Orrick, Herrington & Sutcliffe LLP
Columbia Center
1152 15th Street, N.W.
Washington, DC 20005-1706

+1 202 339 8400
orrick.com

Melanie L. Bostwick

E mbostwick@orrick.com
D +1 202 339 8483
F +1 202 339 8500

September 17, 2020

Via CM/ECF

Peter R. Marksteiner
Circuit Executive & Clerk of the Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

Re: *In re Apple Inc.*, No. 20-135

Dear Colonel Marksteiner:

Pursuant to Rule 28(j), Apple submits as supplemental authority *In re HP Inc.*, 2020 WL 5523561 (Fed. Cir. Sept. 15, 2020).

Like this case, *HP* involves a Texas district court's refusal to transfer patent litigation to the Northern District of California. This Court granted mandamus after concluding that the district court's reasoning on several transfer factors was flawed. Rather than merely accepting the district court's characterizations, this Court "revisit[ed] the court's analysis of the disputed transfer factors" and concluded that the district court had clearly abused its discretion. Order 4-5. For similar reasons, mandamus is also warranted here.

HP particularly demonstrates the district court's error in weighing the practical-problems factor against transfer. Like here, the district court in *HP* considered its own familiarity with the case as a reason to deny transfer. As this Court explained in *HP*, however, "motions to transfer venue are to be decided based on 'the situation which existed when suit was instituted,'" not on subsequent proceedings. Order 7 (citation omitted). In this case, the district court's error was even more egregious—it weighed the practical-problems factor "heavily against transfer" based principally on its familiarity with the asserted patent and the "significant steps [taken] in this case." SAppx29-30. Many of those "significant steps," however, were taken not only after "suit was instituted," and not only after Apple filed its transfer motion, but after the district court orally denied Apple's motion (and while Apple was waiting on the written opinion explaining that denial). Reply 13-14.

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HP also confirms the importance of witness convenience. In that case, like here, several witnesses resided in the California forum and no key witnesses resided in the Texas forum. Order 5. The district court therefore "erred in weighing this factor as neutral." Order 5. The district court committed the same error here, finding this factor neutral after giving little weight to the convenience of party witnesses and improperly considering witnesses who resided in neither forum. Pet. 22-24; Reply 10-11.

As in *HP*, "the court's decision lies far outside the boundaries of a reasonable exercise of discretion," and mandamus is warranted. Order 5.

Respectfully,

/s/ Melanie L. Bostwick
Melanie L. Bostwick
Counsel for Petitioner Apple Inc.

cc: Counsel of record (via CM/ECF)

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NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: HP INC.,
Petitioner

2020-140

On Petition for Writ of Mandamus to the United States District Court for the Eastern District of Texas in No. 4:19-cv-00696-ALM, Judge Amos L. Mazzant, III.

ON PETITION AND MOTION

Before NEWMAN, LOURIE, and HUGHES, *Circuit Judges*.

PER CURIAM.

O R D E R

HP Inc. petitions for a writ of mandamus to direct the United States District Court for the Eastern District of Texas to transfer this case to the United States District Court for the Northern District of California. Largan Precision Co., Ltd. opposes. HP replies. HP also moves without opposition to submit a supplemental appendix. For the following reasons, we grant HP's petition.

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BACKGROUND

Largan, a Taiwanese corporation, brought this suit against two other Taiwanese corporations, Ability Opto-Electronics Technology Co., Ltd. ("AOET") and Newmax Technology Co., Ltd, as well as against HP, for infringing four patents based on HP's incorporation of AOET's and Newmax's optical lenses into HP's laptops.

HP, joined by AOET and Newmax, moved pursuant to 28 U.S.C. § 1404(a) to transfer the case to the Northern District of California where HP is headquartered. Attached to HP's motion was a declaration filed by HP's Senior Litigation Manager, Anthony Baca. Baca identified ten HP employees residing in Northern California that had relevant knowledge regarding sales, marketing, revenue, and profits of the accused products. He added that no employee responsible for such activity works in the Eastern District of Texas. Baca additionally stated that documents relating to the design, development, marketing, and sales of the accused products were also in the transferee district and elsewhere, but not in the Eastern District of Texas.

HP further argued that the only state in the United States to which Largan has a connection is California, noting that Largan had previously filed two patent infringement suits in the Northern District of California, including an action alleging infringement of one of the patents asserted in this case as well as other related patents based on incorporation of Genius Electronic Optical Co., Ltd.'s lenses into Apple Inc.'s products. HP argued that Apple and Genius, which both have offices in Northern California, likely had material information relevant to invalidity and damages that the transferee venue could compel. HP added that transfer would preserve judicial economy given the Northern District of California was already familiar with the technology and one of the patents.

The district court denied the motion. In examining the factors related to the private interests of the litigants, the

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court acknowledged that physical sources of proof and potential willing witnesses are in the Northern District of California, and not the Eastern District of Texas. However, the court weighed those factors as neutral largely because more documents and witnesses would be coming from Taiwan. The court also recognized that Apple and Genius would likely be beyond the reach of its compulsory process powers, but nonetheless weighed the factor against transfer because "Largan identifie[d] specific third-party witnesses, with at least two residing in Texas." Appx24.

The district court also addressed several factors related to the public's interest. The court recognized that the local interest factor weighed at least slightly in favor of transfer given "more of the events giving rise to this suit appear to have occurred in the Northern District of California than in the Eastern District of Texas—specifically, the development of the accused products." Appx30. However, the court weighed against transfer that it had "already gained familiarity with the parties and issues in this case in deciding Defendants' personal jurisdictional challenge" and because "AOET indicated its plans to relitigate its personal jurisdictional challenge if this case is transferred to the Northern District of California." Appx28.

Finding that one factor weighed in favor of transfer, two weighed against transfer, and the rest neutral, the court concluded that the defendants had failed to show that transfer is clearly more convenient and in the interest of justice. Accordingly, the court denied the motion. HP then filed this petition seeking mandamus review.

Discussion

A party seeking mandamus must: (1) show that it has a clear and indisputable legal right; (2) show it does not have any other method of obtaining relief; and (3) convince the court that the "writ is appropriate under the circumstances." *Cheney v. U.S. Dist. Court for D.C.*, 542 U.S. 367, 380–81 (2004) (citation omitted). In the transfer context,

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