No. 2024-111

# In the United States Court of Appeals for the Federal Circuit

IN RE APPLE INC.,
Petitioner.

On Petition for Writ of Mandamus
to the United States District Court
for the Western District of Texas
No. 1:23-cv-00324-ADA

## NON-CONFIDENTIAL RESPONSE TO PETITION FOR WRIT OF MANDAMUS

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# UNITED STATES COURT OF APPEALS
# FOR THE FEDERAL CIRCUIT

## CERTIFICATE OF INTEREST

| | |
|---|---|
| **Case Number** | 2024-111 |
| **Short Case Caption** | In Re: Apple Inc. |
| **Filing Party/Entity** | Carbyne Biometrics, LLC |

**Instructions:**

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

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

Date: February 20, 2024

Signature: /s/*Charles E. Fowler, Jr.*

Name: Charles E. Fowler, Jr.

| **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.<br><br>☒ None/Not Applicable | 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.<br><br>☒ None/Not Applicable |
| Carbyne Biometrics, LLC | | |
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☐ 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

| | |
|---|---|
| **McKool Smith, P.C.** | Joshua Budwin, Richard Kamprath, Bradley Jarrett, Caroline E. Burks, George Fishback, Charles Fowler |
| | |

**5. Related Cases.** Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☐ Yes (file separate notice; see below) ☒ No ☐ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

**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

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## Introduction and Summary

Apple's mandamus petition concerns a motion to transfer venue from Austin, Texas to the Northern District of California. Apple's transfer motion has been briefed for just two and a half months. At a *Markman* hearing five days after briefing was complete, the district court orally denied Apple's motion and offered to postpone the *Markman* hearing until the court entered its written order. Apple declined that offer. The district court then took two months to enter its order. In the meantime, Apple decided it could not "wait any longer" to seek an extraordinary writ. Pet'n 17. Apple "primarily" sought a stay until the district court entered its written order. Pet'n 23. Alternatively, Apple sought a writ transferring the case. Pet'n 23–24.

After this Court ordered a response to Apple's petition, the district court entered its written order, mooting Apple's stay request. *Cf. In re Google LLC*, No. 2022-126, 2022 WL 1124960, at *2 (Fed. Cir. Apr. 15, 2022) (holding that denial of the petitioners' transfer motions "render[ed] moot their request for a stay until those motions are resolved"). That leaves Apple's request for a writ transferring the case.

The district court did not abuse its discretion by denying transfer. Apple's transfer motion hinged on whether its Austin-based engineers are relevant witnesses. Apple concedes that its Austin-based engineers helped develop the accused "Secure Enclave" and "Apple Cash" technologies. But Apple denies that they work on the *specific accused features*. In short,

Apple claims that its Austin-based engineers work on Secure Enclave *hardware* while Carbyne accuses only *software*. And Apple claims that its Austin-based engineers work on *server*-side Apple Cash functions while Carbyne accuses only *client*-side functions.

The district court rejected Apple's fact-based arguments about the scope of Carbyne's patent claims and infringement allegations and found that Apple's Austin-based hardware and server-side engineers are relevant. Anyway, the court found, Apple's Austin-based hardware engineers work on software too, or at least work with the software team, requiring them to know how the hardware and software work together. The court thus found that roughly the same number of relevant Apple employees live in each venue. Whether people may have relevant information is a fact question entrusted to the district court. And the record amply supports the district court's factfindings on relevant Apple witnesses in Austin.

The rest of the district court's transfer analysis flowed largely from its findings on relevant witnesses. For instance, the court found that the all-important witness-convenience factor disfavors transfer because Apple has relevant engineers in both venues (and both sides have relevant witnesses in neither venue but closer to Austin). The same Austin-based engineers are also document custodians and thus Austin-based sources of non-witness proof. Finally, Apple's Austin-based engineers—along with Apple's manufacturing an accused product in Austin—give Austin a localized interest. The district court found that all other factors disfavor transfer or are

neutral. The record gives a plausible basis for the district court's analysis, and so this Court should deny the writ.

But even if Apple met the other requirements for a writ, this Court should exercise its discretion to deny it. Apple is the world's second-largest company and is right at home in Austin. Apple would therefore suffer no hardship from defending this case there through trial. This Court should also deny a writ to discourage Apple from reflexively seeking mandamus in every case as soon as its transfer motion is briefed. Apple apparently expected the district court's immediate attention and sought mandamus *less than two months* after its transfer motion was briefed. Had Apple just waited a few more days for the district court's order, it would have streamlined this proceeding and avoided waste by both sides.

## STATEMENT OF THE CASE

### A. Carbyne sued Apple for patent infringement in Apple's second-largest United States hub.

Carbyne sued Apple in Austin, Texas. Appx10. Apple cannot deny that it calls Austin home in many ways. Austin is Apple's second-largest United States hub. SAppx146–48. Apple employs more than 7,000 Austinites, making it Austin's seventh-largest employer. SAppx151–52, 155–59. And Apple plans aggressive Austin expansion. SAppx151–52, 155–59.

Carbyne accuses Apple of infringing two sets of patents. First, Carbyne's Authentication Patents claim systems and methods that let a user access resources like websites and applications by scanning a biometric

like a face or fingerprint. Appx28–29. The invention protects users' sensitive data (biometrics and passwords) by processing it in a secure part of the device rather than sending it over an unprotected network or processing it in the device's main processor. Appx29–30. The accused Apple products infringe the Authentication Patents mainly by implementing "Secure Enclave," a secure subsystem that stores sensitive data apart from the device's main processor and operating system. Appx36–41.

The Authentication Patents claim not just software but also novel hardware configurations. SAppx2–3. They disclose a dedicated processor accessible only over a restricted interface, which limits access to sensitive data. Appx29–30. For instance, claim 1 of the '512 patent claims a "first" and "second" processor that can communicate with each other only through a "restricted interface." Appx72. The first processor must "establish a secure connection with the external resource" while the "second" processor performs tasks like "determin[ing] that there is a match between the biometric input and a stored biometric template," "access[ing] a record stored in a secure storage," and "perform[ing] a cryptographic operation." Appx72. Apple's products infringe this hardware configuration by including an Application Processor (first processor) and Secure Enclave Processor (second processor). *See, e.g.*, SAppx167, 172 (Carbyne's infringement contentions citing hardware design diagrams to show that the representative iPhone 13 meets specific claim language because it "includes a second

processor, such as the Secure Enclave Processor, with which a first processor (Application Processor) communicates using a restricted interface").

Second, Carbyne's Fraud Reduction Patents claim systems and methods for preventing fraud in electronic transactions. Appx33. When a user tries to transact online, a device implementing the invention scans the user's biometric information. Appx33. A fraud-detection analysis is then performed to verify that the user is alive and aware. Appx33–34. In some embodiments, the fraud-detection analysis also considers location data and stored biometric data. Appx33–34. The accused Apple products infringe the Fraud Reduction Patents mainly by implementing the "Apple Cash" platform on iPhones and iPads. Appx42–46. When a user tries to send money through Apple Cash, Apple's FaceID feature takes pictures of the user's face. Appx43. Apple Cash then performs a fraud-detection analysis to verify the user's identity, that the user is alive and aware, and that the user is in the United States. Appx43.

The functions accused of infringing the Fraud Reduction Patents occur on both users' devices and Apple's servers. SAppx3. Apple's technical documents show that Apple Cash's fraud-detection analysis involves "[redacted] and "[redacted]—project names for server-side Apple Cash functions. SAppx268; *see, e.g.*, SAppx271–311 (showing the [redacted] server's role in fraud-detection analysis). Sever-side functions are thus relevant to claim limitations of at least the '886 and '010 patents. Carbyne understands, for

instance, that while user devices perform biometric verification, the devices send biometric and location data to Apple's servers for some fraud-detection steps, and that server-side functions are also relevant to completing a transaction based on the fraud-detection decision.

**B. Apple has many relevant employees and functions in Austin.**

This case has many ties to Austin. To start, at least nine Austin-based Apple engineers work on the accused features.

For the Authentication Patents, Austin-based engineers Herbeck, Le Roy, and Peeters are relevant because they helped develop the accused Secure Enclave technology. Appx556; *see* SAppx8–9. In the *Identity Security* case involving the same technology, Apple itself relied on these Austin-based engineers when it sought to transfer venue *to Austin* from Waco. Appx545–59. The district court there accepted Apple's description of these Austin-based engineers and so rejected the defendant's "assertion that key decision-making is done in California and not in Austin." Appx567. Apple witnesses had testified that Austin-based Herbeck is the lead design engineer for Secure Enclave, giving him "superior knowledge of the accused technology compared to other members of his team." Appx567; SAppx105, 114. Similarly, Austin-based security architects Peeters and Le Roy select security features for Secure Enclave and define microarchitecture to support those features. Appx567; SAppx112–13, 139.

For the Fraud Reduction patents, Apple acknowledges its "Austin Apple Cash employees [] whose roles focus on server-side or post-transaction events." Appx211; *see* Appx437 (listing Ordonez, Brammer, Shroff, Diouf, Enninful, and Hitt); SAppx55–61 (same). Despite the relevance of server-side Apple Cash functions, *see supra*, Statement § A, the two technical witnesses Apple picked to give venue testimony (Heard and Wells) could not testify about them. To the contrary, Apple's counsel claimed that Heard lacked access to Apple's '[redacted] technical documents and would not let Heard see them during his deposition. SAppx269, 317–18. Wells had not even heard of [redacted] SAppx269, 324. So it appears that *all* the relevant witnesses for sever-side Apple Cash functions are in Austin.

On top of all that, Apple manufactures one of the accused products—its Mac Pro desktop computer—in Austin. SAppx263–64.

### C. Apple sought transfer to the Northern District of California.

In July 2023, Apple moved to transfer this case to the Northern District of California. Apple's strategy was immediately clear: artificially restrict the case's scope to avoid its many Austin ties. Apple cherry-picked seven purportedly "likely trial witnesses," five in the Northern District of California, one in Colorado, and one in Prague, Czech Republic. Appx209–10. Despite claiming in *Identity Security* that its Austin-based employees were relevant, Apple claimed that no likely witness is in Texas and that "the Accused Technologies have no Texas connection." Appx210.

Apple conceded that "some Secure Enclave and Apple Cash engineers work in Austin." Appx210. Even so, Apple insisted, they do not tie the case to Austin because they do not "work on" relevant features. Appx210–11. Apple argued that its Austin-based Secure Enclave engineers work on *hardware* while Carbyne's allegations relate only to *software*. Appx210, 218. Similarly, Apple argued that its Austin-based Apple Cash engineers work on *server*-side features while Carbyne's allegations relate only to *client*-side (user device) features. Appx211. And—wouldn't you know it?—Apple claimed that its *software* and *client*-side people are in Cupertino. Appx210–11.

Carbyne's opposition explained that this is far from a case wholly lacking Austin ties, or whose clear center of gravity is in the Northern District of California. Appx353–67. Carbyne observed that its sole inventor and representative lives in New York—closer to Austin than San Francisco. Appx356. Carbyne also observed that three key Secure Enclave engineers (the ones Apple relied on in *Identity Security*) and several relevant Apple Cash engineers work in Austin. Appx356–58, 437. Apple could not show that those engineers are irrelevant just by unilaterally denying that certain features infringe—a fact issue related to the merits. Appx357–58. At the same time, venue depositions had revealed that Apple's purported "trial witnesses" knew little about the case or accused technology. Appx358–59. Since all other relevant interests disfavored transfer or were

neutral, Carbyne urged the district court to deny Apple's transfer motion. Appx359–67.

Apple filed a reply. Appx399–402. Then, because the Fifth Circuit decided a new precedential § 1404(a) transfer case, Carbyne filed a surreply. Appx432–39 (discussing *In re TikTok, Inc.*, 85 F.4th 352 (5th Cir. 2023)). When Apple obtained leave to file yet another brief on December 7, 2023 (a sur-surreply)—about two and a half months ago—Apple's transfer motion was fully briefed. Appx8, 456–60.

**D. The district court denied Apple's transfer motion.**

In December 2023, five days after venue briefing was complete, the district court orally denied Apple's motion at the start of the *Markman* hearing. Appx8, 475.

On February 12, 2024—after Apple filed its mandamus petition—the district court entered a written order explaining its transfer denial. SAppx1–24. To begin, the court resolved the parties' core fact dispute over the scope of the accused technology, and thus which Apple engineers are relevant. SAppx2–3. That dispute, the court recognized, "is directly relevant to all of the factors below." SAppx2.

The court agreed with Carbyne that the Austin-based engineers Carbyne identified (including those Apple relied on in *Identity Security*) are relevant. After considering the parties' arguments and reviewing the Authentication Patents, the court concluded "that it would be erroneously narrowing the scope of relevant accused technology if it found that only

software features were at issue." SAppx2 (cleaned up). The court thus found "that the scope of the claims includes novel hardware solutions in addition to software." SAppx2–3. Turning to the Fraud Reduction Patents, the court similarly found "that server-side Fraud Detection functionality is relevant to the scope of the [asserted] claims" and thus "reject[ed] Apple's attempt to erroneously narrow the scope of the relevant accused technology" to only client-side (user device) functions. SAppx3.

The district court's assessment of the private- and public-interest factors flowed largely from its findings on the scope of the accused technology. The court found that Apple has six relevant employees in the Northern District of California. SAppx7–8. But the court also found that Apple has three relevant Austin-based Secure Enclave engineers and two relevant Austin-based Apple Cash engineers. SAppx9–10. In reality, Apple has at least *nine relevant Austin-based engineers*.[1] While Apple argued that those Austin-based engineers work on irrelevant hardware and server-side functions, the court had rejected that argument. SAppx9–10. The court also agreed with Carbyne that its only party witness in New York (Jakobsson), as well as Apple's party witnesses in Colorado (Harlow) and Prague

[1] As described above, Apple concedes that it has "Austin Apple Cash employees [] whose roles focus on server-side or post-transaction events." Appx211. And Apple disclosed *six* such employees, who are identically situated as far as the record shows: Ordonez, Brammer, Shroff, Diouf, Enninful, and Hitt. Appx437; SAppx55–61. So while the district court focused on the two examples discussed in Carbyne's transfer opposition (Ordonez and Hitt), the court's analysis applies as well to *all six*. Appx358; SAppx10; *see* Appx437 (Carbyne's surreply listing all six).

(Šubert), weigh against transfer because all live closer to Austin. SAppx11–13. In sum, the court found that party witness convenience—the most important factor—disfavors transfer. SAppx13.

For similar reasons, the court found that sources of proof exist in both venues. SAppx13–17. The court found that Apple employees in Austin, California, Colorado, and Prague are all relevant document custodians. SAppx14. The court rejected Apple's argument that its Austin-based custodians lack "need to know" access credentials for relevant electronic evidence as "essentially rehashing [Apple's] hardware/software distinction." SAppx14. Apple also made "no specific claims regarding physical documents." SAppx15. The court thus concluded that if any physical evidence exists, it could be in both venues, and so its location carries no weight. SAppx15–16.

As to nonparty sources of proof and ability to compel nonparty testimony, the court found that the parties gave too little information to decide whether some nonparties (including Think Computer and TabletKiosk) have relevant information. SAppx16, 19. Apple also listed PayPal as a relevant nonparty, but the court found (and Apple had conceded) that PayPal has relevant witnesses "in both California and Texas." SAppx16, 19; *see* Appx403 n.4. In contrast, the court explained, Carbyne listed 1Password (identified in Carbyne's complaint) as a relevant nonparty and "specifically identifie[d] multiple engineers (including the head of engi-

neering … ) that reside in Austin" and would likely have relevant information. SAppx16–17, 19–20. Holding otherwise would again require the court "to prematurely limit the scope of the accused technology before full fact discovery opens." SAppx19–20.

The court found that the remaining factors are neutral. As for practical problems, the case had progressed some but not enough to disfavor transfer. SAppx21. And since Carbyne and Apple do not compete, the court found that the Western District's time-to-trial edge does not weigh against transfer. SAppx21. Finally, Austin has a local interest since Apple has Austin campuses, has "multiple" Austin-based engineers who helped develop the accused technology, and manufactures accused products in Austin. SAppx23. But since the Northern District of California too has a local interest, the court found that this factor is neutral. SAppx23.

In the end, the court concluded that the witness-convenience and compulsory-process factors disfavor transfer and that no factor favors transfer. SAppx23. Noting this Court's repeated emphasis on witness convenience, the court held that Apple "failed to meet its burden of showing that the Northern District of California is a clearly more convenient forum." SAppx24 (citing *In re Genentech, Inc.*, 566 F.3d 1338, 1342 (Fed. Cir. 2009)).

## MANDAMUS STANDARD

Regional circuit law governs mandamus review of a transfer denial under § 1404(a). *In re Google LLC*, 58 F.4th 1379, 1382 (Fed. Cir. 2023).

"Mandamus is an extraordinary remedy" requiring Apple "to demonstrate that the court's denial of transfer was so patently erroneous as to amount to a clear abuse of discretion." *In re Vistaprint Ltd.*, 628 F.3d 1342, 1344 (Fed. Cir. 2010) (citing *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 314 (5th Cir. 2008) (en banc)). A district court abuses its discretion if it "(1) relies on clearly erroneous factual findings; (2) relies on erroneous conclusions of law; or (3) misapplies the law to the facts." *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194, at *2 (Fed. Cir. Aug. 2, 2021) (citing *Volkswagen*, 545 F.3d at 310).

"A petitioner must satisfy three requirements for a writ of mandamus." *In re TikTok, Inc.*, 85 F.4th 352, 357 (5th Cir. 2023). First, the petitioner must have a clear and indisputable entitlement to the writ. *Id.* Second, "there must be no other adequate means to attain the relief desired." *Id.* (cleaned up). And third, "the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances." *Id.*

## Reasons to Deny the Writ

### I. The district court did not abuse its discretion by denying Apple's transfer motion.

The district court did not abuse its discretion. The court's factfindings about the locations of relevant witnesses and evidence defeat Apple's arguments for transfer. And the record amply supports those findings. So the balance of relevant factors does not favor transfer, let alone clearly so. *See*

*In re Apple Inc.*, 979 F.3d 1332, 1338 (Fed. Cir. 2020) (explaining that the party seeking transfer has "the burden of demonstrating that the transferee venue is clearly more convenient" (quotation marks omitted) (citing *Volkswagen*, 545 F.3d at 314)).

The Fifth Circuit "weigh[s] the private and public interest factors to determine whether the destination venue is 'clearly more convenient.'" *Id.* (quoting *Volkswagen*, 545 F.3d at 315). The private-interest factors are (1) "the cost of attendance for willing witnesses," (2) "the availability of compulsory process to secure the attendance of witnesses," (3) "the relative ease of access to sources of proof," and (4) "all other practical problems that make trial of a case easy, expeditious and inexpensive." *In re TikTok, Inc.*, 85 F.4th 352, 358 (5th Cir. 2023). The public-interest 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.* (brackets omitted).

**A. The private-interest factors disfavor transfer.**

Recognizing that the cost for willing witnesses to attend trial is the most important factor, the district court correctly found that it disfavors transfer. SAppx13. The court also correctly found that the availability of compulsory process disfavors transfer. SAppx20. The court did not clearly

err by finding that access to proof and other practical problems are neutral at worst. SAppx17, 21. If anything, those factors disfavor transfer.

***Cost for willing witnesses to attend.*** The district court correctly weighed witness convenience against transfer. SAppx13. "The convenience of the witnesses is probably the single most important factor in transfer analysis." *In re Apple Inc.*, 818 F. App'x 1001, 1003 (Fed. Cir. 2020). When the existing and proposed venues are more than 100 miles apart, "the factor of inconvenience to the witnesses increases in direct relationship to the additional distance to be traveled." *TikTok*, 85 F.4th at 361.

As the district court recognized, the witness-convenience factor turns mainly on the parties' fact dispute over which Apple witnesses likely have relevant information. "Whether individuals … may have relevant information" is a "fact-intensive matter[] often subject to reasonable dispute." *Apple*, 818 F. App'x at 1004. "Those determinations are generally entrusted to the discretion of the district court." *Id.* (citing *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010)); *see also In re Amazon.com, Inc.*, No. 2023-104, 2023 WL 126447, at *2 (Fed. Cir. Jan. 9, 2023) (refusing to disturb the district court's finding "that information known and held by [Amazon's] operating system development team located in Austin Texas is material to the parties' dispute," which finding "informed the court's understanding and weighing of the disputed factors"); *In re Hewlett Packard Enter. Co.*, No. 2022-154, 2022 WL 3209326, at *2 (Fed. Cir. Aug. 9, 2022)

(refusing to disturb the district court's finding that "individuals identified in Texas have relevant and material information").

The district court correctly found that Apple's Austin-based engineers likely have relevant information. First, the court found that three Austin-based Secure Enclave engineers (Herbeck, Peeters, and Le Roy—the ones Apple itself relied on in *Identity Security*) likely have information relevant to Carbyne's Authentication Patents. SAppx2–3, 9; *see supra*, Statement § B. The court reviewed the Authentication Patents and Carbyne's infringement allegations and agreed with Carbyne that this case involves both software *and hardware*. SAppx2–3, 9; *see* Appx356–58, 435–36. The court thus rejected Apple's sole argument that these Austin-based engineers are irrelevant. SAppx2–3, 9. The court correctly refused to artificially restrict the scope of the accused features before the parties had completed discovery or finalized their contentions. Holding otherwise would require the court to prematurely assess which features infringe. But "the question of whether [Apple] has committed infringement is a merits issue, not one that should be decided on mandamus review in the context of a motion to transfer venue." *See Apple*, 818 F. App'x at 1004.[2]

[2] Carbyne need not have detailed each feature relevant to infringement in its preliminary contentions to show that Apple's Austin-based engineers have relevant information. *See* Pet'n 13, 25, 27, 29. Preliminary infringement contentions are meant to guide discovery and focus the parties on potentially dispositive issues, not to exhaustively detail the patentee's theories. *AntiCancer, Inc. v. Pfizer, Inc.*, 769 F.3d 1323, 1329 (Fed. Cir. 2014). Contrary to Apple's suggestion, moreover, Carbyne has not sought to "add" features to its infringement theories since the parties briefed Apple's transfer motion. *See* Pet'n 29. Carbyne has merely given more detail on

Apple cites no evidence showing clear error in the district court's fact-finding that Herbeck, Peeters, and Le Roy likely have relevant information. *See* Pet'n 26–27. Aside from attorney argument in Apple's own district-court briefs, Apple cites only the declaration and deposition of Tim Paaske, who purportedly led the Secure Enclave hardware architecture team. Appx236. Paaske parroted Apple's view that Herbeck, Peeters, and Le Roy "work[] on" hardware. Appx237, 411. But Paaske gave no view on whether that hardware is relevant to infringement here. Apple's attorney argument cannot overcome the district court's finding that hardware is relevant based on its review of the Authentication Patents and the whole record.

The district court found that, at any rate, Apple's Austin-based Secure Enclave engineers likely know about software features too. SAppx9. The court relied on these witnesses' testimony that "they work on both hardware and software architecture." SAppx9 (citing Appx357; SAppx126, 128, 131, 140–42). And the court rejected Apple's argument that these engineers' software involvement is irrelevant because, as hardware engineers, they merely "interface" with the software team. SAppx9 (citing Appx401). The court reasoned that "[i]nterfacing with the software team requires understanding [] how the code operates, and how the software works in conjunction with the hardware of the Secure Enclave." SAppx9. Knowledge

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the theories it has always pursued (including in its transfer briefing), as naturally occurs during discovery. Appx357–58, 435–37.

of how Secure Enclave hardware and software work together, the court found, is "hardly" irrelevant to Carbyne's infringement allegations. SAppx9. That finding is supported by the record (including the unrefuted testimony cited by the district court) and supports the district court's decision to weigh this factor against transfer.

Second, the district court correctly found that two Austin-based Apple Cash engineers (Ordonez and Hitt) likely have information relevant to Carbyne's Fraud Reduction Patents. SAppx3, 9–10; *see supra*, Statement § B. The court cited Apple's admission that Ordonez and Hitt "are Apple Cash employees who focus on server-side and post-transaction events." SAppx10. And the court agreed with Carbyne that its infringement allegations extend to Apple Cash's server-side fraud-detection functions. SAppx10; *see* Appx358, 436–37. Holding otherwise, the court found, would again "impermissibly … limit the scope of infringement and what is relevant." SAppx10. As with the Authentication Patents, the court was right not to restrict the scope of infringing features "on mandamus review in the context of a motion to transfer venue." *See Apple*, 818 F. App'x at 1004.

Here again, Apple cites nothing showing that the district court clearly erred by finding that server-side features are relevant. *See* Pet'n 28–29. In fact, the cited page of Carbyne's infringement contentions supports the finding: That fraud-detection analysis "is at least *partially based on* location data captured by the phone" tracks with Carbyne's claim that the phone

then sends data to Apple's servers, which perform some fraud-detection steps. *See* Appx471 (emphasis added). If anything, the district court found *too few* relevant Austin-based Apple Cash engineers. Because Carbyne listed six such engineers its briefing, and the record gives no basis to distinguish among them, the district court erred by finding only two rather than six Apple Cash witnesses in Austin. *See supra*, Statement §§ B, D n.1.

Against Apple's five relevant Austin-based engineers (really nine if all of the Apple Cash witnesses are included as they should be), the district court weighed six Apple employees in the Northern District of California. SAppx7–8. Carbyne does not contest the district court's finding that these employees might be relevant. Even still, Apple does not show (and the district court did not find) that any are likelier trial witnesses than Apple's Austin-based engineers. Most of the purported technical witnesses never reviewed Carbyne's complaint, the asserted patents, or the parties' contentions before they were deposed. SAppx76, 89, 94. One said he was not asked whether he thought he was relevant. SAppx77. Another said he was not sure what technology was accused. SAppx94. Apple's licensing witness had not reviewed the patents or contentions and knew of no licenses related to Secure Enclave. SAppx70–71. Apple's marketing witness had never taken part in marketing most of the accused technology. SAppx65. And Apple's sales-and-finance witness worked with people in Texas on her declaration and deposition preparations. SAppx82–84.[3]

[3] The district court correctly ignored unnamed "team members" of the

Next, the district court correctly found that party witnesses outside either district disfavor transfer. To start, Markus Jakobsson is the sole inventor of the asserted patents and Carbyne's only party witness. Appx376. He lives in New York City, Appx372, about 1,500 miles from Austin but more than 2,600 miles from San Francisco. SAppx11–12. So under the Fifth Circuit's 100-mile rule, the inconvenience of testifying in San Francisco is 70 percent greater than the inconvenience of testifying in Austin. The district court correctly recognized that the Fifth Circuit recently overturned this Court's practice of applying the 100-mile rule less rigidly to witnesses who would have a long trip to either venue. SAppx12 (citing *TikTok*, 85 F.4th at 361). In *TikTok*, the Fifth Circuit held that inconvenience to party witnesses in China favored transfer because the Northern District of California is closer to China than the Western District of Texas. 85 F.4th at 361–62. "[F]ollow[ing] the direction of the Fifth Circuit," the district court correctly found that an Austin trial would be more convenient for Jakobsson even though he would have a long trip to either venue. SAppx12.

So too for Apple's witnesses in Colorado (Harlow) and Prague (Šubert). Both witnesses "undisputedly" live closer to Austin than San

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named Apple employees in the Northern District of California because Apple did not identify them or say what they would testify about. SAppx7 (citing *In re Google LLC*, No. 2021-170, 2021 WL 4427899, at *7 (Fed. Cir. Sept. 27, 2021)).

Francisco. SAppx12–13. So both witnesses disfavor transfer under the Fifth Circuit's 100-mile rule. SAppx13.

In sum, the district court correctly weighed the all-important willing-witness factor against transfer. The court correctly found that Austin would be more convenient for Carbyne's only party witness, two Apple witnesses outside either district, and five Austin-based Apple witnesses. The court's only error was finding too few Austin-based Apple witnesses since unrefuted evidence shows all six Austin-based Apple Cash employees are relevant (instead of just the two discussed by the court), meaning that there are nine relevant Austin-based Apple employees (three for Secure Enclave and six for Apple Cash) rather than five. In contrast, the court found just six potentially relevant Apple witnesses in the Northern District of California, most of whom showed little relevant knowledge.

***Availability of compulsory process.*** The district court correctly weighed the availability of compulsory process against transfer. SAppx20. "This factor favors transfer where nonparty witnesses are outside the Western District's subpoena power, and a proper venue that does enjoy absolute subpoena power for both depositions and trial is available." *TikTok*, 85 F.4th at 360 (cleaned up).

The Northern District of California lacks an advantage in trial-subpoena power. The district court plausibly found that one nonparty company with relevant information comes within the Western District's subpoena range. Carbyne will seek testimony from 1Password, a third-party

app developer identified in Carbyne's complaint, because Apple induces widespread infringement by 1Password. Appx363–64; SAppx193–97, 199-201. Carbyne identified eight potential 1Password witnesses in Austin, including its Director of Engineering, Head of Passwordless, Engineering Manager, Senior iOS Developer, and others. SAppx18, 203–39.

The district court credited Carbyne's showing. SAppx19–20. The court found that 1Password is relevant to induced infringement because "Apple gives 1Password development tools to use [accused] security features like Secure Enclave." SAppx20. Holding otherwise would "prematurely limit the scope of the accused technology before full fact discovery opens." SAppx19–20. *See Apple*, 818 F. App'x at 1004 (transfer analysis should not assess the scope of infringement). The court further found that multiple 1Password engineers "reside in the Austin area and would have relevant information about the operation and use of the product that Apple is inducing." SAppx20. Apple gives no basis for disturbing that factual relevance finding. Apple's argument that it may induce infringement by *other nonparties too*, *see* Pet'n 13–14, 31, does not negate 1Password's relevance, especially since Apple identified no other induced infringers.

While the district court found at least one relevant nonparty in the Western District's subpoena range, it correctly gave no weight to Apple's four purported prior-art witnesses. SAppx19; *see* Pet'n 30. Apple conceded that PayPal has potential witnesses near *both* courts, so that "some would be subject to subpoena power in either place." SAppx19; *see* Appx403 n.4.

And the district court found that Apple gave too little information to assess its subpoena power over Tablet Kiosk, Think Computer, and Digital Persona. SAppx19. For those nonparties, Apple did "not specifically identify any people, the information they have that is relevant, or the location of those individuals." SAppx19. Indeed, Carbyne offered evidence that any Digital Persona witnesses were likelier located at Digital Persona's corporate headquarters *in Austin* (though the court found that evidence inconclusive too). SAppx19, 174–91. Here again, this Court should credit the district court's factual relevance findings. *See In re Meta Platforms, Inc.*, No. 2023-143, 2023 WL 7118786, at *1 (Fed. Cir. Oct. 30, 2023) (crediting the district court's finding "that Meta was not sufficiently clear about what relevant and material information [claimed witnesses in northern California and Seattle] possessed").

Apple alludes to "numerous" nonparties besides its four purported prior-art witnesses. *See* Pet'n 30. But the reasons for giving no weight to Apple's *named* prior-art witnesses apply doubly to the *unnamed* ones. The district court was in no "position to determine" the relevance of Apple's purported "100 prior art inventors, authors, and assignees" "given the lack of information provided by Apple." SAppx19. And this Court is surely no better positioned to make that determination. *See Meta Platforms*, 2023 WL 7118786, at *1; *see also Easton v. Wells Fargo & Co.*, No. 20-CV-02193-HSG, 2020 WL 3639934, at *4 (N.D. Cal. July 6, 2020) (giving no weight to unidentified witnesses); *Indus. Access, Inc. v. Ellie Mae, Inc.*, No. LA CV 13-

2769-JAK-AJW, 2013 WL 12133653, at *7 n.7 (C.D. Cal. Sept. 18, 2013) (same).

In sum, the district court correctly weighed compulsory process against transfer. Carbyne showed at least one relevant Texas-based nonparty (1Password) whereas Apple gave too little information to show that the Northern District of California has relevant subpoena power over any relevant nonparty.

***Access to proof.*** The district court treated relative access to proof as neutral. If anything, it disfavors transfer. This "factor focuses on the location of documents and physical evidence." *TikTok*, 85 F.4th at 358 (cleaned up). It favors transfer when "the current district lacks any evidence relating to the case." *Id.* It carries less weight when "the vast majority of the evidence is electronic, and therefore equally accessible in either forum." *Id.* (brackets omitted).

To start, this factor carries little weight because Apple identifies no physical (rather than electronic) evidence. Apple's petition cites none. And the district court correctly observed that Apple "ma[de] no specific claims regarding physical documents." SAppx15. Apple's only evidence of physical records is the declarations of one technical witnesses in California (Paaske) and one licensing witness in Colorado (Harlow). SAppx15. But these witnesses' vague statements specified no records. SAppx15. Indeed, Harlow merely generalized about "physical records and things … , *includ-*

*ing electronic records*." Appx231 (emphasis added). So the district court correctly found that Apple showed no physical evidence in northern California. *See Def. Distributed v. Bruck*, 30 F.4th 414, 434 (5th Cir. 2022) (rejecting "conclusory assertions" about sources of proof); *In re Hewlett Packard Enter. Co.*, No. 2022-154, 2022 WL 3209326, at *2 (Fed. Cir. Aug. 9, 2022) (holding that the petitioner had "not shown a clear right to having the sources of proof factor weighed in favor of transfer" when it "failed to identify any specific documents").

Apple argues that the Western District lacks any evidence because all relevant document custodians are in California, Colorado, and Prague. *See* Pet'n 32–33. That argument is wrong for the reason explained above: all the Austin-based Secure Enclave and Apple Cash engineers described above "are document custodians and likely to have relevant documents and information." SAppx15. As the district court explained, Apple's argument that its Austin employees work only on irrelevant features and lack access to relevant records merely "rehash[es] the hardware/software distinction" that the court rejected. SAppx14. The district court's reasoning is plausible on the record. *See, e.g.*, SAppx115–16, 119, 129–30, 143 (testimony of Apple's Austin-based engineers that they can access relevant evidence, including Secure Enclave source code, from Austin).

Apple ignores still other sources of proof in Texas. For one thing, the district court plausibly found that 1Password witnesses and document custodians in Austin weigh against transfer. SAppx16–17. As described

above, the court credited Carbyne's showing that specific 1Password employees likely have relevant information about Carbyne's induced-infringement claim.

Beyond that, Carbyne's predecessor (RightQuestion) obtained documents from PayPal concerning Carbyne's ownership of the asserted patents during a past case against Samsung. SAppx48–49. Those documents are stored at Carbyne's counsel's Austin office—and, PayPal has declared that no other potentially relevant records beyond those previously-produced and currently stored in Carbyne's counsel's Austin office could be located. SAppx48–49. *See Paltalk Holdings, Inc. v. Sony Comput. Ent. Am. Inc.*, No. 2:09-CV-274-DF-CE, 2010 WL 3517196, at *5 (E.D. Tex. Sept. 3, 2010) (weighing "a large body of evidence" at plaintiff's counsel's office when it was collected during prior litigation and "was relocated to the forum state in good faith rather than in an attempt to manipulate venue rules"). Apple's transfer motion argued that these PayPal documents were relevant, *see* Appx211–12, but Apple dropped that argument after Carbyne explained that they are in Austin, *see* Appx364–65. While the district court did not mention this source of proof, it tips this factor more firmly against transfer.

In sum, while the district court treated this factor as neutral, if anything, it disfavors transfer. Apple identifies no physical proof in northern California and no electronic records that only its California employees can access. And there are several sources of proof in Texas, including Apple

document custodians, nonparty documents, and documents from past litigation stored in Austin.

***Other practical problems.*** The district court called practical problems neutral. If anything, they disfavor transfer. This factor "considers all other practical problems that make trial of a case easy, expeditious, and inexpensive." *TikTok*, 85 F.4th at 362 (cleaned up). That this case is "timely proceeding to trial" in Austin "counsels against transfer." *In re Planned Parenthood Fed'n of Am., Inc.*, 52 F.4th 625, 631 (5th Cir. 2022). The district court and parties have made substantial progress in the case. The parties fully briefed Apple's motion to dismiss under § 101 by late June 2023. SAppx25. The parties exchanged preliminary technical and standing discovery by mid-August 2023. SAppx48. The court held a *Markman* hearing in December 2023 and ruled on claim-construction disputes. Appx472. And fact discovery is now underway, with Carbyne diligently reviewing Apple's source code and working to meet the district court's March 20, 2024, deadline for final infringement contentions. SAppx335.

Apple misreads *TikTok* to argue that progress in the case weighs against transfer only when the defendant inexcusably delayed moving to transfer. *See* Pet'n 43 (citing *TikTok*, 85 F.4th at 362). That is just one circumstances in which "[t]his factor weighs against transfer," not the only circumstance. *See TikTok*, 85 F.4th at 362. Just the opposite, The Fifth Circuit refused to "draw [a] bright line" on when a court can consider progress in the case after the transfer motion was filed. *Id.* at 362 n.10. In

*TikTok*, the Fifth Circuit refused to weigh post-motion progress against transfer because the district court took more than a year to decide the transfer motion. *Id.* at 363. That excessive delay is absent here: as described above, Apple's transfer motion has been fully briefed for only about two and a half months. *See supra*, Statement § C.

In sum, the substantial progress in the case disfavors transfer or, at worst, is neutral.

**B. The public-interest factors disfavor transfer.**

Court congestion and localized interests disfavor transfer. The other two public-interest factors are neutral. *See* Pet'n 35.

***Localized interests.*** The district court called localized interests neutral. If anything, they disfavor transfer. This factor "looks not to the parties' significant connections to each forum but rather the significant connections between a particular venue and the events that gave rise to a suit." *TikTok*, 85 F.4th at 364 (cleaned up). In a patent case, a local interest exists where the accused products were designed or developed "because the lawsuit calls into question the work and reputation of [the] individuals residing" there. *Apple*, 979 F.3d at 1345. Yet again, Apple repeats its argument that no Austin-based engineers contributed to the accused features. *See* Pet'n 35–36. Yet again, the district court plausibly found otherwise, recognizing that Apple developed accused technology in Austin. SAppx21.

Austin also has a localized interest because Apple manufactures one of the accused products—its Mac Pro desktop computer—in Austin and

manufactures none of the accused products in California. SAppx23, 263–64. *See Apple*, 818 F. App'x at 1002 (holding that the district court did not abuse its discretion by denying transfer partly because "one of the accused products is made in Austin, Texas, 'giving those involved with its manufacture a localized interest in determinations made regarding the infringement'"). This Court has not held that the place where the defendant makes the accused products deserves "little weight." *See* Pet'n 37 (quoting *Apple*, 979 F.3d at 1346). The Court in that case was talking about the location of a third-party manufacturer (Flextronics), not the defendant. *See* 979 F.3d at 1346. And the Court's "little weight" comment described the district court's reasoning, not this Court's holding. *See id.*

In sum, Austin has two localized interests: Apple engineers helped develop the accused technology in Austin, and Apple makes one of the accused products in Austin (and none in California). So this factor disfavors transfer.

***Court congestion.*** The district court erroneously treated court congestion as neutral when it disfavors transfer. This factor focuses "on docket efficiency, an issue [that] the district court is better placed to evaluate." *TikTok*, 85 F.4th at 363 (cleaned up). The district court has determined that it has a six-month time-to-trial edge over the Northern District of California. *See, e.g.*, *Align Techs. Corp. v. Atlassian US, Inc.*, No. 1:22-CV-00824-LY, 2023 WL 1861220, at *5 (W.D. Tex. Feb. 9, 2023), *adopted*, 2023 WL 2957823 (W.D. Tex. Apr. 14, 2023) (finding that "the median time to trial

for civil cases in the Northern District of California is 34.7 months, compared with 28.3 months in this District").

Apple and the district court maintain that time-to-trial differences matter only for disputes between competitors. SAppx21; Pet'n 37 (citing *In re Google LLC*, 58 F.4th 1379, 1383 (Fed. Cir. 2023)). After this Court decided *Google*, however, the Fifth Circuit reiterated the relevance of time-to-trial differences and the district court's discretion to assess them. *See TikTok*, 85 F.4th at 363 & n.12. The Fifth Circuit did not suggest (and has *never* suggested) applying this factor only in competitor cases.

In sum, because the Western District of Texas could bring this case to trial faster than the Northern District of California, this factor disfavors transfer.

## II. This Court should exercise its discretion to deny relief because an extraordinary writ is inappropriate under the circumstances.

Last, Apple cannot show that a writ transferring this case would be an appropriate exercise of discretion. Mandamus is a "drastic" remedy "to be invoked only in extraordinary situations." *El Malik v. Shulkin*, 684 F. App'x 961, 964 (Fed. Cir. 2017) (quoting *Kerr v. U.S. Dist. Court*, 426 U.S. 394, 402 (1976)). Even if Apple otherwise meets the requirements for mandamus, this Court "must, in its discretion, 'be satisfied that the writ is appropriate under the circumstances.'" *Id*. (quoting *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 380 (2004)).

This Court should exercise its discretion to deny mandamus here for two reasons. First, Apple would suffer no hardship from defending this case through trial in the Austin. *See In re Roche Molecular Sys., Inc.*, 516 F.3d 1003, 1004 (Fed. Cir. 2008) (explaining that the threat of "hardship" or "inconvenience" does not justify mandamus). Apple is right at home—indeed, it is a major economic force—in Austin. *See supra*, Statement § A. Apple is also the second most valuable company in the world. So covering travel and time off for a few California-based employees to attend trial in Austin—and even compensating them for their personal troubles—would hardly impose a noticeable burden.

Plus, Apple defends patent suits in the Western District of Texas all the time. In some cases, this Court has declined to rescue Apple from suit in the Western District of Texas. *See In re Apple Inc.*, 855 F. App'x 766, 767 (Fed. Cir. 2021); *In re Apple Inc.*, 818 F. App'x 1001, 1004 (Fed. Cir. 2020); *In re Apple Inc.*, 809 F. App'x 961, 962 (Fed. Cir. 2020); *In re Apple, Inc.*, No. 2020-104, 2019 WL 13095535, at *2 (Fed. Cir. Dec. 20, 2019); *see also In re Apple Inc.*, 743 F.3d 1377, 1379 (Fed. Cir. 2014) (declining to order transfer from the Eastern District of Texas). In others, Apple has successfully sought transfer *to Austin*. Appx545–59. Apple counts many Western District regulars among the army of lawyers who routinely defend it in patent cases. No defendant could be better equipped than Apple to endure "inconvenience" from litigating in Austin.

Second, the Court should not reward Apple's impatience in seeking mandamus before the district court entered its order. *See In re Apple Inc.*, 979 F.3d 1332, 1338 n.1 (Fed. Cir. 2020) (taking care not to "condon[e] pre-order mandamus petitions"). Apple's approach leads to waste and rework: much of Apple's petition (and the response Carbyne had drafted) was mooted when the district court entered its written order the night before Carbyne's response was originally due. Apple could have saved everyone time and money—and streamlined this proceeding—by just waiting a few more days for the order the district court had repeatedly said was coming soon. *See* Pet'n 15 (describing correspondence with the district court). Apple seems to think it deserves the immediate, undivided attention of one of the busiest district courts in the country. *See Betty's Best, Inc. v. Yuyao Aggpo Elec. Tech. Co.*, No. 1:22-CV-1078-RP, 2022 WL 17724417, at *3 (W.D. Tex. Dec. 15, 2022) (describing the Western District and Austin Division's caseload). Relief here would encourage Apple to file a mandamus petition in every case as soon as its transfer motion is briefed.

## CONCLUSION

This Court should deny Apple's petition for writ of mandamus.

Respectfully submitted,

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## Certificate of Service

I certify that on February 20, 2024, I electronically filed this document with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit through the Court's CM/ECF system, and a copy of this document was served this on all counsel of record via electronic mail.

*/s/ Charles E. Fowler, Jr.*
Charles E. Fowler, Jr.

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The response complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this petition contains 7,613 words. This response complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type-style requirements of Fed. R. App. P. 32(a)(6) because it was prepared in a proportionally spaced typeface using Microsoft Word in Calisto MT 14-point font.

*/s/ Charles E. Fowler, Jr.*
Charles E. Fowler, Jr.

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