IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

CARBYNE BIOMETRICS, LLC, Plaintiff, v. APPLE INC., Defendant.	CIVIL ACTION NO. 1:23-CV-00324-ADA **JURY TRIAL DEMANDED** [redacted]

DEFENDANT APPLE INC.'S SEALED OPPOSED MOTION TO TRANSFER VENUE UNDER 28 U.S.C. § 1404(a)

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. FACTUAL BACKGROUND 2

A. This Lawsuit and The Asserted Patents 2

B. The Vast Majority of Apple's Witnesses and Documents Are in N.D. Cal. 2

C. Carbyne Has No Connection to W.D. Tex. 5

D. Relevant Nonparty Witnesses Are Primarily in California 5

III. APPLICABLE LAW 7

IV. THIS ACTION COULD HAVE BEEN BROUGHT IN N.D. CAL. 8

V. N.D. CAL. IS CLEARLY THE MORE CONVENIENT VENUE 8

A. The Private Interest Factors Weigh Decisively in Favor of Transfer 8

1. Relative ease of access to sources of proof strongly favor transfer 8

2. Cost of attendance for willing witnesses favors transfer 10

3. Compulsory process over third-party witnesses favors transfer 13

4. Any remaining "practical problems" are neutral 14

B. Public Interest Factors Weigh in Favor of Transfer 14

1. The court congestion factor is neutral 14

2. The local interest factor favors transfer 14

3. Familiarity with governing law and conflicts factors are neutral 15

VI. CONCLUSION 15

TABLE OF AUTHORITIES

Page(s)

Cases

AlmondNet, Inc. v. Samsung Elecs. Co.,
No. W-21-CV-00891-ADA, 2022 WL 17574082 (W.D. Tex. Nov. 28, 2022).....8, 9

In re Apple Inc.,
2021 WL 5291804 (W.D. Tex. Nov. 15, 2021).....9, 10, 11, 15

In re Apple Inc.,
818 F. App'x 1001 (Fed. Cir. 2020).....7, 17

In re Apple Inc.,
979 F.3d 1332 (Fed. Cir. 2020).....1, 10, 14

In re Apple, Inc.,
581 F. App'x 886, 889 (Fed. Cir. 2014).....13

In re Cray Inc.,
871 F.3d 1355 (Fed. Cir. 2017).....8

Cub Club Inv., LLC v. Apple, Inc.,
No. 6:20-cv-00856-ADA, ECF No. 28 (W.D. Tex. Sept. 7, 2021).....10

DataQuill, Ltd. v. Apple Inc.,
No. A-13-CA-706, 2014 WL 2722201 (W.D. Tex. June 13, 2014).....8, 9

In re DISH Network, LLC,
No. 2021-182, 2021 WL 4911981 (Fed. Cir. Oct. 21, 2021).....14, 15

Freshub, Inc. v. Amazon.com Inc.,
No. 19-cv-388-ADA, 2019 WL 10856832 (W.D. Tex. Sept. 9, 2019).....12

In re Genentech, Inc.,
566 F.3d 1338 (Fed. Cir. 2009).....13

In re Google LLC,
No. 2021-178, 2021 WL 5292267 (Fed. Cir. Nov. 15, 2021).....8, 9

In re HP Inc.,
826 F. App'x 899 (Fed. Cir. 2020).....7

In re Hulu, LLC,
No. 2021-142, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021).....13

In re Juniper Networks, Inc.,
14 F.4th 1313 (Fed. Cir. 2021) 10, 11, 12, 15

In re Juniper Networks, Inc.,
No. 2021-156, 2021 WL 4519889 (Fed. Cir. Oct. 4, 2021).....2, 7

LoganTree LP v. Apple Inc.,
No. 6:21-cv-00397-ADA, 2022 WL 1491097 (W.D. Tex. May 11, 2022).....7, 11, 14

In re Microsoft Corp.,
No. 2023-128, 2023 WL 3861078 (Fed. Cir. June 7, 2023).....8, 12

In re Samsung Elecs. Co.,
2 F.4th 1371 (Fed. Cir. 2021) 9, 12, 15

In re TracFone Wireless, Inc.,
848 F. App'x 899 (Fed. Cir. 2021) 14

In re TS Tech. USA Corp.,
551 F.3d 1315 (Fed. Cir. 2008).....15

VLSI Tech. LLC v. Intel Corp.,
No. 6:19-cv-00254-ADA, 2019 WL 8013949 (W.D. Tex. Oct. 7, 2019).....10

In re Volkswagen AG,
371 F.3d 201 (5th Cir. 2004) 7, 11

In re Volkswagen of Am., Inc.,
545 F.3d 304 (5th Cir. 2008) 7, 8

XY, LLC v. Trans Ova Genetics, LC,
No. W-16-CA-447, 2017 WL 5505340 (W.D. Tex. Apr. 5, 2017) 8

Zentian Ltd. v. Apple, Inc.,
No. W-22-CV-00122-ADA, 2023 WL 4167746 (W.D. Tex. June 13, 2023) 14

Statutes

28 U.S.C. § 1400(b) 8

28 U.S.C. § 1404(a) 1, 2, 7, 11

Other Authorities

Fed. R. Civ. P. 45(c) 13

TABLE OF ABBREVIATIONS

Abbreviation	Definition
Apple	Defendant Apple Inc.
Carbyne	Plaintiff Carbyne Biometrics, LLC
Compl.	Plaintiff's Complaint for Patent Infringement (ECF No. 1)
W.D. Tex.	United States District Court for the Western District of Texas
N.D. Cal.	United States District Court for the Northern District of California
'512	U.S. Patent No. 10,929,512
'105	U.S. Patent No. 11,475,105
'138	U.S. Patent No. 11,514,138
'010	U.S. Patent No. 9,972,010
'656	U.S. Patent No. 10,713,656
'886	U.S. Patent No. 11,526,886
Asserted Patents	The '512, '105, '138, '010, '656, and '886 patents
Authentication Patents	The '512, '105, and '138 patents
Fraud Reduction Patents	The '010, '656, and '886 patents
Accused Technologies	Face ID; Touch ID; iCloud Keychain; device-side Apple Cash; and the Secure Enclave, including communication therefrom
Keychain	iCloud Keychain
PICs	Carbyne's Preliminary Infringement Contentions
Roth Decl.	Declaration of Cassandra Roth and exhibits thereto
Benson Decl.	Declaration of Wade Benson
Currie Decl.	Declaration of Matthew Currie
Goldberg Decl.	Declaration of Robin Goldberg
Harlow Decl.	Declaration of Jaqueline Harlow
Heard Decl.	Declaration of Richard Heard
Paaske Decl.	Declaration of Tim Paaske
Spevak Decl.	Declaration of Catherine Spevak
Šubert Decl.	Declaration of Martin Šubert
Veron Decl.	Declaration of Maxime Veron
Wells Decl.	Declaration of Nicole Wells

I. INTRODUCTION

The connections between this suit and the Northern District of California ("N.D. Cal.") are overwhelming, particularly as compared to its meager connections to the Western District of Texas ("W.D. Tex."). Defendant Apple Inc. ("Apple") thus seeks transfer to N.D. Cal. under 28 U.S.C. § 1404(a) for the "convenience of parties and witnesses, in the interest of justice."

Other than this litigation, Plaintiff Carbyne Biometrics LLC ("Carbyne") appears to have no connection to Texas. Carbyne is a Delaware non-practicing entity with a principal place of business in New York and is not registered to do business in Texas. Carbyne has not identified any witnesses, custodians, or records of its own (or the original patentee) in Texas. All of the connections Carbyne has identified between this suit and W.D. Tex. are legally irrelevant, including irrelevant employees (*e.g.*, Apple employees who do not work with any accused technology), speculation about hiring plans (*e.g.*, including one position filled in Cupertino, CA), and irrelevant facilities (*e.g.*, Apple retail stores selling the accused products). These general contacts that are untethered to the lawsuit and common across districts are of no moment—the § 1404 inquiry concerns only "significant connections between a particular venue and *the events that gave rise to a suit*." *In re Apple Inc.*, 979 F.3d 1332, 1345 (Fed. Cir. 2020) ("*Apple III*").

Here, the relevant witnesses, custodians, and records are primarily in Apple's N.D. Cal. headquarters, where the vast majority of the accused features were researched, designed, and developed. Specifically, Carbyne's allegations implicate five distinct technologies in Apple's products: (1) Face ID; (2) Touch ID; (3) iCloud Keychain; (4) device-side Apple Cash; and (5) the Secure Enclave, including communication therefrom (the "Accused Technologies").[1] Apple

[1] Although Carbyne also accuses Password autofill, Find My remote wiping and the Mac migration tool, it accuses portions that relate to iCloud keychain security, which are within the wheelhouse

employees in N.D. Cal. developed these Accused Technologies. Dozens of relevant third parties, including PayPal, TabletKiosk, and Think Computer Corp., are also in California, while few are in Texas.

Apple respectfully requests transfer under 28 U.S.C. § 1404(a) because "the center of gravity of this action is clearly in" N.D. Cal.—not W.D. Tex. *In re Juniper Networks, Inc.*, No. 2021-156, 2021 WL 4519889, at *3 (Fed. Cir. Oct. 4, 2021) ("*Juniper I*").

II. FACTUAL BACKGROUND

A. This Lawsuit and The Asserted Patents

Carbyne accuses a combination of Face ID, Touch ID, iCloud Keychain ("Keychain"), and Secure Enclave features of infringing the Authentication Patents and accuses a combination of Face ID, Apple Cash, and the Secure Enclave features of infringing the Fraud Reduction Patents. Compl. ¶¶ 74-75, Exs. G-O (claim charts). Its allegations are limited to Apple products that purportedly use the accused software features: for the Authentication Patents, A-Series iOS/iPadOS devices with Touch ID or Face ID and M-Series Macs using Touch ID; and for the Fraud Reduction Patents, iOS or iPadOS devices with Face ID. *Id*. There is no dispute that the claims do not involve any novel hardware and are instead addressed to software alone or software running on a particular arrangement of conventional hardware components.

B. The Vast Majority of Apple's Witnesses and Documents Are in N.D. Cal.

Apple is a California corporation headquartered in Cupertino, CA since 1976. Ex. 1 at 1-2; Ex. 2 at 1. Apple employs more than 35,000 people who work in or near its headquarters. Ex. 3 at 2. The marketing, licensing, and finance operations for the accused products occur in N.D. Cal., and nearly all of Apple's likely trial witnesses on these subjects are in N.D. Cal:

---

of Mr. Benson and his team. *See infra* § II.B. Carbyne's Preliminary Infringement Contentions ("PICs") do not accuse Apple Pay or Apple Wallet. Compl. ¶ 68 (accusing both).

Catherine Spevak (Finance Manager) is knowledgeable about Apple's financial records. Spevak Decl. ¶¶ 1, 4. Ms. Spevak and her team work and reside in N.D. Cal. *Id*.

Maxime Veron (Senior Director, Product Marketing) is knowledgeable about Apple's marketing practices. Veron Decl. ¶ 4. He and his team work and reside in N.D. Cal. *Id*. ¶¶ 1, 5-6.

Jaqueline Harlow (Principal Counsel and Senior Manager) and her team are responsible for patent licensing. Harlow Decl. ¶¶ 5-6. She works and resides in Colorado, and her team (except for one other individual in Colorado) works and resides in N.D. Cal. *Id*. ¶ 6.

Moreover, all but one of Apple's likely technical witnesses are located in N.D. Cal.:

Wade Benson (Software Development Engineer, Security) and his Data Protection Team are responsible for the software components of the accused products' security architecture, including that of the Secure Enclave and the Keychain. Benson Decl. ¶¶ 1, 3. Four of the five members of Mr. Benson's team (including Mr. Benson) are in Cupertino, and the fifth is in Maryland. *Id*. ¶¶ 1, 4. None of his team has ever been based in Texas. *Id*. ¶ 4. Carbyne contends that Secure Enclave is involved in infringement of every Asserted Patent and that Keychain is involved in infringement of every Authentication Patent. Ex. 4 ('512) at 1-4 (Secure Enclave), 36-43 (Keychain); Ex. 5 ('105) at 1-4 (Secure Enclave), 21-33 (Keychain); Ex. 6 ('138) at 1-4 (Secure Enclave), 16-25 (Keychain); Ex. 7 ('010) at 1-3; Ex. 8 ('656) at 1-3; Ex. 9 ('886) at 1-5.

Nicole Wells (Machine Learning Manager, Video Computer Vision) and her team develop on-device computer vision and machine perception technologies, including Face ID software. Wells Decl. ¶¶ 1, 3. Her team is located in Cupertino (12 members, including Ms. Wells) and Seattle, WA (four members); none of her team is located in Texas. *Id*. Her team does not interact with any Apple teams or third parties in Texas. *Id*. Carbyne contends Face ID is involved in infringement of every Asserted Patent. Ex. 4 at 10-14; Ex. 5 at 15-19; Ex. 6 at 16-25; Ex. 7 at 3-4;

Ex. 8 at 3-5; Ex. 9 at 13-15.

Richard Heard (Software Development Engineer, Applications Manager, Wallet Apps & Frameworks) manages the device-side engineering team responsible for designing and developing Apple Cash and Apple Pay software on iPhones, iPads, and Macs. Heard Decl. ¶¶ 1, 3. All members of Mr. Heard's team who work on Apple Cash or its intersection with the Messages application are in Cupertino (six members, including Mr. Heard), New York (three members), or Oregon (one member). *Id*. ¶ 4. None of his team members has ever been based in Texas, nor does he or his team interact with other Apple teams or third parties in Texas. *Id*. ¶¶ 4, 6. Carbyne accuses Apple Cash (including its integration with Messages and Apple Pay) in connection with the Fraud Reduction Patents. Ex. 7 at 13; Ex. 8 at 14-18; Ex. 9 at 15-16.

Martin Šubert (Software Development Engineer) and his team develop and validate algorithms for Apple's Touch ID. Šubert Decl. ¶¶ 1, 3. Mr. Šubert and his entire nine-person team are located in Prague, Czech Republic, and have never been based in Texas. *Id*. His team does not interact with anyone in Texas. *Id*. ¶ 3. Carbyne accuses Touch ID in connection with the Authentication Patents. Ex. 4 at 10-14; Ex. 5 at 8-15; Ex. 6 at 16-25.

None of Apple's likely trial witnesses is in Texas. And as shown by the foregoing teams' locations, the Accused Technologies have no Texas connection. Wells Decl. ¶ 1, 3; Šubert Decl. ¶ 1, 3; Benson Decl. ¶¶ 1, 4; Heard Decl. ¶ 4.

Although some Secure Enclave and Apple Cash engineers work in Austin, their work is not relevant to the accused functionality. The Secure Enclave engineers work on the Secure Enclave *hardware*, not on the software implementation that is the target of Carbyne's allegations. Compl. ¶¶ 74-75; Paaske Decl. ¶¶ 6-9, 11 (identified engineers do not work on software). The claims do not involve novel hardware and are instead directed to software alone or software

running on a particular arrangement of generic hardware. *E.g.*, Pltf Opp. to Mot. to Dismiss at 10; *e.g.*, '512, cl. 21 ("a computer program product embodied in a non-transitory computer readable storage medium and comprising computer instructions"); '010, cl. 17 (same); '656, cl. 19 (same); '886, cl. 11 (same); '105, cl. 35 (similar). Even if hardware was relevant, the person most knowledgeable (Mr. Paaske) is in Cupertino. Paaske Decl. ¶¶ 1, 3-9, 11. The Austin Apple Cash employees (whose roles focus on server-side or post-transaction events) are likewise irrelevant because the accused features (which are client-side) were designed and developed by a team in Cupertino. Heard Decl. ¶¶ 3-4, 7.

None of Apple's likely trial witnesses nor their teams store documents in Texas. Benson Decl. ¶ 5; Wells Decl. ¶ 4; Heard Decl. ¶ 5; Šubert Decl. ¶ 4; Spevak Decl. ¶ 4; Veron Decl. ¶ 7; Harlow Decl. ¶ 8. Apple has no relevant data centers or servers in Texas. Goldberg Decl. ¶¶ 7-19. Certain electronic records, such as the financial and marketing records, are accessible only by authorized employees based out of N.D. Cal. Spevak Decl. ¶ 4; Veron Decl. ¶ 7.

C. Carbyne Has No Connection to W.D. Tex.

Carbyne is incorporated in Delaware, operates in New York, does not allege any connection to or interest in Texas, and is not registered to do business in Texas. Compl. ¶ 5; Ex. 10. Carbyne was not involved in the Asserted Patents' development. And Carbyne has not identified any relevant witnesses, documents, or evidence in Texas, let alone in W.D. Tex.

D. Relevant Nonparty Witnesses Are Primarily in California.

Based on Apple's investigation to date, multiple relevant nonparty witnesses are in California and subject to compulsory process in N.D. Cal., but not W.D. Tex.

PayPal, headquartered in San Jose, CA. Ex. 11 at 1, 3. Because Dr. Jakobsson filed the Asserted Patents (or their parents) while employed by PayPal, Apple intends to seek discovery

from PayPal to determine whether PayPal owns the Asserted Patents.[2] PayPal's former witness on this subject was in San Jose, so PayPal's likely witness is in N.D. Cal. Ex. 23 at 2.

Other key third parties. Other early developers of authentication translation and fraud reduction technologies are in California, and Apple expects that they will have invalidating system prior art. For example, Think Computer Corp., owner of FaceCash, is headquartered in Palo Alto, CA (which is in N.D. Cal.), and TabletKiosk, owner of Sahara Slate PC devices, is headquartered in Torrance, CA. *See, e.g.*, Ex. 14 (FaceCash); Ex. 15 (Think Computer Corp.); Ex. 16 (Sahara); Ex. 17 at 1 (TabletKiosk).

Apple has identified 178 patents and patent applications as potentially invalidating prior art, of which approximately 83 inventors and 26 assignees are in California (not including Apple or its acquisitions), including US Pat. Nos. 9,558,485, and Pat. Pub. No. 2010/0042535A1, while only 10 inventors and two assignees are in Texas. *E.g.*, Exs. 18-19. Apple's art search is ongoing.

Carbyne's PICs do not accuse any nonparties of involvement in infringement. Tellingly, they do not mention 1Password or Finisar (entities named in the Complaint).

Prior Patent Owners. At issuance, the Asserted Patents were assigned to RightQuestion, LLC ("RightQuestion"), and to the extent PayPal does not have records of the development of the Asserted Patents, RightQuestion may have records. RightQuestion and other previous owners of the Asserted Patents (Carbyne LLC and Extricatus LLC) may have records of positions prior

[2] The sole inventor of all six Asserted Patents, Dr. Jakobsson, was employed by PayPal from May 2011 to September 2013. Ex. 12 at 3. For the Authentication Patents, Carbyne does not claim a conception/reduction to practice date earlier than the provisional application filed on January 17, 2012, when Dr. Jakobsson was employed by PayPal. Ex. 12 at 3; Ex. 13 at 8-9. For the Fraud Reduction Patents, the provisional application may not enable the patents, and therefore the alleged inventions' conception/reduction to practice may have occurred during Dr. Jakobsson's employment with PayPal. For example, U.S. Patent No. 8,458,041, the first non-provisional patent in the Fraud Reduction family, was filed on May 3, 2011. '101 at Cover.

owners took about the Asserted Patents in litigation or licensing. All but one of these prior assignees has a principal office in N.D. Cal. Exs. 20, 21. None has any known tie to Texas.

III. APPLICABLE LAW

A defendant is entitled to transfer under 28 U.S.C. § 1404(a) if it shows (1) that the suit "might have been brought" in the transferee district and (2) the "transferee venue is clearly more convenient" than the district in which suit was filed. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 312-15 (5th Cir. 2008) (en banc) ("*Volkswagen II*"). In determining relative "convenience," courts weigh the "private" and "public" interest factors. *Id*. at 315. The weighing of the factors "reflects the appropriate deference to which the plaintiff's choice of venue is entitled." *Id*. The private factors are: "(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." *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) (citation omitted) ("*Volkswagen I*"). The public factors are: "(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*. Of these factors, the "convenience of the witnesses is probably the single most important." *In re Apple Inc*., 818 F. App'x 1001, 1003 (Fed. Cir. 2020) (citation omitted) ("*Apple I*"). On balance, courts should look to where the action's "center of gravity" is. *Juniper I*, 2022 WL 1491097, at *3. The transferee venue is clearly more convenient when, as here, it is the defendant's home and the plaintiff has no ties to the transferor forum. *See In re HP Inc.*, 826 F. App'x 899, 904 (Fed. Cir. 2020).

IV. THIS ACTION COULD HAVE BEEN BROUGHT IN N.D. CAL.

Because Apple is a California corporation headquartered in N.D. Cal., this suit could have been brought in that district. *See Volkswagen II*, 545 F.3d at 312-13; *see also* 28 U.S.C. § 1400(b); *In re Cray Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017); Ex. 2 at 1-2.

V. N.D. CAL. IS CLEARLY THE MORE CONVENIENT VENUE

This action's "center of gravity" is N.D. Cal., where the vast majority of potential witnesses with relevant information reside and where accused product features were developed. *In re Microsoft Corp.*, No. 2023-128, 2023 WL 3861078, at *2 (Fed. Cir. June 7, 2023).

A. The Private Interest Factors Weigh Decisively in Favor of Transfer

1. Relative ease of access to sources of proof strongly favor transfer

Relevant sources of proof are overwhelmingly in N.D. Cal., while minimal, if any, evidence is in W.D. Tex. "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." *Apple III*, 979 F.3d at 1339-40 (citation omitted); s*ee DataQuill, Ltd. v. Apple Inc.*, No. A-13-CA-706, 2014 WL 2722201, at *3 (W.D. Tex. June 13, 2014) (the "location of the [accused infringer's] documents tends to be the more convenient venue") (citation omitted). Courts "look to the location where the allegedly infringing products were researched, designed, developed and tested." *XY, LLC v. Trans Ova Genetics, LC*, No. W-16-CA-447, 2017 WL 5505340, at *13 (W.D. Tex. Apr. 5, 2017) (citation omitted).

Here, Apple's sources of proof are overwhelmingly in and around Apple's N.D. Cal. headquarters, where Apple creates and maintains most of its relevant documents and where most of its document custodians reside. *In re Google LLC*, No. 2021-178, 2021 WL 5292267, at *2 (Fed. Cir. Nov. 15, 2021) ("[L]ocation of document custodians and . . . [document] creat[ion] and maint[enence] . . . may bear on the ease of retrieval."); *AlmondNet, Inc. v. Samsung Elecs. Co.*,

No. W-21-CV-00891-ADA, 2022 WL 17574082, at *5–7 (W.D. Tex. Nov. 28, 2022). Specifically, Face ID, Touch ID, Keychain, and the accused Apple Cash features were designed and developed in Cupertino, CA and Prague, Czech Republic, and nearly all the custodians with access to those documents are still in N.D. Cal. and Prague. Wells Decl. ¶¶ 3-4; Šubert Decl. ¶¶ 1, 3-4; Benson Decl. ¶¶ 1, 3-5; Heard Decl. ¶¶ 3-5. Likewise, the design and development of the *software* aspects of the Secure Enclave have always occurred in California. Benson Decl. ¶¶ 1, 3-4. *See* Paaske Decl. ¶¶ 3-11. Apple's marketing, licensing, and finance decisions related to the Accused Technologies all occur in N.D. Cal., and Apple's business records relating thereto are primarily in N.D. Cal. Veron Decl. ¶ 4-7; Harlow Decl. ¶ 5-8; Spevak Decl. ¶ 1, 4. That this wealth of evidence exists in N.D. Cal. is "unsurprising"—that is where the Accused Technologies were "researched, designed, and developed." *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1379-80 (Fed. Cir. 2021) ("*Samsung*"); *see DataQuill*, 2014 WL 2722201, at *3 (because Apple designed the accused products at its headquarters, relevant documents "are likely to be found" there).

Apple has greater ease of access to documents in N.D. Cal. because its N.D. Cal. employees have the "need-to-know basis" credentials required to access relevant documents. Benson Decl. ¶ 5; Wells Decl. ¶ 4; Heard Decl. ¶ 5; Spevak Decl. at ¶ 4; Harlow Decl. ¶ 8; Veron Decl. ¶ 7; *see In re Apple Inc.*, No 2021-181, 2021 WL 5291804, at *2 (Fed. Cir. Nov. 25, 2021) ("*Apple II*") (finding factor favors transfer where "essentially all of [a party's] source code and document[s]" were in the transferee district, regardless of whether the party could theoretically give remote access to otherwise-irrelevant employees in the transferor district). Apple's Austin-based employees do not have such credentials. Benson Decl. ¶ 5; Wells Decl. ¶ 4; Harlow Decl. ¶ 8; Veron Decl. ¶ 7; Šubert Decl. ¶ 4.

By contrast, Carbyne is a Delaware non-practicing entity that likely has few sources of

proof anywhere—let alone any in W.D. Tex. Carbyne does not appear to conduct any significant business activities and therefore is not likely to have many documents, much less any in Texas. None of the Complaint's allegations are tethered to W.D. Tex.

As for third parties, the potential sources of proof in the possession of PayPal, Think Computer Corp., Extricatus, RightQuestion, and numerous inventors and authors of potentially invalidating prior art, are likely in N.D. Cal., weighing in favor of transfer. *See supra* § II.D; *VLSI Tech. LLC v. Intel Corp.*, No. 6:19-cv-00254-ADA, 2019 WL 8013949, at *3-4 (W.D. Tex. Oct. 7, 2019) (noting that third-party sources of proof are relevant).

Accordingly, the "wealth of important information" in N.D. Cal. "turns this factor in favor of transfer." *Apple III*, 979 F.3d at 1340 (holding it was error not to "meaningfully consider" Apple's "significant amount of relevant information in NDCA, including" source code and records relating to research and design, marketing, sales, and financial information"); *see also Cub Club Inv., LLC v. Apple, Inc.*, No. 6:20-cv-00856-ADA, slip op., at 6 (W.D. Tex. Sept. 7, 2021), ECF No. 28 ("Given (1) that Apple resides in [N.D. Cal.] and (2) that the accused features were apparently developed [there] … this factor weighs in favor of transfer to NDCA.").

2. Cost of attendance for willing witnesses favors transfer

The convenience and cost of witness attendance is the most important factor, and this consideration is no less important for party witnesses. *See In re Juniper Networks, Inc.*, 14 F.4th 1313, 1319-20 (Fed. Cir. 2021) ("*Juniper II*") ("[T]he convenience-to-the-witness factor is [not] attenuated when the witnesses are employees of the party calling them.") (citing *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194, at *5 (Fed. Cir. Aug. 2, 2021)). This factor weighs strongly in favor of transfer when, as here, "there are several witnesses located in the transferee forum and none in the transferor forum." *See Apple II*, 2021 WL 5291804, at *3.

All but two of Apple's likely trial witnesses are in N.D. Cal. and would be required to travel 1,500 miles to testify in W.D. Tex. *See supra* § II.B. None is in W.D. Tex. *Id*. In contrast, Carbyne has not identified a single trial witness of its own in Texas. *See supra* § II.C. Apple's N.D. Cal.-based engineering teams will be key to Apple's presentation and defenses, including for non-infringement and damages issues, such as apportionment. *See supra* § II.B. Testimony from Apple's N.D. Cal.-based marketing and financial teams will be imperative to, for example, refute allegations of indirect infringement and damages. *Id*.

The inconvenience of a trial in W.D. Tex. is not diminished because these individuals are Apple employees. If transfer were denied, they would experience substantial expense and disruption in their professional and personal lives, resulting in the very inconveniences § 1404(a) was designed to remedy. *See Apple II*, 2021 WL 5291804, at *3; *Volkswagen I*, 371 F.3d at 204-05; *Juniper II*, 14 F.4th at 1319-20 (district court erred in attaching "little weight to the evidence regarding the party witnesses"). Despite Carbyne's allegations to the contrary, Compl. ¶ 12, Apple is not currently building a hotel in W.D. Tex. and has no internal approved plans to do so. Currie Decl. ¶ 4. Moreover, an Apple hotel in W.D. Tex. would not reduce the inconvenience to Apple's witnesses; travel from work and home would still be required. In contrast, if this case were tried in N.D. Cal., those employees would be required to drive only a short distance.

None of Apple's likely trial witnesses is in W.D. Tex. *See supra* § II.B. Carbyne's reliance on LinkedIn profiles alone is legally insufficient. *See LoganTree LP v. Apple Inc.*, No. 21-cv-00397-ADA, 2022 WL 1491097, at *7 (W.D. Tex. May 11, 2022) (convenience of witnesses "based only on vague LinkedIn profiles" was "owed no weight"). Even if this Court credits the LinkedIn profiles (it should not), they fail to establish any nexus between this suit and Texas, and Apple does not intend to call any of the referenced employees as a trial witness. None created or

maintain the Accused Technologies. *See supra* § II.B. Most are engaged in work wholly irrelevant to the accused functionality. Compl. ¶ 20 n.14-15 (hardware system-on-chip engineers, but hardware details not relevant), n.16 (cloud security engineering manager with no connection to Keychain), ¶ 22, n.18 (Apple Pay engineer, but Apple Pay is not accused), n.19 (Apple Cash specialists/analysts involved in neither the accused functionality nor software development). Although some Secure Enclave engineers are in Austin, they neither created nor maintain the specific accused software, whereas the N.D. Cal. engineers can speak to both the software and the accused hardware arrangement. Compl. ¶¶ 18-19 (identifying four Secure Enclave engineers); Paaske Decl. ¶¶ 6-9, 11 (same four engineers hardware-focused). The small number of marginally relevant Secure Enclave engineers in Austin does not counterbalance, let alone outweigh, the significant number of relevant engineers (for Secure Enclave and the other features) in N.D. Cal. Carbyne's cited job postings are likewise irrelevant. Compl. ¶ 21 (concerning hardware, one of whom was hired in N.D. Ca., Paaske Decl. ¶ 10), Compl. ¶ 22 (Apple Pay).

The convenience of these likely N.D. Cal. witnesses weighs strongly in favor of transfer and must be considered. *See Juniper II*, 14 F. 4th at 1319-20 (courts may not discount a witness's convenience based on a "categorical assumption" regarding his or her likelihood of testifying). This is particularly true where, as here, there is a "substantial imbalance" in witness convenience. *See In re Microsoft Corp.*, 2023 WL 3861078, at *1-2 (finding abuse of discretion where the district court found convenience factor neutral even though 27 potential witnesses were in W.D. Wash. and three were in Texas); *Samsung*, 2 F.4th at 1379; s*ee also Freshub, Inc. v. Amazon.com Inc*., No. 19-cv-388-ADA, 2019 WL 10856832, at *1 (W.D. Tex. Sept. 9, 2019) ("Of greatest import" is that no anticipated witnesses reside in Waco.).

3. Compulsory process over third-party witnesses favors transfer

The compulsory process factor strongly favors transfer because N.D. Cal. has subpoena power over PayPal, Think Computer Corp., and TableKiosk, over 100 prior art inventors, authors, and assignees, and RightQuestion and Extricatus, whereas few relevant nonparty witnesses are subject to compulsory process in W.D. Tex. *See* Fed. R. Civ. P. 45(c). Where, like here, a substantial number of non-willing third-party witnesses reside in the transferee forum, and few are in the transferor forum, this factor strongly supports transfer. *See In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009).

The third parties named in Carbyne's complaint, 1Password and Finisar, are irrelevant. First, Carbyne cursorily alleges that Apple induces infringement by 1Password. But 1Password is a Canadian company headquartered in Canada. Ex. 22 at 1-2, 4. Confirming 1Password's irrelevance, Carbyne did not mention 1Password in its PICs. Moreover, the presence of one alleged third-party infringer does not tip the scales in favor of Texas when there are third parties outside of Texas that Carbyne also alleges are induced by Apple to infringe. Compl. ¶¶ 80, 86, 92, 98, 104, 110. Second, Finisar is a red herring. Finisar produces the vertical cavity surface-emitting lasers ("VCSELs") used in Face ID, but the claims do not concern or accuse the VCSELs. Finisar has no relevance to this case, and no Finisar witnesses will be necessary at trial.

This factor strongly favors transfer because "more third-party witnesses reside within the transferee venue than reside in the transferor venue." *In re Apple, Inc.*, 581 F. App'x 886, 889 (Fed. Cir. 2014) ("*Apple IV*"). This factor is near dispositive when, as here, the identified and relevant potential "third-party witnesses … [are] overwhelmingly located within the subpoena power of only the transferee venue." *In re Hulu*, 2021 WL 3278194, at *4.

4. Any remaining "practical problems" are neutral

The "practical problems" catch-all factor is neutral because no relevant "problems" of judicial economy exist. The little progress in this case since Carbyne filed its complaint is irrelevant to this analysis. *See In re TracFone Wireless, Inc.*, 848 F. App'x 899, 901 (Fed. Cir. 2021) ("[P]rogress of the case since the filing of the complaint is irrelevant when considering the transfer motion and should not color [a district court's] decision.") (citation omitted).

B. Public Interest Factors Weigh in Favor of Transfer

1. The court congestion factor is neutral

This factor is neutral because "[W.D. Tex.] and [N.D. Cal.] show no significant differences in caseload or time-to-trial." *LoganTree LP*, 2022 WL 1491097, at *8 (quoting *Juniper II*, 14 F.4th at 1322). Additionally, the Federal Circuit has recently ruled that, where a patentee is a non-practicing entity, like Carbyne, this factor should not have any weight. *Zentian Ltd. v. Apple, Inc.*, No. W-22-CV-00122-ADA, 2023 WL 4167746, at *10 (W.D. Tex. June 13, 2023) (citing *In re Google LLC*, 58 F.4th 1379, 1383 (Fed. Cir. 2023)).

2. The local interest factor favors transfer

N.D. Cal. has a substantially greater interest in the outcome of this case than W.D. Tex., favoring transfer. *See In re DISH Network, LLC*, No. 2021-182, 2021 WL 4911981, at *3 (Fed. Cir. Oct. 21, 2021) (comparing the relative interest in the transferee and transferor forums). Apple's headquarters, its principal place of business, and the events that gave rise to this suit are in N.D. Cal. Moreover, "because the accused products were designed, developed and tested in NDCA; and because the lawsuit 'calls into question the work and reputation of several individuals residing' in NDCA, this factor weighs in favor of transfer." *Apple III*, 979 F.3d at 1345 (internal citation omitted). Indeed, the design and development of the vast majority of the Accused

Technologies occurred in N.D. Cal., with the majority of the relevant engineering teams responsible for the Accused Technologies, as well as the sales, licensing, and marketing teams, largely located in N.D. Cal. *See supra* § II.B. The purported inventions were conceived and developed in N.D. Cal. and were assigned to multiple N.D. Cal. entities. *See supra* § II.C-D.

The Accused Technologies' connection to Apple's Texas employees and facilities is minimal compared to their connection to N.D. Cal. *See supra* §§ II.B, V.A.1-2. Apple's general presence in Texas is entitled to little or no weight. *See Apple II*, 2021 WL 5291804, at *5 (error to rely on Apple's "general presence in the transferor forum" instead of "the locus of the events that gave rise to the dispute") (citation omitted); *In re DISH*, 2021 WL 4911981, at *3 (W.D. Tex. facilities "insubstantial compared to [D. Colo.'s] significant connection to the [accused feature's] design and development"). Apple's nationwide sales are irrelevant because contacts common across districts cannot support any "localized" interest. *Samsung*, 2 F.4th at 1380.

Carbyne has not identified any relevant connection to W.D. Tex. that could tip the scales in favor of transfer. Carbyne has no connection to Texas. Thus, Carbyne's "presence in [W.D. Tex.]" is not merely "insubstantial," but nonexistent. *Juniper II*, 14 F.4th at 1320-21 (granting mandamus to direct transfer where plaintiff had only a litigation-fueled pre-filing presence in the district). In short, the "relevant events leading to the infringement claims here took place largely in [N.D. Cal.], and not at all in [W.D. Tex.]." *Samsung*, 2 F.4th at 1380. Given this striking imbalance, the local interest factor overwhelmingly favors transfer.

3. Familiarity with governing law and conflicts factors are neutral

Because this case is governed by federal patent law, the last two public interest factors are neutral. *See In re TS Tech. USA Corp.*, 551 F.3d 1315, 1320-21 (Fed. Cir. 2008).

VI. CONCLUSION

For the foregoing reasons, Apple respectfully requests transfer to N.D. Cal.

Dated: July 19, 2023

Respectfully submitted,

/s/ Melissa R. Smith
Melissa R. Smith
State Bar No. 24001351
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
Tel: (903) 934-8450
Fax: (903) 934-9257
melissa@gillamsmithlaw.com

James Travis Underwood
Texas Bar No. 24102587
GILLAM & SMITH, LLP
102 N. College, Suite 800
Tyler, Texas 75702
Telephone: (903) 934-8450
Fax: (903) 934-9257
Email: travis@gillamsmithlaw.com

James R. Batchelder (*pro hac vice*)
Andrew Radsch
James Mack (*admission pending*)
ROPES & GRAY LLP
1900 University Avenue
East Palo Alto, CA 94303-2284
Tel: 650-617-4000
Fax: 650-617-4090
James.Batchelder@ropesgray.com
Andrew.Radsch@ropesgray.com
James.Mack@ropesgay.com

Cassandra Roth (*pro hac vice*)
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036-8704
Phone: +1-212-596-9000
Fax: +1-212-596-9090
Cassandra.Roth@ropesgray.com

Allen S. Cross (*pro hac vice*)
Nicole Pobre (*pro hac vice*)
ROPES & GRAY LLP
2099 Pennsylvania Avenue, N.W.

Washington, DC 20006
Telephone: (202) 508-4600
Fax: (202) 508-4650
Allen.cross@ropesgray.com
Nicole.Pobre@ropesgray.com

S. Lara Ameri (*pro hac vice*)
Ropes & Gray LLP
Prudential Tower
800 Boylston Street
Boston, MA 02199-3600
Phone: +1-617-951-7000
Fax: +1-617-951-7050
Lara.Ameri@ropesgray.com

Attorneys for Defendant, Apple Inc.

CERTIFICATE OF CONFERENCE

I hereby certify that Apple's counsel conferred in good faith with opposing counsel on July 18 pursuant to Local Civil Rule 7(g), and Carbyne is opposed to the relief sought. Accordingly, this Motion and the relief requested herein are submitted to the court for resolution.

/s/ Melissa R. Smith
Melissa R. Smith

CERTIFICATE OF SERVICE

I hereby certify that on July 19, 2023, the documents filed with the Clerk of Court via the Court's CM/ECF system under seal in the above-captioned case were subsequently served on all counsel of record by electronic mail.

/s/ Melissa R. Smith
Melissa R. Smith