

RATNERPRESTIA CASE LAW UPDATE

IN RE NINTENDO CO., LTD AND NINTENDO OF AMERICA, INC.

FEDERAL CIRCUIT TO EASTERN DISTRICT OF TEXAS: GRANT MOTIONS
TO TRANSFER

21 DECEMBER 2009

On December 17, 2009, a three-judge panel at the U.S. Court of Appeals for the Federal Circuit granted a defendant's petition for a writ of mandamus in *In re Nintendo*. The writ vacated an Eastern District of Texas (E.D. Tex.) order denying the defendant's motion to transfer the case to Washington. A writ of mandamus is extraordinary relief that is rarely granted. This is the fourth time that the Federal Circuit has issued a writ of mandamus over the past year, each time vacating an E.D. Tex. denial of a motion to transfer.

In *In re Nintendo*, the plaintiffs, Motiva, filed suit against Nintendo in the E.D. Tex. alleging infringement of a patent relating to a human movement measurement system. Nintendo filed a motion under 28 U.S.C. §1404(a) to transfer venue to the Western District of Washington. Nintendo of America is incorporated in that district, and all of the physical and documentary evidence is located in that district and Japan. Nintendo argued that because the evidence, witnesses, and defendants had no meaningful connection to the E.D. Tex., transfer to the Western District of Washington was proper.

On June 30, 2009, the district court denied Nintendo's motion to transfer. This denial by the district court occurred despite the message sent by the Federal Circuit's grant of a writ in [In re TS Tech USA Corp. \(Dec. 29, 2008\)](#) and *In re Genentech, Inc.* (May 22, 2009), both of which originated from the E.D. Tex. Acting on Nintendo's petition, the Federal Circuit found that Nintendo met its burden of establishing that the E.D. Tex. clearly abused its discretion in denying the transfer to the Western District of Washington.

The Federal Circuit once again applied the Fifth Circuit's "public" and "private" factors for determining *forum non conveniens*. In its application, the Court recognized a "stark contrast in relevant, convenience, and fairness between the two venues." The Court also cited to three cases this past year arising from the E.D. Tex. in which the court granted a writ of mandamus vacating an order denying transfer, *In re TS Tech USA Corp.*, *In re Genentech, Inc.*, and *In re Hoffman-La Roche, Inc.* (Dec. 2, 2009).

With this decision, four of the eight district judges from the E.D. Tex have had their orders denying transfer vacated by the Federal Circuit by a writ of mandamus.