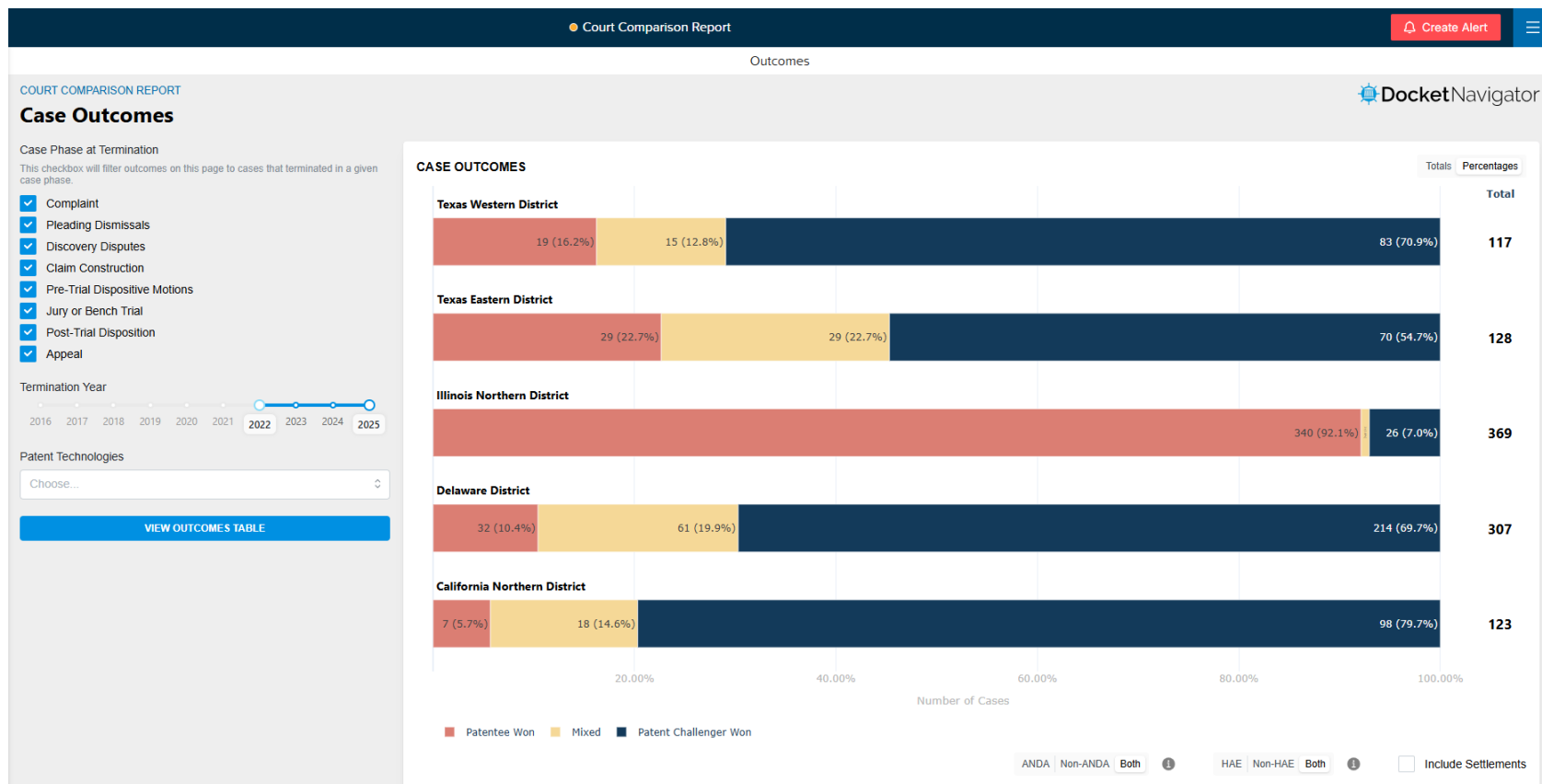


Location, Location, Location: Personal Jurisdiction and Venue in Patent Law

Caroline Desmond & Sarah Jelsema

Klarquist

Location Matters



Docket Navigator, Court Comparison Report, Case Outcomes for Patent Cases Terminating Since 2022 (March 28, 2025).

Different Timelines

Court Name	Average Time To Trial	Average Time To Claim Construction
Texas Eastern District	2.1 yrs	1.4 yrs
Texas Western District	2.4 yrs	1.2 yrs
Delaware District	3.1 yrs	2.1 yrs
California Northern District	3.3 yrs	2.5 yrs
Illinois Northern District	4.8 yrs	4.7 yrs

Familiarity with Patent Cases

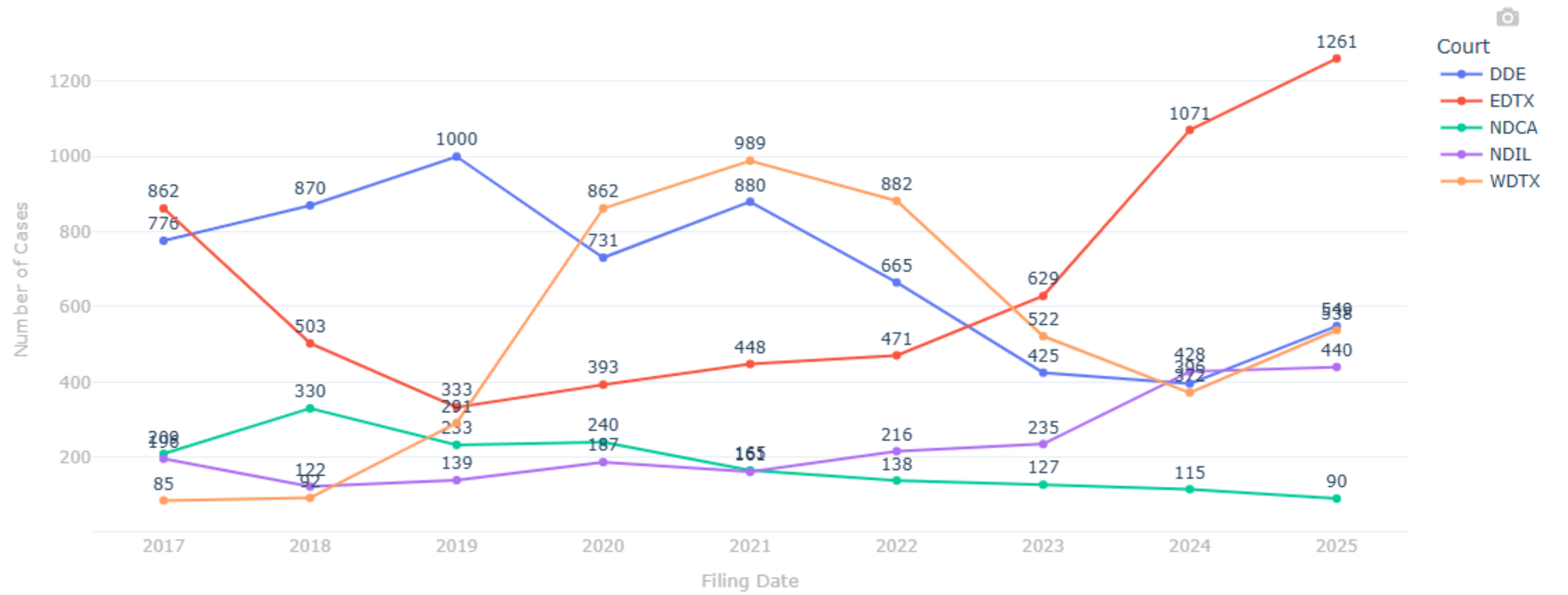
Rank	Court	US Patent Cases
1	Texas Eastern District	1071
2	Illinois Northern District	428
3	Delaware District	396
4	Texas Western District	372
5	New Jersey District	231
6	California Central District	204
7	California Northern District	115
8	New York Southern District	108
9	Florida Southern District	83
10	Texas Northern District	77

YTD **Estimate Current Year**

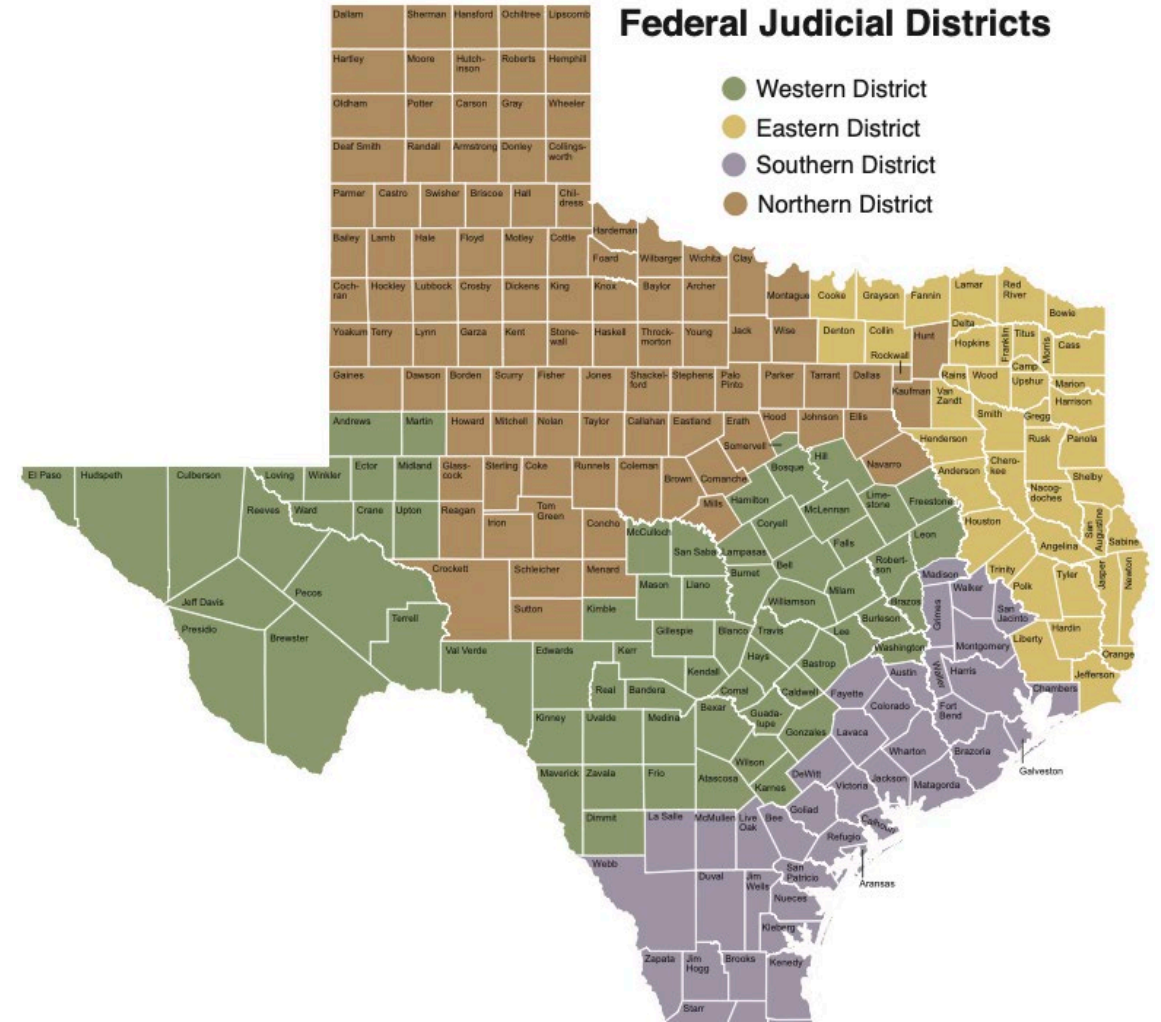


- Court**
- DDE
 - EDTX
 - NDCA
 - NDIL
 - WDTX

CASES FILED OVER TIME



- Personal Jurisdiction – primarily constitutional. Exists on a statewide level. Court’s power over a party being sued in a case.
- Venue – primarily statutory. Exists on a districtwide level. Venue statutes are designed to allocate suits to the most appropriate or convenient federal forum. Even if proper, venue can be challenged if inconvenient.
- Both can be waived.



Personal Jurisdiction



General “All Purpose” Jurisdiction

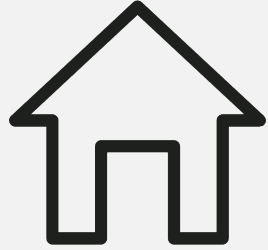
- Any claims.
- State of domicile (for an individual).
- Place of Incorporation or PPB/HQ (for a corporation)*¹



Specific “Case-Linked” Jurisdiction

- More commonly at issue.
- Contacts with the state relate to the claims in the case.
- Does long-arm statute permit service of process?
- Would assertion of jurisdiction violate due process rights?

1.) *Goodyear Dunlop Tires Operations, S.A. v. Brown*, 564 U.S. 915, 919 (2011).



General “All Purpose” Jurisdiction

- Any claims.
- State of domicile (for an individual).
- Place of Incorporation or PPB/HQ (for a corporation)*¹

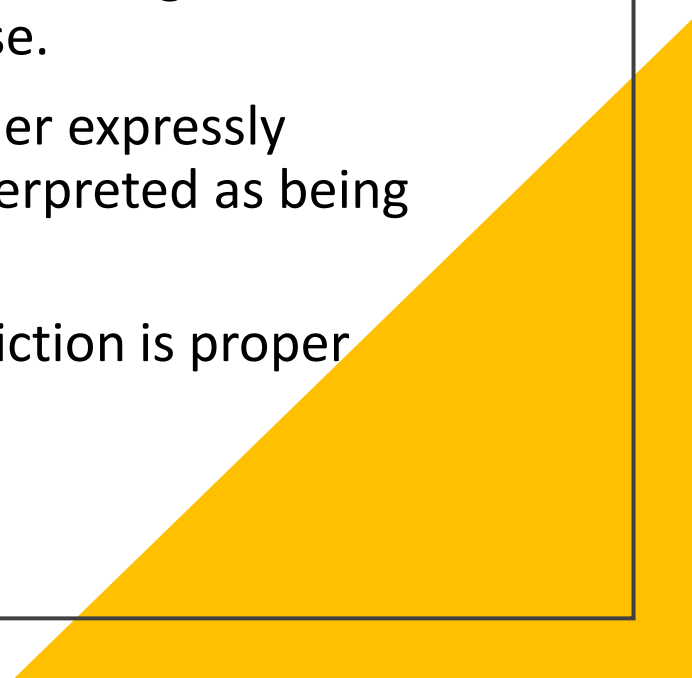


Specific “Case-Linked” Jurisdiction

- More commonly at issue.
- Contacts with the state relate to the claims in the case.
- Does the state’s long-arm statute permit service of process?
- Would assertion of jurisdiction violate due process rights?

1.) *Goodyear Dunlop Tires Operations, S.A. v. Brown*, 564 U.S. 915, 919 (2011).

State Long-Arm Statutes

- Look at whether jurisdiction is authorized by state law before turning to whether jurisdiction is permissible under the Due Process Clause.
 - A majority of states have enacted long-arm statutes that either expressly incorporated the Due Process Clause standard or have been interpreted as being coextensive with the Due Process Clause.
 - So typically, the two inquiries merge into one: whether jurisdiction is proper under the Due Process Clause.
- 
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Due Process Factors

- Purposeful direction?
- Do the claims the arise out of or relate to the defendant's activities with the forum?
- Would assertion of personal jurisdiction be unreasonable?

Fed. Cir. *Prima Facie* Standard Applies to Minimum Contacts

- Purposeful direction?
- Does the arise out of or relate to the defendant's activities with the forum?
- Would assertion of personal jurisdiction be unreasonable?

Case-Linked Contacts in Patent Cases

Patent Infringement Action	Declaratory Judgment Action
Defendant's activities within the forum must relate to the alleged infringement.	Patent rights holder's activities within the forum must relate to enforcement of the patent. ¹

1.) *Apple Inc. v. Zipit Wireless, Inc.*, 30 F.4th 1368, 1374 (Fed. Cir. 2022).

Minimum Contacts Are Context Specific

Patent Infringement Action	Declaratory Judgment Action
Defendant's activities within the forum must relate to the alleged infringement.	Patent rights holder's activities within the forum must relate to enforcement of the patent. ¹ <ul style="list-style-type: none">• Cease-and-desist letters alone are not sufficient.• Need "other activities" too (<i>e.g.</i>, travel to the forum, licensing activities directed to the forum, related lawsuit for the same patent in the forum).

1.) *Apple Inc. v. Zipit Wireless, Inc.*, 30 F.4th 1368, 1374 (Fed. Cir. 2022).

Stream of Commerce Doctrine

The defendant “purposefully shipped” the accused product into the forum State;

“through an established distribution channel”;

AND

the “cause of action for patent infringement is alleged to arise out of these activities.”

The SoC Doctrine Requirements Remain Unsettled

Stream of commerce plus intent: Placing accused products in the “stream of commerce” + “intent or purpose to serve the market in the forum State.”

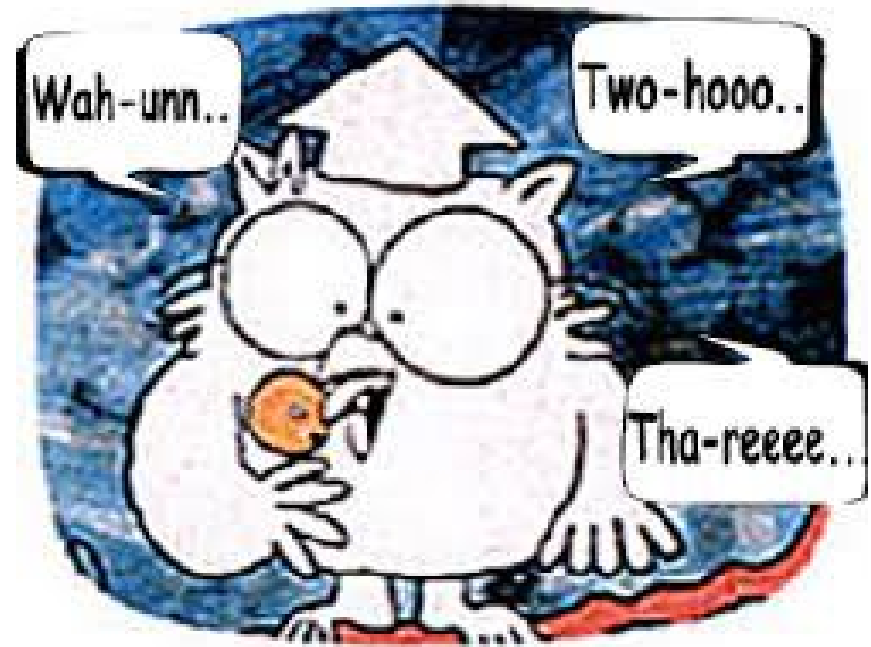
OR

Stream of commerce plus foreseeability: Placing accused products in the “stream of commerce” + awareness “the final product is being marketed in the forum State” such that it is foreseeable that the accused products will enter the forum State.

~~Unilateral Third-Party Activities~~

See, e.g., Theta IP, LLC v. Motorola Mobility LLC, No. 22 C 3441, 2024 WL 1283706, at *5 (N.D. Ill. Mar. 25, 2024) (citing *Asahi Metal Industry Co. v. Superior Court of California, Solano County*, 480 U.S. 102 (1987)).

*So, how many
contacts (and
what kind) are
enough?*



Scenario 1: Sufficient Contacts?

- Patent owner files suit in E.D. Va. against a foreign manufacturer of accused ceiling fans and the U.S. subsidiary incorporated in N.J.
- The Defendants submit declarations that they have not shipped any accused products to Virginia and that they have only made a one-time sale of unrelated goods in the state.
- Plaintiff submits declarations from a private investigator attesting that he purchased one of the accused ceiling fans from a retailer in Virginia. The retailer has six retail outlets in Virginia and over 50 accused fans were available through the retailer. The ceiling fans also came with manuals identifying the U.S. Defendant as the source of the fans and were accompanied by a warranty to be honored by the U.S. Defendant.
- YES - *Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1566 (Fed. Cir. 1994).

Scenario 2: Sufficient Contacts?

- Patent owner files suit in D. Del against a Finnish company and its U.S. sister company that is incorporated in Delaware for infringement of a patent regarding heartrate measurement technology.
- Defendants have a distribution agreement between them. The Finnish company physically fulfills orders of the accused products **in Finland** for U.S. addresses provided by its U.S. sister company.
- U.S. sister company takes title to the accused products **in Finland**.
- Finnish company owns a U.S. website and has made at least eight online sales of accused products to customers in Delaware and shipped 94 accused products to Delaware retailers.
- *YES - Polar Electro Oy v. Suunto Oy*, 829 F.3d 1343, 1351 (Fed. Cir. 2016).

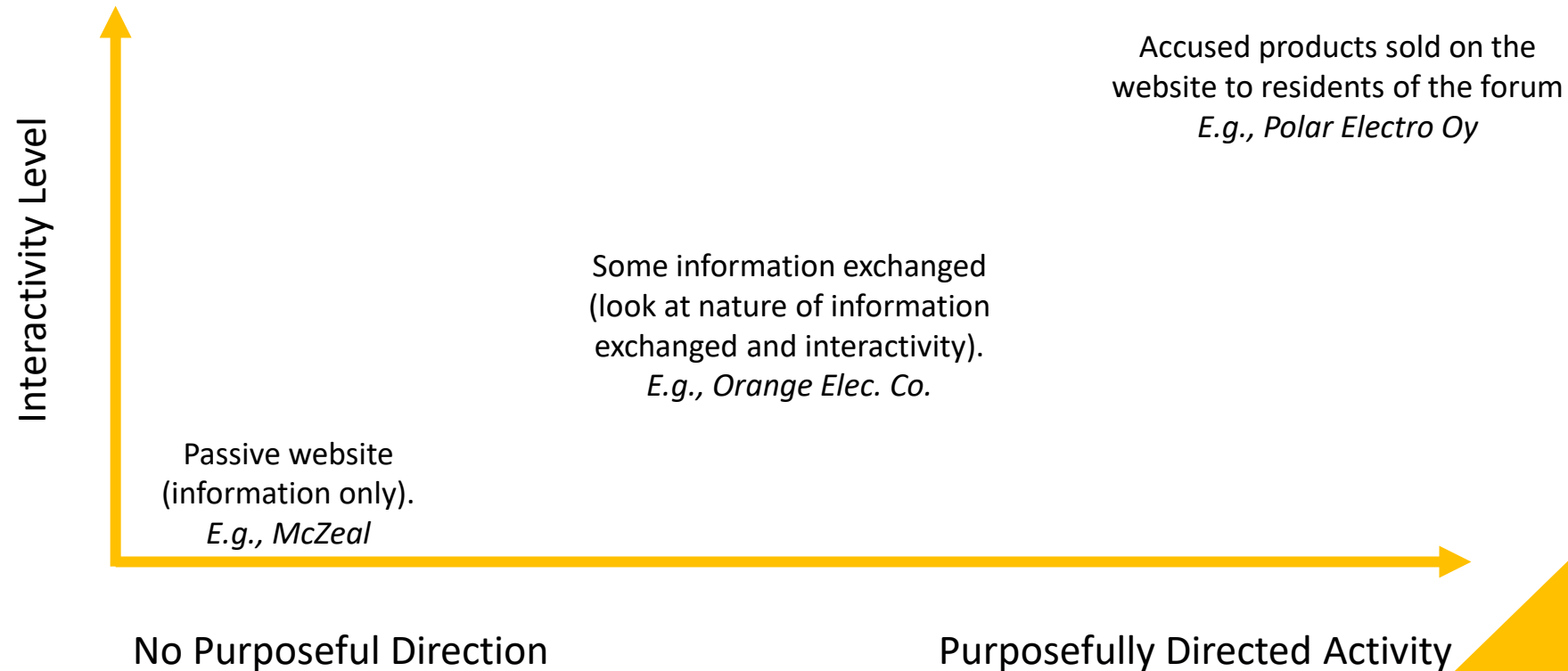
Scenario 3: Sufficient Contacts?

- Owner of patent related to walkie-talkie technology files suit in S.D. Tex. against Defendant telecommunications company incorporated in Delaware with a principal place of business in Illinois.
- Defendant maintains a website that is accessible in Texas. Uncontroverted evidence shows that the website provides information about accused products and email links for potential customers in Texas.
- Defendant's website does not facilitate exchanging information or sales of the accused products.
- Defendant has also answered calls and emails from the Plaintiff who is a Texas resident.
- Plaintiff alleges that Defendant does substantial business with IBM and Samsung who in turn each do business in Texas.
- NO - *McZeal v. Fastmobile, Inc.*, No. CIV.A. H-05-3915, 2006 WL 801175, at *3 (S.D. Tex. Mar. 28, 2006), *aff'd*, 219 F. App'x 988 (Fed. Cir. 2007).

Scenario 4: Sufficient Contacts?

- Patent owner files suit in EDTX against a Defendant who is incorporated in China.
- Defendant sells accused tire pressure monitors directly to its U.S. subsidiary who is not joined to the case and headquartered in New York.
- It is the U.S. subsidiary that imports and sells the accused products to U.S. retailers who have locations in Marshall, TX.
- The Defendant does operate a website that provides the location of U.S. retailers (including those in Marshall) and invites visitors to submit product issues to be resolved by “professional technicians” in the user’s region.
- YES - *Orange Elec. Co. v. Autel Intelligent Tech. Corp.*, No. 2:21-CV-00240-JRG, 2022 WL 4368160, at *4–5 (E.D. Tex. Sept. 21, 2022).

Zippo Spectrum of Interactivity



The Defendant's "Compelling Case" Burden of Proof


- Purposeful direction?
- Does the arise out of or relate to the defendant's activities with the forum?
- Would assertion of personal jurisdiction be unreasonable?

Scenario 1: Compelling Case?

- The court finds that Defendant Taiwanese corporation with principal place of business in Taiwan has sufficient minimum contacts with Texas because it is part of a distribution chain resulting in sales of accused products in Texas.
- Defendant submits a declaration attesting that there would be a significant burden in time, expense, and inconvenience in litigating in EDTX, which is over 7,700 miles away.
- Defendant's declaration also attests that Plaintiff's interest in obtaining relief in Texas is not compelling because key evidence comes from Georgia or Finland, not Texas.
- **NOT COMPELLING - *Am. Pats. LLC v. D-Link Corp.*, No. 4:19-CV-764, 2020 WL 3972740, at *6 (E.D. Tex. July 14, 2020).**

Scenario 2: Compelling Case?

- Accused infringer with Texas HQ files a declaratory judgment action in N.D. Texas against a Patent Rights Holder that is incorporated in Delaware with HQ in Michigan.
- Patent Rights Holder had sent the accused infringer multiple cease and desist letters regarding the patents-in-suit to the accused infringer's Texas HQ.
- Patent Rights Holder also granted an exclusive license to a Texas entity.
- The license covers the patents-in suit but does not obligate the Patent Rights Holder to enforce or defend the patents-in suit.
- YES - *New World Int'l, Inc. v. Ford Glob. Techs., LLC*, 859 F.3d 1032, 1043 (Fed. Cir. 2017).



*What if you
have a foreign
defendant?*

- Agency and Alter-Ego Theories
- Rule 4(k)(2)
- Patent Long-Arm Statute

Foreign Parent/Affiliate an Agent or Alter-Ego of U.S. Child/Affiliate?

Agency Theory	Alter-Ego Theory (Sample Factors)
Defendant exercises control over the activities of the third-party.	Common ownership/management? Do not transact at arms length? Profit flow between entities? Shared website?

Celgard, LLC v. SK Innovation Co., 792 F.3d 1373, 1379 (Fed. Cir. 2015); *Wapp Tech Ltd. P'ship v. Micro Focus Int'l, PLC*, 406 F. Supp. 3d 585, 595 (E.D. Tex. 2019) (citing other alter-ego factors considered)

Imputable Contacts?

- Owner of patents related to mobile device technology files suit against a British software company in EDTX.
- Defendant argues that the alleged contacts are only attributable to its unnamed U.S. subsidiaries.
- But Plaintiff contends that the U.S. subsidiaries' contacts may be imputed to the Defendant.
- It is undisputed that Defendant owns 100% of its subsidiaries' stock. There is also uncontroverted evidence that Defendant sets financial goals and requires financial reporting from its subsidiaries and that Defendant shared one common director with its subsidiaries.
- Plaintiff also presents evidence that Defendant and its subsidiaries do not respect corporate formalities, which is contradicted by Defendant's evidence of separate tax returns, arms-length transactions, and that when its subsidiaries share employees, they are treated as independent contractors.
- *NO - Wapp Tech Ltd. P'ship v. Micro Focus Int'l, PLC*, 406 F. Supp. 3d 585, 595 (E.D. Tex. 2019).

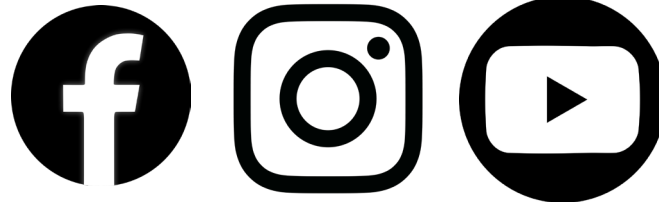
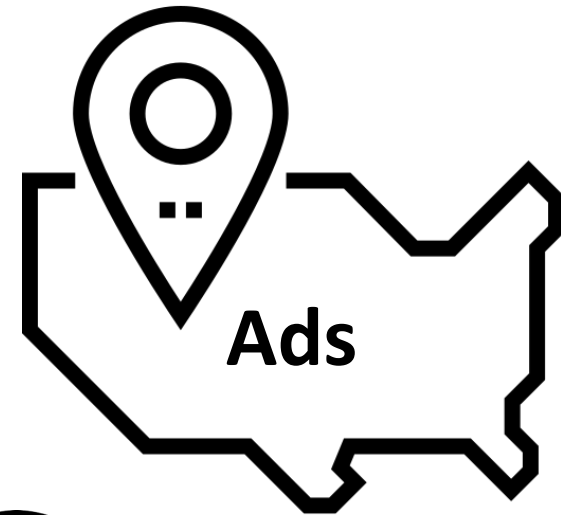
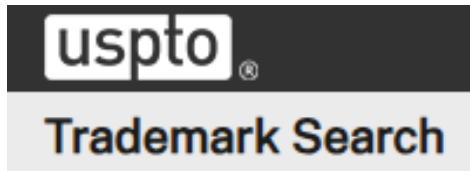
Rule 4(k)(2): Minimum Contacts with the U.S.

- Plaintiff's claim arises under federal law;
- **Defendant is not subject to jurisdiction in any state's courts of general jurisdiction; and**
- **Defendant's contacts with the U.S. as a whole satisfy due process.**

Rule 4(k)(2): Sufficient Contacts?

- Owner of patents related to oil drilling sues Brazilian corporation Defendant in D. Minn.
- Defendant beat out Plaintiff for a contract with a Brazilian oil company, and the contract controlled where the accused systems would be installed.
- Defendant installs the accused systems on U.S. ships (considered U.S. territory).
- Plaintiff thereafter warned the Defendant that the accused systems were infringing its patents. Defendant kept operating the accused systems on the U.S. ships.
- YES - *M-I Drilling Fluids UK Ltd. v. Dynamic Air Ltda.*, 890 F.3d 995, 1001 (Fed. Cir. 2018).

Sample 4(k)(2) Evidence



Seek Jurisdictional Discovery

- Law of the regional circuit applies to whether jurisdictional discovery should be permitted and whether it can be requested in opposition to a 12(b)(2) motion.
- For example, the 9th Circuit permits this when not based on a “mere hunch.”¹
- The 5th Circuit has similarly required plaintiffs to allege facts that suggest with “reasonable particularity the possible existence of the requisite contacts.”²

1.) *Nuance Commc'ns, Inc. v. Abbyy Software House*, 626 F.3d 1222, 1235–36 (Fed. Cir. 2010) (applying 9th Cir. Law);

2.) *Fielding v. Hubert Burda Media, Inc.*, 415 F.3d 419, 429 (5th Cir. 2005).

The Patent Long-Arm Statute



*What if there are
lots of defendants
that each pose a
flight risk?*

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

LUKE COMBS,

Plaintiff,

v.

THE PARTNERSHIPS AND
UNINCORPORATED
ASSOCIATIONS IDENTIFIED ON
SCHEDULE "A",

Defendants.

Case No. 23-cv-14485

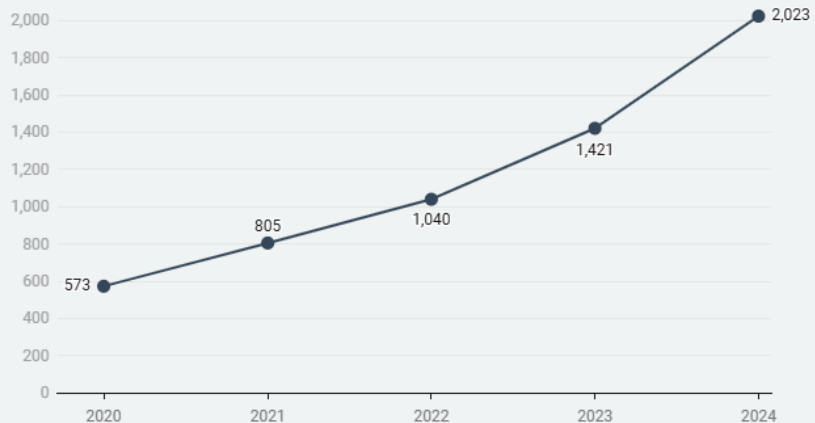
Judge Elaine E. Bucklo

Magistrate Judge Sheila M. Finnegan

“N.D. Illinois v. the Internet”: NDIL Schedule A Cases

Schedule A Cases on the Rise

In recent years, the increase in Schedule A cases, which group dozens and sometimes hundreds of alleged counterfeiters into one complaint, has correlated with an increase in online shopping. This has prompted brands to pursue alleged counterfeiters on platforms like Amazon, eBay and Alibaba.



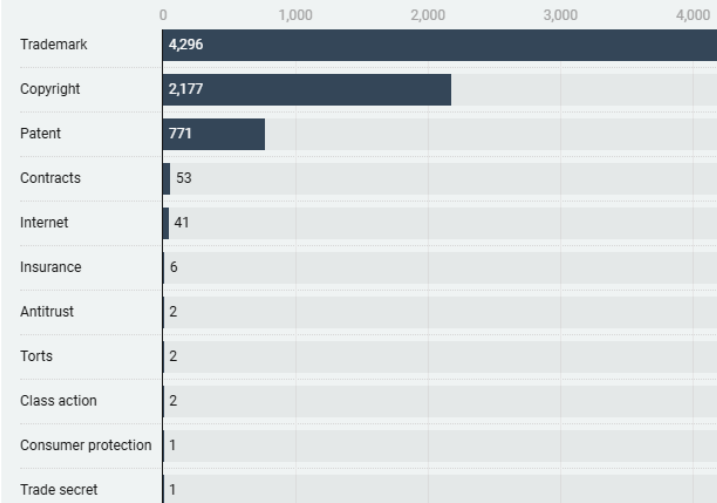
Note: Data covers cases filed between Jan. 1, 2020, and Dec. 31, 2024.

Source: Lex Machina • Created with Datawrapper



IP Claims Make Up the Bulk of Schedule A Cases

Most Schedule A cases assert trademark claims because complaints frequently include counterfeiting allegations.

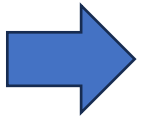


Note: Data covers cases filed between Jan. 1, 2020, and Dec. 31, 2024.

Source: Lex Machina • Created with Datawrapper



Venue



The patent venue statute

When the statute applies

When venue is proper under the statute

Challenging venue as inconvenient

Patent Venue Statute

“Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.”

28 U.S.C. § 1400(b).

General Venue Statute

“Venue in General.—A civil action may be brought in—

(1) a judicial district in which **any defendant resides**, if all defendants are residents of the State in which the district is located;”

28 U.S.C. § 1391(b).

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General Venue Statute

“Residency.—For all venue purposes—

. . . .

(2) an entity . . . whether or not incorporated, shall be deemed to reside . . . in any judicial district in which such defendant is subject to the court’s personal jurisdiction

28 U.S.C. § 1391(c).

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Residence for Corporations

A domestic corporation resides **only in its state of incorporation** for purposes of the patent venue statute.

General Venue Statute

“Venue in General.—A civil action may be brought in—

(1) a judicial district in which **any defendant resides, if all defendants are residents of the State in which the district is located;**

...

(3) if there is no district in which an action may otherwise be brought . . . , **any judicial district in which any defendant is subject to the court’s personal jurisdiction”**

28 U.S.C. § 1391(b).

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Venue for Each Defendant

For patent suits, venue must be proper as to each defendant.

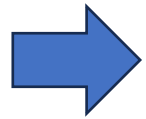
General Venue Statute

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28 U.S.C. § 1391(b).

The patent venue statute



When the statute applies

When venue is proper under the statute

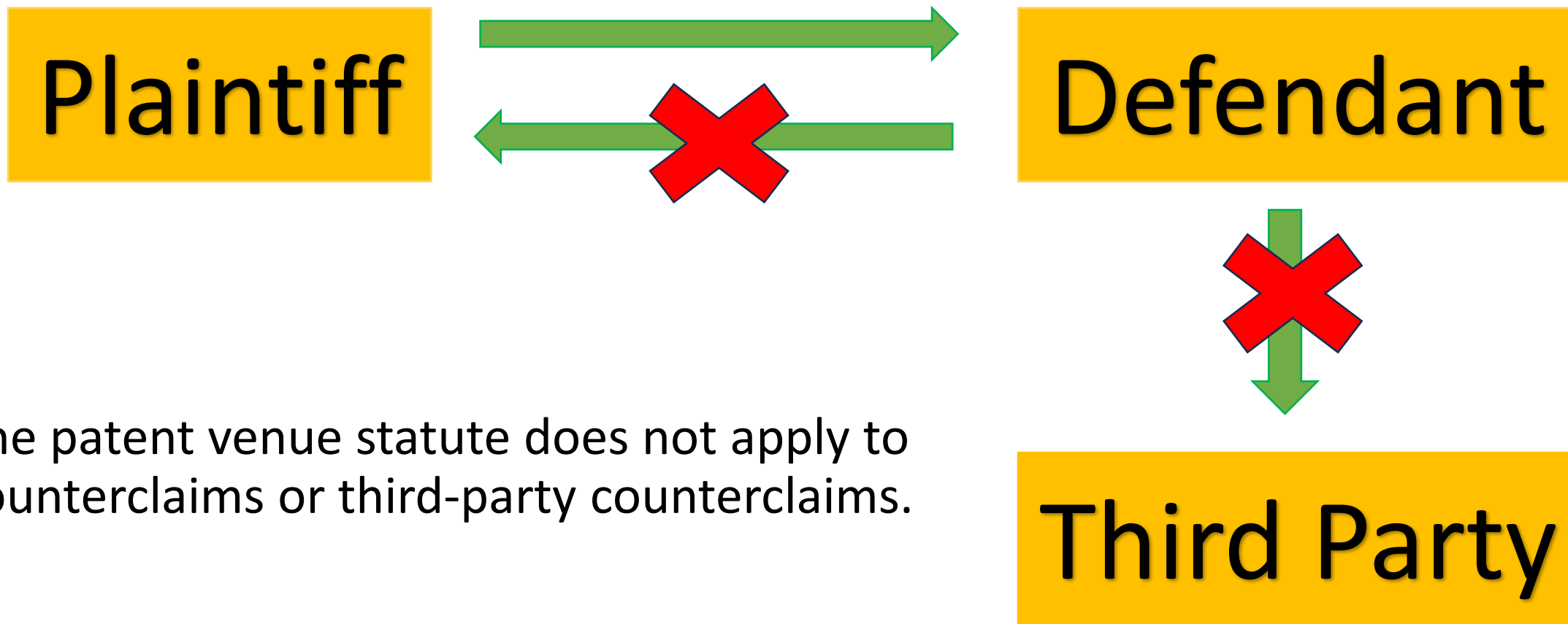
Challenging venue as inconvenient

Patent Venue Statute

“Any **civil action for patent infringement** may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.”

28 U.S.C. § 1400(b).

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The patent venue statute does not apply to counterclaims or third-party counterclaims.

Gen. Elec. Co. v. Marvel Rare Metals Co., 287 U.S. 430, 435 (1932).

BASF Plant Sci., LP v. Commonwealth Sci. & Indus. Rsch. Org., 28 F.4th 1247, 1263 (Fed. Cir. 2022).

Plaintiff



Defendant

~~Patient~~

Other

When Does 28 U.S.C. § 1400(b) Apply?

- Most courts will not exercise “pendent venue” over a patent claim even if the complaint also includes another claim for which venue is proper.

Hoffacker v. Bike House, 540 F. Supp. 148, 149 (N.D. Cal. 1981).

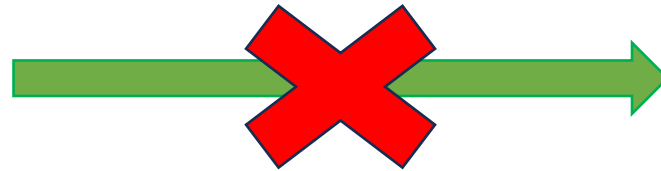
Akurate Dynamics, LLC v. Carlisle Fluid Techs., Inc., No. 6:20-CV-00606-ADA, 2021 WL 860006, at *2 (W.D. Tex. Mar. 8, 2021) (Albright, J).

When Does 28 U.S.C. § 1400(b) Apply?

- But pendent venue was found proper by at least one judge one time:
- A trademark claim was the “primary claim.”
- “Interests of judicial economy, fairness to the litigants, and avoidance of piecemeal litigation” compelled exercising pendent venue over a patent infringement claim.

DJ Non-
infringement

Plaintiff



Defendant

Accused
Infringer

Patent
Owner


VE Holding Corp. v. Johnson Gas Appliance Co., 917 F.2d 1574, 1583 (Fed. Cir. 1990) (dicta).

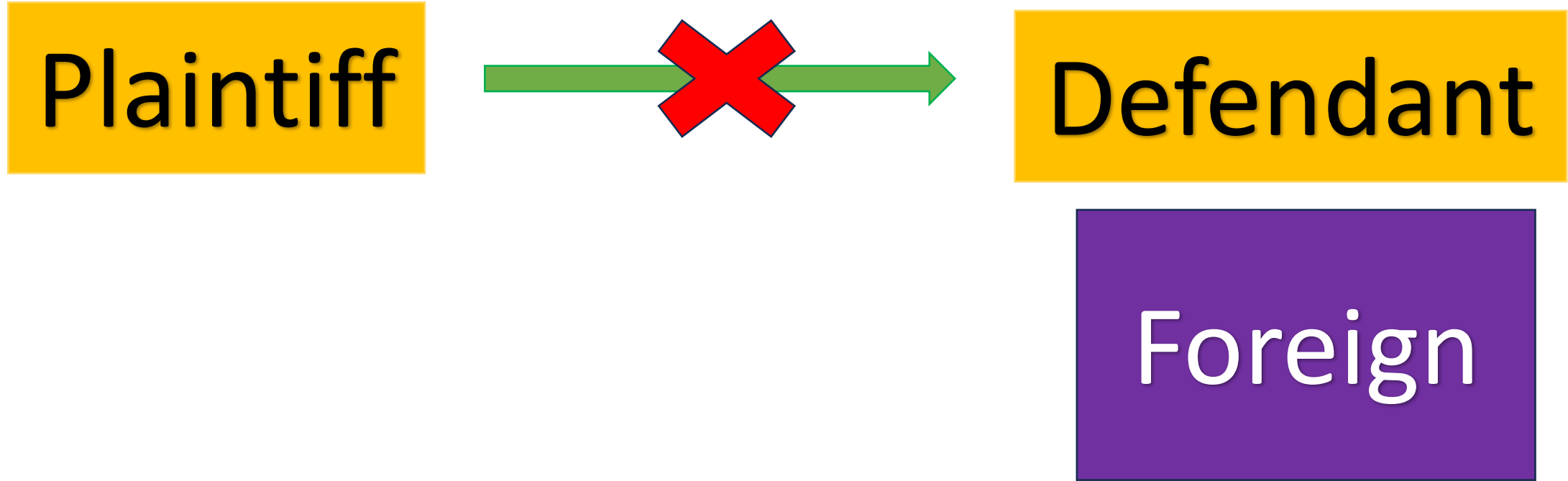
United States Aluminum Corp. v. Kawneer Co., Inc., 694 F.2d 193, 195, 216 USPQ 745, 746 (9th Cir. 1982).

Patent Venue Statute

“Any civil action **for patent infringement** may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.”

28 U.S.C. § 1400(b).

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- The patent venue statute does not apply to foreign defendants.
- Foreign defendants may be sued in any district.

In re HTC Corp., 889 F.3d 1349, 1360 (Fed. Cir. 2018)

Brunette Mach. Works, Ltd. v. Kockum Indus., Inc., 406 U.S. 706, 714 (1972).

The patent venue statute

When the statute applies

→ When venue is proper under the statute

Challenging venue as inconvenient

Any civil action for patent infringement may be brought in the judicial district where the defendant . . .

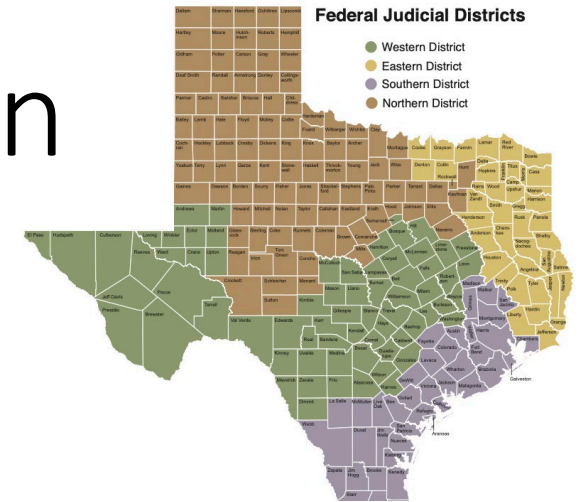
resides



Residence for Corporations

A domestic corporation resides only in its state of incorporation for purposes of the patent venue statute.

Residence for Corporations in Multi-District States



In a state having multiple judicial districts, a corporate defendant resides:

- only in the district within that state where it has a principal place of business, or,
- failing that, the district in which its registered office is located.

Residence for Unincorporated Entities like LLCs or LLPs

- “Because this case comes to us at the pleading stage and has been litigated on the understanding that petitioner is a corporation, we confine our analysis to the proper venue for corporations.”

TC Heartland LLC v. Kraft Foods Grp. Brands LLC, 581 U.S. 258, 263 n.1 (2017).

- “We have applied *TC Heartland*’s holding to venue issues relating to LLCs, like Ring. . . . The parties neither dispute nor address this potential issue, so neither do we.”

Heidary v. Amazon.com, Inc., No. 2024-1580, 2024 WL 4489918, at *2, n.2 (Fed. Cir. Oct. 15, 2024).

Residence for Unincorporated Entities like LLCs or LLPs

- Residence for unincorporated association: **its principal place of business**
Sperry Prods. v. Ass'n of Am. Railroads, 132 F.2d 408, 411–12 (2d Cir. 1942) (Judge Learned Hand).
- The Supreme Court discussed *Sperry* favorably in *Denver & R. G. W. R. Co. v. Bhd. of R. R. Trainmen*, 387 U.S. 556, 560 (1967).
- It held that, with regard to the general venue statute, unincorporated entities should be treated like corporations.

Residence for Unincorporated Entities like LLCs or LLPs

The proper residence for unincorporated defendants is their **principal place of business**.

Maxchief Investments Ltd. v. Plastic Dev. Grp., LLC, No. 3:16-CV-63, 2017 WL 3479504, at *1–2 (E.D. Tenn. Aug. 14, 2017).

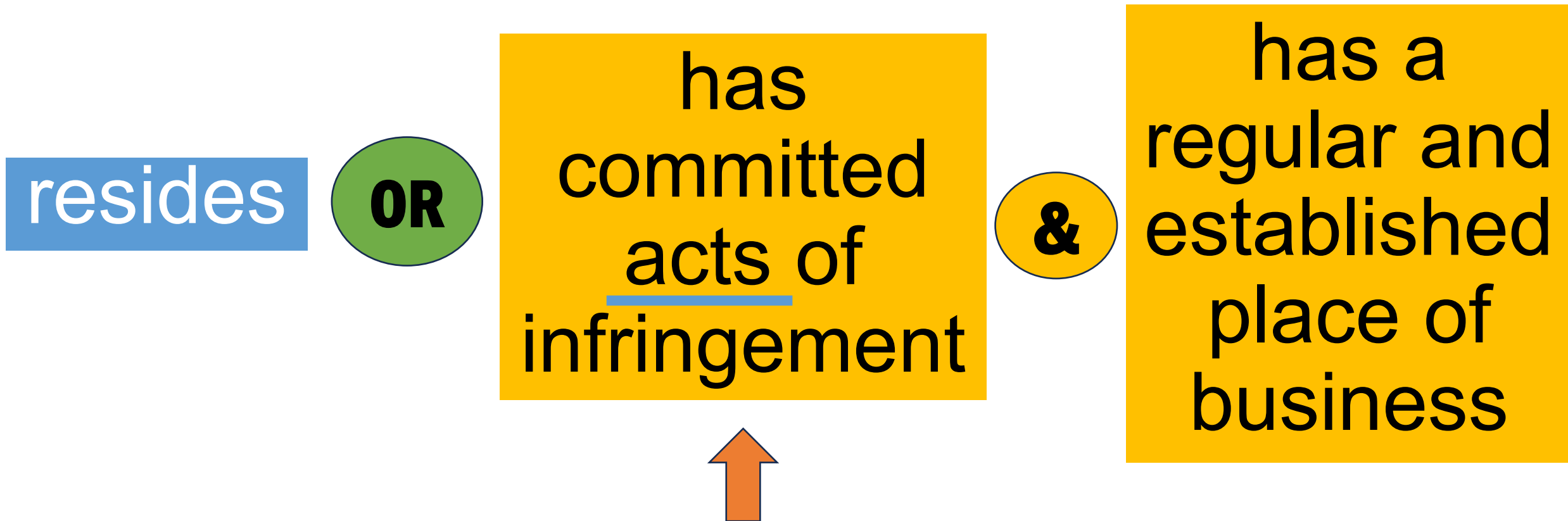
Inhale, Inc. v. Gravitron, LLC, No. CV 18-3883 PSG (KSX), 2018 WL 5880192, at *1-*3 (C.D. Cal. Sept. 5, 2018).

Blue Water Innovations, LLC v. Vevazz, LLC, No. 620CV774ORL78DCI, 2020 WL 6828950, at *2 (M.D. Fla. Oct. 29, 2020).

Residence for Unincorporated Entities like LLCs or LLPs

- The residence of any partners or members (etc.).
- The state under whose laws the entity was created.

Any civil action for patent infringement may be brought in the judicial district where the defendant . . .



Hatch-Waxman Cases

In Hatch-Waxman cases, infringement occurs for venue purposes only in districts where actions related to the submission of an Abbreviated New Drug Application (“ANDA”) occur.

Acts of Infringement 35 U.S.C. § 271

make

use

offer to sell

sell

import

induce infringement

contribute to infringement

Location of Sale

- Federal Circuit has distinguished between the personal jurisdiction context and the liability context in determining location of a sale.
- May be easier to show location in the personal jurisdiction context.

Halo Elecs., Inc. v. Pulse Elecs., Inc., 769 F.3d 1371, 1378 (Fed. Cir. 2014).

Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc., 978 F.3d 1374, 1380 (Fed. Cir. 2020).

Acts of Infringement

The acts accused of infringement must have already occurred.

Acts of Infringement

- Infringing acts of one entity may be imputed to an entirely different entity when the actions were “taken in furtherance of a partnership.”
- One company’s deposit of seeds to a seed collection as part of a patent application was considered to be an infringing act in the relevant district.
- That infringement was imputed to an unrelated company with which it was “engaged in a partnership to carry out a project advanced by obtaining patent protection,” as the seed deposit was “an act in furtherance of that goal.”

Any civil action for patent infringement may be brought in the judicial district where the defendant . . .



Regular and Established Place of Business

(1) There must be a **physical** place in the district,

(2) it must be a **regular and established** place of business, and

(3) it must be the place **of** the defendant.

Regular and Established Place of Business

- “Sporadic activity cannot create venue.”
- A place may not be used “merely temporarily, or for some special work or particular transaction.”

Regular and Established Place of Business

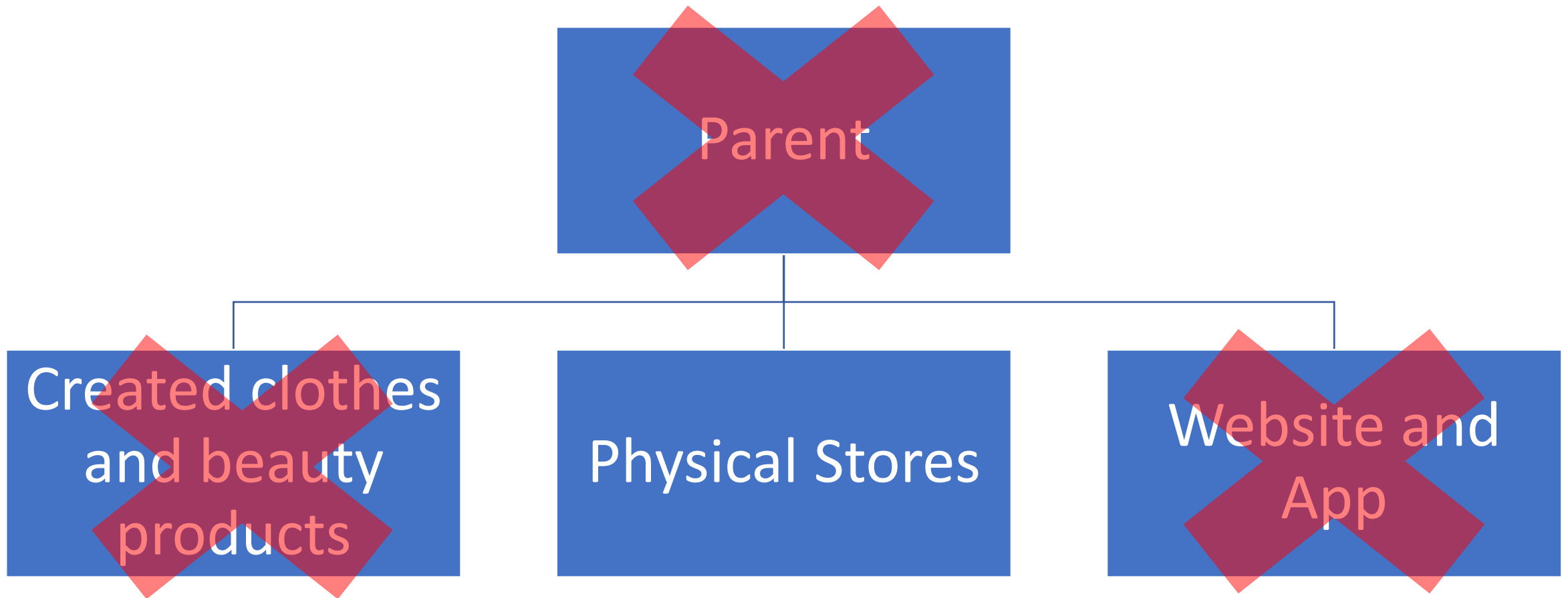
- There must be “[t]he regular, physical presence of an employee or other agent of the defendant conducting the defendant’s business at the alleged place of business.”
- Perhaps a machine could be an “agent.”
- A defendant advertising it has a place of business somewhere or setting up an office there is not enough.

Place of the Defendant

- Does the defendant own or lease the place, or exercise other attributes of possession or control over the place?
- Does the defendant own any equipment at the place?
- Does the defendant list the place on a website, or in a telephone or other directory?
- Does the defendant place its name on a sign associated with or on the place?

Related Entities

“[W]here related companies have maintained corporate separateness, the place of business of one corporation is not imputed to the other for venue purposes.”



Regular and Established Place of Business

- Defendant Ludlow-Saylor Wire Company, based in Missouri, was sued in SDNY, based on a sale of goods to a purchaser in New York.
- It employed a single person as its “Eastern representative” in New York, “paying him a small salary, commission on sales, and traveling expenses.”
- The employee also worked for another company, which rented him “a room.”
- Ludlow-Saylor paid for part of the rent and part of a stenographer’s wages.
- This was not a “regular and established place of business.”

The patent venue statute

When the statute applies

When venue is proper under the statute

➡ Challenging venue as inconvenient

Change of Venue for Convenience

“For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought or to any district or division to which all parties have consented.”

Change of Venue for Convenience

Courts apply the *Gilbert* factors.

Regional circuit law applies to 28 U.S.C. § 1404(a).

Private Interest Factors

- (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 a trial easy, expeditious and inexpensive

Public Interest Factors

- (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 conflicts of laws or in the application of foreign law

Sources of Proof

- Residence of persons with security clearances to view key documents
- Residence of third-party companies that provide accused functionality for the accused products

In re Google LLC, 58 F.4th 1379, 1385 (Fed. Cir. 2023).

In re TikTok, Inc., 85 F.4th 352, 359 (5th Cir. 2023)

Convenience for Witnesses

- “The convenience of the witnesses is probably the single most important factor in a transfer analysis.”
- Would it be cheaper and more convenient for the witnesses to travel to Austin or Amarillo? Not clear: e.g., there are more flights into Austin, but others costs in Amarillo are less—such as hotels and restaurants.

In re Genentech, Inc., 566 F.3d 1338, 1342 (Fed. Cir. 2009).

In re Planned Parenthood Fed’n of Am., Inc., 52 F.4th 625, 631 (5th Cir. 2022).

Compulsory Process



- This factor will weigh heavily in favor of transfer when more third-party witnesses reside within the transferee venue than reside in the transferor venue. (2014)
- Not unreasonable to find this factor neutral when a defendant fails to identify any witness in the transferee district unwilling to come to trial in the transferor district. (2025)

In re Apple, Inc., 581 Fed. Appx. 886, 889 (Fed. Cir. 2014).

In re Databricks, Inc., No. 2025-113, 2025 WL 685916, at *1 (Fed. Cir. Mar. 4, 2025).

In re TikTok, Inc., 85 F.4th 352, 361 (5th Cir. 2023).

Practical Problems That Make a Trial Easy, Expeditious and Inexpensive

- Judicial economy based on a court's familiarity with the patent and technology gained from other suits, especially if there were relatively recent, substantive hearings construing the patent claims.
- “Inexcusable delay” bringing a transfer motion.

In re Google LLC, 58 F.4th 1379, 1383 (Fed. Cir. 2023).

In re Databricks, Inc., No. 2025-113, 2025 WL 685916, at *1 (Fed. Cir. Mar. 4, 2025).

In re TikTok, Inc., 85 F.4th 352, 362 (5th Cir. 2023).

Practical Problems

Plaintiff tips:

- File more than one lawsuit at around a time in the same venue, and file the one with the best venue facts first.
- Maybe wait until the court is familiar with the technology to file the second suit.

Defendant tip:

- File transfer motions promptly

Court Congestion

- The speed with which a case may come to trial or otherwise be resolved
- If the patentee is a non-practicing entity and no evidence suggests a need for an urgent trial, this factor shouldn't be accorded weight.

In re Genentech, Inc., 566 F.3d 1338, 1347 (Fed. Cir. 2009).

In re Google LLC, 58 F.4th 1379, 1383 (Fed. Cir. 2023).

Local Interest Factor

- The “public interest in having localized interests decided at home.”
- If accused products were sold nationwide, the fact that some were sold in a venue does not mean that it has a localized interest.

QUESTIONS?

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Thank You

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