit Judges*.

PER CURIAM.

O R D E R

Google LLC petitions this court for a writ of mandamus directing the United States District Court for the Western District of Texas to transfer this action to the United States District Court for the Northern District of California. We conclude that the district court's refusal to transfer the case constituted a clear abuse of discretion. We therefore grant mandamus directing transfer.

I

Jenam Tech, LLC, filed a complaint in the Waco Division of the Western District of Texas charging Google, a Delaware corporation headquartered in Mountain View, California, with patent infringement. Jenam alleged that Google's use of the Quick UDP Internet Connections ("QUIC") protocol infringes eight patents relating to methods, systems, and computer products for sharing information to detect an idle Transmission Control Protocol connection.

Google moved to transfer the case to the Northern District of California pursuant to 28 U.S.C. § 1404(a). Google noted that Jenam's only registered place of business and its only employee, George Andrew Gordon, are located in the Eastern District of Texas. App. 362. Google further pointed out that a different company based in the Northern District of California, Oso-IP, LLC, appears to handle licensing of Jenam's patents to others. *Id.* Google noted that witnesses knowledgeable about the implementation and maintenance of the protocol and potential prior art reside in the Northern District of California. App. 362–64.

Google also submitted a sworn declaration stating that the "vast majority of the research, design, development, and testing activities related to the QUIC protocol have occurred and continue to occur in Mountain View [California] or Cambridge [Massachusetts]," and "both the source code and technical documents related to Google's QUIC protocol are created and maintained in Mountain View and Cambridge." App. 379. Google stated it was unaware of any potential witnesses or sources of proof in the Western District of Texas.

Jenam responded that Google maintains an office in Austin, Texas, within the Western District of Texas. App. 478. In addition, Jenam argued that the Western District of Texas would be a convenient venue for its own witnesses

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and sources of proof. In support of that assertion, Jenam submitted a declaration from the inventor, Robert Paul Morris, who stated that he would “most likely be unwilling to testify in-person at a deposition, hearing or a trial” either in the Western District of Texas or the Northern District of California “during the COVID-19 pandemic.” App. 500. If he were required to testify, he stated, “it would be safer and far more convenient . . . for me to drive than to fly,” and that he would prefer driving to Waco from his home in Georgia rather driving to California. *Id.* Jenam also noted that the Western District of Texas would be more convenient than the Northern District of California for the patent prosecution attorney, who lives in the Northern District of Texas, and for Mr. Gordon, who lives in the Eastern District of Texas. App. 496.

On July 8, 2021, the district court issued an order denying Google’s transfer motion. At the outset, the court found that this action could have been brought in the Northern District of California. The court then analyzed Google’s transfer motion by applying the set of private-interest and public-interest factors that the Fifth Circuit has directed courts to use in making transfer decisions under section 1404(a). *See In re Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008) (en banc).

The district court took note of the five factors that were disputed between the parties: (1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of non-party witnesses whose attendance may need to be compelled by court order; (3) the relative convenience of the two forums for potential witnesses; (4) the administrative difficulties flowing from court congestion; and (5) the local interest in having disputes regarding activities occurring principally within a particular district decided by a court within that district.

As for the sources of proof, the district court recognized that Google kept local copies of the documents in the Northern District of California, App. 8–9, but found that it would not be difficult for Google to access those documents electronically from Google’s offices within the Western District of Texas, App. 8. As for Jenam’s documents, the court found that it would be more convenient for Mr. Gordon to transfer any documents in his possession to the Western District of Texas than to the Northern District of California. App. 9. On those grounds, the court concluded the sources-of-proof factor “weighs solidly against transfer.” *Id.*

With respect to the availability of compulsory process, Google identified five third-party witnesses who were located in the Northern District of California and who could be compelled to testify by a court in that district but not by the court in the Western District of Texas. The district court, however, found that Google had failed to show that four of those witnesses would be unwilling to testify at trial in the Western District of Texas; the court therefore discounted those witnesses for purposes of the compulsory process factor. App. 10–11. Finding that only one potential third-party witness was “likely unwilling to testify in Texas” (but could be subpoenaed by a court in the Northern District of California) the district court concluded that the compulsory process factor weighed in favor of transfer, but only slightly so. App. 12 (internal quotation marks omitted).

Addressing the convenience of potential witnesses, the court expressed the view that in patent cases generally, the court “assumes that no more than a few party witnesses—and even fewer third-party witnesses, if any—will testify live at trial” and therefore “long lists of potential party and third-party witnesses do not affect the Court’s analysis for this factor.” App. 13. Furthermore, the court expressed the view that the convenience of witnesses is not an

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important consideration in the case of party witnesses. App. 13. The court recognized that two Google employees who were potential witnesses resided in the Northern District of California. App. 13. However, the court concluded that the inconvenience to those Google employees of traveling to Waco would be equivalent to the inconvenience to Mr. Gordon of traveling to California if the case were transferred there. App. 14. The court therefore determined that the convenience-of-the-witnesses factor was neutral as to party witnesses. *Id.*

As for non-party witnesses, the court recognized that Oso-IP's principal and four former Google employees were potential witnesses and were located in the Northern District of California. *Id.* However, the court found that, as "the sole inventor of the Asserted Patents, the importance of Mr. Morris's testimony outweighs the testimony of Google's former employees." App. 15. The court observed that "[t]he additional travel, lodging, and related costs that Mr. Morris will incur with a 2,600-mile drive to the NDCA over a shorter, 900-mile trip to the WDTX amount to a significant difference of convenience." App. 16. The court also noted that Waco would be more convenient for the patent prosecution attorney, who lives in the Northern District of Texas. The court therefore found that the convenience of non-party witnesses weighed against transfer.

As to which district has the greater local interest in this dispute, the district court acknowledged that the Northern District of California had a local interest in resolving this case because the QUIC protocol was designed and developed in that district. App. 18. However, the court found that the local interest factor was neutral with respect to Google because "both Districts are home to Google facilities, employees, and are significant markets for the allegedly infringing products." *Id.* On the whole, the district court found that the local interest factor weighed against transfer on the ground that the Western District of Texas

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