Miscellaneous Docket No. ___

IN THE

United States Court of Appeals for the Federal Circuit

IN RE DISH NETWORK L.L.C.,

Petitioner.

On Petition for Writ of Mandamus to the
United States District Court for the
Western District of Texas
No. 6:19-cv-00716-ADA, Hon. Alan D Albright

DISH NETWORK L.L.C.'S PETITION FOR WRIT OF MANDAMUS

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number

Short Case Caption In re DISH Network L.L.C.

Filing Party/Entity DISH Network L.L.C.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box**. Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 05/28/2021

Signature: /s/ Eric A. Shumsky

Name: Eric A. Shumsky

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.
☐ None/Not Applicable	☑ None/Not Applicable	☐ None/Not Applicable
DISH Network L.L.C.		DISH DBS Corporation, DISH Orbital Corporation, DISH Network Corporation

☐ Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable ☐ Additional pages attached

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Will H. Melehani	Parth Sagdeo	

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

☑ None/Not Applicable ☐ Additional pages attached

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☑ None/Not Applicable ☐ Additional pages attached

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Other Authorities

INTRODUCTION

This case has no business being in the Western District of Texas.

The relevant facts are undisputed. The plaintiff, BBiTV, is a non-practicing entity incorporated in Delaware and headquartered in Hawaii. It sued DISH Network, a Colorado LLC, over products designed and developed by people who live and work in Colorado, asserting patents whose inventor is a California resident and whose patent prosecutors are based in New York. Although BBiTV also has no physical presence, witnesses, documents, products, or services in Texas, it filed suit in the Waco Division of the Western District of Texas.

DISH promptly moved to transfer the case to the District of Colorado, based on Colorado's extensive connections to the controversy. The district court, however, required the parties to litigate in Texas for another eleven months—all the way through claim construction and almost to the end of fact discovery—before issuing a short order denying transfer.

When it did, the district court viewed this as a close case. It found that only two of the § 1404(a) factors weighed against transfer: namely, (1) that co-pending litigation involving the same family of patents was

proceeding in the Austin Division before the same judge, and (2) that the district court's "default schedule would lead to a trial date much sooner than the average time to trial in the District of Colorado." According to the district court, the remaining factors were neutral or, in the case of witness convenience, weighed "slightly" in favor of transfer.

But the district court was mistaken; this isn't remotely a close case. Transfer is clearly appropriate, as this dispute has no connection whatsoever to Texas, much less the Waco Division of the Western District, and the district court didn't even purport to find one. In denying the motion, the district court committed numerous legal errors. Each of them—from discounting party witnesses; to ignoring other witnesses' convenience; to setting aside the location of sources of proof—was a clear abuse of discretion, often in violation of settled precedent. This Court should issue a writ of mandamus directing the district court to transfer this case to the District of Colorado before DISH's rights are further eroded by being made to continue litigating in a forum with no connection to the case.

RELIEF SOUGHT

DISH respectfully requests that the Court grant this petition for a writ of mandamus, vacate the district court's order dated April 20, 2021, and remand the case with instructions to transfer it to the United States District Court for the District of Colorado.

ISSUE PRESENTED

Whether the district court clearly abused its discretion in refusing to transfer this case to the District of Colorado.

FACTUAL BACKGROUND AND PROCEDURAL HISTORY

BBiTV Files Suit Against DISH in the Western District of Texas, a District with No Connection to the Suit

BBiTV is incorporated in Delaware and headquartered in Hawaii. Appx31. DISH is a Colorado limited liability company and its headquarters are in Englewood, Colorado, just outside of Denver. Appx31; Appx484. At issue in this suit are DISH set-top boxes and mobile device apps that provide certain video-on-demand (VOD) functionality. Appx30.

BBiTV filed suit against DISH in December 2019, alleging that DISH's boxes and apps infringe four patents: U.S. Patent Nos.

10,028,026, 10,506,269, 9,998,791, and 9,648,388. Appx30.[1] The inventor on all four patents is Milton Diaz Perez, a resident of California with no known connection to Texas. Appx75; Appx108; Appx141; Appx164; Appx459-460. Each patent claims a process for uploading videos and metadata and then organizing and presenting a hierarchical menu to facilitate finding and retrieving those videos on-demand. Appx75; Appx108; Appx141; Appx164.[2] Accordingly, BBiTV's infringement allegations focus on the "electronic program guide" displayed on the screen when customers use DISH's boxes and apps, as well as the metadata that allow the electronic program guide to function. *E.g.*, Appx34; Appx39.

The software underlying DISH's VOD functionality was designed and developed primarily by DISH employees based in Colorado, with some engineering support from employees in India. Appx186. The

[1] Two days before BBiTV filed this lawsuit, it filed similar lawsuits against AT&T and DirecTV for infringing three of the four patents at issue here. *See* Complaint at 1, *Broadband iTV, Inc. v. AT&T Servs., Inc.*, No. 20-CV-717 (W.D. Tex. Dec. 17, 2019); Appx10.

[2] DISH cites BBiTV's allegations here solely to help the Court understand the nature of the dispute and the evidence that will likely be relevant to resolving it. DISH does not admit the truth of any of these allegations.

current and former DISH employees responsible for designing the company's electronic program guides and managing related metadata are also based in Colorado. Appx186-188. The relevant source code is stored in Colorado, as are technical documents about how DISH's software was designed and developed and non-technical documents like financial records and advertising materials. Appx187.

Although DISH has some operations in the Western District of Texas, none has anything to do with the subject of this litigation. One of DISH's many call centers is in the Western District of Texas. Appx187; Appx303. So are one of DISH's warehouses where DISH receivers are stored and one of DISH's "remanufacturing" facilities where employees refurbish used receivers. Appx187; Appx303. DISH's "digital broadcast operations" centers, which receive program content and uplink it to satellite so it may be delivered to customers, are scattered around the country, and one of them is in the Western District of Texas. Appx187-188; Appx303. Similarly, one of the "numerous" facilities that support technicians who service DISH equipment at customers' homes is in the Western District of Texas. Appx187-188;

Appx303. Again, these generic business operations have nothing to do with BBiTV's patent infringement case. Appx187-188.

Nonetheless, BBiTV filed this suit in the Waco Division of the Western District of Texas. Appx30.

DISH Seeks Transfer to the District of Colorado

DISH has not reflexively contested venue in the Western District of Texas. Appx194; *e.g.*, *Multimedia Content Mgmt. LLC v. DISH Network L.L.C.*, No. 18-CV-207 (W.D. Tex. filed July 25, 2018); *Innovative Foundry Techs. LLC v. Semiconductor Mfg. Int'l Corp. et al.*, No. 19-CV-719 (W.D. Tex. filed Dec. 20, 2019). However, neither BBiTV nor this lawsuit has any tie to the Western District of Texas. Accordingly, on May 7, 2020, DISH filed a motion to transfer the case to the District of Colorado or, in the alternative, the Austin Division of the Western District of Texas. Appx190-210. In connection with that motion, DISH submitted extensive documentation, as well as a sworn declaration from Dan Minnick, DISH's Senior Vice President of Software Engineering. Appx185-189.

That evidence demonstrates that most of the documents relevant to the case are located in Colorado; none is located in Texas. Appx197-

198. Similarly, current DISH employees, former DISH employees, and third parties likely to be witnesses are in Colorado; none is in Texas. Appx198-202. While DISH's accused products are distributed throughout the United States, including in the Western District of Texas, those products were designed and developed in Colorado, giving Colorado—not the Western District of Texas—a local interest in this dispute. Appx203-204. Co-pending litigation brought by BBiTV in the Western District of Texas against DISH's competitors might have weighed slightly against transfer on the theory that consolidated claim construction could lead to marginal efficiency gains, but it does not remotely outweigh the clear advantages of litigating in the District of Colorado. Appx204-206. And court congestion was either neutral or favored the District of Colorado. Appx206-207.[3]

Rather than taking venue discovery, BBiTV immediately opposed DISH's motion to transfer. Appx456-474. In its opposition, BBiTV went to great lengths to hypothesize a connection between this suit and the Western District of Texas. For example, BBiTV asserted—citing no

[3] In addition, DISH explained that, at a minimum, the Austin Division would be clearly more convenient than the Waco Division. Appx208.

evidence—that DISH's hardware remanufacturing center and the employees who worked at that center would have information relevant to this case. Appx463-464. It similarly claimed—again in attorney argument and without citing evidence—that employees and records from a DISH call center located in the district might somehow bear on the parties' dispute. Appx464. Finally, BBiTV identified, from LinkedIn, DISH employees purportedly located in the Western District of Texas and speculated that they might offer relevant testimony. Appx464-465.

In reply, DISH explained that BBiTV's speculation and internet research were simply incorrect. Appx475-482. Witnesses whom BBiTV claimed were located in Texas are in fact located in Colorado, Utah, and Maryland—or never worked for DISH at all. Appx476-477. DISH's remanufacturing center erases, tests, and repairs used receivers before sending refurbished receivers to customers, so it has no possible relevance to this case. Appx477-479. And DISH call center employees are wholly implausible witness candidates. Moreover, call center logs are all kept in Colorado, and if for some reason BBiTV really did need a low-level call center employee to testify at trial, it could call an

employee from one of DISH's multiple Colorado call centers. Appx477; Appx479.

While the Transfer Motion Remains Pending, The District Court Pushes the Case Forward

DISH's transfer motion was fully briefed on May 28, 2021. Appx23; Appx475. But the district court pushed ahead with the merits of the case. It held a telephonic discovery conference on June 25, 2020. Appx23. It addressed (and summarily denied) DISH's motion to dismiss on July 25, 2020. Appx23. It required the parties to brief claim construction. Appx24-26. It held a second telephonic discovery hearing on August 31, 2020. Appx24. It conducted a *Markman* hearing on November 13, 2020. Appx26. And it issued a written *Markman* order on December 3, 2020. Appx26; Appx499-503.

The District Court Denies DISH's Motion to Transfer

On April 20, 2021—almost a year after DISH filed its motion to transfer—the district court finally resolved it. Appx1-13. The district court did not credit any of BBiTV's unsubstantiated attempts to link its suit to the Western District of Texas. But the court nevertheless cast most of the § 1404(a) factors as "neutral." For example, the court recognized that most documents relevant to the case are located in

Colorado—but nonetheless concluded that the access-to-proof factor was neutral because those documents are stored electronically. Appx5-6. Similarly, the court rejected BBiTV's claim that relevant witnesses were located in the Western District of Texas—but nonetheless concluded that witnesses' presence in Colorado was "neutral" (or "slightly favors transfer at the best"), reasoning that keeping the case in Waco would not be inconvenient for those witnesses because the court could require them to testify by video deposition or remotely. Appx7-9.

In the district court's view, two factors weighed "strongly" and "heavily" in favor of keeping the case in the Western District of Texas: the existence of co-pending litigation and the court's ability to set a quick trial date. Appx9-11. Based solely on these factors, the district court denied transfer. Appx13.

REASONS FOR ISSUING THE WRIT

A petitioner seeking mandamus typically must (1) show a "clear and indisputable" right to the writ; (2) have "no other adequate method of attaining the desired relief"; and (3) demonstrate that "the writ is appropriate under the circumstances." *In re Apple Inc.*, 979 F.3d 1332, 1336-37 (Fed. Cir. 2020); *see also*, *e.g.*, *In re Volkswagen of Am., Inc.*,

545 F.3d 304, 311 (5th Cir. 2008) (en banc) ("*Volkswagen II*"). In the § 1404(a) context, "the test for mandamus essentially reduces to the first factor, given that 'the possibility of an appeal in the transferee forum following a final judgment ... is not an adequate alternative,' and that 'an erroneous transfer may result in judicially sanctioned irreparable procedural injury.'"[4] In reviewing a § 1404(a) transfer order, "this court applies the laws of the regional circuit in which the district court sits, in this case the Fifth Circuit." *TS Tech*, 551 F.3d at 1319.

The Fifth Circuit conducts the § 1404(a) transfer analysis with reference to well-established private- and public-interest factors. The private-interest factors include: "(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315. The

[4] *Apple*, 979 F.3d at 1336-37; *see also In re TS Tech USA Corp.*, 551 F.3d 1315, 1322 (Fed. Cir. 2008) ("[I]t is clear under Fifth Circuit law that a party seeking mandamus for a denial of transfer clearly meets the 'no other means' requirement.").

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." *Id.* (alteration in original). The public-interest factors "rarely defeat a transfer motion." *Atl. Marine Constr. Co. v. U.S. Dist. Ct.*, 571 U.S. 49, 64 (2013).

"[I]n a case featuring most witnesses and evidence closer to the transferee venue with few or no convenience factors favoring the venue chosen by the plaintiff, the trial court should grant a motion to transfer." *In re Nintendo Co.*, 589 F.3d 1194, 1198 (Fed. Cir. 2009) (granting mandamus and ordering transfer). That simple rule is determinative here.

I. The District Court Clearly Abused Its Discretion In Evaluating The Private-Interest Factors.

A. In evaluating the convenience of witnesses and the availability of compulsory process, the district court ignored binding precedent and improperly disregarded relevant witnesses.

Two of the private-interest factors concern witness testimony. The first, witness convenience, is "the single most important factor in transfer analysis." *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009) (quoting *Neil Bros. Ltd. V. World Wide Lines, Inc.*, 425 F. Supp. 2d 325, 329 (E.D.N.Y. 2006)); *see also In re Apple Inc.*, 818 F. App'x 1001, 1003 (Fed. Cir. 2020). This factor considers not only "monetary costs" imposed on witnesses who must travel for trial, "but also the personal costs associated with being away from work, family, and community." *Volkswagen II*, 545 F.3d at 317.

The second such factor, the availability of compulsory process, favors the venue that has subpoena power over a greater number of third-party witnesses. *Genentech*, 587 F.3d at 1345. This factor is concerned with ensuring the presence at trial of key witnesses who can be subpoenaed to testify in one venue but not in the other. *See id.*; *see also In re Acer Am. Corp.*, 626 F.3d 1252, 1255 (Fed. Cir. 2010) (this

factor is "important," as the subpoena powers of the transferee court "may be expected to be invaluable, in the event process is required to hale relevant witnesses into court").

Here, both factors clearly favor transfer. All the U.S.-based DISH employees who designed and developed the accused features live and work in Colorado. Appx197. Two former DISH employees who held the title of Director of Software Engineering and were involved in the design and development of the accused products also live in Colorado, as do two inventors of a prior-art system who have relevant testimony about the system's functionality and the timing of its development and use, which bears on a live priority date dispute. Appx199-201. And there are no witnesses in or near the Western District of Texas for whom a Waco trial would be convenient: BBiTV is a Hawaii-based non-practicing entity with no known Texas ties; the named inventor of the patents-in-suit lives in California and would have to travel a significant distance regardless of the trial venue; and the law firm whose attorneys prosecuted the asserted patents is based in New York. Appx198.

Despite this evidence overwhelmingly favoring transfer, the district court found the compulsory process factor to be only neutral,

and the convenience of witnesses to be neutral or, at best, to "slightly" favor transfer. The district court's treatment of both factors was contrary to binding precedent from this Court and from the Fifth Circuit.

First, citing no authority other than one of its own prior orders, the district court stated that the "convenience of party witnesses is given little weight." Appx9. This was the court's sole basis for disregarding the numerous DISH employees in Colorado who are likely witnesses because they designed and developed the accused products or operate the systems that BBiTV accuses of infringing.[5] But this

[5] The district court has repeatedly expressed this theory in the course of denying transfer. *E.g.*, Order Denying Defendant's Motion to Transfer at 14, *Koss Corp. v. Apple Inc.*, No. 20-CV-665 (W.D. Tex. Apr. 22, 2021), ECF No. 76; Order Denying Defendant's Motion to Transfer at 11, *Sito Mobile R&D IP v. Hulu, LLC*, No. 20-CV-472 (W.D. Tex. Mar. 24, 2021), ECF No. 66; Order Denying Motion to Transfer Venue at 9-10, *Ecofactor, Inc. v. Google LLC*, No. 20-CV-75 (W.D. Tex. Apr. 16, 2021), ECF No. 62; Order Denying Motion to Transfer Venue at 12, *Ikorongo Tex. LLC v. LG Elecs. Inc.*, No. 20-CV-257 (W.D. Tex. Mar. 1, 2021), ECF No. 76. Accordingly, it is the sort of issue where mandamus is appropriate to "provide needed guidance." *In re Google LLC*, No. 2018-152, 2018 WL 5536478, at *4 (Fed. Cir. Oct. 29, 2018); *see also Volkswagen II*, 545 F.3d at 319 (granting mandamus and noting that "the issues … have an importance beyond the immediate case" because "the district courts have developed their own," erroneous "tests"); *In re Boon Glob. Ltd.*, 923 F.3d 643, 649 (9th Cir. 2019) (mandamus appropriate to correct "oft-repeated error[s]").

assertion is contrary to numerous decisions recognizing the importance of convenience to party witnesses. *E.g.*, *Acer*, 626 F.3d at 1255 (a "substantial number of party witnesses, in addition to the inventor and prosecuting attorneys, reside in or close to the" transferee district; "[i]f all of these witnesses were required to travel to" the transferor district, "the parties would likely incur significant expenses for airfare, meals, and lodging, as well as losses in productivity from time spent away from work"); *Nintendo*, 589 F.3d at 1198-99; *Genentech*, 566 F.3d at 1343-45; *In re TracFone Wireless, Inc.*, No. 2021-136, 2021 WL 1546036, at *1-3 (Fed. Cir. Apr. 20, 2021).

Discounting the convenience of party witnesses is directly at odds with the "rationale" for this factor—namely, "to minimize the time when [fact witnesses] are removed from their regular work or home responsibilities." *TracFone*, 2021 WL 1546036, at *2 (internal quotation marks omitted) (discussing convenience for "likely employee witnesses").[6] These considerations apply equally to all witnesses,

[6]*See generally In re Volkswagen AG*, 371 F.3d 201, 205 (5th Cir. 2004) ("*Volkswagen I*") ("Additional distance means additional travel time; additional travel time increases the probability for meal and lodging expenses; and additional travel time with overnight stays increases the

including witnesses who have no choice but to testify because their employer is a party. The district court erred as a matter of law in giving "little weight" to this factor with respect to party witnesses.

Second, again citing no authority other than a single prior order in which it denied transfer, the district court asserted it would not count third-party witnesses under the compulsory-process prong unless DISH could *prove* that they are "unwilling." Appx6-7. That was legal error. A witness is "*presumed* to be unwilling" when "there is no indication that a non-party witness is willing." *In re HP Inc.*, No. 2018-149, 2018 WL 4692486, at *3 n.1 (Fed. Cir. Sept. 25, 2018) (emphasis added). Thus, this Court and the Fifth Circuit both have evaluated the availability of compulsory attendance without requiring any threshold proof of unwillingness. *See, e.g.*, *Acer*, 626 F.3d at 1255 (citing importance of compulsory process "*in the event* process is required to hale relevant witnesses into court" (emphasis added)); *Genentech*, 566 F.3d at 1345; *Volkswagen II*, 545 F.3d at 316-17. Nor, as a practical matter, is it clear that a party could prove in the early stages of a case

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time which these fact witnesses must be away from their regular employment.").

that a third-party witness would be unwilling to testify months or even years later at trial. An unwilling witness can hardly be expected to cooperate with the defense and submit an affidavit in support of a motion that, if successful, would render her subject to subpoena. And, of course, a previously willing witness may later change her mind.

Third, the district court discounted the relevance of non-party witnesses likely to testify about the prior art, asserting that (1) "even if testimony from any of the prior art witnesses is necessary to resolve the priority date dispute, a deposition will be sufficient" and (2) "while there is some benefit to providing live witnesses at trial, ... [w]ith remote witness testimony becoming a norm today, the Court is not convinced that remote deposition or testimony at trial by any of the prior art witnesses would seriously inconvenience DISH." Appx7-8. Even leaving aside (a) that such a rule easily could be used to disregard the relevance of *all* out-of-district prospective witnesses and (b) that this same court has emphasized the importance of in-person jury trials (Appx11), there is no authority for the district court to pick and choose which relevant witnesses do and don't deserve to testify in person and exclude some of them from the transfer analysis on this basis.

On the contrary, a district court should simply assess "the relevance and materiality of the information [a] witness may provide." *Genentech*, 566 F.3d at 1343-44. "Requiring a defendant to show that the potential witness has more than relevant and material information at this point in the litigation … is unnecessary." *Id.* Accordingly, the court should not "evaluate the significance of the identified witnesses' testimony" or set them aside on that basis. *Id.* After all, "[a] party to a lawsuit obviously is entitled to present his witnesses." *Charles v. Wade*, 665 F.2d 661, 664 (5th Cir. Unit B 1982); *see also, e.g.*, *Aguilar-Ayala v. Ruiz*, 973 F.2d 411, 419 (5th Cir. 1992) (explaining that live testimony is crucial because it allows the jury to "fully appreciate the strength or weakness of the witness' testimony, by closely observing the witness' demeanor, expressions, and intonations," whereas "[e]ven the advanced technology of our day cannot breathe life into a two-dimensional broadcast").[7]

[7] Even if it were appropriate for the district court to scrutinize and prioritize relevant witnesses in this fashion, the court erred in the way it performed that analysis. Witnesses knowledgeable about disputed aspects of prior-art systems (as opposed to printed prior-art publications) are particularly likely to have relevant trial testimony. *See CEATS, Inc. v. Cont'l Airlines, Inc.*, 526 F. App'x 966,

Finally, the district court clearly abused its discretion in refusing to consider at all the former DISH engineering directors whom DISH identified as likely witnesses. The court determined that those witnesses are irrelevant to the compulsory-process factor because of its flawed conclusion (*supra* at 17-18) that there was no evidence they are "unwilling." Appx6. But even if the witnesses were "willing," the court should have considered their convenience. The court, however, ignored them under that factor too. Appx8-9. These witnesses plainly are relevant to one factor or the other, but the district court disregarded them entirely.

In short, DISH established that the engineers who designed and developed the accused products (both current and former DISH employees) live and work in Colorado, as do witnesses with testimony relevant to a live priority-date dispute, and that Texas would not be a convenient venue for any likely witness. Witness convenience being the "single most important factor," *Genentech*, 566 F.3d at 1343 (quoting

968-69 (Fed. Cir. 2013). Here, DISH explained at length the specific testimony it expected those witnesses to offer regarding the timing of the system's development and use, which is directly relevant to the priority date dispute in this case. Appx200-201.

Neil Bros., 425 F. Supp. 2d at 329), this alone is just the sort of "patently erroneous result and clear[] abus[e of] discretion" that warrants mandamus relief, *Volkswagen II*, 545 F.3d at 309.

B. The district court disregarded binding precedent to find the access-to-proof factor "neutral."

"In patent infringement cases, the bulk of the relevant evidence usually comes from the accused infringer. Consequently, the place where the defendant's documents are kept weighs in favor of transfer to that location." *Genentech*, 566 F.3d at 1345. DISH explained in sworn declarations that most of its documents relevant to this case are stored in Colorado, where DISH is headquartered. *See supra* at 5-8; Appx197. Accordingly, this factor weighs strongly in favor of transferring this case to the District of Colorado. *Genentech*, 566 F.3d at 1345-46.

The district court, however, found that "this factor is neutral." Appx6. In reaching this conclusion, the court did not find, for instance, that relevant documents are housed in the Western District of Texas. Appx5-6. Instead, while paying lip service to "current Fifth Circuit precedent" that "the physical location of electronic documents does affect the outcome of this factor," the district court hewed to its own

view "that the focus on physical location of electronic documents is out of touch with modern patent litigation." Appx5.

Both the Fifth Circuit and this Court have repeatedly admonished courts, and granted mandamus petitions, for just this erroneous "antiquated era argument." *See*, *e.g.*, *Genentech*, 566 F.3d at 1346; *Volkswagen II*, 545 F.3d at 316; *TS Tech*, 551 F.3d at 1321. The Court should do likewise here. "Because most evidence resides in [Colorado] with none in Texas, the district court erred in not weighing this factor heavily in favor of transfer" to the District of Colorado. *Nintendo*, 589 F.3d at 1199-1200; *see also Volkswagen II*, 545 F.3d at 316; *TS Tech*, 551 F.3d at 1321; *Genentech*, 566 F.3d at 1346.

C. The district court clearly erred in concluding that co-pending litigation weighed "strongly" against transfer.

Co-pending litigation may play some role in the transfer analysis as one of the "other practical problems that make a trial easy, expeditious, and inexpensive." *In re Zimmer Holdings, Inc.*, 609 F.3d 1378, 1381 (Fed. Cir. 2010). But a district court clearly abuses its discretion when it denies transfer based on "'negligible' judicial efficiencies" notwithstanding that "the convenience factors strongly

weigh in favor of the transferee venue." *In re Vistaprint Ltd.*, 628 F.3d 1342, 1344 (Fed. Cir. 2010) (citing *Zimmer Holdings*, 609 F.3d at 1382). "To hold otherwise … would … effectively inoculat[e] a plaintiff against convenience transfer under § 1404(a) simply because it filed related suits against multiple defendants in the transferor district. This is not the law under the Fifth Circuit." *In re Google Inc.*, No. 2017-107, 2017 WL 977038, at *3 (Fed. Cir. Feb. 23, 2017).

As the district court noted, BBiTV has filed another lawsuit in the Western District of Texas related to three of the patents-in-suit. Appx10. Notwithstanding the substantial conveniences of litigating this case in the District of Colorado described above, the district court concluded that this co-pending litigation "strongly weigh[ed] against transfer." Appx10. This was a clear abuse of discretion.

In a series of cases, this Court has delineated how to assess the relevance of related litigation. On one hand, the existence of an overlapping patent cannot overcome "substantial conveniences" of litigating in the transferee forum. *Zimmer Holdings*, 609 F.3d at 1382; *see also Google*, 2017 WL 977038, at *2 (the defendant's "strong presence in the transferee district" outweighed co-pending litigation).

On the other hand, where the convenience factors are less substantial (for example, because no defendant is incorporated or headquartered in the transferee forum), the transferor court has "gained substantial experience in construing the patent claims during prior litigation," and there is co-pending litigation involving the same patents, mandamus relief may be unwarranted. *Vistaprint*, 628 F.3d at 1344.

Zimmer Holdings and *Google* dictate the result here. DISH is incorporated, headquartered, and otherwise has strong connections to the District of Colorado, while this suit has no connection to the Western District of Texas. *See supra* at 3-9. Unlike in *Vistaprint*, the district court has no prior experience construing the patents-in-suit. So the question comes down to the mere fact of overlapping patents in co-pending litigation. Under *Zimmer Holdings* and *Google*, this alone cannot defeat the substantial convenience factors detailed above. Here, as in *Zimmer Holdings*, "no defendant is involved in both actions," which means the co-pending litigation would "result in significantly different discovery, evidence, proceedings, and trial." 609 F.3d at 1382. That is all the more true here, because DISH and AT&T are

competitors, unlikely to acquiescence to joint discovery and trial. Appx205.

The district court suggested the co-pending litigation would lead to efficiency in claim construction. Appx9-10. Although efficiency is generally measured at the time the transfer motion is filed, the court delayed so long in resolving DISH's transfer motion that claim construction occurred almost five months *before* the district court issued its transfer order; when the court ruled, there were simply no efficiencies to be gained on this front. Appx499-503. At any rate, there was little effort to be saved; the court's five-page order accorded most terms their plain and ordinary meaning without providing much reasoning, Appx499-503, a fact the PTAB cited in concluding that the district court had not invested enough in the proceedings to weigh against granting *inter partes* review. *DISH Network L.L.C. v. Broadband iTV, Inc.*, No. IPR2020-01280, 2021 WL 406916, at *8 (P.T.A.B. Feb. 4, 2021). Any benefit of consolidated claim construction here is vanishingly small.

Accordingly, the district court clearly abused its discretion in concluding that co-pending litigation weighed "strongly" against

transfer. Appx10. The negligible efficiency gains of having one judge consider cases involving a few overlapping patents do not "negate[] the significance of having trial close to where most of the identified witnesses reside and where the other convenience factors clearly favor." *Zimmer Holdings*, 609 F.3d at 1382.

II. The District Court Clearly Abused Its Discretion In Evaluating The Public-Interest Factors.

A. The district court ignored binding precedent in finding the local interest factor neutral.

The first public-interest factor is "the local interest in having localized interests decided at home." *Volkswagen II*, 545 F.3d at 315. This requires "'significant connections between a particular venue and *the events that gave rise to a suit*.'" *Apple*, 979 F.3d at 1345 (quoting *Acer*, 626 F.3d at 1256) (collecting cases). Accordingly, this factor favors transfer from a district that lacks "any meaningful connection or relationship with the circumstances" of a case to one where the alleged wrongdoing occurred. *Volkswagen I*, 371 F.3d at 206. Where a suit "calls into question the work and reputation of several individuals residing in" a district, the interest of that district is "self-evident." *In re Hoffman-La Roche Inc.*, 587 F.3d 1333, 1336, 1338 (Fed. Cir. 2009).

This factor strongly favors transfer to the District of Colorado. Colorado is where the current and former DISH employees who designed the accused product acted and reside, Appx197-201; Appx203-204; Appx480, making the District of Colorado's interest in the dispute "self-evident," *Hoffman-La Roche*, 587 F.3d at 1336, 1338. Meanwhile, as discussed (at 3-9), there is no connection between the Western District of Texas and "the events that gave rise to [the] suit." *Apple*, 979 F.3d at 1345 (emphasis omitted). *See also* Appx204.

The district court nonetheless found this factor to be neutral. In so doing, it relied solely on its determination that DISH "employs over 1,000 employees and owns call centers, warehouses, a remanufacturing center, and a service center in this District." Appx12. That was legal error. This Court and the Fifth Circuit have both repeatedly explained that such generalized connections to a venue are improper considerations under § 1404(a). *See, e.g.*, *Apple*, 979 F.3d at 1344-45 (the district court "misapplied" this factor when it relied on Apple's "substantial presences in both NDCA and WDTX" to find that "both districts have a significant interest in this case); *see also TracFone*, 2021 WL 1546036, at *3 (finding error where the district court

concluded the local interest factor was neutral because "TracFone utilizes the allegedly infringing process throughout the nation").

As the Fifth Circuit has explained, the rationale adopted by the district court here "eviscerates the public interest that this factor attempts to capture" and "leaves no room for consideration of those actually affected—directly and indirectly—*by the controversies … giving rise to [this] case*." *Volkswagen II*, 545 F.3d at 318 (emphasis added). The district with a local interest in the events giving rise to this case is the District of Colorado, and the district court's reliance on DISH's generalized corporate presence in the Western District of Texas was a clear abuse of discretion.

B. The district court clearly erred in finding that court congestion weighed "heavily" against transfer.

"[T]he administrative difficulties flowing from court congestion" is a *public* factor—not a private factor—in the transfer analysis. *See Genentech*, 566 F.3d at 1342. As such, this factor is not designed to protect individual litigants' interests in the quickest possible trial date. Instead, it considers "whether there is an appreciable difference in docket congestion between the two forums." *In re Adobe Inc.*, 823 F. App'x 929, 932 (Fed. Cir. 2020) (citing *Parsons v. Chesapeake & Ohio*

Ry. Co., 375 U.S. 71, 73 (1963)). It is error for a court with a congested docket to distort the analysis under this factor by "set[ting] an aggressive trial date" and finding "that other forums that historically do not resolve cases at such an aggressive pace are more congested." *Apple*, 979 F.3d at 1344.

That is precisely what occurred here. Even before the recent surge in patent litigation in the Waco Division, the Western District of Texas was much busier than the District of Colorado, with judges handling over a hundred more cases on average. *See* Appx206; Appx212-214. The district court nonetheless concluded that its aggressive "default schedule" for patent cases "would lead to a trial date much sooner than the average time to trial in the District of Colorado." Appx11. As an initial matter, it was legal error for the district court to ignore general court congestion to focus on the specific trial date that it set here. *See Apple*, 979 F.3d at 1344. Nor could this accelerated trial date outweigh the "stark contrast in convenience between the two forums" detailed above. *Adobe*, 823 F. App'x at 932 (citing *Genentech*, 566 F.3d at 1348).

Moreover, there is substantial reason to question the "default schedule" on which the court relied. In recent years, the Waco Division of the Western District of Texas has seen an avalanche of new patent filings.[8] That court was assigned only 28 patent cases in 2018; the number ballooned to about 248 patent cases in 2019, and 793 cases in 2020 (including 220 by the time DISH filed its motion in May)—all of them being handled by a single judge.[9] Given that exponential increase in cases, it is implausible that the district court will be able to adhere to its default schedule in all patent cases. And ultimately, these developments support the notion that the Western District of Texas, particularly the Waco Division, is considerably more congested than the District of Colorado.

For many of these same reasons, the district court's analysis of court congestion has already been rejected twice by this Court, *Apple*, 979 F.3d at 1344; *Adobe*, 823 F. App'x at 932, and it should be rejected

[8] *See* J. Jonas Anderson & Paul R. Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 Duke L.J. (forthcoming) (manuscript at 27-28), https://papers.ssrn.com/abstract_id=3668514.

[9] Appx206, Appx216; Anderson, *supra* note 8, at 28, 31.

here, too.[10] Given the extraordinary congestion in the Western District of Texas, this factor weighs in favor of transfer; at a bare minimum it is neutral; and the district court clearly abused its discretion in concluding that this factor "weigh[ed] heavily *against* transfer." Appx11 (emphasis added).

CONCLUSION

This dispute has significant connections to the District of Colorado—including party and non-party witnesses who reside there, sources of proof located there, and local interests deeply bound up in the resolution of this case. On the other side of the ledger, DISH showed that there are no connections between this dispute and Texas. The

[10] Perhaps in view of those prior orders, the district court bolstered its analysis of congestion with reference to the COVID-19 pandemic. It observed that it had held trials in October 2020 and early 2021 and claimed there was "no evidence that the District of Colorado … is capable of safely holding in-person jury trials in the pandemic." Appx11. The court was mistaken. The same general order from the District of Colorado cited by the court makes clear that "trial[s] to a jury of fewer than 10 [jurors] … may proceed in accordance with social distancing and other appropriate measures to ensure the safety of all participants." District of Colorado, District Court General Order 2021-3 (Feb. 12, 2021), https://tinyurl.com/6ycfdra4. Indeed, on the day the district court issued its opinion, an in-person civil jury trial was in progress in the District of Colorado. *See Harris v. Falcon Sch. Dist. 49*, No. 18-CV-2310.

district court didn't even disagree: It didn't find that a single relevant witness or document is in Texas, much less the Waco Division of the Western District of Texas. Instead, it committed a variety of clear legal errors, downplaying factors that overwhelmingly favor transfer and amplifying factors going the other way that it should have discounted or ignored outright. This Court's intervention is urgently needed.

For the foregoing reasons, the Court should grant DISH's petition, vacate the district court's order, and remand with instructions to transfer this case to the District of Colorado.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system on May 28, 2021.

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CERTIFICATE OF COMPLIANCE

The petition complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this petition contains 6,243 words.

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