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

CARBYNE BIOMETRICS, LLC, **Plaintiff,** **v.** **APPLE INC.,** **Defendant.**	**No. 1:23-CV-00324-ADA** **JURY TRIAL**

PLAINTIFF CARBYNE BIOMETRICS, LLC'S RESPONSE TO DEFENDANT APPLE, INC.'S MOTION TO TRANSFER VENUE UNDER 28 U.S.C. § 1404(a)

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I. INTRODUCTION

Carbyne sued Apple in its second largest United States hub: Austin, Texas. Ex. 6. Apple employs more than 7,000 Austinites—making it Austin's seventh-largest employer—and its Austin footprint keeps growing. Exs. 7, 8. In a prior case accusing the same technology, Apple successfully moved to transfer venue *to Austin*, pointing to Austin-based Apple engineers whose testimony will be just as relevant here. Those Austin-based engineers helped develop the accused technology, and Apple builds an accused product here too. Many witnesses, Apple records, and nonparty information sources are more accessible here than in N.D. Cal.

Two themes pervade Apple's motion. First, Apple artificially narrows the scope of relevant information sources (like Apple employees and nonparties) to avoid Texas ties. Second, Apple cherry-picks potentially relevant information sources (like Apple employees and prior art) to exaggerate California ties. But Apple cannot unilaterally decide what evidence would be relevant to Carbyne's allegations at trial. Apple's arguments rest largely on merits issues related to the scope of the asserted claims, whether the accused products infringe, and how. Those issues are premature at this stage. Apple cannot carry its burden of showing that N.D. Cal. would be not just more convenient but *clearly* so. This Court should deny Apple's motion.

II. BACKGROUND

Carbyne filed this case in the Austin Division.[1] 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. 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

[1] This case was first assigned to Judge Yeakel but, when he retired, reassigned to Judge Albright. ECF No. 13.

device's main processor. 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.

The Authentication Patents claim not just software code but also novel hardware configurations. They disclose a dedicated processor accessible only over a restricted interface, which limits access to sensitive data. 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." Ex. 9, '512 Patent 10:62–11:3. 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." *Id.* Apple's products infringe this hardware configuration by including an Application Processor (first processor) and Secure Enclave Processor (second processor). Ex. 10, "Ex. A" at 4, 8–10 & "Ex. B" at 6, 15–28.

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

III. ARGUMENT

Regional circuit law governs a motion to transfer venue in a patent case. *In re Monolithic Power Sys., Inc.*, 50 F.4th 157, 161 (Fed. Cir. 2022). The Fifth Circuit's transfer analysis takes two steps. First, the court "ask[s] whether the case 'might have been brought' in the destination venue." *In re Planned Parenthood Fed. of Am., Inc.*, 52 F.4th 625, 630 (5th Cir. 2022) (quoting 28 U.S.C. § 1404(a)).[2] Second, the court "weigh[s] the private and public interest factors to determine whether the destination venue is 'clearly more convenient.'" *Id.* (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc)).

A defendant always endures some inconvenience from getting sued. *Id.* at 629. So "the fact that litigating would be more convenient for that defendant elsewhere is not enough to justify transfer." *Id*. Rather, Apple must show "good cause for transfer based on convenience and justice." *Id.* (quotation marks omitted). Otherwise, "the standard [would] have no real or practical meaning." *Rafqa Star, LLC v. Google LLC*, No. 6-22-CV-01207-ADA, 2023 WL 6050593, at *2 (W.D. Tex. Sept. 15, 2023) (quotation marks omitted).

A. The private-interest factors disfavor transfer.

1. The cost for willing witnesses to attend trial disfavors transfer.

Witness convenience carries the most weight in the transfer analysis. *In re Apple Inc.*, 818 F. App'x 1001, 1003 (Fed. Cir. 2020) (citing *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009)). When the existing and proposed venues are more than 100 miles apart, "the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled." *Volkswagen*, 545 F.3d at 317; *see also In re Radmax, Ltd.*, 720 F.3d 285, 289 (5th Cir.

[2] The parties agree that this suit "might have been brought" in N.D. Cal. *See* Mot. 8.

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2013) (explaining that the 100-mile rule gives this factor "greater significance when the distance is greater than 100 miles").

Markus Jakobsson is the sole inventor of the Asserted Patents. *E.g.*, Ex. 9 at 1. [redacted]. Jakobsson Dep. 28:5–28:11, 60:1–18. Jakobsson lives in [redacted] *id.* at 11:14–16, about 1,500 miles from Austin but more than 2,600 miles from San Francisco—70 percent farther. So under the Fifth Circuit's 100-mile rule, the inconvenience of testifying in San Francisco is 70 percent more than in Austin. *See Volkswagen*, 545 F.3d at 317. Even under the Federal Circuit's less "rigid" application of the 100-mile rule, the longer bicoastal flight from New York City to San Francisco would make testifying in San Francisco at least "slightly more inconvenien[t]." *See In re Apple Inc.*, 979 F.3d 1332, 1342 (Fed. Cir. 2020).

As for Apple's witnesses, this Court held that Austin-based engineers Le Roy, Peeters, and Herbeck were relevant in a prior case accusing Secure Enclave technology. Order at 7, *Identity Sec. LLC v. Apple, Inc.*, No. 6:21-CV-00460-ADA (W.D. Tex. Jan. 20, 2022), ECF No. 55 (*Identity Sec.* Order). Apple moved to transfer that case from Waco to Austin. Motion to Transfer, *Identity Sec. LLC v. Apple, Inc.*, No. 6:21-CV-00460-ADA (W.D. Tex. Sept. 10, 2021), ECF No. 27. Apple claimed that "[t]he team responsible for designing and developing the Secure Enclave technology includes two Austin-based engineers who are responsible for defining the security architecture specifications for Secure Enclave and one Austin-based engineer who is responsible for the design specifications for Secure Enclave." *Id*. at 2. Apple argued that Austin was convenient for these witnesses since "they could remain home during trial or any proceeding in which their attendance is necessary." *Id*. at 7.

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This Court agreed and weighed these Austin-based witnesses in favor of transfer to Austin. It rejected the "assertion that key decision-making is done in California and not in Austin." *Identity Sec.* Order at 8. Rather, Apple witnesses testified, and this Court found, that Herbeck is the lead design engineer for Secure Enclave, giving him "superior knowledge of the accused technology compared to other members of his team." *Id.*; [redacted] 14:6–16; [redacted] 28:6–10. Similarly, [redacted] *Identity Sec.* Order at 7; [redacted] 14:18–25; [redacted] 10:11–13, 10:25–11:9. In short, these witnesses helped develop the accused technology and so have relevant knowledge of it.

Apple cannot avoid the position it took in *Identity Security* by claiming that these Austin-based engineers work only on Secure Enclave *hardware* while Carbyne's patents claim *software*. *See* Mot. 2, 4–5, 12. For one thing, [redacted] 17:11–21, 23:6–10, 24:7–22; [redacted] 10:24–11:6, 16:8–16, 35:1–19. At any rate, the Authentication Patents read on Secure Enclave's hardware configuration as described in Carbyne's infringement contentions. *See supra*, Part II.

To draw Apple's hardware-software distinction, the Court would have to decide the scope of the claims and accused technology and assess infringement—merits issues. A court deciding a venue-transfer motion should not consider these merits issues before the parties have completed discovery. *Apple*, 818 F. App'x at 1004. This Court has thus rejected an attempt to "limit the scope of relevant information" at the venue stage by "erroneously narrow[ing] the scope of relevant accused technology." *Rafqa Star*, 2023 WL 6050593, at *4, *7. The Court called it "troubling," "baseless," and "improper" for Google to exclude witnesses by calling product features "irrelevant" and "not accused." *Id.* at *4; *see also DoDots Licensing Sols. LLC v. Samsung Elecs.*

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Co., No. W-22-CV-00535-ADA, 2023 WL 4939394, at *5 (W.D. Tex. Aug. 2, 2023) (rejecting Samsung's claim that a Samsung employee identified by the plaintiff lacked relevant knowledge). The same goes for Apple's attempt to exclude Austin-based Secure Enclave engineers.

Austin-based Apple employees are also relevant to the accused Apple Cash platform. Apple identified as relevant—and so produced—documents related to [redacted] Burks Dec. ¶ 7. Those documents identify relevant Austin-based employees, including [redacted] and [redacted]. *Id.* ¶ 7 & Exs. 4, 5, 30. Similarly, an Apple witness identified [redacted] as an Austin-based employee responsible for [redacted] source code. [redacted] Dep. 20:6–20, 29:16–30:4; Ex. 30. Apple acknowledges having "Austin Apple Cash employees" who "focus" on the server side but calls them "irrelevant" because Carbyne's patents claim "client-side" features. Mot. 5.[3] Here again, Apple tries to prematurely narrow the scope of the accused technology before full discovery has shown where all the accused fraud-detection steps occur. *See Apple*, 818 F. App'x at 1004; *Rafqa Star*, 2023 WL 6050593, at *4. Apple's document production suggests that server-side functions are relevant to the infringement analysis. So Apple cannot exclude its Austin-based Apple Cash employees from the venue-transfer analysis by simply denying their relevance.

For its part, Apple identifies seven purportedly "likely trial witnesses," including five in N.D. Cal., one in Colorado, and one in Prague, Czech Republic. Mot. 2–4. But Apple fails to show that they are likelier witnesses than its Austin employees. Most of the purported technical witnesses never reviewed Carbyne's complaint, the Asserted Patents, or the parties' contentions

[3] Apple offers only attorney argument on this point. Its declarant [redacted]. Mot. 5 (citing [redacted] Dec. ¶ 3–4, 7).

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before deposition preparations. [redacted] Dep. 13:21–14:11; [redacted] Dep. 10:10–18; [redacted] Dep. 9:20–10:9. One said he was not asked whether he thought he was relevant. [redacted] Dep. 26:17–20. Another said he was not sure what technology was accused. [redacted] Dep. 11:3–6. Apple's licensing witness had not reviewed the patents or contentions and [redacted]. [redacted] Dep. 14:15–20, 20:19–21. Apple's marketing witness had never taken part in marketing most of the accused technology. [redacted] Dep. 50:5–51:25. And Apple's sales-and-finance witness worked with people in Texas on her declaration and deposition preparations. [redacted] Dep. 10:15–21, 41:23–46:16.

Last, while given "little weight," *Marble VOIP Partners LLC v. RingCentral, Inc.*, No. W-22-CV-00259-ADA, 2023 WL 3938480, at *8 (W.D. Tex. June 9, 2023), *mand. denied*, *In re Ringcentral, Inc.,* No. 2023-139, 2023 WL 6368336 (Fed. Cir. Sept. 29, 2023), Apple's technical expert is in W.D. Tex. Burks Dec. ¶ 8.

In sum, Austin would be more convenient for Carbyne's fact witness, six Apple fact witnesses, and Apple's expert. Apple cites just five party witnesses in N.D. Cal. Most showed little grasp of the relevant facts, let alone relevant knowledge that its Austin employees would lack. For Apple's possible witnesses in Colorado and Prague, neither W.D. Tex. nor N.D. Cal. would be more convenient. Because "more relevant witnesses would find this District more convenient," *see Rafqa Star*, 2023 WL 6050593, at *3, party witness convenience disfavors transfer.

2. The availability of compulsory process disfavors transfer.

This factor "focuses on non-party witnesses whose attendance may need to be secured by a court order." *Rafqa Star*, 2023 WL 6050593, at *6. It matters less when the movant does not claim or show "that any witness would be unwilling to testify." *Planned Parenthood*, 52 F.4th at

630–31. Apple lists all nonparties under this factor without claiming that any would be unwilling. *See* Mot. 13. For that reason alone, Apple does not carry its burden on this factor.[4]

Anyway, N.D. Cal. lacks an advantage in trial-subpoena power. Take prior-art witnesses. While prior-art witnesses "rarely testify at trial," *EcoFactor, Inc. v. Google LLC*, No. W-22-CV-00032-ADA, 2022 WL 17169178, at *9 (W.D. Tex. Nov. 1, 2022), Federal Circuit cases foreclose ignoring them, *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1319 (Fed. Cir. 2021). Even so, the likeliest witnesses for Digital Persona—one of Apple's four primary references for the Authentication Patents—are in Austin. *See* Ex. 11 at 15, 24, 44, 61. Digital Persona is owned by HID, which has its headquarters for the Americas in Austin. Exs. 12–14. Sure, Apple cherry-picks two other prior-art sources purportedly based in N.D. Cal.: Tablet Kiosk (for the Authentication Patents) and Think Computer (for the Fraud Detection Patents). Mot. 2, 6, 10, 13; Ex. 11 at 14, 16. But Apple neither specifies people likely to testify for these companies (or their locations), nor explains why they are likelier trial witnesses than Austin-based HID employees. *See VoIP-Pal.com, Inc. v. Google LLC*, No. 6:21-CV-00667-ADA, 2022 WL 2068254, at *4 (W.D. Tex. June 8, 2022) ("discount[ing] the likelihood that Google will call its 'cherry picked' prior art witnesses" from a list of many references).

Apple's other 100-plus unidentified "prior art inventors, authors, and assignees," Mot. 13, carry no weight since the Court should "not base its conclusion on unidentified witnesses." *Parity Networks, LLC v. Juniper Networks, Inc.*, No. 6:17-CV-495-KNM, 2018 WL 9539505, at *2 (E.D. Tex. Aug. 10, 2018); *see also 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) (discounting a purportedly

[4] This Court has noted Federal Circuit case law presuming that nonparties are unwilling. *Rafqa Star*, 2023 WL 6050593, at *6 (citing *In re HP Inc.,* No. 2018-149, 2018 WL 4692486 (Fed. Cir. Sept. 25, 2018)). But it has recognized that controlling Fifth Circuit precedent undermines that presumption. *Id.*

"important (but as yet unidentified) third-party witness as to prior art"). Anyway, Apple's prior-art tally would show only that references are widely scattered, favoring no venue.

Apple also points to possible PayPal witnesses, who, Apple says, may testify that PayPal owns the Asserted Patents. *See* Mot. 5–6, 10, 13. But when Apple refers to "PayPal's former witness," it means PayPal's *document custodian* in a prior case asserting some of the same patents against Samsung. Exs. 2, 3. That person would unlikely testify on patent ownership here. The two former PayPal employees who know most about Jakobsson's work there ([redacted]) are in Austin (within this Court's subpoena range) and [redacted] (within neither court's). Jakobsson Dep. 91:11–13, 95:7–17, 95:24–96:12. Anyway, Apple would unlikely call a PayPal witness at trial. PayPal has never claimed ownership of the Asserted Patents even though, in March 2022, Samsung took the same nonparty discovery of PayPal as Apple now proposes. Burks Dec. ¶ 5.

Last, Apple points to Carbyne's predecessors, Extricatus and RightQuestion. *See* Mot. 6–7, 13. But this Court does not count predecessors that lack relevant employees or records. *Smart Mobile Techs. LLC v. Samsung Elecs. Co.*, No. W-21-CV-00701-ADA, 2023 WL 5918324 (W.D. Tex. Sept. 11, 2023). Extricatus no longer exists and has no relevant records, as it was dissolved around 2010. Jakobsson Dep. 17:10, 17:14–20, 89:8–25. RightQuestion too transferred the Asserted Patents and all relevant records to Carbyne [redacted] *Id.* at 17:24–22:11, 90:23–91:6; [redacted] Dec. ¶¶ 3–4.[5]

In sum, Apple fails to show that N.D. Cal. would have more subpoena power than W.D. Tex. Prior-art witnesses are as likely located within this Court's (or neither court's) subpoena

[5] Apple suggests that "Carbyne LLC" is another predecessor. Mot. 6–7. [redacted]. Jakobsson Dep. 20:14–18, 24:16–25:8.

range as within N.D. Cal.'s, PayPal witnesses are likelier within this Court's subpoena range, and Carbyne's predecessors are irrelevant. Even if moving the case to N.D. Cal. would bring *some* California nonparties within subpoena range, it would take more out. *Cf. Volkswagen*, 545 F.3d at 316 (considering that the proposed venue would have subpoena power over *all* nonparties). So this factor disfavors transfer.

3. Access to sources of proof disfavors transfer.

This factor focuses on "where documentary evidence, such as documents and physical evidence, is stored." *Rafqa Star*, 2023 WL 6050593, at *7. To carry its burden, Apple must show "the existence of relevant sources of proof, not merely an expression that some sources likely exist," and a district court "err[s] by uncritically accepting conclusory assertions." *Def. Distributed v. Bruck*, 30 F.4th 414, 434 (5th Cir. 2022). The location of evidence carries much more weight when the evidence is physical rather than electronic. *Planned Parenthood*, 52 F.4th at 630; *see also In re Gen. Motors Co.*, No. 2023-105, 2023 WL 355108, at *2 (Fed. Cir. Jan. 23, 2023) (crediting the district court's finding that "evidence stored electronically on data centers" in another district could be accessed in W.D. Tex.).

Apple fails to prove that evidence in its possession is more accessible from N.D. Cal. than W.D. Tex. In *Identity Security*, the prior case accusing Secure Enclave technology, Apple "identifie[d] the security architecture specifications and the design specifications of the Secure Enclave technology as relevant documentary evidence." Order at 4–5. And Apple's witnesses testified [redacted]. [redacted] Dep. 30:7–14, 31:4–10, 36:6–18; [redacted] Dep. 29:3–30:2; [redacted] Dep. 35:16–20. This Court further found "that at least some physical documents are stored in the Austin Apple offices or in the Austin residences of the employees." *Identity Sec.* Order at 5 (citing Kim

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Dep. 33:22–34:20). This Court weighed access to Apple evidence in favor of moving the case to Austin. *Id.* Since Carbyne accuses the same technology here, the same evidence is relevant.

In contrast, Apple identifies no specific physical evidence stored in N.D. Cal. *See* Mot. 8–9. In like circumstances, this Court has discounted conjectural claims based on testimony about where "documents are normally created and maintained," explaining that the testimony failed to "identify actual documents" needed for trial. *Rafqa Star*, 2023 WL 6050593, at *8; *see also Marble*, 2023 WL 3938480, at *8 (noting the defendant's "fail[ure] to identify any specific physical evidence that is likely needed for trial").

Apple also fails to show that "need-to-know" policies limit its Austin employees' access to evidence. Apple cites an unpublished case suggesting that electronic evidence may be more accessible in one district just because accessing it another would require giving login credentials to employees there. Mot. 9 (citing *In re Apple Inc.*, No. 2021-181, 2021 WL 5291804, at *2 (Fed. Cir. Nov. 15, 2021)). But controlling Fifth Circuit precedent has corrected that suggestion, taking the commonsense view that courts should ask whether a given venue would require moving *physical* evidence. *Planned Parenthood*, 52 F.4th at 630. Apple stipulates that, [redacted]. Ex. 15. And Apple's *Identity Security* witnesses confirmed that they [redacted] Dep. 31:4–10; [redacted] Dep. 35:8–20. Apple's witnesses here claim that they are "not aware of" Austin employees with access to relevant code. [redacted] Dec. ¶ 5; [redacted] Dec. ¶ 4; [redacted] Dec. ¶ 4. But they neither directly refute Apple's *Identity Security* testimony nor state that it would be inconvenient to give credentials to more Austin personnel.

Next, Apple unduly dismisses as "irrelevant," Mot. 13, the nonparty sources of proof cited in Carbyne's complaint. Carbyne will seek discovery from 1Password because Apple induces

widespread infringement by 1Password. 1Password is a third-party app developer whom Apple gives development tools enabling its apps to use Apple security features like Secure Enclave. Exs. 16, 17. And while 1Password is a Canadian company, its Austin-area employees include at least its Director of Engineering, Head of Passwordless, Engineering Manager, Senior iOS Developer, and others. Exs. 18–25. So Austin is a likely source of 1Password evidence. Similarly, Finisar produces VCSEL components for the accused Apple products in Sherman, Texas. Exs. 26–28. Apple argues—without support or analysis—that the asserted "claims do not concern or accuse the VCSELs." Mot. 13. But Apple boasts that VCSELs "power some of Apple's most popular new features" like "Face ID," an accused feature here. Ex. 27 at 2. Because Finisar makes this key part of the accused products in Texas, it likely has relevant information. Yet again, Apple tries to prematurely narrow the accused technology before full fact discovery opens. *See Rafqa Star*, 2023 WL 6050593, at *4.

Last, Apple points again to PayPal, *see* Mot. 10, but identifies no PayPal evidence stored in N.D. Cal. PayPal unlikely has *any* relevant evidence. *See supra*, Part III.A.2. And, to repeat, Samsung already took the discovery from PayPal that Apple now proposes in a prior case asserting some of the Asserted Patents. [redacted]. Burks Dec. ¶ 5 & Exs. 2, 3. Counsel for Carbyne's predecessor (RightQuestion) then stored PayPal's documents in counsel's Austin office. Burks Dec. ¶ 5. *See Paltalk Holdings, Inc. v. Sony Comput. Ent. Am. Inc.*, No. 2:09CV274-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 where 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"). Thus, any relevant PayPal documents are stored in Austin, Apple specifies no relevant docu-

ments not produced in the prior case, and none likely exist. Carbyne has already produced PayPal's documents to Apple. Burks Dec. ¶ 5.[6]

In sum, this Court has found that Apple has evidence in this district relevant to Secured Enclave. In contrast, Apple specifies no relevant physical evidence in N.D. Cal. and fails to show that source code is more accessible there. Nonparty sources of proof are at least as accessible in W.D. Tex. This factor disfavors transfer.

4. Other practical concerns disfavor transfer.

Fifth Circuit precedent defeats Apple's claim that progress in this case is "irrelevant." Mot. 14 (citing *In re TracFone Wireless, Inc.*, 848 F. App'x 899 (Fed. Cir. 2021)). The Fifth Circuit recently considered that the defendant moved to transfer seven months into the case, months into discovery and after the district court had denied a motion to dismiss. *Planned Parenthood*, 52 F.4th at 631. That the case was "timely proceeding to trial further counsel[ed] against transfer." *Id.*; *cf. In re ZTE Corp.*, No. 2022-122, 2022 WL 1419605, at *1 (Fed. Cir. May 5, 2022) (holding that the district court did not err in considering that the case was "proceeding 'at a relatively fast pace,' including that claim construction briefing had finished, fact discovery had progressed for months, and the district court had resolved several discovery disputes").

The substantial litigation completed here weighs against transfer. Apple waited until almost four months after Carbyne filed its complaint to seek a change of venue. In that time, the parties exchanged preliminary infringement and invalidity contentions and briefed Apple's motion to dismiss, and the Court held a case-management conference. The parties agreed to an early exchange of key technical, invalidity, and standing documents. Burks Dec. ¶ 3 & Ex. 1. By mid-

[6] Apple repeats its points about prior-art witnesses and Carbyne's predecessors under the sources-of-proof factor. *See* Mot. 13. They do not favor transfer for the reasons stated above. *See supra*, Part III.A.2.

August, the parties had exchanged almost 7,000 documents, with Carbyne producing almost 27,000 pages and Apple producing more than 600,000. *Id.* ¶¶ 4–6. *Markman* briefing has opened and will close in just over a month, with a hearing set for December 6, 2023. ECF No. 33 at 2. The case is "timely proceeding to trial," *Planned Parenthood*, 52 F.4th at 631, which is set for December 2024, ECF. No. 33 at 4. Transfer to N.D. Cal. would delay trial by many months, especially given that court's longer time to trial. *See infra*, Part III.B.1.

Besides the progress made in the case, transfer to N.D. Cal. would generally inflate cost. This Court has credited evidence "that San Francisco is 'the world's most expensive place for visitors to spend the night.'" *SVV Tech. Innovations, Inc. v. Asustek Comput. Inc.*, No. 6:22-CV-311-ADA, 2023 WL 2764761, at *5 (W.D. Tex. Apr. 3, 2023). It has thus found "that the cost of attendance in Waco, on average, would be less expensive than in San Francisco." *Id.* While Austin's amenities may cost more than Waco's, they do not approach San Francisco's. The prospect of a cheaper trial in Austin weighs against transfer.

B. The public-interest factors disfavor transfer.

1. This Court imposes a lesser burden from congestion.

Recognizing "the importance of rapid disposition of patent cases," this Court has relied on recent statistics showing "that time to trial in this District is faster than the NDCA." *BiT-MICRO LLC v. Intel Corp.*, No. W-22-CV-00335-ADA, 2023 WL 3855091, at *8 (W.D. Tex. June 6, 2023); *see also Planned Parenthood*, 52 F.4th at 631 (refusing to ignore relative docket congestion as "speculative" and observing that the district court is best placed to reliably estimate it). This district's faster time to trial disfavors transfer.[7]

[7] Following Federal Circuit precedent, this Court has given this factor no weight when the parties do not compete. *See, e.g.*, *Rafqa Star*, 2023 WL 6050593, at *9 (citing *In re Google LLC*, 58 F.4th at 1383). That holding conflicts with controlling Fifth Circuit precedent refusing to ignore time-to-trial differences. *Planned Parenthood*, 52 F.4th at 631.

2. Austin has strong localized interests.

This factor concerns "not merely the parties' significant connections to each forum writ large, but rather the significant connections between a particular venue and the events that gave rise to a suit." *Def. Distributed*, 30 F.4th at 435 (quoting *Apple*, 979 F.3d at 1345). The Court "consider[s] where the accused products were designed and developed and whether the lawsuit calls into question the work and reputation of individuals residing in either forum." *Marble*, 2023 WL 3938480, at *1 (quotation marks omitted); *see also Rafqa Star*, 2023 WL 6050593, at *10 (finding a local interest "because of the work of [Google's] employees on the accused products in this District").

Austin has two strong localized interests here. First, Austin-based Apple engineers helped develop Secure Enclave technology and the Apple Cash platform, *see supra*, Part III.A.1, and this case calls their work into question. Second, Apple builds one of the accused products—its "flagship desktop computer, the Mac Pro"—in Austin. *STC.UNM v. Apple Inc.*, No. 6:19-CV-00428-ADA, 2020 WL 4559706, at *8 (W.D. Tex. Apr. 1, 2020), *mand. denied*, *In re Apple Inc.*, 818 F. App'x 1001; *see* Ex. 10, "Ex. A" at 1 n.1 & "Ex. B. at 1 n.1; Ex. 29. This Court has held that, when a patentee accuses the Mac Pro, Apple's producing it "solely within this District[] [gives] those involved with its manufacture a localized interest in" whether it infringes. *STC.UNM*, 2020 WL 4559706, at *8.

3. Familiarity with the law and conflicts of laws are neutral.

The parties agree that these factors are neutral. *See* Mot. 15.

IV. CONCLUSION

The Court should deny Apple's motion to transfer this case to N.D. Cal.

PUBLIC VERSION

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CERTIFICATE OF SERVICE

I certify that I served a copy of this document on all counsel of record through the Court's ECF system on October 20, 2023.

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