

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

360HEROS, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 17-1302-LPS-CJB
)	
GOPRO, INC.,)	
)	
Defendant.)	

MEMORANDUM ORDER

Presently pending before the Court in this patent infringement case is Defendant GoPro Inc.’s (“Defendant” or “GoPro”) motion seeking a transfer of venue to the United States District Court for the Northern District of California (“Northern District of California”), pursuant to 28 U.S.C. § 1404(a) (the “Motion”). (D.I. 28) Plaintiff 360Heros, Inc. (“Plaintiff” or “360Heros”) opposes the Motion. For the reasons set forth below, Defendant’s Motion is DENIED.

I. BACKGROUND

A. The Parties

Plaintiff is a Delaware corporation with its principal place of business in Olean, New York. (D.I. 23 at ¶ 2) Plaintiff currently has no offices or employees anywhere outside of western New York. (D.I. 34 at ¶¶ 4-7) Michael Kintner is the President of 360Heros and the inventor of the patent-in-suit, United States Patent No. 9,152,019 (the “019 patent”). (*Id.* at ¶ 1) Mr. Kintner is a resident of Olean, New York. (*Id.* at ¶ 3)

Defendant is a Delaware corporation with its principal place of business in San Mateo, California, which is within the Northern District of California. (D.I. 23 at ¶ 3) The company has about 1,250 employees; most (approximately 850) work in the United States. (D.I. 31 at ¶ 2) Defendant’s U.S.-based employees are “primarily” located in its two U.S.-based offices: its

headquarters in San Mateo and another office located in San Diego, California. (*Id.*; D.I. 35, ex. 5 at 3) It has no offices or facilities located in Delaware. (*Id.* at ¶ 3)

B. The Asserted Patent and the Accused Products

In this case, Plaintiff asserts direct infringement and willful infringement of multiple claims of its '019 patent. (D.I. 23) The patent is entitled “360 Degree Camera Mount and Related Photographic and Video System[.]” (*Id.* at ¶ 13) GoPro is accused of infringing the patent-in-suit by making, using, offering to sell and selling three virtual reality camera rigs—the Abyss, the Odyssey, and the Omni (the “accused products”). (*Id.* at ¶¶ 21-42)

The Omni and Odyssey rigs were primarily designed and developed in GoPro’s San Mateo offices. (D.I. 31 at ¶ 6) GoPro’s research and development, product development, sales and finance operations are located in San Mateo. (*Id.*) Technical documents and financial and sales documents relating to these two products would be located there too. (*Id.*)

The Abyss rig was designed by a third party, Subspace Pictures, located in Switzerland. (*Id.* at ¶ 8) Financial and sales information related to this product “can be accessed” from GoPro’s San Mateo offices. (*Id.*) Certain French GoPro employees are knowledgeable about the marketing, financial and sales information relating to the Abyss rig and the use of that rig. (*Id.*)

C. Procedural History

1. The California Action

On April 13, 2016, GoPro filed a lawsuit against 360Heros in the Northern District of California for trademark infringement, copyright infringement, unfair competition, and for a declaratory judgment of non-infringement of the '019 patent (the “California Action”). (D.I. 32, ex. A) On August 22, 2016, 360Heros filed a counterclaim for direct and indirect infringement of the '019 patent, (*id.*, ex. B); in later-served infringement contentions, 360Heros identified the

Abyss and Odyssey camera rigs as infringing products, *see GoPro, Inc. v. 360Heros, Inc.*, Case No. 16-cv-01944-SI, 2017 WL 1278756, at *1 (N.D. Cal. Apr. 6, 2017). In April 2017, 360Heros moved to amend its infringement contentions to include the Omni camera rig, but the District Court (the “California Court”) denied this motion, finding that 360Heros had not been diligent in seeking leave to amend its contentions. (D.I. 33 at 2); *see also GoPro, Inc.*, 2017 WL 1278756, at *2.

The patent issues were litigated in the California Action through fact discovery, which ended on November 3, 2017. (D.I. 30 at 4) During that time period, the California Court held a *Markman* hearing and issued a claim construction order, (D.I. 32, ex. F), and it addressed a number of discovery-related motions, (D.I. 30 at 4).

During the summer of 2017, GoPro learned facts that caused it to believe that 360Heros lacked standing to assert the '019 patent: that Mr. Kintner did not assign the patent to 360Heros until October 2016, after the filing of the complaint and counterclaim in the California Action. (D.I. 30 at 5; D.I. 33 at 5) On September 8, 2017, GoPro’s counsel sent a letter to 360Heros’ counsel in the California Action, notifying 360Heros of this issue. (D.I. 32 at ¶ 17)

On September 15, 2017, GoPro moved for summary judgment that, *inter alia*, 360Heros lacked standing to assert the '019 patent, or, alternatively, that its accused camera rigs did not infringe the patent (the “motion for summary judgment”). (D.I. 32, ex. C at 1) On November 3, 2017, the California Court heard argument on, *inter alia*, the standing and patent infringement issues. (*Id.*) And on November 14, 2017, the California Court granted the motion for summary judgment on lack-of-standing grounds, therefore dismissing without prejudice GoPro’s declaratory judgment claim for non-infringement and 360Heros’ counterclaim of infringement (the “November 14 decision”). (*Id.* at 13) The California Court did not reach the parties’

arguments on patent infringement in this November 14 decision, noting that the record before it on that score was not fully developed. (*Id.* at 1, 12) However, the Court did advise the parties in its decision that “based on the information currently in the record, it appears to the Court that GoPro’s rigs do not infringe the patent-in-suit.” (*Id.* at 12)

The California Court later granted GoPro’s summary judgment motion on copyright infringement grounds. (D.I. 32, ex. J) The remaining non-patent claims in the California Action were settled on May 17, 2018 with the assistance of a United States Magistrate Judge in the Northern District of California. (D.I. 54 at 1; D.I. 55 at 1)

2. The Filing of This Action

In May 2017—after the California Court denied 360Heros’s motion in the California Action seeking to amend its infringement contentions to include the Omni product—360Heros began speaking with its outside counsel in this case, SpencePC, about the possibility of filing a lawsuit against GoPro in Delaware regarding the Omni product. (D.I. 35 at ¶ 3)¹ 360Heros formally retained the firm in August 2017 to file a complaint against GoPro in this District. (*Id.*)

On September 13, 2017, five days after GoPro alerted it to its possible lack of standing in the California Action, 360Heros filed its original Complaint against GoPro in this Court. (D.I. 1) That Complaint identified only the Omni rig as an infringing product. (D.I. 1 at ¶¶ 14-19) On October 10, 2017, GoPro filed a motion seeking dismissal of this Complaint, or, in the alternative, that the case be transferred to the Northern District of California. (D.I. 8; D.I. 9)

On November 22, 2017, after the California Court granted GoPro’s motion for summary judgment, 360Heros moved to amend its Complaint in this case to include the Abyss and Odyssey camera rigs as infringing products. (D.I. 22) GoPro did not oppose this motion to

¹ SpencePC did not represent 360Heros in the California Action. (D.I. 35 at ¶ 2)

amend, reserving its right to move to transfer the instant case to the Northern District of California. (*Id.* at 1)² Thereafter, 360Heros filed the operative First Amended Complaint, in which it accuses all three GoPro products of infringement. (D.I. 23)

GoPro filed the instant Motion on December 15, 2017. (D.I. 28) The parties completed briefing on the Motion on January 19, 2018. (D.I. 37) The parties submitted notices of supplemental authority relevant to the Motion on May 17, 2018 and May 18, 2018, respectively, (D.I. 54; D.I. 55), and recently submitted other correspondence related to the Motion, (D.I. 59; D.I. 60).

II. DISCUSSION

A. Legal Standard

Section 1404(a) of Title 28 provides the statutory basis for a transfer inquiry. It provides that “[f]or the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought or to any district or division to which all parties have consented.” 28 U.S.C. § 1404(a).

The party seeking a transfer has the burden “to establish that a balancing of proper interests weigh[s] in favor of the transfer[.]” *Shutte v. Armco Steel Corp.*, 431 F.2d 22, 25 (3d Cir. 1970) (citation omitted); *see also Jumara v. State Farm Ins. Co.*, 55 F.3d 873, 879 (3d Cir. 1995).³ That burden is a heavy one: “unless the balance of convenience of the parties is strongly in favor of [the] defendant, the plaintiff’s choice of forum should prevail.” *Shutte*, 431 F.2d at

² GoPro also withdrew its earlier-filed motion to dismiss or transfer. (D.I. 26)

³ In analyzing a motion to transfer venue in a patent case, it is the law of the regional circuit that applies. *Micron Tech., Inc. v. Rambus Inc.*, 645 F.3d 1311, 1331 (Fed. Cir. 2011).

25 (internal quotation marks and citation omitted); *see also* *CNH Am. LLC v. Kinzenbaw*, C.A. No. 08-945(GMS), 2009 WL 3737653, at *2 (D. Del. Nov. 9, 2009).

The United States Court of Appeals for the Third Circuit has observed that courts must analyze “all relevant factors” to determine whether “on balance the litigation would more conveniently proceed and the interests of justice be better served by transfer to a different forum.” *Jumara*, 55 F.3d at 879 (internal quotation marks and citation omitted). Nevertheless, it has identified a set of private interest and public interest factors that are appropriate to account for in this analysis (the “*Jumara* factors”). The private interest factors to consider include:

[1] [The] plaintiff’s forum preference as manifested in the original choice, [2] the defendant’s preference, [3] whether the claim arose elsewhere, [4] the convenience of the parties as indicated by their relative physical and financial condition, [5] the convenience of the witnesses—but only to the extent that the witnesses may actually be unavailable for trial in one of the fora, . . . and [6] the location of books and records (similarly limited to the extent that the files could not be produced in the alternative forum)[.]

Id. (citations omitted). The public interest factors to consider include:

[1] [T]he enforceability of the judgment, [2] practical considerations that could make the trial easy, expeditious, or inexpensive, [3] the relative administrative difficulty in the two fora resulting from court congestion, [4] the local interest in deciding local controversies at home, [5] the public policies of the fora, . . . and [6] the familiarity of the trial judge with the applicable state law in diversity cases[.]

Id. at 879-80 (citations omitted).

B. Appropriateness of Transferee Venue

The first step in the transfer analysis is to determine whether this action could have been brought in the proposed transferee venue. *Mallinckrodt Inc. v. E-Z-Em Inc.*, 570 F. Supp. 2d 349, 356 (D. Del. 2009). Plaintiff could have properly brought this infringement action in the Northern District of California, as it is not disputed that Defendant has its principal place of

business there, and alleged infringement occurred there. (D.I. 30 at 8); *see also* 28 U.S.C. § 1400(b).

C. Application of the *Jumara* Factors

The Court will proceed to analyze the *Jumara* factors and their impact on whether transfer should be granted.

1. Private Interest Factors

a. Plaintiff's choice of forum

When analyzing the first *Jumara* private interest factor—the “plaintiff’s forum preference as manifested in the original choice”—the court should not consider simply the fact of that choice, but the reasons behind the choice. *Pragmatus AV, LLC v. Yahoo! Inc.*, Civil Action No. 11-902-LPS-CJB, 2012 WL 4889438, at *4 (D. Del. Oct. 15, 2012) (citation omitted), *adopted by* 2013 WL 174499 (D. Del. Jan. 16, 2013); *Affymetrix, Inc. v. Synteni, Inc.*, 28 F. Supp. 2d 192, 200 (D. Del. 1998). “If those reasons are rational and legitimate[,] then they will weigh against transfer, as they are likely to support a determination that the instant case is properly venued in this jurisdiction.” *Pragmatus*, 2012 WL 4889438, at *4 (internal quotation marks, brackets and citations omitted); *see also Intellectual Ventures I LLC v. Altera Corp.*, 842 F. Supp. 2d 744, 753-54 (D. Del. 2012). However, if the plaintiff’s choice is made for an improper reason—such as where it is arbitrary, irrational, or selected to impede the efficient and convenient progress of a case—this factor will likely weigh against transfer. *Pragmatus*, 2012 WL 4889438, at *4 (citation omitted).

Plaintiff states that it brought the case in the District of Delaware for a number of good reasons.⁴ And each reason it provides has been recognized by our Court as being legitimate and understandable:

- Plaintiff notes that both parties are incorporated in Delaware. (D.I. 33 at 9) Certainly a plaintiff's own state of incorporation is a legitimate venue in which it might pursue litigation, given that it is the locus of that party's corporate business activities. See *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, Civil Action No. 15-1168-LPS-CJB, 2016 WL 8677211, at *3 (D. Del. Sept. 23, 2016); *FastVDO LLC v. Paramount Pictures Corp.*, 947 F. Supp. 2d 460, 462 (D. Del. 2013). It is also rational and legitimate for a plaintiff to choose to sue a defendant in that defendant's state of incorporation—a district where a plaintiff can have certainty that there will be personal jurisdiction over the defendant. See, e.g., *TSMC Tech., Inc. v. Zond, LLC*, Civil Action No. 14-721-LPS-CJB, 2014 WL 7251188, at *15 (D. Del. Dec. 19, 2014) (citing cases).
- Plaintiff also rightly notes that the rationale for suing here became even stronger after the decision of the Supreme Court of the United States in *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514 (2017). (D.I. 33 at 9-10) In *TC Heartland*, the Supreme Court interpreted the patent venue statute, 28 U.S.C. § 1400(b), to allow that a corporate defendant could be sued for patent infringement only in a jurisdiction: (1) where it resides (i.e., where it is incorporated) or (2) where it committed an act of infringement and has a regular and established place of business. 137 S. Ct. at 1517. In light of *TC Heartland* and the record here, then, if Plaintiff did not wish to sue Defendant in the California federal districts where Defendant's two offices are located—a decision that many plaintiffs make, uncontroversially, in patent cases—then this District was Plaintiff's only other choice.
- Lastly (and related to the point above), Plaintiff explains that it chose to sue in the closest possible available venue to western New York, which is the location of its principal place of business. (D.I. 33 at 10) That certainly makes a lot of practical and logistical sense. See *Pragmatus*, 2012 WL 4889438, at *6 (citation omitted).

Despite the above, however, Defendant argues that this factor should actually weigh in *its*

⁴ The parties devote some space to discussing whether Delaware is Plaintiff's "home turf" under the law of this District. (D.I. 30 at 15; D.I. 33 at 10-11) For reasons that the Court has previously explained, an analysis of that "home turf" issue is unnecessary here, as it has no independent significance in the *Jumara* transfer analysis. See, e.g., *Tessera, Inc. v. Broadcom Corp.*, Civil Action No. 16-379-LPS[-]CJB, Civil Action No. 16-380-LPS-CJB, 2017 WL 1065865, at *4 n.6 (D. Del. Mar. 21, 2017); *Pragmatus*, 2012 WL 4889438, at *5.

favor. This is because Defendant asserts that Plaintiff's decision to file here is an example of "forum shopping." (D.I. 30 at 13) To that end, the Court has previously noted that where a plaintiff's act of filing litigation in this District "bears the hallmarks of classic forum shopping[.]" then this first *Jumara* private interest factor could indeed "weigh strongly in favor of transfer[.]" *Ross v. Inst. Longevity Assets LLC*, Civil Action No. 12-102-LPS-CJB, 2013 WL 5299171, at *9 (D. Del. Sept. 20, 2013). Forum shopping, as the term is used in this context, describes "a situation in which a party seeks to litigate in one district court, because it is 'shopping' for a favorable ruling and has indication that such a ruling would not be forthcoming in an alternative venue." *TSMC Tech. Inc.*, 2014 WL 7251188, at *10. This type of judge- or court-shopping is to be "discouraged" in the federal court system. *Micron Tech. v. Rambus Inc.*, 645 F.3d 1311, 1332 (Fed. Cir. 2011).

Defendant's best argument to demonstrate that such forum shopping occurred here relates to the issue of patent infringement. As noted above, in ruling on the motion for summary judgment in the California Action, the California Court did not make a final ruling as to whether GoPro's Abyss and Odyssey products infringe the patent-in-suit. Instead, the Court dismissed the patent-related claims in the case on lack-of-standing grounds. But in its November 14 decision, the California Court did note that as to the infringement issue, "based on the information currently in the record, it appears to the [California] Court that GoPro's [Abyss and Odyssey] rigs do not infringe the patent-in-suit." (D.I. 32, ex. C at 12) After this decision, 360Heros did not subsequently file an affirmative infringement case as to the Abyss and Odyssey products in the Northern District of California. Instead, eight days later, on November 22, 2017, it sought to add such allegations to an already pending Complaint in this District against GoPro. (D.I. 22)

At first blush (and without any additional context) this timeline looks bad for Plaintiff. Although the California Court had not made a final decision on the matter, it had certainly expressed skepticism about 360Heros' assertion that the Abyss and Odyssey products infringe the patent-in-suit. And right after it did so, 360Heros immediately brought those same patent infringement allegations in a different court (where, presumably, it was hoping for a different result). That sounds a lot like forum shopping.

However, the Court is hesitant to assume bad faith on the part of such a plaintiff if there are other reasonable explanations for its actions. And here, when it comes to Plaintiff's decision to bring the claims regarding the Abyss and Odyssey products in this Court, there are such explanations. That is, there are reasons to believe that Plaintiff's decision was motivated by something other than a naked attempt to avoid an unfavorable ruling from the transferee court.

First, it is important that, at the time of the California Court's November 14 decision, the instant case in this District already existed. Plaintiff filed that case (alleging infringement of the patent-in-suit by the Omni product, which was not then at issue in the California Action) back in September 2017. So by the time of the November 14 decision, if Plaintiff wished to seek redress for infringement as to the Abyss and Odyssey products, it makes sense that it would simply have sought to append those claims to an already existing suit in this Court (its preferred forum) that involved the same patent.

Second, and relatedly, Plaintiff had already expressed its desire to litigate the patent-in-suit in this Court *prior to* the California Court's November 14 decision. It filed this action (as to the Omni product) on September 13, 2017, over two months before the California Court expressed doubt about the merits of Plaintiff's infringement claims as to the Abyss and Odyssey products. As Plaintiff argues, "[a]s a matter of logic, [it] cannot have brought a lawsuit in

Delaware in September to evade dicta in a summary judgment decision that would issue two months later.” (D.I. 33 at 13)⁵

Third, there is at least some reason to believe that the decision on patent infringement regarding the Abyss and Odyssey products was not a *fait accompli* in the California Court. Plaintiff notes that the California Court “adopted almost all of 360Heros’ proposed constructions” in its claim construction order. (*Id.*) And it asserts that “full expert discovery” had not yet been completed by the time of the November 14 decision, (*id.* at 13-14), such that the California Court itself expressed that it did not have a fully “developed record” on the infringement question, (D.I. 32, ex. C at 12). Thus, it is not as if in bringing the claims as to the Abyss and Odyssey products in this Court, Plaintiff was seeking to avoid what was an absolutely certain defeat in the transferee court.

Therefore, because (1) there are a number of clear, legitimate reasons why Plaintiff chose this forum for suit, and (2) the Court cannot firmly conclude that Plaintiff has engaged in forum shopping here, then (3) this factor weighs against transfer.

b. Defendant’s forum preference

As for the second private interest factor—the defendant’s forum preference—Defendant prefers to litigate in the Northern District of California. In analyzing this factor, the Court has

⁵ Defendant has not demonstrated to the Court that there was anything legally defective about Plaintiff’s decision to file infringement claims regarding the Omni product in this Court in September 2017. And, for what it is worth, the California Court does not appear to have viewed the filing of the instant suit (regarding the Omni product) to have been a wrongful end-run around its prior decisions. When advised about the status of that suit at a November 2017 hearing in the California Action, the California Court stated to GoPro’s counsel that “Delaware is a wonderful, capable venue. So I don’t think you should shy away from [litigating that case in] Delaware in any respect.” (D.I. 35, ex. 3 at 16)

similarly “tended to examine whether the defendant can articulate rational, legitimate reasons to support that preference.” *Pragmatus*, 2012 WL 4889438, at *6 (citation omitted).

Defendant notes that it has a number of legitimate reasons for seeking to transfer this action to the Northern District of California. These include that: (1) the forum is the location of its headquarters; (2) the majority of the relevant documents are located in the forum; and (3) most of its party witnesses are located in the forum. (D.I. 30 at 15-16) As this Court has often held, the physical proximity of the proposed transferee district to a defendant’s principal place of business (and relatedly, to witnesses and evidence potentially at issue in the case) is a clear, legitimate basis for seeking transfer. *See, e.g., Nalco Co. v. AP Tech Grp. Inc.*, C.A. No. 13-1063-LPS, 2014 WL 3909114, at *1 (D. Del. Aug. 8, 2014); *Genetic Techs. Ltd. v. Natera, Inc.*, C.A. No. 12-1737-LPS, 2014 WL 1466471, at *1 (D. Del. Apr. 15, 2014). That logic applies here, and thus, the second private interest *Jumara* factor weighs in favor of transfer.

c. Whether the claim arose elsewhere

The third private interest *Jumara* factor asks “whether the claim arose elsewhere.” As a matter of law, a claim regarding patent infringement arises “wherever someone has committed acts of infringement, to wit, ‘makes, uses, offers to sell, or sells any patented invention’ without authority.” *McRo, Inc. v. Activision Blizzard, Inc.*, Civil Action No. 12-1508-LPS-CJB, 2013 WL 6571618, at *5 (D. Del. Dec. 13, 2013) (certain internal quotation marks and citations omitted). Nevertheless, as to this factor, this Court typically focuses on the location of the production, design, and manufacture of the accused instrumentalities. *Id.* (citing cases).

Here, GoPro is accused of making, using, offering to sell and selling the accused products in an infringing manner. It is not clear from the record where the accused products are manufactured (i.e., “made”). Two of the three accused products—the Odyssey and Omni rigs—

were designed and developed in the Northern District of California (the Abyss rig was designed and developed in France)—so it may be that they could be said to have been “made” and/or “used” there. As for infringing “sales” or “offers for sale,” there is also not great clarity in the record. GoPro apparently sells its accused products nationally, (D.I. 33 at 17), though its own employees who are responsible for sales and finance operations work out of its headquarters in San Mateo, (D.I. 31 at ¶ 6).

The Court wishes it had a better record as to this factor. But it seems as if any alleged infringement would have had a greater connection to the Northern District of California than to any other district. For that reason, the Court concludes that this factor favors transfer. *See Contour IP Holding, LLC v. GoPro Inc.*, Civil Action No. 15-1108-LPS-CJB, 2017 WL 3189005, at *10 (D. Del. July 6, 2017) (concluding the same in a matter involving GoPro’s accused camera products, where the products were manufactured overseas, but where the evidence of record as to infringing conduct indicated that some significant amount of infringing making, using, selling or offers to sell the products occurred in the Northern District of California), *adopted by* 2017 WL 3225983 (D. Del. July 31, 2017).

d. Convenience of the parties as indicated by their relative physical and financial condition

In assessing the next private interest factor—“the convenience of the parties as indicated by their relative physical and financial condition”—this Court has traditionally examined a number of issues. These include: “(1) the parties’ physical location; (2) the associated logistical and operational costs to the parties’ employees in traveling to Delaware (as opposed to the proposed transferee district) for litigation purposes; and (3) the relative ability of each party to bear these costs in light of its size and financial wherewithal.” *Audatex N. Am., Inc. v. Mitchell*

Int'l, Inc., C.A. No. 12-cv-139 (GMS), 2013 WL 3293611, at *4 (D. Del. June 28, 2013) (internal quotation marks and citations omitted); *see also McKee v. PetSmart, Inc.*, C.A. No. 12-1117-SLR-MPT, 2013 WL 1163770, at *4 (D. Del. Mar. 20, 2013) (footnote omitted).

Defendant argues that because its principal place of business and a significant number of its employees are in the Northern District of California, that district would be a more convenient venue for it to engage in litigation. (D.I. 30 at 17) The Court agrees that it would.

However, three other considerations dilute the impact of Defendant's convenience argument. First, because Defendant has incorporated in Delaware (and, thus, has willingly submitted to suit here), it would be hard to conclude that Delaware is a decidedly *inconvenient* location for it to defend a lawsuit. *See, e.g., Contour*, 2017 WL 3189005, at *10; *see also Altera*, 842 F. Supp. 2d at 756. Second, while Defendant's employees would face some additional inconvenience were they obligated to travel to Delaware for pre-trial or trial proceedings, the amount of such travel is not likely to be large—particularly if this case does not result in a trial. *See, e.g., Contour*, 2017 WL 3189005, at *10; *Graphics Props. Holdings Inc. v. Asus Comput. Int'l, Inc.*, 964 F. Supp. 2d 320, 328-29 (D. Del. 2013) (“[A]s a practical matter, regardless of the trial venue, most of the discovery [in a patent case involving Defendant] will take place in California or other locations mutually agreed to by the parties. . . . The only events likely to occur in Delaware are the claim construction hearing, [certain] hearing[s] on motions[,] the pretrial conference and trial.”). And third, GoPro is a large corporation that can likely afford to easily absorb any increased travel costs, having taken in hundreds of millions in revenue in 2017. (D.I. 14, ex. 6 at 3)

As for Plaintiff, it is located in New York, and New York is obviously far closer to Delaware than it is to California. And so it is understandable why it would be logistically easier

for Plaintiff's employees, including Mr. Kintner, to travel to court in this District as compared to the transferee district.

Plaintiff also argues that its size and financial condition are a factor here. On that front, it is undisputed that Plaintiff is "the smaller of the two companies"; [REDACTED] [REDACTED] (D.I. 33 at 7 & n.32 (citing D.I. 13 at ¶ 11)) It thus asserts that the "thousands of dollars [it] would have to spend on airfare and hotels for each trip to San Francisco [REDACTED] [REDACTED]" and that it could "massively reduce these costs by litigating in Wilmington, to which [Mr.] Kintner and 360Heros' employees can make a round trip by car for less than \$100." (*Id.* at 15)

Yet it is hard to know how much this difference in travel cost will really affect Plaintiff. Its employees too should not have to travel to the transferee court frequently if the case is transferred. And the Court does not have a lot information about 360Heros' number of employees, its operations or its finances. At most, the Court is willing to infer that Plaintiff's size and financial condition would cause it some amount of strain, were it required to litigate in California (as compared to Delaware).

Everything considered, the above factors suggest that travel to the transferee district will burden 360Heros slightly more than travel to Delaware will burden GoPro. Thus, this factor weighs slightly against transfer. *Cf. AIP Acquisition LLC v. iBasis, Inc.*, Civil Action No. 12-616 GMS, 2012 WL 5199118, at *4 & n.4 (D. Del. Oct. 19, 2012) (finding this factor weighed against transfer where the defendant's earnings numbers "tower[ed] over [plaintiff's] patent spending and reported revenue"); *InvestPic, LLC v. SAS Inst., Inc.*, 871 F. Supp. 2d 317, 320 (D. Del. 2012) (finding this factor to weigh against transfer where the defendant had more than 12,000 employees worldwide and annual revenues of over \$2 billion, and where plaintiff

consisted of two people and there was “little reason to believe that its pockets are particularly deep”).

e. Convenience of the witnesses to the extent that they may actually be unavailable for trial in one of the fora

The “convenience of the witnesses” is the next factor, “but only to the extent that the witnesses may actually be unavailable for trial in one of the fora.” Of particular concern here are third-party fact witnesses who may not appear of their own volition in the venue-at-issue and who could not be compelled to appear by subpoena pursuant to Federal Rule of Civil Procedure 45. *ADE Corp. v. KLA-Tencor Corp.*, 138 F. Supp. 2d 565, 569 (D. Del. 2001); *Affymetrix, Inc.*, 28 F. Supp. 2d at 203.

Here, the parties agree that they are not aware of any relevant non-party witnesses. (D.I. 30 at 18; D.I. 33 at 17) Thus, this factor is neutral.

f. Location of books and records

Next, the Court considers “the location of books and records (similarly limited to the extent that the files could not be produced in the alternative forum).” “In patent infringement cases, the bulk of the relevant evidence usually comes from the accused infringer. Consequently, the place where the defendant’s documents are kept weighs in favor of transfer to that location.” *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009) (internal quotation marks and citation omitted). Yet this factor is commonly given little weight, as technological advances have “shortened the time it takes to transfer information, reduced the bulk or size of documents or things on which information is recorded . . . and have lowered the cost of moving that information from one place to another.” *Cypress Semiconductor Corp. v. Integrated Circuit Sys., Inc.*, No. 01-199-SLR, 2001 WL 1617186, at *3 (D. Del. Nov. 28, 2001) (internal quotation

marks and citation omitted); *see also Collectis S.A. v. Precision Biosciences, Inc.*, 858 F. Supp. 2d 376, 382 (D. Del. 2012) (same).

Here, the record indicates that any relevant GoPro records related to the Odyssey and Omni rigs are located at its headquarters in San Mateo. (D.I. 30 at 19; D.I. 31 at ¶ 6) While that discovery was already produced to 360Heros in the California Action as to the Odyssey rig (and the Abyss rig), document production will still need to occur in this case as to the Omni rig. (D.I. 33 at 17; D.I. 37 at 7 n.7) On the other hand, no one is claiming that there will be any difficulty producing such records in either forum at issue.

As such, this factor should only slightly favor transfer and should not have a significant impact in the overall calculus. *Contour IP*, 2017 WL 3189005, at *13; *McRo, Inc.*, 2013 WL 6571618, at *9-10.

2. Public Interest Factors

The Court below addresses the four public interest factors that were asserted by the parties to be anything other than neutral.

a. Practical considerations that could make the trial easy, expeditious, or inexpensive

The Court first considers the “practical considerations” factor.

Defendant argues that “[t]ransferring this case to the Northern District of California would ‘make the trial easy, expeditious, or inexpensive’ due to the significant time and effort that the California Court has invested in construing the claims and hearing summary judgment of noninfringement on the [patent-in-suit].” (D.I. 30 at 9) Indeed, the California Court appears to have obtained real familiarity with many of the facts at issue here, having: (1) previously presided over a case between the same parties, involving the same patent-in-suit and two of the three accused products, for a lengthy time period; (2) issued a claim construction order and

considered a motion for summary judgment on, *inter alia*, patent infringement issues; and (3) used the resources of the Court to help settle that litigation. This Court, in contrast, has not yet really engaged with any of the substantive liability or damages issues in the case. (D.I. 37 at 9 (Defendant noting that were the case to remain here, this Court would “still need to expend additional time and effort in learning about the case, the asserted patent, and the accused products just to acquire the knowledge and experience already possessed by the California Court.”)) These facts support transfer, as there would no doubt be real efficiency gains in keeping like subject matter in the hands of one court’s judges, not two. *Cf. Good Tech. Corp. v. MobileIron, Inc.*, Civil Action No. 14-1308-LPS-CJB, 2015 WL 1458091, at *8 (D. Del. Mar. 27, 2015) (finding this factor to favor transfer where the transferee court was currently presiding over a case involving related patents and many of the same accused products, where the transferee court had “invested significant time and effort in [the other] case, including presiding over a claim construction proceeding and issuing a *Markman* order on 16 claim terms, hearing argument on two motions for summary judgment . . . and issuing an order denying both motions, and conducting several discovery dispute hearings”).

The Court acknowledges that since the filing of the Motion, the California Action has been dismissed. And, as Plaintiff asserts, there may be some inefficiency involved in requiring the California Court to open a new case and set a new schedule (as opposed to a scenario where that Court were able to simply incorporate this action into an already-pending matter that was heading toward trial). (D.I. 33 at 20 (Plaintiff arguing that “there is no gain to judicial economy because even after transfer, this will still be a new patent case [in the Northern District of California] requiring a new schedule.”)) But nevertheless, for the reasons set out above, this factor surely favors transfer.

b. Administrative difficulties in getting the case to trial

The next factor is the “relative administrative difficulty in the two fora resulting from court congestion.” Defendant asserts that because of the decision in *TC Heartland*, there has been an increase in the number of patent cases filed in the District of Delaware since mid-2017. (D.I. 30 at 12) That is certainly true, and it is also the case that two of this District’s four full-time United States District Judge positions are currently vacant. *See Blackbird Tech. LLC v. Cloudflare, Inc.*, CIVIL ACTION No. 17-283, CIVIL ACTION NO. 17-284, 2017 WL 4543783, at *12 (D. Del. Oct. 11, 2017). But two District Judge nominees for this District are currently pending confirmation by the full United States Senate. (D.I. 33 at 19 & n.87) And unlike in many transfer cases, Defendant has provided no statistical information as to the recent state of the dockets in the two districts (this District and the Northern District of California).

On this record, the Court is not prepared to conclude that this factor is anything other than neutral.

c. Local interests in deciding local controversies at home

In patent litigation, the local interest factor is typically neutral, as patent issues tend to raise controversies that are more properly viewed as national, not local, in scope. *Graphics Props.*, 964 F. Supp. 2d at 330. Nevertheless, “if there are significant connections between a particular venue and the events that gave rise to a suit, this factor should be weighed in that venue’s favor.” *In re Hoffmann-La Roche, Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009); *see also Graphics Props.*, 964 F. Supp. 2d at 330-31.

Neither party has demonstrated that the case has any type of outsized resonance to the citizens of either district. It is *that* kind of showing that, pursuant to relevant precedent, would cause this factor to meaningfully favor one party or the other. *Cf. Andrews Int’l, Inc. v. Indian*

Harbor Ins. Co., C.A. No. 12-775-LPS, 2013 WL 5461876, at *4 (D. Del. Sept. 30, 2013) (holding that this factor “strongly” favored transfer where the case involved consideration of the enforceability under California law of certain insurance coverage provisions, which was “an issue of first impression” in that state, where the transferee district was located); *Downing v. Globe Direct LLC*, Civil Action No. 09-693 (JAP), 2010 WL 2560054, at *4 (D. Del. June 18, 2010) (finding that this factor favored transfer where the case “concern[ed] . . . the conduct of [a] Massachusetts government agency, and therefore the case [had] the potential to impact the public policy of as well as, to some extent, the taxpayers of Massachusetts[, the transferee forum]”); *see also Papst Licensing GmbH & Co. KG v. Lattice Semiconductor Corp.*, 126 F. Supp. 3d 430, 445-46 & n.12 (D. Del. 2015) (citing cases).

Here, both parties are incorporated in Delaware, which has an interest in seeing disputes among its corporate citizens adjudicated here. *McRo, Inc.*, 2013 WL 6571618, at *12. But GoPro is physically located in the transferee district, and so it could be said that some of its employees there will be impacted by this case’s outcome. *Id.* In light of these competing considerations, this factor is neutral. *Id.* at *13.

d. Public policies of the fora

As for the “public policies of the fora,” our Court has noted that “[t]he public policy of Delaware encourages the use by Delaware corporations of Delaware as a forum for resolution of business disputes.” *Altera*, 842 F. Supp. 2d at 760 (internal quotation marks and citation omitted). This factor disfavors transfer, although the Court gives it minimal weight. *Id.*

3. Conclusion Regarding Impact of *Jumara* Factors

In sum, Defendant’s forum preference, the “whether the claim arose elsewhere” factor and the “practical considerations” factor all squarely favor transfer. The “location of books and

records” factor slightly favors transfer. On the other hand, Plaintiff’s choice of forum weighs squarely against transfer. And the “convenience of parties” and “public policies” factors weigh slightly against transfer. The remainder of the *Jumara* factors are neutral.

It is true that more of these factors tilt in Defendant’s favor, with the “practical considerations” factor, for the reasons set out above, being the most significant. But the Court cannot conclude the balance “is *strongly in favor* of” transfer to the Northern District of California. *Shutte*, 431 F.2d at 25 (emphasis added).

That is because there are clear connections between this case and this District. Plaintiff brought the case in the only venue in which it could have been brought outside of those in Defendant’s state of residence: the venue that is its corporate home, the venue that is Defendant’s corporate home, and the venue that is far closer to Plaintiff’s principal place of business than is the Northern District of California. Had the Court been able to conclude that forum shopping, and not these connections, was what motivated the suit here, the outcome would have been different. But on this record, it could not draw that conclusion. And so, the *Jumara* analysis ultimately militates in favor of the case remaining in this Court.

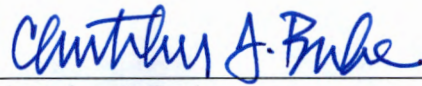
III. CONCLUSION

The Court therefore DENIES Defendant’s Motion.

Because this Memorandum Order may contain confidential information, it has been released under seal, pending review by the parties to allow them to submit a single, jointly proposed, redacted version (if necessary) of the document. Any such redacted version shall be submitted by not later than **July 27, 2018** for review by the Court, along with an explanation as to why disclosure of any proposed redacted material would “work a clearly defined and serious injury to the party seeking closure.” *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir.

1994) (internal quotation marks and citation omitted). The Court will subsequently issue a publicly-available version of its Memorandum Order.

Dated: July 24, 2018



Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE