No. 07-40058

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

IN RE VOLKSWAGEN AG AND VOLKSWAGEN OF AMERICA, INC.
Petitioners.

Original Proceeding from the United States District Court for the
Eastern District of Texas, Marshall Division

BRIEF FOR AMICUS CURIAE AD HOC COMMITTEE OF INTELLECTUAL PROPERTY TRIAL LAWYERS IN THE EASTERN DISTRICT OF TEXAS IN SUPPORT OF RESPONDENTS

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April 25, 2008

SUPPLEMENTAL CERTIFICATE OF INTERESTED PERSONS

The undersigned counsel of record certifies that the following additional listed persons and entities have an interest in the outcome of this case. The representations are made in order that the Judges of this Court may evaluate possible disqualification or recusal.

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STATEMENT OF INTEREST OF AMICUS CURIAE

This Brief is filed on behalf of the Ad Hoc Committee of Intellectual Property Trial Lawyers in the Eastern District of Texas (the "Committee") in support of Respondents. The Committee was formed after this Court agreed to review this case *en banc* and after the American Intellectual Property Association (AIPLA) filed its brief with this Court. The Committee's members share a number of common concerns, including: (1) a belief that the prior panel decision and AIPLA's brief improperly characterize the consideration that should be given to a plaintiff's choice of forum in a motion to transfer; (2) a concern that the decisions of judges in the Eastern District have been unfairly characterized in AIPLA's brief; and (3) an apprehension that the panel's decision and AIPLA's suggested approach to transfer motions would unduly restrict the broad discretion conferred on district courts by established legal precedent and undermine the benefits of a wide choice of forum conferred on patent holders by the existing venue statutes. The Committee presently consists of trial attorneys listed on pages i-iv, *supra*, who practice in the Eastern District and have approved the filing of this Brief.

All of the parties have consented to the filing of this Brief for Amicus Curiae Ad Hoc Committee of Intellectual Property Trial Lawyers in the Eastern District of Texas.[1]

[1] FED. R. APP. P. 29(a).

ARGUMENT

I. The Standard Of Review: The Writ Of Mandamus Should Be Denied Because This Case Is Not An Extraordinary Case And Does Not Involve A Usurpation Of Judicial Power Or A Clear Abuse Of Discretion

This Court has stated that it will only "entertain" writs of mandamus seeking review of district courts' §1404(a) transfer decisions where those courts did not correctly construe or apply the statute, failed to consider relevant factors, or committed a "clear abuse of discretion." *Ex Parte Chas. Pfizer & Co*., 225 F.2d 720, 723 (5th Cir. 1955). Accordingly, this Court has held that it will not simply reweigh the §1404(a) factors to achieve a better result, even if it disagrees with the district court's decision. *Id.* ("We shall not attempt to . . . weigh and balance the factors which the District Court was required to consider in reaching its decision.").

This narrow standard of review in cases involving motions to transfer reflects not only the limited role of the writ, but also the "broader" discretion that was conferred on district courts by §1404(a) as compared to the prior *forum non conveniens* law. *See Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955) ("This is not to say that the relevant factors have changed or that the plaintiffs' choice of forum is not to be considered, but only that the discretion to be considered is ***broader***.") (emphasis added). This broader discretion includes the discretion to deny transfer as well as the discretion to grant it.

The Amicus Curiae Brief of the American Intellectual Property Law Association (AIPLA) largely ignores the expanded grant of discretion to the district courts and the very limited role of a writ of mandamus in transfer motions. Yet there are good reasons why the writ of mandamus should not be granted in this case.

The power to grant a writ of mandamus derives from the All Writs statute, 28 U.S.C. § 1651. The statute does not grant an appellate court the power "to consider the pros and cons" of a transfer order even if it believes the district court was wrong and "would have directed the transfer had the original application been addressed to [the appellate court]." *American Flyers Airline Corp. v. Farrell*, 385 F.2d 936, 937 (2d Cir. 1967). Mandamus is a drastic remedy reserved only for truly extraordinary situations. *Will v. United States*, 389 U.S. 90, 106 (1967); *Apache Bohai Corp. v. Texaco China, BV*, 330 F.3d 307, 310 (5th Cir. 2003). When a court of appeals issues a writ of mandamus and does not demonstrate on the record that the abuse is of an extraordinary character, issuance of the writ must be vacated. *Will*, 389 U.S. at 107.

The fundamental problem with the panel decision in this case and with the argument of AIPLA in support of Petitioners is that "there is nothing 'really extraordinary' about this cause," *see American Flyers*, 385 F.2d at 938, and neither the panel's decision nor AIPLA demonstrate that this is such a case. Indeed, this

Court has held in denying a writ of mandamus that a writ is even "less appropriate" in cases in which a transfer motion has been denied "than in the instance in which the motion is granted." *See In re McDonnell-Douglas Corp.*, 647 F.2d 515, 517 (5th Cir. 1981).

AIPLA argues that this Court needs to issue a writ of mandamus because there has been an "uneven treatment of the level of deference given to plaintiff's forum choice under § 1404(a)" among the different circuits and among cases in the Eastern District. AIPLA Br. at 7-9. Similarly, the panel decision in this case initially purported to find an abuse of discretion because the district court gave an elevated status to the Plaintiffs' choice of forum in a manner allegedly contrary to Fifth Circuit precedent. *In re Volkswagen of America, Inc. ("Volkswagen II")*, 506 F.3d 376, 380 (5th Cir. 2007). However, the panel then retreated from this position and stated: "Thus, although we hold that the district court erroneously applied the stricter forum non conveniens dismissal standard, we need not decide whether this error alone warrants mandamus relief in this case, *as we decide this petition on different grounds.*" *Id*. (emphasis added).

There are at least two important reasons why this portion of the panel's decision and AIPLA's similar argument cannot support issuance of the writ. First, and most obviously, the panel itself disclaimed any intention to base the writ on such grounds. But the more fundamental problem is that the precise weight to be

assigned a plaintiff's choice of forum is not a proper ground for granting a writ of mandamus.

In *Stewart Organization, Inc. v. Ricoh*, 487 U.S. 22 (1988), the United States Supreme Court considered whether Alabama law or federal law under §1404(a) controlled the forum selection clause in a contract. While the Court decided that §1404(a) was the controlling law in the dispute, the Court eschewed any attempt to instruct the district court on precisely how much weight should be given to the forum selection clause on remand. Instead, the Court stated:

> The forum-selection clause, which represents the parties' agreement as to the most proper forum, should receive ***neither dispositive consideration*** (as respondent might have it) ***nor no consideration*** (as Alabama law might have it), but rather the consideration for which Congress provided in § 1404(a). *Cf. Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955) (§ 1404(a) accords broad discretion to district court, and ***plaintiff's choice of forum is only one relevant factor for its consideration*)**.

Id. at 31 (emphasis added). If the U.S. Supreme Court found it *unnecessary* to define the precise weight to be given a forum selection clause in the resolution of a motion to transfer and was satisfied to describe *both parties'* agreement on the proper forum as "one relevant factor," there is no need for this Court to issue a writ of mandamus to define the precise weight to be given the *plaintiff's* choice of forum.

AIPLA has suggested that "the district courts would greatly benefit from receiving additional guidance in applying the transfer statute," AIPLA Br. at 3, and

argues in support of that view that the district court gave "*undue deference* to the plaintiff's forum choice" and failed to give "*proper weight* to the convenience of the parties and witnesses." AIPLA Br. at 4 (emphasis added). These arguments are, however, only subtle invitations for this Court to define and dictate the precise weight that should be given to the plaintiff's choice of forum when a district court exercises its discretion. Such an invitation, if accepted, would narrow, not broaden, the discretion granted the district courts and would involve this Court in a level of appellate oversight that is inconsistent with the role of an appellate court in reviewing a motion to transfer.

In *Stewart*, the Supreme Court was careful to warn district courts against giving a forum selection clause either decisive weight or no consideration at all, *and pointedly left the entire middle ground for the district courts*. AIPLA would have this Court enter that middle ground and define the weight to be given a plaintiff's choice of forum, thereby undertaking a task that the Supreme Court has studiously avoided.

AIPLA is also incorrect in its characterization of existing precedent in the Eastern District of Texas. AIPLA asserts that the writ should be granted because the district courts in the Eastern District of Texas are applying an improper standard to plaintiff's choice of forum by giving it "*decisive* weight." AIPLA Br. at 9 (emphasis added). Even a cursory glance at the decisions in the Eastern

District shows this not to be true. *See Zoltar Satellite Sys., Inc. v. LG Elecs. Mobile Commc'ns Co.*, 402 F. Supp. 2d 731, 738 (E.D. Tex. 2005) ("Although the court gives due deference to a plaintiff's choice of forum, it is just one component in the court's overall analysis.").

While plaintiff's choice of forum is never "decisive," it is also clear from *Stewart's* reading of *Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955) that, even after the enactment of §1404(a), the plaintiff's choice of forum is entitled to *substantive*, not merely procedural, weight. Yet AIPLA improperly suggests that "the courts should treat plaintiff's forum choice as the presumptive starting point for the venue analysis, *but should not give substantive weight to that decision itself*." AIPLA Br. at 4 (emphasis added). Similarly, the panel asserts, relying on this Court's decision in *Humble Oil & Ref. Co. v. Bell Marine Serv., Inc.*, 321 F.2d 53, 56 (5th Cir. 1963) that "the weight given to a plaintiff's choice of forum . . . corresponds with the burden that a moving party must meet to demonstrate that a transfer should be granted under § 1404(a)." *See Volkswagen II*, 506 F.3d at 381. Neither view is correct.

The dicta in the *Humble Oil* case on which the panel relied cannot be interpreted as denuding a plaintiff's choice of forum of its substantive weight and reducing it to nothing more than the burden of persuasion which accompanies every motion. Such an interpretation would be contrary to both *Norwood* and

Stewart, which clearly state that plaintiff's choice of forum is "one relevant factor" to be considered by the district court. *Stewart*, 487 U.S. at 31; *Norwood*, 349 U.S. at 32. ("This is *not* to say that the relevant factors have changed . . . .") (emphasis added). Moreover, none of the cases discussed in AIPLA's brief demonstrate that substantive weight is *not* to be given the plaintiff's choice of forum. AIPLA Br. at 5-12.

Once it is conceded that consideration of the plaintiff's choice of forum must be given *some* weight, the process of weighing and balancing the relevant factors is committed to the "broader" discretion of the district court. *See Norwood*, 349 U.S. at 32. Hence, if this Court issues a writ of mandamus based on the premise that it must precisely define the weight to be given to the plaintiff's choice of forum, its issuance of mandamus will intrude itself directly into the weighing and balancing of concededly proper criteria, precisely what this Court and the Supreme Court have held is *not* a permissible use of a writ of mandamus. *See Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 257 (1981) (finding that the court of appeals substituted its own analysis of the public and private interests for that of the district court). The entire first section of the panel's decision and the argument of both Petitioners and AIPLA on the excessive weight given the plaintiff's choice of forum suffer from this defect and should be rejected as an impermissible basis for mandamus.

The rest of the panel's decision is equally flawed in that it is based on Petitioners' argument that "although the district court correctly enumerated [the private and public interest factors], the court abused its discretion *by failing meaningfully to analyze and weigh them*." 506 F.3d at 384 (emphasis added). AIPLA's criticism is the same. AIPLA Br. at 4-14. If this standard of review is adopted, it will lower the threshold for issuance of a writ of mandamus, undermine the district court's discretion, and unduly encourage motions to transfer. In *American Flyers*, the Second Circuit described the consequences of an ill-advised grant of mandamus petitions in transfer cases:

> What has brought down upon us this plague of ill-advised mandamus petitions in cases of transfer applications under *28 U.S.C. Section 1404(a)*, is the use, sometimes even in Supreme Court opinions, of the inherently ambiguous phrases 'clear abuse of discretion,' 'clear cut abuse of discretion,' and so on. The use of such misleading phrases is nothing short of an invitation to the defeated party, who seems always to be quite convinced that the judge is wrong, and who as often as not is also playing for delay, to apply for mandamus and give us a full scale review of every detail tending to support the transfer. Where it is evident as here that the Judge has exercised his discretion in a judicial manner, and that the case before us is not a 'really extraordinary cause' we should summarily deny the petition for mandamus.

385 F.2d at 938; *see also* 15 CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE & PROCEDURE § 3848 at 163 (3d ed. 2007) ("In addition to the respect that should be accorded the plaintiff's forum

choice, setting the defendant's burden of persuasion at a low level will encourage the making of transfer motions . . . .").

The facts in the present case are very different from this Court's prior review of §1404(a) cases in which it considered a district court's use of *improper* criteria. *See, e.g.*, *In re Volkswagen AG ("Volkswagen I")*, 371 F.3d 201, 204, 206 (5th Cir. 2004) (noting refusal to consider convenience of third party defendant and improper consideration of convenience of counsel). The Supreme Court's §1404(a) cases fall into the same category. *See Stewart*, 487 U.S. at 31 (noting refusal of district court to consider forum selection clause).

By contrast, the message that a grant of the writ will send in this case is that this Court is now willing to review a district court's ruling on a motion to transfer if the losing party argues that the district court assigned either insufficient or excessive weight to one or more factors pertinent to the motion and, as a consequence, reached the wrong result. While it is possible to clothe such a process in terms that disguise the actual standard of review, as the panel attempted to do in this case, *Volkswagen II*, 506 F.3d at 384 ("the court abused its discretion by failing meaningfully to analyze and weigh them"), the actual standard used by the panel amounts to nothing more than an improper consideration of the "pros and cons" of the transfer order. *See American Flyers*, 385 F.2d at 937. As the Supreme Court wisely counseled in the *Will* case: "Courts faced with petitions for

the peremptory writs must be careful lest they suffer themselves to be misled by labels such as 'abuse of discretion' and 'want of power' into interlocutory review of nonappealable orders on the mere ground that they may be erroneous." 389 U.S. at 99.

The original panel in this case was correct in denying the writ and in the reasons that it gave for its decision. *In re Volkswagen of America, Inc.*, 233 Fed. Appx. 305, 306-07 (5th Cir. 2007) ("The district court here did not clearly and indisputedly abuse its discretion in denying Volkswagen's motion to transfer venue, and *we are thus unwilling to substitute our own balancing of the transfer factors for that of the district court*.") (emphasis added). Its ruling should be adopted by this Court and the petition for writ of mandamus denied.

II. There Was No Abuse Of Discretion In Denying Transfer In The Circumstances Of This Case

In addition to finding that the district court gave excessive weight to the plaintiff's choice of forum, the panel found fault with the district court because, *inter alia*, the district court allegedly gave insufficient weight to: (1) the 100-mile limitation on the trial court's subpoena power for witnesses, (2) the two-and-one-half-hour drive between Dallas and Marshall, Texas and (3) the location of documents. The panel's disagreement with the weight accorded to a factor in the analysis does not render the district court's decision a clear abuse of discretion.

A. The Availability of Compulsory Process to Secure the Attendance of Unwilling Witnesses

The panel in this case scolded the district court for not giving weight to the fact that Volkswagen's potential non-party witnesses who live and work in the Dallas area are more than 100 miles from the Marshall division and therefore would be beyond the "absolute" subpoena power of the Eastern District. *See Volkswagen II*, 506 F.3d at 385. Of course, as the district court noted, the Eastern District could "compel any witness residing in the state in which the court sits to attend trial, subject [on a motion to quash] to reasonable compensation if the witness incurs substantial expense." *See Singleton v. Volkswagen of America, Inc.*, No. 2:06-CV-222 (TJW), 2006 U.S. Dist. LEXIS 65006, *10 (E.D. Tex. Sept. 11, 2006); Pet. App. at 6a. However, Petitioners never contended that "travel from Dallas to Marshall by non-party witnesses would incur substantial expense," Pet. App. at 12a, and it is not likely that a 150-mile drive would do so. *See, e.g., Mills v. Beech Aircraft Corp.*, 886 F.2d 758, 761 (5th Cir. 1989) (finding that change of venue of 150 miles "did not appreciably increase the distance" required for travel).

Nonetheless, the panel held that the district court's analysis was inadequate because the fact that "the district court can deny any motions to quash does not address concerns regarding the convenience of parties and witnesses." *Volkswagen II*, 506 F.3d at 385. That may be true in the abstract, but the panel overlooks or ignores the district court's finding that the defendant had submitted a list of

witnesses, but had not explained "why all these witnesses are actually material to its case" or "outline[d] the substance of [their] testimony." Pet. App. at 5a. The district court stated that "with such scant information about these individuals, the Court cannot determine that they are indeed key fact witnesses whose convenience should be assessed in this analysis." *Id.*

AIPLA suggests that the Eastern District requires "an unrealistically high degree of specificity to prove that a more convenient forum exists." AIPLA Br. at 4. There is, however, nothing unique about the Eastern District's application of the law in this respect. Professors Wright, Miller and Cooper have specifically noted that the "party seeking the transfer must specify clearly, typically by affidavit, the key witnesses to be called and their location and must make a general statement of what their testimony will cover." 15 FEDERAL PRACTICE & PROCEDURE § 3851 at 221-22. If the moving party fails, as here, to "provide sufficient information to permit the district court to determine what and how important [the witnesses'] testimony will be, the application for transferring the case should be denied." *Id*. at 228-35 (citing over seventy cases in the Second, Third, Fourth, Fifth, Sixth, Seventh, Eighth, Ninth, Tenth and Eleventh Circuits).

The Petitioners' affidavits are deficient in other respects as well. For example, the affidavits do not state which, if any, of these witnesses would not be willing to attend a trial in Marshall, Texas, and would thus have to be subpoenaed.

The affidavits of Kenie Wiginton and Irene Soto state only that it would be a burden and inconvenient for them to travel to Marshall, Texas, for trial. Pet. App. 64a and 66a. They affirmatively state, however, a "willing[ness] to travel to Sherman, Texas," which is 75 miles from one witness's residence and 70 miles from the other, *id*., and is therefore half the distance to Marshall. Accordingly, there is no proof in this record that any of defendants' non-party witnesses would be *unwilling* to travel to Marshall, Texas for trial.

Without such evidence in the record, the absence of "absolute" subpoena power in the Marshall court is properly accorded no weight. *See Tapia v. Dugger*, No. SA 06-CA-0147, 2006 U.S. Dist. LEXIS 69356, at *12 (W.D. Tex., Sept. 7, 2006) ("The Defendants, however, do not claim that compulsory process would be necessary to secure the testimony of any of these witnesses if the court denies their motion to transfer."); *see also Nat'l Guardian Risk Retention Group, Inc. v. Central Ill. Emergency Physicians, LLP*, No. 1:06-CV-247, 2006 U.S. Dist. LEXIS 46387, at *10-11 (W.D. Mich. July 10, 2006); *ADE Corp. v. KLA-Tencor Corp.*, 138 F. Supp. 2d 565, 571 (D. Del. 2001). AIPLA is wrong that such omissions in the affidavits can be dismissed as "unrealistically high" requirements outside the purview of the district court. In *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 511 (1947), the Supreme Court discussed the willingness of witnesses to appear at trial as a factor bearing on the convenience of the witnesses and expressly stated that

"[s]uch matters are for the District Court to decide in exercise of a sound discretion."

AIPLA also implies that the district courts in the Eastern District have somehow acted improperly in considering whether depositions can be used in lieu of live testimony in determining the convenience of witnesses. AIPLA Br. at 12. But there is nothing unique about the Eastern District in this respect. Courts in jurisdictions outside the Eastern District have also refused to find that weight should be given the absence of subpoena power unless the movant explains in his affidavit why the use of a deposition would not be an adequate substitute.[2] *Moses v. Business Card Exp., Inc.*, 929 F.2d 1131, 1138-39 (6th Cir. 1991) (noting "[t]here is no reason why the testimony of witnesses could not be presented by deposition"); *GLMKTS, Inc. v. Decorize, Inc.*, No. 04-CV-2805, 2004 U.S. Dist. LEXIS 21812 *8 (E.D.N.Y. Nov. 1, 2004) ("In addition, neither party has

[2] Nor does this Court's opinion in *Perez & Compenia (Cataluna), S.A. v. M/V Mexico I*, 826 F.2d 1449, 1453 (5th Cir. 1987) establish the impropriety of such a consideration, as AIPLA argues. AIPLA Br. at 13, n.12. *Perez* involved a case where all parties to the lawsuit and all witnesses were in a foreign country. This Court cited *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501 (1947), for the proposition that fixing "the place of trial at a point where litigants cannot compel personal attendance and *may be forced to try their case on deposition* is to create a condition not satisfactory to court, jury or most litigants." *Perez*, 826 F.2d at 1453 (emphasis added). However, *Perez* and *Gilbert* were referring to the situation where almost the entire case would have to be tried by deposition if the case were not transferred. That is clearly not the situation here.

demonstrated that its witnesses will not appear voluntarily, or that the use of videotaped depositions will be an inadequate substitute.").

In sum, the Petitioners' response and affidavits fail to state (1) the nature of the witness's testimony, (2) whether the witness is willing or uncooperative, (3) why a deposition would be inadequate and (4) whether travel from Dallas to Marshall will create substantial additional expense. These deficiencies undermine the panel's ruling that the district court erred in not assigning weight to the unavailability of absolute subpoena power. Thus, the issue for this Court is not whether the reasons given by the district court for not weighing this factor more heavily were right or wrong in the abstract, but whether its exercise of discretion *on the facts of this particular case* was such a clear abuse of discretion that this Court must intervene. *See Stewart*, 487 U.S. at 29 (quoting *Van Dusen v. Barrack*, 376 U.S. 612, 622 (1964) ("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.'")).

In the circumstances of this case, no such intervention is required. Indeed, the creation of a flat rule that is not responsive to the variety of circumstances that can arise in individual cases demonstrates why this Court should not try to create a comprehensive standard for the district courts to use in future transfer cases. Such a template would destroy the very flexibility that the broad discretion granted the

district court is intended to confer. *See Kiefer v. E. F. Hutton*, No. 83 CIV. 6802, 1984 U.S. Dist. LEXIS 17441, at *3 (S.D.N.Y. April 19, 1984) ("In exercising its discretion, the [district] court should undertake its analysis with flexibility . . . .")).

B. The 100-Mile Rule

The panel also found that "the district court abused its discretion [in evaluating inconvenience for *willing* witnesses] by ignoring the 100 mile rule." 506 F.3d at 386. AIPLA expressly endorses such a rule as part of its advocacy of a "center of evidentiary gravity" analysis. AIPLA Br. at 14.

The 100-mile rule purportedly originated in *Volkswagen I*, 371 F.3d at 204-05, where this Court noted: "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." *Id.* at 204-05. The Court in *Volkswagen I* was simply noting that additional distance results in greater travel time, increased probability for meal and lodging expenses, and more time away from work. *Id.* at 205. Indeed, in that case, substantially all of the fact witnesses resided in San Antonio. Given the distance between San Antonio and Marshall (390-400 miles), the Court concluded that the convenience of the witnesses "would be substantially improved" by holding trial in San Antonio rather than in Marshall. *Id.*

There is nothing in the *Volkswagen I* opinion that indicates that this Court intended to establish a fixed 100-mile rule requiring a district court to weigh this factor in favor of transfer every time the distance to a transferee forum exceeds 100 miles. *Volkswagen I* employs an incremental analysis in which the additional distance to be traveled (290-300 miles) was found to have "substantially improved" the convenience of witnesses if the case was transferred.

By contrast, the district court in this case could reasonably find that the distance of 155 miles to Marshall (and the incremental distance of only 55 miles) was insufficient to materially impact the convenience and expenses of witnesses, including the need for overnight lodging, time away from work, and scheduling conflicts. *See Tapia v. Dugger*, No. SA 06-CA-0147(XR), 2006 U.S. Dist. LEXIS 69356, at *14 (W.D. Tex. Sept. 7, 2006) ("Defendants have failed to carry their burden . . . . This roughly two-and-one-half hour drive . . . would not require these non-party witnesses to incur overnight lodging costs."); *Leesona Corp. v. Duplan Corp.*, 317 F. Supp. 290, 300 (D.R.I. 1970) ("I find that the additional two hundred miles which defendants' witnesses will have to travel, if trial of this case remains in Rhode Island, is insignificant in terms of additional expense, cost, or time, and therefore lends no support to the motion to transfer.").

C. The Location of Documents

Finally, the panel found that the district court abused its discretion when it held that the location of all the documents and physical evidence in this case was in the Dallas Division, but did not weigh this factor in favor of transfer because advances in copying technology and information storage had rendered it less significant. *Volkswagen II*, 506 F.3d at 384-85. The panel stated that even though access to some sources of proof presented a lesser inconvenience because of these technological developments, that fact did not render the location of documents "superfluous." *Id.* at 385. The panel found that the district court erred in applying this factor "because it does weigh in favor of transfer, *although its precise weight may be subject to debate*." *Id.* (emphasis added).

The district court's observation about the effects of technological advances on the weight to be given the location of documents is not an irrational one. Professors Wright, Miller and Cooper have similarly noted that, since documents now exist in electronic format, their location is entitled to little weight. 15 FEDERAL PRACTICE & PROCEDURE § 3853 at 239-42 (citing cases).

If the panel's concern were that these advances may reduce, but do not completely eliminate, the weight to be given the location of documents, that concern does not warrant a finding that the district court abused its discretion. The district court's finding was case specific. The district court does not hold that the

location of documents is of little weight in every transfer case. Certainly, if a movant can show that the burden of transporting documents from a distant forum is not resolved by technological advances, this factor would still be entitled to weight. But defendant in this case *made no such showing*, and the district court could reasonably decide the factor is entitled to no weight because of that omission. *See* 15 FEDERAL PRACTICE & PROCEDURE § 3853 at 245 (noting that the moving party "must establish" the location of the documents, "their importance to the resolution of the case" and their "inability to be moved or effectively copied easily").

The same is true of the physical evidence. If transporting the damaged automobile to the courthouse or requiring that the jury visit the site of the accident were necessary on the facts of this case, then Petitioners were required to demonstrate that necessity. *See ADE Corp.*, 138 F. Supp. 2d at 574 (giving no weight to location of machines because it was not clear that a jury visit would be necessary or appropriate).

In view of the Petitioners' failure to establish the necessity for a Dallas forum either with respect to the transportation of documents or physical evidence, there was no abuse of discretion in the circumstances of this case in according these factors no weight.

III. The Judges In The Eastern District Of Texas Have Not Excessively Retained Cases Or Exercised Their Discretion In A Manner Inconsistent With Courts In Other Jurisdictions

The Eastern District has unjustly garnered a reputation as a place where large corporations are dragged against their will, particularly in patent cases, and given a good thrashing. This reputation is largely a myth. *See* Spencer Hosie, *Myth-Busting Software Patent Trolls*, 2006 LAW. COM. LEGAL TECHNOLOGY (Oct. 29, 2007). As members of the Ad Hoc Committee know (who are more familiar with the historical facts), the popularity of the Eastern District for the filing of complex patent cases was started by corporate giant Texas Instruments in the early 1990's and was driven by the speed with which such cases could be resolved in the Eastern District and by the determination of judges of the district to "reduce the 'transactional costs' of modern civil litigation." *See* Michael C. Smith, *Rocket Docket: Marshall Court Leads Nation in Hearing Patent Cases*, 69 TEXAS BAR JOURNAL 1045, 1046 (Dec. 2006). Major corporations like Apple Computer, Intel, Ericsson, Cisco, Hewlett Packard, IBM and many others have filed patent cases in the Eastern District to take advantage of the District's ability to resolve their cases promptly. *See* Exhibit A to this brief.

All things ebb and flow, however; and as the number of cases has increased, the docket has slowed. *See* Nate Raymond, *Taming Texas*, 2008 THE AMERICAN LAWYER ON THE WEB, www.americanlawyer.com (March 1, 2008). According to

one recent report on the state of infringement litigation in the Eastern District, the district has dropped from the fifth fastest judicial district to eighteenth. *See id.* Some are predicting that increasing slowness of the Eastern District's docket will result in fewer new patent cases. Robert R. McKelvie, *Forum Selection in Patent Litigation: A Traffic Report*, INTELL. PROP. & TECH. L.J., Aug. 2007, at 8. Indeed, it turns out that the number of new patent cases filed during the first three months of 2008 is less than one fourth of the total number of patent cases filed in all of 2007.[3] Accordingly, the judges in the Eastern District have no incentive to cling to cases that should be transferred.

Unfortunately, neither the historical facts nor recent developments in the District have deterred AIPLA from arguing that the routine filing of patent infringement complaints in the Eastern District is "encouraged by the seeming reluctance of courts in that district to transfer cases." AIPLA Br. at 2. However, based on our review of PACER records, judges in the Eastern District *do* regularly grant motions to transfer in patent cases.[4] AIPLA has identified no evidence to

[3] Public court records show that 368 patent cases were filed in the Eastern District in 2007. These same records show that 73 patent cases were filed in the Eastern District between January 1, 2008, and March 31, 2008.

[4] Recent patent cases in which a motion to transfer was granted pursuant to § 1404(a) include the following: *LG Electronics, Inc. v. Hitachi, Ltd.*, No. 9:07-CV-00138 (Dec. 3, 2007); *QR Spex, Inc. v. Motorola, Inc.*, No. 5:06-CV-00124 (June 18, 2007); *Orica Explosives Tech. Ltd. v. Austin Powder Co.*, No. 2:06-CV-00450 (Apr. 13, 2007); *Baxter Healthcare Corp. v. Fresenius Med. Care Holdings, Inc.*,

support its claim that the Eastern District grants "very few" motions to transfer as compared to other judicial districts. AIPLA Br. at 10. Given the regular transfer of patent cases out of the Eastern District, it is dubious to claim, as AIPLA does, that patent holders are "encouraged" to file suit in the Eastern District by the judges' "seeming reluctance" to transfer. AIPLA Br. at 2.

The perception that jurors in the Eastern District are favorably predisposed to patent holders may also be lagging behind recent developments. In 2007, of the seven infringement cases tried to jury, three resulted in a verdict for the defendant on all asserted claims of infringement.[5] The consequent win-rate for patent holders in 2007, 57%, is below the historical win-rate for patent holders nationally. *See* McKelvie, *supra*, at 2 (citing a report showing "that patent holders had won 68 percent of jury trials" between 1994 and 2005). In light of these outcomes, patent

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No. 2:06-CV-00438 (Feb. 6, 2007); *Nuance Comms., Inc. v. Voice Signal Tech., Inc.*, No. 5:06-CV-00071 (Oct. 30, 2006); *American Calcar, Inc. v. American Honda Motor Co.*, No. 6:05-CV-00475 (Sept. 26, 2006); *Zoltar Satellite Sys., Inc. v. LG Electronics Mobile Comm. Co.*, No. 2:05-CV-00215 (Nov. 13, 2005); *Pyrotek, Inc. v. Molten Metal Equip. Innovations, Inc.*, No. 6:05-CV-00146 (June 28, 2005).

[5] These seven patent cases (and the party favored by the judgment entered in each) are as follows: *QPSX Development 5 PTY LTD v. Juniper Networks, Inc.*, No. 2:05-CV-00268 (plaintiff); *Forgent Networks, Inc. v. Echostar Communications Corp.*, No. 6:06-CV-00208 (defendant); *Orion IP LLC v. Mercedes-Benz USA LLC*, No. 6:05-CV-00322 (plaintiff); *Hybrid Patents, Inc., v. Charter Communications, Inc.*, No. 2:05-CV-00436 (defendant); *TGIP, Inc. v. AT&T Corp.*, No. 2:06-CV-00105 (plaintiff); *Computer Acceleration Corp. v. Microsoft Corp.*, No. 9:06-CV-00140 (defendant); *Power-One, Inc., v. Artesyn Technologies, Inc.*, No. 2:05-CV-00463 (plaintiff).

holders are considering alternative forums in California, Pennsylvania, and Wisconsin. *See* William J. Holstein, *The Eastern District of Texas Goes Soft on Defendants*, IP LAW & BUSINESS (Oct. 2007).

There is also nothing extraordinary about the manner in which judges in the Eastern District have exercised their discretion. AIPLA suggests that this and other cases decided in the Eastern District are unique in that transfer of these cases has been denied even though "the only factor that supported retaining the case was the (non-resident) plaintiff's forum choice." AIPLA Br. at 10. AIPLA takes particular aim at *FCI USA, Inc. v. Tyco Elecs. Corp.*, No. 2:06-CV-4 (TJW), 2006 U.S. Dist. LEXIS 50466 (E.D. Tex. July 24, 2006), and *Arielle, Inc. v. Monster Cable Products, Inc.*, No. 2:06-CV-382 (TJW), 2007 U.S. Dist. LEXIS 21295 (E.D. Tex. March 26, 2007). AIPLA Br. at 9-10.

In *FCI*, however, the movant made no attempt to show who the key witnesses were and how they might be inconvenienced. 2006 U.S. Dist. LEXIS 50466 at *7. And in *Arielle*, five of the seven "key" nonparty witnesses named by defendant filed declarations stating that they were willing to travel to Marshall, Texas for trial, and one of the other two witnesses named by defendant was its paid consultant. *See Arielle*, No. 2:06-CV-382 (E.D. Tex. 2007) (Doc. No. 16, available on PACER). Accordingly, AIPLA's reliance on *FCI* and *Arielle* is misplaced.

In cases like *FCI* and *Arielle*, where the countervailing factors are of little or no weight or not established, there is clearly no abuse of discretion if the plaintiff's choice of forum is honored. *See* 15 FEDERAL PRACTICE & PROCEDURE § 3851 at 227-28 ("If the moving party merely has made a general allegation that necessary witnesses are located in the transferee forum, without identifying them and providing sufficient information to permit the district court to determine what and how important their testimony will be, the application for transferring the case should be denied . . . .").

There is no showing here that the judges in the Eastern District have abused their discretion, or that there has been an abuse of discretion in this particular case.

CONCLUSION

For the foregoing reasons, the petition for writ of mandamus should be denied.

Respectfully submitted,

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Dated: April 25, 2008

CERTIFICATE OF SERVICE

I hereby certify that I am over the age of eighteen (18) years, not a party to this action, and that, on this 25th day of April, 2008, I caused one original and 26 true and accurate paper copies of the BRIEF FOR AMICUS CURIAE FOR AD HOC COMMITTEE OF TRIAL LAWYERS IN THE EASTERN DISTRICT OF TEXAS IN SUPPORT OF RESPONDENTS and one copy in Adobe Acrobat pdf format, to be served on the Clerk of the Court and I further certify that on the 25th day of April, 2008, two printed copies along with an electronic copy in Adobe Acrobat pdf format, were served by Federal Express mail upon the following:

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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7) and Fifth Circuit Rule 32.3:

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because the brief contains 6,285 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii), and is less than one-half of the maximum length authorized for Respondent's brief, pursuant to FED. R. APP. P. 29(d) and Fifth Circuit Rule 29.1.

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2000 in 14 point (14 point in footnotes), Times New Roman font.

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EXHIBIT A