

**UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
TAMPA DIVISION**

**EVANS DESIGN DYNAMICS, LLC,**

**Plaintiff,**

**v.**

**Case No. 8:12-cv-493-T-27TBM**

**NIKE, INC., and UMBRO CORP.,**

**Defendants.**

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**REPORT AND RECOMMENDATION**

THIS MATTER is before the Court on referral for a Report and Recommendation on **Defendants Nike, Inc.’s and Umbro Corp.’s Motion to Transfer Case to the District of Oregon and Incorporated Memorandum of Law** (Doc. 37) and Evans Design Dynamics, LLC’s Opposition (Doc. 39).<sup>1</sup> For the reasons set forth herein, I recommend the Motion be **GRANTED.**<sup>2</sup>

I.

Plaintiff, Evans Design Dynamics, LLC (“Evans Design”) is a limited liability company organized under the laws of Florida and has been active as of January 27, 2012. Its principal place of business is 1814 North 15th Street, Suite #5, Tampa, FL 33605. Anthony Evans, the inventor of the patent at issue, is the sole owner and shareholder of Evans Design.

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<sup>1</sup>Additionally, the parties filed affidavits, declarations and exhibits in support of their respective positions. (Docs. 37-1 through 37-8, 39-1 through 39-17).

<sup>2</sup>Defendants Nike, Inc.’s and Umbro Corp.’s Motion for Leave to File Reply Memorandum (Doc. 42) is **DENIED AS MOOT.**

Mr. Evans is a resident of the United Kingdom. Evans Design was purportedly formed to be the licensing arm of the patent at issue and it is the assignee of all past, present, and future interest of the patent. Defendant Nike, Inc. (“Nike”) is a corporation organized under the laws of the State of Oregon. Its principal place of business is One Bowerman Drive, Beaverton, Oregon. Defendant Umbro Corp. (“Umbro”) is a corporation organized under the laws of the State of Delaware. Its principal place of business is also One Bowerman Drive, Beaverton, Oregon. Umbro is a 100% wholly-owned subsidiary of NIKE International Holding Inc., which is an indirect wholly-owned subsidiary of Nike. Nike engages in the design, development, worldwide marketing and sale of athletic and fashion footwear, apparel and sports equipment. Umbro also engages in the design, development, worldwide marketing and sale of football apparel, footwear and equipment.

Plaintiff sues Defendants for patent infringement. *See* Amended Complaint (Doc. 27). Plaintiff alleges that Defendants infringed its U.S. Patent No. 6,101,746 (the ‘746 patent), entitled “Footwear,” by making, using, importing, offering to sell, and/or selling athletic shoes which embody the inventions claimed in the ‘746 patent. More particularly, Plaintiff claims that products such as the Nike CTR360 Trequartista 2 FG, the Nike CTR360 Maestri II FG, the Nike Mercurial, and the Umbro Geometra line of soccer shoes infringe its patent. Plaintiff alleges that in 2003, Umbro ceased to make payments to Mr. Evans under a licensing agreement, all the while continuing to make, use, import, offer to sell, and/or sell infringing products without authorization. Thereafter, in 2007, Nike purchased Umbro and thus, owing to its acquisition, Nike knew or should have known of Umbro’s infringement of Mr. Evan’s

patent rights and has profited from the same. Moreover, Plaintiff alleges that Nike itself has willfully infringed Plaintiff's rights by making, using, selling, offering to sell and/or importing shoes that it knows or should know infringe Plaintiff's patent rights. Plaintiff seeks damages under 35 U.S.C. § 284 and attorney fees and costs under 35 U.S.C. § 285. (Doc. 27).

By their Motion, Defendants seek to transfer the case to the District of Oregon under 28 U.S.C. § 1404(a). Defendants contend that the pertinent considerations underlying such a request to transfer all militate in favor of transfer. Thus, given the nature of a patent infringement case and the fact that the relevant evidence and witnesses are located in the District of Oregon where Nike and Umbro maintain their principal place of business, transfer is appropriate. This is especially so since the pertinent activities related to the accused products took place primarily in Oregon and in England. Further, the relevant marketing decisions and financial accounting related to the accused products also occurred primarily in Oregon. As for third-party witnesses, Defendants maintain the most likely company to be called is also based in Oregon. While acknowledging that Plaintiff's choice of forum is a significant factor, in this case, Defendants urge that it merits little or no weight because there is no meaningful connection between the parties, the suit and the Middle District of Florida. Moreover, Defendants urge that the relative means of the parties do not alter the convenience equation. (Doc. 37).

In contrast, Plaintiff contends that Defendants have not met their burden of demonstrating that the benefits of transfer clearly outweigh the significant consideration afforded its choice of forum. Plaintiff claims that venue is appropriately found in this Court

because it is a Florida corporation with its principal place of business in the Middle District of Florida. In addition, the documents necessary to litigate the instant dispute are also located within this District where both Defendants do business as well. Plaintiff's argument rests mainly on the contention that its choice of forum should be afforded great weight in the transfer analysis and when afforded such weight, a transfer is unwarranted. Weighing the several factors deemed pertinent to the analysis, Plaintiff contends that consideration of the convenience of the parties and witnesses, the relative ease of access to sources of proof and location of relative documents, the availability of compulsory witnesses, and public interest factors are all essentially neutral. As for the relative means of the parties and the likelihood of Nike, Inc. selling Umbro Corp., such considerations weigh against transfer. (Doc. 39).

## II.

28 U.S.C. § 1404(a) permits a district court to transfer a civil action to any other district where it might have been brought “[f]or the convenience of the parties and witnesses, in the interest of justice.” 28 U.S.C. § 1404(a). “Section 1404(a) is intended to place discretion in the district court to adjudicate motions for transfer according to an individualized, case-by-case consideration of convenience and fairness.” *Suomen Colorize Oy v. DISH Network LLC*, 801 F. Supp. 2d 1334, 1337 (M.D. Fla. 2011) (quoting *Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 29 (1988)). However, the Eleventh Circuit has noted that “[t]he plaintiff's choice of forum should not be disturbed unless it is clearly outweighed by other considerations.” *Robinson v. Giarmarco & Bill, P.C.*, 74 F.3d 253, 260 (11th Cir. 1996) (quoting *Howell v. Tanner*, 650 F.2d 610, 616 (5th Cir. Unit B 1981)). Thus, “the burden is

on the movant to establish that the suggested forum is more convenient.” *In re Ricoh Corp.*, 870 F.2d 570, 573 (11th Cir. 1989). A district court may transfer a case to another district “where it might have been brought.” 28 U.S.C. § 1404(a). In addition, there are several factors relevant to a transfer inquiry, which include,

(1) [T]he convenience of the witnesses; (2) the location of relevant documents and the relative ease of access to sources of proof; (3) the convenience of the parties; (4) the locus of operative facts; (5) the availability of process to compel the attendance of unwilling witnesses; (6) the relative means of the parties; (7) a forum’s familiarity with the governing law; (8) the weight accorded a plaintiff’s choice of forum; and (9) trial efficiency and the interests of justice, based on the totality of circumstances.

*Manuel v. Convergys Corp.*, 430 F.3d 1132, 1135 n.1 (11th Cir. 2005) (citing *Gibbs & Hill, Inc. v. Harbert Int’l, Inc.*, 745 F. Supp. 993, 996 (S.D.N.Y. 1990)); *Motorola Mobility, Inc. v. Microsoft Corp.*, 804 F. Supp. 2d 1271, 1275 (S.D. Fla. 2011); cf. *Anthony Sterling v. Provident Life & Accident Ins. Co.*, 519 F. Supp. 2d 1195, 1204 (M.D. Fla. 2007). Moreover, “where the operative facts underlying the cause of action did not occur within the forum chosen by the Plaintiff, the choice of forum is entitled to less consideration.” *Garay v. BRK Elecs.*, 755 F. Supp. 1010, 1011 (M.D. Fla. 1991) (citing *Windmere Corp. v. Remington Prods., Inc.*, 617 F. Supp. 8, 10 (S.D. Fla. 1985)).

In addition, “[i]n patent cases, the preferred forum is the defendant’s place of business as that usually constitutes the center of gravity of the alleged patent infringement.” *Suomen*, 801 F. Supp. 2d at 1338 (quoting *Proven Winners N. Am., LLC v. Cascade Greenhouse*, No. 2-06-cv-428-FTM-29DNF, 2007 WL 1655387, at \*2 (M.D. Fla. June 6, 2007)); see also *Motorola Mobility, Inc.*, 804 F. Supp. 2d at 1276.

III.

As an initial matter, the Court must determine whether the action could have been brought in the District of Oregon. *See* 28 U.S.C. § 1404(a); *Suomen*, 801 F. Supp. 2d at 1337. Clearly, it could have, and neither party disputes that this case might have been brought there had Plaintiff chosen to file it in that district. *See* (Doc. 37 at 12, Doc. 39 at 7).

As for Plaintiff's choice of forum, case law in this Circuit dictates that such consideration is generally entitled to considerable deference when determining the propriety of a transfer and should not be disturbed unless clearly outweighed by other considerations. *Giarmarco & Bill, P.C.*, 74 F.3d at 260. Here, however, I conclude that the circumstances of this suit militate against such deference. In addition to the convenience factors discussed below, Plaintiff's forum selection merits less weight where, as here, neither the Plaintiff company nor the facts underlying its patent infringement claims appear to have any meaningful connection to this District.<sup>3</sup> While Plaintiff is a Florida corporation with its principal place of business now physically located in the Middle District of Florida, the facts and circumstances underlying this patent suit appear to have no other significant connection or

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<sup>3</sup>As Defendants note, numerous cases support this position. *See In re Microsoft Corp.*, 630 F.3d 1361, 1365 (Fed. Cir. 2011); *In re Zimmer Holdings, Inc.*, 609 F.3d 1378, 1381 (Fed. Cir. 2010); *In re Hoffman-La Roche Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009); *Brandywine Comm'n Tech. v. Cisco Sys.*, No. 11-01843, at \*5 (M.D. Fla. Mar. 26, 2012); *Suomen*, 801 F. Supp. 2d at 1338; *Proven Winners North Am., LLC*, 2007 WL 1655387, at \*1; *Cellularvision Tech. & Telecomm., L.P. v. Alltel Corp.*, 508 F. Supp. 2d 1186, 1189-90 (S.D. Fla. 2007); *Cellularvision Tech. & Telecomm., L.P. v. Cellco P'ship*, No. 06-60666, 2006 WL 2871858, at \*3 (S.D. Fla. Sept. 12, 2006); *Balloveras v. Purdue Pharma Co.*, No. 04-20360, 2004 WL 1202854, at \*1 (S.D. Fla. May 19, 2004); *Thermal Techs., Inc. v. Dade Serv. Corp.*, 282 F. Supp. 2d 1373, 1375-76 (S.D. Fla. 2003); *Windmere Corp.*, 617 F. Supp. at 10. (Doc. 37 at 13-14).

In contrast, Plaintiff distinguishes the cases cited by Defendants. (Doc. 39 at 9-11).

relationship with this District apart from the fact that the Defendants sell their products in the State. Case law supports that “where the operative facts underlying the cause of action did not occur within the forum chosen by the Plaintiff, the choice of forum is entitled to less consideration.” *Garay*, 755 F. Supp. at 1011 (citing *Windmere Corp.*, 617 F. Supp. at 10)). Here, Plaintiff’s argument rests on the fact that it was formed under the laws of Florida, it pays applicable taxes here, and rents office space in Tampa, where it also maintains its principal and mailing address.<sup>4</sup> *See* (Doc. 39-1, Declaration of Anthony Evans (“Evans Decl.”)). Moreover, Plaintiff contends that all of its relevant documents are located in Florida. *Id.* However, I find these considerations less than persuasive. Evans Design was incorporated in Tampa, Florida on January 27, 2012, only shortly before suit was filed. (Doc. 37-3). The ‘746 patent appears to have been issued in August 2000. *See* (Doc. 27-1). The inventor, Mr. Evans, continues to reside in England. (Doc. 39 at 12). The alleged infringement is said to have started in 2003 by Umbro and in 2007 by Nike when it acquired Umbro. (Doc. 27 at 3). Umbro is a company organized under the laws of Delaware. (Doc. 37-1, Declaration of Ann Miller (“Miller Decl.”) at 2).<sup>5</sup> Nike is organized under the laws of Oregon. *Id.* Both Defendants’ principal places of business are in Oregon. *Id.* While Nike’s products are sold nationwide, it appears unrefuted that “[n]one of Nike’s design, development,

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<sup>4</sup>In legal support of its argument, Plaintiff cites to *S.E.C. v. Lauer*, No. 09-15138, 2012 WL 1352930, at \*2 (11th Cir. Apr. 19, 2012) (citing *Giarmarco & Bill, P.C.*, 74 F.3d at 260); *Trinity Christian Ctr. of Santa Ana, Inc. v. New Frontier Media, Inc.*, 761 F. Supp. 2d 1322, 1330 (M.D. Fla. 2010); *Anthony Sterling, M.D.*, 519 F. Supp. 2d at 1204; *Response Reward Sys., L.C. v. Meijer, Inc.*, 189 F. Supp. 2d 1332, 1339 (M.D. Fla. 2002); *Am. Aircraft Sales Int’l, Inc. v. Airwarsaw, Inc.*, 55 F. Supp. 2d 1347, 1351 (M.D. Fla. 1999). (Doc. 39 at 7-8).

<sup>5</sup>Ann Miller is a Senior Counsel, Corporate Governance & Securities, at Nike, Inc.

and testing activities relating to the Nike products at issue occurs in Florida.” *Id.* at 3. Moreover, “[n]one of Umbro Corp.’s design, development, and testing activities relating to the Umbro products at issue occurs in Florida.” *Id.* In addition, neither company’s accused products are manufactured in the United States. *Id.* According to Ms. Miller, “[t]he effort to design and develop each of the Nike and Umbro products at issue involved a team of individuals . . . [who] work at Nike’s facilities in Beaverton, Oregon.” *Id.* Likely Nike witnesses connected with the design and development work are identified and nearly all appear to reside in Oregon. *Id.* Similarly, nearly all the documents, samples and prototypes related to design, development and testing of the accused products are in Oregon. *Id.* at 3-4. Again, apart from the fact that both Nike and Umbro do business in the State of Florida, there appears no other connection between the allegations of patent infringement and this District. These claims are not refuted by Plaintiff, and thus it appears that most if not all the operative facts underlying the cause of action appear to have occurred outside the Middle District of Florida.

Plaintiff contends that all of its relevant documents involving the design of the patents and related to the infringement are located in Tampa, Florida. That may well be true, but apart from the conceded fact that Nike and Umbro sell the accused products nationwide, Plaintiff makes no showing that the operative facts underlying the alleged patent infringement occurred in the forum district. For this reason, I give little deference to Plaintiff’s choice of forum.



Furthermore, I am here obliged to conclude that the pertinent factors related to convenience, on the whole, also favor transfer. The discussion above reveals that consideration of the locus of operative facts supports the transfer. Concerning convenience of the witnesses<sup>6</sup> and the parties, I find that consideration of witness convenience favors transfer. Defendants offer a persuasive argument that their key employees that are likely to be involved in this litigation, along with the records related to the design, development, testing, marketing and sale of the accused products, are in Oregon.<sup>7</sup> As for Plaintiff, only two witnesses, Mr. Evans and the law firm who prosecuted the '746 patent, are addressed in the pleadings; neither of whom resides in Florida. It is readily apparent that both will be inconvenienced by the need to travel regardless of where the case is tried. Mr. Evans resides in England and the law firm which prosecuted the '746 patent is based in Philadelphia, Pennsylvania. Plaintiff points to flight times for these witnesses and urges that their flights to Oregon would be longer and more inconvenient than if they were to fly to Florida. *See* (Doc. 39-2, Declaration of Nicholas

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<sup>6</sup>Nike has identified Andrew Caine, Nike's Creative Director for Global Football, Matthew Hudson, a Nike designer, and Forbes Campbell, Nike's Senior Integrated Technology Business Systems Analyst, as likely witnesses in Oregon who will provide testimony on design, development, and testing of the Nike and Umbro products at issue. (Miller Decl. at 3). Moreover, Defendants "do not anticipate that any Nike or Umbro Corp. employees . . . relating to this case will be located in Florida." *Id.* at 4. Plaintiff does not identify any witness that is located in Florida, although a custodian of records is surely one. As for third-party witnesses, Defendants identify a third-party witness, LawnGrips LLC, which is also located in Oregon. (Doc. 37-2, Declaration of Richard T. Mulloy ("Mulloy Decl.") at 2, Doc. 37-8). In any event, Plaintiff concedes the burdens on any third parties are neutral. (Doc. 39 at 14).

<sup>7</sup>There is some support for Plaintiff's contrary argument that consideration of the convenience of these witnesses is diminished because they are "employees of a party and their presence at trial can be obtained by that party." *Trinity Christian Ctr.*, 761 F. Supp. 2d at 1327.

S. Mancuso (“Mancuso Decl.”)).<sup>8</sup> While such may be the case, I find the argument unpersuasive when considered against the whole of the witnesses likely to be involved in the litigation. Plaintiff is correct that a transfer will require it to transport records now kept in Florida to Oregon should the case reach trial. However, as discussed below, it seems likely that there are more relevant documents and tangible evidence already located in Oregon. In the balance, considerations of witness convenience favor transfer.<sup>9</sup>

As for the location of relevant documents and the relative ease of access to sources of proof, I again conclude that such factors weigh in favor of transfer as well. “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.’” *Suomen*, 801 F. Supp. 2d at 1339 (quoting *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009)). Here, Defendants assert, “[n]early all of the substantial amount of documentary and physical evidence that is relevant to this case is located at Nike’s headquarters in Oregon, including documents related to the design, development, and testing of the accused products.” (Miller Decl. at 3). This assertion is left

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<sup>8</sup>Mr. Mancuso is an attorney representing Plaintiff.

<sup>9</sup>The inconvenience to the parties seems to me to be a lesser consideration and perhaps a wash in the circumstances. Plaintiff surely recognized that it would experience inconvenience by filing this suit even in Florida. Defendants will also experience inconvenience, especially in Florida. One judge in this Court has found that “convenience of the parties is practically irrelevant to whether the motion to transfer should be granted” (*Cent. Money Mortg. Co. [IMC], Inc. v. Holman*, 122 F. Supp. 2d 1345, 1346 (M.D. Fla. 2000) (citing *Colondy v. Iverson, Yoakum, Papiano & Hatch*, No. 93-1464-CIV-T-17C, 1994 WL 150835, at \*2 (M.D. Fla. Apr. 14, 1994)). While I would not go so far, I do find it a lesser consideration than the inconvenience to witnesses.

uncontested by Plaintiff. Nonetheless, Plaintiff contends that such matters can be easily imaged and transferred electronically without much inconvenience, thereby eliminating the need for a transfer.

Here, I am persuaded that the bulk of the relevant design, development, testing, marketing, and sales records are in the District of Oregon and that ultimately, it would be far more inconvenient for Defendants to have to relocate such evidence for a trial in this District than it would be for Plaintiff to relocate its proof to Oregon. While the discovery of such matters could be streamlined by the electronic or digital transfer of paper and e-documents, it appears to me that a trial of this type of dispute will require the use of many more of Defendants' records than Plaintiff's. While a transfer will undoubtedly require Plaintiff to transport some documents to Oregon should the case proceed to trial, I am persuaded a much greater burden would be imposed on Defendants were they required to transport their evidence to this District for trial. Therefore, these factors also tend to support transfer.

Moreover, this Court also takes into consideration the relative interests of the two forum states in the litigation and the trial efficiency factor. By my consideration, these forums should have an equal interest in protecting these parties from patent infringement. That said, because of the Defendants' residence in Oregon, the District of Oregon clearly has a significant interest in resolving these allegations. Which district will offer more effective compulsory process for non-employee and other third-party witnesses is difficult to judge without knowing the full witness and evidence lists. However, it does appear that very few witnesses will be located in Florida as compared to Oregon, and reluctant witnesses may

therefore be more amenable to compulsory process in Oregon than in this District. Unstated by Plaintiff, but surely a consideration, is its concern about having to contest the litigation on Defendants' home turf. While such concern is understandable, there is no apparent reason to question the ability of the federal court in the District of Oregon to fully and fairly resolve this dispute.

Plaintiff also argues the District of Oregon has a longer average time to trial than the Middle District of Florida.<sup>10</sup> That fact alone is not particularly persuasive, and I nonetheless find that it would be "substantially more efficient and more practical to try this case" in the District of Oregon. *Suomen*, 801 F. Supp. 2d at 1339. "With greater availability of witnesses and evidence, the [District of Oregon] is better situated to effectively resolve the issues in this case without overwhelming disruption to the parties." *Id.*

As for the relative means of the parties, Plaintiff argues that given their relative sizes, Defendants are far better situated to bear the financial costs of the litigation than it is. As evidence of Defendants' ability to afford litigation here, it cites other cases in this District involving Nike. *See* (Docs. 39-7 through 39-14).<sup>11</sup> Defendants urge, however, that this factor

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<sup>10</sup>Plaintiff points to Exhibit E of Defendants' Mulloy Declaration, which is a copy of excerpts of the U.S. District Court - Judicial Caseload Profile, collected on May 29, 2012. Using Exhibit E, Plaintiff asserts that the average time from filing to trial in the District of Oregon is 26.43 months, while in the Middle District of Florida, the average time is 19.72 months. (Doc. 39 at 17-18); *see also* (Mulloy Decl. Ex. E).

<sup>11</sup>Plaintiff cites to *Omega Patents, LLC, v. Lear Corp.*, No. 6:07-cv-1422-Orl-35DAB, 2009 WL 1513392, at \*3 (M.D. Fla. May 27, 2009), to support its assertion that Nike's litigation in this forum without complaint bears some weight in deciding the relative means of the parties. However, the Court in *Omega Patents* used defendant's litigation in this forum as an indication that defendant's complaint of economic difficulty was not compelling. *See Omega Patents, LLC*, 2009 WL 1513392, at \*3 ("[A]s [Defendant] has litigated in this forum

in no way supports a trial in this District in light of the lack of connection between this District and the suit and parties. I tend to agree. While Defendants likely do have greater financial means and could litigate in this District if required to do so, given that so little, if any, of the operative facts occurred in this District and most of the witnesses, records and documents appear to be located in Oregon, this factor is of lesser significance to the transfer analysis. Moreover, as Defendants propose, some of Plaintiff's costs concerns can be mitigated in other ways such as by requiring Mr. Evans to be deposed in England where he resides and by an efficient plan for exchanging documentary evidence by electronic or digital transmission. Thus, while Defendants likely have the greater means, such does not weigh heavily against transfer.<sup>12</sup>

In sum, given that the bulk of the parties' witnesses and evidence relevant to the infringement claims or the defenses of the same appear to reside in and around Oregon where most of the salient events took place, and there is no reason to believe that the District Court in Oregon cannot capably, efficiently and expeditiously handle this dispute, I conclude that transfer of the case to the District of Oregon is appropriate despite the Plaintiff's residence in this District.

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without complaint for over a year prior to filing this motion, its present economic difficulties are not compelling." Here, on the other hand, Defendants have not raised an issue of economic hardship. Rather, they argue for transfer due to the location of the witnesses and evidence.

<sup>12</sup>Plaintiff also contends that Defendants' Motion is premature because of news reports of Nike's intention to sell Umbro Corp. *See* (Docs. 39-15 to 39-17). I find it premature to even consider the argument given that the sale may or may not ever occur.

IV.

For the foregoing reasons, it is recommended that Defendants Nike, Inc.'s and Umbro Corp.'s Motion to Transfer Case to District of Oregon and Incorporated Memorandum of Law (Doc. 37) be **GRANTED**.

Respectfully submitted on this  
22nd day of October 2012.



THOMAS B. McCOUN III  
UNITED STATES MAGISTRATE JUDGE

**NOTICE TO PARTIES**

Failure to file written objections to the proposed findings and recommendations contained in this report within fourteen (14) days from the date of its service shall bar an aggrieved party from attacking the factual findings on appeal and a *de novo* determination by a district judge. 28 U.S.C. § 636(b)(1); Fed. R. Civ. P. 72; M.D. Fla. R. 6.02; *see also* Fed. R. Civ. P. 6.

Copies to:  
United States District Judge  
Counsel of Record