

No. 2021-118

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

IN RE TRACFONE WIRELESS, INC.,

Petitioner

On Petition for Writ of Mandamus to the United States District Court
for the Western District of Texas in Case No. 6:20-cv-00303-ADA,
District Judge Alan D. Albright

MOTION TO REISSUE ORDER AS PRECEDENTIAL

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May 7, 2021

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 32.1(e), 27(a)(3), and 47.4, counsel for Movants certifies that:

1. The full names of the Movants I represent are: Patent Law Professors (See Attachment A).

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) I represent is: N/A.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the petitioners I represent are: None.

4. The names of all law firms and the partners or associates that appeared for the Movants I represent or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are: None.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal: *In re Vulcan Indus. Holdings, LLC*, No. 2021-141 (Fed. Cir. filed Apr. 14, 2021).

6. Information required under Fed. R. App. P. 26.1(b) and 26.1(c): None

May 7, 2021

/s/ Phillip R. Malone

Phillip R. Malone

Attorney for Movants

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ATTACHMENT A TO CERTIFICATE OF INTEREST

Professor Jonas Anderson

American University Washington College of Law

Professor Jeremy W. Bock

Tulane University Law School

Professor Michael A. Carrier

Rutgers Law School

Professor Michael W. Carroll

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Professor Bernard Chao

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Professor Michael J. Meurer
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Professor Joseph Scott Miller
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Professor Shawn P. Miller
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Professor Joshua D. Sarnoff
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MOTION TO REISSUE ORDER AS PRECEDENTIAL

Pursuant to Circuit Rule 32.1(e), Movants respectfully request that the Court reissue as precedential its March 8, 2021 nonprecedential mandamus order addressing the failure of a district court in the Western District of Texas to rule on a long-standing § 1404(a) transfer motion.¹ Movants are professors of patent law at universities throughout the United States.² Movants have no personal interest in the outcome of this case, but a professional interest in seeing the law develop in a clear and consistent manner.³ This motion is filed within the 60-day time period specified in Rule 32.1(e).

The only pending case of which Movants are aware that would be directly and immediately affected by converting this case into a precedential ruling is *In re Vulcan Indus. Holdings, LLC*, No. 2021-141 (Fed. Cir. filed Apr. 14 2021), but a precedential ruling also will likely affect many cases in the future.

¹ Pursuant to Circuit Rule 27(a)(2), counsel for Movants has discussed this motion with the parties and has been advised that TracFone consents to the Motion and Precis Group opposes it. Both parties indicated that they do not intend to file a response.

² A full list of Movants can be found in the Appendix.

³ Movants thank Stanford Law School Juelsgaard Intellectual Property and Innovation Clinic Certified Law Students Samuel Henick and Grace Ann Brew for their substantial assistance in drafting this motion.

I. A Precedential Order is Needed to Prevent Further Procedural Abuses

The Federal Circuit’s mandamus order in *TracFone* remedied the district court’s significant procedural errors in this case. In *TracFone*, Judge Albright had failed to rule on the petitioner’s motion to transfer for eight months. *See* No. 2021-118, 2021 WL 865353, at *1 (Fed. Cir. Mar. 8, 2021). While the transfer motion was still pending, the court proceeded to schedule discovery, a Markman hearing, and the start of trial. *Id.* This Court granted mandamus and ordered the district court to stay all proceedings and rule on the motion to transfer. *Id.* at *2. In doing so, the Court reiterated several prior orders addressing the same procedural error: “District courts must give promptly filed transfer motions ‘top priority’ before resolving the substantive issues in the case.” *Id.* at *2 (quoting *In re Horseshoe Entm’t*, 337 F.3d 429, 433 (5th Cir. 2003)); *see In re SK hynix Inc.*, 835 F. App’x 600, 601 (Fed. Cir. 2021); *In re Google Inc.*, No. 2015-138, 2015 WL 5294800, at *1 (Fed. Cir. Jul. 16, 2015). But each of those decisions, like this one, were designated nonprecedential.

The March 8, 2021 *TracFone* order is not the first time this Court has admonished the same district court for procedural abuses. This Court has issued numerous non-precedential orders compelling the same district court to abide by procedures that are critical to the fair operation of the judicial system. *E.g.*, *SK hynix*, 835 F. App’x at 600-01 (castigating the court’s “egregious delay and blatant disregard for precedent” in adjudicating a motion to transfer); *In re Adobe Inc.*, 823

F. App'x 929, 931 (Fed. Cir. 2020) (noting the court “ran afoul of governing precedent” and “committed several errors” in denying motion to transfer); *In re Intel Corp.*, 841 F. App'x 192, 193 (Fed. Cir. 2020) (finding the court’s re-transferal of trial “fundamentally inconsistent with the governing statutes”). But each of those decisions too was designated nonprecedential.

In spite of repeated mandamus orders by this Court to the district court below, that court has impermissibly denied transfer motions and even refused to rule on transfer motions altogether.⁴ This Court should reissue its *TracFone* order as precedential to definitively establish the law regarding improper delays in ruling on transfer motions and requests for stay pending the resolution of such motions. Absent clear precedential guidance, courts may continue to disregard this court’s nonprecedential instructions and make procedural errors that force parties to settle or to litigate in an inappropriate, inconvenient, and costly forum. Such an outcome

⁴ See *TracFone*, 2021 WL 865353, at *2 (failure to stay proceedings and rule promptly on transfer motion); *SK hynix Inc.*, 835 F. App'x at 601 (same); *In re TracFone Wireless, Inc.*, No. 2021-136, 2021 WL 1546036, at *3-4 (Fed. Cir. Apr. 20, 2021) (clear error in transfer analysis); *In re Apple*, 979 F.3d 1332, 1336-37 (Fed. Cir. 2020) (same); *Adobe Inc.*, 823 F. App'x at 931 (same); *Intel Corp.*, 841 F. App'x at 193 (district court erred in its analysis of its authority to transfer); see also *In re Nitro Fluids L.L.C.*, 978 F.3d 1308, 1312-13 (Fed. Cir. 2020) (district court misinterpreted first-to-file rule).

would undermine the judiciary’s ability to ensure uniformity, efficiency, and fairness in the law.⁵

II. The Federal Circuit’s Internal Operating Procedures Warrant Reissuing the Order as Precedential

The Federal Circuit’s Internal Operating Procedures provide three separate reasons to reissue *TracFone* as precedential. A precedential order would (a) clarify existing law, (b) remedy an issue of substantial public interest, and (c) rectify a procedural error.

A. A Precedential Order Would Clarify Existing Law

First, the order should be made precedential because it “clarifie[s]” an “existing rule of law.” Fed. Cir. IOP #10, ¶ 4(d). This Court has repeatedly chastised lower courts for “egregious delay[s]” and “blatant disregard of precedent” in refusing to promptly rule on transfer motions. *SK hynix*, 835 F. App’x at 600-01 (mandamus order addressing decision by Judge Albright); *see also Google*, 2015 WL 5294800, at *1 (“[L]engthy delays have the ability to frustrate 28 U.S.C. § 1404(a)’s intent” by forcing defendants “to expend resources litigating substantive matters in an inconvenient venue while a motion to transfer lingers unnecessarily on the docket.”);

⁵ Although in *TracFone* this Court was applying Fifth Circuit law regarding transfers, the specific problem of venue and transfer in patent cases, which involves a specific statute and rules, *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514, 1516-17 (2017), will only ever arise before this Court, so there is a need for precedential guidance.

In re ADTRAN, Inc., 840 F. App'x 516, 517 (Fed. Cir. 2021) (denying mandamus petition but noting that the district court's "failure to promptly act . . . might tip the balance in favor of mandamus relief upon reapplication in the future," and that the Court "fully expect[s] . . . that the district court will give the stay motion and venue issues top priority"); *In re EMC Corp.*, 501 F. App'x 973, 975 (Fed. Cir. 2013) (stressing "the importance of addressing motions to transfer at the outset of litigation").

However, none of the Federal Circuit's mandamus orders regarding the failure to timely rule on transfer motions have been designated as precedential.⁶ Without definitive and binding guidance on the matter, district courts, including the district court in this case, may continue to misapply the proper procedural and substantive rules for motions to transfer under § 1404(a).

Clear, binding precedent is needed to clarify the law for lower courts and litigants. *See* Fed. Cir. IOP #10, ¶ 2 ("The purpose of a precedential disposition is to inform the bar and interested persons other than the parties.")⁷

⁶ The Federal Circuit's precedential decision in *Apple* concerned the related but analytically distinct issue of whether the denial of a motion to transfer was improper. 979 F.3d at 1336-37; *see also TracFone*, No. 2021-136 (non-precedential order granting TracFone's "second petition for a writ of mandamus . . . concerning its motion to transfer" in the same case).

⁷ Judge Albright's March 23, 2021 Standing Order Regarding Motion for Inter-District Transfer, *see In re Apple Inc.*, 844 F. App'x 364, at *1-2 (Fed. Cir. Apr. 9, 2021) (denying a mandamus petition because of the new standing order), does not

B. A Precedential Order Would Resolve an Issue of Substantial Public Interest Which the Court Has Not Sufficiently Treated

Second, the order should be made precedential because it resolves a “legal issue of substantial public interest, which the court has not sufficiently treated recently.” Fed. Cir. IOP #10, ¶ 4(g). The public maintains a strong interest in the efficient resolution of patent cases. After all, § 1404(a)’s purpose is “to prevent the waste ‘of time, energy, and money’ and ‘to protect litigants, witnesses and the public against unnecessary inconvenience and expense.’” *Van Dusen v. Barrack*, 376 U.S. 612, 616 (1964). In fact, the district court’s repeated and prolonged delays in ruling on transfer motions and refusals to grant stays while such motions are pending have already raised considerable public interest and concern.⁸

This district court’s repeated disregard of the law in addressing transfer motions demonstrates that the relevant legal issues have not been sufficiently resolved. Over

obviate the need for a decisive, binding resolution of these issues. A precedential order would provide important guidance to the bar and other parties and would ensure that this district court and others avoid similar procedural errors going forward.

⁸ See J. Jonas Anderson & Paul R. Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 DUKE L.J. (forthcoming 2021), <http://dx.doi.org/10.2139/ssrn.3668514>; Josh Landau, *Trouble in Plaintiff’s Paradise?*, PATENT PROGRESS (Oct. 30, 2020), <https://www.patentprogress.org/2020/10/30/trouble-in-plaintiffs-paradise> (85 percent of patent suits in Western District of Texas are by non-practicing entities); Britain Eakin, *New West Texas Judge Wants His Patent Suits Fast and Clean*, LAW360 (Oct. 25, 2019), <https://www.law360.com/articles/1213867/new-west-texas-judge-wants-his-patent-suits-fast-and-clean>; Tommy Witherspoon, *Waco Becoming Hotbed for Intellectual Property Cases with New Federal Judge*, WACO

20 percent of all patent cases filed in the United States in 2020 were filed in the Western District of Texas. Almost all of these patent cases filed in the district are filed in Waco and heard by Judge Albright.⁹ The lack of binding resolution regarding these issues risks a particularly profound impact on the significant portion of patent defendants sued in the Western District of Texas. They face serious potential for undue delay, inconvenience, and expense that may well determine the outcome of their cases. *See Anderson & Gugliuzza, supra* note 8, at 34-48, 61. A precedential order is thus needed to protect litigants and the public against further procedural errors.

C. A Precedential Order Would Correct Serious Procedural Errors and Errors in the Conduct of the Judicial Process

Third, the order should be made precedential because it corrects “[p]rocedural errors, or errors in the conduct of the judicial process.” Fed. Cir. IOP #10, ¶ 4(1). As noted above, the order addressed recurring procedural errors and errors in the conduct of the judicial process on the part of the district court. The mandamus petition provides the sole vehicle through which litigants may seek to correct the district court’s errors; therefore, a precedential mandamus order is essential for this Court to clearly and conclusively rectify those errors in a manner that is binding on

TRIB.-HERALD (Jan. 18, 2020), https://www.wacotrib.com/news/local/waco-becoming-hotbed-for-intellectual-property-cases-with-new-federal-judge/article_0bcd75b0-07c5-5e70-b371-b20e059a3717.html.

⁹ Anderson & Gugliuzza, *supra* note 8, at 28, 32-34.

courts in future cases. *See Apple*, 979 F.3d at 1336-37 (“[T]he possibility of an appeal in the transferee forum following a final judgment . . . is not an adequate alternative . . .”).

For the foregoing reasons, Movants respectfully request that the Court reissue its March 8, 2021 nonprecedential order as a precedential order.

May 7, 2021

/s/ Phillip R. Malone

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APPENDIX

Movant law professors are listed below. Affiliation is provided for identification purposes only. All signatories are participating in their individual capacity, not on behalf of their institutions.

Professor Jonas Anderson

American University Washington College of Law

Professor Jeremy W. Bock

Tulane University Law School

Professor Michael A. Carrier

Rutgers Law School

Professor Michael W. Carroll

American University Washington College of Law

Professor Bernard Chao

University of Denver Sturm College of Law

Professor Ralph D. Clifford

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University of Georgia School of Law

Professor Shawn P. Miller
University of San Diego School of Law

Professor Joshua D. Sarnoff
DePaul University College of Law

Professor Christopher B. Seaman
Washington and Lee University School of Law

Professor Shine Tu
West Virginia University College of Law

Professor Christopher M. Turoski
University of Minnesota Law School

CERTIFICATE OF SERVICE

I hereby certify that on May 7, 2021, I caused the foregoing **MOTION TO REISSUE ORDER AS PRECEDENTIAL** to be served by electronic means via the Court's CM/ECF system on all counsel registered to receive electronic notices.

/s/ Phillip R. Malone

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