Miscellaneous Docket No. ___

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 PETITION FOR WRIT OF MANDAMUS

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CERTIFICATE OF INTEREST

Case Number _____

Short Case Caption In re Apple Inc.

Filing Party/Entity Apple Inc.

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Date: 01/31/2024

Signature: /s/ Melanie L. Bostwick

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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).
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TABLE OF CONTENTS

Page

CERTIFICATE OF INTEREST i

TABLE OF AUTHORITIES vi

INTRODUCTION 1

RELIEF SOUGHT 3

ISSUE PRESENTED 4

FACTUAL BACKGROUND AND PROCEDURAL HISTORY 4

Carbyne sues Apple for patent infringement in the Western District of Texas, despite Carbyne having no connection to that district 4

Apple seeks transfer to the Northern District of California 8

The district court orally denies Apple's transfer motion without a written order or any explanation of its rationale 14

REASONS FOR ISSUING THE WRIT 17

I. Apple Has A Clear And Indisputable Right To The Writ 19

A. The district court clearly abused its discretion in failing to provide a written order resolving Apple's transfer motion while pressing ahead with the merits. 19

B. In the alternative, the district court's denial of transfer amounts to a clear abuse of discretion. 23

1. The private-interest factors strongly favor transfer. 24

2. The public-interest factors favor transfer. 34

II. Apple Has No Other Adequate Means To Obtain Relief 38

III. Mandamus Is Appropriate Under the Circumstances. 39

CONCLUSION 41

Carbyne Ex 2018, p.5 of 55
Apple v. Carbyne
IPR2024-00507

CERTIFICATE OF SERVICE
CERTIFICATE OF COMPLIANCE
CERTIFICATE OF CONFIDENTIAL MATERIAL

CONFIDENTIAL MATERIAL OMITTED

The material redacted from page 28 of the petition names confidential Apple technology.

TABLE OF AUTHORITIES

Page(s)

Cases

In re Acer Am. Corp.,
626 F.3d 1252 (Fed. Cir. 2010) 32

In re Apple Inc.,
52 F.4th 1360 (Fed. Cir. 2022)..... 19, 20, 38

In re Apple Inc.,
581 F. App'x 886 (Fed. Cir. 2014) 30

In re Apple Inc.,
979 F.3d 1332 (Fed. Cir. 2020) 18, 19, 22, 23, 26, 35, 36, 37, 38, 40

In re Apple Inc.,
No. 2021-181, 2021 WL 5291804 (Fed. Cir. Nov. 15, 2021) ... 25, 30, 32

In re Apple Inc.,
No. 2022-163, 2022 WL 16754376 (Fed. Cir. Nov. 8, 2022) 20

In re Apple Inc.,
No. 2022-164, 2022 WL 16754153 (Fed. Cir. Nov. 8, 2022) 20

In re Apple Inc.,
No. 2023-120, 2023 WL 2359699 (Fed. Cir. Mar. 6, 2023)..... 14, 20

Cheney v. U.S. Dist. Ct.,
542 U.S. 367 (2004)..... 18

Cont'l Grain Co. v. The Barge FBL-585,
364 U.S. 19 (1960)..... 19

In re DISH Network L.L.C.,
No. 2021-182, 2021 WL 4911981 (Fed. Cir. Oct. 21, 2021)..... 37

In re EMC Corp.,
501 F. App'x 973 (Fed. Cir. 2013) 19, 29

In re Genentech, Inc.,
566 F.3d 1338 (Fed. Cir. 2009) 24, 26, 30, 32

In re Google Inc.,
No. 2015-138, 2015 WL 5294800 (Fed. Cir. July 16, 2015) 20

In re Google LLC,
58 F.4th 1379 (Fed. Cir. 2023)..... 32, 35, 37, 41

In re Google LLC,
No. 2021-170, 2021 WL 4427899 (Fed. Cir. Sept. 27, 2021) 28

In re Google LLC,
No. 2021-171, 2021 WL 4592280 (Fed. Cir. Oct. 6, 2021)..... 25

In re Google LLC,
No. 2021-178, 2021 WL 5292267 (Fed. Cir. Nov. 15, 2021) 32

Hoffman v. Blaski,
363 U.S. 335 (1960)..... 29

In re Honeywell Int'l Inc.,
No. 2023-152, 2024 WL 302397 (Fed. Cir. Jan. 26, 2024) 41

In re Horseshoe Ent.,
337 F.3d 429 (5th Cir. 2003)..... 19

Hustler Magazine, Inc. v. U.S. Dist. Ct.,
790 F.2d 69 (10th Cir. 1986)..... 21, 22

In re Juniper Networks, Inc.,
14 F.4th 1313 (Fed. Cir. 2021)..... 24, 33, 37, 41

LoganTree LP v. Apple Inc.,
No. 6:21-cv-00397-ADA, 2022 WL 1491097
(W.D. Tex. May 11, 2022) 28

In re Microsoft Corp.,
No. 2023-128, 2023 WL 3861078 (Fed. Cir. June 7, 2023) 39, 41

In re Nintendo Co.,
544 F. App'x 934 (Fed. Cir. 2013)..... 19

In re Nintendo Co.,
589 F.3d 1194 (Fed. Cir. 2009) 23

In re Planned Parenthood Fed'n of Am., Inc.,
52 F.4th 625 (5th Cir. 2022) 34, 38

In re Radmax, Ltd.,
720 F.3d 285 (5th Cir. 2013) 34

In re Samsung Elecs. Co.,
2 F.4th 1371 (Fed. Cir. 2021) 35, 36, 41

In re SK hynix Inc.,
835 F. App'x 600 (Fed. Cir. 2021) 20, 22, 39

In re TikTok, Inc.,
85 F.4th 352 (5th Cir. 2023) 29, 30, 33, 34, 41

In re TracFone Wireless, Inc.,
848 F. App'x 899 (Fed. Cir. 2021) 16, 20, 39

In re Volkswagen of Am., Inc.,
545 F.3d 304 (5th Cir. 2008) 17, 24, 35, 39, 40

Statutes

28 U.S.C. § 1404(a) 1, 3, 8, 18, 20, 21, 34, 35

Other Authorities

Standing Order Governing Proceedings (OGP) 4.4 (W.D. Tex.
Jan. 23, 2024), http://tinyurl.com/mr4c7n3r 21

INTRODUCTION

Once again, a plaintiff with no connection to Texas has filed a patent suit in the Western District of Texas (here, the Austin Division) accusing Apple of infringement based on technologies that were designed and developed in the Northern District of California by employees who are overwhelmingly based in that district. Indeed, the asserted patents were also developed in Northern California, and several third parties likely to have information relevant to this dispute are there as well. Apple accordingly sought transfer under 28 U.S.C. § 1404(a) to the Northern District of California. Plaintiff Carbyne ignored Apple's demonstration of the overwhelming number of witnesses and documents in California and instead founded its allegations on publicly available sources (here, a completely unrelated lawsuit) and Apple documents discussing unaccused technologies in a failed effort to identify something relevant in the Western District of Texas.

The district court should have weighed the parties' competing submissions, analyzed the relevant private- and public-interest factors, and provided a transfer ruling with a reasoned basis—and it should

have done so before proceeding with the merits of this case. Instead, despite Apple's timely request for a stay of proceedings to allow for the resolution of the transfer issue, the district court announced at the outset of the *Markman* hearing that it was going to deny transfer and that it would provide a written opinion containing its reasons for doing so the next day. Apple agreed to go forward with the *Markman* based on "Your Honor's representation that the order will come out tomorrow." Appx475.

More than seven weeks have passed since that hearing, and the district court still has not issued a written order or otherwise explained why it declined to transfer this case. Apple has pressed for a written order and has repeatedly been told it is forthcoming imminently, but each promised date has passed. Apple has again sought a stay of proceedings to prevent this case from continuing to proceed on the merits without a reasoned transfer analysis, and the district court has not ruled on even that request. Meanwhile, this case has been proceeding on the merits, with more substantive deadlines looming.

This Court has made clear that district courts must give priority to venue transfer motions; that such motions should be resolved before

a district court proceeds with the merits of a case; and that a district court should provide not only a bottom-line ruling on transfer but a ruling that analyzes the facts and arguments presented by the parties and allows for meaningful appellate review. Apple respectfully requests that this Court issue a writ of mandamus to direct the district court to adhere to those requirements by staying all proceedings until a written order on transfer has issued. That is no mere formalistic step; as Apple demonstrated to the district court, the § 1404(a) factors here clearly favor the Northern District of California and demand transfer to that forum. Any contrary ruling could be reached only through a clear abuse of discretion in violation of the decisions of this Court and the Fifth Circuit. For that reason, should the Court prefer to reach the merits of the transfer issue, it should issue a writ of mandamus directing the district court to grant Apple's transfer request.

RELIEF SOUGHT

Apple respectfully requests that the Court grant this petition for a writ of mandamus and remand with instructions for the district court to stay proceedings until it has issued a written opinion stating its reasons for denying transfer. In the alternative, Apple respectfully requests

that the Court grant this petition, vacate the district court's decision to deny Apple's transfer motion, and remand the case with instructions to transfer this action to the United States District Court for the Northern District of California.

ISSUE PRESENTED

Whether Apple is entitled to a writ of mandamus directing the district court to stay further substantive proceedings until it has issued a written opinion on transfer or, alternatively, a writ of mandamus to compel the district court to transfer the underlying litigation to the Northern District of California.

FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Carbyne sues Apple for patent infringement in the Western District of Texas, despite Carbyne having no connection to that district

Carbyne is a Delaware non-practicing entity with a principal place of business in New York. Appx11. Carbyne is not registered to do business in Texas and has no known offices or employees there. *See, e.g.*, Appx11; Appx211. Indeed, Carbyne does not appear to have any connection at all to the Western District of Texas. Appx11; Appx207; Appx356.

Nonetheless, in March 2023, Carbyne filed this patent lawsuit against Apple in the Austin Division of the Western District of Texas. *See* Appx10-56. Carbyne accuses various technologies in Apple's products of infringing six patents. Appx28-29; Appx32-33; Appx36-46. Carbyne's patents fall into two categories: (1) the "Authentication Patents"—related U.S. Patent Nos. 10,929,512; 11,475,105; and 11,514,138, Appx206—which Carbyne describes as relating to "systems and methods that let a user access resources like websites and applications by scanning a biometric like a face or fingerprint," Appx353; and (2) the "Fraud Reduction Patents"—related U.S. Patent Nos. 9,972,010; 10,713,656; and 11,526,886, Appx206—which Carbyne describes as relating to "systems and methods for preventing fraud in electronic transactions," Appx354.

The sole named inventor on all six asserted patents is Bjorn Markus Jakobsson, Carbyne's co-owner and sole employee. Appx356. Although Dr. Jakobsson now resides in New York City, Appx356, he filed the applications that led to the asserted patents while he was employed by PayPal, headquartered in San Jose. Appx211. The patents all list Dr. Jakobsson as a resident of Portola Valley, California,

and were originally assigned to RightQuestion, LLC, a company headquartered in Menlo Park, California. *See* Appx212-213; Appx347-348; Appx58; Appx76; Appx108; Appx126; Appx149; Appx172. The patents were later assigned to Extricatus, headquartered in Palo Alto, California, and to Carbyne LLC, the "original incarnation" of plaintiff Carbyne that was "formed in California by mistake and re-formed in Delaware." Appx361 n.5 (quoting Appx373-375); *see* Appx212; Appx345.

The asserted claims of the Authentication Patents recite generic processors configured with instructions, and memory for storing such instructions, but focus on the instructions themselves and the functions performed when they are executed. For example, claim 1 of the '512 patent recites a processor configured to establish a secure connection with an external resource and communicate with another processor, which is in turn configured to receive biometric input, access a securely stored record, perform a cryptographic operation, facilitate the user's login to the external resource, and perform a secure backup of the record. Appx72-73. Carbyne accuses certain versions of Apple's iPhone, iPad, and Mac devices of infringing the Authentication Patents through a combination of the Face ID and/or Touch ID, iCloud Keychain, and

Secure Enclave features. Appx208; *see* Appx255-271; Appx273-301; Appx303-316.[1]

The asserted claims of the Fraud Reduction Patents likewise recite generic processors configured with instructions, and memory for storing those instructions, while focusing on the functions performed when the instructions are executed. For example, claim 1 of the '010 patent recites a system with one or more processors configured to perform various functions including "a fraud detection analysis" of "captured contextual information associated with [an] electronic transaction." Appx146. Carbyne accuses certain versions of Apple's iPhone and iPad devices of infringing the Fraud Reduction Patents through a combination of the Face ID, Apple Cash, and Secure Enclave features. Appx208; *see* Appx318-322; Appx324-333; Appx335-343.

The five-member team that is responsible for the accused aspects of the Secure Enclave and the iCloud Keychain is based in Cupertino, California (where Apple is headquartered), with one team member in Maryland. Appx209; Appx226. The sixteen-member team responsible

[1] Apple cites Carbyne's infringement contentions to help the Court understand the subject matter of this dispute. Apple does not admit the truth of any allegation or characterization made by Carbyne.

for the accused aspects of Face ID is likewise based in Cupertino, with four members in Seattle. Appx209; Appx252. The ten-member team responsible for the accused aspects of Apple Cash is also based in Cupertino, with three members in New York and one member in Oregon. Appx210; Appx233. And the nine-member team responsible for the accused aspects of Touch ID is located in Prague, Czech Republic. Appx210; Appx245. None of these teams has any members in Texas. Appx209-210.

Apple seeks transfer to the Northern District of California

Because of the strong connections between this case and the Northern District of California, and the lack of any connection to the Western District of Texas, Apple in July 2023 filed a motion to transfer under 28 U.S.C. § 1404(a). Appx202-223.

Apple's transfer motion demonstrated that likely witnesses and relevant documents are concentrated in the Northern District of California, where the patented technology was primarily developed and where the accused technology was primarily designed and developed. Appx208-212 & n.2; Appx399-402. The Northern District of California is also where Apple is headquartered; where its management, primary

research and development, and marketing facilities are located; and where more than 35,000 Apple employees work, including those knowledgeable about the accused features. Appx207-208.

Apple submitted sworn declarations from seven employees who would be likely witnesses at trial: (1) Catherine Spevak, a Finance Manager based in Cupertino, California, who is knowledgeable about Apple's sales and financial information concerning the accused products; (2) Maxime Veron, a Senior Director based in Cupertino, who leads the iPhone Product Marketing team responsible for marketing practices and strategies regarding iPhone products; (3) Jacqueline Harlow, a Principal Counsel and Senior Manager based in Boulder, Colorado, who leads the IP Transactions Team responsible for patent licensing; (4) Wade Benson, a Software Development Engineer based in Cupertino, who leads the Data Protection team responsible for the software components of the accused products' security architecture, including Secure Enclave and iCloud Keychain; (5) Nicole Wells, a Machine Learning Manager based in Cupertino, who leads the team that develops on-device computer vision and machine perception technologies, including Face ID software; (6) Richard Heard, a Software

Development Engineer based in Cupertino, who manages the engineering team responsible for designing and developing Apple Cash and Apple Pay on iPhones, iPads, and Macs; and (7) Martin Šubert, a Software Development Engineer based in Prague, Czech Republic, who leads the team responsible for developing and validating algorithms for Touch ID. Appx209-210.

These declarations established that the research, design, and development of the accused technology took place at Apple's facilities in California and (for one team) in Prague. Appx209-210; Appx217-218; Appx225-234; Appx240-253. None of these employees or their team members is in the Western District of Texas, and most do not even work with Texas-based Apple employees or third parties. Appx209-210; Appx230-231; 234; Appx242-243; Appx245; Appx249; Appx252. Moreover, because these employees are responsible for the accused technology, they are also the custodians of relevant technical documents. Appx211; Appx227; Appx231; Appx233-234; Appx242-243; Appx245-246; Appx249-250; Appx252-253. The location of these employees matters because they have the "need-to-know basis" credentials required to access relevant documents that are stored

electronically. Appx215; Appx227; Appx231; Appx233-234; Appx242-243; Appx245-246; Appx249-250; Appx252-253. None of Apple's likely trial witnesses nor their teams stores documents in Texas. Appx211.

Apple also demonstrated that relevant third-party documents and witnesses are primarily in California and subject to the subpoena power of the Northern District of California. These third parties include: (1) PayPal, which employed Dr. Jakobsson when he filed the applications that led to the asserted patents, and which may therefore have rights in the asserted patents; (2) early developers of authentication translation and fraud reduction technologies that Apple intends to rely on as system prior art, including PayPal as well as other companies such as Think Computer Corp. and TabletKiosk; (3) previous owners of the asserted patents such as RightQuestion and Extricatus; and (4) over 100 printed prior art inventors, authors, and assignees. Appx211-213; Appx219; Appx403.

Carbyne opposed transfer. But, despite deposing eight Apple witnesses and securing extensive written venue discovery, Carbyne was unable to identify any relevant witnesses in the Western District of Texas or otherwise establish a connection between this case and its

chosen forum. Appx400. Instead, Carbyne relied heavily on three likely witnesses from a different case—*Identity Security LLC v. Apple, Inc.*, No. 6:21-CV-00460-ADA (W.D. Tex.)—which involves different parties, different patents, and different issues than this case. Appx356-357; Appx401. The plaintiff in *Identity Security* accused only a specific feature of Apple's Secure Enclave, not the other features at issue here, and its infringement theory focused on hardware. In contrast, Carbyne's infringement contentions in this case are broader than just the Secure Enclave and, with respect to the Secure Enclave, focus on software. Appx401-402. The Austin-based Secure Enclave hardware engineers who were relevant to the specific hardware feature accused in *Identity Security* are therefore not likely witnesses in *this* case. Appx401.

Apart from the *Identity Security* witnesses, Carbyne identified one Apple employee as "Austin-based," but she actually lives in Santa Clara Valley, California (and, in any event, has no relevant knowledge). *See* Appx358; Appx401. Carbyne also asserted that one Austin-based Apple employee is relevant because of a passing reference to his name, with no indication of his relationship to the accused technology, in just 2 of the

4800 documents produced by Apple, and contended that another Apple employee is relevant because she works with source code mentioned in those documents. Appx358. But Apple demonstrated that these two employees—whom Carbyne opted not to depose—do not have knowledge relevant to the issues in this case; their roles focus on server-side events for Apple Cash, whereas Carbyne's infringement contentions focus on functionality on the user's device. Appx207; Appx211; Appx402.

Carbyne took a similar approach to third-party witnesses and evidence. For example, it relied on the fact that a third party, Finisar Corporation, produces in Texas certain lasers used in Face ID. Appx364. But Carbyne failed to show why Finisar would be relevant to this case, particularly given that its infringement claims do not mention those lasers. *See* Appx219; Appx364; Appx399. Similarly, Carbyne identified one third-party app developer, 1Password, that is based in Canada but has a presence in Texas and that allegedly uses Apple's products in an infringing manner. Appx363-364. But Carbyne offered no reason why 1Password (alone among third-party app developers)

would have any relevant information, particularly when it too was absent from Carbyne's contentions. Appx212.

Apple explained these and other deficiencies in Carbyne's arguments in its transfer reply, filed on November 3. Appx395-405. Carbyne then sought and received leave to file a sur-reply, and Apple sought and received leave to file a sur-sur-reply. Appx432-440; Appx456-462.

The district court orally denies Apple's transfer motion without a written order or any explanation of its rationale

On November 28, 2023, eleven days after transfer briefing closed and with the *Markman* hearing just two weeks away, Apple moved to stay all proceedings until the district court resolved Apple's transfer motion. Appx441-454.[2] To that end, Apple requested that the *Markman* hearing, then scheduled for December 11, be postponed until after Apple's transfer motion was decided. Appx452. Carbyne opposed the stay, and the district court responded by postponing the *Markman* hearing by one day, from December 11 to December 12.

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[2] Consistent with *In re Apple Inc.*, No. 2023-120, 2023 WL 2359699, at *2 (Fed. Cir. Mar. 6, 2023), Apple endeavored to seek a stay sufficiently in advance of the scheduled hearing.

The district court did not rule on transfer before December 12, however, nor did it grant the requested stay. Instead, at the outset of the *Markman* hearing that day, the district court orally stated without explanation that it would be denying Apple's transfer motion and that "we'll have a written order out I think by tomorrow." Appx475. The district court indicated its preference to proceed with the *Markman* hearing, to which Apple agreed based on the court's "representation that the [written] order will come out tomorrow." Appx475. Following that hearing, the district court issued a minute order stating that a written order on transfer would be "forthcoming." Appx8.

On January 2, 2024, three weeks after the *Markman* hearing, Apple contacted the district court's clerk to ask when the court anticipated issuing a written opinion on the transfer motion. Appx544. On January 8, the clerk responded that the "full order" would issue by Friday, January 12. Appx543. That Friday, however, the clerk emailed the parties stating that "an order would be out by Tuesday," January 16. Appx543. That written order still has not yet issued, nor has the district court otherwise provided its rationale for denying transfer.

On January 17, in light of imminent substantive deadlines—including those for written discovery responses and final infringement and invalidity contentions—Apple filed a second stay motion. Appx514-527. It requested a stay of all case activity until the district court "issues a written order explaining the bases for its ruling on" transfer. Appx518. Apple relied on this Court's directives for district courts to do more than just grant or deny transfer motions before proceeding substantively, but to issue a ruling that "provides a basis for [the court's] decision that is capable of meaningful appellate review." *In re TracFone Wireless, Inc.*, 848 F. App'x 899, 901 (Fed. Cir. 2021) (cited at Appx518). Apple also filed a motion to expedite briefing on the stay motion; the district court did not rule on that request. Appx529-532. On January 24, Carbyne filed a one-paragraph stay opposition that did not engage with the Federal Circuit authority Apple cited, instead asserting that a stay was "unnecessary" because the district court had "confirmed" it would issue a written transfer order "in the coming days." Appx534-535. Apple filed a reply the same day reiterating the legal basis for a stay. Appx537-541.

As of the date of this petition—more than seven weeks since the district court orally denied transfer and indicated that a written opinion was imminent—the district court has neither ruled on Apple's stay motion nor provided its reasons for denying transfer. Meanwhile, the case continues to move forward. Not only has the *Markman* hearing already taken place, but the district court has also issued claim constructions, fact discovery has opened, initial written discovery responses have been served, third-party subpoenas have issued, and other substantive milestones (including final infringement and invalidity contentions) are approaching. Appx520.

Given the rapid progression of this case, Apple cannot wait any longer for a written order before seeking mandamus to prevent the case from continuing to move forward in an inconvenient venue.

REASONS FOR ISSUING THE WRIT

A petitioner seeking mandamus relief must (1) show a "clear and indisputable" right to the writ; (2) have "no other adequate means to attain the relief [it] desires"; and (3) demonstrate that "the writ is appropriate under the circumstances." *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 311 (5th Cir. 2008) (en banc) (*Volkswagen II*) (quoting

Cheney v. U.S. Dist. Ct., 542 U.S. 367, 380-81 (2004)).[3] All three conditions are satisfied here.

The district court has clearly abused its discretion in refusing to prioritize Apple's transfer motion, and this Court has properly used its mandamus authority to correct such errors and require a reasoned decision on transfer before a case proceeds on the merits. *Infra* § IA. The district court's approach here is particularly problematic when the denial of transfer is independently worthy of mandamus relief, given the clear inconvenience of Carbyne's chosen forum and Carbyne's inability to provide any lawful reason to keep the case there. *Infra* § IB. Apple has tried every other means of securing a proper transfer ruling, leaving mandamus as the only available remedy. *Infra* § II. And mandamus is especially appropriate in these circumstances, given the district court's defiance of precedent regarding both the process and substance of the § 1404(a) analysis. *Infra* § III.

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[3] On mandamus review of a § 1404(a) transfer ruling, this Court applies the law of the regional circuit, here the Fifth Circuit. *See In re Apple Inc.*, 979 F.3d 1332, 1336 (Fed. Cir. 2020).

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

A. The district court clearly abused its discretion in failing to provide a written order resolving Apple's transfer motion while pressing ahead with the merits.

Precedent is clear that a transfer motion must be given "top priority," even accounting for courts' "discretion as to how to handle their dockets." *Apple*, 979 F.3d at 1337; *see also In re Apple Inc.*, 52 F.4th 1360, 1362 (Fed. Cir. 2022) (recognizing "precedent entitl[ing] parties to have their venue motions prioritized"); *In re Horseshoe Ent.*, 337 F.3d 429, 433 (5th Cir. 2003) ("[D]isposition of that [transfer] motion should have taken a top priority in the handling of this case."). The transfer statute is designed "to protect litigants, witnesses and the public against unnecessary inconvenience and expense." *Cont'l Grain Co. v. The Barge FBL-585*, 364 U.S. 19, 27 (1960). But that goal is "thwarted" when defendants must participate in protracted litigation before transfer is resolved. *In re EMC Corp.*, 501 F. App'x 973, 976 (Fed. Cir. 2013).

For that reason, this Court has stressed "the importance of addressing motions to transfer at the outset of litigation." *Id.* at 975; *see also In re Nintendo Co.*, 544 F. App'x 934, 941 (Fed. Cir. 2013) ("[A]

trial court must first address whether it is a proper and convenient venue before addressing any substantive portion of the case."). And when district courts fail to afford the requisite priority to transfer motions, this Court has used its mandamus authority to ensure that those courts do not "frustrate 28 U.S.C. § 1404(a)'s intent" by forcing litigants "to expend resources litigating substantive matters in an inconvenient venue while a motion to transfer lingers unnecessarily on the docket." *In re Google Inc.*, No. 2015-138, 2015 WL 5294800, at *1 (Fed. Cir. July 16, 2015); *see also Apple*, 2023 WL 2359699, at *2; *Apple*, 52 F.4th at 1363; *In re Apple Inc.*, No. 2022-163, 2022 WL 16754376, at *1 (Fed. Cir. Nov. 8, 2022); *In re Apple Inc.*, No. 2022-164, 2022 WL 16754153, at *1 (Fed. Cir. Nov. 8, 2022); *TracFone*, 848 F. App'x at 901; *In re SK hynix Inc.*, 835 F. App'x 600, 600-01 (Fed. Cir. 2021).

In doing so, this Court has made clear that prioritizing a transfer motion entails providing the parties with a written opinion explaining the basis for granting or denying transfer. In remedying improper delay, this Court has specifically ordered district courts to "provide a reasoned basis for [a transfer] ruling that is capable of meaningful appellate review." *TracFone*, 848 F. App'x at 901; *see also SK hynix*,

835 F. App'x at 601 (ordering stay of proceedings until district court "has issued a ruling on the [transfer] motion capable of providing meaningful appellate review of the reasons for its decision"). Other courts have similarly recognized that a mere up-or-down decision on transfer is insufficient. "When a motion for change of venue is filed pursuant to § 1404(a), the trial court is called upon to carefully weigh the competing equities relied upon by the parties for changing the place of trial." *Hustler Magazine, Inc. v. U.S. Dist. Ct.*, 790 F.2d 69, 71 (10th Cir. 1986) (granting mandamus when district court summarily denied transfer without a hearing or reasoning).

The district court here did not give Apple's transfer motion the priority that precedent requires. Indeed, the district court did not even substantively comply with its own standing order, which provides that, "[i]f a motion to transfer remains pending, the Court will either promptly resolve the pending motion before the *Markman* hearing, or postpone the *Markman* hearing." Standing Order Governing Proceedings (OGP) 4.4 (W.D. Tex. Jan. 23, 2024), http://tinyurl.com/mr4c7n3r. Despite Apple timely seeking a stay of the *Markman* hearing in view of its pending transfer motion, Appx441-454,

the district court neither resolved that motion promptly nor postponed the *Markman* hearing to do so.

And while the district court indicated its bottom-line decision to deny transfer at the outset of the *Markman* hearing, Appx475, it provided no basis for that decision, let alone a reasoned basis capable of meaningful appellate review. There was no apparent careful weighing of the transfer facts and arguments; instead, like the district court in *Hustler*, the district court here denied transfer in a single conclusory sentence. Appx475.

In the seven weeks that have passed since, and despite Apple's diligent but respectful inquiries seeking a written order, the district court still has neither "give[n] air to those facts which [Apple] assert[s] entitle[s] [it] to a transfer," *Hustler*, 790 F.2d at 71, nor provided "a ruling on the [transfer] motion capable of providing meaningful appellate review of the reasons for its decision," *SK hynix*, 835 F. App'x at 601. While repeatedly promising a date for a written order and then letting that date pass, the district court has "barreled ahead on the merits in significant respects," including issuing claim constructions and forging ahead with discovery. *Apple* 979 F.3d at 1338.

The district court's approach to transfer in this case is a clear abuse of discretion that warrants mandamus. Apple is entitled to a considered, written ruling on its transfer motion, and to know what the district court's reasoning is, before being forced to continue litigating in a clearly inconvenient forum.

B. In the alternative, the district court's denial of transfer amounts to a clear abuse of discretion.

Apple would have preferred to await a written transfer ruling before seeking relief in this Court. It would benefit the parties and this Court to understand how the district court evaluated the parties' evidence and arguments and how it assessed each transfer factor. That is why Apple primarily asks this Court to order the district court to stay the case until the court provides its rationale for denying transfer. But here, as in prior cases, the district court has "heavily prioritized the merits of the case" while withholding its reasoning for denying transfer. *Apple*, 979 F.3d at 1338 n.1. Meanwhile, any proper analysis of the private- and public-interest factors in this case reveals the kind of "stark contrast in relevance, convenience, and fairness between the two venues" that compels transfer and has previously warranted mandamus to accomplish that result. *In re Nintendo Co.*, 589 F.3d 1194, 1198 (Fed.

Cir. 2009). Should the Court prefer to examine the district court's transfer denial now, even in the absence of a written decision, Apple respectfully contends that the denial "amounts to a clear abuse of discretion under [the] governing legal standards" and warrants "mandamus to overturn the denial of transfer." *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1318 (Fed. Cir. 2021).

1. The private-interest factors strongly favor transfer.

The private-interest factors include "(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious and inexpensive." *Volkswagen II*, 545 F.3d at 315 (citation omitted). These factors clearly favor transfer here, save the last, which is neutral.

Witness Convenience. The witness-convenience factor "is 'probably the single most important factor in [the] transfer analysis.'" *Juniper Networks*, 14 F.4th at 1318 (quoting *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009)). And where, as here, most potential witnesses are in the transferee forum and none are in the transferor

forum, that critical factor weighs heavily in favor of transfer. *See, e.g.*, *In re Apple Inc.*, No. 2021-181, 2021 WL 5291804, at *3 (Fed. Cir. Nov. 15, 2021); *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021).

Apple identified its seven likely witnesses who are best positioned to speak on the topics pertinent to Carbyne's infringement allegations, as revealed by Carbyne's own contentions, and to damages. Of those seven, five are in the Northern District of California (as are most of their team members), and the remaining two are outside either potential forum (in Colorado and Prague). *See supra* 9-10.

Carbyne does not dispute that these individuals are likely witnesses in this case. And nothing it offers in response can outweigh the convenience of these California-based witnesses. First, the one Carbyne employee who may be a witness, Dr. Jakobsson, is in New York and—like Apple's witnesses in Boulder and Prague—will need to travel a significant distance regardless of whether transfer is granted. Appx356. This Court has held in analogous circumstances that witnesses located in "Europe, Iowa, and the East Coast would be only 'slightly more inconvenienced by having to travel to California' than to

Texas." *Apple*, 979 F.3d at 1341 (quoting *Genentech*, 566 F.3d at 1348). Furthermore, any marginal inconvenience to Carbyne's New York-based witness (*see* Appx356) cannot outweigh the "substantial number of witnesses residing within the [Northern District of California] who would be unnecessarily inconvenienced by having to travel away from home to testify in the [Western] District of Texas." *Genentech*, 566 F.3d at 1344.

Second, Carbyne's attempt to identify Apple employees in Austin by relying on an unrelated case fails. Carbyne identified three Austin-based Apple employees—Vincent Le Roy, Eric Peeters, and Gil Herbeck—whom the district court previously deemed relevant in another case accusing specific aspects of Secure Enclave technology. Apple identified these engineers in *Identity Security* based on their work on aspects of the Secure Enclave hardware that were at issue there but are not at issue here. Appx237-238; *see* Appx411; Appx429-430. To be clear, Apple explained in *Identity Security* that "[t]he team responsible for designing and developing the Secure Enclave technology"—hardware and software—"is based in California, at or near Apple's Cupertino headquarters." Appx550. But because that team

"also includes" three Austin-based engineers who work on the Secure Enclave hardware features relevant in *Identity Security*, Apple sought (and was granted) intradistrict transfer of that case from the Waco Division to the Austin Division of the Western District of Texas. Appx550; *see* Appx559; Appx560-574.

Here, however, Carbyne's asserted patents speak to the functions performed by instructions executed on a processor, and its infringement contentions therefore target the software aspects of the Secure Enclave. *See supra* 12; *see also, e.g.*, Appx401-402. The three Austin-based employees are not likely witnesses because none possesses relevant knowledge regarding the alleged infringement—again, as defined *by Carbyne*. Moreover, to the extent the Secure Enclave hardware is relevant, the director of Apple's Platform Architecture Group—Tim Paaske, based in Cupertino—testified that he is "the person most knowledgeable about the Secure Enclave hardware at Apple." Appx417; *see* Appx412-414; Appx416-417; Appx401-402; Appx236. Two of the three Austin-based individuals that Carbyne relies on—Mr. Le Roy and Mr. Peeters—in fact report through multiple levels of management to Mr. Paaske. Appx402; Appx413-415.

Carbyne knows all this—Apple explained it through sworn declarations, and Apple's witnesses confirmed it in their venue depositions. Yet Carbyne mischaracterizes statements from publicly available sources (here, the *Identity Security* docket) to manufacture some link to Texas. Carbyne's strategy is not meaningfully different from plaintiffs who point to snippets of publicly available LinkedIn profiles to claim potentially relevant witnesses are in their preferred forum. Both this Court and the district court have rightly criticized that approach as "highly speculative." *In re Google LLC*, No. 2021-170, 2021 WL 4427899, at *7 (Fed. Cir. Sept. 27, 2021); *see also LoganTree LP v. Apple Inc.,* No. 6:21-cv-00397-ADA, 2022 WL 1491097, at *7 (W.D. Tex. May 11, 2022). Carbyne's approach—in the face of extensive venue discovery—is no more reliable and should be rejected as well.

Carbyne's final attempt to justify keeping this case in Texas is similarly flawed. As explained above (at 12-13), Carbyne scoured the thousands of documents Apple produced during venue discovery and found passing mention of individuals who work on server-side Apple Cash functions known as "[redacted]" and "[redacted]." In doing so, it identified two such individuals based in Austin—Laura Hitt and

Antonio Ordonez. Appx358.[4] But Carbyne's infringement contentions are directed to Apple Cash's device-side functionalities and therefore do not mention such server-side technology. Appx458; Appx426; Appx389-391; Appx471. Although Carbyne has suggested since transfer briefing concluded that it may add server-side functions to its infringement theory, it has not updated its contentions to do so. Furthermore, any amendments should not be relevant, as "[m]otions to transfer venue are to be decided based on 'the situation which existed when suit was instituted.'" *EMC*, 501 F. App'x at 976 (quoting *Hoffman v. Blaski*, 363 U.S. 335, 343 (1960)).

Furthermore, even if any of the Austin-based individuals cited by Carbyne had some relevance to this case, their presence could not possibly outweigh the twenty-two undisputedly relevant Apple employees in Cupertino whose work focuses on the technology specifically accused in Carbyne's infringement contentions. *See supra* 7-8 (identifying declarants and their team members based in Cupertino); *In re TikTok, Inc.*, 85 F.4th 352, 361 (5th Cir. 2023) ("The

[4] Carbyne initially identified a third employee, Julia Hanson, but does not now dispute that she lives in Northern California, not Austin. Appx401.

presence of one Texas witness cannot overcome the immense inconvenience that the majority of relevant witnesses would face if this case were to be tried in Texas.”).

Because the vast majority of knowledgeable willing witnesses are in Northern California (or outside either possible forum), with at most a few individuals of questionable relevance in Texas, the witness-convenience factor heavily favors transfer. *See id.* at 362.

Compulsory Process. This factor also “weigh[s] heavily in favor of transfer” because there appear to be substantially “more third-party witnesses resid[ing] within the transferee venue than … in the transferor venue.” *Apple*, 2021 WL 5291804, at *3 (quoting *In re Apple, Inc.*, 581 F. App’x 886, 889 (Fed. Cir. 2014)); *see also, e.g.*, *Genentech*, 566 F.3d at 1345.

Apple identified numerous third parties within the subpoena power of the Northern District of California. Appx211-213; Appx219; Appx402. These include companies with relevant system prior art such as Tablet Kiosk, Think Computer, PayPal, and Digital Persona. *See* Appx212; Appx360. Carbyne accused Apple of “cherry-pick[ing]” California-based companies, Appx360, but it did not dispute their

relevance. And while Carbyne pointed out that Digital Persona has a parent company based in Austin, Appx360, it offered no reason why this parent company would be relevant, particularly when the Digital Persona prior-art system was developed in California. Appx402-403.

Carbyne has failed to identify any other relevant third parties within the subpoena power of the Western District of Texas. Carbyne's complaint briefly referenced 1Password, a Canadian-based app developer with a presence in Texas, and Finisar, which manufactures in Texas certain lasers used in FaceID. Appx219; *see supra* 13. But neither company (or their respective activities) is mentioned in or implicated by Carbyne's infringement contentions. Appx219; Appx399. In particular, Carbyne has offered no reason why 1Password, alone among app developers, would be relevant, while the many app developers outside of Texas would not.

Because relevant third-party witnesses are overwhelmingly subject to the Northern District of California's subpoena power—indeed, *all* relevant third-party witnesses appear to reside in the Northern District of California—the compulsory-process factor must weigh

heavily in favor of transfer. *See, e.g.*, *In re Google LLC,* 58 F.4th 1379, 1385 (Fed. Cir. 2023); *Apple*, 2021 WL 5291804, at *3.

Sources of Proof. The location of the sources of proof also weighs heavily in favor of transfer. Because "[i]n patent infringement cases, the bulk of the relevant evidence usually comes from the accused infringer," "the place where the defendant's documents are kept weighs in favor of transfer to that location." *Genentech*, 566 F.3d at 1345.

Here, Apple's sources of proof are almost entirely located in the Northern District of California, where Apple is headquartered and most of Apple's document custodians reside. *See* Appx215; *In re Google LLC*, No. 2021-178, 2021 WL 5292267, at *2 (Fed. Cir. Nov. 15, 2021) (noting relevance of "location of document custodians"). That is because the accused features were overwhelmingly designed in the Northern District of California (and partly in Prague, which favors neither forum). *See* Appx215; *In re Acer Am. Corp.*, 626 F.3d 1252, 1256 (Fed. Cir. 2010).

By contrast, Carbyne has failed to identify any likely sources of proof in the Western District of Texas. Largely ignoring the importance of the accused infringer's documents, Carbyne instead points to

documents held by potential third parties like 1Password and Finisar, Appx363-364—which are irrelevant here, *supra* 31.

Carbyne has also argued that Apple's electronic documents can also be accessed in Austin and that the district court in *Identity Security* found physical documents related to the Secure Enclave technology located in Austin. Appx362-363. But the Apple employees with the "need-to-know-basis" credentials necessary to access relevant electronic documents are in the Northern District of California, Appx215, which favors transfer. *See TikTok*, 85 F.4th at 359. Moreover, as explained above (at 26-27), *Identity Security* involved hardware aspects of the Secure Enclave that are not at issue here and, in any event, the bulk of the Secure Enclave team (and their documents) is in California.

Ultimately, "the *relative* access to sources of evidence in the two competing forums" weighs strongly in favor of the Northern District of California. *Juniper Networks*, 14 F.4th at 1321 (emphasis added).

Other Practical Problems. This factor is neutral. Carbyne has argued otherwise, claiming that "[t]he substantial litigation completed [in the Western District of Texas] weighs against transfer." Appx365.

But the Fifth Circuit has permitted this factor to weigh against transfer only when a party has "inexcusably delayed" filing a § 1404(a) motion—such as waiting months into the merits discovery period before seeking transfer. *TikTok*, 85 F.4th at 362 (quoting *In re Planned Parenthood Fed'n of Am., Inc.*, 52 F.4th 625, 631 (5th Cir. 2022)); *see also In re Radmax, Ltd.*, 720 F.3d 285, 289 (5th Cir. 2013) ("garden-variety delay" cannot be relevant, or it "would militate against transfer in every case"). There was no such delay here. Apple filed its transfer motion less than four months after being served with the complaint, less than two months after filing a motion to dismiss (which remains pending), and in compliance with the scheduling order to which the parties jointly agreed. *See* Appx194-197; Appx198-201. Furthermore, while *Markman* is now complete and fact discovery is open, Apple repeatedly attempted to avoid those milestones passing without transfer being resolved. *See supra* 14-17. There is no plausible basis to weigh the "practical problems" factor against transfer here.

2. The public-interest factors favor transfer.

Public interests entail: "(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." *Volkswagen II*, 545 F.3d at 315 (citation omitted). Both parties agree that the third and fourth factors are neutral here. Appx367. And the first two either favor transfer or are neutral as well.

Local Interests. The district court could only have properly concluded that the local-interest factor weighs in favor of transfer. What matters for purposes of the § 1404(a) transfer analysis is "[t]he relevant events leading to the infringement claims." *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1380 (Fed. Cir. 2021). As discussed above (at 7-8), four of the five Apple technologies that Carbyne accuses in its complaint and infringement contentions were developed by teams based (and almost entirely located) in Cupertino, California. (The fifth was developed by a team based in Prague. *Supra* 8.) The asserted patents likewise were developed in the Northern District of California. *See supra* 5-6. Given these "significant connections" with "the events that gave rise to [the] suit," the Northern District of California has a strong local interest. *Apple*, 979 F.3d at 1344-45; *see Google*, 58 F.4th at 1384-

85 ("[W]here both the patented and accused technology were developed" in the Northern District of California, the "local interest factor favors transfer."). And Carbyne has no competing connection to the Western District of Texas. *See Samsung*, 2 F.4th at 1380 (local-interest factor favored transfer because "[t]he relevant events leading to the infringement claims here took place largely in Northern California, and not at all in the Western District of Texas").

Carbyne argues that the few Austin-based Apple employees that it identified, despite having no demonstrated relevance, made Austin the locus of local interest. Appx356-358; Appx401. But even if those employees had some limited connection to the dispute at hand, they could not possibly outweigh the twenty-two undisputedly relevant Apple employees in Cupertino or the design and development of the accused technology there. *See supra* 7-8; *Apple*, 979 F.3d at 1346 (improper to focus on questionably relevant Texas-based employees "to the exclusion of all other employees and activity").

Carbyne also relied on the assembly of a single accused product, the Mac Pro computer, in Austin. Appx367. But Carbyne's infringement allegations have nothing to do with the assembly of the

Mac Pro, which in all events cannot outweigh the design and development of most of the accused technology in California. *See, e.g.*, *Apple*, 979 F.3d at 1346 (proper to give "little weight" to location of Mac Pro assembler); *In re DISH Network L.L.C.*, No. 2021-182, 2021 WL 4911981, at *3 (Fed. Cir. Oct. 21, 2021) (any Texas-based "connection is insubstantial compared to [transferee forum's] significant connection to the design and development of the accused features").

Court Congestion. The relative congestion of the Western District of Texas and the Northern District of California can only have a neutral effect on the transfer analysis. This Court has "noted that the Western District of Texas and the Northern District of California show no significant differences in caseload or time-to-trial statistics." *Juniper Networks*, 14 F.4th at 1322.

Moreover, as this Court has explained, the court-congestion factor is necessarily neutral where, like here, a patentee "is not engaged in product competition in the marketplace and is not threatened in the market in a way that … might add urgency to case resolution and give some significance to the time-to-trial difference." *Google*, 58 F.4th at 1383. Contrary to Carbyne's claims, Appx366 n.7, that precedent does

not conflict with Fifth Circuit precedent saying only that, "to the extent docket efficiency can be reliably estimated, the district court is better placed to do so." *Planned Parenthood*, 52 F.4th at 631.

II. Apple Has No Other Adequate Means To Obtain Relief.

Mandamus is the only way for Apple to obtain relief. "[P]recedent entitles parties to have their venue motions prioritized." *Apple*, 52 F.4th at 1362. Apple has attempted to obtain that prioritization by first seeking to stay the *Markman* hearing until transfer could be resolved; agreeing to go forward with the *Markman* based solely on the district court's "representation" that a transfer ruling would issue the next day; and diligently seeking a written transfer ruling or a stay of proceedings pending such a ruling. Appx475; *see supra* 14-16. The district court has declined at every step to afford Apple's transfer motion the priority that precedent requires. Apple's only remaining recourse is with this Court.

In deference to this Court's direction that it does not "condon[e] pre-order mandamus petitions," *Apple*, 979 F.3d at 1338 n.1, Apple waited more than seven weeks after the *Markman* hearing for the district court's promised decision to issue. But Apple cannot wait indefinitely for an order to issue, especially as substantive milestones

continue to pass and Apple continues to expend resources litigating in an inconvenient forum. *See also In re Microsoft Corp.*, No. 2023-128, 2023 WL 3861078, at *1 n.* (Fed. Cir. June 7, 2023) (emphasizing that "timing considerations are always relevant when [this Court is] asked to grant the extraordinary relief of mandamus"). Apple is asking this Court to use its mandamus authority to pause that progress until a written transfer ruling orders, as this Court has done before. *See SK hynix*, 835 F. App'x at 601; *TracFone*, 848 F. App'x at 901.

Apple makes this request because the convenience analysis here is so heavily in favor of the Northern District of California that transfer must be warranted—a result that likewise can be achieved only through this Court's mandamus review, not by any alternative. *See Volkswagen II*, 545 F.3d at 319. The second prong of the mandamus test is therefore satisfied should the Court decide to review the merits of the transfer denial at this stage.

III. Mandamus Is Appropriate Under the Circumstances.

Mandamus is an appropriate remedy for the district court's refusal to afford Apple's transfer motion the priority precedent requires. Apple timely submitted a transfer motion, supported by several sworn

declarations and exhibits, carefully laying out the basis for transfer. The parties engaged in months of venue discovery and submitted not only the usual opposition and reply but also a sur-reply and sur-sur-reply, extensively addressing the facts in this case and governing precedent. The district court dismissed all of that at the *Markman* hearing: "I'm going to deny that now." Appx475.

It then held the *Markman* hearing and issued claim constructions—"two of the most important and time-intensive substantive tasks a district court undertakes in a patent case," *Apple*, 979 F.3d at 1338—and has otherwise allowed this case to move forward. Meanwhile, it has neither issued a written transfer ruling—despite Apple agreeing to go forward with the *Markman* solely on the "representation that the order will come out" on December 13, 2023, Appx475—nor has it responded to Apple's second request for a stay to prioritize transfer.

"[A] court must exercise its discretion within the bounds set by relevant statutes and relevant, binding precedents," and "mandamus is entirely appropriate to review for an abuse of discretion that clearly exceeds the bounds of judicial discretion." *Volkswagen II*, 545 F.3d at

310. Here, the district court has exceeded the bounds of its discretion in treating Apple's transfer motion as an afterthought. It is particularly troubling that the district court has done so in the face of Apple's showing that "several important transfer factors favor transfer, while nothing of significance ties this case to the Western District of Texas." *In re Honeywell Int'l Inc.*, No. 2023-152, 2024 WL 302397, at *3 (Fed. Cir. Jan. 26, 2024). Indeed, as shown above, this case presents the kind of clear imbalance that warrants mandamus directing transfer outright. *See supra* § IB; *TikTok*, 85 F.4th at 367; *Microsoft*, 2023 WL 3861078, at *2; *Google*, 58 F.4th at 1385; *Juniper Networks*, 14 F.4th at 1322-23; *Samsung*, 2 F.4th at 1379-81. In these circumstances, mandamus is appropriate.

CONCLUSION

The Court should grant the petition and direct the district court to stay further proceedings until it has issued a written opinion explaining its transfer ruling. In the alternative, the Court should grant the petition, vacate the district court's decision denying Apple's motion to transfer, and direct the district court to transfer the case to the Northern District of California.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system on January 31, 2024.

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CERTIFICATE OF COMPLIANCE

The petition complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this petition contains 7788 words.

This petition 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 petition 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 petition contains 2 unique words and numbers marked confidential.

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