

No. 2021-____

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

IN RE INTEL CORPORATION,

Petitioner.

On Petition for Writ of Mandamus to the United States District Court for the Western District of Texas in Case No. 1:19-cv-977-ADA, Judge Alan D. Albright

**PETITIONER INTEL CORPORATION'S MOTION
FOR A STAY OF A DISTRICT COURT RETRANSFER ORDER PENDING
RESOLUTION OF MANDAMUS PETITION, AN EXPEDITED BRIEFING
SCHEDULE, AND/OR A TEMPORARY STAY OF THE PROCEEDING**

GREGORY H. LANTIER
RICHARD A. CRUDO
STEVEN J. HORN
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Avenue
Washington DC 20006
(202) 663-6000

WILLIAM F. LEE
JOSEPH J. MUELLER
LAUREN B. FLETCHER
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

*Attorneys for Petitioner
Intel Corporation*

January 4, 2021

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1	Order Granting Plaintiff VLSI's Emergency Motion to Retransfer Venue to Waco Pursuant to 28 U.S.C. §1404(a), Dkt. No. 408 (Dec. 31, 2020)
2	Transcript of Hearing on Plaintiff VLSI Technology LLC's Emergency Motion to Transfer Venue Back to Waco, held December 30, 2020, Dkt. 406 (Dec. 30, 2020)

RULE 27(A)(2) STATEMENT

Pursuant to Federal Rule of Appellate Procedure 8 and Federal Circuit Rule 8, Petitioner Intel Corporation (“Intel”) seeks a stay of the district court’s December 31, 2020 order retransferring this case from Austin to Waco pending resolution of Intel’s Petition for a Writ of Mandamus co-filed with this motion.¹ Given that trial in this case is scheduled to begin February 16, 2021 (with trial participants expected to begin traveling to Waco on February 8, 2021 in advance of jury selection), Intel also requests that this Court order expedited briefing on this motion and, if needed, enter a temporary stay pending the Court’s resolution of this motion.

Counsel for Respondent VLSI Technology LLC (“VLSI”) has informed counsel for Intel that VLSI opposes this motion and will file a response.

INTRODUCTION

Despite this Court’s grant of Intel’s first mandamus petition, the district court has again retransferred this action from Austin to Waco for the sole purpose of rushing to trial. Intel has filed a second mandamus petition because the district court’s second retransfer order disregards the guidance provided by this Court and misapplies the legal standards governing retransfer. The district court should not be permitted to conduct a jury trial in Waco while Intel’s second mandamus petition is

¹ On December 30, 2020, the district court denied Intel’s oral motion to stay the retransfer order pending resolution of Intel’s then-forthcoming mandamus petition. Ex. 2 at 40.

pending. A February 2021 trial would result in this case being tried in the wrong forum, without all of Intel's witnesses available to testify in person, and would expose case participants to significant health and safety risks during the COVID-19 pandemic. Such harm cannot be undone after the fact.

Granting a stay pending review of Intel's second mandamus petition will promote each of the factors this Court must consider. First, Intel's petition is likely to succeed, and at least presents a substantial case on the merits, because the district court's retransfer ruling ignores this Court's instruction that a proper retransfer analysis must show "that 'unanticipated post-transfer events frustrated the original purpose for transfer' of the case from Waco to Austin originally." *In re Intel Corp.*, __ F. App'x __, 2020 WL 7647543, at *3 (Fed. Cir. Dec. 23, 2020) (quoting *In re Cragar Indus., Inc.*, 706 F.2d 503, 505 (5th Cir. 1983)). Intel's petition is also likely to succeed because the district court erroneously concluded that retransfer to Waco is now supported by an analysis under 28 U.S.C. §1404(a)—contrary to its earlier determination that Austin is "clearly more convenient" than Waco. The district court reached this opposite result only after committing several legal errors, including improperly shifting the burden to Intel to show that Austin is still clearly more convenient than Waco, disregarding some of its earlier §1404(a) findings, placing undue weight on time-to-trial considerations, and ignoring evidence regarding the state of the COVID-19 pandemic.

Second, absent a stay, Intel would be irreparably harmed by being forced to try this case in the wrong forum, and during a continued surge in the COVID-19 pandemic. Third, a brief stay would not harm VLSI, which can be fully compensated by monetary damages if it prevails in this lawsuit. Finally, the public interest strongly favors a stay because it would contravene the public interest to force the parties, witnesses, court staff, and Waco jurors to risk their health and safety to try a case in Waco that implicates what the district court previously determined are issues relating to Austin.

Accordingly, Intel respectfully requests that this Court stay the district court's order retransferring this case to Waco while the Court considers Intel's mandamus petition. And given the February 16, 2021 trial date (which is expected to have jury selection on February 11, 2021, and will likely require case participants to travel to Texas beginning February 8, 2021), Intel respectfully requests that the Court order expedited briefing on this motion and, if needed, enter a temporary stay of the district court's retransfer order pending the Court's resolution of this motion.

BACKGROUND

A. This Court Grants Intel's First Mandamus Petition Following The District Court's First Order Retransferring This Case From Austin To Waco.

As is more fully described in Intel's pending mandamus petition, in October 2019, the district court transferred this case from the Waco Division to the Austin

Division based on its determination that Austin is “clearly more convenient” under 28 U.S.C. §1404(a) given its strong connections to the case. Appx152-161.² On November 20, 2020, the district court reversed course and retransferred the case to Waco solely because the Austin courthouse has temporarily stayed jury trials due to COVID-19, and the district court wished to proceed to trial in January 2021. Appx163-170. The district court justified its ruling based on Federal Rule of Civil Procedure 77(b) and the court’s “inherent power” to manage its docket. Appx165-168. The court stated that “its conclusion is fully in accord with the guidance provided” by *Cragar*. Appx168.

Intel filed a petition for a writ of mandamus. On December 23, 2020, this Court granted Intel’s petition and vacated the district court’s retransfer order. *Intel*, 2020 WL 7647543, at *3. The Court held that neither Rule 77(b) nor the district court’s “inherent authority for docket management ... authorizes the order at issue[.]” *Id.* at *1. Further, the Court explained that a proper retransfer analysis must be “based on the traditional factors bearing on a §1404(a) analysis” and must show “that ‘unanticipated post-transfer events frustrated the original purpose for transfer’ of the case from Waco to Austin originally.” *Id.* at *3 (quoting *Cragar*, 706 F.2d at 505). The Court instructed that “[s]uch analysis should take into account

² The Appendix was filed with the Court as an attachment to Intel’s pending mandamus petition.

the reasons of convenience that caused the earlier transfer to the Austin division.”

Id.

B. The District Court Retransfers To Waco Again.

On December 23, 2020 (the same day this Court granted Intel’s mandamus petition), just before the close of business, VLSI filed an “emergency” motion to retransfer the case from Austin to Waco. Appx291-306. VLSI argued that the private and public interest factors under §1404(a) favor retransfer. Appx298-301. VLSI also argued that *Cragar* does not prohibit retransfer and that the district court “has already found that the purpose of [its] original transfer order transferring the case from Waco to Austin *will* be frustrated because the Austin courthouse is now closed indefinitely.” Appx301-303.

On December 26, 2020, the district court ordered Intel to respond by December 29, 2020. In its opposition to VLSI’s motion, Intel explained that retransfer from Austin to Waco was impermissible under *Cragar* and §1404(a). Appx307-321. Specifically, Intel argued that the underlying purpose of the district court’s original transfer—i.e., to have the case litigated and tried in the forum having the strongest ties thereto—had not been frustrated by the Austin courthouse’s temporary closure. Appx313-316. Intel explained that VLSI’s arguments to the contrary conflicted with this Court’s clear direction that an analysis of whether “unanticipated post-transfer events frustrate the original purpose for transfer” under

Cragar “should take into account the reasons of convenience that caused the earlier transfer to the Austin division.” Appx314-316. Intel also explained that the §1404(a) factors that the district court previously found to favor Austin continue to favor Austin, and that Austin is even more appropriate now than it was at the time of the district court’s original transfer ruling because the state of the COVID-19 pandemic is worse in Waco than in Austin. Appx316-320.

The district court heard oral argument on December 30, 2020. Focused on its desire to try this case by February 2021, the court decided that “it is appropriate for me to transfer the case back to Waco.” Ex. 2 at 30. The court reset the trial date for February 16, 2021, to allow time for this Court to address the retransfer because “it would be good for the [Federal] Circuit to tell me whether or not I’m properly applying [the §1404(a) factors] in terms of the retransfer.” *Id.* at 30-32. The district court also denied Intel’s oral motion to stay the retransfer order pending resolution of Intel’s then-forthcoming mandamus petition. *Id.* at 40.

On December 31, 2020, the district court issued a written order retransferring venue to Waco. Ex. 1. The court “reevaluate[d] its §1404(a) analysis in light of the pandemic” and found “at least two factors weigh in favor of transferring the case back to Waco” (both based on time-to-trial considerations) and “one factor is against transferring to Waco” (based on Austin’s “localized interests”). Ex. 1 at 5-11. Without considering Intel’s evidence showing that the COVID-19 pandemic is

actually *worse* in Waco than in Austin, the court then concluded that *Cragar* was satisfied because “the pandemic has frustrated transfer by changing what was clearly more convenient pre-pandemic to what is not clearly more convenient mid-pandemic.” *Id.* at 11.

With trial scheduled to begin in Waco on February 16, 2021 (and with case participants likely required to begin traveling to Waco on February 8, 2021, and jury selection expected to begin on February 11, 2021), Intel promptly filed its petition for mandamus and this motion to stay.

LEGAL STANDARD

In deciding whether to stay district court proceedings pending appellate review, this Court generally considers “(1) whether the stay applicant has made a strong showing that it is likely to succeed on the merits; (2) whether the applicant will be irreparably injured absent a stay; (3) whether issuance of a stay will substantially injure the other parties interested in the proceeding; and (4) where the public interest lies.” *Nken v. Holder*, 556 U.S. 418, 425-426 (2009) (quoting *Hilton v. Braunskill*, 481 U.S. 770, 776 (1987)); see *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 897 F.2d 511, 512 (Fed. Cir. 1990); *Ruiz v. Estelle*, 650 F.2d 555, 565 (5th Cir. 1981).

Even where the Court determines that the moving party is not “likely to succeed on the merits,” a stay is still warranted if the movant “nonetheless

demonstrate[s] a *substantial case* on the merits,’ provided the other factors militate in [the] movant’s favor.” *Standard Havens*, 897 F.2d at 513 (emphasis altered) (quoting *Hilton*, 481 U.S. at 778); *see also Ruiz*, 650 F.2d at 565 (“[O]n motions for stay pending appeal[,] the movant need not always show a ‘probability’ of success on the merits; instead, the movant need only present a *substantial case* on the merits when a serious legal question is involved and show that the balance of the equities weighs heavily in favor of granting the stay.” (emphasis added)).

As described below, these factors clearly favor a stay of the district court’s retransfer order under the circumstances here.

ARGUMENT

I. THE COURT SHOULD STAY THE DISTRICT COURT’S RETRANSFER ORDER PENDING MANDAMUS REVIEW.

A. Intel’s Petition Is Likely To Succeed And, At A Minimum, Presents A Substantial Case On The Merits.

Intel respectfully submits that it is likely to prevail on the merits of its mandamus petition. At the very least, Intel has presented a “substantial case on the merits” so as to warrant a brief stay pending the Court’s resolution of its petition, particularly in view of the fact that the Court has *already* granted mandamus relief as to similar issues implicated in Intel’s first petition. Further, the district court committed multiple legal errors and abused its discretion by retransferring the case to Waco shortly before trial.

1. As explained in Intel’s pending mandamus petition, the district court erred by failing to faithfully apply *Cragar*. This Court explained in its mandamus order that an analysis of whether “unanticipated post-transfer events frustrate the original purpose for transfer” under *Cragar* “should take into account the reasons of convenience that caused the earlier transfer to the Austin division.” *Intel*, 2020 WL 7647543, at *3. The district court did not heed these instructions and instead cited its now-vacated retransfer order, stating that it “believed and continues to believe” that retransfer is appropriate under *Cragar*. Ex. 1 at 5 (citing Appx168). By failing to explain how the unanticipated post-transfer event—i.e., the Austin courthouse’s temporary closure due to COVID-19—affected the specific “reasons of convenience that caused the earlier transfer to the Austin division,” the district court failed to properly apply *Cragar*, much less as instructed by this Court.

The *Cragar* standard for retransfer cannot be satisfied here. Time-to-trial did not serve as a basis for the district court’s original transfer ruling. Instead, the district court’s original transfer order was based on the fact that Austin’s strong nexus to the case made the “relative ease of access to sources of proof,” the “cost of attendance,” and the “localized interests” all favor Austin over Waco. Appx156-161. The district court found that each of those factors favored Austin over Waco because “Intel has a campus in Austin, but not in Waco,” “Intel employs a significant number of people working in Austin,” most of the named inventors “reside in Austin while none reside

in Waco,” and “most of the patents were invented in Austin, by inventors residing in Austin, while working at companies (Freescale and Sigmatel, now NXP) in Austin.” *Id.* None of these factors or the key facts underlying them have been affected by the Austin courthouse’s temporary closure, and the district court did not explain otherwise. Thus, while the Austin courthouse’s temporary closure due to COVID-19 was unanticipatable, it did not frustrate the underlying purpose of the original transfer to Austin. On the contrary, that purpose can still be given full effect by trying this case in Austin when the courthouse there reopens.

2. Even if the *Cragar* standard were met, retransfer from Austin to Waco would still be unwarranted under §1404(a). The district court previously found that Austin is “clearly more convenient” than Waco because Austin, unlike Waco, has substantial connections to this case and a strong localized interest in deciding it. Appx156-161. That determination was correct at the time it was made and remains so today. In ordering retransfer based on the opposite conclusion now, the district court committed several legal errors.

To begin with, the district court applied an incorrect legal standard that improperly shifted the burden to Intel. Rather than assessing whether *VLSI* (the party moving for retransfer) had demonstrated under §1404(a) that Waco is now “clearly more convenient” than Austin, the court determined that *Intel* failed to show that Austin remains as convenient today as it was one year ago. That error alone

warrants mandamus relief. *See In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc) (transfer appropriate only when “***the movant demonstrates*** that the transferee venue is ***clearly more convenient***” (emphases added)); *In re Nitro Fluids L.L.C.*, 978 F.3d 1308, 1312 (Fed. Cir. 2020) (“[E]rror concerning the legal standard for assessing whether transfer is required ... warrants mandamus relief[.]”).

The district court also misapplied the §1404(a) factors to the facts of the case and improperly balanced those factors. The factors that the district court previously found favor Austin over Waco still favor Austin, and, if anything, the present circumstances favor Austin more now because the COVID-19 risks are ***worse*** in Waco than in Austin. Nevertheless, the district court misapplied the §1404(a) analysis by discounting those factors and finding that two other factors both favored retransfer to Waco solely because the court could hold a trial there in February 2021 while the Austin courthouse is closed. Ex. 1 at 8-10. In so doing, the district court improperly elevated time-to-trial considerations in contravention of this Court’s precedent warning against placing undue weight on such considerations. *See In re Apple Inc.*, 979 F.3d 1332, 1344 & n.5 (Fed. Cir. 2020) (“[T]he speed of the transferee district court should not alone outweigh all [the] other factors[.]”); *In re Adobe Inc.*, 823 F. App’x 929, 932 (Fed. Cir. 2020) (“[T]he district court erred in giving this factor dispositive weight[.]”).

The district court also ignored Intel’s evidence demonstrating that the state of the COVID-19 pandemic is *worse* in Waco than in Austin. Appx180-182.³ Intel also explained that it would greatly contravene the public interest to force trial participants to risk their health and safety to try a case in Waco that implicates what the district court previously found were Austin-related issues. Appx311; Appx320. The district court did not even consider any of this in its §1404(a) analysis. *See* Ex. 1 at 6-11.

In light of these significant errors, Intel is likely to succeed on the merits of its mandamus petition and, at the very least, has presented a “substantial case on the merits” so as to warrant a brief stay pending the Court’s resolution of its petition.

B. Intel Would Be Irreparably Harmed Absent A Stay, As The Harm Caused By A February 2021 Trial In Waco Cannot Be Undone After Trial.

Failing to stay the district court’s retransfer order would irreparably harm Intel. For the past year, Intel has relied on the district court’s original transfer ruling in preparing this case for trial in Austin and has spent significant time and effort addressing logistical considerations for an Austin trial. Now, contrary to the district court’s original transfer order and this Court’s prior mandamus order, the district

³ *Waco-McLennan County COVID-19 Statistics*, <http://covidwaco.com/county> (visited Jan. 2, 2021); *Texas COVID-19 Data, New Confirmed Cases over Time by County*, <https://dshs.texas.gov/coronavirus/additionaldata.aspx> (visited Jan. 2, 2021); *Texas COVID-19 Data, Estimated Active Cases over Time by County*, <https://dshs.texas.gov/coronavirus/additionaldata.aspx> (visited Jan. 2, 2021).

court has retransferred the case to Waco. *See Odem v. Centex Homes, Inc.*, 2010 WL 2382305, at *2 (N.D. Tex. May 19, 2010) (refusing to retransfer and finding that the defendant “would be prejudiced by retransfer at this late stage of the proceedings”), *adopted*, 2010 WL 2367332 (N.D. Tex. June 8, 2010).

Absent a stay, Intel would be forced to try this case in Waco—even though, as the district court found in its original transfer ruling, this case has substantial connections to Austin and no connections to Waco. If this Court does not stay the retransfer order pending resolution of Intel’s mandamus petition, Intel would be subject to the very harm its petition seeks to prevent—having a Waco jury, rather than an Austin jury, decide this Austin-related case. *See Asbury v. Germania Bank*, 752 F. Supp. 503, 505 (D.D.C. 1990) (retaining in the District of Columbia case involving “Illinois parties, Illinois witnesses, Illinois facts, and Illinois law ... borders on a violation of due process”).

Even more concerning, moving forward with a trial in Waco in February 2021 would unnecessarily put all case participants, including Intel’s trial team—i.e., its corporate representatives, witnesses, lawyers, and support staff—at risk of contracting or spreading COVID-19 during the continued surge of the pandemic. The recent infection rates in McLennan County (Waco) are concerningly high. *Coronavirus (COVID-19): Waco—McLennan County Public Health District*, available at <https://covidwaco.com/county/> (visited Jan. 2, 2021). Waco-McLennan

County hospitals have been flooded with patients testing positive for coronavirus and are now pushed to their limits with nearly all ICU beds occupied. *Id.*

In light of these troubling statistics, Dr. Cristie Columbus, Medical Director for epidemiology and infectious diseases at Baylor University Medical Center, explained that “there is a high likelihood that individuals would be infected” if trial were to proceed in Waco during the continued surge in the COVID-19 pandemic, particularly given that dozens of people would need to travel to Waco from across the country and the trial would necessarily be held in an indoor space. Appx188-192. These serious risks simply cannot be mitigated after trial. Indeed, Intel’s trial team includes attorneys and at least one expert witness who are considered at high risk of serious complications if they contract the virus. Appx171-174; Appx176-178.

C. A Brief Stay Would Not Harm VLSI, Which Does Not Sell Any Products Or Practice The Patents.

By contrast, a stay pending resolution of Intel’s mandamus petition would not harm VLSI. As an initial matter, the patents-in-suit issued in 2009 and 2010, some accused products have been on sale since 2013, and VLSI only acquired the patents a few months before filing suit in 2019. There is thus no time-sensitive reason to try this case in February 2021. VLSI has never contended otherwise.

Moreover, given the exigency associated with Intel’s petition, and this Court’s prompt resolution of such matters, any delay from a stay pending mandamus review

is likely to be short in duration. And any harm to VLSI from this brief delay would be minimal. VLSI—a two-employee company backed by a multi-billion dollar hedge fund—does not make or sell any products, let alone any that practice the patents-in-suit. It thus can be fully compensated by potential money damages regardless of when trial occurs. *In re Morgan Stanley*, 417 F. App'x 947, 950 (Fed. Cir. 2011) (“[W]e do not regard the prospective speed with which this case might be brought to trial to be of particular significance” where plaintiff “does not make or sell any product[.]”).

Under these circumstances, a slight delay in VLSI’s potential monetary recovery is simply an insufficient basis to deny a stay. *See VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1318-1319 (Fed. Cir. 2014) (reversing district court order denying stay and explaining that “[a] stay will not diminish the monetary damages to which [a plaintiff] will be entitled if it succeeds in its infringement suit—it only delays realization of those damages”); *Crossroads Sys., Inc. v. Dot Hill Sys. Corp.*, 2015 WL 3773014, at *2 (W.D. Tex. June 16, 2015) (“[M]ere delay in collecting [monetary] damages does not constitute undue prejudice.”).

D. The Public Interest Strongly Favors A Stay Over Forcing Waco Jurors And Case Participants To Risk Their Safety During A Continued Surge Of The COVID-19 Pandemic.

The public interest strongly favors a stay of the district court’s retransfer order pending resolution of Intel’s mandamus petition.

If the Court ultimately grants Intel’s petition and reverses the district court’s retransfer order after trial begins in Waco (or even after the parties’ trial teams have traveled to Waco for trial), then everyone involved in the trial—including the district court and its staff, the parties, witnesses, and jurors—will have invested time and effort in a trial that needs to be redone in Austin.

What is worse, they will have done so during a troubling time in the COVID-19 pandemic, putting themselves and members of the Waco community at risk of contracting or spreading the virus. The public interest is promoted by ensuring the wellbeing of all those involved, not by jeopardizing participants’ health and safety just so a patent case in which the plaintiff seeks money damages can be adjudicated as quickly as possible. *Cf. Ortuño v. Jennings*, 2020 WL 1701724, at *4 (N.D. Cal. Apr. 8, 2020) (“[T]he public interest in promoting public health is served by efforts to contain the further spread of COVID-19[.]”); *Castillo v. Barr*, 449 F. Supp. 3d 915, 923 (C.D. Cal. 2020) (“The public has a critical interest in preventing the further spread of the coronavirus.”); *Coronel v. Decker*, 449 F. Supp. 3d 274, 287 (S.D.N.Y. 2020) (“[B]oth Petitioners and the public benefit from ensuring public health and safety.”).

Further, there is a public interest in having this case tried in the forum having the strongest ties to the case. *American Dredging Co. v. Miller*, 510 U.S. 443, 448 (1994) (“There is a local interest in having localized controversies decided at

home.”); *Halo Creative & Design Ltd. v. Comptoir Des Indes Inc.*, 816 F.3d 1366, 1369 (Fed. Cir. 2016) (same); *Koehring Co. v. Hyde Constr. Co.*, 324 F.2d 295, 296 (5th Cir. 1963) (same). As the district court has continued to recognize, the Austin community has a strong localized interest in this case because of its many Austin connections thereto. Ex. 1 at 10; Appx156-161. Thus, if the Court grants Intel’s petition, the district court will be able to further the Austin community’s strong public interest by conducting a trial in Austin, with an Austin jury deciding this Austin-related case.

On the other hand, it would undermine the public interest to impose the burden of jury duty on Waco residents where Waco has no connection to this case. *See In re Volkswagen AG*, 371 F.3d 201, 206 (5th Cir. 2004) (“[J]ury duty is a burden that ought not to be imposed upon the people of a community which has no relation to the litigation.”). This is true during the best of times, and it is especially true during a pandemic.

Finally, there is a “general public policy of preserving judicial resources from the risk of reversal.” *Cruson v. Jackson Nat’l Life Ins. Co.*, 2018 WL 2937471, at *5 (E.D. Tex. June 12, 2018) (quoting *Weingarten Realty Inv’rs v. Miller*, 661 F.3d 904, 913 (5th Cir. 2011)). As explained above, Intel’s petition presents a substantial case on the merits—including questions regarding the applicable legal standard and the scope of a district court’s authority in deciding where to conduct a jury trial.

Therefore, public policy favors temporarily staying proceedings to ensure that the correct legal standard is applied and that the upcoming trial is held in the appropriate forum.

II. THE COURT SHOULD ORDER AN EXPEDITED BRIEFING SCHEDULE FOR THIS STAY MOTION AND/OR GRANT A TEMPORARY STAY.

Given the timing considerations at issue, Intel respectfully requests that the Court order expedited briefing on this motion. Specifically, Intel requests that the Court order VLSI to file any response to this motion no later than January 11, 2021, and Intel to file any reply no later than January 14, 2021. *See In re Comcast Cable Commc'ns, LLC*, No. 17-114, ECF No. 11 at 2 (Fed. Cir. Mar. 2, 2017) (staying district court order pending resolution of mandamus petition, and ordering respondent to respond by the next day).

Additionally (or alternatively), if needed to afford this Court sufficient time to consider and rule on this stay motion before case participants must start traveling to Waco for trial (with such travel likely beginning on February 8, 2021), Intel requests that the Court enter a temporary stay of the district court's retransfer order pending resolution of this motion. *See, e.g., Waymo LLC v. Uber Techs., Inc.*, No. 17-2253, ECF No. 5 at 2 (Fed. Cir. June 30, 2017) (ordering temporary stay pending Court's consideration of motion papers); *In re Greg Abbott*, No. 20-50264, at 1 (5th Cir. Mar. 31, 2020) (temporarily staying district court order pending consideration of emergency motion for stay).

CONCLUSION

For the foregoing reasons, Intel respectfully requests that the Court grant this motion and stay the district court's retransfer order pending resolution of Intel's mandamus petition. Intel also requests that the Court order expedited briefing on this motion and, if needed, enter a temporary stay of the district court's retransfer order pending the Court's resolution of this motion.

Respectfully submitted,

/s/ William F. Lee

WILLIAM F. LEE
JOSEPH J. MUELLER
LAUREN B. FLETCHER
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

*Attorneys for Petitioner
Intel Corporation*

GREGORY H. LANTIER
RICHARD A. CRUDO
STEVEN J. HORN
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Avenue
Washington DC 20006
(202) 663-6000

January 4, 2021

CERTIFICATE OF INTEREST

Counsel for Petitioner Intel Corporation certifies the following:

1. Represented Entities. Fed. Cir. R. 47.4(a)(1). Provide the full names of all entities represented by undersigned counsel in this case.

Intel Corporation

2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2). Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None.

3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3). Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

None.

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

WILMER CUTLER PICKERING HALE AND DORR LLP: Arthur W. Coviello, Jeffrey A. Dennhardt, Felicia H. Ellsworth, Jordan L. Hirsch, Thomas Lampert, James M. Lyons, Amanda L. Major, George F. Manley, Alexis Pfeiffer, Kate Saxton, Mary V. Sooter, Joshua L. Stern, Louis W. Tompros, Anh-khoa Tran, Paul T. Vanderslice

KELLY HART & HALLMAN LLP: J. Stephen Ravel, Sven Stricker (former)

PILLSBURY WINTHROP SHAW PITTMAN LLP: Brian C. Nash

James Eric Wren, III

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00254 (W.D. Tex.);
VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00255 (W.D. Tex.);
VLSI Technology LLC v. Intel Corp., No. 6:19-cv-00256 (W.D. Tex.);
In re Intel Corp., No. 21-105 (Fed. Cir. Dec. 23, 2020) (Prost, C.J., Lourie & Chen, JJ.) (per curiam order granting mandamus petition).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None.

Dated: January 4, 2021

/s/ William F. Lee
WILLIAM F. LEE
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109

EXHIBIT 1

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

<p>VLSI TECHNOLOGY LLC, <i>Plaintiff,</i></p>	<p>§ § § § § § § § §</p>	<p>1:19-CV-00977-ADA (lead case)</p>
<p>v.</p>		
<p>INTEL CORPORATION <i>Defendant.</i></p>		<p>6:19-CV-00254-ADA (member case)</p>

**ORDER GRANTING PLAINTIFF VLSI’S EMERGENCY MOTION TO
RETRANSFER VENUE TO WACO PURSUANT TO 28 U.S.C. § 1404(a)**

Before the Court is Plaintiff VLSI’s Motion to Transfer the -00254 case back to the Waco division pursuant to 28 U.S.C. § 1404(a), which was filed on December 23, 2020.¹ ECF #400. Defendant Intel filed its Response on December 29, 2020. ECF #403. VLSI filed its Reply on December 29, 2020. ECF #404. After considering all related pleadings, the relevant law, and the party’s oral arguments during a hearing conducted on December 30, 2020, the Court is of the opinion that VLSI’s Motion should be **GRANTED**.

I. Factual Background

VLSI sued Intel for allegedly infringing eight patents across the three cases. 6:19-cv-00254, ECF #1, 6:19-cv-00255, ECF #1 and 6:19-cv-00256, ECF #1. Intel filed a motion to transfer venue to the District of Delaware on May 20, 2019. ECF #24. The Court conducted a hearing on Intel’s Motion to Transfer on July 31, 2019. ECF #50. The Court agreed with VLSI that this District is the most sensible and convenient forum when the facts of the cases are properly considered. Transfer Order [ECF #53] at 16.

¹ VLSI originally filed three cases (6:19-cv-00254, 6:19-cv-00255, and 6:19-cv-00256) in the Waco division on April 11, 2019. The Court consolidated the three cases together on September 5, 2019, where the -00254 case was the lead case. ECF #69. The Court transferred the consolidated case to the Austin division on October 7, 2020. ECF #78.

About a week after the Court denied Intel's inter-district Motion to Transfer, Intel filed an intra-district Motion to Transfer, which would move the case from Waco to Austin. ECF #56. On October 7, 2019, the Court granted Intel's motion for intra-district transfer from the Waco Division to the Austin Division under 28 U.S.C. § 1404(a), finding that Austin was the more convenient venue at that time. ECF #78. At the time, trial for the first case was set for October 9, 2020. Oct. 7, 2019 Dkt. Entry.

Five months after that order was entered, the coronavirus pandemic began in the United States. Press Release, The White House, Message to the Congress on Declaring a National Emergency Concerning the Novel Coronavirus Disease (COVID-19) Outbreak (Mar. 13, 2020), <https://www.whitehouse.gov/briefingsstatements/message-congress-declaring-national-emergency-concerning-novel-coronavirus-disease-covid-19-outbreak/>.

The Court delayed the trial date twice, first to November 16, 2020 and again to January 11, 2020. ECF #161, #320. On October 9, 2020, the Court requested briefing from the parties to address whether it had authority to transfer the case back to Waco for trial. ECF #367-73. On November 20, 2020, after considering the briefing, oral arguments, and the relevant case law, the Court entered an order holding that, if the Austin courthouse did not reopen in time for a trial in early January, the trial for the -00254 case was transferred back to Waco pursuant to Rule 77(b) and the Court's inherent authority. ECF #352. Shortly after the Court entered its order, Intel filed a petition for writ of mandamus requesting that the Federal Circuit reverse this Court's order.

On December 23, 2020, the Federal Circuit granted Intel's petition and vacated this Court's retransfer order. *In re Intel*, 2020 WL 7647543, at *3 (Fed. Cir. 2020). The Federal Circuit held that neither Rule 77(b) nor this Court's inherent authority authorizes the transfer. *Id.* at *1. The Federal Circuit explained that a proper retransfer analysis must be based on a 28 U.S.C. § 1404(a)

analysis. *Id.* at *3. The appellate court further instructed that the § 1404(a) analysis should take into account the reasons of convenience that caused the transfer to the Austin division. *Id.* at *6.

On the same day as the Federal Circuit's order, VLSI filed the instant emergency motion to retransfer from Austin to Waco, which the parties have now fully briefed and argued before the Court on December 30, 2020.

II. Standard of Review

In the Fifth Circuit, the § 1404(a) factors apply to both inter-district and intra-district transfers. *In re Radmax Ltd.*, 720 F.3d 285, 288 (5th Cir. 2013). It is well-settled that trial courts have even greater discretion in granting intra-district transfers than they do in the case of inter-district transfers. *See, e.g., Sundell v. Cisco Systems Inc.*, 1997 WL 156824, at *1, 111 F.3d 892 (5th Cir. 1997) (“Under 28 U.S.C. § 1404(b), the district court has broad discretion in deciding whether to transfer a civil action from a division in which it is pending to any other division in the same district.”).

Title 28 U.S.C. § 1404(a) provides that, for the convenience of parties, witnesses and in the interests 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.

“Section 1404(a) is intended to place discretion in the district court to adjudicate motions for transfer according to an ‘individualized, case-by-case consideration of convenience and fairness.’” *Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 29 (1988) (quoting *VanDusen v. Barrack*, 376 U.S. 612, 622 (1964)). A motion for transfer, whether intra- or inter-district, involves a two-step analysis: 1) whether the case could have been properly brought in the forum to which transfer is sought and 2) whether transfer would promote the interest of justice and/or convenience

of the parties and witnesses. *Radmax*, 720 F.3d 285, 288; *see also In re Volkswagen of America, Inc.*, 545 F.3d 304, 312, 314 (5th Cir. 2004) (en banc).

The Fifth Circuit has held that “[t]he determination of ‘convenience’ turns on a number of public and private interest factors, none of which can be said to be of dispositive weight.” *Action Indus., Inc. v. US. Fid & Guar. Co.*, 358 F.3d 337, 340 (5th Cir. 2004). The private 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.” *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) (hereinafter “*Volkswagen I*”) (citing to *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 241 n.6 (1982)). The public factors include: “(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 of the application of foreign law.” *Id.*

III. Discussion

The -00254 case plainly *could* have been brought in the Waco Division. Indeed, VLSI originally filed the case in Waco and opposed Intel’s motion to transfer the cases to Austin. Accordingly, the first step in the analysis set forth in *Radmax* supports transfer back to Waco. *Radmax*, 720 F.3d 285, 288.

Under Fifth Circuit law, this Court retains discretion to retransfer an action back to the original district where it was filed when unanticipatable post-transfer events frustrate the original purpose for transfer. *In re Cragar Indus., Inc.*, 706 F.2d 503, 505-06 (5th Cir. 1983). Such unanticipated post-transfer events, in conjunction with the traditional factors bearing on a §

1404(a) analysis, are the appropriate statutory authority for moving an action from one court to another intra-district court. *Intel*, 2020 WL 7647543, at *5-6.

A. Unanticipatable post-transfer events frustrated the original purpose for transfer to the Austin Division.

As discussed extensively in this Court’s November 20, 2020 order, this Court believed and continues to believe that the decision to transfer the -00254 case back to Waco is in accord with the guidance provided in *Cragar*. ECF #352 at 6. In *Cragar*, Plaintiff filed suit in the Northern District of Mississippi, but later filed an unopposed motion to transfer to the Western District of Louisiana. *Cragar*, 705 F.2d at 504. Much later in the case, after one defendant filed a summary judgment motion, Plaintiff filed its retransfer motion seeking to return to the case to the Northern District of Mississippi, which the district court granted. *Id.* Defendants then filed a petition for a writ of mandamus regarding the transfer back to Mississippi. *Id.*

The Fifth Circuit wrote that “[w]hen such unanticipatable post-transfer events frustrate the original purpose for transfer, a return of the case to the original transferor court does not foul the rule of the case[.]” *Id.* at 505. The panel further stated that a retransfer should only be granted “under the most impelling and unusual circumstances.” *Id.* But because the panel did not find a unanticipatable post-transfer event that frustrated the purpose of the original transfer, the panel granted Defendants’ petition for writ of mandamus. *Id.* at 506. More specifically, the panel found that:

[W]e are unable to find that any event has occurred since the original transfer that was not reasonably foreseeable by [Plaintiff]. No new facts have been discovered. No new witnesses have been located. The only “change” is the realization of [Plaintiff] that his claim against Cragar cannot proceed and that General Motors may enjoy a defense in Louisiana it did not have in Mississippi, a matter concerning which we express no opinion. At best, Robinson's requested return to Mississippi is bottomed upon a realization that he may have made a tactical error in his original transfer request[.]

For ease of understanding, the following must be met to satisfy *Cragar*:

- 1) there must be an unanticipated post-transfer event that
- 2) frustrates the original purpose for transfer and
- 3) retransfer should be granted under the most impelling and unusual circumstances.

The Court has stated and both parties agree that the Austin courthouse's closure due to COVID-19 was an unanticipated post-transfer event. *See* ECF #352 at 7 and ECF #403 at 3-4. Further, the Court has stated and Intel does not dispute that the pandemic presents a quintessential "unusual and impelling circumstance" in which to order transfer. *See* ECF #352 at 7. Thus, the only remaining element is whether the pandemic has frustrated the original purpose of transferring the case to the Austin division. To do so, the Court reevaluates its § 1404(a) analysis in light of the pandemic. *Intel*, 2020 WL 7647543, at *6.

B. The private *Volkswagen* factors favor transferring the case to Waco.

i. The "relative ease of access to sources of proof" factor is neutral.

The Court previously found that this factor weighs in favor of transferring to the Austin division. ECF #78 at 5. The Court's conclusion rested on three points of reasoning, all of which are moot at this time.

First, the Court found that Intel's electronic documents would be easier to access from Austin than Waco, thus weighing the factor in favor of transfer. *Id.* But, since the transfer, document discovery is complete and readily available in electronic form to all parties. Intel argues in their response that disputes may arise before or during trial which might give rise to the importance of this factor, but, as VLSI noted in their reply brief, all copies of trial exhibits have already been exchanged. ECF # 403 at 12 and ECF #404 at 4-5.

Second, the Court found that documents from third parties would be easier to access from Austin than from Waco. *Id.* But, as described above, because document discovery is complete and

available in electronic form to counsel for all parties, access to third-party documents no longer has any bearing on relative ease of access to sources of proof.

Lastly, no Intel employee from Austin, nor any Dell witness, is expected to be a witness in the upcoming trial. ECF #400 at 6. Because of changed circumstances since the Court's October 2019 Order, this factor is neutral.

ii. The “compulsory process” factor is neutral.

The Court previously found that this factor weighed against transfer to Austin. ECF #78 at 6. At that time, the only witnesses that may need to be compelled to testify at trial were the Dallas-based non-party witnesses. *Id.* Now, however, there are now no Dallas-based fact witnesses on either party's witness list, so this factor is now neutral.

iii. The “cost of attendance” factor is neutral at minimum.

The Court previously found that this factor weighed strongly in favor of transfer to Austin. *Id.* at 7. But now, for the reasons described below, this factor is, at minimum, neutral, if not weighing in favor of transferring the case to Waco.

First, it is undisputed that hotel costs in Waco are cheaper than in Austin. *Id.* at 8, ECF #404 at 4. Second, both parties have requested and this Court has ruled that witnesses may testify via videoconferencing at trial, which fully alleviate inconvenience if there are witnesses either party decides to call who do not wish to travel. *See* ECF #404 at 4, ECF #366-2 at 2.

Third, in light of the above, for the witnesses that do travel: one will be coming from Austin and does not object to proceeding in Waco, two others that live in Austin are unlikely to be called, and the fourth lives within one hundred miles of the Waco courthouse.² Nafekh Decl. ¶ 7.

² To alleviate any concern of the rare possibility of added costs, VLSI has offered to cover these witnesses' costs of attendance in Waco. ECF #65 at 6.

Thus, because hotel costs are cheaper in Waco, witnesses may testify via videoconference, Austin witnesses' costs will be minimal, and VLSI has offered to cover costs of attendance, this factor is, at a minimum, neutral toward transferring the case to Waco.

iv. The “all other practical problems” factor weighs in favor of transfer.

The Court previously found that this factor was neutral. ECF #78 at 9. Now, however, because of the pandemic, scheduling a trial in the Austin courthouse presents a practical problem: it is closed for the foreseeable future.

More specifically, on December 21, 2020, Judge Yeakel and Judge Pitman entered the Tenth Order Relating to Entry Into the United States Courthouse Austin, Texas which extends the effective closure of the Austin courthouse at least through January 31, 2021.^{3,4} This comes after Chief Judge Garcia's December 10, 2020 Eleventh Supplemental Order Regarding Court Operations Under the Exigent Circumstances Created by the COVID-19 Pandemic for the Western District of Texas which provides a courthouse the option of moving forward with trials in the Western District.⁵

By contrast, as noted in the November 2020 Order, this Court has conducted multiple in-person hearings since the pandemic began and continues to be prepared to conduct this trial and others in Waco going forward. ECF #352 at 3.

³ See Tenth Order Relating to Entry Into the United States Courthouse Austin, Texas (W.D. Tex. Dec. 21, 2020), <https://www.txwd.uscourts.gov/wp-content/uploads/2020/12/TenthOrderRelatingToEntryIntoAustinCourthouse122120.pdf> (visited Dec. 30, 2020).

⁴ To be clear, the Court believes that the Austin courthouse will be closed for a significant portion of 2021. In particular, the Court has been told that the Austin courthouse will remain closed through at least March 2021. During the hearing on this this motion, the Court speculated that it thought that the Austin courthouse might be closed until June 2021, if not later.

⁵ See Eleventh Suppl. Order Regarding Court Operations Under the Exigent Circumstances Created by the COVID-19 Pandemic (W.D. Tex. Dec. 10, 2020), <https://www.txwd.uscourts.gov/wp-content/uploads/2020/12/OrderEleventhSupplementalCOVID121020.pdf> (visited Dec. 30, 2020).

Because Austin courthouse is closed for the foreseeable future, but the Waco courthouse is open, this factor weighs in favor of transferring the case to Waco for a February trial.

C. The public *Volkswagen* factors favor transferring the case to Waco.

i. The “administrative difficulties flowing from court congestion” factor weighs in favor of transfer.

The Court previously found this factor to be neutral. ECF #78 at 10. But now because the Austin courthouse is closed, this case can only move forward in the Waco courthouse in the near future. As this Court noted in the December 30 hearing, this Court is extremely busy and has at least one trial scheduled every month from now through 2022. ECF #406 at 24. Delaying one trial means moving another.⁶

Here, the delay associated with holding the trial in Austin is not the “garden variety” delay associated with transfer. *In re Radmax, Ltd.*, 720 F.3d 285, 289 (5th Cir. 2013). Rather, the delay here is at least five months long (November 2020 to April 2021) and will likely be at least seven or eight months. As such, the Court finds that this is one of those “rare and special circumstances” where “a factor of ‘delay’ or of ‘prejudice’ might be relevant in deciding the propriety of transfer.” *In re Horseshoe Entm’t*, 337 F.3d 429, 434 (5th Cir. 2003).

But, as Intel correctly noted in their brief, this factor cannot receive dispositive or undue weight in a § 1404(a) analysis. *See* ECF #403 at 13 *citing In re Adobe Inc.*, 823 F. App’x 929, 932 (Fed. Cir. 2020). This Court takes note of the Federal Circuit’s guidance and does not attribute dispositive or undue weight to this factor but accords it weight equivalent to that given to other factors.

⁶ Given the expected amount of trial time, the trial in this case may last more than a week which would require moving multiple other trials.

After weighing the facts and the applicable law from the Fifth and Federal Circuits, the Court concludes that this factor weighs in favor of transferring the case to Waco.

ii. The “localized interest” factor weighs against transfer.

The Court previously found that this factor was weighed in favor of transfer. ECF #78 at 10. As the parties have noted in their briefs, the facts relating to localized interest have not changed materially since the Court’s October 2019 ruling. More specifically, Intel still has a campus in Austin, the patents-in-suit still originated in Austin-based companies and inventors reside in Austin. Thus, the “localized interest” factor weighs against transferring the case to Waco.

iii. The remaining public factors are neutral.

Finally, the Court previously found that the remaining public factors (familiarity of the forum with law that will govern case and problems associated with conflict of laws) are neutral. Neither party argued these factors. As such, the Court concludes that these factors are still neutral.

IV. Conclusion

The following table summarizes the Court’s conclusions for each factor and the Court’s current reassessment of those factors:

Factor	Pre-Pandemic (October 2019)	Mid-Pandemic (December 2020)
Relative ease of access to sources of proof	Weighs in favor of transfer to Austin	Neutral
Compulsory process	Slightly weighs against transfer to Austin	Neutral
Cost of attendance	Strongly weighs in favor of transfer to Austin	Neutral at minimum
All other practical problems	Neutral	Weighs in favor of transfer to Waco
Localized interest	Weighs in favor of transfer to Austin	Weighs against transfer to Waco

Administrative difficulties flowing from court congestion	Neutral	Weights in favor of transfer to Waco
Familiarity of the forum with law that will govern case	N/A	N/A
Problems associated with conflict of law	N/A	N/A

Previously, three factors weighed in favor of transferring to the Austin division while one factor slightly weighed against. Now, at least two factors weigh in favor of transferring the case back to Waco (*i.e.*, would have weighed against transferring to Austin), one factor is against transferring to Waco (*i.e.*, would have weighed for transferring to Austin) and the remaining factors are neutral. Thus, the pandemic has frustrated transfer by changing what was clearly more convenient pre-pandemic to what is not clearly more convenient mid-pandemic. Because this satisfies the final element of *Cragar*, the Court finds that it is appropriate to retransfer the case back to Waco pursuant to *Cragar* and 28 U.S.C. § 1404(a).

As such, the Court finds that Plaintiff VLSI's Motion to Transfer the -00254 case pursuant to 28 U.S.C. § 1404(a) should be and hereby is **GRANTED**. The Court orders -00254 case be unconsolidated from the -00977 case and **TRANSFERRED** back to the Waco Division. To be clear, nothing in this Order affects the patents in the -00255 and -000256 cases.

SIGNED this 31st day of December, 2020.



ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

EXHIBIT 2

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

VLSI TECHNOLOGY LLC *
*
VS. * CIVIL ACTION NO. AU-19-CV-977
*
INTEL CORPORATION * December 30, 2020

BEFORE THE HONORABLE ALAN D ALBRIGHT, JUDGE PRESIDING
MOTION HEARING (via Zoom)

APPEARANCES:

For the Plaintiff: Morgan Chu, Esq.
Benjamin W. Hattenbach, Esq.
Alan J. Heinrich, Esq
Dominik Slusarczyk, Esq.
Charlotte J. Wen, Esq.
Amy E. Proctor, Esq.
Ian Robert Washburn, Esq.
Babak Redjaian, Esq
Iian D. Jablon, Esq.
Brian Weissenberg, Esq.
Jordan Nafekh, Esq.
Elizabeth C. Tuan, Esq.
Irell & Manella, L.L.P.
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067-4276

J. Mark Mann, Esq.
Andy W. Tindel, Esq.
Mann, Tindel & Thompson
112 East Line Street, Suite 304
Tyler, TX 75702

For the Defendant: William F. Lee, Esq.
Joseph Mueller, Esq.
Felicia H. Ellsworth, Esq.
WilmerHale
60 State Street
Boston, MA 02109

Josh L. Stern, Esq.
Steven Horn, Esq.
Amanda L. Major, Esq.
Wilmer Cutler Pickering Hale Dorr LLP
1875 Pennsylvania Ave., NW
Washington, DC 20006

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Mary V. Sooter, Esq.
Wilmer Cutler Pickering Hale Dorr LLP
1225 17th Street, Suite 2600
Denver, CO 80202

J. Stephen Ravel, Esq.
Kelly Hart & Hallman LLP
303 Colorado Street, Suite 2000
Austin, TX 78701

James Eric Wren, III, Esq.
Baylor University Law School
One Bear Place #97288
Waco, TX 76798-7288

Court Reporter:

Kristie M. Davis
United States District Court
PO Box 20994
Waco, Texas 76702-0994
(254) 666-0904/kmdaviscsr@yahoo.com

Proceedings recorded by mechanical stenography, transcript
produced by computer-aided transcription.

1 (December 30, 2020, 10:02 a.m.)

2 DEPUTY CLERK: Motion hearing by Zoom in Civil Action
3 1:19-CV-977, styled VLSI Technology LLC versus Intel
4 Corporation.

5 THE COURT: If I could hear announcements from counsel,
6 please.

7 MR. MANN: Yes, Your Honor. Good morning. Mark Mann and
8 Andy Tindel from Mann Tindel & Thompson. And I'm going to
9 announce all those that will participate depending on what the
10 Court takes up. Morgan Chu from Irell & Manella.

11 MR. CHU: Good morning, Your Honor.

12 THE COURT: Good morning.

13 MR. MANN: Ben Hattenbach, Alan Heinrich, Amy Proctor, Ian
14 Washburn, Iian Jablon, Elizabeth Tuan, Dominik Slusarczyk,
15 Babak Redjaian, Jordan Nafekh, Brian Weissenberg and Charlotte
16 Wen.

17 And we're ready to proceed, Your Honor.

18 THE COURT: If you'll --

19 MR. RAVEL: Your Honor, for defendant Intel, it's Steve
20 Ravel. From our clients, Kim Schmitt and Mashood Rassam.

21 From Waco, Jim Wren.

22 From Wilmer, Bill Lee, Joe Mueller, Mindy Sooter, Josh
23 Stern, Steven Horn and Thomas Lampert. Others are attending
24 just in case.

25 Mr. Lee will be our primary speaker today.

1 THE COURT: Very good.

2 MR. MANN: Your Honor, excuse me. I left off
3 Mr. Stolarski, Michael Stolarski who's our company
4 representative. I just wanted to acknowledge that. Thank you.

5 THE COURT: I appreciate him and everyone else who has
6 taken the time to attend that's in-house. Obviously this is an
7 important issue that we've got to take up this morning.

8 Mr. Mann, you're the one who filed the motion. However,
9 I'm not sure if you're the one that is going to be arguing.
10 I'm happy to hear.

11 And let me say I appreciate you all working so quickly.
12 We got all the briefing. I know it was a short schedule, but
13 obviously I wanted to get to this as quickly as possible. And
14 I'll let you know that I have reviewed everything that you all
15 have sent in. So I'm prepared to hear the motion -- the
16 emergency motion that was filed by VLSI.

17 MR. MANN: Your Honor, I'm Mark Mann on behalf of VLSI,
18 and may it please the Court, I know the Court has reviewed the
19 briefing so I'm going to be fairly brief. But as the Court
20 knows, the standard in this case is whether there's an
21 impelling and unusual circumstance that frustrates the original
22 decision of the Court.

23 The Court has already found that the pandemic frustrated
24 the original purpose of the transfer. So I won't be going into
25 the COVID issues unless the Court wants to hear that later on,

1 but I think that's been well-argued in our previous hearing the
2 day of the mandamus, so I don't plan on touching on that much.

3 THE COURT: Mr. Mann, let me ask you this: Let me -- I'm
4 sorry to interrupt you, and you are welcome to add -- I'm
5 sorry, I'm having to -- we're having to -- my phone is in my
6 car which hopefully I'll get back as well. But I'm having to
7 rely on different things.

8 Help me out here. My sense of what the Federal Circuit
9 told me was that I -- if for lack of a more articulate way of
10 putting it, the way I had -- the rule that I had relied on to
11 transfer it back to Waco was incorrect. In essence, you can't
12 take, like a part of a -- you can't just say I'm going to put
13 the trial somewhere else, under that rule. I mean, I think
14 what they said -- I might be able to do that if the parties
15 agreed, for example. But I can't just move it.

16 But my sense of the Circuit's order was that I do have the
17 power to move it. And they specifically -- I think they
18 specifically said -- not that they were endorsing that I could
19 as much as that I had the power to do that. And was that your
20 takeaway from the Circuit decision?

21 MR. MANN: Yes. Exactly, Your Honor. I think what we
22 read the Court to say is that the analysis the Court has
23 previously done they would not accept, but if we did a 1404(a)
24 analysis, considering Cragar, that allows the Court to
25 reconsider issues that are frustrating this purpose, that you

1 do have the power to send the case back, send the whole case
2 back to Waco. And that's what we're arguing that you can and
3 should do because of 1404(a) and, you know, the private and
4 public factors.

5 THE COURT: Because if you think about it in this case, it
6 was my decision really -- I guess Intel asked me to maybe, but
7 it was really my decision to divide the trials. It was one
8 case and I made the decision that we would divide it up into
9 smaller bites, as it were, for trial because of the size of the
10 patents.

11 But if you think about it that way, since it was filed as
12 a case, it would make more sense for it to be transferred back
13 as -- for the full case to be transferred back.

14 I've been looking at it as three trials just as a
15 practical matter, but it was filed as a case. And in fact, I
16 don't know that there would be any reason -- and I'm not
17 planning on doing this, but for example, there's no reason I
18 couldn't, I guess, reassemble all the patents into one trial
19 and it be one trial wherever was appropriate, correct?

20 MR. MANN: I think that's correct, Your Honor. And I
21 think once the case is transferred back, the full case, then
22 the Court has the right to control its docket and how it
23 handles the case. It can separate them out then, basically in
24 Waco again.

25 THE COURT: Right.

1 MR. MANN: So that is our position. We think it's pretty
2 clear the Court has had these three cases from the outset. And
3 for the Court's purposes and for, you know, the litigants'
4 purposes to be able to divide the case up where it's, in your
5 words, more easily digestible by the jury.

6 THE COURT: And let me put also on the record here that
7 the part of the reason -- and I think I may have said this
8 earlier, but I definitely want -- it's worth reiterating is
9 while I understand it goes partly to the COVID thing, I guess,
10 you know, when we'll -- the Austin court reopening, when
11 will -- when we'll be able to have trials. But it is part of
12 the issue in this case that if I don't get a trial -- if I
13 don't get this third of the case tried, you know, then we may
14 be looking at -- if we were to -- if we were to -- if I were to
15 push back the trial date, it might be wiser or necessary, for
16 lack of wisdom, for me to have to do just one trial and try all
17 the patents at one time.

18 Because the problem I'm having is I don't have a March or
19 April or -- for example, Intel's suggestion that I can -- we
20 can just do this in May or April, I guess because of the
21 availability of the Austin courthouse perhaps. You know, I'm
22 already planning to have one of the other trials in this case
23 in that month -- or those months.

24 So maybe another alternative would be to have just one
25 trial. I know we're here to decide where that trial will be,

1 whether Waco or Austin or where the case should be. But I'm
2 just saying there are a lot of considerations that I've got to
3 take into respect here. So...

4 MR. MANN: Your Honor, I wanted to back up just a minute.
5 I know the Court said -- we did file three separate cases.

6 THE COURT: Okay.

7 MR. MANN: The Court did consolidate them for discovery.

8 THE COURT: Okay.

9 MR. MANN: And then specifically said, if I remember
10 right, that we'll make a decision about how we divide the cases
11 up later on.

12 THE COURT: Okay. So I interrupted you, but -- so but
13 basically I can transfer all three of the cases back to Waco is
14 your reading of the Circuit?

15 MR. MANN: Yes. Yes, Your Honor. And I think part of
16 what the Court just hit on was one of the public factors, and
17 that is the administrative difficulties flowing from the Court
18 congestion.

19 I think what the Court was trying to say, if I anticipate
20 you right is that not only do we frustrate the purpose of
21 (audio disruption) being able to carry on three cases, you
22 know, the three separate cases, but it causes congestion of all
23 the other cases that the Court has. And so part of the
24 decisionmaking of the Court is not only how this affects the
25 flow of the Court congestion for our case, but for other cases

1 too.

2 But if the Court would indulge me, what I wanted to say is
3 that in doing 1404(a) analysis, it's not just stacking up the
4 eight different factors, the public and private factors, but
5 part of the decisionmaking in 1404(a) is the interest of
6 justice. And the interest of justice we say would be served
7 appropriately by transferring the case back to Waco for the
8 reasons that are set out, not only in our previous briefing but
9 in our present briefing on the factors in this case.

10 A couple of things before I start down the path of the
11 factors for 1404(a) is it seems like Intel is trying to say
12 that back at the time that the Court made the decision in 2019
13 about time to trial, that was one of the factors of time to
14 trial, that it would be no difference between Austin and Waco,
15 and that the Court really didn't analyze that issue very
16 strongly.

17 But as the Court will remember, and knows, same judge is
18 in Waco and Austin, you. And you had control of the docket.
19 As a practical matter I guess it didn't affect the length of
20 time to trial, because the Court had total control of that as
21 opposed to usual issues where you're transferring to another
22 court with another judge.

23 Second, they seem to try to argue that the law of the case
24 is an issue in this case. And I think that's not correct. The
25 law of the case just to be able to give proper credence to a

1 sister court if the case is transferred. And you are the
2 sister court. You are the court in Waco and in Austin.

3 And so what we say is that this is a two-part test, as it
4 always is in 1404(a). And that is, could the case be
5 originally filed in Waco, and it was, the cases were filed in
6 Waco. And they were transferred at the behest of Intel, and
7 the Court at that time, 2019, seemed to agree with that. But
8 the prerequisite for the 1404(a) analysis is theirs if the
9 Court -- the case could be filed there.

10 So when we go through the factors that should be
11 considered in 1404(a), I want to go back to the private
12 factors. And originally the Court -- the relative ease of
13 access to sources of proof factor is neutral. All of the
14 documents in this case have been electronically exchanged.

15 I know the Court has previously, in other hearings that
16 I've been involved in, had some frustration of the fact that
17 everything's done electronically or digitally now. And so this
18 factor, although it's still a factor, at least to me and I
19 think probably to the Court as a practical matter, it's lost
20 some of its relevance over the years, but the fact is --

21 THE COURT: I think here we may even have mooted that by
22 the fact that I think that is something that when you filed the
23 case we might have taken up. But right now you guys have
24 exchanged trial exhibits is my understanding. So that notion
25 of convenience I think is not really relevant.

1 MR. MANN: Correct, Your Honor. And that's what we were
2 trying -- we've exchanged exhibits and nobody had to go to
3 Austin to exchange them.

4 The issue on compulsory process, back, you know, at the
5 time the Court found that that was a factor for us. But
6 additionally, we now have, as of December 22nd, exchanged
7 witnesses, and --

8 THE COURT: Mr. Mann, I've gone through that too. Y'all
9 did a good job of that.

10 And I'll tell you, it will, you know, the Roku trial will
11 impact me going forward. And I didn't -- I don't think -- I
12 think Roku, in the same way Intel here acted in good faith, I
13 think Roku acted in good faith at the time they filed their
14 motion to transfer, in saying we think these are the people
15 that are relevant. But then you get to trial and it turns out
16 the people that are relevant at trial aren't just necessarily
17 the three or four or five engineers who work on a code or
18 something, that happen to live in a different part, you know,
19 for trial witnesses may be different than fact witnesses that
20 are relevant during discovery as it turns out. And I think
21 that's the relevant factor here.

22 MR. MANN: Exactly, Your Honor. And we're not saying
23 anybody did anything in bad faith. It's just circumstances
24 change as you get closer to trial.

25 The cost of attendance, I think the Court can take

1 judicial notice of the fact that cost of hotels and travel are
2 cheaper in Waco than in Austin. And also there's an airport
3 ten minutes -- 12 minutes away from the courthouse, as opposed
4 to Austin.

5 THE COURT: Mr. Mann, hold on one second, please.

6 (Pause in proceedings.)

7 THE COURT: I apologize. Mr. Mann, like I said, I'm
8 having to use different electronic devices this morning to keep
9 up. And this is actually something about the case. Let me
10 check this. I apologize for interrupting you.

11 MR. MANN: Sure. No problem.

12 THE COURT: Okay. Thank you.

13 Okay. Mr. Mann, you may continue.

14 MR. MANN: Thank you, Your Honor.

15 The fourth factor, all of the practical problems that
16 should be analyzed, the fourth factor and the private factors.
17 As the Court knows, I mean, the issue in that is the practical
18 problems that make the trial of the case easy, expeditious and
19 inexpensive.

20 And this is a factor that has totally been turned on its
21 head from the original analysis in 2019. Obviously the
22 courthouse is closed. There's no way to have an expeditious
23 trial in Austin on the issue of when it will be open. We're
24 all guessing on that.

25 The issue is that we can more easily, expeditiously and

1 inexpensively try the case in Waco now in January as opposed to
2 waiting for some time in the future that may happen at some
3 time later that frustrates the Court's congestion of its docket
4 and -- for not only this case but other cases. So we think
5 that factor now weighs in favor of VLSI and that the case
6 should be in Waco.

7 And I have the analysis that the Court did previously in
8 2019 and I can go through that, but I think the Court's
9 familiar with what you've said back at that time where you said
10 the Court agrees with VLSI, that there are no arguments that
11 weigh in favor for or against transfer, that this factor was
12 neutral. And it's no longer neutral; it weighs in favor of
13 being in Waco.

14 The public factors, Your Honor, I mentioned a moment ago
15 that the first factor, the administrative difficulties flowing
16 from the Court congestion. Obviously you know as good as
17 anybody in the nation, because of the number of cases that have
18 been filed in Waco and then either remain in Waco or have been
19 transferred to Austin, that court congestion is an issue I'm
20 sure that you're concerned with.

21 I know that we as practicing lawyers, just like you, we
22 didn't worry about court congestion, we worried about our cases
23 going to trial. But now that you're on the other side of
24 the -- of being the judge, that's an issue that you have to
25 seriously consider. And I think by moving this case and other

1 cases that 1404(a) allows you to do allows us to go to trial in
2 Waco and other cases.

3 So that is a factor that now, although maybe it had been
4 neutral before, is a factor that weighs in favor of being in
5 Waco. We don't argue that...

6 THE COURT: Mr. Mann, and I'll hear from Mr. Lee, but --
7 and I'm previewing for him kind of the uphill road he has to
8 climb, I guess, with my questions, but I truly have no way of
9 knowing when the Austin courthouse will open. I don't know
10 this for a fact, but it would not surprise me if they weren't
11 having trials in Austin until June.

12 And at a minimum I don't think -- I certainly -- I'm very
13 confident that no one -- and I know both judges in Austin, both
14 judges in Austin, and it's the senior judge, very much want to
15 get back to trial. They're not -- you know, they're not -- can
16 I put you on hold for just one second?

17 MR. MANN: Sure.

18 (Interruption.)

19 (Pause in proceedings.)

20 THE COURT: Yes, sir. I'm sorry, Mr. Mann.

21 And it just -- I mean, I know we're all frustrated. You
22 know, I know Mr. Lee and Intel are frustrated and you are and I
23 am. It's -- I want to make it as clear as possible, I said --
24 I think said this back in September or October, that I was
25 moving the trial from November to January in the hopes -- in

1 the hope that we would be able to have it in Austin and that I
2 was going to keep it in Austin if I could even get a date
3 certain when we could have it in Austin.

4 I mean, that -- you know, that's -- and the judges there
5 are unable to give me that. In other words, if I said today
6 we're going to keep it in Austin and we're going to set the
7 trial in March, I don't have the ability to set it in March. I
8 don't have the ability to set it right now at all because we
9 don't know when that's going to happen.

10 And so -- you know, it's -- I mean, that -- and so I'm not
11 really sure when you're talking about the interest of justice
12 how, when you have a venue where the trial can take place and a
13 venue where it can't take place and there's no certainty as to
14 when that will happen, how that factor isn't overwhelming in
15 this consideration.

16 What do you think about that?

17 MR. MANN: Your Honor, if -- I think that's exactly right.
18 It's -- this -- this is probably the most relevant issue
19 that's -- that's come up in any time for consideration of
20 retransfer of a case back to its original place of -- of
21 filing. And I don't know how you can have a fact situation set
22 up any better for retransfer when you have a courthouse that's
23 totally closed down. It'd be no different than if the
24 courthouse burned down, and this, this is worse.

25 THE COURT: Correct.

1 MR. MANN: So to kind of finalize, Your Honor, we -- we
2 think that because of what the Court has just said that, you
3 know, the public factors, at least the -- the administrative
4 difficulties of flowing from court congestion mitigate in favor
5 of transferring the case to Waco.

6 The local interest issue has not changed since the
7 original analysis. We're not arguing that. The other two
8 issues, the familiarity with the forum and application of
9 foreign laws, those are neutral.

10 I will say, Your Honor, that I didn't want to mislead the
11 Court from anything I said earlier or from what the Court said.
12 We're not advocating sending back the case -- to try all three
13 cases together. I mean, the original --

14 THE COURT: No. No. No. No. I --

15 MR. MANN: Okay. I just --

16 THE COURT: No. I fully understand that. And I
17 understand -- no. I fully understand that and I'm not planning
18 on doing that.

19 MR. MANN: Okay.

20 THE COURT: And so I was just -- I was musing -- I was --
21 I was venting. Venting's the wrong word. I was -- you know,
22 I'm just, it's -- this is a difficult case. It's a case with
23 lawyers that are from a long way away and close also. It's --
24 these are important matters and they're important to VLSI,
25 they're important to Intel. And I'm just, as I told Mr. Lee

1 and you both in December -- in -- yeah. Was it December? Late
2 November?

3 MR. MANN: It was.

4 THE COURT: So, you know, I'm just trying to balance the
5 equities here and, you know, and get this to trial. It's
6 certainly not -- I'm not -- I didn't -- I would prefer not to
7 have had us do this brain damage. You know, I would have
8 preferred to have tried it in November in Austin where we
9 originally scheduled it. So I'm just trying to do the right
10 thing for both sides.

11 MR. MANN: The only other thing I wanted to -- to discuss
12 and -- and the Court can tell me you don't need me to discuss
13 it, the witness issues. We kind of discussed this a little bit
14 ago about -- back at the time of the decision in 2019, there
15 were, oh, gosh, 20, 30 witnesses that were at least considered
16 as potential.

17 THE COURT: I apologize, Mr. Mann.

18 (Interruption.)

19 (Pause in proceedings.)

20 THE COURT: Well, that was the least successful car thief
21 in Austin it turns out. So at any rate, I apologize for
22 interrupting this hearing for that, but it's hard to deal with
23 the police at the same time and I didn't want to move this
24 hearing. I probably should have.

25 Mr. Mann, I've got a pretty good handle from your

1 briefing, especially in the reply, on what the situation is
2 with respect to the witnesses.

3 MR. MANN: So I -- I will not cover that then, Your Honor.
4 So -- so to end my presentation, I'll -- I will say that what
5 we're asking the Court to do is to transfer what amounted to
6 the 254 case back to Waco for trial.

7 The other two cases, I guess, for lack of a better way to
8 say it, can await COVID and whether the courthouse is opened
9 and those issues later on where you don't have to retransfer
10 them back to Austin potentially.

11 THE COURT: Correct.

12 MR. MANN: Now, the '254 case is the case that we would
13 like to transfer the whole case back because of 1404(a), and
14 that's our presentation, Your Honor.

15 THE COURT: Thank you, sir.

16 Mr. Lee?

17 MR. LEE: Thank you, Your Honor.

18 Your Honor, can I answer Your Honor's first question to
19 Mr. Mann? The Federal Circuit did say that under 1404(a) you
20 would have the power to transfer back to Waco, but it actually
21 said more than that. And I think for those of us who spent
22 time studying the Federal Circuit's opinion, the last paragraph
23 of the opinion is key because it says that for us involved in
24 the case, Your Honor, VLSI, Intel, if there's going to be a
25 transfer under 1404(a), Cragar applies. There has to be an

1 unanticipated post-transfer event that frustrates the original
2 purpose of the transfer and the 1404(a) factors have to be
3 applied.

4 And we think, Your Honor, if you take what the Federal
5 Circuit outlines, as in the analytical framework, the case
6 cannot be transferred back to Waco and should not be
7 transferred back to Waco.

8 I would say parenthetically, Your Honor, if you were
9 inclined to transfer back to Waco, we of course would seek
10 further review, as we mentioned to the Court back in November
11 we would. And there's no way we can do that between now and
12 January 11th and be ready for trial.

13 So let me start with two points, Your Honor, and -- and
14 one is legal and one is factual. And if -- if Your Honor will
15 indulge me, I think it's important to go back to where we
16 started this case, if that's okay with Your Honor.

17 THE REPORTER: Judge, you're on mute.

18 THE COURT: Mr. Lee, I said yes. Of course, please.

19 MR. LEE: So, Your Honor, there are, as Mr. Mann correctly
20 stated, three cases. There are seven patents that are left.
21 Of those six -- seven patents, six were originally filed in
22 Delaware, Your Honor may recall.

23 After a series of developments in Delaware, VLSI dismissed
24 those patents without prejudice and re-filed the next day in
25 Waco. We moved before Your Honor to transfer back to Delaware

1 where those seven patents had been the subject of litigation
2 already. VLSI opposed. And VLSI's opposition, Your Honor, is
3 I think important to the determination you have to make because
4 what it says -- said in its opposition is this is an Austin
5 case. That's where the inventors were located. That's where
6 the inventions were made. That's where the predecessors in
7 interest were located. That's where Intel has a facility.
8 That's where Intel has engineers. And in contrast Waco has
9 none of those. So based upon that, Your Honor denied the
10 motion to transfer back to Delaware.

11 After VLSI made those representations to Your Honor, as
12 Your Honor relied upon them in denying the transfer back to
13 Delaware, we moved, given Your Honor's opinion, to transfer the
14 case to Austin because that is where -- if you took VLSI's
15 word, that's where the locus of the case was: The inventors,
16 the infringer, the inventions, the predecessors in interest,
17 the documents. And Your Honor granted that motion.

18 And without going through the details, and this is
19 something that was before the Federal Circuit, you granted the
20 motion because you found it -- Austin clearly to be more
21 convenient.

22 So Austin is the case -- is the venue where the case is
23 pending now. It is the venue where the case has been pending.
24 It was clearly more convenient. And the question is whether,
25 under the analytical framework that the Federal Circuit has

1 given us in its last paragraph, can the case be retransferred
2 now? And, Your Honor, we suggest the answer is no.

3 The second issue I'd like to address at the outset is the
4 analytical framework because this is the second part of the
5 response to Your Honor's question on whether the Court has the
6 power.

7 The Federal Circuit's decision at Page 6, Your Honor,
8 gives the framework. It says that the Court has to apply
9 Cragar. And it says Cragar requires that there be an
10 unanticipated event that -- and that unanticipated event has to
11 frustrate the purposes of the original transfer order. That's
12 the key. It's not just there be an unanticipated event. The
13 pandemic is an unanticipated event. No one's going to suggest
14 otherwise, but it has to frustrate the original purposes of the
15 order.

16 And even if you find that impelling circumstance, to quote
17 Cragar, you still have to go through the 1404(a) factors. And
18 the Federal Circuit actually counseled the Court and all of us
19 that you have to go back in time to the factors that Your Honor
20 found justified having the case in Waco -- in the Western
21 District and then in Austin specifically. And, Your Honor, we
22 suggest that those apply and stay the same.

23 Now, I get into applying the facts that I've described to
24 you, the historical facts, to the -- to the analytical
25 framework. Let me take it in two parts.

1 First is the Cragar part. And as I said the key is, has
2 there been an unanticipated post-transfer event that frustrates
3 the original purpose of the transfer? And the answer is there
4 has not.

5 There -- there was no discussion with Your Honor and Your
6 Honor made no finding about speed to trial being the reason for
7 the transfer. And that actually makes perfect common sense
8 since Your Honor would be the trial judge whether we were
9 sitting in Austin or Waco. Speed to trial wouldn't make a
10 difference because it was your docket that Your Honor was
11 managing and it was your docket that would have the trials.

12 The fact -- the facts that you relied upon, Your Honor,
13 are the same facts that you relied upon in denying the transfer
14 of the patents back to Delaware, again where they'd first been
15 filed. And it was Intel's campus in Austin, not in Waco;
16 Intel's employees in Austin, but not in Waco; the fact that the
17 patents were invented in Austin, but not in Waco; the fact that
18 there were inventors residing in Austin, right, but not in
19 Waco; and those are the factors that Your Honor find were
20 clearly more convenient.

21 So what -- the pandemic is, as I said, an unanticipated
22 post-transfer event, but it didn't frustrate any of those
23 reasons for Your Honor transferring the case to Austin. All of
24 them still exist. And the mere fact that we're closer to trial
25 doesn't make this any less an Austin case.

1 Your Honor relied upon the fact that the inventions had
2 been made in Austin. That was a historical fact at the time
3 Your Honor ruled. It's a historical fact today. Your Honor
4 relied upon the fact that Intel had a facility, a presence,
5 that made this an Austin case. That is true today. Your Honor
6 relied upon the fact that Intel had 1,700 employees in Austin.
7 That is true today. All of those facts remain the same.

8 What VLSI says is the -- the pandemic has frustrated time
9 to trial, and there are really two problems with that argument.
10 One, that's not the basis on which Your Honor granted transfer.
11 It's not the basis on which Your Honor denied transfer back to
12 Delaware. It's not the basis on which Your Honor denied --
13 granted transfer to Waco.

14 In fact, as we said, it would have made no sense for
15 either of us to make that argument to you because we'd both be
16 trying the case to you.

17 The second is that the Federal Circuit has made very clear
18 in a series of decisions that time to trial can't trump
19 everything. And when you have a case where the locus of the
20 case is and as Your Honor has found clearly is in Austin, the
21 time to trial cannot trump everything particularly in the midst
22 of the pandemic.

23 THE COURT: Well, Mr. Lee, part of the problem I think
24 we're having here -- part of the problem I'm having is trying
25 to fit a, you know, square peg into a round hole. And what I

1 mean by that is I think time to trial is a concept that when a
2 case is filed, you know, will -- you know, what is the typical
3 time to trial in the Western District versus Delaware versus
4 California, all the other things that we take in. And I get --
5 I get that none of the factors are conclusive.

6 But when we're talking about time to trial now, it's time
7 to trial as in, could it be January, could it be February,
8 could it be June? And the problem is not just the time to --
9 and another problem with trying to figure out what to do in
10 this case -- and I'm putting this all on the record. I know
11 you might ask the people above me to revisit this, so I want to
12 make sure they understand what my thinking is. Is time to
13 trial from the perspective of when the case gets filed, I think
14 is partially from the parties' perspective, like how quickly
15 can we get to trial?

16 For me, the time to trial is, as Mr. Mann pointed out is
17 sort of flipped, is I have something every month between now
18 and I think through '22 already. And so my time to trial is if
19 I don't get this case tried either in January or February or
20 very soon, I don't -- A, I don't just have a window when I can
21 try it easily in March or April or May or June, because those
22 are all taken. And I also don't know that I could -- I could
23 try it in Austin before June, or in June.

24 And so help me out. I mean, it's always exciting for me
25 to listen to the Supreme Court arguments and hear someone of

1 your caliber arguing to them. And it's amazing to me I get to
2 have the same privilege of asking you questions and getting
3 answers, but --

4 (Interruption.)

5 THE COURT: Help me out on those issues if you can.

6 MR. LEE: Do you need to take that call?

7 THE COURT: No. I'm good. I'm good. Thank you though.
8 The police are searching my car right now for evidence. So I'm
9 in yet another advantage, I guess.

10 MR. LEE: So, Your Honor, let me just provide three
11 answers. I'm not sure that any of them will climb the hill
12 that you -- you mentioned to Mr. Mann that I had to climb, but
13 let me give you three answers.

14 And the first is, you know, in the interest of the same
15 degree of candor that we provided you in November, if Your
16 Honor was inclined to transfer the 254 case back to Waco, we
17 would ask Your Honor to stay the order, and we would seek
18 immediate mandamus review again.

19 I think that we have to -- I have a pretty good sense of
20 how I read a lot of --

21 THE COURT: I'm sorry, Mr. Lee. I do need you to hold on
22 for just one second.

23 MR. LEE: Oh, sure.

24 (Pause in proceedings.)

25 THE COURT: Yes, sir. Thank you. I'm sorry.

1 MR. LEE: Your Honor, if I could back up just a little
2 bit --

3 THE COURT: Yes, please.

4 MR. LEE: -- and I'll be as precise as I can.

5 The first thing is, you know, it's as I said, in the same
6 candor that we attempted to provide you in November, if Your
7 Honor was inclined to transfer that 254 case back to Waco, we
8 would seek an immediate stay and review. We can't get that
9 done by January 11th.

10 And I think in order to try the case on January 11th
11 people would have to start traveling this Friday or Saturday.
12 And it would be -- to use Your Honor's phrase, it would be
13 unfair for folks to have to start to do that without having
14 guidance from the Federal Circuit.

15 Number two, I think that I understand what Your Honor says
16 about Your Honor's docket. I understand what Your Honor says
17 about the uncertainty. But the Federal Circuit was pretty
18 clear that here's the analytical framework. The analytical
19 framework is, has there been a post-transfer event that so
20 frustrates the original reason -- the original reason being
21 that this was an Austin-focused case -- that the transfer is
22 (audio disruption) justified. And we say the answer is no.

23 And the third, Your Honor -- the third part of your answer
24 is to go back to the unsuccessful argument I made to you on
25 December 15th. It's -- it is to me at least a little

1 inconsistent to, on one hand say that the post pandemic -- the
2 pandemic is a post-transfer event of such proportions that it
3 can trump the other factors. Yet that pandemic and all of the
4 risks it create was insufficient to justify the month or two
5 continuance that we asked for.

6 Now, I think, Your Honor, no one can predict what it's
7 going to be like in February or March. But I think we're all
8 hopeful that it's going to be better.

9 We have an April 12th trial date with Your Honor, right?
10 If we get to April 12th and Austin's open, we'll go to trial in
11 Austin. If we get to April 12th and Austin's not open, I think
12 we're all going to be in an unhappy situation.

13 The analysis that Your Honor might do then would be
14 different than the analysis Your Honor would do today. And I
15 know that's a request on our behalf that we all stay flexible,
16 but rushing to -- even if you just looked at the most recent
17 reports from the medical community today, rushing ahead in the
18 next ten days by putting people on planes in two days without a
19 chance to hear what the Federal Circuit says, we would suggest
20 is not the best way to approach this.

21 And I actually think, Your Honor, if you read that last
22 paragraph -- and you may well read it differently than I read
23 it, but I read it pretty thoroughly and very, very clearly and
24 very directly. What it says to me is, yes, you have the power,
25 to answer your question, but you need to consider these three

1 factors: Cragar, 1404(a) and the reasons that were articulated
2 in the first motion to transfer. And those are the things you
3 have to consider before you retransfer, and you have to find an
4 impelling circumstance.

5 It can't be that the pandemic, which is affecting time to
6 trial and Your Honor's docket to be sure, can be the impelling
7 circumstance when it doesn't frustrate the original purpose.
8 It can't be that it's impelling circumstance when it's not
9 sufficient to justify a continuance to protect the public
10 health and safety and the safety of the participants.

11 THE COURT: Mr. Lee, let me ask you this, which may
12 foretell what I'm going to do, but remind me how long between
13 when I made the decision in this case to move forward and you
14 all took it up, what was the length of time between that -- you
15 knowing what I was going to do and the Court being able -- the
16 Circuit being able to hear it and resolve this?

17 MR. LEE: We filed within about seven days from the time
18 when Your Honor's decision -- you told us that you were
19 considering doing it, and about a month later it became a
20 certainty. We filed within seven days.

21 THE COURT: No, no. I'm sorry. My question wasn't very
22 articulate.

23 Here's what I'm trying to figure out: If I were to decide
24 today to transfer it back, I'm trying to figure out how long it
25 would be fair to give Intel before I were to -- when I could

1 set the trial to give you all sufficient time to seek relief
2 from the Circuit.

3 MR. LEE: So, Your Honor, I think that -- at least as I
4 understand it -- Your Honor would have to articulate the
5 reasons for the transfer. As soon as they were articulated, we
6 would move. We would move to stay probably immediately.

7 THE COURT: No, no. Again, what I'm trying to figure out
8 is, I'm certainly leaning towards your way that you might not
9 be able to get an answer from the Circuit before the current
10 trial date, and yet you would be having to have people fly in
11 during a period of uncertainty.

12 What I'm trying to figure out -- maybe I should be more
13 articulate. If I were to reset the case for trial in -- I'm
14 not planning on waiting until April, but what would be a safe
15 date? Would it be January 31st? I'm just -- I don't know if
16 that's a -- I'm saying, are you -- what amount -- if I were to
17 set it for February 1st, just as an easy date, would that give
18 Intel the opportunity to get to the Circuit and have them tell
19 me whether what I've done is correct or not?

20 MR. LEE: Your Honor, I think that if you set it for the
21 first week of February, we would go to the Circuit and tell
22 them that you had set it then so that we could get a decision
23 from them. And hopefully we would get a decision from them by
24 then.

25 THE COURT: Okay.

1 MR. LEE: But I think that as a practical matter, as Your
2 Honor asked me the last time we had this discussion, the
3 average mandamus is about 56 days, two months. But they got to
4 this one more quickly because we told them that we had a
5 January trial date.

6 THE COURT: Okay.

7 MR. LEE: So I think, Your Honor, some time -- and I
8 appreciate it. I just don't want to put people -- given --

9 THE COURT: No. I understand what you're saying, Mr. Lee.

10 MR. LEE: I don't want to put people on planes.

11 THE COURT: I'm going to put you on hold for a couple of
12 seconds so I can chat with my clerks, and I'll be back.

13 MR. LEE: Thank you.

14 (Pause in proceedings.)

15 THE COURT: Let's go back on the record. I think it is
16 appropriate for me to transfer the case back to Waco. However,
17 I don't think it's appropriate to maintain the current trial
18 date and not give Intel an opportunity to get this to the -- to
19 get this before the Circuit, if they intend to do that. And I
20 think Mr. Lee has made it clear that they want that
21 opportunity. I also don't see a point in having people
22 traveling when the case may or may not take place.

23 We are going to -- I'm going to reset the trial for
24 February 15th. That's so you can tell the Circuit, Mr. Lee.
25 I'm trying to give you enough time to give them enough time to

1 address this.

2 My plan is to -- Mr. Lee, you need to do whatever you need
3 to do, but my plan is to have out by the end of this week an
4 order that gives the reasons, which I would think would be more
5 helpful to you.

6 I know sometimes -- I've had situations where people have
7 gone to the Circuit before I've given my reasons for doing it
8 which makes less sense to me. Obviously you need to do
9 whatever you want to do, but I'm telling you you can anticipate
10 having an order this week to take up, if that's the order that
11 you want to do it in, to give the Circuit the benefit of having
12 my reasoning for doing it.

13 MR. LEE: Your Honor, that will be helpful. We'll wait
14 till we have Your Honor's written order, because it'll make for
15 a less wasted effort on everybody's part, and I think will make
16 it easier for all the parties involved.

17 So we will wait for the order. If it comes out at the end
18 of this week, we'll get it filed early next week so that we can
19 get a prompt decision.

20 THE COURT: Okay. Well, I think again, I believe -- I
21 wouldn't be doing this if I didn't think what I was doing was
22 correct; however, I want to be sensitive.

23 These are non-normal issues that we're dealing with. Like
24 I said, I think the 1404 factors, I certainly get them; we deal
25 with them a lot. But I haven't dealt with them in the context

1 of COVID, and you know, the cases that you all have cited. I'm
2 blanking on the specific cases that we discussed today.

3 But as Mr. Mann pointed out, I think it would be good for
4 the Circuit to tell me whether or not I'm properly applying
5 that in terms of the retransfer.

6 So we will set this on the -- it's February 16th. I
7 believe the 15th is a holiday. So we will -- and that will
8 also shift back the need for everyone to come to Texas until,
9 hopefully -- I'm trying to give you enough time for the Circuit
10 to make its decision if I'm incorrect, not to have moved people
11 unnecessarily.

12 MR. LEE: Thank you, Your Honor. We appreciate that.
13 And, you know, we'll move very promptly once we get the written
14 order so that we all can get whatever guidance there is as
15 quickly as we can.

16 THE COURT: Okay.

17 Mr. Mann, did you have anything else?

18 MR. MANN: No, Your Honor. Except I see Mr. Chu rising.
19 Every time I talk, he rises to say something. And he always
20 has something good to say too, so could we hear from him?

21 THE COURT: Happy to.

22 MR. CHU: All I wanted to say was thank you very much,
23 Your Honor, for your time. I know for both parties you've been
24 very responsive to requests from either side, so we appreciate
25 that.

1 THE COURT: Well, as I say often, but I don't think it's
2 ever wasted time, I probably should do this job for free. The
3 ability to have lawyers of the quality that I get almost
4 100 percent of the time is truly exceptional. There is no one
5 who is luckier than I am to get to do this job and have -- and
6 that being said, some hard issues, some hard decisions come
7 along with it. I'm doing the best I can to get those correct.
8 So I hope you all have a happy new year.

9 Just so you know, I checked on this as well. Let me take
10 up y'all's time though, if you have a couple more minutes. A
11 couple of things.

12 One, it's the same jury panel, so we're not losing --
13 it'll make no difference on the panel from January to February.

14 Also, I want you all to be thinking about this and coming
15 up with suggestions. The way I'm currently thinking about
16 doing the voir dire is -- will be fairly unique, I think. And
17 it is to try and address the issues of COVID.

18 I think several of you know my courtroom -- well, you've
19 all been in my courtroom. I'm just -- one of the highlights of
20 my life, the day I had Mr. Chu and Mr. Lee in my courtroom
21 arguing. You know, for a kid from south Texas, I thought I'd
22 done pretty well to have two so preeminent lawyers in front of
23 me.

24 But if you can picture my courtroom, we've got two sets of
25 eight rows. What I am currently thinking about doing, but

1 again I am certainly open to suggestions from you all, what I'm
2 thinking about doing is having 16 people brought in and they
3 would each sit one per side, so you've got essentially two rows
4 of eight. And then probably four or five more in order, four
5 or five of the venire people, who would come and spread out in
6 the jury box. So you're talking a very spread out venire
7 panel.

8 I would then -- because we will have had -- hopefully you
9 all will have responses to questionnaires. The role of the
10 magistrate in doing the voir dire would be entirely nonverbal.
11 He would ask questions, anything you all wanted him to ask, and
12 venire people would hold up their hand, for example: Have you
13 ever filed for a patent? People could hold up their hands or
14 not and you guys could make notes.

15 What I'm thinking then is of giving each side around two
16 hours and we would then bring the jurors -- veniremen -- we
17 would take everyone out and then the veniremen would come in
18 one at a time, sort of like it's a capital punishment-type
19 venire, and you would do the venire -- you would do the voir
20 dire with them sitting in the witness box without a mask on
21 because they've got Plexiglass up. And you would get to decide
22 how to use your two hours of total time per side to question.

23 You know, I would hope you would limit no one to more than
24 10 or 15 minutes of voir dire, but that would be up to you to
25 decide how, you know, three minutes or five minutes or ten

1 minutes, whatever.

2 We intend to have that -- the question and answer
3 simulcast into a much larger room so all of the venire people
4 are watching the questions and answering that's going on. But
5 hopefully we'll have no more than maybe just two or three of
6 the veniremen in the courtroom at any one time. And so there's
7 not a group in there other than for the initial deal, which
8 will still be a pretty small group of maybe 22 to 23 people.

9 But during your question and answering phase, I would end
10 up having one person in the witness box and maybe two or three
11 people, the next in turn, in the back of the courtroom. So it
12 would be a very spread out experience with very few people in
13 the courtroom.

14 I would like for you all to be thinking so you could tell
15 me next week at the pretrial. I would like to still have the
16 pretrial conference on Tuesday. I prepared for it. I'd like
17 to do that.

18 I'd like for you all to be thinking about how many people
19 we can have in the courtroom. And what I mean by that is
20 number of lawyers and representatives at the table. There's a
21 panel -- there's a bench right behind the table, or a couple of
22 seats, there are then the rows. I'm going to severely limit
23 the number of people from the public who can be in the
24 courtroom to make sure the number -- total number of people in
25 the courtroom is safe.

1 But I understand that you also will have to have technical
2 people. I know you'll want to have a paralegal or two. So if
3 you all will be thinking about suggestions for what to do
4 during the course of the trial.

5 Also so you can know, I don't have bench conferences
6 during the trial because I don't want the visual of you all
7 being right at the bench and having to talk that way. So what
8 we've done at the other trials was we've taken up those issues
9 before the witness came on the witness stand, or I've dismissed
10 the jury and they leave the courtroom so I can take up a
11 side-bar.

12 But again, we're going to be super safe when we're having
13 the trial. I've been thinking a lot about how to do this as
14 safely as possible. But that's my current thought about how to
15 do the voir dire, is to do it individually and have the
16 absolute fewest number of people as possible in the courtroom
17 while we're doing it. I think that makes sense to me unless
18 you all have an objection to doing it that way.

19 And you don't have to tell me today. Think about it. It
20 seems to me if the way I'm doing it is stealing it from the way
21 capital punishment juries are picked, it seems to me I'm
22 probably in pretty good company in terms of saying that is an
23 effective way of doing the voir dire that protects everyone's
24 rights. So -- and also I want to make sure that the jurors
25 feel safe.

1 Also I'll report back to you from our jury clerk in the
2 District Clerk's office. We're having absolutely no problem
3 having people willing to attend and serve on the juries. I
4 mean, in terms of having a very substantial beginning panel
5 from which we will select the tinier group that would come in
6 for the trial from which we would select the first 20 people or
7 so of those. We're experiencing no problems with folks in the
8 Waco area being resistant to coming and serving on the jury.
9 And so I thought that would be intel you would want as well.

10 I look forward to chatting with you all next Tuesday. And
11 so -- and, Mr. Lee, like I said, we will have an order out this
12 week and you can do what you need to do with it.

13 MR. LEE: Thank you, Your Honor. We appreciate this, and
14 we appreciate the fact that you understand that we need to do
15 what we need to do for our clients, as you (inaudible)
16 practice.

17 THE COURT: Look. I am just trying to do the best I can,
18 I know you know that, in uncertain times. And I need -- you
19 need to protect your clients, as does Mr. Chu, and anything I
20 can do to make this as lawyer friendly as I can, I'm happy to
21 do. And so...

22 MR. LEE: We appreciate it.

23 MR. MANN: Thank you, Your Honor.

24 THE COURT: Anything else, gentlemen?

25 MR. HATTENBACH: Your Honor, this is Mr. Hattenbach.

1 Could I -- just a quick logistical question on people in the
2 courtroom?

3 THE COURT: Sure. Absolutely.

4 MR. HATTENBACH: So one of the thoughts I was having,
5 having never experienced this kind of situation before, is
6 perhaps if we could set up some kind of closed circuit
7 television link to beam the proceedings to either a nearby
8 courtroom or to people --

9 THE COURT: We have that. We have that.

10 MR. HATTENBACH: And so we should take that into account,
11 it sounds like?

12 THE COURT: We should.

13 MR. HATTENBACH: Terrific.

14 THE COURT: I should have mentioned that. We will have
15 that and it will go -- I think what we did the last time was we
16 put it in -- we piped it into the other district courtroom,
17 which is not as big as mine, but it's -- still it's a district
18 courtroom. So it's a pretty good size.

19 And so yes. I have every interest in making this as
20 accessible as possible to as many people as possible in as safe
21 a way as possible. And I'm open to doing that in whatever way.

22 We have just gone through a major upgrade in the
23 technology in my courtroom that you all will benefit from. I'm
24 very pleased to say I think we will be as -- I think we'll -- I
25 think had you come in July, you would have found 1957

1 technology. I can't promise you, because it's the Federal
2 Government, you'll have 2020 technology. I'd like to think you
3 will. But I'm told that -- I know there's been a very -- the
4 last three months they've been working on my courtroom, so I
5 think we will be as up-to-speed technologically as anyone. But
6 it would not be a bad idea for you and other counsel to make
7 sure with my technical person, in case we need to enlist your
8 help to make that possible.

9 I will tell you that the lawyers in the Roku trial on both
10 sides were magnificent. You know, they made it so much easier
11 for us. They brought in a lot of equipment. They actually --
12 one of the parties was who put up the Plexiglass around the
13 witness stand so we could move forward. I mean, they were
14 enormously helpful.

15 And if I haven't made this clear to you, as far as I'm
16 concerned, you all -- other than the fact that we may be in
17 trial, which would -- might be nice for you, you know, to come
18 watch, but as far as we're concerned, we will get you -- if
19 you'll work with my law clerks, we will get you the name of
20 Blake, who's our technical person. You all will have unlimited
21 access to my courtroom to set up and get things ready. And so
22 we will make it -- we'll make the courtroom and the courthouse
23 literally as accessible as possible.

24 And so -- and you'll just need to have Blake Tully's
25 number and coordinate with him to get whatever it is that you

1 need set up ready to go. We will make that -- hopefully that
2 will be -- hopefully it'll be the easiest courtroom you've ever
3 had to work with to get ready for setup. That will be my goal.
4 And if you don't have that, call Evan and let him know and I'll
5 make sure that happens.

6 Anything else?

7 MR. LEE: Your Honor, just to avoid creating work for
8 you --

9 THE COURT: Yes.

10 MR. LEE: -- we're going to the Federal Circuit, and in
11 order to jump through the hoops, I would have to move to stay
12 the order before you. Can we just deem it that I've moved,
13 Your Honor has denied it, so we can move on to getting your
14 written order?

15 THE COURT: Yes, sir. You can.

16 MR. LEE: Okay. Thank you, Your Honor.

17 THE COURT: I understand. Again, nothing -- I can't
18 imagine anything you could do that could offend me, and
19 certainly that is not something.

20 MR. LEE: Well, I'm going to promise you I'm not -- I'm
21 going to try not to. So...

22 THE COURT: And so, gentlemen, all, I hope you have a
23 wonderful new year. I look forward to next Tuesday. For me
24 it's like a kid going to Christmas every day. So have a
25 wonderful rest of the week. I look forward to seeing you next

1 week.

2 And I guess this means -- actually I guess this means that
3 I don't have to have 15 Markmans next week. Maybe I can have
4 just a few fewer so -- and we can spread them out a little bit.

5 Take care.

6 (Hearing adjourned at 11:17 a.m.)

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1 UNITED STATES DISTRICT COURT)
2 WESTERN DISTRICT OF TEXAS)

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4 I, Kristie M. Davis, Official Court Reporter for the
5 United States District Court, Western District of Texas, do
6 certify that the foregoing is a correct transcript from the
7 record of proceedings in the above-entitled matter.

8 I certify that the transcript fees and format comply with
9 those prescribed by the Court and Judicial Conference of the
10 United States.

11 Certified to by me this 30th day of January 2020.

12

13

/s/ Kristie M. Davis
KRISTIE M. DAVIS
Official Court Reporter
800 Franklin Avenue
Waco, Texas 76701
(254) 340-6114
kmdaviscsr@yahoo.com

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CERTIFICATE OF SERVICE

I hereby certify that, on this 4th day of January, 2021, I filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, which will send notice of such filing to all registered CM/ECF users, and I caused a copy of the foregoing to be served via email and overnight courier to the following addresses:

ANDY TINDEL MANN TINDEL THOMPSON 112 E. Line Street, Suite 304 Tyler, TX 75702 (903) 596-0900	MORGAN CHU BENJAMIN W. HATTENBACH DOMINIK SLUSARCZYK IRELL & MANELLA LLP 1800 Avenue of the Stars, Suite 900 Los Angeles, CA 90067 (310) 277-1010
J. MARK MANN MANN TINDEL THOMPSON 300 W. Main Street Henderson, TX 75652 (903) 657-854	

Additionally, on this 4th day of January, 2021, I caused a copy of the foregoing to be served via email and overnight courier to the U.S. District Judge:

The Honorable Alan D. Albright
800 Franklin Avenue, Room 301
Waco, Texas 76701
(254) 750-1510

/s/ William F. Lee
WILLIAM F. LEE
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

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The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because:

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2. The brief has been prepared using Microsoft Word for Office 365 in 14-point Times New Roman font. As permitted by Fed. R. App. P. 32(g), the undersigned has relied upon the word count feature of this word processing system in preparing this certificate.

/s/ William F. Lee
WILLIAM F. LEE
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, MA 02109
(617) 526-6000

January 4, 2021