

# IN THE SUPREME COURT OF TEXAS

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No. 10-0141

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VERNON F. MINTON , PETITIONER,

v.

JERRY W. GUNN, INDIVIDUALLY, WILLIAMS SQUIRE & WREN, L.L.P., JAMES E. WREN, INDIVIDUALLY, SLUSSER & FROST, L.L.P., WILLIAM C. SLUSSER, INDIVIDUALLY, SLUSSER WILSON & PARTRIDGE, L.L.P., AND MICHAEL E. WILSON, INDIVIDUALLY, RESPONDENTS

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ON PETITION FOR REVIEW FROM THE  
COURT OF APPEALS FOR THE SECOND DISTRICT OF TEXAS

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**Argued March 1, 2011**

JUSTICE GUZMAN, joined by JUSTICE MEDINA and JUSTICE WILLETT, dissenting.

Our system of justice has a “deep-rooted historic tradition that everyone should have his own day in court,” *Martin v. Wilks*, 490 U.S. 755, 762 (1989) (quotation marks omitted), but there is no right to a second day in a different court. By adopting the approach of the Federal Circuit instead of the United States Supreme Court, the Court allows a defeated litigant to undeservedly hit the “reset” button on his failed legal malpractice case. The defendants, having won on the merits in state court, must now repeat a no doubt costly and time-consuming defense all over again in federal court, a result not required by the mainstream of federal question jurisprudence.

In concluding that there is exclusive federal jurisdiction over this case, the Court principally relies on a pair of Federal Circuit cases, with additional support from a Fifth Circuit case. *See USPPS, Ltd. v. Avery Dennison Corp.*, 647 F.3d 274 (5th Cir. 2011); *Immunocept, LLC v. Fulbright & Jaworski, LLP*, 504 F.3d 1281 (Fed. Cir. 2007); *Air Measurement Techs., Inc. v. Akin Gump Strauss Hauer & Feld, L.L.P.*, 504 F.3d 1262 (Fed. Cir. 2007). The two Federal Circuit opinions were written by the same judge, for the same three-judge panel, and issued on the same day. The Fifth Circuit's position in *USPPS* appears to have been primarily driven by those two opinions. Collectively, these opinions represent a novel method of determining federal question jurisdiction, and one which this Court should not adopt.

Contrary to the Federal Circuit's reasoning in *Air Measurement* and *Immunocept*, federal question jurisprudence requires a more nuanced approach than the version found in these two cases, and implicitly adopted today by this Court. The United States Supreme Court mandates that courts conduct a four-part inquiry before finding federal question jurisdiction in embedded federal issue cases. *See Grable & Sons Metal Prods. v. Darue Eng'g & Mfg.*, 545 U.S. 308, 314 (2005). More specifically, a persuasive Fifth Circuit precedent, conducting that very inquiry, indicates that a legal malpractice case that touches upon federal intellectual property law should nonetheless remain under the jurisdiction of state courts. *See Singh v. Duane Morris LLP*, 538 F.3d 334, 340 (5th Cir. 2008). Yet, in *Air Measurement* and *Immunocept*, the Federal Circuit failed to conduct more than a cursory attempt at applying the *Grable* factors.

Only opinions of the United States Supreme Court are binding on this Court. *See Penrod Drilling Corp. v. Williams*, 868 S.W.2d 294, 296 (Tex. 1993). Therefore, we are not required to

follow the Federal Circuit's view of federal patent jurisdiction. We are, however, bound to follow the Supreme Court's pronouncements, *id.*, and they fully support the conclusions drawn by the Fifth Circuit in *Singh* and the court of appeals' judgment in the instant case. The Supreme Court's federal question precedents require that we reject Minton's assertion of exclusive federal jurisdiction over this case, and, with the exception of *Singh*, the circuit cases on point are contrary to the Supreme Court's opinions and unpersuasive on this point of law. Because federal question jurisprudence does not require the result reached by the Court today, I respectfully dissent.

## **I. Analysis**

Unlike the courts of this state, federal courts are courts of limited jurisdiction, and thus "due regard for the constitutional allocation of powers between the state and federal systems requires a federal court scrupulously to confine itself to the jurisdiction conferred on it by Congress and permitted by the Constitution." *In re Carter*, 618 F.2d 1093, 1098 (5th Cir. 1980). There are two main types of federal jurisdiction: diversity jurisdiction, and federal question jurisdiction, often also referred to as "arising under" jurisdiction because of the governing constitutional and statutory language. *See* ERWIN CHEMERINSKY, FEDERAL JURISDICTION 266 (5th ed. 2007). Federal question jurisdiction is in turn subdivided into (1) cases in which federal law provides a cause of action, and (2) state-law claims that implicate a federal issue. *Grable*, 545 U.S. at 312. It is this latter subtype, often referred to as "embedded" federal-issue cases, CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3562 at 187 (3d ed. 2008), that is at issue here.

One area of federal question jurisdiction, encompassing both subtypes described above, is that covering federal intellectual property law, as established by section 1338(a) of the United States

Code.<sup>1</sup> *See* 28 U.S.C. § 1338(a). Specifically, section 1338(a) gives federal courts jurisdiction over cases “arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks.” *Id.* That jurisdiction is exclusive for patent, plant variety protection, and copyright cases. *Id.* Speaking to patent cases particularly, the Supreme Court has explained that section 1338(a) applies:

[O]nly to those cases in which a well-pleaded complaint establishes either that federal patent law creates the cause of action or that the plaintiff’s right to relief necessarily depends on resolution of a substantial question of federal patent law, in that patent law is a necessary element of one of the well-pleaded claims.

*Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 809 (1988) (citations omitted).

The above quote is the point of departure for the Court today, and also for the Federal Circuit cases the Court relies on. However, the full inquiry when determining federal question jurisdiction is not so simple: the well-pleaded complaint must “necessarily raise a stated federal issue, actually disputed and substantial, which a federal forum may entertain without disturbing any congressionally approved balance of federal and state judicial responsibilities.” *Grable*, 545 U.S. at 314. In other words, it is *not* enough that the federal issue constitute an element of the plaintiff’s well-pleaded complaint. *See id.* at 313 (“[E]ven when the state action discloses a contested and substantial federal question, the exercise of federal jurisdiction is subject to a possible veto.”); *Singh*, 538 F.3d at 338 (“The fact that a substantial federal question is necessary to the resolution of a state-law claim is not sufficient to permit federal jurisdiction . . .”). Rather, the Supreme Court has laid

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<sup>1</sup> Although much of the Supreme Court’s federal question jurisprudence is in the context of the more general federal question statute, 28 U.S.C. § 1331, sections 1331 and 1338 both have the phrase “arising under” as their operative language, and the Supreme Court applies section 1331 precedent to section 1338 cases. *See Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808–09 (1988); *Air Measurement*, 504 F.3d at 1271.

out a four-element test for determining whether federal question jurisdiction is proper over a state-law claim with an embedded federal issue (such as this case): “federal question jurisdiction exists where (1) resolving a federal issue is necessary to resolution of the state-law claim; (2) the federal issue is actually disputed; (3) the federal issue is substantial; and (4) federal jurisdiction will not disturb the balance of federal and state judicial responsibilities.” *Singh*, 538 F.3d at 338 (interpreting *Grable*, 545 U.S. at 314). Explicating the final element, the Supreme Court explains that “the federal issue will ultimately qualify for a federal forum only if federal jurisdiction is consistent with congressional judgment about the sound division of labor between state and federal courts.” *Grable*, 545 U.S. at 314. The Supreme Court further requires: “[T]here must always be an assessment of any disruptive portent in exercising federal jurisdiction.” *Id.* As the Supreme Court explained, “[t]he doctrine captures the commonsense notion that a federal court ought to be able to hear claims recognized under state law that nonetheless turn on substantial questions of federal law, and thus justify resort to the experience, solicitude, and hope of uniformity that a federal forum offers on federal issues.” *Id.* at 312.

*Grable* is a landmark case in this area of jurisprudence, and it should be the touchstone for any court’s analysis of whether embedded question jurisdiction is proper. *See* CHARLES ALAN WRIGHT ET AL., *FEDERAL PRACTICE AND PROCEDURE* § 3562 at 197–99 (3d ed. 2008) (“In 2005, the Supreme Court issued its finest effort in this line of cases . . . . In *Grable*, the Court for the first time discussed comprehensively the relevant factors for assessing [embedded question jurisdiction]. . . .

Grable brings considerable clarity to what had been quite muddled.”). I therefore turn to the analysis required of this Court by *Grable*.<sup>2</sup>

In this case, only the first of the *Grable* elements is potentially met; the other three are not. The federal issue here is neither disputed nor substantial, and the exercise of exclusive federal jurisdiction over cases such as this would disrupt the proper balance between the state and federal judiciaries intended by Congress. I address each element in turn.

#### **A. Federal Issue Is Not Disputed**

First, the federal issue is not in dispute. The Court and the Federal Circuit have read this element of the *Grable* test as simply requiring some live controversy, effectively making it a mootness requirement. But a review of the roots of the element reveal its true meaning: for the federal issue to be “disputed” under *Grable*, there must be a controversy as to the “‘validity, construction, or effect’” of the federal issue. *Grable*, 545 U.S. at 315 n.3 (quoting *Shulthis v. McDougal*, 225 U.S. 561, 570 (1912)). The Supreme Court noted “the limiting effect of the requirement that the federal issue in a state-law claim must actually be *in dispute* to justify federal-question jurisdiction,” and cited *Shulthis* as an example where “this Court found that there was no federal-question jurisdiction to hear a plaintiff’s [state law] claim in part because the federal statutes on which [the claim] depended were not subject to ‘any controversy respecting their validity, construction, or effect.’” *Id.* (quoting *Shulthis*, 225 U.S. at 570) (emphasis added).

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<sup>2</sup> The Court makes a good faith effort of its own to apply *Grable*, but the outcome of that effort is incorrect because it is conducted through the lens of *Air Measurement* and *Immunocept*.

Here, there is no such controversy. The experimental use exception is well-established in meaning and scope. See *Elizabeth v. Pavement Co.*, 97 U.S. 126, 134–35 (1877) (establishing the exception in 1877); *Electromotive Div. of Gen. Motors Corp. v. Transp. Sys. Div. of Gen. Elec. Co.*, 417 F.3d 1203, 1210–18 (Fed. Cir. 2005) (applying it in its modern form). The parties do not dispute its meaning; they simply dispute whether it was available as a defense in the original patent infringement suit. And that dispute turns on whether the TEXCEN lease concluded between Minton and R.M. Stark & Co. was experimental or commercial in nature—a question to be resolved by reference to the lease and the conduct of the parties, rather than a disputed construction of federal law.

#### **B. Federal Issue Is Not Substantial**

The federal issue is also not substantial. The Supreme Court has explained that federal question jurisdiction based on federal law being a “necessary element” of the complaint is limited to a “special and small category” of cases, *Empire Healthchoice Assurance, Inc. v. McVeigh*, 547 U.S. 677, 699 (2006) (citations omitted), and that “it takes more than a federal element ‘to open the “arising under” door,’” *id.* at 701 (quoting *Grable*, 545 U.S. at 313). The Court emphasized that *Grable*, in which interpretation of a federal statutory notice provision was at issue, presented an almost purely legal issue, one whose resolution would both be dispositive in that case, and “controlling in numerous other cases.” *Id.* at 700 (citing *Grable*, 545 U.S. at 313). It was also significant that *Grable* “centered on the action of a federal agency (IRS) and its compatibility with a federal statute,” thus making the issue ““substantial.”” *Id.* (citing *Grable*, 545 U.S. at 313). The Supreme Court has also drawn a line between federal statutory construction issues and other issues

such as federal common law. In *Empire*, the United States asserted that the federal issue of whether an insurer’s recovery of amounts paid to an insured as a result of an accident should take into account the insured’s attorney’s fees in obtaining the initial recovery. *Id.* at 701. While the Supreme Court conceded that may be an issue, it refused to find federal jurisdiction because “it is hardly apparent why a proper ‘federal-state balance’ would place such a nonstatutory issue under the complete governance of federal law, to be declared in a federal forum.” *Id.* (citation omitted). The Supreme Court also re-affirmed that state courts are “competent to apply federal law, to the extent it is relevant,” in deciding actions under their jurisdiction. *See id.*

Here, the federal issue is not substantial for three reasons the Supreme Court has outlined: (1) the determination is one of fact—not law; (2) it will not result in precedent that controls numerous other cases; and (3) it involves federal common law, not a federal statute. First, the federal issue is whether the experimental use exception was legally and factually available to Minton’s attorneys in the underlying patent infringement case. The answer to this question is purely factual and turns on the nature of the TEXCEN lease between Minton and R.M. Stark & Co.: was that particular lease for experimental purposes (thus making the exception available) or for commercial ends (rendering it unavailable)? Because the federal issue is one of fact, it is not substantial. *See Empire*, 547 U.S. at 700–01 (noting that *Grable* claim was subject to federal jurisdiction because it was a “nearly pure issue of law” but that claim at issue in *Empire* was not subject to federal jurisdiction because it was “fact-bound and situation-specific”). Second, the experimental use exception is well defined. It need only be applied to the facts of this case. A determination of whether the experimental use exception applies to the lease will not result in an



important precedent. *Id.* at 700 (citing *Grable*, 545 U.S. at 313) (noting that *Grable* claim was subject to federal jurisdiction because it “would be controlling in numerous other cases” but that claim at issue in *Empire* was not subject to federal jurisdiction because the bottom-line practical issue was the share of settlement property from a state court proceeding). Third, the experimental use exception is a creature of federal common law, not of any statute. *See id.* (noting that *Grable* claim was subject to federal jurisdiction because it involved a federal statute and IRS action but that claim at issue in *Empire* was not subject to federal jurisdiction because it involved a federal common law determination in a state law claim). Because the federal issue here is one of fact (not law), will not control numerous other cases, and involves only federal common law and not a federal statute, the federal issue here is not substantial.

### **C. The Court’s Holding Upsets the Division Between Federal and State Courts**

Finally, the Court’s holding today upsets the division between federal and state courts envisioned by Congress. Legal malpractice, along with the regulation of the practice of law generally, has traditionally been a matter for the states. *See Singh*, 538 F.3d at 339 (“Legal malpractice has traditionally been the domain of state law, and federal law rarely interferes with the power of state authorities to regulate the practice of law.”). It was not the purpose of Congress to encroach on this state sphere when it enacted section 1338; rather, the plain language of the statute simply indicates an intent to assure federal jurisdiction over, and uniform interpretation of, federal intellectual property law. It is only under the gloss applied to that language by later decisions of the Federal Circuit that we could imagine that a legal malpractice action “arises under” patent law.

Common sense tells us that this is a matter for state courts. And our sense on this matter is confirmed by the oft-quoted wisdom of Justice Cardozo:

What is needed is something of that common-sense accommodation of judgment to kaleidoscopic situations which characterizes the law in its treatment of causation. . . . If we follow the ascent far enough, countless claims of right can be discovered to have their source or their operative limits in the provisions of a federal statute or in the Constitution itself with its circumambient restrictions upon legislative power. To set bounds to the pursuit, the courts have formulated the distinction between controversies that are basic, and those that are collateral, between disputes that are necessary and those that are merely possible.

*Gully v. First Nat. Bank in Meridian*, 299 U.S. 109, 117–18 (1936), *quoted with approval in Grable*, 545 U.S. at 313.

In Justice Cardozo’s terms, the federal issue here is collateral, not basic. This is a legal malpractice case, litigated after final judgment in the original, federal case. Resolution of the malpractice claim in question does not impact any live patent law claims. *Cf. Singh*, 538 F.3d at 341 (noting that a legal malpractice action “will in no way disturb or interfere with the judgments of the federal courts” regarding the underlying federal intellectual property lawsuit). Moreover, it is unlikely that the legal malpractice opinions of Texas courts will in any way disrupt the uniformity of patent law that Congress sought by enacting section 1338; on the merits of actual patent lawsuits, federal courts will no doubt look first to federal patent precedents, not Texas legal malpractice cases.

Unfortunately, the Federal Circuit has not remained faithful to the Supreme Court’s federalism inquiry in the context of malpractice decisions arising from patent cases. Instead, under the Federal Circuit’s approach, the federalism element is simply an invocation of the need for uniformity in patent law. In *Air Measurement*, the federalism discussion was limited to the benefits

of a federal forum, the need for uniformity in patent law, and the fact that patents are issued by a federal agency. *See Air Measurement*, 504 F.3d at 1272. There was no consideration of what effect asserting exclusive federal jurisdiction would have over the balance between the state and federal judiciaries intended by Congress. *See id.*; *see also USPPS* 647 F.3d at 281 n.4 (“*Air Measurement Technologies* is silent as to the *Grable* question of federalism . . .”). Rather, the court simply noted “[i]n § 1338, Congress considered the federal-state division of labor and struck a balance in favor of this court’s entertaining patent infringement.” *Air Measurement*, 504 F.3d at 1272. Of course, there is no doubt that Congress wants the Federal Circuit to “entertain[] patent infringement,” but that is not the issue under *Grable*’s federalism analysis: what is required is a consideration of the impact on our federal system.

In *Immunocept*, application of the *Grable* factors, and particularly the federalism analysis, was equally cursory. The Federal Circuit concluded that the federalism element was met simply because litigants benefit from the expertise of federal judges, and Congress intended to “remove non-uniformity in the patent law.” *Immunocept*, 504 F.3d at 1285–86. Again, there was no consideration of the impact on the balance between state and federal courts, as required by the Supreme Court in precedents such as *Grable* and *Empire*.<sup>3</sup>

This is particularly disheartening given the potential consequences on the division between state and federal courts beyond the purview of patent disputes. The impact of the Court’s decision

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<sup>3</sup> In *Davis v. Brouse McDowell, L.P.A.*, 596 F.3d 1355 (Fed. Cir. 2010), a legal malpractice case derived from a patent application, the Federal Circuit went even further and neither cited *Grable* nor mentioned its factors at all. *See generally id.* This approach was repeated in *Warrior Sports*, another patent-law legal malpractice case, which likewise made no mention of *Grable* or federalism. *See generally Warrior Sports, Inc. v. Dickinson Wright, P.L.L.C.*, 631 F.3d 1367 (Fed. Cir. 2011).

on other potential types of embedded question cases is relevant in conducting the federalism inquiry required in this case. *See Grable*, 545 U.S. at 317 (“[I]n exploring the outer reaches of § 1331, determinations about federal jurisdiction require sensitive judgments about congressional intent, judicial power, and the federal system.”) (quoting *Merrell Dow Pharm. Inc. v. Thompson*, 478 U.S. 804, 810 (1986)). In *Merrell Dow*, the Supreme Court found the federal balance was upset in a case, as here, where there was no federal cause of action. *See Grable*, 545 U.S. at 318–19. The Court noted that asserting federal jurisdiction over the state law claim at issue “would have attracted a horde of original filings and removal cases raising other state claims with embedded federal issues.” *Id.* at 318. “For if the federal labeling standard without a federal cause of action could get a state claim into federal court, so could any other federal standard without a federal cause of action. And that would have meant a tremendous number of cases.” *Id.*

This point is telling, because the Supreme Court’s fears have already been realized in *USPPS*. There, the Fifth Circuit adopted the reasoning applied by the Federal Circuit in *Air Measurement* and *Immunocept* to reach the same outcome in a fraud and breach of fiduciary duty case involving patent law. *See USPPS*, 647 F.3d at 284.<sup>4</sup> Put another way, the reach of the Federal

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<sup>4</sup> Although the Fifth Circuit previously expressed skepticism about the Federal Circuit’s approach, and declined to apply it to a legal-malpractice case involving trademarks and section 1338, *see Singh*, 538 F.3d at 340, it recently adopted the *Air Measurement/Immunocept* reasoning, *see USPPS*, 647 F.3d at 278–81. Although *USPPS* mentioned the treatment of *Grable* (described above) found in *Air Measurement* and *Immunocept*, and promised to be “sensitive” to federalism issues, *see id.* at 278 n.1, *USPPS* contains no federalism analysis of its own. *See generally id.* Rather, the *USPPS* opinion simply quoted *Immunocept* on the federal interest in patent law uniformity, and then applied as binding precedent the Fifth Circuit’s own opinion in *Scherbatskoy v. Halliburton Co.*, 125 F.3d 288, 291 (5th Cir. 1997). *See USPPS*, 647 F.3d at 282. *Scherbatskoy* in turn conducted no federalism analysis, *see* 125 F.3d at 291; but that is unsurprising because it was decided some eight years *prior* to *Grable*. Given *Grable*’s landmark status, it is thus curious that *USPPS* relies so heavily on *Scherbatskoy* on this point. Other than stating “[i]n so holding, we conform . . . to *Singh*’s requirement of balancing the federal and state interests involved,” *USPPS* made no other analysis of the *Grable* factors, thus carrying forward the Federal Circuit’s misguided approach. 647 F.3d at 282.

Circuit’s section 1338 reasoning is uncabined, and can potentially sweep any state law case that touches on substantive patent law (or, for that matter, the other areas of law covered by section 1338, such as copyright and trademarks) irrevocably into federal court.

In contrast to *Air Measurement* and *Immunocept*, *Singh* correctly applied the Supreme Court’s federal question jurisprudence governing embedded question cases to a section 1338 trademark legal malpractice case, with a proper analysis of the federalism element. *Singh* discussed at length the *Grable* factors of substantialness and federalism. *See Singh*, 538 F.3d at 337–41. As for the first, the court noted that trademark law has an entirely different purpose from state malpractice law, and further that the trademark issue in question was predominantly one of fact, not law, rendering the trademark issue insubstantial under *Grable*. *Id.* at 339. *Singh* then conducted a careful and substantive federalism analysis, one that considered the impact on the division of labor between state and federal courts. *See id.* at 339–40. The court observed that legal malpractice traditionally is a state law matter, and that “federal law rarely interferes with the power of state authorities to regulate the practice of law.” *Id.* at 339. The court further observed that exerting federal jurisdiction would “constitute a substantial usurpation of state authority in an area in which states have traditionally been dominant.” *Id.* The court also expressed concern, echoing the Supreme Court’s fears in *Grable* and *Merrell Dow*, that adopting such reasoning in one type of federal question case could lead to its application in other types of embedded question cases.<sup>5</sup> *See*

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<sup>5</sup> The *Singh* court is certainly not the only court to have examined the *Grable* factors and concluded that there is no exclusive federal jurisdiction over claims such as this. *See, e.g., New Tek Mfg., Inc. v. Beehner*, 702 N.W.2d 336 (Neb. 2005) (finding no federal jurisdiction over malpractice claim and holding “[w]hen patent issues are merely implicated incidentally in a cause of action, however, federal courts do not have jurisdiction of the case pursuant to § 1338”); *E-Pass Tech., Inc. v. Moses & Singer, LLP*, 189 Cal. App. 4th 1140, 1152 (Cal. Ct. App. 2010), review denied (Feb. 23, 2011) (finding no federal jurisdiction over malpractice claim and holding that “to the

*id.* at 340 (“Because all Texas malpractice plaintiffs must prove that they would have prevailed in their prior suits, federal jurisdiction could extend to every instance in which a lawyer commits alleged malpractice during the litigation of a federal claim.”). As mentioned previously, this concern has ironically been borne out in *USPPS*, a subsequent Fifth Circuit case that applied the Federal Circuit’s reasoning in patent law malpractice cases to a fraud and breach of fiduciary duty case. *See USPPS*, 647 F.3d at 278–81.

In sum, the cases relied on by the Court are not persuasive authority because they either ignore the standard required by United States Supreme Court precedent or apply it in a conclusory manner. The Court therefore errs when it concludes, based on the importance of uniformity in patent law emphasized in *Air Measurement* and *Immunocept*, that the balance between state and federal courts is not upset by allowing jurisdiction here.

## **II. Conclusion**

The Federal Circuit has pursued a particular mandate—to achieve uniformity in patent law. *Panduit Corp.*, 744 F.2d at 1574 (“This court . . . has a mandate to achieve uniformity in patent matters.”). The Federal Circuit appears to be animated by this goal when finding section 1338

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extent that the subject matter of patent law is relevant to the determination of the professional negligence claim, it does not present a question of patent law that is substantial”) (citations omitted); *Roof Technical Servs., Inc. v. Hill*, 679 F. Supp. 2d 749, 753–54 (N.D. Tex. 2010) (finding no federal jurisdiction over malpractice claim and holding “even if the court must decide patent law issues, those decisions will not create or destroy any patent rights such that uniformity in the way patents are issued or enforced will be threatened”); *Genelink Biosciences, Inc. v. Colby*, 722 F. Supp. 2d 592 (D. N.J. 2010) (finding no federal jurisdiction over malpractice claim involving patent law); *Danner, Inc. v. Foley & Lardner, LLP*, No. 09-1220-JE, 2010 WL 2608292, at \*5 (D. Or. Mar. 15, 2010) (finding no federal jurisdiction over malpractice claim and holding that because “plaintiff’s malpractice claim . . . is supported by theories that do not depend on patent law or the resolution of patent issues, its claim does not ‘arise’ under patent laws”); *Anderson v. Johnson*, No. 08-CV-6202, 2009 WL 2244622, at \*3 (N.D. Ill. July 27, 2009) (finding no federal jurisdiction over malpractice claim and holding that a “federal court’s adjudication of [a] state malpractice claim [involving copyright law] would disturb the balance of federal and state judicial responsibilities”).

jurisdiction over state legal malpractice claims. *See Immunocept*, 504 F.3d at 1285; *Air Measurement*, 504 F.3d at 1272. The Federal Circuit’s focus on this mandate is understandable, but uniformity in patent law is not the be-all and end-all of jurisprudence. It must give way to the contours of federal question jurisdiction provided by the Supreme Court. *See Grable*, 545 U.S. at 312–15. In turn, this Court has its own mandate, of at least equal importance to that of the Federal Circuit. We owe a duty to the people of this state to exercise the judicial power, *see* TEX. CONST. art. V, §§ 1, 3, and that duty includes vital matters such as ensuring consistency and certainty in the civil law of the state, *see* TEX. GOV’T CODE § 22.001, and regulating the practice of law, *id.* § 81.011(c). Accordingly, we should not risk the confusion and inconsistency that will result from having two sets of binding precedent in Texas legal malpractice law—one stemming from this Court and the other courts of this state, and another, entirely outside of our control after today’s opinion, developing under the direction of the Federal Circuit, largely uninformed by the deep roots of Texas jurisprudence and the requirements of the Texas Constitution.

This Court should not be quick to follow Federal Circuit case law that fails to follow the test set forth by the Supreme Court. Because this case fails to meet three of the four elements required by the Supreme Court for federal-element “arising under” jurisdiction, the court of appeals was correct when it held that exclusive federal patent jurisdiction does not lie here. I therefore respectfully dissent.

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Eva M. Guzman  
Justice

**OPINION DELIVERED: December 16, 2011**