

## Federal Circuit Issues Another Writ of Mandamus Transferring a Patent Case Out of the Eastern District of Texas

12-07-2009

By [Swope, Richard S.](#); [Martinelli, Richard F.](#)

On December 2, 2009, the Federal Circuit issued a writ of mandamus granting transfer of a patent infringement case out of the Eastern District of Texas. *In re Hoffmann-La Roche, Inc., et al.*, Misc. Dkt. No. 911 (Fed. Cir. December 2, 2009). This case follows the Federal Circuit's recent decisions, *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008) and *In re Genentech, Inc.*, Misc. Dkt. No. 901 (Fed. Cir. May 22, 2009), and provides further analysis of the circumstances that warrant transfer of venue. Importantly, the Federal Circuit rejected the district court's determination that the Eastern District of Texas was as convenient as any another district when parties, witnesses and documents were spread throughout the country and there was no one "centralized" venue.

### Background of the Appeal

In *Hoffmann*, Novartis Vaccines and Diagnostics, Inc. sued Hoffmann-La Roche, Inc., Roche Laboratories, Inc., Roche Colorado Corp. and Trimeris, Inc. in the Eastern District of Texas, alleging that Fuzeon, a commercial HIV inhibitor drug, infringed a Novartis patent. Fuzeon was developed initially by scientists at Duke University in North Carolina and tested by Trimeris in Morrisville, North Carolina. The active ingredient in Fuzeon is manufactured by Roche in Colorado, further processed by Roche in Switzerland or Michigan, and packaged by Roche in New Jersey. Novartis, the patent holder, is headquartered in California. Witnesses relevant to the action were similarly spread throughout various locations.

Judge Folsom denied defendants' transfer motion, stating, in part, that this was a "decentralized" case and the transfer would simply shift the inconvenience from the witnesses closer to North Carolina to those who were closer to Texas.

### Federal Circuit Analysis

The Federal Circuit held that Judge Folsom abused his discretion by denying the motion to transfer and ordered the district court to transfer the case to the Central District of North Carolina.

The Federal Circuit held that there was a "stark contrast in relevance, convenience and fairness between the two venues" as several facts showed that the Eastern District of North Carolina is a more convenient jurisdiction:

- three nonparty witnesses subject to the court's subpoena power resided in the district;
- the accused drug was developed and tested in the district;
- relevant documents and sources of proof remained in the district;
- the district was less congested than the Eastern District of Texas, so the case may be resolved more quickly; and
- there is a strong local interest in the case because the litigation calls into question the work and reputation of several individuals residing in or near the district.

The Federal Circuit also noted that there was no connection between the case and the Eastern District of Texas. In particular, the court remarked that *Novartis'* assertion that the 75,000 documents it moved to Texas in anticipation of the litigation was a "fiction which appears to have been created to manipulate the propriety of the venue."

[Intellectual Property](#)