UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

PUMA SE and PUMA NORTH AMERICA, INC., Plaintiffs, v. BROOKS SPORTS, INC., Defendant.	))))))))))	No. 1:22-cv-01362-RLY-MPB

ENTRY ON DEFENDANT BROOKS SPORTS INC.'S MOTION TO TRANSFER VENUE

Plaintiffs Puma SE and Puma North America, Inc. (collectively "Puma") and Brooks Sports, Inc. are competitors in the sports apparel and footwear industry. Puma brings trademark and patent infringement claims against Brooks, alleging that Brooks' running shoes with nitro-infused midsoles infringe Puma's trademark rights in the word "nitro," and that Brooks' "Aurora BL" running shoe infringes U.S. Design Patent No. D897,075.

In the present motion, Brooks moves to transfer this case to the Western District of Washington. For the reasons set forth below, the motion is **GRANTED**.

I. Background

A. Brooks Sports, Inc.

Brooks is located and incorporated in Washington State, with its principal place of business in Seattle, Washington. (Filing No. 1, Compl. ¶ 5). The majority of Brooks' employees, including those who work in its research and development, marketing and

advertising, and design departments, are located in Seattle. (Filing No. 39-3, Ross Decl. ¶ 5). Brooks' only two brick-and-mortar retail stores are in the Seattle area. (*Id.* ¶ 7). Brooks' North American sales largely occur online or in third-party retail stores. (*Id.* ¶ 24).

Brooks' distribution facility is in Whitestown, Indiana. (*Id.* ¶ 21). The 400,000 square-foot distribution facility contains a warehouse where inventory is received, organized, stored, and then distributed to customers and resellers. (*Id.* ¶ 22).

B. Puma SE and Puma North America, Inc.

Puma SE is organized under the laws of Germany with its principal place of business in Herzogenaurach, Germany. (Filing No. 1, Compl. ¶ 4). (*Id.*). Puma North America Inc. is incorporated in Delaware with its principal place of business in Somerville, Massachusetts. (*Id.*). Puma maintains brick-and-mortar stores throughout the world, including one in Edinburgh, Indiana. (Filing No. 52-1, Mastrostefano Decl. ¶ 11). Like Brooks, Puma also sells its goods online and through third-party stores. (*Id.* ¶ 12).

Puma alleges it owns rights in the mark NITRO and uses its NITRO mark on and in connection with Puma footwear. (Compl. ¶ 16). Since launching its NITRO line of running shoes in March 2021, Puma has seen substantial growth over its previous running shoe line. (*Id.* ¶ 17). Puma's NITRO-branded shoes are currently its top selling running shoes in the U.S. (*Id.*).

C. The Parties' Dispute

Since 2019, Brooks has marketed running shoes containing midsoles infused with

nitrogen. (Ross Decl. ¶ 19). As part of its advertising campaign, Brooks refers to the shoes as "nitro-infused" and includes pictures of nitrogen gas tanks and nitrogen gas bubbles, and it uses the elemental symbol for nitrogen. (*Id.* ¶ 13). All of Brooks' nitro-infused shoes bear the BROOKS trademark and logo. (*Id.*).

In November 2021, a Puma employee took photographs of a Brooks trade show display in Texas, which included large signs that read "NITRO" and "NITRO DOME." (Compl. ¶ 22). Puma's counsel sent a letter to Brooks on December 21, 2021, asserting that Puma had exclusive rights to "nitro" in connection with running shoes and related footwear. (*Id.* ¶ 23). At Puma's request, Brooks engaged in discussions with Puma to resolve the dispute. (*Id.* ¶ 24). Those discussions were unsuccessful. (*Id.*).

On March 22, 2022, Puma sent Brooks a draft complaint and threatened to file suit if Brooks did not stop using "nitro" in any context. (Ross Decl. ¶ 27). The draft complaint was captioned for the Western District of Washington and included three counts: trademark infringement, violation of Washington's unfair and deceptive trade practices act, and common law trademark infringement. (*Id.* ¶ 28 & Ex. B). Brooks refused. (*Id.* ¶ 29). On July 8, 2022, Puma initiated this action in the Southern District of Indiana and added a design patent infringement claim against Brooks' Aurora BL running shoe. (*See* Compl.). Brooks has since filed a four-count Counterclaim, seeking a declaratory judgment that Puma has no valid or enforceable rights in "nitro" for footwear; a declaratory judgment of non-infringement in any rights Puma claims to have in "nitro"; a declaratory judgment of non-infringement of Puma's '075 Patent; and a declaration of invalidity of Puma's '075 Patent.

II. Discussion

Brooks moves to transfer venue of this case to the Western District of Washington, Seattle Division, pursuant to 28 U.S.C. § 1404(a). Section 1404(a) provides: "For the convenience of the 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." Transfer under § 1404(a) is appropriate where the moving party establishes that (1) venue is proper in the transferor district, (2) venue and jurisdiction are proper in the transferee district, and (3) the transfer will serve the convenience of the parties, the convenience of the witnesses, and the interest of justice. *Commissioning Agents, Inc. v. Long*, 187 F. Supp. 3d 980, 985 (S.D. Ind. 2016). Where, as here, the parties agree the statutory requirements for venue are met in both the transferor and transferee courts, the court need only consider whether the case should be transferred based on the third factor noted above: whether transfer will serve the convenience of the parties, the convenience of the witnesses, and the interest of justice. *Id.* at 985. This analysis requires an "individualized, case-by-case consideration of convenience and fairness." *Van Dusen v. Barrack*, 376 U.S. 612, 622 (1964).

The party moving for transfer bears the burden of establishing, by reference to particular circumstances, that the transferee forum is "*clearly* more convenient" than the transferor forum. *Coffey v. Van Dorn Iron Works*, 796 F.2d 217, 219 (7th Cir. 1986) (emphasis added). Transfer is not appropriate when doing so would merely shift the inconvenience of the litigation from one party to the other. *Rsch. Auto., Inc. v. Schrader-Bridgeport Int'l, Inc.*, 626 F.3d 973, 978–79 (7th Cir. 2010).

A. Convenience of the Parties and Witnesses

Factors relevant to the convenience inquiry include: (1) the plaintiff's choice of forum; (2) the situs of material events; (3) the relative ease of access to sources of proof; (4) the convenience of the parties litigating in the respective forums; and (5) the convenience of the parties. *Est. of Davis v. Erickson Beamon, Ltd.*, No. 1:12-cv-01687-JMS-DKL, 2013 WL 6328726, at *5 (S.D. Ind. Dec. 4, 2013) (citation omitted). The court begins its discussion with Puma's choice of forum.

1. Plaintiffs' Choice of Forum

Ordinarily, a plaintiff's choice of forum is accorded a great deal of deference. *FDIC v. Citizens Bank & Trust Co.*, 592 F.2d 364, 368 (7th Cir. 1979). "[U]nless the balance is strongly in favor of the defendant, the plaintiff's choice of forum should rarely be disturbed." *In re Nat'l Presto Indus., Inc.,* 347 F.3d 662, 664 (7th Cir. 2003) (citations omitted). A plaintiff's choice of forum is afforded less deference, however, when another forum has a stronger relationship to the dispute or when the forum of plaintiff's choice has no significant connection to the situs of material events. *Moore v. Motor Coach Indus., Inc.*, 487 F. Supp. 2d 1003, 1007 (N.D. Ill. 2007) (citing *Chi., Rock Island & Pac. R.R. v. Igoe,* 220 F.2d 299, 304 (7th Cir. 1955)).

Puma's choice of forum is entitled to little deference. Puma is not an Indiana corporation, is not headquartered in Indiana, and has only one brick-and-mortar store in Indiana (out of over 100 in the United States).[1] Moreover, the events at issue in this case

[1] *See* Find a Puma Store, Puma.com, https://about.puma.com/en/storelocator.

did not occur in Indiana. As described below, the Western District of Washington has stronger ties to the parties' dispute than this District.

2. Situs of Material Events

The venue analysis in intellectual property cases focuses on the accused infringer's place of business and where the design, development, and/or manufacture of the accused products occurred. *See SRAM Corp. v. SunRace Roots Enter. Co.*, 953 F. Supp. 257, 259 (N.D. Ill. 1997) (noting "intellectual property cases generally focus on the infringer's place of business"); *Est. of Davis*, 2013 WL 6328726, at *6 (explaining key inquiries for venue analysis in a trademark-related case are whether the defendant "researched, designed, developed, or manufactured the allegedly infringing products for sale in Indiana"). As Brooks has asserted counterclaims against Puma for non-infringement and invalidity of the '075 Patent, the court considers this factor from both parties' perspective.

Brooks is headquartered in Seattle, the allegedly infringing products and marketing campaigns were developed and designed in Seattle, and all but one of Brooks' key designers, developers, and corporate executives currently reside in the Seattle area; none live in Indiana. (Ross Decl. ¶¶ 4, 9–14, 16–19). The events giving rise to Brooks' Counterclaim did not occur in Indiana either. They appear to have occurred in Germany and Massachusetts—where Puma developed the NITRO mark and the design claimed in the '075 Patent. (Mastrostefano Decl. ¶¶ 13, 21). As none of the events giving rise to Brooks' counterclaims occurred in Indiana, the court finds this factor weighs in favor of transfer.

3. Ease of Access to Sources of Proof

Brooks' research and development laboratories and facilities are in Seattle. (Ross Decl. ¶¶ 12, 14, 19). Thus, relevant evidence relating to (1) nitro-infused midsoles in Brooks products; (2) the nitro-infusion advertising and marketing campaign; and (3) the design and development of the Aurora BL, is in Washington State. (*Id.* ¶¶ 12, 14, 19). On the other hand, Puma's research and development laboratories are in Germany and Massachusetts. (Mastrostefano Decl. ¶¶ 7, 13). Evidence relating to: (1) Puma's development, use, and application to register its NITRO mark; (2) the development of the nitrogen-infusion technology; and (3) the '097 Patent, is therefore in Germany and Massachusetts. (*Id.* ¶¶ 15-22).

As Puma observes, most of the evidence in this case is documentary in nature and electronically stored in the parties' respective locations. Given that the bulk of parties' evidence can be transferred easily to either Indiana or Washington, this factor does not weigh in favor of either party. *Moore*, 487 F. Supp. 2d at 1008 (finding factor neutral because "documents outside this district can just as easily be shipped or sent to Illinois" or New York).

4. Convenience of the Parties and Witnesses

The parties have identified only top executives and employees as witnesses. Therefore, the convenience of the parties is the primary factor at issue. *Long*, 187 F. Supp. 3d at 988 (explaining that "courts generally assign little weight to the location of employee-witnesses because they are usually within the control of the parties and are likely to appear voluntarily in either forum"). In assessing the convenience of the parties,

the court considers the parties' residences and the parties' ability to bear the expense of trial[2] in each forum. *Post Media Sys. LLC v. Apple Inc.*, No. 19 C 5538, 2020 WL 833089, at *3 (N.D. Ill. Feb. 20, 2020). The court also considers the necessity of travel for each party. *Id.*

Brooks' witnesses largely reside in the Seattle area, including key executives like Brooks' Vice President of Research and Development, its Senior Vice President and Chief Marketing Officer, the product and innovation designers for the accused products, and the marketing and creative team members that designed and implemented the advertising campaigns at issue. (Ross Decl. ¶¶ 11, 14, 17-18). Puma's witnesses reside in Germany and Massachusetts. Those in the Boston area include Puma's Chief Brand Officer; its General Manager of the Run/Train Business Unit; and Senior Team Head of the Product Line Management, Run/Train Footwear. (Mastrostefano Decl. ¶ 14). Those in Germany include Puma's Team Head for Trademarks and Legal Affairs; Senior Team Head Material Engineering Innovation; and Senior Head of Innovation. (*Id.*).

Although Puma contends that flights to Indiana are shorter than flights to Seattle, (Mastrostefano Decl. ¶¶ 23-24), its witnesses will have to travel regardless. Moreover, Brooks submitted an exhibit showing that there are more direct flights from Boston to Seattle than from Boston to Indianapolis. (Filing No. 57-2, Fischer Decl. Ex. 1 at 2-5). And according to Google Flights, there are direct flights from Frankfurt, Germany to Seattle. (*Id.* at 6-9). In comparison, there are no direct flights from any city in Germany

[2] Both parties are multi-national corporations and are fully capable of bearing the expense of trial.

to Indianapolis. (*Id.* at 10-12). On the other hand, proceeding in this District will require Brooks' witnesses, who would otherwise not have to fly, to travel thousands of miles across three time zones. Because Brooks will need to travel only if the court denies transfer and Puma will have to travel regardless of the court's decision, the court finds the convenience factor weighs in favor of transfer. *Body Sci. LLC v. Boston Sci. Corp.*, 846 F. Supp. 2d 980, 997 (N.D. Ill. 2012) (holding this factor weighs in favor of transfer where plaintiff must travel regardless of whether the court transfers venue, but the defendant need only travel if the case proceeds in Illinois).

B. The Interests of Justice

Lastly, the court considers whether the interest of justice would be better served in either district. *Long*, 187 F. Supp. 3d at 989. "The 'interest of justice' is a separate element of the transfer analysis that relates to the efficient administration of the court system." *Rsch. Auto.*, 626 F.3d at 978. Factors considered in this analysis include docket congestion and the likely speed to trial in the transferor and transferee forums, each court's familiarity with relevant law, the desirability of resolving controversies in each locale, and the relationship of each community to the controversy. *Id.* (citations omitted). "The interest of justice may be determinative, warranting transfer or its denial even where the convenience of the parties and witnesses points toward the opposite result." *Id.* (citing *Coffey*, 796 F.2d at 220-21).

According to Federal Judicial Caseload Statistics, this District has a higher caseload than the Western District of Washington (as of June 30, 2022, 11,835[3] compared to 2,928); fewer judges (five compared to seven); and a longer median time to trial (39.9 months compared to 35.3). (Filing No. 39-1, Fischer Decl. Ex. 1). While both courts are familiar with patent and trademark law, the Western District of Washington has a far greater interest in this dispute. That is the location of Brooks' headquarters and the situs of material events. Transfer will also promote the efficient administration of the court system, since courts in the Western District of Washington have previously adjudicated cases involving Brooks' intellectual property rights and continue to do so. *See, e.g.*, *Brooks Sports, Inc. v. Sparc Grp. LLC, et al.*, 2:20-cv-1491 (W.D. Wash. 2020) (trademark dispute); *Townsend v. Brooks Sports, Inc.*, 2:17-cv-01322 (W.D. Wash. 2017) (patent dispute); *Brooks Sports, Inc. v. Fred Meyer Stores, Inc.*, 2:12-cv-01815 (W.D. Wash. 2012) (trademark dispute); *Brooks Sports, Inc. v. Adidas AG, et al.*, 2:11-cv-00937 (W.D. Wash. 2011) (trademark dispute). Taken together, the public interest factors strongly favor transfer to the Western District of Washington.

III. Conclusion

For the foregoing reasons, Defendant's Motion to Transfer Venue (Filing No. 38) is **GRANTED**. The Clerk is **ORDERED** to transfer this case to the Western District of Washington.

SO ORDERED this 20th day of January 2023.

RICHARD L. YOUNG, JUDGE
United States District Court
Southern District of Indiana

[3] This number is skewed due to the *Cook Medical* MDL which, as of June 30, 2022, had 8,432 pending cases.

Distributed Electronically to Registered Counsel of Record.