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No Transfer? No Problem!: The Federal Circuit's Excessive Use of the Most Potent Weapon in the Judicial Arsenal for § 1404(a) Transfer Appeals

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NO TRANSFER? NO PROBLEM!:
INTERLOCUTORY APPEAL OF § 1404(A)
ORDERS AND THE FEDERAL CIRCUIT'S
UNPRECEDENTED USE OF THE MOST POTENT
WEAPON IN THE JUDICIAL ARSENAL

*Colin Hickl**

ABSTRACT

Like all federal plaintiffs, patent owners who feel their patent has been infringed have the right to file suit in any federal court, so long as venue is proper. Patent plaintiffs often select plaintiff-friendly venues, like the Eastern and Western Districts of Texas. Usually, plaintiffs may select these venues because many of the alleged infringers are large companies with a national presence, which makes them susceptible to suit in many federal courts around the country. Defendants in patent cases often file a motion under 28 U.S.C. § 1404(a) to transfer a case to a more defendant-friendly venue, on the basis that the destination venue is more convenient. If the district court denies the motion to transfer, that almost always ends the matter. The exception is that the defendant can petition the proper appellate court—the Federal Circuit in patent cases—for a writ of mandamus: an “extraordinary remedy” that directs the district court to transfer the case. The Supreme Court has mandated that this remedy is reserved for extreme circumstances and may not be used as an appeal. Despite this clear mandate, the Federal Circuit appears to treat such petitions as full-fledged appeals.

This Comment seeks to address the ever-growing number of mandamus petitions being granted by the Federal Circuit. Specifically, this Comment focuses on patent cases filed in Texas federal courts. While patent cases in Texas federal courts, like all other patent cases, are appealed to the Federal Circuit, the Federal Circuit remains bound by Fifth Circuit law on motions to transfer under § 1404(a). The Supreme Court and Fifth Circuit have held that a mandamus petition should only be granted upon a clear abuse of

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discretion by the district court, but the Federal Circuit seems to misapply Fifth Circuit law. The Federal Circuit's proclivities in determining the propriety of a petition for a writ of mandamus have caused confusion among Texas plaintiffs and uncertainty in the law. This Comment calls attention to the Federal Circuit's tendency to: (1) misapply Fifth Circuit transfer law; (2) impermissibly add its own nuances to transfer law; and (3) substitute the district court's judgment for its own, effectively giving defendants a *de novo* review; or in other words, a second bite at the apple in attempting to transfer a case. Finally, this Comment proposes solutions including: (1) an expansion of Fifth Circuit § 1404(a) jurisprudence; (2) the Supreme Court granting certiorari to provide clarity on the issue; or (3) a change in the Federal Circuit's choice of law rule.

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I. INTRODUCTION

OVER the years, the Eastern and Western Districts of Texas have become hot spots for plaintiffs seeking to file their patent claims.¹ Defendants in these cases often file a motion under 28 U.S.C. § 1404(a) to transfer the case, arguing that another federal district is a more convenient venue for the matter to be heard.² If the district court denies the motion, the defendant can petition the proper appellate court,

1. See, e.g., Dabney Carr, *Change Could be Coming to Patent Suit Volume in Texas*, LAW360 (June 29, 2022, 4:32 PM), <https://www.law360.com/articles/1505495/change-could-be-coming-to-patent-suit-volume-in-texas> [<https://perma.cc/D5RQ-3QQC>].

2. See 28 U.S.C. § 1404(a).

the Federal Circuit in patent cases, for a writ of mandamus.³ If granted, the district court is instructed to transfer the case.⁴ Though any plaintiff may *file* a petition for a writ of mandamus, courts are not to grant them absent extraordinary circumstances; the writ of mandamus is an “extraordinary remedy” that may not be used as a substitute for appeal.⁵ For this reason, the Supreme Court has classified the writ of mandamus as “one of ‘the most potent weapons in the judicial arsenal.’”⁶

Recently, the Federal Circuit has granted this “extraordinary remedy” for § 1404(a) appeals frequently, specifically within the Eastern and Western Districts of Texas.⁷ In so doing, the Federal Circuit routinely makes three mistakes: (1) misapplying binding Fifth Circuit law; (2) impermissibly applying nuances to transfer law that the Fifth Circuit has not stated; and (3) substituting the district court’s judgment for its own, effectively conducting a *de novo* review, despite being mandated to apply a clear abuse of discretion standard.

Part II of this Comment provides a brief history of convenience transfers under § 1404(a), the writ of mandamus, and the Federal Circuit. Part III presents the analytical framework for § 1404(a) in the Fifth Circuit—which the Federal Circuit *must* apply when it accepts appeals from the Eastern and Western Districts of Texas. The framework includes a discussion of the public and private interest factors that a district court must consider when faced with a motion to transfer venue under § 1404(a). Part IV briefly discusses why patent cases are often filed in the Eastern and Western Districts of Texas in the first place. Part V analyzes two recent cases and argues that the Federal Circuit is incorrectly applying the Fifth Circuit law that binds it. Part VI further analyzes the Federal Circuit’s unprecedented use of the writ of mandamus and explains why this is problematic. Part VII proposes three solutions to restore the integrity of the writ of mandamus and correct the Federal Circuit’s dangerous use of it. Finally, Part VIII provides closing remarks and asserts that the status quo cannot continue.

II. SETTING THE STAGE

A. HISTORY OF CONVENIENCE TRANSFERS UNDER § 1404(A)

Analysis of the Federal Circuit’s modern-day § 1404(a) tendencies first requires looking at the historical underpinnings of § 1404(a) transfers in patent cases. The natural starting point is the controlling statute itself: “For 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

3. See *infra* Part II.B.

4. See *infra* Part II.B.

5. See *Ex parte Fahey*, 332 U.S. 258, 259–60 (1947).

6. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (citing *Will v. United States*, 389 U.S. 90, 107 (1967)); see also *Ex parte Fahey*, 332 U.S. at 259–60 (describing a writ of mandamus as an “extraordinary remedy” that is “reserved for really extraordinary causes”).

7. See *infra* note 175.

have consented.”⁸ As the text indicates, § 1404(a) contemplates the transfer of a suit to another venue, even though venue is proper in the original venue, in the interest of convenience and justice.⁹ The idea that a court, acting out of “convenience,” could decide not to hear a case where venue was otherwise proper was first brought to federal courts in *Gulf Oil v. Gilbert*.¹⁰ There, the Supreme Court held that the doctrine of *forum non conveniens* applied to federal courts.¹¹ *Forum non conveniens* simply posits that a federal court may dismiss a case, even though venue is proper, in the interest of convenience and justice.¹² The *Gulf Oil* Court laid out private and public interest factors that lower courts should consider when making the determination of whether to dismiss a case under *forum non conveniens*.¹³ The remedy under *forum non conveniens*, however, is dismissal of the claim, and therefore, “unless the balance is strongly in favor of the defendant, the plaintiff’s choice of forum should rarely be disturbed.”¹⁴

In 1948, just one year after the Supreme Court’s decision in *Gulf Oil*, Congress enacted § 1404(a).¹⁵ When enacted, practitioners and scholars alike generally considered it a codification of *forum non conveniens* as contemplated in *Gulf Oil*.¹⁶ A few years later, however, the Supreme Court clarified that § 1404(a) was distinct from *forum non conveniens* because the remedy under § 1404(a) was to transfer the case, rather than dismiss it.¹⁷ Therefore, a trial judge receives more discretion to transfer a case under § 1404(a) because the remedy preserves the claim rather than terminates it.¹⁸

B. WRIT OF MANDAMUS

For present purposes, a history of the writ of mandamus is similarly informative. Under the general rule of appealability, appellate courts only review final judgments from district courts.¹⁹ This means that interlocutory appeal—an immediate appellate review of a non-final district court order—is generally not permitted.²⁰ However, one means of obtaining an

8. 28 U.S.C. § 1404(a).

9. *See id.*

10. *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 502 (1947).

11. *See id.* at 507–09.

12. *See id.* at 507 (“A plaintiff sometimes is under temptation to resort to a strategy of forcing the trial at a most inconvenient place for an adversary . . .”).

13. *See id.* at 508–09.

14. *Id.* at 508; *see also* James W. Curlee, Note, *Law to be Applied Following Section 1404(a) Transfers*, 18 Sw. L.J. 742, 742 (1964).

15. *See* 28 U.S.C. § 1404.

16. *See* Louis Hilfman, *Appellate Review of 1404(a) Orders—Misuse of an Extraordinary Writ*, 1 J. MARSHALL J. PRAC. & PROC. 297, 297 (1968).

17. *See* *Norwood v. Kirkpatrick*, 349 U.S. 29, 31 (1955).

18. *See id.* at 32 (“[W]e believe that Congress . . . intended to permit courts to grant transfers upon a lesser showing of inconvenience” than needed under *forum non conveniens*.); *see also* Richard B. Wilkins, *Federal Courts—Change of Venue Under Section 1404(a)—Consideration of Applicable Substantive Law “In the Interest of Justice”*, 25 LA. L. REV. 771, 772 (1965).

19. *See* 28 U.S.C. § 1291.

20. *See* Robert S. Berger, *The Mandamus Power of the United States Courts of Appeals: A Complex and Confused Means of Appellate Control*, 31 BUFF. L. REV. 37, 37 (1982).

interlocutory appeal is through the writ of mandamus.²¹ The writ of mandamus is an extraordinary remedy that compels a lower court or governmental officer to correct a prior action.²² While there is no explicit right to an interlocutory appeal from a district court's decision on a motion to transfer venue under § 1404(a), appellate courts use the writ of mandamus to immediately review such transfer decisions.²³ In such situations, appellate courts derive their power to issue a writ of mandamus from 28 U.S.C. § 1651(a).²⁴

The Supreme Court has proclaimed the writ of mandamus to be “one of ‘the most potent weapons in the judicial arsenal.’”²⁵ For a court to issue a writ of mandamus, three conditions must be met: (1) the petitioner seeking the writ must have no other adequate means to attain the relief sought; (2) the petitioner must prove their right to the writ is “clear and indisputable”; and (3) “even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances.”²⁶ The Supreme Court has held that a writ of mandamus should only be issued “when there is ‘usurpation of judicial power’ or a clear abuse of discretion.”²⁷ Similarly, in the context of a § 1404(a) transfer, the Fifth Circuit has held that the second element—whether the right to the writ is clear and indisputable—is established where the district court clearly abused its discretion.²⁸ This abuse of discretion standard is vital to the integrity of this remedy, as the Fifth Circuit and the Supreme Court have clarified that a writ of mandamus should not be a substitute for appeal.²⁹ Therefore, the Federal Circuit's practice of frequently granting mandamus petitions on § 1404(a) transfer motions raises the question of whether the Federal Circuit is properly treating the writ of mandamus as an extraordinary remedy.

C. HISTORY OF THE FEDERAL CIRCUIT

The history and functioning of the Federal Circuit are also critical to note. Through the Federal Courts Improvement Act of 1982, Congress

21. *See id.*

22. *See* Bobby Kim, Note, *Missed Statutory Deadlines and Missing Agency Resources: Reviving Historical Mandamus Doctrine*, 121 COLUM. L. REV. 1481, 1483 n.3 (2021).

23. *See* Note, *Appealability of 1404(a) Orders: Mandamus Misapplied*, 67 YALE L.J. 122, 125 (1957).

24. “The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.” 28 U.S.C. § 1651(a).

25. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (citing *Will v. United States*, 389 U.S. 90, 107 (1967)); *see also Ex parte Fahey*, 332 U.S. 258, 259–60 (1947) (A writ of mandamus is an “extraordinary remedy” that is “reserved for really extraordinary causes.”).

26. *Cheney*, 542 U.S. at 380–81.

27. *Schlagenhauf v. Holder*, 379 U.S. 104, 110 (1964) (quoting *Bankers Life & Cas. Co. v. Holland*, 346 U.S. 379, 383 (1953)).

28. *See In re Volkswagen of Am., Inc. (Volkswagen II)*, 545 F.3d 304, 311 (5th Cir. 2008) (en banc).

29. *In re Chesson*, 897 F.2d 156, 159 (5th Cir. 1990) (“[A writ of mandamus] is charily used and is not a substitute for an appeal.”); *see also Ex parte Fahey*, 332 U.S. at 260 (“We are unwilling to utilize [writs of mandamus] as substitutes for appeals.”).

created the U.S. Court of Appeals for the Federal Circuit.³⁰ The Federal Circuit is unique among other federal appellate courts because it has exclusive jurisdiction over claims arising out of any Congressional Act relating to patents.³¹ Thus, if a lawsuit contains multiple claims and includes a patent-related claim, the Federal Circuit's jurisdiction reaches all claims in the lawsuit.³² Despite the Federal Circuit's interpretation of its jurisdiction to include all claims arising from a case involving a patent claim, the Federal Circuit does not apply its own law to every issue before it.³³

Though the Federal Circuit applies its own body of law for substantive patent issues, the Federal Circuit applies a unique choice-of-law rule.³⁴ This choice-of-law rule is triggered when the Federal Circuit is faced with a procedural issue, rather than substantive patent issue.³⁵ The rule states that "the Federal Circuit shall review procedural matters, that are not unique to patent issues, under the law of the particular regional circuit court where appeals from the district court would normally lie."³⁶ As the Federal Circuit noted, when district courts are faced with patent-related claims under 28 U.S.C. § 1338, they must apply the substantive patent law of the Federal Circuit, not the "general law" of the regional circuit.³⁷ Thus, the Federal Circuit's choice-of-law rule reflects the unique position of the Federal Circuit as compared to the other federal appellate courts.³⁸

Thus, the core question becomes whether a motion to transfer under § 1404(a) in a case with patent claims is a substantive patent law issue, in which case the Federal Circuit applies its own law, or a procedural matter, in which case the law of the regional circuit court applies.³⁹ But this question is not open; the Supreme Court has already addressed it.⁴⁰ In *Stewart Org. v. Ricoh Corp.*, the Court noted that both the history and purpose of § 1404(a) indicate that it is a federal judicial housekeeping measure that reflects no change in substantive law.⁴¹ As such, it is properly classified as a procedural mechanism.⁴² And despite its case law seemingly adverse to this understanding, the Federal Circuit agrees.⁴³

30. Federal Courts Improvement Act (FCIA) of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982).

31. See 28 U.S.C. § 1295(a)(1).

32. See *Eaton Corp. v. Appliance Valves Corp.*, 790 F.2d 874, 876 n.3 (Fed. Cir. 1986) ("This court has subject matter jurisdiction under 28 U.S.C. § 1295(a)(1) over the case, including dependent nonpatent issues.").

33. See *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984).

34. See *id.*

35. See *id.*

36. *Id.*

37. See *id.* at 1573.

38. See Jennifer E. Sturiale, *A Balanced Consideration of the Federal Circuit's Choice-of-Law Rule*, 2020 UTAH L. REV. 475, 486 (2020) ("Unlike the jurisdiction of the other twelve U.S. Courts of Appeals, the Federal Circuit's jurisdiction is defined substantively, rather than geographically.").

39. See *Panduit*, 744 F.2d at 1574-75.

40. *Stewart Org. v. Ricoh Corp.*, 487 U.S. 22, 32 (1988).

41. See *id.*

42. See *id.*

43. See *In re TS Tech U.S. Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008) (applying Fifth Circuit law to a denial of a motion to transfer under § 1404(a) from the Eastern District of Texas).

Indeed, the Federal Circuit concluded that transfers under § 1404(a) do not involve a substantive patent law issue and that regional circuit law applies.⁴⁴ For example, if a patent case were filed in a federal district court in Texas, and the district court denied the defendant's motion to transfer venue under § 1404(a), the Federal Circuit is bound by the Fifth Circuit's § 1404(a) transfer law when reviewing the petition.⁴⁵ Therefore, an analysis of the Fifth Circuit's law regarding a motion to transfer under § 1404(a) is appropriate.

III. FIFTH CIRCUIT TRANSFER LAW

A. FRAMEWORK FOR ANALYSIS

Any analysis of Fifth Circuit transfer law should begin with the case referred to as *Volkswagen II*.⁴⁶ With over two thousand citing decisions, this en banc decision is the starting point for any Texas federal district court facing a motion to transfer under § 1404(a).⁴⁷ The question before the court was whether a suit filed in the Eastern District of Texas, arising out of an automobile collision, should be transferred to the Northern District of Texas.⁴⁸ The district court denied transfer, and the first Fifth Circuit panel refused to issue a writ to transfer.⁴⁹ However, a second Fifth Circuit panel issued a writ to transfer the case to the Northern District of Texas.⁵⁰ Finally, the Fifth Circuit granted a petition to hear the case en banc.⁵¹

Through *Volkswagen II*, the Fifth Circuit, sitting en banc, clarified that a writ of mandamus should only be granted where there is a clear abuse of discretion by the district court.⁵² Furthermore, "district courts have 'broad discretion in deciding whether to order a transfer.'"⁵³ Rather importantly, the en banc court emphasized that a writ of mandamus review should never replace the district court's exercise of its discretion.⁵⁴ Indeed, recent Fifth Circuit jurisprudence continues to emphasize the importance of a district court's discretion in deciding a § 1404(a) motion to transfer.⁵⁵

44. See *id.*; see also *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 836 (Fed. Cir. 2003) (applying Seventh Circuit law to a granting of a motion to transfer under § 1404(a) from the Western District of Wisconsin).

45. See *In re TS Tech.*, 551 F.3d at 1319 ("Because this [§ 1404(a)] petition does not involve substantive issues of patent law, this court applies the laws of the regional circuit in which the district court sits, in this case the Fifth Circuit.")

46. *Volkswagen II*, 545 F.3d 304 (5th Cir. 2008) (en banc).

47. *Id.* at 307.

48. *Id.*

49. *Id.* at 308.

50. *Id.*

51. *Id.*

52. *Id.* at 309.

53. See *id.* at 311 (quoting *Balawajder v. Scott*, 160 F.3d 1066, 1067 (5th Cir. 1998)).

54. See *id.* at 312 ("But—and we stress—in no case will we replace a district court's exercise of discretion with our own; we review only for clear abuses of discretion that produce patently erroneous results.")

55. *In re Planned Parenthood Fed'n of Am., Inc.*, 52 F.4th 625, 629–32 (5th Cir. 2022) (reiterating multiple times that district courts have broad discretion in deciding motions to transfer).

Volkswagen II lays out the proper analysis for courts facing a § 1404(a) motion to transfer venue.⁵⁶ “The preliminary question under § 1404(a) is whether a civil action ‘might have been brought’ in the destination venue.”⁵⁷ In other words, venue must also be proper in the destination venue pursuant to 28 U.S.C. § 1391.⁵⁸ If the destination venue is proper, then “he who seeks the transfer must show good cause.”⁵⁹ This “good cause” burden is met when the movant “clearly demonstrate[s] that a transfer is ‘[f]or the convenience of parties and witnesses, in the interest of justice.’”⁶⁰ Therefore, if the destination venue is not clearly more convenient, “the plaintiff’s choice should be respected.”⁶¹

To determine whether a § 1404(a) transfer is for the convenience of the parties and witnesses and in the interest of justice, the Fifth Circuit applies the private and public interest factors that the Supreme Court first introduced in *Gulf Oil*.⁶² Private interest factors seek to protect the interests of all litigants in a suit.⁶³ While a plaintiff must have sufficient access to justice in a convenient forum, a plaintiff may be tempted to strategically force trial at a venue that is inconvenient to the defendant, even at some inconvenience to the plaintiff.⁶⁴ Therefore, courts in the Fifth Circuit consider the following private interest factors: “(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.”⁶⁵ Because the public in the relevant venue also possesses an interest in where litigation takes place, courts consider public factors as well.⁶⁶ As such, public interest 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 [or in] the application of foreign law.”⁶⁷ While these factors are chief in the analysis, this list is “not necessarily exhaustive or exclusive.”⁶⁸ Additionally, no factor is to be given dispositive weight.⁶⁹

56. *See Volkswagen II*, 545 F.3d at 312–15.

57. *See id.* at 312.

58. *See id.*

59. *Id.* at 315 (citing *Humble Oil & Refin. Co. v. Bell Marine Serv., Inc.*, 321 F.2d 53, 56 (5th Cir. 1963)).

60. *Id.* (second alteration in original).

61. *Id.*; *see also In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 632 (5th Cir. 2022) (denying a mandamus petition to reverse a district court’s denial of a § 1404 (a) transfer and noting that “[t]he standard for reversing that holding is high”).

62. *See Volkswagen II*, 545 F.3d at 315 (citing *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501 (1947)).

63. *See id.*

64. *See Gulf Oil*, 330 U.S. at 507.

65. *See Volkswagen II*, 545 F.3d at 315 (quoting *In re Volkswagen AG (Volkswagen I)*, 371 F.3d 201, 203 (5th Cir. 2004)).

66. *See id.* at 317–18.

67. *Id.* at 315 (alteration in original) (quoting *Volkswagen I*, 371 F.3d at 203).

68. *Id.*

69. *See id.*; *see also Action Indus., Inc. v. U.S. Fid. & Guar. Co.*, 358 F.3d 337, 340 (5th Cir. 2004).

In the years following *Volkswagen II*, the Fifth Circuit has issued a few additional opinions, which further developed the contours of § 1404(a) transfer jurisprudence.⁷⁰ Each private factor and public interest factor has begun to develop nuances under Fifth Circuit law. In the following sections, each factor will be discussed in turn.

B. PRIVATE INTEREST FACTORS

The first private interest factor courts consider is the relative ease of access to sources of proof in each venue.⁷¹ The moving party must provide an actual showing of the existence of relevant sources of proof rather than mere conclusory assertions that proof likely exists in a prospective forum.⁷² Further, “the question is *relative* ease of access, not *absolute* ease of access.”⁷³ This means that even where the inconvenience is slight, if it exists, this factor could weigh in favor of transfer.⁷⁴ While advancing technology may very well facilitate access to sources of proof, the mere existence of such advancements does not render this factor superfluous.⁷⁵ At the same time, however, the location of evidence is much more important when the evidence is “physical in nature.”⁷⁶

The second private interest factor courts weigh is whether each venue has a compulsory process for assuring the attendance of witnesses.⁷⁷ Relevant to this analysis is whether non-party witnesses are within the subpoena power of either court.⁷⁸ This analysis is one of convenience, which means a district court’s ability to deny any motion to quash a subpoena does not make that district court an equally convenient forum compared to one that has absolute subpoena power.⁷⁹ The availability of a compulsory process, however, “receives less weight when it has not been alleged or shown that any witness would be unwilling to testify.”⁸⁰

The third private interest factor contemplates the cost of attending trial for willing witnesses in both venues.⁸¹ In analyzing this factor, courts assess all parties and witnesses.⁸² The Fifth Circuit has laid out the “100-mile rule,” which states: “When the distance between an existing venue for trial of

70. See *In re Radmax, Ltd.*, 720 F.3d 285, 288–89 (5th Cir. 2013); *City of New Orleans Emps. Ret. Sys. v. Hayward*, 508 F. App’x 293, 298–99 (5th Cir. 2013); *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 630 (5th Cir. 2022); *Def. Distributed v. Bruck*, 30 F.4th 414, 434–35 (5th Cir. 2022).

71. See *Volkswagen II*, 545 F.3d at 315–16.

72. See *Bruck*, 30 F.4th at 434.

73. *In re Radmax*, 720 F.3d at 288 (emphasis in original).

74. See *id.*

75. See *Hayward*, 508 F. App’x at 298.

76. *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 630 (5th Cir. 2022) (noting that the district court concluded that most of the evidence was electronic and equally accessible in either forum).

77. See *Volkswagen II*, 545 F.3d 304, 315–16 (5th Cir. 2008) (en banc).

78. See *id.* at 316; see also FED. R. CIV. P. 45.

79. See *Volkswagen II*, 545 F.3d at 316.

80. *In re Planned Parenthood*, 52 F.4th at 630–31 (quoting *Hefferan v. Ethicon Endo-Surgery Inc.*, 828 F.3d 488, 499 (6th Cir. 2016)).

81. See *Volkswagen I*, 371 F.3d 201, 203 (5th Cir. 2004).

82. See *id.* at 204.

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.”⁸³ Additional distance necessitates additional travel time, food and lodging expenses, increased time missing work, and the like.⁸⁴ The rule does not bar a court from considering this factor if the destination venue is within 100 miles of the parties or potential witness—convenience and cost remains a relevant factor in the analysis.⁸⁵ The rule simply states that this factor is of greater significance when the destination venue is more than 100 miles from the current venue.⁸⁶

Finally, a court must consider all other practical problems that make trial easy, expeditious, and inexpensive.⁸⁷ For example, the delay associated with granting a motion to transfer “may be relevant ‘in rare and special circumstances.’”⁸⁸ One example of “rare and special circumstances” is when a “transfer [of] venue would cause yet another delay in [an already] protracted litigation.”⁸⁹ But “garden-variety” delay that is associated with transferring a case should not be considered.⁹⁰ Otherwise, “delay would militate against transfer in every case.”⁹¹

C. PUBLIC INTEREST FACTORS

Several factors similarly anchor a court’s inquiry into the public interest at stake. First, courts consider “the administrative difficulties flowing from court congestion.”⁹² These administrative considerations include a “court’s interest in controlling a crowded docket.”⁹³ Indeed, “[d]ifficulties arise ‘when litigation is piled up in congested centers instead of being handled at its origin.’”⁹⁴ An action can be too burdensome when it “brings to the court more than an ordinary task of adjudication; it brings a task of administration.”⁹⁵ Acknowledging that some sister circuits downplay the court-congestion factor by holding it to be “speculative,”⁹⁶ the Fifth Circuit

83. *Volkswagen II*, 545 F.3d at 317 (quoting *Volkswagen I*, 371 F.3d at 204–05).

84. *See id.*

85. *See In re Radmax, Ltd.*, 720 F.3d 285, 289 (5th Cir. 2013) (“We did not imply, however, that a transfer *within* 100 miles does not impose costs on witnesses or that such costs should not be factored into the venue-transfer analysis, but only that this factor has greater significance when the distance is greater than 100 miles.” (emphasis in original)).

86. *See id.*

87. *See id.* at 288.

88. *Id.* at 289 (quoting *In re Horseshoe Ent.*, 337 F.3d 429, 535 (5th Cir. 2003)).

89. *See id.* (alterations in original) (quoting *Peteet v. Dow Chem. Co.*, 868 F.2d 1428, 1436 (5th Cir. 1989)).

90. *Id.*

91. *Id.*

92. *Volkswagen II*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) (quoting *Volkswagen I*, 371 F.3d 201, 203 (5th Cir. 2004)).

93. *City of New Orleans Emps. Ret. Sys. v. Hayward*, 508 F.App’x 293, 299 (5th Cir. 2013) (quoting *Baumgart v. Fairchild Aircraft Corp.*, 981 F.2d 824, 828 (5th Cir. 1993)).

94. *Id.* (quoting *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508 (1947)).

95. *See id.* (quoting *Koster v. (Am.) Lumbermens Mut. Cas. Co.*, 330 U.S. 518, 526 (1947)).

96. Ironically, the Fifth Circuit cites the Federal Circuit as the court believing the court-congestion factor to be “speculative.” *See In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 631 (5th Cir. 2022) (citing *In re Genentech, Inc.*, 566 F.3d 1338, 1347 (Fed. Cir. 2009)).

held that this factor warrants consideration in certain circumstances.⁹⁷ If the district court believes that it can reliably estimate the congestion of both venues, the reviewing appellate court should defer to the district court's discretion.⁹⁸

The second public interest factor assesses “the local interest in having localized interests decided at home.”⁹⁹ Essential considerations germane to this inquiry include “the location of the injury, witnesses, and the [p]laintiff's residence.”¹⁰⁰ Notably, the location of the alleged wrong is “one of the most important factors in venue determinations.”¹⁰¹ This factor “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.”¹⁰² Further, “jury duty is a burden that ought not to be imposed upon the people of a community which has no relation to the litigation.”¹⁰³

The final two public interest factors weigh the familiarity of the forum with the law that will govern the case and whether any problems of conflict of laws or foreign law might arise.¹⁰⁴ These factors seldom create issues in transfer cases.¹⁰⁵ If both courts are equally capable of applying the relevant law, this factor should be neutral.¹⁰⁶ “Federal judges routinely apply the law of a State other than the State in which they sit”¹⁰⁷ Therefore, some exceptional feature of state or constitutional law that is likely to defy comprehension by a federal judge sitting in another state must exist for this factor to weigh in favor of transfer.¹⁰⁸

The preceding law is binding upon the Federal Circuit when it reviews a mandamus petition from the denial of a § 1404(a) transfer motion in a federal district court within the Fifth Circuit's jurisdiction, such as Texas.¹⁰⁹ Before discussing the Federal Circuit's application of the law mandated by the Fifth Circuit, it is vital to first understand why patent cases are often filed in the Eastern and Western Districts of Texas.

97. *Id.* (“[T]o the extent docket efficiency can be reliably estimated, the district court is better placed to do so than this court.”).

98. *See id.*

99. *Volkswagen II*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) (quoting *Volkswagen I*, 371 F.3d 201, 203 (5th Cir. 2004)).

100. *Def. Distributed v. Bruck*, 30 F.4th 414, 435 (5th Cir. 2022).

101. *Id.* (quoting *Watson v. Fieldwood Energy Offshore, LLC*, 181 F. Supp. 3d 402, 412 (S.D. Tex. 2016)).

102. *Id.* (citing *In re Apple Inc.*, 979 F.3d 1332, 1345 (Fed. Cir. 2020)).

103. *Volkswagen I*, 371 F.3d at 206 (quoting *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508–09 (1947)).

104. *Volkswagen II*, 545 F.3d at 315.

105. *See In re Radmax, Ltd.*, 720 F.3d 285, 289 (5th Cir. 2013).

106. *See id.*

107. *Def. Distributed v. Bruck*, 30 F.4th 414, 436 (5th Cir. 2022) (alteration in original) (quoting *Atl. Marine Constr. Co., Inc. v. U.S. Dist. Ct. for W. Dist. of Tex.*, 571 U.S. 49, 67 (2013)).

108. *See id.*

109. *See In re TS Tech USA Corp.*, 551 F.3d 1315, 1319 (Fed. Cir. 2008) (“Because this petition does not involve substantive issues of patent law, this court applies the laws of the regional circuit in which the district court sits, in this case the Fifth Circuit.”); *see also Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 32 (1988) (classifying transfer of venue under § 1404(a) as procedural, rather than substantive).

IV. PATENT CASES IN THE EASTERN AND WESTERN DISTRICTS OF TEXAS

Plaintiffs with patent claims frequently file their claims in the Eastern and Western Districts of Texas.¹¹⁰ Colloquially, this phenomenon is known as “forum shopping,” which occurs when a plaintiff strategically files a claim in a jurisdiction that they believe will give them a more favorable outcome than any other.¹¹¹ As a preliminary matter, it should be noted that forum shopping is expected from a plaintiff in litigation.¹¹² Forum shopping is increasingly common in patent claims against large tech companies because, given the national reach of these large corporations, venue is proper in many federal courts around the country.¹¹³

Plaintiffs in patent cases likely migrate to the Eastern and Western Districts of Texas for a few reasons. First, these venues are considered “plaintiff-friendly,” and perhaps more importantly, “patent-friendly.”¹¹⁴ Second, due to the substantial patent docket that both districts maintain,¹¹⁵ plaintiffs likely enjoy greater predictability of how a judge may rule on certain motions, given that the judge has likely ruled on a similar motion previously. Finally, many consider these jurisdictions to be “rocket dockets,” which refers to a court that sets an aggressive docket schedule with the intent of getting to trial quickly.¹¹⁶ In a patent claim, a rocket docket is desirable for a plaintiff.¹¹⁷ Statistics suggest that the win rate in a patent case is quite high in a jury trial.¹¹⁸ Thus, it may be in a patent plaintiff’s best interest to file in a district that can reach trial quickly. Both the Eastern and Western Districts

110. See Aimee Fagan, *Two Months After the WDTX Waco Order: The Surprise Is What Hasn’t Changed*, TEX. LAW. (Oct. 19, 2022), <https://www.law.com/texaslawyer/2022/10/19/two-months-after-the-wdtx-waco-order-the-surprise-is-what-hasnt-changed> [https://perma.cc/2U5J-RE5Z] (providing statistics revealing that the Western and Eastern Districts of Texas are first and third respectively in patent case filings among all federal district courts around the country).

111. See *Forum-Shopping*, BLACK’S LAW DICTIONARY (11th ed. 2019).

112. See Patrick E. Higginbotham, *EDTX and Transfer of Venue: Move Over, Federal Circuit—Here is the Fifth Circuit’s Law on Transfer of Venue*, 14 SMU SCI. & TECH. L. REV. 191, 197 (2018):

There is nothing illegal, improper, or unjust about a plaintiff deciding to go to a forum where he thinks a jury is more generous—whether he is right or he is wrong—where he thinks the judges are better, or whether he just thinks “that is where I want to be.” If there is a flaw in that, it lies with the venue statute.

113. See Edward L. Barrett, Jr., *Venue and Service of Process in the Federal Courts—Suggestions for Reform*, 7 VAND. L. REV. 608, 617 (1954).

114. See David Lisch & David G. Henry, *The Newest Patent “Rocket-Docket”: Waco, Texas*, IPWATCHDOG (Feb. 18, 2019, 6:15 PM), <https://ipwatchdog.com/2019/02/18/newest-patent-rocket-docket-waco-texas/id=106453> [https://perma.cc/M7XS-EPMZ]; Lena Colin, Jason Cunningham, Jeffrey Mills & Steven Zager, *Considering a Move to Texas? Here’s What You Need to Know About Patent Litigation*, JDSUPRA (Oct. 4, 2021), <https://www.jdsupra.com/legalnews/considering-a-move-to-texas-here-s-what-9220724> [https://perma.cc/F2U9-WVLB] (“Jurors in the EDTX tend to respect the patents. They also award large damage amounts . . . About 5% of patent cases filed in Marshall go to trial and the plaintiff wins in about 78% of them.”).

115. See Fagan, *supra* note 110.

116. See, e.g., Lisch & Henry, *supra* note 114.

117. See *id.*

118. See Andrei Iancu & Jay Chung, *Real Reasons the Eastern District of Texas Draws Patent Cases—Beyond Lore and Anecdote*, 14 SMU SCI. & TECH. L. REV. 299, 305 (2017)

of Texas have an accelerated discovery timeline and pretrial deadlines that help push the cases to trial faster than other districts.¹¹⁹ Even if a plaintiff does not want to go to trial, defendants may be more likely to settle with the threat of a fast-approaching trial looming in the not-so-distant future.¹²⁰

In sum, patent plaintiffs regard the Eastern and Western Districts of Texas as vitally important to effectively assert their rights. Therefore, when defendants in these cases file a motion to transfer under § 1404(a) and the district judge denies the motion, the Federal Circuit must take care to apply Fifth Circuit law correctly. The writ of mandamus is an extraordinary weapon for a defendant, which, if misapplied, threatens patent litigants everywhere. If the writ of mandamus is granted too frequently, the practical result is that defendants will get two bites at the apple when attempting to transfer a case—once at the district level and once by petitioning the Federal Circuit for a writ of mandamus. An unfair consequence of this magnitude subverts the rules of civil procedure and threatens fundamental fairness, which is precisely why the Supreme Court and Fifth Circuit sought to avoid it by mandating that the writ of mandamus is not a substitute for an appeal.¹²¹

V. FEDERAL CIRCUIT APPLYING FIFTH CIRCUIT TRANSFER LAW?

Over the last few years, the Federal Circuit has developed a trend of granting many writ of mandamus petitions to overturn district courts in the Eastern and Western Districts of Texas on § 1404(a) transfer decisions.¹²² A close look at case law indicates that the Federal Circuit consistently seems to make three errors: (1) misapplying Fifth Circuit law as it exists; (2) adding nuances to transfer law that the Fifth Circuit has not stated; and (3) substituting its own judgment for the district court, which practically results in a *de novo* review. Recall that the standard of review for § 1404(a) transfer appeals is “clear abuse of discretion,”—a highly deferential standard—absent which, the Federal Circuit is mandated by the Supreme Court and Fifth Circuit to deny the writ of mandamus.¹²³ The following two cases illustrate this problem.

(finding that the average win rate for patentees at jury trial is 73% in the Eastern District of Texas and 68% nationally).

119. See Brian Love & James Yoon, *Predictably Expensive: A Critical Look at Patent Litigation in the Eastern District of Texas*, SANTA CLARA L. DIGIT. COMMONS, Sept. 2016, at 20 (illustrating a chart comparing the pretrial timeline of Judge Gilstrap in the Eastern District of Texas to Judge Stark in the District of Delaware); see also Higginbotham, *supra* note 112, at 198 (discussing how the Eastern District of Texas’s practice is to get cases set for trial quickly); Colin, Cunningham, Mills & Zager, *supra* note 114 (“The Texas courts in the Western District of Texas (WDTX) and Eastern District of Texas (EDTX) are very experienced in patent matters and the cases move quickly.”); Lisch & Henry, *supra* note 114 (discussing Judge Albright’s tendencies to set early *Markman* hearings, resolve discovery disputes quickly by phone, ensure quick claim construction and an early trial date).

120. See Colin, Cunningham, Mills & Zager, *supra* note 114.

121. See *In re Chesson*, 897 F.2d 156, 159 (5th Cir. 1990); *Ex parte Fahey*, 332 U.S. 258, 260 (1947).

122. See *infra* note 175.

123. See *Schlagenhauf v. Holder*, 379 U.S. 104, 110 (1964); see also *Volkswagen II*, 545 F.3d 304, 309 (5th Cir. 2008) (en banc).

A. *IN RE APPLE*

In re Apple involved a patent infringement suit by a plaintiff against Apple, filed in the Western District of Texas (WDTX).¹²⁴ Apple moved to transfer the case to the Northern District of California (NDCA) under § 1404(a) on the basis that California would be a more convenient venue.¹²⁵ The district court denied the motion to transfer, and Apple subsequently filed a petition for a writ of mandamus.¹²⁶ The Federal Circuit ultimately issued a writ of mandamus and ordered the case to be transferred to California.¹²⁷ In so holding, the Federal Circuit made a few missteps while applying the Fifth Circuit's transfer law.

Regarding the first private interest factor—ease of access to sources of proof—the Federal Circuit held that the district court “overemphasiz[ed] the sources of proof in or nearer to [the] WDTX and fail[ed] to meaningfully consider the sources of proof in [the] NDCA.”¹²⁸ The abuse of discretion, according to the Federal Circuit, is that “[i]n patent infringement cases, the bulk of the relevant evidence usually comes from the accused infringer”; “[c]onsequently, the place where the defendant's documents are kept weighs in favor of transfer to that location.”¹²⁹ There are two problems with the Federal Circuit's holding here. First, the Federal Circuit seems to believe that certain evidence—the physical location of Apple's documents—should have been more persuasive to the district court.¹³⁰ But Fifth Circuit law is clear: the district court has broad discretion to weigh the evidence—however *it* sees fit.¹³¹ Second, the Federal Circuit's assertion that the accused infringer's evidence is more important in patent infringement cases derives from its own precedent, rather than the Fifth Circuit as settled federal law requires.¹³² Indeed, the Fifth Circuit has not shed light on which side's evidence is more important in patent cases.¹³³

As for the third private interest factor—cost of attendance for willing witnesses—the Federal Circuit is similarly bound to follow the Fifth Circuit's “100-mile rule,” which states that “[w]hen 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.”¹³⁴ However, the Federal Circuit, again citing its own precedent, held that “the ‘100-mile’ rule should not be rigidly applied” if the witnesses will have to travel far

124. *In re Apple Inc.*, 979 F.3d 1332 (Fed. Cir. 2020).

125. *Id.* at 1336.

126. *Id.*

127. *Id.* at 1347.

128. *Id.* at 1340.

129. *Id.* (quoting *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009)).

130. *See id.* (“[T]he district court erred by failing to meaningfully consider the wealth of important information in [the] NDCA.”).

131. *See Volkswagen II*, 545 F.3d 304, 311 (5th Cir. 2008) (en banc).

132. *See In re Apple*, 979 F.3d at 1340.

133. Notably, the Fifth Circuit will likely never comment on this because the Federal Circuit has exclusive jurisdiction of appeals in patent infringement cases. *See supra* Part I.C.

134. *Volkswagen II*, 545 F.3d at 317 (citation omitted).

regardless.¹³⁵ As a result of this misapplication of law, the Federal Circuit held that the “district court misapplied the law to the facts of this case by too rigidly applying the 100-mile rule,” because although the WDTX was closer than the NDCA, the witnesses would have to travel far regardless.¹³⁶ Again, the Federal Circuit’s unilateral conclusion based on *its own law* is problematic. Unlike the Federal Circuit, the Fifth Circuit has never held that the 100-mile rule should not be rigidly applied where witnesses will have to travel far regardless. In fact, a plain reading of the Fifth Circuit’s rule suggests the exact opposite: the factor’s importance “increases in direct relationship to the *additional distance* to be traveled.”¹³⁷ The district court is within its discretion to rigidly apply the rule if it chooses to.¹³⁸ It is difficult to understand how the WDTX committed an abuse of discretion by strictly adhering to Fifth Circuit law. In effect, the Federal Circuit acted alone; in performing the factors test, it substituted its own judgment for that of the district court.¹³⁹

As to the final part of the private interest inquiry, the district court determined that the fourth factor—all other practical problems related to quick, easy, and inexpensive trial—weighed in favor of denying transfer because the NDCA’s docket was significantly more congested than the WDTX.¹⁴⁰ The Federal Circuit, however, held that the district court erred because both parties had other lawsuits pending in the Northern District of California and “it is beyond question that the ability to transfer a case to a district with numerous cases involving some overlapping issues weighs at least slightly in favor of such a transfer.”¹⁴¹ Not only does the Federal Circuit fail to cite any Fifth Circuit precedent to ground that assertion, but it also fails to cite anything at all.¹⁴² In response, the dissent flagged the majority’s failure to cite anything for that assertion, and that the majority appeared to disregard “the carefully considered facts regarding [the] NDCA and the cases themselves which the district court discussed over many pages of its opinion.”¹⁴³

As for part two of the analysis, which contemplates the various public interest factors at play, the district court began the inquiry by assessing the administrative difficulties flowing from court congestion. The district court found that this factor weighed in favor of denying transfer because the court had already set a fast-paced schedule for trial, and the case would therefore reach trial much faster in Texas.¹⁴⁴ The Federal Circuit, on the other hand, held that the district court erred because “a court’s general ability to set a

135. See *In re Apple*, 979 F.3d at 1341 (quoting *In re Genentech, Inc.*, 566 F.3d 1338, 1344 (Fed. Cir. 2009)).

136. See *id.* at 1342.

137. *Volkswagen II*, 545 F.3d at 317 (emphasis added) (citation omitted).

138. See *id.* at 311 (“There can be no question but that the district courts have ‘broad discretion in deciding whether to order a transfer.’” (citation omitted)).

139. See *In re Apple*, 979 F.3d at 1342.

140. See *id.* at 1343.

141. *Id.* at 1344.

142. See *id.*

143. See *id.* at 1350 (Moore, J., dissenting).

144. *Id.* at 1344.

fast-paced schedule is not particularly relevant to this factor.”¹⁴⁵ The propriety of this decision is questionable because, again, the Fifth Circuit has never considered a district court’s ability to set a fast-paced schedule as flatly irrelevant.¹⁴⁶ In keeping with its apparent, emerging custom on these issues, the Federal Circuit cites only itself for this assertion.¹⁴⁷

In re Apple represents three fundamental errors the Federal Circuit committed. The Federal Circuit (1) misapplied the Fifth Circuit’s 100-mile rule; (2) added nuances to rules without citing any Fifth Circuit precedent as justification for the district court’s “abuse of discretion”; and (3) claimed the district court abused its discretion by weighing evidence differently than the Federal Circuit would have—which amounts to the Federal Circuit substituting its own judgment for the district court and necessarily circumventing the Supreme Court’s express mandate. Granting a writ of mandamus petition in this instance provided Apple with a second attempt to transfer the case. After the district court exercised its broad discretion to determine that a transfer was not proper, the Federal Circuit conducted a de novo review, failing to adhere to the abuse of discretion standard.¹⁴⁸

B. *IN RE GOOGLE*

In re Google serves as a similar illustration.¹⁴⁹ This case involved a patent infringement suit against Google also filed in the Western District of Texas.¹⁵⁰ Google filed a § 1404(a) motion to transfer the case to the Northern District of California.¹⁵¹ The district court denied the motion, holding that the transfer factors did not weigh in favor of transferring the case.¹⁵² Google filed a petition for a writ of mandamus to the Federal Circuit, which the Federal Circuit granted, concluding that the district court abused its discretion.¹⁵³ Again, the Federal Circuit made many familiar errors applying the Fifth Circuit’s transfer law.

The district court determined that the third private interest factor—cost and convenience of willing witnesses—weighed against transferring the case.¹⁵⁴ In reaching this decision, the district court assigned little weight to the fact that the parties own witnesses (Google’s employees) were located in the Northern District of California.¹⁵⁵ Instead, the district court’s analysis on this factor centered more on non-party witnesses living in the

145. *Id.* (citing *In re Adobe Inc.*, 823 F. App’x 929, 932 (Fed. Cir. 2020)).

146. In fact, although this caselaw was not available to the Federal Circuit at the time of *In re Apple*, the Fifth Circuit has recently stated that if a case is proceeding towards trial in a timely manner, that weighs *against* transfer. *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 631 (5th Cir. 2022).

147. *See In re Apple*, 979 F.3d at 1344.

148. *See id.* at 1347 (Moore, J., dissenting).

149. *In re Google LLC*, No. 2021-170, 2021 WL 4427899 (Fed. Cir. Sept. 27, 2021).

150. *Id.* at *1.

151. *Id.* at *1–2.

152. *Id.* at *2.

153. *Id.*

154. *Id.* at *4.

155. *Id.* at *3–4.

Northeastern United States.¹⁵⁶ The district court, adhering to the Fifth Circuit's 100-mile rule, determined that the Western District of Texas was more convenient because it required 1,000 fewer miles of travel compared to the Northern District of California.¹⁵⁷ The Federal Circuit had a different view. The Federal Circuit began the analysis by seemingly admonishing the district court for citing its own precedent to determine that party witnesses are given little weight.¹⁵⁸ Ironically, however, the Federal Circuit proceeds to cite itself—not the Fifth Circuit—to assert that a party's ability to compel its own witness does not mean that party witnesses should be of lesser weight in the transfer analysis.¹⁵⁹ More significantly, the Federal Circuit acknowledges the Fifth Circuit's 100-mile rule, but determines—on its own accord—that “time is a more important metric than distance.”¹⁶⁰ Consequently, even though Waco was geographically closer to the non-party witnesses than the Northern District of California, Waco would not be more convenient because there is no major airport there, and it would, therefore, take longer to travel to Waco.¹⁶¹ The Federal Circuit's actions here hardly seem consistent with Fifth Circuit precedent. First, the district court has broad discretion under this analysis and, therefore, has the discretion to find that party witnesses are less persuasive in the transfer analysis, barring any Fifth Circuit precedent that says otherwise. The Federal Circuit breaches that discretion by substituting its own determination (while also citing its own precedent) that party witnesses should, in fact, be more persuasive in the transfer analysis. Second, the Federal Circuit's determination that “time is a more important metric than distance”¹⁶² is directly contrary to the Fifth Circuit's 100-mile rule—which quite literally incorporates *distance* into its name. The Federal Circuit is bound by Fifth Circuit law, which means the 100-mile rule is binding precedent.

With respect to the first public interest factor—which considers court congestion—the district court found that this factor weighed against transfer because the time to trial would be quicker in the WDTX compared to the NDCA.¹⁶³ The Federal Circuit disagreed, holding that “[w]here, as here, the district court has relied on median time-to-trial statistics to support its conclusion as to court congestion, we have characterized this factor as the ‘most speculative’ of the factors bearing on the transfer decision.”¹⁶⁴ As a result, such speculation did not support a conclusion to keep the case in

156. *Id.* at *4.

157. *Id.*; *see also id.* at *2 (“The district court explained that the witnesses in the northeast ‘would be more inconvenienced traveling more than twice the distance—over 1000 additional miles—to the NDCA compared to the WDTX.’”).

158. *See id.* at *3–4.

159. *See id.* at *4 (“We have rejected the district court's reliance on the fact that a party's ability to compel the testimony of its employees supports assigning little or no weight to the convenience and cost to those witnesses.” (citing *In re Juniper Networks, Inc.*, 14 F.4th 1313 (Fed. Cir. 2021); *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021))).

160. *Id.*

161. *See id.*

162. *Id.*

163. *Id.* at *7.

164. *Id.* (citing *In re Genentech, Inc.*, 566 F.3d 1338, 1347 (Fed. Cir. 2009)).

the Western District of Texas.¹⁶⁵ Once again, however, the Federal Circuit made this legal assertion with citations to its own precedent, not to the Fifth Circuit.¹⁶⁶ Remarkably, in the time since *In re Google*, the Fifth Circuit issued an opinion denying a petition for writ of mandamus regarding a § 1404(a) transfer motion and held that “to the extent docket efficiency can be reliably estimated, the district court is better placed to do so than [the reviewing appellate court].”¹⁶⁷ Therefore, a district court is within its discretion to rely on median time-to-trial statistics.¹⁶⁸ Not only did the Federal Circuit ground its decision in its own precedent to substitute its judgment for the district court, but subsequent Fifth Circuit case law illustrates why the Federal Circuit was wrong to do so.¹⁶⁹

Finally, the second private interest factor—the existence of a compulsory process to compel unwilling witnesses—deserves attention. The district court determined that this factor weighed against transfer because Google provided no evidence indicating that witnesses would be unwilling to testify in Waco.¹⁷⁰ The Federal Circuit then stated that its own precedent, *In re Hulu, LLC*,¹⁷¹ had already “rejected the proposition, adopted by the district court in this case, that the compulsory process factor is irrelevant unless the witnesses in question have expressly indicated an unwillingness to testify voluntarily.”¹⁷² Again, the Federal Circuit held that the district court abused its discretion by merely choosing to find certain factors more or less persuasive. And in justifying its decision, the Federal Circuit offered only its own precedent, effectively substituting its own judgment for that of the district courts. Notably, and once again, the Fifth Circuit has sided with the district court by stating that this factor “receives less weight when it has not been alleged or shown that any witness would be unwilling to testify.”¹⁷³

VI. CRITIQUE OF THE FEDERAL CIRCUIT

The Federal Circuit is making three errors. First, the Federal Circuit is making decisions contrary to Fifth Circuit precedent where that precedent is on point, namely, the 100-mile rule. Second, the Federal Circuit is citing to its own precedent where there is no Fifth Circuit precedent directly on point. For example, striking down district courts’ decisions about time-to-trial statistics, party witnesses’ willingness to testify, and which sides’ evidence weighs more in patent cases. Third, the Federal Circuit is effectively reevaluating the evidence by substituting district courts’ discretion for its

165. *Id.*

166. *See id.*

167. *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 631 (5th Cir. 2022) (discussing the court congestion factor).

168. *See id.*

169. *See id.*

170. *In re Google*, 2021 WL 4427899, at *6.

171. *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021).

172. *In re Google*, 2021 WL 4427899, at *7.

173. *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 630–31 (5th Cir. 2022) (citations omitted).

own. The practical consequence is that the Federal Circuit is effectively conducting a de novo review, which stands in stark contrast to the standard of review it is required to apply—clear abuse of discretion. As a result, the Federal Circuit is exploiting the writ of mandamus—the “most potent weapon[] in the judicial arsenal.”¹⁷⁴ *In re Apple* and *In re Google* represent just two examples of a frequent and growing problem. Over the last few years, the Federal Circuit has been busy overturning district courts in the Eastern and Western Districts of Texas for a purported abuse of discretion in denying § 1404(a) transfers in patent cases.¹⁷⁵

Research reveals just how frequently the Federal Circuit is granting petitions for a writ of mandamus. A study conducted between 2008 and 2021 uncovered that the Federal Circuit was granting petitions for a writ of mandamus and overturning the Eastern and Western Districts of Texas over 37% of the time.¹⁷⁶ That rate jumps to about 45% when the destination venue is the Northern District of California, which happens to be where most of the big tech companies—common defendants in patent litigation—are located.¹⁷⁷ Notably, Judge Alan Albright, who sits in the Waco Division of the Western District of Texas, specifically takes on a substantial portion of the national patent docket, and the Federal Circuit grants petitions for a writ of mandamus to transfer his cases over 56% of the time.¹⁷⁸ Again, this jumps to 63% when the petition involves a transfer from the Western District of Texas to the Northern District of California.¹⁷⁹ Significantly, the study concluded by remarking that, although 2022 was not included in the study, big tech defendants were off to a strong start.¹⁸⁰ To illustrate the significance and abnormality of the above statistics, the Federal Circuit’s rate

174. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (citing *Will v. United States*, 389 U.S. 90, 107 (1967)).

175. See, e.g., *In re Apple Inc.*, No. 2022-128, 2022 WL 1196768 (Fed. Cir. Apr. 22, 2022); *In re Google LLC*, No. 2022-140, 2022 WL 1613192 (Fed. Cir. May 23, 2022); *In re Apple Inc.*, No. 2022-137, 2022 WL 1676400 (Fed. Cir. May 26, 2022); *In re Google LLC*, No. 2021-171, 2021 WL 4592280 (Fed. Cir. Oct. 6, 2021); *In re NetScout Sys., Inc.*, No. 2021-173, 2021 WL 4771756 (Fed. Cir. Oct. 13, 2021); *In re Quest Diagnostics Inc.*, No. 2021-193, 2021 WL 5230757 (Fed. Cir. Nov. 10, 2021); *In re Apple Inc.*, No. 2021-181, 2021 WL 5291804 (Fed. Cir. Nov. 15, 2021); *In re Amazon.com, Inc.*, No. 2022-157, 2022 WL 17688072 (Fed. Cir. Dec. 15, 2022); *In re Pandora Media, LLC*, No. 2021-172, 2021 WL 4772805 (Fed. Cir. Oct. 13, 2021); *In re Atlassian Corp.*, No. 2021-177, 2021 WL 5292268 (Fed. Cir. Nov. 15, 2021); *In re Juniper Networks, Inc.*, 14 F.4th 1313 (Fed. Cir. 2021); *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021); *In re Samsung Elecs. Co.*, 2 F.4th 1371 (Fed. Cir. 2021); *In re TracFone Wireless, Inc.*, 852 F. App’x. 537 (Fed. Cir. 2021).

176. Paul R. Gugliuzza, Jonas Anderson & Jason Rantanen, *Who Escapes Texas? And Where Do They Go? Mandamus Petitioners and Transferee Courts in Patent Venue Disputes*, PATENTLY-O (June 17, 2022), <https://patentlyo.com/patent/2022/06/mandamus-petitioners-transferee.html> [https://perma.cc/5LPN-Q5VV].

177. *Id.*

178. Jonas Anderson, Paul Gugliuzza & Jason Rantanen, *Extraordinary Writ or Ordinary Remedy? Mandamus at the Federal Circuit—Part 3*, PATENTLY-O (Oct. 21, 2021), <https://patentlyo.com/patent/2021/10/extraordinary-ordinary-mandamus-federal-circuit.html> [https://perma.cc/T53K-8WW8].

179. Gugliuzza, Anderson & Rantanen, *supra* note 176.

180. Apple was 2-0 to start 2022, and Google and Samsung both won their first petitions of the year. *Id.*

for granting a writ of mandamus petition on § 1404(a) motions in all federal districts, excluding the Eastern and Western Districts of Texas, was 17.6%.¹⁸¹

Moreover, between 2019 and 2021, every other federal circuit court granted a petition for a writ of mandamus from the denial of a § 1404(a) motion for a grand total of *one time*.¹⁸² The Federal Circuit, on the other hand, did so *fourteen times* in the same period.¹⁸³ Remember, the writ of mandamus is the most potent weapon in the judicial arsenal.¹⁸⁴ Plaintiffs are supposed to have their choice of venue.¹⁸⁵ However, as it stands, the Federal Circuit will likely deprive plaintiffs in patent cases of that choice—defendants in these cases essentially receive two bites at the apple. First, the defendant can sway the district court to grant the § 1404(a) motion outright. If that fails, however, the Federal Circuit’s review—which seems to be conducted like a *de novo* review—allows the defendant another chance to show that the destination venue is more convenient. This advantage is especially true for big tech companies who are frequently the defendants in patent litigation, and who have no problem spending the money to petition the Federal Circuit.¹⁸⁶

Perhaps the most persuasive evidence that the Federal Circuit is misapplying Fifth Circuit transfer law comes from a dissent written by Judge Diana Moore of the Federal Circuit in the same case discussed above, *In re Apple*.¹⁸⁷ Judge Moore emphasized that the Federal Circuit’s “review on a petition for a writ of mandamus is supposed to be limited,” and that a district court should be overturned *only* for an abuse of discretion.¹⁸⁸ Judge Moore notes that protecting this standard of review is vital because a district court is in a better position to familiarize itself with the evidence and “ultimately is better able to dispose of these motions.”¹⁸⁹ Most importantly, Judge Moore stressed that “mandamus jurisdiction is not an invitation to exercise *de novo* dominion.”¹⁹⁰ Judge Moore cautioned the Federal Circuit against repeating the majority’s flawed reasoning, which essentially reevaluated the § 1404(a) transfer factors for a second time.¹⁹¹ Judge Moore succinctly explained why the majority’s actions could lead to unwanted results:

181. Anderson, Gugliuzza & Rantanen, *supra* note 178.

182. Jonas Anderson, Paul Gugliuzza & Jason Rantanen, *Extraordinary Writ or Ordinary Remedy? Mandamus at the Federal Circuit—Part 1*, PATENTLY-O (Oct. 19, 2021), <https://patentlyo.com/patent/2021/10/extraordinary-ordinary-mandamus.html> [<https://perma.cc/66FF-D33U>] (showing the single occurrence courtesy of the Seventh Circuit).

183. *Id.*

184. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004).

185. *See Higginbotham*, *supra* note 112, at 197:

The United State Supreme Court has said—and it is fundamentally the case—that when the plaintiff decides to file suit and lacks venue, he does not do so with an open and generous heart, he does so out of the thought of finding the best place for himself. . . . [T]he law gives them the right to make that choice If there is a flaw in that, it lies with the venue statute.

186. *See* Gugliuzza, Anderson & Rantanen, *supra* note 176 (“To be sure, the world’s richest corporations, like Apple and Google, enjoy massive advantages any time they litigate; the notion that we have an impartial court system indifferent to litigants’ economic power is fanciful.”).

187. *In re Apple Inc.*, 979 F.3d 1332, 1347–53 (Fed. Cir. 2020) (Moore, J., dissenting).

188. *Id.* at 1347.

189. *Id.* (quoting *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010)).

190. *Id.*

191. *See id.* at 1348.

Rather than conducting this limited review, the majority usurps the district court's role in the [§ 1404(a)] transfer process, disregards our standard of review and substitutes its judgment for that of the district court. I am concerned that the majority's blatant disregard for the district court's thorough fact findings and for our role in a petition for mandamus will invite further petitions based almost entirely on ad hominem attacks on esteemed jurists similar to those Apple wages here I am not comfortable with the new role the majority has carved out for our court, and I believe it is inconsistent with the Fifth Circuit law that we are bound to follow.¹⁹²

Judge Moore's description captures the essence of the issue. The Federal Circuit is bound to apply Fifth Circuit law. The Federal Circuit must not substitute its own judgment for that of the district court. The Federal Circuit should only grant this extraordinary remedy where the district court abuses its discretion. A writ of mandamus should not be granted where the Federal Circuit merely disagrees with the district court's decision.

VII. PROPOSED SOLUTIONS

To maintain the integrity of the writ of mandamus and to protect patent plaintiffs' choice of venue, some change must be implemented. This Comment proposes three plausible solutions to resolve this issue.

First, and perhaps most obvious, the Fifth Circuit could issue more frequent and expansive § 1404(a) decisions to build its transfer law jurisprudence. If the Fifth Circuit provided opinions that instructed how much weight should be given to certain types of evidence, it would prevent district courts and the Federal Circuit from disputing it. For example, a recent Fifth Circuit opinion clarified the law surrounding the court congestion factor and the ability to compel unwilling witness factor—both of which had been a source of dispute between the Federal Circuit and district courts.¹⁹³ However, this solution is limited. Aside from the fact that the Fifth Circuit does not often issue full opinions on § 1404(a) cases, the Fifth Circuit will never be able to develop transfer law jurisprudence in the context of patent cases because the Federal Circuit has exclusive jurisdiction over patent claims. Therefore, the Federal Circuit has an admittedly difficult task of applying patent-specific facts to the available Fifth Circuit transfer law. Moreover, the viability of this solution presumes the major premise—that the Federal Circuit would abide by Fifth Circuit law. This is no guarantee (e.g., the Federal Circuit's misapplication of the Fifth Circuit's 100-mile rule).

A second solution is that the Supreme Court could grant certiorari on one of the many Federal Circuit decisions granting a mandamus petition and declare that the Federal Circuit is incorrectly applying the abuse of discretion standard in these decisions. As the Supreme Court itself has stated, a writ of mandamus is “one of ‘the most potent weapons in the judicial

192. *Id.*

193. *See In re Planned Parenthood Fed'n of Am., Inc.*, 52 F.4th 625, 630–31 (5th Cir. 2022).

arsenal.”¹⁹⁴ If, in fact, the writ of mandamus is such a potent weapon, it follows that the judiciary should deliver such a crushing blow only in extreme cases—where justice requires it. In the context of a § 1404(a) petition, the Federal Circuit has granted this extraordinary remedy over ten times more than the rest of the federal appellate courts combined.¹⁹⁵

In fact, the Supreme Court has a second justification for reversing the Federal Circuit. As *In re Apple* and *In re Google* illustrate, the Federal Circuit has developed a habit of citing its own case precedent to resolve these cases.¹⁹⁶ To be clear, the Supreme Court has declared a § 1404(a) transfer to be a procedural issue, not a substantive one.¹⁹⁷ Therefore, the Supreme Court could reverse the Federal Circuit for injecting its own substantive patent law into an analysis that, by law, must only contain the procedural law of the regional circuit in which the case arises.

If the Supreme Court does not grant certiorari, a third, and perhaps lesser, solution exists. The Federal Circuit could conclude that a § 1404(a) transfer motion, specifically in the context of a patent claim, is a substantive patent law issue, and therefore the Federal Circuit should apply its own law. Importantly, one could (and should) argue that this goes against Supreme Court precedent, which has already held that a § 1404(a) transfer motion is a procedural matter.¹⁹⁸ Nonetheless, the Federal Circuit could plausibly distinguish Supreme Court precedent to find that a § 1404(a) transfer—only in the context of a patent case—can be categorized as a substantive patent issue. Often, patent cases involve unique facts that should be relevant in the convenience analysis under § 1404(a). Examples include the location of electronic documents, which sides’ witnesses are most important in patent cases, and the importance of prior art evidence—evidence that an invention is already known. The Fifth Circuit, or any other circuit for that matter, will never answer questions like this because these courts will never decide patent cases. The Federal Circuit may need to develop its own transfer law as it applies to patent cases because there are certain facts in patent cases that seem like apples to oranges when compared to other cases.

Furthermore, the reality is that the Federal Circuit has already developed plenty of transfer law nuances of its own. The Federal Circuit’s § 1404(a) cases contain numerous citations to its own precedent, rather than the Fifth Circuit precedent that often binds it. Unless the Federal Circuit changes how it applies its choice of law rule regarding § 1404(a), or until the Supreme Court steps in, the Federal Circuit may continue to abuse the “extraordinary remedy” that is the writ of mandamus.

194. *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (citing *Will v. United States*, 389 U.S. 90, 107 (1967)).

195. See Anderson, Gugliuzza & Rantanen, *supra* note 182.

196. See *supra* Sections V.A–B.

197. *Stewart Org. v. Ricoh Corp.*, 487 U.S. 22, 32 (1988).

198. See *supra* Section II.C.

VIII. CONCLUSION

The writ of mandamus is an extraordinary remedy to be reserved for extraordinary circumstances. Giving a defendant the opportunity, in the middle of litigation, to appeal the decision of a district judge is a powerful weapon. This weapon is even more powerful when it can be used to overturn the plaintiff's choice of forum. An abuse of the writ of mandamus results in a defendant receiving two bites at the apple—two chances to transfer the case out of the plaintiff's chosen forum. Such a powerful weapon demands a high burden to prevent its overuse: one that is strictly followed. As such, the abuse of discretion standard that binds the Federal Circuit must be adhered to.

The Federal Circuit is making three errors in petitions for a writ of mandamus in § 1404(a) cases. The Federal Circuit is (1) misapplying Fifth Circuit law, (2) adding nuances to transfer law that the Fifth Circuit has not stated, and (3) applying a *de novo* review, not an abuse of discretion standard, by substituting its own judgment for the district court. To say that district judges in the Eastern District and Western Districts of Texas have been abusing their discretion in so many patent cases in the last few years is a clear signal that change is necessary. Until that change, however, patent plaintiffs are tasked with two, steep climbs: (1) persuading a district judge that the destination forum is not clearly more convenient than the present forum, and (2) convincing a panel of federal circuit judges of the same.

The overuse of the writ of mandamus—one of the most potent weapons in the judicial arsenal—decreases the legitimacy of the court, threatens patent plaintiffs everywhere, and creates confusion in the law, particularly in the Fifth Circuit. Whether the Fifth Circuit further expands its transfer law jurisprudence, the Supreme Court grants certiorari, or the Federal Circuit changes its application of its choice of law rule, it is clear that the status quo is not tenable.

