
The New ‘Renegade Jurisdiction’: How the Fifth Circuit Can Prevent the Extraordinary Writ of Mandamus from Becoming an Extra-Ordinary Remedy

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Abstract. Two particularly thorny issues with patent litigation venue continue to plague the jurisprudence of the U.S. Court of Appeals for the Federal Circuit. First, when a federal district court denies a purported infringer’s transfer motion under 28 U.S.C. § 1404(a), how tenuous must that infringer’s ties be to the plaintiff’s chosen forum to justify intervention by the Federal Circuit through a writ of mandamus? Second, what effect (if any) do technological advances in modern litigation have on the court’s venue-transfer calculus? Scholarly debate surrounding these issues reached its apogee in 2021 when the Federal Circuit granted eighteen mandamus petitions—eviscerating its previous annual grant record of five petitions—all directed to Judge Albright of the U.S. District Court for the Western District of Texas. Although the Federal Circuit has used the writ of mandamus to manage the courts within its jurisdiction before, no court has ever used the writ this often.

The cause of this mandamus mania is a fundamental disagreement between the Federal Circuit and Judge Albright on how to apply the Gilbert factors. Judge Albright believes that the broad language of § 1404(a) conveys district court judges with broad discretion to account for technological developments in litigation like video conferencing or electronic discovery. The Federal Circuit disagrees. While this Comment explores several resolutions to this controversy, it advocates for one: the U.S. Court of Appeals for the Fifth Circuit, whose mandamus jurisprudence binds the Federal Circuit, should develop a clarifying line of precedent on the proper application of the Gilbert

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factors given the realities of modern litigation. For it is in the interests of justice to do so.

Introduction

The Court of Appeals for the Federal Circuit (“Federal Circuit”) made history in 2021 when it granted eighteen mandamus petitions for denied venue-transfer motions under 28 U.S.C. § 1404(a).¹ What is more, all eighteen were directed at Judge Alan Albright of the Western District of Texas (“WDTX”).² Although the Federal Circuit’s use of writs of mandamus to manage the courts within its jurisdiction is not entirely unprecedented,³ no court has ever used the writ this often.

The Federal Circuit itself refused to grant a single mandamus petition under § 1404(a) for its first twenty-five years.⁴ And even after that, it never granted more than five mandamus petitions in a year.⁵ No other court of appeals, by contrast, has even granted eighteen mandamus petitions *total* since Congress codified § 1404(a) over seventy years ago.⁶ These low grant rates reflect the view taken by most appellate courts: the broad discretion conveyed by § 1404(a) makes it nearly impossible to find a clear abuse of discretion.⁷ Indeed, using the writ of mandamus to overrule a district court judge’s determination of party convenience erodes their congressionally vested discretion. Continued erosion may yield unintended consequences in other areas of law. To understand where this might lead, we must step back and observe where it all began.

Historically, appellate courts used the writ to *mandamus*—or “command”—an inferior court either to correct an official court action made inconsistent with the court’s jurisdiction or to compel the

¹ *Docket Navigator Analytics*, DOCKET NAVIGATOR [hereinafter *Federal Circuit Mandamus Docket 2021*], <https://perma.cc/8N9S-FCV2> (last visited Dec. 21, 2022) (running search for Docket Text: mandamus; Courts: Federal Circuit; and Document Filing Date: On or After Jan. 1st, 2021).

² *Id.*

³ Paul R. Gugliuzza, *The New Federal Circuit Mandamus*, 45 IND. L. REV. 343, 345–46 (2012) (finding the Federal Circuit’s historical mandamus grant rate was 10% between 1982 and 2012).

⁴ *Id.* at 381.

⁵ See Jonas Anderson, Paul Gugliuzza & Jason Rantanen, *Extraordinary Writ or Ordinary Remedy? Mandamus at the Federal Circuit—Part 3*, PATENTLY-O fig.1 (Oct. 21, 2021) [hereinafter *Extraordinary Writ: Part 3*], <https://perma.cc/6Y6G-MF4P> (showing the total venue-transfer mandamus petitions granted by the Federal Circuit from 2008 through September 31, 2021).

⁶ The author developed this empirical data by searching Westlaw for “mandamus” and “1404(a)” under all federal courts, and then filtering out the Federal Circuit and all results for non-appellate courts. The author manually reviewed the 363 case results and tabulated his findings to conclude the proposition above. The circuit courts that granted the largest volumes of mandamus petitions under 28 U.S.C. § 1404(a) since 1948 are the Third Circuit (12), the Fifth Circuit (11), and the Seventh and Eighth Circuits (7).

⁷ *Garner v. Wolfenbarger*, 433 F.2d 117, 120 (5th Cir. 1970) (noting that “only a few litigants have surmounted the formidable obstacles and secured the writ [of mandamus]” for venue transfers).

performance of some judicial duty.⁸ This framework remained intact for over two hundred years. Along the way, Congress passed § 1404(a), which codified the common-law doctrine of *forum non conveniens* without its harshest result⁹—mandatory case dismissal—and vested the district court with broad discretion to transfer cases to more convenient forums.¹⁰ Even with these distinctions, the Supreme Court found that the public- and private-interest factors used under *forum non conveniens*—known as the *Gilbert* factors¹¹—applied equally to § 1404(a).¹² But since the mandamus inquiry largely deferred to the district court’s findings, appellate courts rarely granted mandamus petitions.¹³ Yet the twenty-first century ushered in a new mandamus.

The Eastern District of Texas (“EDTX”) fueled the writ’s transformation by amassing an unusually robust patent docket in the rural town of Marshall in the early 2000s.¹⁴ As Marshall’s docket continued to grow—at one time possessing 43% of the nation’s patent infringement cases—public outcry against the EDTX for purported abuse of power intensified.¹⁵ Seeking to castigate the “renegade jurisdiction,”¹⁶ the Court of Appeals for the Fifth Circuit (“Fifth Circuit”), sitting en banc, decided its most consequential § 1404(a) mandamus case: *In re Volkswagen of America*.¹⁷ There, the majority applied a new framework for mandamus

⁸ See *Mandamus*, BLACK’S LAW DICTIONARY (11th ed. 2019); Robert J. Pushaw, Jr., *The Inherent Powers of Federal Courts and the Structural Constitution*, 86 IOWA L. REV. 735, 747 n.45 (2001) (“The [Supreme] Court construed the ‘all other writs’ statutory language [of the Judiciary Act of 1789] narrowly as limited to instances where the proper exercise of jurisdiction would otherwise be defeated.” (citing *McIntire v. Wood*, 11 U.S. (7 Cranch) 504, 505–06 (1813); *United States v. Lawrence*, 3 U.S. (3 Dall.) 42, 47 (1795))); see also Gugliuzza, *supra* note 3, at 354 nn.62–63.

⁹ *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 253 (1981) (“Congress enacted § 1404(a) to permit change of venue between federal courts. Although the statute was drafted in accordance with the doctrine of *forum non conveniens*, it was intended to be a revision rather than a codification of the common law.” (citations omitted)).

¹⁰ *Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955).

¹¹ These factors were established by the Supreme Court in *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508–09 (1947).

¹² See *Ex parte Collett*, 337 U.S. 55, 57–58 (1949).

¹³ See, e.g., *Ex parte Chas. Pfizer & Co.*, 225 F.2d 720, 723 (5th Cir. 1955) (requiring the district court to only weigh three things to avoid appellate inquiry: (1) construe and apply the correct statute to case-specific facts; (2) consider the relevant factors; and (3) not clearly abuse its discretion).

¹⁴ See Xuan-Thao Nguyen, *Justice Scalia’s “Renegade Jurisdiction”: Lessons for Patent Law Reform*, 83 TUL. L. REV. 111, 130 & tbl.6 (2008).

¹⁵ *Id.* at 112 & n.1, 130 & tbl.6; Jonas Anderson, *Judge Shopping in the Eastern District of Texas*, 48 LOY. U. CHI. L.J. 539, 558 (2016).

¹⁶ Nguyen, *supra* note 14, at 112 (citing Transcript of Oral Argument at 11, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (No. 05-130)).

¹⁷ 545 F.3d 304 (5th Cir. 2008) (en banc).

review, which scrapped fifty years of deference to the district court’s findings in favor of de novo review.¹⁸ The Federal Circuit, which must apply local circuit precedent over nonpatent issues,¹⁹ granted its first mandamus petition just two months later, invoking *In re Volkswagen of America* to mandamus the EDTX in *In re TS Tech USA Corp.*²⁰ Even so, the EDTX’s patent docket continued to grow.²¹ The Supreme Court intervened in 2017, ratcheting up the venue requirements for patent litigation in *TC Heartland LLC v. Kraft Food Groups Brands LLC* (“*TC Heartland*”).²² As a result, the EDTX’s new patent infringement filings were slashed in half.²³ And these contracted levels remain today.²⁴

But then came Judge Alan Albright in 2018.²⁵ And the WDTX, like its predecessor, began a meteoric rise to become the busiest patent docket in the nation—hosting 25% of the nation’s patent infringement cases.²⁶ This time was different, though: the WDTX had a get-out-of-*TC Heartland*-free card—Austin, Texas—which provided the district with a potent venue hook.²⁷ Thus, the WDTX’s patent docket grew rapidly.²⁸ Part of this growth stemmed from Judge Albright’s initial refusal to transfer cases under § 1404(a)—a refusal that drew criticism.²⁹ After a few years of this practice, the Federal Circuit’s frustration prompted a flurry of mandamus orders directed to Judge Albright.³⁰

The disagreement between Judge Albright and the Federal Circuit centralizes around their differing applications of three *Gilbert* factors.³¹

¹⁸ *Id.* at 316–18; *id.* at 319 (King, J., dissenting).

¹⁹ Jennifer E. Sturiale, *A Balanced Consideration of the Federal Circuit’s Choice-of-Law Rule*, 2020 UTAH L. REV. 475, 476.

²⁰ 551 F.3d 1315, 1322–23 (Fed. Cir. 2008).

²¹ *See infra* Figure 1.

²² 581 U.S. 258, 269–70 (2017).

²³ *See infra* Figure 1.

²⁴ *Id.*

²⁵ PN1523—Alan D. Albright—The Judiciary, CONGRESS, <https://perma.cc/49RJ-KKTT>.

²⁶ Ryan Davis, *WDTX Now Has 25% of All US Patent Cases*, LAW360 (July 2, 2021), <https://perma.cc/X59D-QA-QA>; *see infra* Figure 2.

²⁷ J. Jonas Anderson & Paul R. Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 DUKE L.J. 419, 445–46 (2021).

²⁸ *Id.* at 447 fig.2.

²⁹ *See, e.g.*, Mark Curriden, *Patent Lawyers: WDTX Waco Order Unfair, Misguided and Hypocritical*, TEX. LAWBOOK (July 28, 2022), <https://perma.cc/LAGJ-PAW8> (citing that a “major complaint against Judge Albright is that he refuses to transfer patent cases to other districts,” which legal experts confirm was the case “during the first two years” he was on the bench).

³⁰ *See Federal Circuit Mandamus Docket 2021*, *supra* note 1.

³¹ The three factors include (1) the relative ease of access to sources of proof; (2) the cost of attendance for willing witnesses; and (3) the administrative difficulties flowing from court congestion. *Gulf Oil Co. v. Gilbert*, 330 U.S. 501, 508 (1947).

First, Judge Albright discounts the sources-of-proof factor given the prevalence of eDiscovery;³² the Federal Circuit, by contrast, elevates the physical location of documents and servers above the actual effect this has on party convenience.³³ Second, Judge Albright believes that witness convenience is best served through remote proceedings when available;³⁴ the Federal Circuit, again, ignores the effects of technology on convenience and instead compares the costs for a given witness to attend a future trial in each venue.³⁵ Third, Judge Albright believes that party convenience is served by resolving a given case in the venue that can bring the case to final judgment or dismissal more quickly;³⁶ the Federal Circuit believes that empirical case-disposition data on trial times or scheduled trial dates are too tenuous to be given much—if any—weight.³⁷ As a result, the Federal Circuit believes that Judge Albright should have transferred many cases he chose to retain.³⁸

But the resulting mandamus mania, though generating headlines,³⁹ failed to change litigant behavior as patent-infringement filings at the WDTX continued at elevated levels.⁴⁰ In response, then-Chief Judge

³² See, e.g., *XR Comms., LLC v. Google LLC*, No. 21-cv-00625, 2022 WL 3702271, at *4 (W.D. Tex. Aug. 26, 2022) (“The Federal Circuit has time and again rebuffed district courts for grounding the sources-of-proof factor in reality and, for example, tempering the weight accorded to the ‘location’ of electronic documents that can be transmitted across the globe with great ease.”).

³³ See, e.g., *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1321 (Fed. Cir. 2021) (“What matters is the relative access to sources of evidence in the two competing forums. And while electronic storage of documents makes them more widely accessible than was true in the past, that does not make the sources-of-proof factor irrelevant.” (citation omitted)).

³⁴ See, e.g., *XR Comms.*, 2022 WL 3702271 at *4 (“In step with [its] Luddite jurisprudence, the [Federal Circuit] will not start appreciating advents in technology now. ‘[R]ecent developments,’ like the mainstreaming of remote testimony, will not ‘render this factor superfluous.’” (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 316 (5th Cir. 2008)).

³⁵ See, e.g., *In re Apple Inc.*, 979 F.3d 1332, 1341–42 (Fed. Cir. 2020).

³⁶ See, e.g., *XR Comms.*, 2022 WL 3702271 at *9 (stating that “[a] faster average time to trial means more efficient and economical resolutions of the claims at issue,” but noting that “the Federal Circuit has accorded [this factor] *strikingly little weight in recent history*”) (emphasis added).

³⁷ See, e.g., *In re Apple*, 979 F.3d at 1344 (rejecting the lower court’s empirical explanation of why the case would be resolved faster in the WDTX and reiterating that “a court’s general ability to set a fast-paced schedule is not particularly relevant to this factor”).

³⁸ See, e.g., *id.* at 1346 (finding that Judge Albright clearly abused his discretion in denying transfer).

³⁹ See, e.g., RPX Corporation, *United States: Federal Circuit Continues Steady Drip of Judge Albright Venue Rebukes After 2021’s Mandamus Wave*, MONDAQ (July 6, 2022), <https://perma.cc/62HB-Q8QV>; Logan Murr, *CAFC Corrects Albright on Transfer Again, Granting Mandamus to Volkswagen and Hyundai*, IPWATCHDOG (Mar. 10, 2022), <https://perma.cc/KNZ6-FKSH>; Dennis Crouch, *Mandamus Monday, PATENTLY-O* (Nov. 15, 2021), <https://perma.cc/5AVV-A8FT>.

⁴⁰ See *infra* Figure 2 (noting that the WDTX’s 2021 docket had more patent infringement filings in 2021 than the preceding five years).

Orlando Garcia of the WDTX issued an order on July 25, 2022, that required all patent cases filed in Waco to enter a lottery system that would randomly assign each case to any of the WDTX’s twelve judges.⁴¹

And so the search for a new premier patent docket would need to begin anew. But then-Chief Judge Garcia issued an amended order on November 15, 2022—three days before taking senior status—that modified the WDTX’s current case-assignment structure.⁴² While this order appears to have rescinded his July 25 order (and thus the Waco patent lottery system), patent-infringement filings in Waco remained sparse for December 2022.⁴³ Even still, unless Chief Judge Alia Moses issues her own order reinstating the lottery, the controversy between Judge Albright and the Federal Circuit is likely to reignite soon. This Comment argues that a more permanent solution than a revocable-at-will standing order is required and explores who should provide it.

The best option is Congress, which could resolve this controversy through legislation. But Congress has done little to intervene other than to express its disdain for Judge Albright’s purported abuse of discretion.⁴⁴ And its current legislative impotence makes new legislation unlikely. Congress also has the power to impeach Judge Albright.⁴⁵ But when comparing his actions to previously impeached Article III judges,⁴⁶ this option appears more theoretical than actual. To its credit, Congress requested that Chief Justice John Roberts direct the Judicial Conference

⁴¹ Order Assigning the Business of the Court as It Relates to Patent Cases, (W.D. Tex. July 25, 2022) [hereinafter *Garcia July Order*], <https://perma.cc/XEP9-JC8K>.

⁴² Amended Order Assigning the Business of the Court (W.D. Tex. Nov. 15, 2022) [hereinafter *Garcia Amended Order*], <https://perma.cc/L8HG-R2PF>; Dennis Crouch, *Waco May Be Heating up Again This Winter* (Dec. 15, 2022), <https://perma.cc/7CEW-CYV5>.

⁴³ See Sarah Ring, *Is More Big Change Afoot in the Western District of Texas’ Patent Docket?*, JDSUPRA (Dec. 15, 2022), <https://perma.cc/5VXK-3UUQ>.

⁴⁴ See Letter from Senator Patrick Leahy, Chair, Subcommittee on Intellectual Property, and Senator Thom Tillis, Ranking Member, Subcommittee on Intellectual Property, to Chief Justice John Roberts (Nov. 2, 2021) [hereinafter *Senator IP Letter*], <https://perma.cc/TU3A-77VC>; see also Dennis Crouch, *Letter to the Chief Justice About Judge Albright*, PATENTLY-O (Nov. 3, 2021), <https://perma.cc/LJ86-XUH4>; Gene Quinn & Steve Brachmann, *Criticism of Judge Albright Looms Large in Tillis Letters to Hirshfeld, Chief Justice Roberts*, IPWATCHDOG (Nov. 3, 2021, 5:55 PM), <https://perma.cc/F6JV-LCY2>.

⁴⁵ U.S. CONST. art. I, § 2, cl. 5.

⁴⁶ See, e.g., *Nixon v. United States*, 506 U.S. 224, 226–28 (1993) (summarizing Judge Walter Nixon’s conviction and impeachment for making false statements before a grand jury); Michael J. Broyde, *Expediting Impeachment: Removing Article III Federal Judges After Criminal Conviction*, 17 HARV. J.L. & PUB. POL’Y 157, 164–65 (1994) (discussing Judge Harry E. Claiborne’s impeachment in 1986 for tax fraud).

to recommend reforms for the current situation.⁴⁷ But new rules from the Judicial Conference usually take about three years before they gain final approval.⁴⁸

The judiciary could also intervene. The Supreme Court, for example, could step in and provide guidance as it did in *TC Heartland*. But affirming a Federal Circuit mandamus grant would unlikely change very much; patent litigators' preference for the WDTX appears unaffected by mandamus orders.⁴⁹ Nor do Judge Albright or the Federal Circuit show any signs of changing their jurisprudential views.

Another solution, which this Comment endorses, asks the Fifth Circuit to intervene by clarifying that the *Gilbert* factors need not be rigidly applied through the lens of the 1950s—a time when neither the internet nor cell phones existed. Rather, they should be applied to reflect the realities of modern litigation on party convenience, for this is what the text of § 1404(a) contemplates. Indeed, the Fifth Circuit's recent *In re Planned Parenthood Federation of America, Inc.*⁵⁰ decision so stated.⁵¹

Clarifying how the *Gilbert* factors should be applied today would produce several benefits, such as (1) aligning the current mismatch between the text of § 1404(a) and the Federal Circuit's wooden application of the *Gilbert* factors; (2) allowing the Fifth Circuit to resolve a local issue within its geographic jurisdiction; and (3) binding the Federal Circuit's analyses for all future mandamus petitions.

The purpose of this Comment is not to critique the Fifth Circuit's or Federal Circuit's mandamus jurisprudence. Instead, this Comment strives to add another voice to the debate. While the Federal Circuit's mandamus jurisprudence under § 1404(a) has been studied extensively,⁵² this Comment takes a different approach—exploring the Fifth Circuit's mandamus jurisprudence.

This Comment proceeds in three parts. Part I explores the writ of mandamus's English roots and traces its development in American law generally and in the Fifth and Federal Circuits specifically. Part II reviews why applying the *Gilbert* factors without accounting for the effects of

⁴⁷ See *Senator IP Letter*, *supra* note 44; see also Dennis Crouch, *Supreme Court and Judicial Conference Considering Judge Albright's Problematic Patent Court*, PATENTLY-O (Dec. 31, 2021), <https://perma.cc/8R6E-AAJ2>.

⁴⁸ *The Judicial Conference: A Century of Service to the Federal Judiciary*, U.S. COURTS (Sept. 23, 2022), <https://perma.cc/G5DC-2ZJ4>.

⁴⁹ See *infra* Figure 2.

⁵⁰ 52 F.4th 625 (5th Cir. 2022).

⁵¹ *Id.* at 630 (reiterating that the “*Gilbert* factors ‘are not necessarily exhaustive or exclusive,’” which implies that there is room in the transfer analysis for consideration of the realities of modern litigation) (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008)).

⁵² See, e.g., Gugliuzza, *supra* note 3, at 383–85.

technology on modern litigation has led to erroneous results. Part III discusses the strengths and weaknesses of the proposed solution and explains how the Fifth Circuit can proceed to resolve the Federal Circuit–Judge Albright showdown.

I. Mandamus: From English Origins to Modern American Doctrine

Today’s appellate courts use the writ of mandamus as “a command” to direct an “inferior court” to perform a particular function or duty.⁵³ But as Justice Oliver Wendell Holmes Jr. once said: “The history of what the law has been is necessary to the knowledge of what the law is.”⁵⁴ Thus, we begin where so many of our nation’s storied legal traditions and apprehensions derive from—the King of England.⁵⁵

A. English Origins: The King’s Prerogative Writs

Early English kings asserted absolute power over their subjects.⁵⁶ But as England’s central monarchy expanded after the Norman Conquest, the King’s power became more dispersed.⁵⁷ During the Tudor Period, for example, Parliament passed the Star Chamber Act of 1487,⁵⁸ which created an executive tribunal distinct from the common-law courts.⁵⁹ The Privy Council, described as “the upholders of the power of the Executive,”⁶⁰ operated “through the prerogative courts of Star Chamber.”⁶¹

⁵³ *Mandamus*, BLACK’S LAW DICTIONARY (11th ed. 2019).

⁵⁴ See Harold Weintraub, *English Origins of Judicial Review by Prerogative Writ: Certiorari and Mandamus*, 9 N.Y.L.F. 478, 478 (1963) (quoting OLIVER WENDELL HOLMES, JR., *THE COMMON LAW* 37 (1881)).

⁵⁵ For a more comprehensive review of the writ of mandamus’s history and interpretation, see 16 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, *FEDERAL PRACTICE AND PROCEDURE* §§ 3932–3935 (3d ed. 2019). See also Gugliuzza, *supra* note 3, at 352–61 (providing a comprehensive review of both the writ’s history and the Federal Circuit’s mandamus jurisprudence from inception through 2012); Weintraub, *supra* note 54, at 479–83; Edward Jenks, *The Prerogative Writs in English Law*, 32 YALE L. J. 523, 523, 530 (1923) (reviewing the use of the prerogative writs in England).

⁵⁶ See, e.g., 1 WILLIAM BLACKSTONE, *COMMENTARIES* *231. King James I, for example, likened a subject’s questioning of his authority to a subject’s questioning of god’s existence: “[A]s it is atheism and blasphemy in a creature to dispute what the deity may do, so it is presumption and sedition in a subject to dispute what a king may do in the height of his power . . .” *Id.*

⁵⁷ See Jenks, *supra* note 55, at 523.

⁵⁸ 1 Hen. 7, c. 1 (1486).

⁵⁹ See Weintraub, *supra* note 54, at 483.

⁶⁰ Jenks, *supra* note 55, at 526.

⁶¹ Weintraub, *supra* note 54, at 483.

The Privy Council's remedial powers were as broad as they were nebulous, limited only by the breadth of the King's wishes.⁶² Unbound by common-law precedent, it could "bring a complete and inexorable justice" to the people, protecting them "against the exactions and corruptions of the king's officials."⁶³ The Privy Council enforced its decisions by using several "prerogative writs"—previously used only by the King himself—including the writs of habeas corpus, prohibition, quo warranto, certiorari, and mandamus.⁶⁴ While each prerogative writ has its own story of common-law incorporation, the writ of mandamus was woven into the judiciary's common-law fabric by Sir Edward Coke—the "father" of mandamus—while he presided on the King's Bench in 1615.⁶⁵

For most scholars, the watershed decision for the common-law writ of mandamus is *Bagg's Case*,⁶⁶ in which James Bagg challenged his removal from a magistrate position by his borough mayor and fellow magistrates for alleged misconduct.⁶⁷ Chief Justice Coke, unpersuaded by the evidence presented, gave the borough two options: (1) restore Mr. Bagg to office or (2) show cause as to why he was removed.⁶⁸ Their attempt to show cause failed,⁶⁹ and the King's Bench issued a writ to compel the borough to restore Mr. Bagg to his prior office.⁷⁰ Chief Justice Coke supported his authority to issue such a writ with a sweeping declaration:

[The] King's Bench [has] authority, not only to correct errors in judicial proceedings, but other errors and misdemeanors extra-judicial, tending to the breach of peace, or oppression of the subjects, or to the raising of faction, controversy, debate, or to any manner of misgovernment; so that no wrong or injury, either public or private, can be done but that it shall be (here) reformed or punished by due course of law.⁷¹

⁶² *Id.*

⁶³ *Id.* (quoting J. Hurstfield, *Constitutional Development*, in *LIFE UNDER THE TUDORS* 29, 31–32 (1950)).

⁶⁴ See Jenks, *supra* note 55, at 527–30.

⁶⁵ Weintraub, *supra* note 54, at 488. But see Robert H. Howell, *An Historical Account of the Rise and Fall of Mandamus*, 15 VICTORIA U. WELLINGTON L. REV. 127, 128–32 (1985) (arguing that the writ of mandamus has roots far deeper than *Bagg's Case*).

⁶⁶ See James Bagg's Case (1615) 77 Eng. Rep. 1271; 11 Co. Rep. 93 b.

⁶⁷ *Id.* at 1275; 11 Co. Rep. at 96 a.

⁶⁸ *Id.* at 1271–72; 11 Co. Rep. at 93 b–94 a.

⁶⁹ *Id.* at 1281; 11 Co. Rep. at 99 b.

⁷⁰ *Id.* The court, however, technically issued a writ of restitution in response to Mr. Bagg's claim. But the effect of the writ was to command a government official to perform an action, which in substance functioned like a writ of mandamus. *Id.* at 1280; 11 Co. Rep. at 99 a–99 b.

⁷¹ *Id.* at 1277–78; 11 Co. Rep. 98 a (footnotes omitted).

In effect, Chief Justice Coke asserted that the King’s Bench possessed the same breadth of equitable power as the King’s prerogative courts.⁷² This assertion was dubious at best. But common-law tradition ratified his invocation over the next century. Indeed, Blackstone’s recitation of the writ in 1765 supports this interpretation.⁷³

To sum up, the mandamus began with the English King, who vested this power in the Privy Council, which Lord Coke arrogated for the King’s Bench, and common-law tradition ratified. The substance of this writ of mandamus largely resembles the American writ used today. Yet the American incorporation and development of the writ added further nuance.

B. *American Lineage: From Common-Law Doctrine to Federal Statute*

Early Article III courts used the writ of mandamus similarly to England’s common-law courts. The Founders understood both the utility and the need to allow the judiciary to compel performance of its orders by obstinate judges or members of the coequal branches. Thus, the First Congress expressly empowered the judiciary to issue writs—including the writ of mandamus—under the Judiciary Act of 1789 in Sections 13 and 14.⁷⁴ Particularly relevant is Section 14, which vested in all U.S. courts the “power to issue . . . all other writs not specially provided for by statute, which may be necessary for the exercise of their respective jurisdictions, and agreeable to the principles and usages of law.”⁷⁵

Early Supreme Court decisions interpreted the “all other writs” provision “narrowly[,] as limited to instances where the proper exercise of jurisdiction would otherwise be defeated.”⁷⁶ Indeed, the writ of mandamus was usually invoked for only two reasons: (1) to correct an official court action made inconsistent with its jurisdiction; or (2) to compel the performance of some official duty.⁷⁷ In the watershed case of *Marbury v. Madison*,⁷⁸ for example, Chief Justice John Marshall found that a writ of

⁷² See Weintraub, *supra* note 54, at 489 (“This was an extraordinary assertion of power, authority and independence . . .”).

⁷³ BLACKSTONE, *supra* note 56, at *110 (“A writ of mandamus is, in general, a command issuing in the king’s name from the court of king’s bench, and directed to any person, corporation, or inferior court of judicature, within the king’s dominions; requiring them to do some particular thing therein specified, which appertains to their office and duty, and which the court of king’s bench has previously determined, or at least supposes, to be consonant with right and justice.” (emphasis omitted)).

⁷⁴ See Judiciary Act of 1789, ch. 20, §§ 13–14, 1 Stat. 73, 81–82 (1789).

⁷⁵ *Id.* § 14.

⁷⁶ Pushaw, *supra* note 8, at 474 n.45.

⁷⁷ See *id.*

⁷⁸ 5 U.S. (1 Cranch) 137 (1803).

mandamus would have been the proper remedy to compel then-Secretary of State James Madison to deliver Mr. Marbury's commission.⁷⁹ The scope of permissible applications for the writ changed little over the next century; federal courts continued to invoke the writ "in the same manner as English courts at common law."⁸⁰

This practice was codified in Title 28 of the Judiciary Act of 1948.⁸¹ Both provisions relevant to this Comment remain substantively unchanged since their codification:

* 28 U.S.C. § 1651(a): "The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law."⁸²

* 28 U.S.C. § 1404(a): "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought"⁸³

While § 1651 used language consonant with the Judiciary Act of 1789, the meaning of § 1404(a) was less clear. The precursor to § 1404, the doctrine of *forum non conveniens*, permitted a competent court to dismiss a case in which venue was proper "for the convenience of the litigants and the witnesses, [if] it appear[ed] that the action should proceed in another forum" where it could have been brought initially.⁸⁴ The Supreme Court's 1947 decision in *Gulf Oil Corp. v. Gilbert*⁸⁵ is often cited as a modern explanation of the doctrine. *Gilbert*'s holding required district courts to weigh eight factors when deciding whether to dismiss a case for *forum non conveniens*.⁸⁶ The four private interests include (1) the relative ease of access to sources of proof; (2) the availability of compulsory

⁷⁹ *Id.* at 139.

⁸⁰ *Gugliuzza*, *supra* note 3, at 354 & nn.62–63 (citing *United States ex rel. Dunlap v. Black*, 128 U.S. 40, 48 (1888) (compelling executive official to act when refusing to take a required action); *Ex parte Bradstreet*, 32 U.S. (7 Pet.) 634, 648–50 (1833) (ordering inferior courts to reinstate improperly dismissed cases); *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 614–15 (1824) (mandating a district judge to conduct a patent validity trial)).

⁸¹ See Judiciary Act of 1948, ch. 646, §§ 1404, 1651, 62 Stat. 869, 937, 944; see also Whitney R. Harris, *Survey of the Federal Judicial Code: The 1948 Revision and First Interpretive Decisions*, 3 SW. L.J. 229, 234–37 (1949) (discussing both substantive and procedural law changes arising from the 1948 codification).

⁸² 28 U.S.C. § 1651(a).

⁸³ 28 U.S.C. § 1404(a).

⁸⁴ *Forum Non Conveniens*, BLACK'S LAW DICTIONARY (11th ed. 2019). For those who seek a deeper understanding of the adoption and development of *forum non conveniens* in American jurisprudence, see generally Paxton Blair, *The Doctrine of Forum Non Conveniens in Anglo-American Law*, 29 COLUM. L. REV. 1 (1929).

⁸⁵ 330 U.S. 501 (1947).

⁸⁶ *Id.* at 508–09.

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.⁸⁷ The four public interests 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 conflicts of laws problems.⁸⁸

But Congress created a substantial ambiguity when it enacted § 1404. Forum non conveniens required a district court to dismiss a case in full.⁸⁹ Section 1404(a), however, permitted a district court to exercise broad discretion and either retain jurisdiction over the case or transfer it to another court when it was “[f]or the convenience of parties and witnesses” and “in the interest of justice.”⁹⁰

Predictably, the question arose: did Congress intend to merely codify forum non conveniens with § 1404(a) or was this an intentional revision of the common-law doctrine? The Supreme Court resolved this ambiguity just a year later. In *Ex parte Collett*,⁹¹ the Court held that a decision to transfer venue required the district court to apply the forum non conveniens factors.⁹² The Supreme Court also admonished the petitioners for seeking a writ of mandamus, for the writ was an “extraordinary remed[y]” that was “reserved for really extraordinary causes.”⁹³ This heightened threshold remains good law today.⁹⁴

Six years later, the Court decided *Norwood v. Kirkpatrick*,⁹⁵ which clarified the relationship between forum non conveniens and § 1404(a). There, the Court discussed Congress’s adoption of § 1404(a), finding that it “intended to do more than just codify the existing law on forum non conveniens,” for Congress “was revising as well as codifying.”⁹⁶ Since Congress had excised “[t]he harshest result” of forum non conveniens—“dismissal of the action”—the Court inferred that Congress had “intended

⁸⁷ *Id.* at 508; see also *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 241 & n.6 (1981) (citing *Gilbert*, 330 U.S. at 508).

⁸⁸ *Gilbert*, 330 U.S. at 508–09; see also *Piper Aircraft*, 454 U.S. at 241 & n.6 (citing *Gilbert*, 330 U.S. at 509).

⁸⁹ See *Gilbert*, 330 U.S. at 503.

⁹⁰ 28 U.S.C. § 1404(a).

⁹¹ 337 U.S. 55 (1949).

⁹² *Id.* at 58, 72.

⁹³ *Id.* at 72 (quoting *Ex parte Fahey*, 332 U.S. 258, 259–60 (1947)).

⁹⁴ See, e.g., *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380 (2004) (“This is a ‘drastic and extraordinary’ remedy ‘reserved for really extraordinary causes.’” (quoting *Ex parte Fahey*, 332 U.S. at 259–60)).

⁹⁵ 349 U.S. 29 (1955).

⁹⁶ *Id.* at 32 (emphasis removed) (citing *Ex parte Collett*, 337 U.S. at 55–61).

to permit courts to grant transfers upon a lesser showing of inconvenience.⁹⁷ But this did not mean § 1404(a) created a new test. Rather, the Court explained that its decision did not change the relevant factors or the importance of plaintiff's choice of forum but emphasized "that the discretion to be exercised is broader."⁹⁸

By the 1950s, the writ of mandamus's substantive features were remarkably unchanged from the prerogative writ employed by the Privy Council. And this continued for another fifty years in the Fifth Circuit.

C. *The Fifth Circuit's Mandamus Jurisprudence*

At first, the Fifth Circuit's use of the writ of mandamus for § 1404(a) motions was limited. It generally deferred to the district court's fact finding, affording it wide discretion.⁹⁹ In the 1950s, the Fifth Circuit granted only one out of six relevant mandamus petitions.¹⁰⁰ But even that one grant was anomalous because the district court improperly rested its decision on two mistrials in the district court.¹⁰¹

That said, one of the cases denying mandamus merits further discussion. *Ex parte Chas. Pfizer & Co.*¹⁰² was the seminal case that governed § 1404(a) mandamus petitions in the Fifth Circuit until *In re Volkswagen of America*.¹⁰³ In *Ex Parte Chas.*, Pfizer received a chemical patent and sued the

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ See, e.g., *Ex parte Chas. Pfizer & Co.*, 225 F.2d 720, 722–23 (5th Cir. 1955).

¹⁰⁰ See *Cont'l Grain Co. v. Fed. Barge Lines, Inc.*, 268 F.2d 240, 243–44 (5th Cir. 1959) (denying petition because location of witnesses supported venue transfer), *aff'd*, 364 U.S. 19 (1960); *Ex parte Blaski*, 245 F.2d 737, 737–39 (5th Cir. 1957) (denying petition because location of witnesses and economy of litigation supported transfer); *Ex parte Pharma-Craft Corp.*, 236 F.2d 911, 912 (5th Cir. 1956) (per curiam) (denying petition because the economy of litigation from joining three other suits in the requested forum superseded the plaintiff's choice of forum and pray for a reduced time to trial); *Ex parte Chas.*, 225 F.2d at 723 (denying petition because the district court judge properly weighed the interests and balanced the necessary factors); *Crummer Co. v. Du Pont*, 196 F.2d 468, 469 (5th Cir. 1952) (denying petition because venue transfer is non-appealable and interlocutory petition for mandamus had been rejected); *Atl. Coast R.R. Co. v. Davis*, 185 F.2d 766, 769–70 (5th Cir. 1950) (granting petition because the district court's decision to transfer venue based on two mistrials without considering the standard venue transfer factors amounted to a "renunciation of jurisdiction").

¹⁰¹ *Atl. Coast R.R. Co.*, 185 F.2d at 769–70.

¹⁰² 225 F.2d 720 (5th Cir. 1955).

¹⁰³ See, e.g., *In re Horseshoe Ent.*, 337 F.3d 429, 432 (5th Cir. 2003) (stating that *Ex parte Chas.* had not "been overruled or criticized by this Court"); *Novartis Vaccines & Diagnostics, Inc. v. Wyeth*, No. 2-08-cv-0006, 2010 WL 3447806, at *3 (E.D. Tex. Aug. 30, 2010) (citing *In re Volkswagen of Am., Inc.*, 506 F.3d 376, 380 (5th Cir. 2007), for forum non conveniens factors); *Mod. Am. Recycling Serv., Inc. v.*

defendants for patent infringement in the Northern District of Georgia.¹⁰⁴ The defendants moved to transfer venue under § 1404(a) to the Southern District of New York, which the court granted.¹⁰⁵ Denying Pfizer’s petition for a writ of mandamus to transfer the case back, the Fifth Circuit held that the district court had not abused its discretion.¹⁰⁶ The Fifth Circuit’s cursory review of the lower court’s decision is instructive. The court declared that it “should not entertain motions for Writs of Mandamus” under § 1404(a) unless the district court failed to “construe and apply the statute,” “consider the relevant factors,” or the Fifth Circuit needed to “correct a clear abuse of discretion.”¹⁰⁷ Indeed, the court revealed that it “shall not attempt to recite the facts nor to weigh and balance the factors which the District Court was required to consider in reaching its decision.”¹⁰⁸ In other words, if the district court judge analyzed a § 1404(a) request by evaluating all the *Gilbert* factors based on case-specific facts, the Fifth Circuit deferred to its ruling. The Court’s decision in *Ex parte Pharma-Craft Corp.*¹⁰⁹ confirms this understanding.¹¹⁰

No relevant § 1404(a) mandamus petitions were granted in the 1960s.¹¹¹ Yet the Fifth Circuit did elaborate on the defendant’s burden of proof in *Humble Oil & Refining Co. v. Bell Marine Service, Inc.*¹¹² That case concerned a tug boat collision that occurred on the Mississippi River.¹¹³ Reviewing the defendant’s venue-transfer mandamus petition, the Fifth Circuit scrutinized the lower court’s analysis by reviewing whether each relevant fact weighed for or against transfer.¹¹⁴ With factors pointing in

Dunavant, No. 10-3153, 2011 WL 1303136, at *4 (E.D. La. Mar. 31, 2011) (citing *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (en banc), for forum non conveniens factors).

¹⁰⁴ *Ex parte Chas.*, 225 F.2d at 720–21.

¹⁰⁵ *Id.* at 721.

¹⁰⁶ *Id.* at 723.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ 236 F.2d 911 (5th Cir. 1956).

¹¹⁰ *Id.* at 912 (refusing to grant mandamus because the district court “considered all pertinent facts, properly construed the statute and did not abuse its discretion”).

¹¹¹ See *Miller v. Connally*, 354 F.2d 206, 209 (5th Cir. 1965); *Humble Oil & Refin. Co. v. Bell Marine Serv., Inc.*, 321 F.2d 53, 57 (5th Cir. 1963); *In re Sw. Mobile Homes, Inc.*, 317 F.2d 65, 66–67 (5th Cir. 1963); *United States v. Choate*, 276 F.2d 724, 729 (5th Cir. 1960).

¹¹² 321 F.2d 53, 56–57 (5th Cir. 1963).

¹¹³ *Id.* at 55.

¹¹⁴ *Id.* at 56. For the Southern District of Texas, the court found: (1) three ex-crew members of the plaintiff were Texas residents not subject to compulsory process in Louisiana; (2) the plaintiff named these ex-employees as probable witnesses; (3) their testimony appeared crucial, with sufficient detail of their testimony provided in an affidavit; (4) two of the three parties (Humble and Bell) had principal offices and officers in Houston; (5) no party had its principal office in Louisiana; and (6) the tug boat was registered in Houston. *Id.* For the Eastern District of Louisiana: (1) one of Humble’s

both directions, the Fifth Circuit denied the petition, holding that since the district court relied on the proper factors and relevant facts, the decision to transfer “was a matter to be weighed by the District Court.”¹¹⁵ The Fifth Circuit extended this further in the 1970s, declaring in *Garner v. Wolfinbarger*¹¹⁶ that the “basis for a writ [of mandamus]” is not just that the requested forum is “on balance . . . a more convenient forum.”¹¹⁷ Indeed, the Fifth Circuit clarified that the balance of convenience factors had to weigh “*strongly* in favor of the defendant.”¹¹⁸ The Fifth Circuit made no relevant doctrinal changes to its mandamus jurisprudence in the 1990s.

All in all, the Fifth Circuit hewed closely to the framework in *Ex parte Chas.* for nearly fifty years. It clarified, however, that a defendant needed to show that the convenience factors weighed strongly in their favor; merely showing that the requested forum was on balance more convenient was insufficient.¹¹⁹ This framework also reflected the Supreme Court’s original interpretation of § 1404(a) in *Ex parte Collett* and *Kirkpatrick*, later reaffirmed by *Piper Aircraft Co. v. Reyno*.¹²⁰ But then something changed. And the Fifth Circuit created a new mandamus framework out of whole cloth.

Between 2002 and the Fifth Circuit’s seminal *In re Volkswagen of America* decision in 2008, the court granted all four¹²¹ relevant § 1404(a) mandamus petitions.¹²² The Fifth Circuit’s earliest jurisprudential shift

witnesses resided in Louisiana; (2) the manager of one of the defendant’s companies resided in Louisiana; (3) the manager stated his witnesses were in Louisiana, but he did not name them or describe their testimony; (4) the collision occurred in Louisiana; and (5) the related proceeding in Louisiana would save time, cost, and judicial resources if they could run a consolidated trial. *Id.*

¹¹⁵ *Id.* at 57.

¹¹⁶ 433 F.2d 117 (5th Cir. 1970).

¹¹⁷ *Id.* at 120–21. The Fifth Circuit upheld *Garner* eleven years later in *Castanho v. Jackson Marine, Inc.*, 650 F.2d 546, 550–51 (5th Cir. 1981).

¹¹⁸ *In re McDonnell-Douglas Corp.*, 647 F.2d 515, 517 (5th Cir. 1981) (emphasis added) (citing *Gulf Oil Co. v. Gilbert*, 330 U.S. 501 (1947)).

¹¹⁹ See, e.g., *Garner*, 433 F.2d at 121.

¹²⁰ 454 U.S. 235, 257 (1981); see, e.g., *Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955).

¹²¹ There are actually seven relevant decisions; however, three are not counted. Two opinions are superseded by en banc decisions. See *In re Volkswagen of Am., Inc.*, 506 F.3d 376 (5th Cir. 2007); *In re Volkswagen of Am., Inc.*, 223 F. App’x 305 (5th Cir. 2007). The remaining case was reheard and withdrawn. See *In re Horseshoe Ent.*, 305 F.3d 354 (5th Cir. 2002).

¹²² *In re Volkswagen AG*, 371 F.3d 201, 206 (5th Cir. 2004); *In re Horseshoe Ent.*, 337 F.3d 429, 435 (5th Cir. 2003); *In re DaimlerChrysler Corp.*, 294 F.3d 697, 700 (5th Cir. 2002); *In re DaimlerChrysler Corp.*, Nos. 02-10029, 02-10034, 02-10035, 02-10036, 02-10037, 2002 U.S. App. LEXIS 8756, at *7–8 (5th Cir. Mar. 8, 2002). Two of these cases, however, were granted because of jurisdictional defects related to orders issued by a district court that directed parties under the jurisdiction of another court. See, e.g., *In re DaimlerChrysler Corp.*, 294 F.3d at 700.

occurred in *In re Horseshoe Entertainment*,¹²³ where the district court found the following: (1) all parties resided in the requested forum, which “militate[d] in favor of . . . transfer”; (2) the location of books and records was irrelevant because of advances in electronic records and document exchange practices; (3) the possibility of delay or prejudice from transfer weighed for retention; and (4) the plaintiff’s choice of forum and the location of counsel also favored retention.¹²⁴ The court rejected transfer, concluding the relevant factors were “evenly divided.”¹²⁵

The Fifth Circuit disagreed, ordering transfer and admonishing the lower court for making three errors: (1) using the location of counsel as a relevant factor; (2) discounting the relevance of the location of books and records; and (3) considering the “possibility of delay or prejudice” as a relevant factor.¹²⁶ The first and third errors, it stated, concerned irrelevant factors that should not have been considered.¹²⁷ The second error, by contrast, concerned a relevant factor improperly weighed.¹²⁸ In support, the Fifth Circuit cited *Ex parte Chas.*, finding that the lower court failed to “consider the relevant factors incident to ruling.”¹²⁹ In dissent, Judge Pedro Benavides found that “[a]ll necessary facts and factors were considered by the district court,” and because the “transfer statute was properly construed,” the court should “not even attempt to weigh and balance the factors.”¹³⁰ He also characterized the majority’s analysis as a “*de novo* review.”¹³¹

The Fifth Circuit doubled down on this “*de novo* review” in *In re Volkswagen AG*,¹³² reviewing the district court’s analysis factor by factor, granting mandamus and largely discounting the district court’s conclusions.¹³³ Yet this new framework had not been adopted in full by the Fifth Circuit.¹³⁴ Thus, to enshrine the current majority position of the Fifth

¹²³ 337 F.3d 429 (5th Cir. 2003).

¹²⁴ *Id.* at 433–34.

¹²⁵ *Id.* at 434 (quoting *Rogers v. Horseshoe Ent.*, No. 01–CV–295 (M.D. La. July 2, 2002) (opinion available on transferred docket as *Rogers v. Horseshoe Ent.*, No. 02–cv–02026, (W.D. La. Sep 20, 2002), ECF No. 50).

¹²⁶ *Id.* at 435 (quoting *In re Horseshoe Ent.*, No. 01–CV–295).

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ See *In re Horseshoe*, 337 F.3d at 432 (citing *Ex parte Chas. Pfizer & Co.*, 225 F.2d 720 (5th Cir. 1955), as “*Ex parte Pfizer & Co.*” and referring to the standards of review as the “Pfizer Standards”).

¹³⁰ *Id.* at 435 (Benavides, J., dissenting).

¹³¹ *Id.*

¹³² 371 F.3d 201 (5th Cir. 2004).

¹³³ *Id.* at 204–06.

¹³⁴ See, e.g., *In re Volkswagen of Am. Inc.*, 223 F. App’x 305, 306–07 (5th Cir. 2007) (denying mandamus), *rev’d on reh’g*, 506 F.3d 376 (5th Cir. 2007).

Circuit, the court reviewed a previous case en banc where mandamus had been denied at first but granted on rehearing.¹³⁵ This case was *In re Volkswagen of America*.¹³⁶

In re Volkswagen of America was a products liability case brought by the plaintiff for injuries sustained in a car accident in his Volkswagen.¹³⁷ Volkswagen moved to transfer the case from the EDTX to the Northern District of Texas (“NDTX”) because (1) the accident occurred in Dallas; (2) the accident witnesses were in Dallas; (3) the third-party defendant lived in Dallas; (4) neither the plaintiffs nor the witnesses lived in the EDTX; (5) no sources of proof were in the EDTX; and (6) no facts giving rise to the suit were tied to the EDTX.¹³⁸

The majority began by stating that it declined to “replace a district court’s exercise of discretion with our own; we review only for clear abuses of discretion that produce patently erroneous results.”¹³⁹ It then concluded “that the district court gave undue weight to the plaintiffs’ choice of venue, ignored our precedents, misapplied the law, and misapprehended the relevant facts” and therefore held “that the district court reached a patently erroneous result and clearly abused its discretion in denying the transfer.”¹⁴⁰ Table 1 below summarizes the four contested district court findings juxtaposed to the Fifth Circuit majority’s findings.

¹³⁵ *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 307–08 (5th Cir. 2008) (en banc).

¹³⁶ *Id.*

¹³⁷ *Id.* at 307.

¹³⁸ *Id.* at 307–08.

¹³⁹ *Id.* at 312.

¹⁴⁰ *Id.* at 309.

Table 1: <i>In re Volkswagen of America</i> : Venue-Transfer Factor Determinations by the EDTX and the Fifth Circuit Majority ¹⁴¹		
Venue-Transfer Factor	EDTX	Fifth Circuit Majority
(1) Relative Ease of Access to Sources of Proof	Neutral because of the realities of eDiscovery in modern litigation.	Favored transfer because even though electronic documents reduced the sources of proof burden, the NDTX possessed physical evidence of the crash at issue.
(2) Availability of Compulsory Process	Neutral because the district court's subpoena power could ultimately compel third-party witnesses to attend trial.	Favored transfer because some non-party witnesses may fall outside the EDTX's subpoena power.
(3) Cost of Attendance for Willing Witnesses	Neutral because the defendant had failed to designate key witnesses and Dallas's proximity to Marshall made any increased cost to the witnesses negligible.	Favored transfer because many witnesses were over 100 miles from the EDTX courthouse, which increased witness inconvenience.
(4) Local Interest in Deciding Case	Neutral because Marshall's citizens had the same interest as any other city in knowing whether defective Volkswagens were sold nearby.	Favored transfer because a generalized interest does not constitute a sufficient nexus to create a localized interest.

Judge Carolyn King wrote for the dissent and rejected most (if not all) of the majority's analysis.¹⁴² She began with the following admonishment: "Whether we agree with the district court's decision . . . is not controlling . . . [because] when the district court acts within its power and authority,

¹⁴¹ *Id.* at 316–18.

¹⁴² *Id.* at 319–27 (King, J., dissenting).

mandamus is inappropriate to challenge . . . [its] decision.”¹⁴³ For support, Judge King started with the text of § 1404(a): Congress’s use of “may” meant that a change of venue request need not ever be approved by a district court.¹⁴⁴ Indeed, if “a matter is committed to discretion,” she stated, then “it cannot be said that a litigant’s right to a particular result is clear and indisputable.”¹⁴⁵

Next, Judge King repudiated the majority’s analysis of each private interest factor.¹⁴⁶ Beginning with the sources-of-proof factor, she noted that since both districts use Electronic Case Files (“ECF”), any relevant documents “will be converted to electronic form” whether they are “displayed on monitors in Dallas or Marshall.”¹⁴⁷ Second, Judge King rejected the majority’s alleged “avalanche of motions to quash,” as a theoretical but not a practical concern.¹⁴⁸ What is more, she noted that products liability cases hinge on expert testimony, and Volkswagen had not alleged that its experts lived in Dallas.¹⁴⁹ Turning to the third contested factor, Judge King criticized the majority’s 100-mile rule as arbitrary and untethered to modern litigation because cases rarely go to trial.¹⁵⁰ She also chided the majority for ignoring the Supreme Court’s warning in *Will v. United States*,¹⁵¹ which stated that “mandamus must not devolve into ‘interlocutory review of nonappealable orders on the mere ground that they *may* be erroneous.’”¹⁵²

After *In re Volkswagen of America*, the Fifth Circuit’s factor-by-factor de novo review has fully supplanted precedents like *Ex parte Chas*.¹⁵³ The

¹⁴³ *Id.* at 320.

¹⁴⁴ *Id.* at 321–22; see also 28 U.S.C. § 1404(a) (“a district court *may* transfer”) (emphasis added).

¹⁴⁵ *In re Volkswagen of Am.*, 545 F.3d at 326 (quoting *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 36 (1980)).

¹⁴⁶ *Id.* at 322–23.

¹⁴⁷ *Id.* at 322.

¹⁴⁸ See *id.*

¹⁴⁹ *Id.* at 320.

¹⁵⁰ *Id.* at 322–23; see also Joff Wild, *Why Plaintiffs in US Patent Cases Who Understand the Odds of Victory Are Almost Always Best Off Settling*, LEXOLOGY (Feb. 16, 2018), <https://perma.cc/EU9K-MUL4> (“In 2016 there were 5,100 patent litigation lawsuit filings. The vast majority of patent lawsuits settle[d] before trial—95% to 97% of them.”).

¹⁵¹ 389 U.S. 90 (1967).

¹⁵² *In re Volkswagen of Am.*, 545 F.3d at 324 (King, J., dissenting) (emphasis added) (quoting *Will*, 389 U.S. at 98 n.6).

¹⁵³ Compare *Def. Distrib. v. Bruck*, 30 F.4th 414, 434–36 (5th Cir. 2022) (reviewing the district court’s application of each § 1404(a) factor), with *Ex parte Chas. Pfizer & Co.*, 225 F.2d 720, 723 (5th Cir. 1955) (“We shall not attempt to recite the facts nor to weigh and balance the factors” which were considered by the district court).

framework has also been extended to intra-district venue transfers.¹⁵⁴ And because the Federal Circuit is precedentially bound on matters of procedure by the appellate court with jurisdiction over the appealed-from district court,¹⁵⁵ this decision created a ripple effect that would forever alter the Federal Circuit’s patent litigation jurisprudence. We now explore the ramifications of *In re Volkswagen of America* at the Federal Circuit.

D. *The Federal Circuit’s Original Mandamus Jurisprudence*

The effects of *In re Volkswagen of America* were as striking as they were immediate. Before that decision, the Federal Circuit had denied every venue-transfer mandamus petition it had received—all twenty-two of them.¹⁵⁶ But before discussing *In re Volkswagen of America’s* progeny, this Comment provides some background on the Federal Circuit.

Congress passed the Federal Courts Improvement Act in 1982, which merged the United States Court of Customs and Patent Appeals and the appellate branch of what is now the Court of Federal Claims to create the Federal Circuit.¹⁵⁷ Congress created the court to serve several purposes: fostering nationwide uniformity in patent law interpretation; reducing forum-shopping by mandating all patent appeals to be heard by one court; creating judicial efficiency through specialization; and allowing the federal appellate courts to better attend to their ever-increasing caseloads.¹⁵⁸ Unique to the Federal Circuit, Congress imposed a “choice-of-law” regime for non-patent issues,¹⁵⁹ which requires the court to “apply the law of the regional circuit” when evaluating § 1404(a) motions to transfer.¹⁶⁰ But its power to mandamus, like its sister circuits, remained rooted in the All Writs Act.¹⁶¹

¹⁵⁴ See, e.g., *In re Radmax, Ltd.*, 720 F.3d 285, 288–90 (5th Cir. 2013) (granting petition for an intra-district transfer after reviewing all eight convenience factors and finding five factors were neutral, two weighed slightly in favor of transfer, and one clearly favored transfer).

¹⁵⁵ See, e.g., *In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014); Sturiale, *supra* note 19, at 476.

¹⁵⁶ See Gugliuzza, *supra* note 3, at 346.

¹⁵⁷ See Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, §§ 106, 117, 122, 127, 96 Stat. 25, 28, 32, 36–38 (1982); see also Ellen E. Sward & Rodney F. Page, *The Federal Courts Improvement Act: A Practitioner’s Perspective*, 33 AM. U. L. REV. 385, 385–86 (1999).

¹⁵⁸ See Sward & Page, *supra* note 157, at 386–89.

¹⁵⁹ See Sturiale, *supra* note 19, at 476 (discussing how the “choice-of-law” regime binds the Federal Circuit by its own substantive patent law precedent, but for non-patent issues, the regional circuit with appellate jurisdiction over the appealing district court binds the Federal Circuit).

¹⁶⁰ See, e.g., *In re Barnes & Noble, Inc.*, 743 F.3d 1381, 1383 (Fed. Cir. 2014).

¹⁶¹ 28 U.S.C. § 1651(a).

The Federal Circuit's early writs of mandamus were granted solely for "traditional purposes," such as "reigning in a court that was acting beyond its authority or compelling a district court to exercise jurisdiction."¹⁶² This use tracked the practices of both the late-eighteenth-century Supreme Court and the pre-twenty-first-century Fifth Circuit.¹⁶³ Faithfully applying the Fifth Circuit's mandamus precedent under *Ex parte Chas.*, the Federal Circuit rejected every venue-transfer mandamus petition it received for over twenty-five years.¹⁶⁴

But a perfect storm was brewing. The EDTX had been making a name for itself. It employed targeted case management procedures through local patent rules to create a pro-plaintiff forum that guaranteed quick resolutions.¹⁶⁵ EDTX's "rocket docket" was burgeoning, with patent filings increasing ten-fold over five years.¹⁶⁶ Scholars and jurists decried the EDTX, and Justice Antonin Scalia famously coined it the "renegade jurisdiction" in 2006.¹⁶⁷ With the cacophony of critics growing each year, a consensus emerged that the EDTX's ability to exert jurisdiction over future patent infringement actions should be limited.¹⁶⁸

Since two Fifth Circuit panels had recently granted mandamus petitions in *In re Horseshoe Entertainment* and *In re Volkswagen AG*, one could argue that the Federal Circuit already had the authority to mandamus the EDTX for abusing its discretion by refusing to grant venue-transfer motions. But uprooting twenty-five years of practice and relying on two newer—and possibly rogue—Fifth Circuit panel decisions was a shaky foundation for the Federal Circuit to flex its authority on. And then came *In re Volkswagen of America*, which the Fifth Circuit decided sitting en banc, solidifying its new de novo review standard for § 1404(a) mandamus petitions. The Federal Circuit could now apply a more muscular mandamus review and check the EDTX for exceeding its jurisdiction. It did so just two months later.

¹⁶² See Gugliuzza, *supra* note 3, at 368 (footnotes omitted).

¹⁶³ See, e.g., *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 614–15 (1824); *In re Galiardi*, 745 F.2d 335, 337 (5th Cir. 1984) (per curiam).

¹⁶⁴ See Gugliuzza, *supra* note 3, at 346, 381.

¹⁶⁵ See Nguyen, *supra* note 14, at 112 n.1, 134 (2008).

¹⁶⁶ *Id.* at 112, 130–31.

¹⁶⁷ *Id.* at 112; see also *id.* at 112 n.1 (listing sources that capture public opinion towards the EDTX's patent-docket proliferation).

¹⁶⁸ Jonas Anderson, *Congress as a Catalyst of Patent Reform at the Federal Circuit*, 63 AM. UNIV. L. REV. 961, 982–96 (2014) [hereinafter Anderson, *Congress as a Catalyst*] (discussing how both Congress and the Federal Circuit each took decisive steps to police the EDTX in response to the public outcry surrounding forum-shopping at the EDTX); see also Nguyen, *supra* note 14, at 143–51 (discussing the efforts of corporate lobbyists and Congress to police the EDTX).

E. *The Renegade Jurisdiction for Patent Litigation: The EDTX*

In *In re TS Tech USA Corp.*,¹⁶⁹ the petitioner sought mandamus from the Federal Circuit to direct transfer of its patent infringement case from the EDTX to the Southern District of Ohio.¹⁷⁰ The petitioner contended that Ohio was more convenient because (1) the physical evidence was predominately there; (2) the key witnesses all lived in Ohio, Michigan, or Canada; and (3) “none of the parties were incorporated in Texas or had offices located in the [EDTX].”¹⁷¹ The defendant countered that since several vehicles with the “allegedly infringing headrest assembly had been sold in Texas,” the district had a vested interest in the litigation and venue was proper.¹⁷² The district court denied the transfer request.¹⁷³

The Federal Circuit began its review by tipping its hat to the Fifth Circuit, embracing the “patently erroneous result” standard in *In re Volkswagen of America*.¹⁷⁴ In like manner, the court continued with the same factor-by-factor review as the Fifth Circuit in *In re Volkswagen of America*, identifying “several key errors”:¹⁷⁵ (1) “weigh[ing] the plaintiff’s choice [of venue] as a ‘factor’ against transfer”; (2) “ignor[ing] Fifth Circuit precedent in assessing the cost of attendance for witnesses”; (3) improperly finding the sources-of-proof factor neutral because eDiscovery offset any inconvenience created by physical documents in Ohio; and (4) contradicting Fifth Circuit precedent by finding the availability of infringing vehicles in the venue sufficient to create an adequate local interest to retain the case in the EDTX.¹⁷⁶ The Federal Circuit downplayed the incongruity of applying a venue-transfer analysis from a mass-tort case to a patent infringement case, finding no legally relevant distinction between them.¹⁷⁷ It then arrived at a circular conclusion, finding that the district court reached a “[p]atently [e]rroneous” result because TS Tech “ha[d] met its difficult burden of demonstrating a clear and indisputable right to a writ,” analogizing the case to *In re Volkswagen of America*.¹⁷⁸

¹⁶⁹ 551 F.3d 1315 (Fed. Cir. 2008).

¹⁷⁰ *Id.* at 1317.

¹⁷¹ *Id.* at 1318.

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 1319 (citing *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 310 (5th Cir. 2008) (en banc)).

¹⁷⁵ *In re TS Tech USA Corp.*, 551 F.3d at 1320.

¹⁷⁶ *Id.* at 1320–21.

¹⁷⁷ *Id.* at 1321. For example, a sources-of-proof favoring the location of physical evidence makes sense when the key proof is a physical (and totaled) car that cannot be moved from one district to another without significant cost.

¹⁷⁸ *Id.* at 1321–22.

In the year following the *In re TS Tech USA Corp.* decision, the Federal Circuit granted three out of the five § 1404(a) mandamus petitions it received—all from the EDTX.¹⁷⁹ Although one of the cases in which mandamus was denied, *In re Telular Corp.*,¹⁸⁰ applied a deferential standard of review that required only “a rational legal argument” from the district court,¹⁸¹ this analytical framework was anomalous compared to the Federal Circuit’s other mandamus decisions in 2009—*In re Genentech, Inc.*¹⁸² and *In re Nintendo Co.*¹⁸³ In both cases, the lower court rested its decision on the inconvenience imposed on overseas witnesses by the chosen venue, which should have supplied the “rational legal argument” necessary to prevail under *In re Telular Corp.*¹⁸⁴ Yet mandamus was granted in both cases.¹⁸⁵ To that end, the Federal Circuit continued to mandamus the EDTX by relying on two main factors: the location of witnesses and sources of proof.¹⁸⁶

The EDTX remained in the Federal Circuit’s crosshairs from 2009 through 2017, comprising 122 out of 333 mandamus requests—around 37% of all mandamus petitions to the Federal Circuit.¹⁸⁷ All the while, patent infringement filings in the EDTX exploded, peaking in 2015 with 2,540 patent cases—43% of the nation’s patent docket.¹⁸⁸ Congress proposed several reforms to patent venue requirements to address this

¹⁷⁹ See *In re Nintendo Co.*, 589 F.3d 1194, 1201 (Fed. Cir. 2009) (granting mandamus); *In re Hoffmann-La Roche, Inc.*, 587 F.3d 1333, 1335 (Fed. Cir. 2009) (granting mandamus); *In re Genentech, Inc.*, 566 F.3d 1338, 1348–49 (Fed. Cir. 2009) (granting mandamus); *In re Volkswagen of America, Inc.*, 566 F.3d 1349, 1351–52 (Fed. Cir. 2009) (denying mandamus); *In re Telular Corp.*, 319 F. App’x 909, 912 (Fed. Cir. 2009) (denying mandamus).

¹⁸⁰ 319 F. App’x 909 (Fed. Cir. 2009).

¹⁸¹ See *id.* At 912. This appears to have been one last attempt by the panel to constrain the court’s recent mandamus expansion. But the panel’s attempt was ultimately unsuccessful.

¹⁸² 566 F.3d 1338 (Fed. Cir. 2009).

¹⁸³ 589 F.3d 1194 (Fed. Cir. 2009).

¹⁸⁴ See *In re Genentech, Inc.*, 566 F.3d at 1343–44; *In re Nintendo Co.*, 589 F.3d at 1198–99.

¹⁸⁵ See *In re Genentech, Inc.*, 566 F.3d at 1348; *In re Nintendo Co.*, 589 F.3d at 1201.

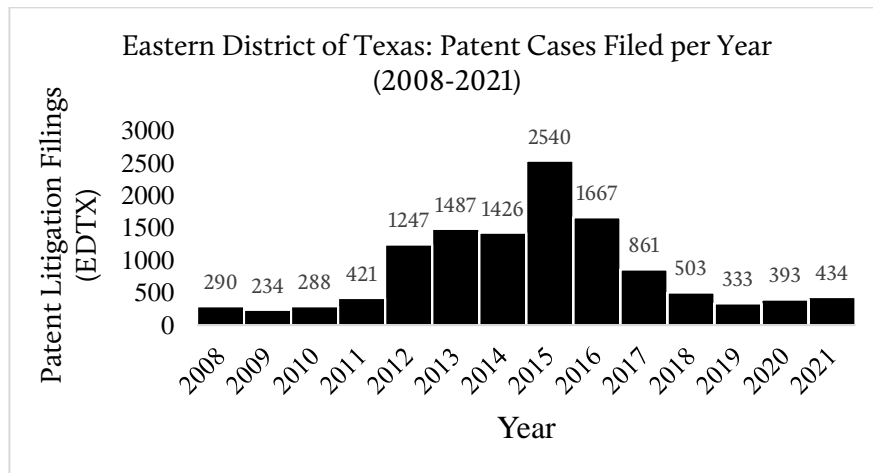
¹⁸⁶ See, e.g., *In re Acer Am. Corp.*, 626 F.3d 1252, 1255–56 (Fed. Cir. 2010) (granting mandamus because “a substantial number of party witnesses” resided “in or close to the Northern District of California,” as did a “significant portion of the evidence,” which “significantly favor[ed] transfer”); *In re Microsoft Corp.*, 630 F.3d 1361, 1363–64 (Fed. Cir. 2011); *In re Apple, Inc.*, 581 F. App’x 886, 889 (Fed. Cir. 2014) (“On the Apple side of the balance are eight identified witnesses while on the EON side of the balance are none. Such a strong showing of convenience weighs heavily in favor of transfer.”).

¹⁸⁷ Jonas Anderson, Paul Gugliuzza & Jason Rantanen, *Extraordinary Writ or Ordinary Remedy? Mandamus at the Federal Circuit—Part 2*, PATENTLY-O fig.1 (Oct. 20, 2021) [hereinafter *Extraordinary Writ: Part 2*], <https://perma.cc/S79N-ZQ8V>.

¹⁸⁸ Owen Byrd, *Lex Machina 2015 End-of-Year Trends: Patent Litigation*, LEX MACHINA fig.3 (Jan. 7, 2016), <https://perma.cc/F9WA-BAYC>.

concern.¹⁸⁹ Yet all the proposed reforms, which began in 2005 and continued until Congress passed the America Invents Act in 2011, did not succeed.¹⁹⁰ Finally, the Supreme Court intervened in its 2017 *TC Heartland* decision, which constrained the EDTX’s patent jurisdiction by imposing stricter venue requirements.¹⁹¹ Patent filings in the EDTX plunged, shown by Figure 1.

Figure 1: Patent Litigation Filings in the EDTX by Year¹⁹²



With the EDTX sufficiently neutered by the *TC Heartland* decision, the outcry surrounding its patent litigation empire quieted. But then the Senate confirmed a new WDTX judge in September 2018.¹⁹³ Enter Alan Albright.

¹⁸⁹ Anderson, *Congress as a Catalyst*, *supra* note 168, at 985–1004.

¹⁹⁰ *See id.*

¹⁹¹ *See TC Heartland LLC v. Kraft Foods Group Brands LLC*, 581 U.S. 258, 268–270 (2017)

¹⁹² *See Docket Navigator Analytics*, DOCKET NAVIGATOR (Dec. 26, 2021), <https://perma.cc/8N9S-FCV2> (searching analytics for cases filed: Courts: Eastern District of Texas and Document Filing Date: On or After Jan. 1st, 2008). For an explanation of why patent filings decreased in 2016 (before the Supreme Court’s *TC Heartland* decision), *see* Michael Loney, *Patent Litigation Cools in the Eastern District of Texas*, MANAGINGIP (July 29, 2016), <https://perma.cc/373B-LQXT> (discussing how an anticipated amendment to the Federal Rules of Civil Procedure in December 2015 caused a spike of over 800 cases to be filed in November 2015, which would have likely otherwise been filed in 2016).

¹⁹³ *PNI523—Alan D. Albright—The Judiciary*, *supra* note 25.

F. *The NEW ‘Renegade Jurisdiction’ for Patent Litigation: The WDTX*

Judge Albright was appointed to the Waco division of the WDTX in 2018.¹⁹⁴ As of April 2023, he remains the sole judge over this division.¹⁹⁵ And the WDTX’s local rules ensured that any plaintiff which filed in the Waco division would have Judge Albright preside over its case.¹⁹⁶ Since venue is based on federal *districts* and not federal *divisions*, if venue was proper anywhere in the WDTX—including Austin (often called Silicon Valley II)¹⁹⁷—venue was also proper in the Waco division.¹⁹⁸ This introduced another wrinkle into the venue-transfer equation that allowed the WDTX to withstand the Supreme Court’s recent tightening of venue requirements. The EDTX, by contrast, had only three larger cities—each a suburb of Dallas.¹⁹⁹ The jurisdictional hook of Austin, then, could put large tech companies in the crossfire of various nonpracticing entities (NPEs), also known as “patent trolls.”²⁰⁰ Shortly after Judge Albright’s confirmation, an explosion of patent litigation ensued. Filings increased nearly ten-fold in the WDTX from 2018 to 2020, shown below in Figure 2.²⁰¹

¹⁹⁴ *Id.*

¹⁹⁵ See *Judges’ Directory & Biographies*, U.S. DIST. CT. W. DIST. TEX., <https://perma.cc/K2B8-2ZD6> (providing information on the WDTX’s judges and divisions).

¹⁹⁶ *Amended Order*, *supra* note 42.

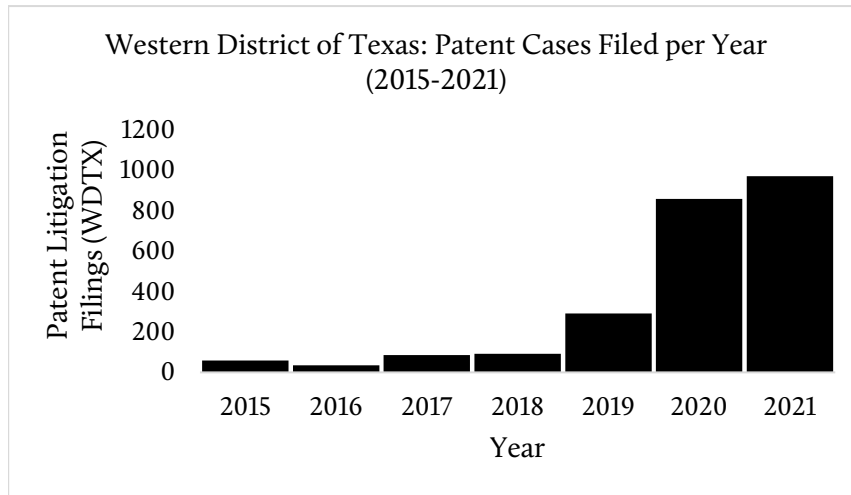
¹⁹⁷ See, e.g., *Austin, Nicknamed Silicon Hills, Is on Its’ Way to Beginning an Even Bigger Tech Hub*, RECRUITABILITY (Apr. 19, 2022) (referring to Austin as “Silicon Hills”), <https://perma.cc/952N-ZWJ3>.

¹⁹⁸ See, e.g., *In re Cray, Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017) (“[O]ur analysis of the case law and statute reveal three general requirements relevant to the [venue] inquiry: (1) there must be a physical place in the *district*; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant. If any statutory requirement is not satisfied, venue is improper under § 1400(b).” (emphasis added)).

¹⁹⁹ *Court Information*, U.S. DIST. CT. E. DIST. OF TEX., <https://perma.cc/H966-DWFT> (referring to Plano, McKinney, and Frisco).

²⁰⁰ See, e.g., Anderson & Gugliuzza, *supra* note 27, at 422 (noting that “over 85 percent of Waco’s patent suits [we]re filed by ‘nonpracticing entities’ (‘NPEs,’ or more pejoratively, ‘patent trolls’)—companies that do not make anything but that exist solely to enforce patents”).

²⁰¹ See Derek Freitas & BakerHostetler, *2020 Patent Litigation: Year in Review*, JDSUPRA (Mar. 25, 2021), <https://perma.cc/KN5Z-L853>.

Figure 2: Patent Litigation Filings in the WDTX by Year²⁰²

Just as with the EDTX before it, the WDTX’s spike in patent infringement filings, combined with Judge Albright’s interest in retaining patent cases, increased mandamus petitions at the Federal Circuit: one in 2019, eleven in 2020, and forty-nine in 2021.²⁰³ The Federal Circuit reviewed these petitions with increasing skepticism, employing the same *de novo* review it applied in *In re TS Tech USA Corp.*²⁰⁴

In *In re Apple Inc.*,²⁰⁵ for example, Apple moved to transfer from the WDTX to the Northern District of California (“NDCA”).²⁰⁶ Table 2 below summarizes the differences between the conclusions drawn by the district court, which denied Apple’s venue-transfer request, and the Federal Circuit majority, which granted Apple’s mandamus petition.²⁰⁷

²⁰² See *Docket Navigator Analytics*, DOCKET NAVIGATOR (Dec. 26, 2021), <https://perma.cc/8N9S-FCV2> (searching analytics in Patent Library for cases filed: Courts: Western District of Texas and Document Filing Date: On or After Jan. 1st, 2015).

²⁰³ See *Extraordinary Writ: Part 2*, *supra* note 187, at fig.1 (using the 2019, 2020, and part of the 2021 figures); *Federal Circuit Mandamus Docket 2021*, *supra* note 1 (using results to quantify Federal Circuit mandamus petitions for 2021 not reflected by Figure 1 in the Anderson article (10/1/2021-12/31/2021)).

²⁰⁴ 551 F.3d 1315 (Fed. Cir. 2008).

²⁰⁵ 979 F.3d 1332 (Fed. Cir. 2020).

²⁰⁶ *Id.* at 1335.

²⁰⁷ *Id.* at 1336, 1347.

Table 2: <i>In re Apple</i>: Venue-Transfer Factor Determinations by the WDTX and the Federal Circuit Majority²⁰⁸		
Venue-Transfer Factor	WDTX	Federal Circuit Majority
(1) Relative Ease of Access to Sources of Proof	Slightly favored transfer because the location of witnesses favored transfer and the location of documents was neutral.	Favored transfer because the lower court didn't properly weigh the various sources of proof, especially those in the NDCA.
(2) Cost of Attendance for Willing Witnesses	Neutral because the inventors were closer to the WDTX, but most of the party witnesses resided in NDCA.	Favored transfer because the third-party witnesses would be only marginally inconvenienced with a trial in California instead of Texas, and both parties had several party witnesses in the NDCA.
(3) Practical Problems	Weighed heavily against transfer because the case had progressed substantially and the NDCA had greater case congestion from its larger civil docket.	Favored transfer slightly because there would be judicial economy to resolve this case with Apple's other pending cases in the NDCA. It rejected the district court's reasoning because the significant steps were taken after Apple filed its transfer motion, and historically the NDCA had a faster time to trial than the WDTX.
(4) Administrative Difficulties Flowing from Court Congestion	Weighed against transfer because the scheduled trial date was faster than NDCA's historical time to trial.	Neutral because the court's ability to set an early trial date was not that relevant to the court congestion factor.

²⁰⁸ *Id.* at 1339–45.

(5) Local Interest in Deciding Case	Neutral because Apple had a substantial presence in both the WDTX and NDCA.	Favored transfer because the events giving rise to the suit occurred in the NDCA, where Apple maintains significant ties to the community.
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Judge Kimberly Moore dissented vigorously, rebuking the majority for using the court’s mandamus jurisdiction to “exercise de novo dominion . . . over the district court’s individual fact findings and the balancing determination that Congress has committed ‘to the sound discretion of the trial court.’”²⁰⁹ She also underscored Apple’s substantial ties to the WDTX: “Apple maintains a large campus [in the WDTX] employing thousands of people,” which manufactures one of the accused products, hosts “third-party information and potential witnesses,” and makes adjudication in the WDTX “convenient for potential witnesses and sources of proof” and “would not impose a significant hardship on Apple.”²¹⁰ Judge Moore concluded by characterizing the majority’s decision as “simply substitut[ing] its judgment that transfer should be ordered for that of the district court,” which she found insufficient to “warrant the extraordinary remedy of mandamus.”²¹¹

The de novo review employed by the majority in *In re Apple, Inc.* governed the Federal Circuit’s WDTX mandamus petitions for the rest of 2021 and most of 2022.²¹² Compared to the historical mandamus grant rate of 10% by the Federal Circuit,²¹³ 2021 was an aberration: the court granted 60% (18/30) of the § 1404(a) mandamus petitions against Judge Albright.²¹⁴

²⁰⁹ *Id.* at 1347 (Moore, J., dissenting).

²¹⁰ *Id.*

²¹¹ *Id.* at 1353.

²¹² See, e.g., *In re Apple, Inc.*, No. 2022-128, 2022 WL 1196768, at *2–5 (Fed. Cir. Apr. 22, 2022) (conducting an extensive review and rejecting the court’s conclusions on six factors and ordering transfer); *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1318–19, 1321 (Fed. Cir. 2021) (finding eleven witnesses in the NDCA to one in the WDTX a “striking imbalance,” and that even though “Juniper maintains evidence on servers in other locations [than the NDCA],” since none is in the WDTX, “the court clearly erred”); *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1379 (Fed. Cir. 2021) (finding that since the “petitioners submitted undisputed affidavits identifying over a dozen third-party individuals with relevant and material information as residing in Northern California” both factors weighed clearly towards transfer.).

²¹³ Gugliuzza, *supra* note 3, at 345–46.

²¹⁴ See *Extraordinary Writ: Part 2*, *supra* note 187, at fig.1 (using the 1/1/2021–9/30/2021 figures); *Federal Circuit Mandamus Docket 2021*, *supra* note 1 (adding the docketed mandamus petitions from 10/1/2021–12/31/2021).

Judge Albright's prodigious patent docket, combined with the Federal Circuit's frequent mandamus of him, attracted substantial media attention.²¹⁵ Senators Thom Tillis and Patrick Leahy sent a joint letter to Chief Justice Roberts, highlighting their concerns about Judge Albright and asking the Chief Justice to recommend legislative solutions for Congress.²¹⁶ In turn, Chief Justice Roberts directed the Judicial Conference to review the situation and recommend legislative reforms.²¹⁷

But before any recommendations were made to Congress, then-Chief Judge Garcia of the WDTX intervened. On July 25, 2022, he ordered that any patent cases filed in the Waco Division be randomly assigned among all the district judges in the WDTX.²¹⁸ For context, the WDTX covers a geographic area of 93,000 square miles.²¹⁹ If a plaintiff resided in Waco, for example, and sued in the Waco Division, but the case was reassigned to Judge Cardone in El Paso, she would have to drive nearly ten hours—over 600 miles—to attend in-court proceedings.²²⁰ In effect, this order gutted Judge Albright's patent docket.²²¹

Yet this order appears to have been temporary. On November 15, 2022, then-Chief Judge Garcia issued an amended order, which assigned “[a]ll cases and proceedings in the Waco Division” to Judge Albright and was made “in lieu of *prior similar orders* of the Court on assignment of the business of the Court.”²²² But patent litigation filings in Waco since the order's effective date, December 1, 2022, have remained low.²²³ While the industry's lackluster response signals some doubt as to whether the order did indeed rescind the patent lottery system, this good-for-four-months-only order shows why a standing order cannot provide a permanent solution: it may be rescinded or amended unilaterally at any time.

²¹⁵ See, e.g., Miriam Rozen, *How Waco Became a Patent Litigation Hotspot*, FIN. TIMES (June 15, 2022), <https://perma.cc/W58W-AY6P>; Dani Kass, *Judge Albright Only Got More Popular in 2021*, LAW360 (May 18, 2022), <https://perma.cc/BWK9-J3RV>; Gene Quinn, *The Federal Circuit's Obsession with Judge Albright Is Becoming Increasingly Bizarre*, IPWATCHDOG (Sept. 29, 2021), <https://perma.cc/XBC8-KCMW>; Logan Murr, *Albright Rebuked Again by CAFC After Letting Second Transfer Motion Linger*, IPWATCHDOG (Mar. 12, 2021), <https://perma.cc/UM8C-294A>.

²¹⁶ See *Senator IP Letter*, *supra* note 44.

²¹⁷ See JOHN G. ROBERTS, JR., U.S. SUP. CT., 2021 YEAR-END REPORT ON THE FEDERAL JUDICIARY 5 (2021), <https://perma.cc/8KK6-LX98>.

²¹⁸ See *Garcia July Order*, *supra* note 41.

²¹⁹ *Offices of the Western District of Texas*, U.S. DEP'T OF JUST., <https://perma.cc/DTU8-Y2EZ>.

²²⁰ Driving Directions from Waco, TX, to El Paso, TX, GOOGLE MAPS, <https://perma.cc/82CS-8P9G>.

²²¹ See, e.g., Christopher Yasiejko & Samantha Handler, *West Texas Sees Patent Filings Plummet After Albright Dethroned*, BLOOMBERG LAW (Sept. 6, 2022), <https://perma.cc/ZLH6-BKHT>.

²²² See *Garcia Amended Order*, *supra* note 42 (emphasis added).

²²³ See *Ring*, *supra* note 43.

So what is the best way to resolve the venue-transfer feud between Judge Albright and the Federal Circuit? New legislation. But Congress has avoided updating the *Gilbert* factors that govern current venue-transfer motions for over seventy years. Congress could also address the Waco division “judge shopping” issue directly. Yet several divisions across the country implicate these concerns.²²⁴ And any legislation that would purport to govern the district court’s case-assignment protocol would offend the Constitution’s separation of powers by encroaching on the judiciary’s prerogative to control its own court system.

Or the Supreme Court could intervene as it did to curb the EDTX in *TC Heartland*. But mandamus orders do not appear to change the filing behavior of patent litigators.²²⁵ Besides, Judge Albright has life tenure, so a Supreme Court mandamus order would likely accomplish little. And since mandamus orders continued well into 2022,²²⁶ neither Judge Albright nor the Federal Circuit appear ready to adopt the other’s § 1404(a) interpretation.

This Comment proposes another solution—Fifth Circuit intervention through a clarifying line of mandamus precedent that considers party convenience given the practical realities of modern litigation. As stated above, the Fifth Circuit took the first step towards doing so in November 2022.²²⁷ In *In re Planned Parenthood*, the court refused to grant mandamus for a denied venue-transfer motion in a qui tam action.²²⁸ Judge Jennifer Elrod, writing for the unanimous panel, reiterated two legal principles relevant here: (1) the *Gilbert* factors are “not necessarily exhaustive or exclusive”; and (2) “[t]he location of evidence bears much more strongly on the transfer analysis when, as in *Volkswagen*, the evidence is physical in nature.”²²⁹ In effect, Judge Elrod’s opinion signaled that a district court judge analyzing a § 1404(a) motion is not bound to apply a formalistic reading of the *Gilbert* factors. Rather, they may consider other factors that bear on the convenience of the parties.²³⁰ And less

²²⁴ See generally, Alex Botoman, *Divisional Judge-Shopping*, 49 COLUM. HUM. RTS. L. REV. 297 (2018).

²²⁵ See *supra* Section I.E; Figure 2 and accompanying text.

²²⁶ See, e.g., *In re Apple, Inc.*, No. 2022-128, 2022 WL 1196768 at *5 (Fed. Cir. Apr. 22, 2022).

²²⁷ See Dennis Crouch, *Fifth Circuit Seems to Raise the Bar on Venue Transfer Mandamus*, PATENTLY-O (NOV. 29, 2022), <https://perma.cc/G3WE-97NV>.

²²⁸ 52 F.4th 625, 628 (5th Cir. 2022).

²²⁹ *Id.* at 630 (emphasis added) (quoting *In re Volkswagen of Am. Inc.*, 545 F.3d 304, 315 (5th Cir. 2008)).

²³⁰ 52 F.4th at 631 (finding that the lower court’s consideration of flight, lodging, and food costs between the relevant venues was not “based on incorrect legal principles”).

weight may be afforded to the sources-of-proof factor when the relevant evidence is, unlike in *In re Volkswagen of America*, electronically available.²³¹

How the Federal Circuit will respond to this development remains to be seen. But before suggesting how the Fifth Circuit can build on this precedent to address other shortcomings with the *Gilbert* factors, we first review some relevant technological advances in recent litigation to understand how such technology can have a drastic effect on party convenience.

II. The Digital Age: Technology and Party Convenience

The digital age has transformed modern litigation. On the positive side, technological improvements allowed the Judicial Conference to respond rapidly to the COVID-19 pandemic by “approv[ing] the use of video and teleconferencing” for “civil proceedings during the COVID-19 national emergency.”²³² Yet eDiscovery costs have also spiraled out of control.²³³ In any event, technology has become entrenched in modern litigation.

Even in today’s high-tech world, however, the *Gilbert* factors—established in 1947—continue to govern today’s venue-transfer motions. Two of these longstanding factors, the relative ease of access to sources of proof and the relative convenience for and cost of attendance of witnesses, often prove dispositive on mandamus petitions.²³⁴ This Part considers each factor given modern litigation practice.

A. Online Hearings and Witness Convenience

The Federal Circuit has stressed that “the relative convenience for and cost of attendance of witnesses between the two forums is ‘probably the single most important factor in transfer analysis.’”²³⁵ And viewed through the lens of the 1950s—limited transportation options and no remote working capabilities, internet, or cell phones—attending a trial across the

²³¹ *Id.* at 630.

²³² See *Judiciary Authorizes Video/Audio Access During COVID-19 Pandemic*, U.S. COURTS (Mar. 31, 2020), <https://perma.cc/H49Q-3CEK>.

²³³ See, e.g., Karel Mazanec, *Capping E-Discovery Costs: A Hybrid Solution to E-Discovery Abuse*, 56 WM. & MARY L. REV. 631, 632 (2014); Bradley Kuxhausen, *An E-Discovery Model Order: Saving the Golden Goose of Patent Litigation One Golden Egg at a Time*, 4 CYBARIS INTELL. PROP. L. REV. 250, 253 (2013); John Prudhomme, *Discovery in the Paperless World: How Speed and Ease of Technology Has Slowed and Complicated the Process*, 14 SMU SCI. & TECH. L. REV. 159, 166 (2010).

²³⁴ See, e.g., *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1379 (Fed. Cir. 2021).

²³⁵ *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1318 (Fed. Cir. 2021) (citing *In re Genentech, Inc.*, 566 F.3d 1338, 1343 (Fed. Cir. 2009)).

country was daunting. This factor is less compelling today. First, the percentage of cases that reach trial has plummeted since the 1950s and continues to trend downwards.²³⁶ Second, the increased availability of remote court proceedings changes the witness-convenience factor calculus.²³⁷

Trials are exceedingly rare today. While trial rates in the early twentieth century were about 20%,²³⁸ today’s patent litigation results in trial rates between 3–5%.²³⁹ In 2021, this rate was even lower—between 1–2%.²⁴⁰ With trial rates a mere fraction of what they were when the *Gilbert* factors were developed, using a hypothetical trial test as a proxy for expected party inconvenience no longer makes sense.

For example, if we multiply the patent-litigation trial rate by the number of mandamus petitions docketed annually by the Federal Circuit, about *one case per year* would be expected to proceed to trial.²⁴¹ But under the current venue-transfer framework, the burden of a hypothetical trial on its hypothetical witnesses—the most important factor—presumes that a trial is likely. Yet that is not the case. Indeed, this presumption could prove false for every docketed mandamus petition at the Federal Circuit for a given year.

Second, the recent approval of online court proceedings could change the witness-convenience factor entirely. As the Fifth Circuit stated in *In re Volkswagen AG*, “[a]dditional distance means additional travel time; additional travel time increases the probability for meal and lodging

²³⁶ See Robert P. Burns, *What Will We Lose if the Trial Vanishes?*, 37 OHIO N.U. L. REV. 575, 577 (2011) (describing historical trial rates); see also Jeffrey Q. Smith & Grant R. MacQueen, *Going, Going, But Not Quite Gone: Trials Continue to Decline in Federal and State Courts. Does It Matter?*, JUDICATURE, Winter 2017, at 29 (reviewing decreases in trial rates since the 1990s onward).

²³⁷ See Christopher J. Vidrine, *The Zoom Paradox: Schrodinger’s Witness*, 82 LA. L. REV. 311, 328–35 (2021).

²³⁸ Burns, *supra* note 236, at 577.

²³⁹ See Wild, *supra* note 150 (indicating 3–5% of patent cases went to trial in 2016); Branka Vuleta, *25 Patent Litigation Statistics - High-Profile Feuds About Intellectual Property*, LEGALJOBS (Aug. 6, 2021), <https://perma.cc/NL32-N7MN> (“95% to 97% of patent infringement lawsuits are settled out of court.”).

²⁴⁰ Bruce Berman, *Patent Suits Drop 33% From 2013; 2021 Damages Awards Are More Than \$1 Billion Less than 2012*, IP CLOSEUP at figs.1 & 18 (June 1, 2022), <https://perma.cc/QF6U-HBXX> (combining the results of Figure 18, which shows sixty-five patent trials were held in 2021, with Figure 1, which shows that there were between 3,576 and 4,002 patent cases filed per year from 2018–2020, results in a trial rate between 1.6% and 1.8%).

²⁴¹ This number was calculated by multiplying an average of twenty-seven mandamus petitions filed in the Federal Circuit from 2008 to 2021, see *Extraordinary Writ: Part 2*, *supra* note 187, at fig.1 (averaging the total mandamus petitions), by rates of 3% and 5%, which results in an expected trial occurrence between .8 to 1.3 trials per year resulting from mandamus petition docketed each year at the Federal Circuit.

expenses,” which increases how long “fact witnesses must be away from their regular employment.”²⁴² If a federal judge offers remote court proceedings, then witnesses need not be inconvenienced at all by a trial and could provide necessary depositions or testimony from their homes or offices. Simply put, remote hearings lower the cost of attendance for witnesses—whether financial or temporal.

The COVID-19 pandemic forced many courts and judges to outfit their courtrooms for remote proceedings. One example is Judge Albright, who remodeled his courtroom over six weeks to render it “among the most technologically advanced in the country.”²⁴³ In an interview with Magna Legal Services, he remarked that online trials were “[i]n 99% of the way” the same as in-person trials, and that “Zoom is here forever for hearings.”²⁴⁴ Incorporating the availability of remote proceedings into the venue-transfer framework is simple. If the original district court offers online proceedings while the defendant’s requested venue does not, then the witness-convenience factor should militate against transfer.²⁴⁵

B. *eDiscovery and the Sources-of-Proof Factor*

Society so relies on the internet to send and receive information that 99% of it is now stored electronically.²⁴⁶ Indeed, “almost every business, large and small, saves their data electronically.”²⁴⁷ Digital business records have ushered in eDiscovery. Although Congress partially accounted for this through the 2006 amendments to the Federal Rules of Civil

²⁴² *In re Volkswagen AG*, 371 F.3d 201, 205 (5th Cir. 2004).

²⁴³ *One-on-One with Federal Judge Alan Albright*, MAGNA LEGAL SERVS., <https://perma.cc/JZB9-XMW3>.

²⁴⁴ *Id.*

²⁴⁵ A 2021 law review article, *The Zoom Paradox: Schrodinger’s Witness*, discussed the videoconferencing issue in greater depth and offered other insights into how the availability of zoom trials can continue in a post-pandemic world. See Vidrine, *supra* note 237, at 328–35. First, “courts unanimously agree that a court may compel a witness to attend video deposition that is outside of the court’s district but within 100 miles of the witness’s local area.” *Id.* at 334. Second, although Rule 43(a) of the Federal Rules of Civil Procedure has currently not been interpreted to allow a judge to compel testimony via videoconferencing, allowing judges to do so could alleviate any compulsory process concerns for unwilling witnesses. *Id.* at 334–35.

²⁴⁶ See Kuxhausen, *supra* note 233, at 260 (citing Douglas R. Nemeec, Hope S. Yates, Devin Kothari & Gayle Denman, *Discovery Issues in Patent Litigation: Making the Most of the Federal Rules 36* (PATENT L. CTR., PRAC. L. INST. 2009)).

²⁴⁷ *Id.*

Procedure,²⁴⁸ several areas of law—including the sources-of-proof factor—remain outdated.²⁴⁹

The relative ease of access to sources of proof supports venue transfer when most discoverable files are physically located in the requested venue.²⁵⁰ In patent infringement litigation, the defendant is expected to have “the bulk of the relevant evidence.”²⁵¹ And so this factor almost always favors transfer: most defendants petitioning the Federal Circuit for mandamus will have files in its home venue. The sources-of-proof factor, then, operates as a default thumb on the scale for defendants. A survey of recent Federal Circuit mandamus grants establishes why this matters: when both sources of proof and witness convenience favor transfer, mandamus is usually granted.²⁵²

Despite the ubiquity of eDiscovery in patent litigation, the Federal Circuit has narrowly construed the *Gilbert* factors—*found nowhere in the text of § 1404(a)*—at the expense of the *actual* text and purpose of the statute: to grant venue-transfer motions “[f]or the convenience of parties and witnesses” and “in the interest of justice.”²⁵³ Take the Federal Circuit’s *In re Juniper Networks, Inc.*²⁵⁴ decision, where the court found that the sources-of-proof factor favored transfer when Juniper provided a declaration stating that it “stores the majority of its documentary evidence

²⁴⁸ See, e.g., FED. R. CIV. P. 26(a)(1)(A)(ii) (“*In General*. Except as exempted by Rule 26(a)(1)(B) or as otherwise stipulated or ordered by the court, a party must, without awaiting a discovery request, provide to the other parties: a copy—or a description by category and location—of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.” (emphasis added)).

²⁴⁹ But see Vidrine, *supra* note 237, at 327 (suggesting that certain situations, such as “where a court’s decision hinges on its ability to view a physical premises or physical evidence that could not be easily transported to a court” could merit affording weight to this factor).

²⁵⁰ See, e.g., *In re Microsoft Corp.*, 630 F.3d 1361, 1362–63, 1365 (Fed. Cir. 2011) (per curiam) (granting mandamus since all of Microsoft’s witnesses and evidence were located in the requested venue); *In re TOA Techs., Inc.*, 543 F. App’x 1006, 1009–10 (Fed. Cir. 2013) (granting mandamus because some physical sources of proof were in the requested forum and there was evidence “that at least seven witnesses . . . [were] within 100 miles of the [requested forum]”); *In re Samsung Elecs. Co.*, 2 F.4th 1371, 1379, 1381 (Fed. Cir. 2021) (granting mandamus, relying heavily on the fact that the “petitioners submitted undisputed affidavits identifying over a dozen third-party individuals with relevant and material information as residing in [the requested forum]”).

²⁵¹ *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009).

²⁵² Most (if not all) of the mandamus petitions granted by the Federal Circuit in 2021 and 2022 against Judge Albright found that the witness-convenience and sources-of-proof factors favored transfer. See, e.g., *In re Apple, Inc.*, No. 2022-128, 2022 WL 1196768, at *3–4 (Fed. Cir. Apr. 22, 2022); *In re Samsung*, 2 F.4th at 1379, 1381; *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1319–23 (Fed. Cir. 2021).

²⁵³ 28 U.S.C. § 1404(a).

²⁵⁴ 14 F.4th 1313 (2021).

relevant to the Accused Products . . . at its Sunnyvale headquarters.”²⁵⁵ It is unclear what files Juniper possessed that could not be accessed remotely during eDiscovery or transferred electronically before trial without inconvenience. Such a rigid application of this common-law factor does not serve the convenience of the parties. But this is old hat. The District Court of Delaware offered a similar sentiment in 2011 in *XPRT Ventures, LLC v. eBay, Inc.*:²⁵⁶

With respect to discovery, documents generally are stored, transferred and reviewed electronically. It would be surprising to the court to find that sophisticated litigants . . . still maintain their business records in hard copy, thus requiring either travel to [the requested venue] for review of the documents or the copying and transporting of documents. With respect to witnesses, generally the parties agree to take depositions where the witnesses are located (or the court can so order). Moreover, for those cases that get to trial, only a handful of witnesses testify live, and only a very small proportion of those documents produced during discovery are used as trial exhibits. Given these realities, this factor is outdated, irrelevant, and should be given little weight, if any, except for those rare exceptions where truly regional defendants are litigating.²⁵⁷

In short, the current rigid and myopic application of two of the *Gilbert* factors—the sources of proof and convenience of the witnesses—is objectionable for at least three reasons. First, modern trial rates should reduce the weight given to the hypothetical inconvenience imposed on hypothetical witnesses under the hypothetical trial test. The rare exception—a patent infringement case proceeding to trial—should not be the default presumption. Second, the convenience of the witnesses is best served by remote hearings and trials. Thus, if the district court exercising jurisdiction offers remote hearings and trials but the requested district does not, the district court should find that this factor weighs against transfer. Third, the Federal Circuit overemphasizes the words lurking inside the *Gilbert* factors, such as “relative ease of access,” while ignoring the text of § 1404(a). The sources-of-proof factor made sense when relevant documents were stored as hard copies. But Congress used the words “convenience of the parties” in § 1404(a), a phrase broad enough to allow judges to infuse the effects of technological changes into the transfer-motion calculus.

III. A Path Forward: A New Venue-Transfer Framework

Since venue transfer out of the WDTX is within the Fifth Circuit’s geographical jurisdiction, it should be the final arbiter of the Federal Circuit–Judge Albright disagreement. And the Fifth Circuit’s recent

²⁵⁵ *Id.* at 1321.

²⁵⁶ No. 10-595, 2011 WL 2270402 (D. Del. June 8, 2011).

²⁵⁷ *Id.* at *3.

decision in *In re Planned Parenthood* provides a well-reasoned foundation to return the venue-transfer analysis to what Congress had intended—a practical application of the *Gilbert* factors focused on the convenience of the parties. After discussing suggested changes to the application of the *Gilbert* factors, this Part concludes by applying them to *In re Apple, Inc.*—a representative venue-transfer case in which the Federal Circuit granted mandamus.²⁵⁸

A modern framework that would best facilitate the convenience of the parties requires three major changes. First, the rules below would apply to the witness-convenience factor when online proceedings are an option for the parties. If the original district court offers online proceedings while the defendant’s requested venue does not, then the witness-convenience factor should militate against transfer. If both courts offer online proceedings, however, then this factor would be neutral. If only the requested forum offers online proceedings, then this factor weighs heavily towards transfer. If neither court has an online hearing option, then *In re Volkswagen of America* applies.

Second, for the sources-of-proof factor, the court could go further than *In re Planned Parenthood* and establish a rebuttable presumption that eDiscovery makes the physical location of documents irrelevant, rendering the factor neutral when all discoverable documents are electronic. A defendant could rebut this presumption, however, by showing that there is relevant physical evidence unable to be shared electronically in the requested forum. The volume and significance of this evidence would then dictate whether this factor shifts from neutral to favoring transfer.

Third, for the administrative difficulties flowing from court congestion, the Federal Circuit has considered and rejected several metrics.²⁵⁹ This section explores other metrics that could be useful for quantifying the actual inconvenience created by court congestion.

Since the Federal Circuit in thirteen out of eighteen mandamus grants ordered transfer from the WDTX to California (eleven to the NDCA, and two to the Central District of California (“CDCA”)),²⁶⁰ metrics for these three courts from 2019–2021 are compared below.²⁶¹ Three

²⁵⁸ *In re Apple, Inc.*, 979 F.3d 1332, 1347 (Fed. Cir. 2020).

²⁵⁹ See, e.g., *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194, at *5 (Fed. Cir. Aug. 2, 2021) (finding that “a court’s general ability to set a fast-paced schedule is not particularly relevant to’ the court congestion factor” (quoting *In re Apple*, 979 F.3d at 1344)). And even when this factor weighs slightly in favor of transfer, “slight imbalance alone” is not “enough to tip the scales in favor of denying transfer” because this factor often calls for speculation. *Id.* (citing *In re Apple*, 979 F.3d at 1344 n.5).

²⁶⁰ See *Federal Circuit Mandamus Docket 2021*, *supra* note 1.

²⁶¹ See Docket Navigator Analytics, DOCKET NAVIGATOR [hereinafter *WDTX–NDCA–CDCA Case Outcomes Comparison*], <https://perma.cc/8N9S-FCV2> (last visited Jan. 9, 2022) (searching cases for

metrics are examined: (1) cumulative settlement rate and average time to case dismissal; (2) median time to claim construction; and (3) median time to trial.

Beginning with the first, Table 3 below compares the rates of settlement or voluntary dismissal in the three districts.

Table 3: Patent Litigation Metrics for the WDTX, NDCA, and CDCA (2019–2021)²⁶²			
Litigation Metric	WDTX	NDCA	CDCA
Total Cases Decided	1170	721	811
Total Cases Settled or Voluntarily Dismissed	1135	497	692
Average Settlement or Voluntary Dismissal Rate	97%	69%	85%
Average Time to Termination (days)	238	609	339

Some quick conclusions: parties have settled or voluntarily dismissed cases at much higher rates in the WDTX (97%) than in either the CDCA (85%) or the NDCA (69%); and the average time it has taken for a case to be settled or voluntarily dismissed in the WDTX was 1.5 times higher in the CDCA and 2.5 times higher in the NDCA.²⁶³

There are several possible explanations for this disparity. For one, it could stem from the WDTX's case management procedures, which include early exchange of invalidity and infringement contentions between parties; limited discovery; and a default, expedited claim construction hearing date.²⁶⁴ Since the result of claim construction is often

each district court, viewing the case outcome analytics for each court, and recording the 2019–21 results; then navigating to the Court Milestones tab from the main page and viewing the Omnibus Report (2008 to Present), filtering and recording information for each court on three tabs: Time to Termination; Time to Trial; and Time to Markman).

²⁶² *Id.* Voluntary dismissal is defined as case withdrawal without judicial intervention, but no official consent decree filed with the court. See DOCKET NAVIGATOR, CASE OUTCOMES: THE COMPLICATED, BUT NECESSARY, PROCESS OF DETERMINING WINS AND LOSSES IN FEDERAL PATENT CASES 7 (2021), <https://perma.cc/8N9S-FCV2>.

²⁶³ One thing to note: Each court's operational responses to the COVID-19 pandemic, which began in January 2020, may have skewed some of this data. But since Judge Albright only recently took the bench, *PN1523—Alan D. Albright—The Judiciary*, *supra* note 25, this data was the best available when this Comment was written. Future investigation should re-examine these metrics when new data become available.

²⁶⁴ Standing Order Governing Proceedings (OGP) 4.2—Patent Cases, U.S. 3, 7, 12 (W.D. Tex. Sept. 16, 2022) [hereinafter *Albright Patent Rules*], <https://perma.cc/4D5H-3FLV> (signed by Judge Albright).

dispositive on a case’s merits,²⁶⁵ earlier claim construction hearings could result in earlier case termination. But a more cynical explanation is that Waco’s patent docket hosts a larger portion of patent trolls that file borderline frivolous patent infringement cases to extract settlements from large corporations. Some evidence supports this.²⁶⁶ Whether the high settlement or voluntary dismissal rate means that large corporations benefit from having the Waco Division is unclear. On the one hand, faster case termination in Waco suggests that a case filed there would be resolved faster and cheaper than if that same case was filed in the CDCA or NDCA. By contrast, one could argue that plaintiffs—especially NPEs—bring these cases only because they believe settlements can be more readily extracted through litigation in the Waco Division. Judge Albright’s case management procedures guarantee that a given plaintiff will have a chance to be heard soon after filing.²⁶⁷ The CDCA and NDCA, by contrast, have longer docket times and allow for broader discovery, which provides corporations with a simple path to victory: a war of attrition. Both explanations are plausible and the subject merits further investigation.

Another set of metrics that helps to quantify the court-congestion factor are the median time to claim construction and time to trial, shown below in Table 4.

Table 4: Median Time to Claim Construction & Time to Trial Metrics for the WDTX, NDCA, and CDCA (2019-2021) ²⁶⁸								
Court	Time to Claim Construction (days)				Time to Trial (days)			
	2019	2020	2021	Average	2019	2020	2021	Average
WDTX	673	371	404	483	N/A	636	854	745
NDCA	898	766	1019	894	609	N/A	1095	852
CDCA	500	591	535	542	936	1421	1587	1315

From 2019 through 2021, the WDTX boasted faster median times to both claim construction hearings and trial than the NDCA and CDCA.²⁶⁹ The COVID-19 pandemic, however, likely accounts for some of the trial-time increases since 2019. At any rate, this data set is well suited to reveal

²⁶⁵ See Vincent P. Kovalick, *Markman Hearings and Their Critical Role in U.S. Patent Litigation*, LEXOLOGY (Oct. 31, 2009), <https://perma.cc/S79M-9LKQ>.

²⁶⁶ See, e.g., Anderson & Gugliuzza, *supra* note 27, at 422.

²⁶⁷ *Albright Patent Rules*, *supra* note 264, at 1-2.

²⁶⁸ See WDTX-NDCA-CDCA Case Outcomes Comparison, *supra* note 261.

²⁶⁹ *Id.*

how a judge could meaningfully resolve the court-congestion factor. Compare a transfer between the WDTX and NDCA. The large difference between each court's median time to claim construction favors retention. But the small difference between time to trial would only slightly favor retention. Because the frequency of claim construction hearings far exceeds patent infringement trials, more weight should be given to the former. And so the court-congestion factor, applied to a request seeking transfer from the WDTX to the NDCA, would weigh against transfer.

Yet some may still find that median times to specific case events are too indirectly related to party inconvenience to serve as an appropriate proxy. True enough. But perhaps quantifying an expected litigation cost by district could make party inconvenience more tangible. Provided below in Table 5 is a portion of a table from the AIPLA's Economic Survey for 2021²⁷⁰ that provides the average cost of patent litigation by procedural posture for patent infringement suits where the plaintiff is seeking over \$25 million in damages.²⁷¹

Table 5: AIPLA's 2021 Economic Survey – Cumulative Cost by Litigation Activity When Over \$25 Million is at Risk²⁷²	
Litigation Activities Included in Cost	Cumulative Cost in 2020 (USD)
Initial Case Management (ICM)	\$250,000.00
ICM + discovery, motions, and claim construction (DMC)	\$2,125,000.00
ICM +DMC + pre and post-trial, and appeal if applicable	\$4,000,000.00

Combining the data from Tables 3, 4, and 5, we can then derive an equation for the expected cost of patent litigation by district. Beginning with the information in Tables 3 and 4, each court has a far faster median time to case termination than median time to claim construction hearing. So we can assume that more cases are dismissed before claim construction

²⁷⁰ See AM INTELL. PROP. L. ASS'N & ARI ASS'N RSCH., INC., AIPLA 2021 REPORT OF THE ECONOMIC SURVEY 60 (2021) [hereinafter *AIPLA Economic Report*].

²⁷¹ In 2021, the average patent damages award exceeded \$61 million. See Berman, *supra* note 240, at fig.18. Thus, the AIPLA category of patent litigation with over \$25 million at risk was chosen as representative.

²⁷² *AIPLA Economic Report*, *supra* note 270, at 60.

than after.²⁷³ To approximate the procedural distribution of cases, this Comment conservatively assumes that 50% of cases settle early after initial case management; 30% are dismissed before the claim construction hearing; and 20% are dismissed after the claim construction hearing. Further, the historical 3% trial rate is used as the expected rate of cases that will continue to trial.²⁷⁴ Thus, the expected cost to defend against a patent infringement suit by district with over \$25 million at risk is summarized below in Table 6.

Stage of Litigation (Cost)	WDTX (Expected % of Cases)	NDCA (Expected % of Cases)	CDCA (Expected % of Cases)
(1) Voluntarily Dismissed After ICM (\$250,000)	49%	35%	43%
(2) Dismissed Before Claim Construction (\$1.5M) ²⁷⁶	29%	21%	26%
(3) Dismissed After Claim Construction or Disposed of on Summary Judgment (\$2.125M)	19%	41%	28%
(4) Full-Trial (\$4M)	3%	3%	3%
Expected Cost:	\$1,100,000	\$1,400,000	\$1,200,000

In sum, a defendant would expect to expend anywhere from \$100,000 to \$300,000 less per suit in the WDTX instead of the NDCA or CDCA for the average patent infringement case.²⁷⁷ Decreasing the cost of patent

²⁷³ The author assumes that if more cases were dismissed after claim construction, then the median time to either settlement or voluntary dismissal would exceed the median time to claim construction.

²⁷⁴ See *supra* Section II.A.

²⁷⁵ The expected cases come from multiplying the settlement or voluntary dismissal rates by the distribution described above. The distribution is then multiplied based on the cost at each stage of litigation and summed to determine the expected cost, which is rounded to the nearest \$100,000.

²⁷⁶ Note this value is not present in the AIPLA survey. The author made this approximation based on his understanding of patent litigation generally.

²⁷⁷ The cost disparity estimated in Table 6 is likely conservative because it does not include the added cost of briefing the venue-transfer motion and any later motions associated with it (i.e., motion for reconsideration, petition for mandamus, motion for rehearing en banc, and so on.), nor does it

litigation is in the “interest of justice” because it enables more litigants to access the Article III court system for fair and prompt adjudications. And reducing the time and cost a party must divert from productive business endeavors to litigate also decreases party inconvenience. In short, court congestion creates measurable effects on party convenience that implicate the text of § 1404(a). Thus, courts should treat this factor more seriously.²⁷⁸

Using *In re Apple Inc.* as a representative mandamus grant from the WDTX, Table 7 below compares the factor-by-factor findings of the Federal Circuit’s majority opinion with the likely outcome of each factor under a framework that applies the changes proposed by this section. Applying this framework results in four neutral factors, two favoring retention, one slightly favoring retention, and one favoring transfer. Thus, the petitioners in *In re Apple Inc.* would likely be denied its requested mandamus relief.

Venue-Transfer Factor	Federal Circuit Majority	Proposed Framework
(1) Relative Ease of Access to Sources of Proof	Favored transfer because of sources of proof in the NDCA.	Presumed neutral unless Apple shows that it has relevant non-electronic documents.
(2) Availability of Compulsory Process	Neutral.	Neutral.
(3) Cost of Attendance for Willing Witnesses	Favored transfer because a California trial was convenient for party witnesses and only slightly inconvenient for third-party witnesses.	Favors retention because fully remote hearings are more convenient to all parties than in-person hearings and were only

include the cost of any subsequent administrative filings (ex: Motion for Admission Pro Hac Vice) and status conferences necessary to begin the case in the new forum.

²⁷⁸ Creating a standard, reliable way to quantify this factor would put parties on notice of what arguments to make, and better tie this factor to § 1404(a). Further research is recommended.

²⁷⁹ See *In re Apple Inc.*, 979 F.3d 1332, 1339–45 (Fed. Cir. 2020).

		an option at the WDTX.
(4) All Other Practical Problems	Favored transfer slightly because of the judicial economy gained by allowing the NDCA to resolve related patent cases together, and historically the NDCA was faster to trial.	Slightly favors retention because the judicial economy is offset by the large disparity in time to dismissal, time to claim construction, and time to trial.
(5) Administrative Difficulties from Court Congestion	Neutral because the court's ability to set an early trial date was not that relevant to the court-congestion factor.	Favors retention because cases are dismissed faster in the WDTX, and cases are terminated in the WDTX more economically.
(6) Local Interest in Deciding Case	Favored transfer because of Apple's strong presence in the NDCA.	Favors transfer.
(7) Familiarity with Law	Neutral.	Neutral.
(8) Conflicts of Law	Neutral.	Neutral.
Outcome:	<u>Mandamus was Granted.</u>	<u>Mandamus Should Be Denied.</u>

Conclusion

Previous attempts to resolve the venue-transfer problem in patent infringement suits have been unsuccessful. Neither Congress nor the Supreme Court appear poised to provide a meaningful resolution soon. And standing orders are too easily retracted to provide litigants with the certainty they need to efficiently conduct business.

But Judge Elrod's *In re Planned Parenthood* decision is a great first step towards constraining the Federal Circuit and ending the mandamus mania. Depending on the Federal Circuit's response, the Fifth Circuit should continue to build from this decision and modernize the application of the *Gilbert* factors.

While this approach has several benefits, the most notable is that it remains faithful to the text, history, and traditional use of § 1404(a). Indeed, by evaluating the *actual* inconvenience imposed on the parties, rather than the *theoretical* inconvenience imposed by an unlikely trial or by seamlessly accessing electronic documents across states, the Fifth Circuit can dispense the justice that Congress created § 1404(a) to provide.