Miscellaneous Docket No. 24-111

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, Hon. Alan D Albright

APPLE INC.'S NON-CONFIDENTIAL REPLY IN SUPPORT OF PETITION FOR WRIT OF MANDAMUS

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The material redacted from page 5 of the reply names confidential Apple technology.

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The district court's written transfer ruling, issued only after this Court called for responsive briefing on Apple's mandamus petition, rests on a series of clear legal and factual errors. And, rather than engaging in the evidentiary assessment required by precedent, the district court's ruling relies on speculation and accepting Carbyne's unfounded arguments, which misrepresented the actual venue record. As Apple's petition demonstrated, this is a classic case where the vast majority of likely witnesses, evidence, relevant third parties, and genuine localized interests are in the proposed transferee forum. Nothing in the district court's order or Carbyne's opposition undercuts that showing. Based on the record, the district court should have granted transfer, and this Court should grant mandamus.

I. Apple Has A Clear And Undisputable Right To The Writ.

A. The private-interest factors strongly favor transfer.

1. Witness Convenience.

There is no dispute that the witnesses responsible for the technology accused in Carbyne's complaint and preliminary infringement contentions—Carbyne's basis for filing this lawsuit—are overwhelmingly located in the Northern District of California. And there is no dispute that Carbyne's own witness is in New York and will

be inconvenienced by either potential forum. That is why the witness-convenience factor clearly favors transfer. *See* Pet. 7-8, 24-26, 29. The district court, however, weighed this factor against transfer. SAppx13. It did so through a series of clear errors that rewarded Carbyne's conjecture that leads to a forum that will be inconvenient for every witness likely to testify at an eventual trial.

To start, the district court erred in discounting the number of Apple witnesses in the Northern District of California by acknowledging only those employees who submitted declarations and ignoring their many "team members" cited in those declarations. SAppx7. Contrary to the district court's ruling (and Carbyne's claim), Apple demonstrated that those team members "possess[] knowledge of the facts relevant to this infringement action." SAppx7 (quoting *In re Google LLC*, No. 2021-170, 2021 WL 4427899, at *7 (Fed. Cir. Sept. 27, 2021)); *see also* Opp. 19-20 n.3.

Each Apple declarant who leads a team responsible for aspects of the accused technology specified the responsibilities and location of *that team*, not just themselves. *See, e.g.*, Appx226 (stating that "[t]he Data Protection Team is responsible for the software components of Apple

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products' security architecture" and that "four of the five employees in the Data Protection team is in Cupertino"); Appx233 (describing "the client-side engineering team that is responsible for designing and developing, among other products, Apple Cash and Apple Pay" and stating that all team members "who work on Apple Cash" are in Cupertino and New York); Appx252 (stating "[m]y team develops" certain "Face ID software" and 12 team members "are located in Cupertino"); Appx249 (stating "[m]y team is responsible for … marketing practices and strategies with respect to iPhone products," and her three direct reports work in Cupertino).

After improperly reducing the number of California-based witnesses, the district court further erred by relying on five Austin-based Apple employees who do not work on the technology Carbyne has accused of infringement in this case, but whom Carbyne insisted were relevant once venue became disputed. Specifically, the district court credited three employees who work on Secure Enclave technology that was accused in the *Identity Security* case but is not here, and two who work on server-side Apple Cash functions that Carbyne had not accused of infringement in its contentions. SAppx8-10; *see* Pet. 26-29.

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"A district court should assess the relevance and materiality of the information [a] witness may provide." *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009). The district court did not do so here. It articulated no basis for finding that "the scope of the claims includes novel hardware solutions in addition to software," SAppx2-3, such that hardware engineers are relevant. As Apple demonstrated (Pet. 6-7, 12), neither the patent claims nor Carbyne's infringement contentions support this characterization. Recognizing this fact is not a matter of prejudging the infringement case, as the district court suggested. SAppx2. It is a matter of avoiding "pure speculation" based on "unsupported contentions" by the party opposing transfer. *In re TikTok, Inc.*, 85 F.4th 352, 360 (5th Cir. 2023); *accord In re Apple Inc.*, No. 2021-181, 2021 WL 5291804, at *4 (Fed. Cir. Nov. 15, 2021).

The district court's speculation was particularly problematic because it depended entirely on evidence from a different case (*Identity Security*) involving different parties, different patents, and different accused technology. *See* SAppx8-9; Pet. 12, 26-28. Carbyne asserts without support that *Identity Security* involved "the same technology," Opp. 6, but it offers nothing to overcome Apple's contrary showing. And

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neither Carbyne nor the district court deals with the unrebutted testimony *in both cases* that most Secure Enclave engineers—hardware and software—are in California, not Texas. *See* Pet. 26-27; Appx236-237; Appx550. Contrary to Carbyne's criticism, Mr. Paaske did not "parrot[] Apple's view" on this point. Opp. 17. Mr. Paaske, who led the "teams responsible for designing and developing the Secure Enclave from 2011 until 2021" and has led the "Security Hardware Architecture team" since mid-2022, Appx236, provided unrebutted testimony about the location of his team members. The district court's conclusory findings did not account for this testimony.

Finally, the fact that the few Austin-based hardware engineers "[i]nterfac[e] with the software team" does not, as the district court speculated without citation, mean that they understand "how the code operates." SAppx9. The only record evidence suggests otherwise. Appx237; Appx401.

The district court's reliance on two server-side Apple Cash employees is equally indefensible. SAppx10. The district court's unexplained "understand[ing]" that [redacted] Technology and [redacted] Technology are "relevant to the fraud-detection analysis functionality that is accused by Plaintiffs,"

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SAppx10, was a clear abuse of discretion. The district court cited no basis for that "understanding," and the transfer record contains none. *See* Pet. 28-29.

Finally, the district court patently erred in concluding that two likely Apple witnesses located in neither forum weighed against transfer. SAppx12-13. The district court seems to have accepted Carbyne's unsupported, unexplained assertion in its sur-reply that San Francisco is "six percent less convenient" for Martin Šubert, who lives in Prague. Appx439. Carbyne calculated convenience based on geographic distance, Appx356, overlooking that often "the difference in distance is not as important as the difference in travel time." *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021); *see also Google*, 2021 WL 4427899, at *4. Regardless, a six percent difference in distance does not make Austin meaningfully more convenient for a Prague-based witness. *See Genentech*, 566 F.3d at 1344 (rejecting such a "rigid[]" approach). Likewise for Jacqueline Harlow, her home base in Colorado would require "only marginally less" travel time to Austin than to San Francisco. *Google*, 2021 WL 4592280, at *5. And even this marginal difference is surely offset by the fact that

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"[t]he primary place of work for [her] team is in the San Francisco Bay Area," Appx230, such that any time not spent at trial could be efficiently spent with her team.

Undoing any one of these errors would eliminate the district court's basis for weighing this factor against transfer. *See* SAppx13. And a proper assessment of likely witnesses, based on the record in this case, would result in several relevant witnesses in Northern California or outside either forum, with no witnesses in Texas and at most Mr. Jakobsson finding Texas more convenient. His marginal convenience "cannot overcome the immense inconvenience that the majority of relevant witnesses would face if this case were to be tried in Texas." *TikTok*, 85 F.4th at 361-62. This factor should have strongly favored transfer.

2. Compulsory Process.

Apple's petition demonstrated (at 11, 30-32) that the compulsory-process factor heavily favors transfer here, where Apple identified several undisputedly relevant third parties within the subpoena power of the Northern District of California and Carbyne relied on irrelevant entities just because they are in Texas. The district court's decision to

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weigh this factor "slightly against transfer," SAppx20, rested on clearly erroneous legal and factual conclusions that warrant mandamus. *See In re Volkswagen of Am., Inc.*, 545 F.3d 304, 310 (5th Cir. 2008) (en banc).

First, the district court rejected Apple's reliance on unquestionably relevant third-party entities, including owners of system prior art, because Apple did not "specifically identify" the individual "people" at those companies who might have relevant information. SAppx19. This Court has rejected identical reasoning, holding that "[t]he district court erroneously discounted [relevant] third parties when it faulted Apple for not identifying any specific employees of those entities." *Apple*, 2021 WL 5291804, at *3; *see also In re HP Inc.*, 826 F. App'x 899, 903 (Fed. Cir. 2020) (finding "no basis to discount" named entities "just because individual employees were not identified"). Carbyne defends the district court's reasoning but fails to reconcile it with this Court's caselaw. *See* Opp. 23. Carbyne's own cited authority is not to the contrary. In that case, this Court faulted a party seeking transfer for failing to identify which of *its own employees* were likely witnesses—not for failing to name individual third-party

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employees. *See In re Meta Platforms, Inc.*, No. 2023-143, 2023 WL 7118786, at *1 (Fed. Cir. Oct. 30, 2023).

Absent this clear legal error, the district court should have weighed the availability of compulsory process over Think Computer Corp., Tablet Kiosk, PayPal, and DigitalPersona—all owners of system prior art charted in Apple's invalidity contentions, and all located in California, *see* Appx212, Appx402-403—as favoring transfer. The district court did not and could not find that Apple failed to identify the relevant information held by the companies, as opposed to any individual employee. *See* SAppx19. This is undisputed for Think Computer and Tablet Kiosk. As to PayPal, while the individuals who worked with Dr. Jakobsson (and thus have information about the development of the asserted patents) may be evenly split between California and Texas, SAppx19, PayPal itself is a system prior-art owner and is headquartered in San Jose, California. Appx578. As to DigitalPersona, Carbyne did not, as it claims (at 23), "offer[] evidence" that relevant witnesses "were likelier located at Digital Persona's corporate headquarters *in Austin*." Its cited "evidence" consists of (1) an office listing for DigitalPersona's corporate parent, HID, SAppx174-179,

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and (2) information about DigitalPersona that does not mention geography, SAppx180-191. Apple, in contrast, demonstrated that DigitalPersona itself is located in Redwood City, California. Appx402-403; Appx585-586.

The district court's second error was a factual one. Apple cited two former owners of the asserted patents, Extricatus and RightQuestion, as third-party witnesses. Pet. 11. The district court rejected these entities, stating that they "no longer exist" and so "no longer have relevant records." SAppx19. That may be true as to Extricatus, but as Dr. Jakobsson himself acknowledged, RightQuestion "still exist[s]." Appx373. Indeed, RightQuestion earlier this month filed two patent-infringement lawsuits asserting other patents naming Dr. Jakobsson as the inventor—and confirming, as Apple demonstrated, that RightQuestion is located in Menlo Park, California. *RightQuestion, LLC v. Verizon Commc'ns Inc.*, No. 2:24-cv-00091-JRG, Dkt. 1 ¶¶ 4, 7 (E.D. Tex. Feb. 9, 2024); *RightQuestion, LLC v. AT&T Inc.*, No. 2:24-cv-00094-JRG, Dkt. 1 ¶¶ 4, 7 (E.D. Tex. Feb. 12, 2024); *see* Appx212-213; Appx403.

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Third, the district court legally erred by overvaluing the significance of 1Password, a third-party app developer that uses Apple's accused technology. SAppx20. Neither the district court nor Carbyne has identified any reason to believe that 1Password has relevant information that other app developers (who would infringe under Carbyne's theory) would not. *See* Pet. 31. Carbyne responds that this "does not negate 1Password's relevance." Opp. 22. But this Court has rejected a similarly arbitrary focus on *some* infringing parties under the local-interest factor. *See, e.g.*, *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009). And treating third parties like this as relevant simply encourages plaintiffs to manipulate venue by, as Carbyne did, strategically naming only certain users of the accused technology in a complaint. Appx19; *see Van Dusen v. Barrack*, 376 U.S. 612, 623 (1964) (§ 1404(a) should not be applied to allow "parties opposed to transfer, by means of their own acts or omissions, to prevent a transfer otherwise proper").

Even if the district court was right to credit 1Password, however, its presence in Texas is clearly outweighed by the numerous relevant third parties in California that the district court wrongly discounted

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based on its first legal error. With or without 1Password, therefore, the district court clearly abused its discretion in refusing to weigh the compulsory-process factor heavily in favor of transfer. *See, e.g.*, *In re Apple Inc.*, 581 F. App'x 886, 889 (Fed. Cir. 2014).

3. Sources of Proof

The district court's conclusion that this factor is neutral was a clear abuse of discretion warranting mandamus. Even under the district court's flawed reasoning, its recognition that there are more relevant documents in the Northern District of California than in the Western District of Texas means that this factor should have favored transfer. *Apple*, 2021 WL 5291804, at *2.

But the district court's assessment that only "slightly more" relevant documents are in California, with "relevant third-party documents" in Austin, SAppx17, turned on patently erroneous reasoning. First, the district court's conclusion that Apple's Austin-based employees have relevant documents—a conclusion it seems to have based entirely on the *Identity Security* case, *see* SAppx14-15—was flawed for the reasons discussed above (at 3-4).

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Second, the district court's rejection of Apple's sworn testimony regarding the location of physical documents was a clear abuse of discretion. The district court rejected Ms. Harlow's testimony that physical records are in the Bay Area and Boulder because "Ms. Harlow does not work in the Bay Area office." SAppx15. But as Ms. Harlow explained, most of the team she supervises *does* work in the Bay Area. Appx230. The district court offered no reason to doubt Ms. Harlow's knowledge of where her team stores its records. Similarly, the district court discounted Mr. Paaske's testimony as "vague." SAppx15. But this Court has rejected similar criticism as "unjustified." *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1321 (Fed. Cir. 2021). It is equally unjustified here. Mr. Paaske described the work his team performs on the "design and development of the Secure Enclave" and explained that they store "physical records" and "electronic records (including source code)" at their primary workplaces, which is Northern California for "the majority" of the team. Appx236; Appx238.

It was especially arbitrary to discount Apple's sworn declaration about the location of relevant documents while simultaneously accepting Carbyne's unsupported and non-specific assertion that

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"Austin is a likely source of 1Password evidence." Appx364. The district court treated hypothetical 1Password evidence as decisive for this factor, SAppx16-17, yet neither Carbyne nor the district court articulated *what* documents 1Password (just one of many of the technology's users) might have or why they would be particularly relevant. *See supra* 11-12.

Finally, this Court should not accept Carbyne's invitation to credit even more alleged evidence in Texas than the district court accepted. *See* Opp. 26-27. That is not an argument that the district court's findings were patently erroneous, but an argument for additional findings that the district court never made. Carbyne cannot simultaneously request new appellate factfinding while insisting that such factual questions are "entrusted to the district court" (Opp. 2) when it favored Carbyne.

4. Practical Problems

The district court correctly found this factor neutral. SAppx21. Carbyne argues that the district court erred by overlooking the "substantial progress in the case." Opp. 27. Not only is that progress irrelevant to the transfer analysis, *see In re TracFone Wireless, Inc.*, 848

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F. App'x 899, 901 (Fed. Cir. 2021), but the cited milestones are the very ones that Apple sought to avoid passing before transfer was resolved, *see* Pet. 34.

B. The public-interest factors favor transfer.

1. Local Interests

Apple demonstrated that the local-interest factor favors transfer because the Northern District of California has "significant connections" with "the events that gave rise to [the] suit." *In re Apple Inc.*, 979 F.3d 1332, 1344-45 (Fed. Cir. 2020); *see* Pet. 35. Four of the five accused Apple technologies were developed by teams based in Cupertino (with the fifth developed by a team based in Prague), and the asserted patents were also developed in the Northern District of California. Pet. 5-8.

The district court found this factor neutral by disregarding those "relevant events leading to the infringement claims," *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1380 (Fed. Cir. 2021). The bare fact that "Apple has an office in Austin," SAppx23, cannot create a local interest in *this case*. *See Apple*, 2021 WL 5291804, at *5 (noting this Court has

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"repeatedly rejected" reliance on party's general presence to create local interest).

The district court also found that both forums have a local interest because "some individuals who worked on the accused product are likely located" in California and "multiple individuals … who work on the Secure Enclave technology" are in Austin. SAppx23. That analysis improperly collapses the local-interest factor into the witness-convenience and other private-interest factors, "essentially render[ing] this factor meaningless." *Hoffmann-La Roche*, 587 F.3d at 1338 (faulting district court for reducing local-interest factor to redundancy with private-interest factors). The local-interest factor concerns where the design of the accused products or development of the patents took place. *See Apple*, 979 F.3d at 1346 (deeming it error to "focus[] exclusively" on defendant's questionably relevant Austin-based employees "to the exclusion of all other employees and activity").

The district court also erred in finding that the assembly of the Mac Pro in Austin "provides further localized interest." SAppx23. Apple already explained why this is wrong. *See* Pet. 36-37. Carbyne fails to distinguish this Court's prior endorsement of giving "little

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weight" to the Mac Pro's assembly in Austin. *Apple*, 979 F.3d at 1351-52. Carbyne asserts that the Court "was talking about the location of a third-party manufacturer (Flextronics), not the defendant." Opp. 29. But Flextronics (also called "Flex") is the entity that assembles the Mac Pro in Austin for Apple; indeed, Carbyne's transfer opposition relied on a case saying exactly that. Appx367; *see STC.UNM v. Apple Inc.*, No. 6:19-CV-00428-ADA, 2020 WL 4559706, at *5 (W.D. Tex. Apr. 1, 2020) (referring to "Apple's manufacturer for the Mac Pro in Austin, Flex Ltd."). Regardless, the manufacturing location of a single accused product matters little to the local-interest analysis. Here, the fact that "both the patented and accused technology were developed" in the Northern District of California should have tipped the scales in favor of transfer. *In re Google LLC*, 58 F.4th 1379, 1384-85 (Fed. Cir. 2023).

2. Court Congestion

The district court properly found the court-congestion factor neutral because Carbyne "does not engage in product competition." SAppx21. That finding was required by this Court's precedent. *See Google,* 58 F.4th at 1383; Pet. 37-38.

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Carbyne nonetheless resists it, arguing that this factor "disfavors transfer" because the district court "has determined that it has a six-month time-to-trial edge over the Northern District of California." Opp. 29. This Court, however, has explained that "the Western District of Texas and the Northern District of California show no significant differences in caseload or time-to-trial statistics." *Juniper*, 14 F.4th at 1322. And, contrary to Carbyne's argument (at 30), nothing in *TikTok* (which was not a patent case) conflicts with this Court's precedent. 85 F.4th at 363-64 & n.13 (finding clear abuse of discretion in weighing this factor against transfer).

II. Mandamus Is Appropriate Under The Circumstances.

This Court has consistently deemed mandamus appropriate when, as here, the district court has committed a clear abuse of discretion in assessing the § 1404(a) factors. Pet. 41. Yet Carbyne offers two arguments for why mandamus is inappropriate even if the Court agrees with Apple. Neither argument has merit.

First, Carbyne says that "Apple would suffer no hardship" from litigating in Austin because it "is a major economic force" there; "defends patent suits in the Western District of Texas all the time"; and

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includes "many Western District regulars" among its so-called "army of lawyers." Opp. 31. None of the few facts buried within these barbs has anything to do with the § 1404(a) inquiry or this Court's mandamus review. The location of a party's counsel, for example, "is irrelevant and improper for consideration in determining the question of transfer of venue." *In re Horseshoe Ent.*, 337 F.3d 429, 434 (5th Cir. 2003). Section 1404(a) does mandate consideration, however, of the effects on the lives of the individual employees (not just Apple, the corporation) who will be forced to travel for trial, and of the interests of the local community who will be called to serve as jurors. *See, e.g.*, *Volkswagen*, 545 F.3d at 317-18. Carbyne's argument ignores the very factors the statute requires courts to consider. Indeed, Carbyne's focus on Apple's general presence in Austin "improperly conflate[s] the requirements for establishing venue under 28 U.S.C. § 1400(b) and the requirements for establishing transfer under § 1404(a)." *Apple*, 979 F.3d at 1346.

Carbyne's second argument fares no better. Carbyne criticizes Apple's supposed "impatience in seeking mandamus before the district court entered its order." Opp. 32. Respectfully, Apple is not responsible for any wasted resources resulting from Carbyne having to begin

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preparing its mandamus opposition without the benefit of a written transfer order. *Contra id.* Apple agreed to go forward with the *Markman* hearing solely based on the district court's representation that its transfer ruling would issue the next day—that is, December 13, 2023. Appx475; *see* Pet. 38. Once the district court had missed several stated deadlines for issuing the order, Apple tried to avoid an unnecessary mandamus petition by seeking a stay until the transfer order issued. *See* Pet. 15-17. Carbyne opposed that stay, insisting (on January 24) that a written transfer order was "imminen[t]." Appx534. But it was not.

This Court has been emphatically clear that district courts must afford transfer motions "top priority" and should not, for example, hold *Markman* hearings and issue claim constructions before resolving transfer. *See Apple*, 979 F.3d at 1337-38; Pet. 19-21 (collecting cases). Yet that is functionally what the district court did here. Meanwhile, Apple was faced with precedent requiring parties to seek mandamus promptly after a transfer ruling—which, technically, had happened here on December 12. *See In re Microsoft Corp.*, No. 2023-128, 2023 WL 3861078, at *1 n.* (Fed. Cir. June 7, 2023) (considering challenge that

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party had delayed unreasonably by allowing 69 days to pass between "transfer decision" and mandamus petition). Apple waited 50 days after the oral denial of transfer to seek mandamus, and even then it stressed that it "would have preferred to await a written transfer ruling before seeking relief in this Court." Pet. 23.

Carbyne insists that Apple should have waited "a few more days." Opp. 32. But nearly two more weeks passed between the filing of Apple's petition and the district court's written ruling. Only after this Court issued a call for responsive briefing and stated its expectation "that the district court is expeditiously working to issue its decision," Dkt. 6 at 2, did the district court finally provide a written ruling—and even then, it took nearly another week to do so.

Apple agrees with Carbyne that the process in this case is not desirable. But the district court's failure to give transfer the priority this Court's precedent demands, and the resulting inconvenience to the parties and this Court, makes mandamus more—not less—appropriate.

CONCLUSION

The Court should grant the petition and direct the district court to grant transfer.

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CERTIFICATE OF COMPLIANCE

The reply complies with the type-volume limitation of Fed. Cir. R. 21(b) because this reply contains 3897 words.

This reply 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 this reply has been prepared in a proportionally spaced typeface using Microsoft Word for Microsoft 365 in Century Schoolbook 14-point font.

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CERTIFICATE OF CONFIDENTIAL MATERIAL

The reply contains 0 unique words and numbers marked as confidential, not previously marked in this case's briefing.

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