IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

INVITROGEN CORPORATION,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 01-692-SLR
	)	
INCYTE GENOMICS, INC.,	)	
	)	
Defendant.	)	

MEMORANDUM ORDER

I. INTRODUCTION

Plaintiff Invitrogen Corporation ("Invitrogen") filed this patent action against defendant Incyte Genomics, Inc. ("Invitrogen") on October 17, 2001. (D.I. 1) Invitrogen contends that Incyte infringes its U.S. Patents Nos. 5,244,797 ("'797"), 5,668,005 ("'005") and 6,063,608 ("'608"). On November 21, 2001, Incyte filed an answer and counterclaim seeking a declaratory judgment of invalidity and noninfringement of each of the patents. (D.I. 6)

Presently before the court is Incyte's motion to transfer venue from this district to the United States District Court for the District of Maryland pursuant to 28 U.S.C. § 1404(a)[1]. (D.I.

[1] Title 28, Section § 1404(a) provides:

> For 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.

7) The motion has been fully briefed. (D.I. 9, 10, 11, 16, 20, 21, 22) For the reasons that follow, the motion will be denied.

II. BACKGROUND

Invitrogen is a Delaware corporation with its principal place of business in Carlsbad, California. (D.I. 1) In September 2000, Life Technologies, Inc. ("LTI") merged with and into Invitrogen. (D.I. 17) LTI was headquartered in Maryland. (Id.) Following the merger, "Invitrogen transferred much of [LTI's] executive, administrative, sales, marketing, and research and development functions to California." (Id. ¶ 4) Additional corporate functions, including distribution, finance, legal and human resources, as well as manufacturing activities related to the patents-in-suit, are designated for transfer to California sometime in 2002. (Id. ¶ 5)

Incyte is a Delaware corporation with its principal place of business in Palo Alto, California. (D.I. 16) Both Incyte and Invitrogen conduct business in all fifty states.

The technology at issue relates to the creation and use of a modified reverse transcriptase enzyme[2]. "The invention covered by the claims of the patents-in-suit, the RNase H minus reverse transcriptase, was a significant milestone in the manipulation

[2] All three patents ('797, '005, '608) are entitled "Cloned Genes Encoding Reverse Transcriptase Lacking RNase H activity" and were issued on September 14, 1993, September 16, 1997 and May 16, 2000, respectively, to Michael L. Kotewicz and Gary F. Gerard. (D.I. 1 ¶ 7)

and understanding of the human genome and helped foster what is now called the 'genomics revolution.'" (D.I. 1 ¶ 9) All three patents were originally assigned to LTI. (D.I. 8 at 2) When the merger occurred, Invitrogen became the owner of record of the patents. Invitrogen "sells and distributes its own RNase H minus RT products styled SuperScript™ and SuperScript II™, which are covered by the patents-in-suit, and Invitrogen marks these products accordingly." (D.I. 1 ¶ 16)

Incyte indicates "that it is part of the genomics industry and that it uses RNase H minus reverse transcriptase to make cDNA from mRNA." (D.I. 6 ¶ 14) Incyte further states that

> it has inventories of cDNA, that it makes products including cDNA arrays and cDNA clones which are sold to its customers, that it offers services to its customers including making custom cDNA clones, and that it generates information concerning its cDNA clones and sells and/or offers for sale access to databases containing that information.

(Id. ¶ 15)

III. RELATED LITIGATION

The United States District Court for the District of Maryland has three cases[3] currently pending involving the same

[3] Life Technologies, Inc. v. Statgene Inc., Civil Action No. AW-94-277(infringement of the'797 patent); Life Technologies, Inc. v. Clontech Laboratories, Inc., Civil Action No. AW-96-4080 (infringement of the '797 and '005 and '608 patents)(D.I. 10 Ex. F and G); Life Technologies, Inc. v.. Stratagene Holding Corp., Stratagene, Inc. and Biocrest Manufacturing, L.P., Civil Action

patents, the '797, '005 and '608 patents. (D.I. 10) This court has a related matter, Clontech v. Invitrogen, Civil Action No. 98-750-SLR, which until recently was stayed awaiting resolution of the Maryland action.

IV. DISCUSSION

Congress intended through 28 U.S.C. § 1404 to place discretion in the district court to adjudicate motions to transfer according to an individualized, case-by-case consideration of convenience and the interests of justice. Stewart Org., Inc. v. Ricoh Corp., 487 U.S. 22, 29 (1988); Affymetrix, Inc. v. Synteni, Inc., 28 F. Supp.2d 192, 208 (D. Del. 1998).

The burden of establishing the need to transfer rests with the movant "to establish that the balance of convenience of the parties and witnesses strongly favors the defendants." Bergman v. Brainin, 512 F. Supp. 972, 973 (D. Del. 1981) (citing Shutte v. Armco Steel Corp., 431 F.2d 22, 25 (3d Cir. 1970), cert. denied, 401 U.S. 910 (1971). "Unless the balance is strongly in favor of a transfer, the plaintiff's choice of forum should prevail". ADE Corp. v. KLA-Tencor Corp., 138 F. Supp.2d 565, 567 (D. Del. 2001); Shutte, 431 F.2d at 25.

The deference afforded plaintiff's choice of forum will

No. 00-620-JJF (infringement of the '608 patent); Life Technologies action was originally filed in Delaware and then transferred to Maryland upon motion of defendants. (Id., Ex. I)

apply as long as a plaintiff has selected the forum for some legitimate reason. C.R. Bard, Inc. v. Guidant Corp., 997 F. Supp. 556, 562 (D. Del 1998); Siemens Medical Systems, Inc. v. Fonar Corporation, C.A. No. 95-261-SLR, slip. op. at 8 (D. Del. Nov. 1, 1995); Cypress Semiconductor Corp. v. Integrated Circuit Systems, Inc., C.A. No. 01-199-SLR, slip. op. at (D. Del. Nov. 28, 2001). Although transfer of an action is usually considered as less convenient to a plaintiff if the plaintiff has not chosen its "'home turf' or a forum where the alleged wrongful activity occurred, the plaintiff's choice of forum is still of paramount consideration, and the burden remains at all times on the defendants to show that the balance of convenience and the interests of justice weigh strongly in favor of transfer." In re M.L.-Lee Acquisition Fund II, L.P., 816 F. Supp. 973, 976 (D. Del. 1993).

The Third Circuit Court of Appeals has indicated the analysis for transfer is very broad. Jumara v. State Farm Ins. Co., 55 F.3d 873, 879 (3d Cir. 1995). Although emphasizing that "there is no definitive formula or list of factors to consider," id., the court has identified potential factors it characterized as either private or public interests. The private interests include: (1) plaintiff's forum preference as manifested in the original choice; (2) 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) 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 interests include: (1) the 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. (citations omitted).

V. ANALYSIS

A. Private Factors

Since the parties do not dispute that this action could have been initiated in the District of Maryland, an examination of the private issues implicated by a transfer is warranted.

Incyte argues that all significant documents, witnesses, the patent inventors and other relevant evidence is located in Maryland and, consequently, it would be more convenient to proceed in Maryland. (D.I. 8, 10)

Invitrogen conversely asserts that Maryland is no more convenient for either party than is Delaware. (D.I. 16) Because the transfer of its operations from Maryland to California is almost complete, both parties will now have their corporate offices and research and development facilities in California. Further, Invitrogen contends its "choice of forum is paramount and controlling absent compelling justification for a transfer." (Id. at 1 ¶ 2)

The court finds that the balance of the private factors does not weigh in favor of transfer. Given the proximity between the Delaware and Maryland courts, convenience of travel for the parties involved is minimal. As national corporations, plaintiff and defendant conduct business throughout the country. Moreover, considering Incyte operates out of California and by the end of the second quarter 2002, Invitrogen will likewise be conducting its entire business there, both will have to travel for the trial whether to Maryland or Delaware is inconsequential. Moreover, the practical realities are that discovery will likely occur in California regardless of the trial venue. Although Incyte indicates that witnesses, documents and other evidence relevant to this action are located in Maryland (D.I. 8), it has not identified any witnesses or documents that will have difficulty traveling to Delaware. See Critikon, Inc. v. Becton Dickinson Vasular Access, Inc., 821 F. Supp. 962, 966-67 (D. Del. 1993);

Liggett Group Inc. v. R.J. Reynolds Tobacco Co., 102 F. Supp.2d 518, 529 (D.N.J. 2000)(the moving party must submit sufficient information in the record to meet its burden of persuasion to transfer).

B. Public Interests

Similarly, the court finds the public interests implicated do not compel transfer to Maryland. Although this case involves the same patents as those under consideration in Maryland, the record does not reflect that the Maryland cases are close to trial or resolution. When presented with a similar issue two years ago, this court was persuaded that the interests of judicial economy mandated that the Delaware Clontech case be stayed pending the outcome of related litigation. (D.I. 22, Ex. S) However, the court is no longer convinced that waiting for a determination in the Maryland cases is prudent. For two years the Clontech case has been inactive while the parties and court have anticipated a decision from Maryland. Finally, since there has been no resolution, the court lifted the stay and scheduled trial for October 7, 2002. Along those lines, this action shall remain in Delaware.

VI. CONCLUSION

For the reasons stated, at Wilmington, this 1st day of May, 2002;

IT IS ORDERED that Incyte's motion to transfer is denied. (D.I. 7)

Sue L. Robinson
United States District Judge