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WHAT DOES FORUM SHOPPING IN THE EASTERN DISTRICT OF TEXAS MEAN  
FOR PATENT REFORM?

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## ABSTRACT

The Eastern District of Texas has recently become a rocket docket for patent litigation owing to the adoption of Judge T. John Ward's local patent rules. However, the disproportional amount of patent cases filed in the Eastern District is evidence of plaintiffs forum shopping. Notwithstanding the benefit of forum shopping in creating, by default, patent law expertise in certain district courts, the existence of forum shopping illuminates the reality that patent law application is not uniformly applied throughout the district courts. This comment proposes a mandatory post-grant opposition proceeding occurring at the Board of Patent Appeals and Interferences of the Patent and Trademark Office when a defendant in a patent infringement case claims invalidity as an affirmative defense. The unification of patent law application would result because all district courts would defer to the Board's finding under an administrative standard of review, after which, there would be no incentive to forum shop.

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# WHAT DOES FORUM SHOPPING IN THE EASTERN DISTRICT OF TEXAS MEAN FOR PATENT REFORM?

ALISHA KAY TAYLOR\*

## INTRODUCTION

The Eastern District of Texas has a meager population and is home to neither major businesses nor metropolitan areas.<sup>1</sup> Yet, the district court has become the new rocket docket<sup>2</sup> for patent cases thanks to Judge T. John Ward.<sup>3</sup> The administration of strict local procedural rules forcing parties to engage in early discovery and adhere to firm trial dates contributes to the docket's efficiency and appeal.<sup>4</sup> In determining in which forum to bring suit, plaintiffs are attracted to the Eastern District's local rules because they provide a quick system of resolving patent disputes, which reduces the cost of litigation.<sup>5</sup>

Under the current venue laws for patent cases, plaintiffs can establish personal jurisdiction over defendants in numerous district courts and, thus, have the opportunity to select the forum<sup>6</sup> most advantageous to their case.<sup>7</sup> When defendants are haled into court for a patent dispute, they have little means of obtaining a transfer to a court more receptive to their case.<sup>8</sup> Generally, the factors relevant to whether the court will grant a transfer under 28 U.S.C. § 1404(a)<sup>9</sup> include convenience and location of the witnesses and the accessibility and location of sources

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<sup>1</sup> Andrew DiNovo & Michael Smith, *The New Spindletop-the Patent Litigation Boom in the Eastern District of Texas*, ST. B. OF TEX., INTELL. PROP. L. SEC., Winter 2006, at 5.

<sup>2</sup> BLACK'S LAW DICTIONARY 1354 (8th ed. 2004). A rocket docket is "a judicial district known for its speedy disposition of cases."

<sup>3</sup> See Tresa Baldas, *Texas IP Rocket Docket Headed for Burnout?*, LAW.COM (Dec. 28, 2004) <http://www.law.com/jsp/article.jsp?id=1103549728998> (last visited Mar. 23, 2007). District Judge T. John Ward joined the bench in 1999 and created the patent rocket docket by adopting rules with strict trial dates and discovery deadlines. *Id.*

<sup>4</sup> Michael C. Smith, "Patent Pirates" Only Exist in Neverland, TEXAS LAWYER, 30, Oct. 11, 2004.

<sup>5</sup> See Sam Williams, *A Haven for Patent Pirates: In One Federal Court in East Texas, Plaintiffs Have Such an Easy Time Winning Patent-Infringement Lawsuits Against Big-tech Companies that Defendants Often Chose to Settle Rather than Fight*, TECHNOLOGY REVIEW, Feb 3, 2006, [http://www.technologyreview.com/read\\_article.aspx?id=16280&ch=infotech](http://www.technologyreview.com/read_article.aspx?id=16280&ch=infotech).

<sup>6</sup> BLACK'S LAW DICTIONARY 681 (8th ed. 2004). Forum shopping is "the practice of choosing the most favorable jurisdiction in which a claim might be heard." *Id.*

<sup>7</sup> See generally Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 N.C.L. REV. 889 (2001).

<sup>8</sup> See *Connectel v. Cisco Sys., Inc.*, No. 2:04-CV-396, 2005 U.S. Dist. LEXIS 2252, at \*6 (E.D. Tex. Feb. 16, 2005) ("[T]he plaintiffs choice of forum is nonetheless entitled to some deference.").

<sup>9</sup> 28 U.S.C. § 1404(a) (2006) ("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.").

or proof.<sup>10</sup> However, these factors are not as prevalent in patent cases, where a multitude of districts would be equally convenient for both parties.<sup>11</sup>

Patent cases are not evenly dispersed throughout the district courts, which suggests that patent holders are forum shopping by choosing to bring suit in certain districts and not others.<sup>12</sup> The very existence of forum shopping suggests a lack of uniformity in the legal system.<sup>13</sup> The question becomes to what extent, if any, the lack of uniformity should be corrected.

This comment addresses the popularity of the Eastern District of Texas with regard to forum shopping and the ramifications it has on patent reform. Section I presents the local rules of the Eastern District of Texas, the history of venue and jurisdiction in patent cases, and the present application of venue statutes. Section I also presents the well established policy against forum shopping. Section II analyzes the policy ramifications in favor of forum shopping in the rocket docket. Section II also analyzes transfer of venue cases in the Eastern District, which support the policy in favor of forum shopping. Section III proposes possible solutions to unify the application of patent law throughout all of the district courts. Finally, Section IV concludes by recommending the most advantageous solution to decrease forum shopping.

## I. BACKGROUND

Part A of this section discusses of the origin of the local patent rules in the Northern District of California. Part B addresses the patent rules of the Eastern District of Texas. Part C discusses the history of jurisdiction and venue in patent litigation. Finally, Part D presents policy in favor of and against forum shopping.

### A. *Origin of the Local Patent Rules*

The 1983 amendments to the Federal Rules of Civil Procedure pertaining to Rule 16 permit courts to adopt local rules, which encourage local district courts to become more involved in litigation in order to promote judicial efficiency.<sup>14</sup> Under the amendments, a judge may regulate his courtroom in any manner consistent with the federal law and the local rules of the court.<sup>15</sup>

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<sup>10</sup> *Connectel*, 2005 U.S. Dist. LEXIS 2252, at \*5 (discussing the factors the court considers in motions to transfer including “(a) plaintiff’s choice of forum, (b) convenience and location of witnesses and the parties, (c) cost of obtaining the attendance of witnesses and other trial costs, (d) place of the alleged wrong, (e) accessibility and location of sources of proof, and (f) delay and prejudice if transfer is granted.”).

<sup>11</sup> *See id.* (“Given that patent cases like this involve battles of documents and technical experts scattered across the nation, [accessibility and location of sources of proof] is immaterial and thus does not favor transfer.”).

<sup>12</sup> Moore, *supra* note 7, at 892.

<sup>13</sup> *See* Moore, *supra* note 7, at 893.

<sup>14</sup> FED. R. CIV. P. 16 advisory committee’s note (“permits each district court to promulgate a local rule under Rule 83 exempting certain categories of cases in which the burdens of scheduling orders exceed the administrative efficiencies that would be gained.”).

<sup>15</sup> FED. R. CIV. P. 83(b).

In 2000, the Northern District of California became the first court to adopt patent local rules.<sup>16</sup> The Northern District developed local rules to promote judicial efficiency specifically for patent litigation that govern trial practices.<sup>17</sup>

### *B. Eastern District of Texas Local Rules*

In 2001, Judge Ward adopted his own patent rules combining the Northern District of California's Patent Local Rules<sup>18</sup> with his own modifications designed to promote a more efficient judicial system.<sup>19</sup> In 2005, the Eastern District of Texas adopted uniform patent rules<sup>20</sup> that set forth specific schedules for discovery and patent-specific pretrial hearing.<sup>21</sup> There is little toleration for parties not following the local rules because every party receives a copy of the patent rules, which are attached to the court's scheduling order.<sup>22</sup> The patent rules enable the court to effectively manage its docket with an efficient pretrial process through local rules that are specific exceptions to the normal pretrial procedures found in the Federal Rules of Civil Procedure.<sup>23</sup>

One reason the patent rules of the Eastern District of Texas are efficient is that the rules direct the parties into a non-objecting discovery process.<sup>24</sup> Furthermore, the rules force the plaintiff to serve the opposing party a Disclosure of Asserted

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<sup>16</sup> Edward Brunet, *Markman Hearings, Summary Judgment, and Judicial Discretion*, 9 LEWIS & CLARK L. REV. 93, 109 (2005).

<sup>17</sup> See *Precision Shooting Equip. v. High Country Archery*, 1 F. Supp. 2d 1041, 1042 (D. Ariz. 1998); see also *Atmel Corp. v. Info. Storage Devices, Inc.*, No. C 95-1987 FMS, 1998 U.S. Dist. LEXIS 17564, at \*7 (N.D. Cal. Nov. 4, 1998). The Northern District of California noted the purpose of their patent rules was to "give claim charts more 'bite' [by] requir[ing] parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed." *Id.* See generally *E-Pass Tech., Inc. v. 3Com Corp.*, 222 F. Supp. 2d 1157, 1161 (N.D. Cal. 2002) (holding the plaintiff could not amend its initial infringement claims to add additional infringing claims after the *Markman* Hearing); *JSR Corp. v. Tokyo Ohka Kogyo Co.*, No. C 99-20156, 2001 U.S. Dist. LEXIS 24959, at \*18 (N.D. Cal. Sept. 13, 2001) (noting the purpose of the local patent rules in preventing parties from amending claim constructions was to discourage the injustice of parties shifting positions mid-trial).

<sup>18</sup> See Ellisen S. Turner, *Swallowing the Apple Whole: Improper Patent Use by Local Rule*, 100 MICH. L. REV. 640, 640-41 (2001) (noting not only are other districts adopting similar patent local rules, but the American Bar Association Section of Intellectual Property Law found the Northern District of California Local Rules to have considerable merit and used them as a basis for the ABA/IPL 1999 proposed resolution governing patent claim construction practice and procedure).

<sup>19</sup> See Alfonso Garcia Chan, *Proposed Patent Local Rules for Adoption by Texas' Federal District Courts*, 7 COMP. L. REV. & TECH. J. 149, 151 (2003) (discussing Ward's adoption of patent rules that modified local patent rules of the Northern District of California).

<sup>20</sup> General Order 05-08, Adopting Uniform Patent Rules (E.D. Tex. 2005), available at <http://www.txed.uscourts.gov/Rules/GeneralOrders/GeneralOrders.htm>. Compare Appendix F, Additional Provisions and Procedures for Inclusion in Discovery Orders entered in Patent Cases Pending Before T. John Ward (E.D. Tex. 2001), reprinted in Chan, *supra* note 19, at 214-19, with Appendix M, U.S. Dist. Ct. R. E.D. Tex. P.R. 2-5 [hereinafter *Tex. Rules*].

<sup>21</sup> *STMicroelectronics, Inc. v. Motorola, Inc.*, 307 F. Supp. 2d 845, 848 (E.D. TX 2004).

<sup>22</sup> *Id.*

<sup>23</sup> *Id.* at 849.

<sup>24</sup> *Tex. Rules*, *supra* note 20. A party cannot object to an opposing party's discovery request on account of the request being premature unless the request seeks a party's claim construction, the request seeks the patent claimant's comparison of the claims and the accused product, or the request seeks opinions of counsel. *Id.*

Claims document and Preliminary Infringement Contentions document.<sup>25</sup> These documents must specify each claim of each patent allegedly infringed, a chart identifying where each element of each asserted claim is found, and a determination of whether each element is literally infringed or infringed under the doctrine of equivalents.<sup>26</sup> Next, the defendant must compile all information the party intends on using in its defense to invalidate the plaintiff's claims.<sup>27</sup> Generally these two documents, the Preliminary Infringement Contentions and the Preliminary Invalidity Contentions, are binding on the parties throughout the litigation.<sup>28</sup> Because amendments are prohibited except by Court order,<sup>29</sup> the patent rules provide more efficiency since the parties are held to their original contentions, which result in less backtracking and more predictability.<sup>30</sup>

The strict rules pertaining to claim construction demonstrate another aspect of efficiency in the Eastern District. The procedural rules force the parties to work together to present a Joint Claim Construction and Prehearing Statement, which contains both parties' proposed construction of each disputed element within the claims.<sup>31</sup> Within thirty days after filing the Joint Claim Construction document to the court, the parties must complete all discovery relating to claim construction, including any depositions of witnesses.<sup>32</sup> At least ten days before the Claim Construction Hearing, the parties must jointly submit a claim construction chart to the court.<sup>33</sup>

The Eastern District strictly enforces the patent local rules. For example, in *STMicroelectronics, Inc. v. Motorola, Inc.*, the plaintiff failed to serve the opposing

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<sup>25</sup> *Tex. Rules*, *supra* note 20, at 3-1. U.S. Dist. Ct. E.D. Tex. P.R. 3-1. Disclosure of Asserted Claims and Preliminary Infringement Contentions. A party claiming patent infringement has ten days from the Initial Case Management Conference to serve the opposing party a Disclosure of Asserted Claims and Preliminary Infringement Contentions. *Id.*

<sup>26</sup> *Tex. Rules*, *supra* note 20, at 3-1. The Disclosure must include each claim of the patent in suit that is allegedly infringed and how the accused infringing device infringes the specified claim. *Id.* A claim chart is also required, which identifies where each element of the claim is found within each accused instrumentality. *Id.*

<sup>27</sup> *Tex. Rules*, *supra* note 20, at 3-3. Preliminary Invalidity Contentions. The party opposing a claim of patent infringement has forty-five days after it received the Disclosure of Asserted Claims and Preliminary Infringement Contentions to assert its claims of patent invalidity. *Id.* The Preliminary Invalidity Contentions must contain items of prior art that anticipate the patent at issue, assertions of whether the prior art anticipates the patent or renders it obvious, a chart comparing the prior art to the element of each asserted claim, and assertions of any grounds of invalidity based on enablement or written description in the patent. *Id.*

<sup>28</sup> *Tex. Rules*, *supra* note 20, at 3-6.

<sup>29</sup> *Tex. Rules*, *supra* note 20, at 3-7. Amendments are prohibited unless the party obtained a court order, which is only granted upon showing good cause. *Id.*

<sup>30</sup> *See* *Coopervision, Inc. v. CIBA Vision Corp.*, No. 2:06-CV-149, 2007 U.S. Dist. LEXIS 23812, at \*6 (E.D. Tex. Mar. 30, 2007) ("The Local Patent Rules 'exist to further the goal of full, timely discovery and provide all parties with adequate notice and information with which to litigate their cases, not to create supposed loopholes through which parties may practice litigation by ambush.'" (quoting *IXYS Corp. v. Advanced Power Tech., Inc.*, No. C 02-03942, 2004 U.S. Dist. LEXIS 10934, at \*3 (N.D. Cal. June 16, 2004))).

<sup>31</sup> *Tex. Rules*, *supra* note 20, at 4-2. The parties have twenty days after the service of the Preliminary Invalidity Contentions to exchange a list of claims terms and elements for construction. *Id.* *See also* P.R. 4-3 (stating no later than sixty days after the Preliminary Invalidity Contentions the parties must complete and file a Joint Claim Construction and Prehearing Statement, which contains both parties' proposed construction of each disputed claim).

<sup>32</sup> *Tex. Rules*, *supra* note 20, at 4-4.

<sup>33</sup> *Tex. Rules*, *supra* note 20, at 4-5. *See Tex. Rules*, *supra* note 20, at 4-6 (stating the Claim Construction Hearing will take place two weeks following the reply brief, subject to the convenience of the court).

party a list of each claim of each patent in the suit that allegedly infringed within ten days from the Initial Case Management Conference as required by the patent local rules.<sup>34</sup> The court held the patent rules are court orders to control the docket and litigants are not free to ignore them without an order from the court and upon showing of good cause.<sup>35</sup>

### C. History of Patent Jurisdiction and Venue

Federal district courts have exclusive subject matter jurisdiction over all patent cases pursuant to 28 U.S.C. § 1338.<sup>36</sup> A patent holder can only initiate suit in any district court with proper venue and where the defendant is subject to personal jurisdiction.<sup>37</sup>

First, venue for patent cases is defined in 28 U.S.C. § 1400(b), which provides two options for proper venue: (1) where the defendant resides and (2) where the defendant commits infringement and maintains an established place of business.<sup>38</sup> The Supreme Court, in *Fourco Glass Co. v. Transmirra Products Corp.*,<sup>39</sup> held that § 1400(b) is the exclusive provision that controls venue in patent infringement cases and § 1400(b) is not to be broadened by the application of § 1391(c),<sup>40</sup> which extends venue to cover any place the corporation does business.<sup>41</sup> *Fourco* limited the places the plaintiff could file suit to the district where the defendant resides and for a corporate defendant, where the company was incorporated.<sup>42</sup>

However, thirty-one years after *Fourco*, Congress amended 28 U.S.C. § 1391(c) to read “[f]or purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced.”<sup>43</sup> In *VE Holding Corp. v. Johnson Gas Appliance Co.*, the Federal Circuit determined the 1988 congressional amendment adopting a new definition of “reside” for corporate defendants changed the interpretation of not only the general venue statute of § 1391, but also of the patent venue statute of § 1400(b).<sup>44</sup> *VE Holding Corp.* greatly increased the options

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<sup>34</sup> See *STMicroelectronics, Inc. v. Motorola, Inc.*, 307 F. Supp. 2d 845, 847 (E.D. TX 2004).

<sup>35</sup> *Id.* at 852.

<sup>36</sup> 28 U.S.C. § 1338(a) (2006). “The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.” *Id.*

<sup>37</sup> 8-21 DONALD S. CHISUM, CHISUM ON PATENTS § 21.02 (2006).

<sup>38</sup> 28 U.S.C. § 1400(b) (2006). “Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” *Id.*

<sup>39</sup> *Fourco Glass Co. v. Transmirra Prods. Corp.*, 353 U.S. 222, 229 (1957).

<sup>40</sup> *Id.* 28 U.S.C. § 1391 is entitled “Venue generally” and prior to 1988 amendments read “A corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes.” *Id.* at 223.

<sup>41</sup> *Id.* at 224 (reasoning that § 1400 is a specific venue statute applicable to patent infringement actions and supersedes § 1391(c), which is a general venue).

<sup>42</sup> *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1575, 1578 (Fed. Cir. 1990). “The Supreme Court in *Fourco* confirmed that for defendants that are corporations, ‘resides’ meant the state of incorporation only.” *Id.* at 1578.

<sup>43</sup> 28 U.S.C. § 1391(c) (2006).

<sup>44</sup> See *VE Holding Corp.*, 917 F.2d at 1583–84.

of where the plaintiff could file suit according to the prior precedent, *Fourco*.<sup>45</sup> The result of *VE Holding Corp.* is that venue in a patent infringement case now includes any district where the court has personal jurisdiction over the defendant at the time the action is commenced.<sup>46</sup>

Along with proper venue under the first option of § 1400(b), venue is also proper under the second option in § 1400(b) when two criteria are met: (1) the defendant has committed acts of infringement<sup>47</sup> and (2) has a regular established place of business.<sup>48</sup> Patent infringement takes place at the location the defendant makes, uses, or sells the plaintiff's patented item.<sup>49</sup> In addition, the plaintiff must prove the second criteria that the defendant has a permanent establishment from which it regularly conduct business.<sup>50</sup>

Second, personal jurisdiction is established through general or specific jurisdiction.<sup>51</sup> General jurisdiction is achieved when the defendant has certain minimum contacts such that the maintenance of the suit does not offend traditional notions of fair play.<sup>52</sup> Specific jurisdiction exists when the defendant purposefully directed its activities at the residents of the forum, the claim arose out of or is related to those activities, and the assertion of personal jurisdiction is reasonable and fair.<sup>53</sup>

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<sup>45</sup> Michael L. Keller & Kenneth J. Nunnenkamp, *Patent Law Developments in the United States Court of Appeals for the Federal Circuit During 1990*, 40 AM. U.L. REV. 1157, 1189–90 (1991) (noting “the Court held a corporate defendant is deemed to reside in any judicial district where it is subject to personal jurisdiction. So long as personal jurisdiction can be exercised over the defendant, venue will be proper under section 1400(b).”).

<sup>46</sup> *VE Holding Corp.*, 917 F.2d at 1583 (allowing the plaintiff to file in any district where the court has personal jurisdiction over the defendant).

<sup>47</sup> 35 U.S.C. § 271(a) (2006) (“Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”).

<sup>48</sup> *See Gen. Radio Co. v. Superior Elec. Co.*, 293 F.2d 949, 951 (1st Cir. 1961) (finding that both requirements of committing acts of infringement and having a regular and established place of business in the forum must be met in conjunction to confer venue). *See also Cordis Corp. v. Cardiac Pacemakers*, 599 F.2d 1085, 1086–87 (1st Cir. 1979) (finding the plaintiff did not establish the defendant had a regular and established place of business in the forum because, among other things, the defendant did not maintain inventory in the forum or own any property in the forum).

<sup>49</sup> *See N. Am. Phillips Corp. v. Am. Vending Sales*, 35 F.3d 1576, 1578 (Fed. Cir. 1994) (35 U.S.C. § 271(a) “on its face clearly suggests the conception that the ‘tort’ of patent infringement occurs where the offending act is committed and not where the injury is felt.”).

<sup>50</sup> *See Samsonite Corp. v. Texas Imperial Am., Inc.*, No. 3-81-1038-H, 1982 U.S. Dist. LEXIS 10144, at \*5 (N.D. Tex. April 15, 1982) (finding conducting business two times a year in the forum does not establish a regular and established place of business).

<sup>51</sup> *Plant Genetic Sys., N.V. v. Ciba Seeds*, 933 F. Supp. 519, 523 (M.D.N.C. 1996) (citing *Helicopteros Nacionales de Columbia, S.A. v. Hall*, 466 U.S. 408, 414 nn.8–9 (1984)). The court held the plaintiff established personal jurisdiction over the defendant because the infringing acts occurred in the defendant's plant located in the forum. *Id.* at 525.

<sup>52</sup> *See Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1565 (Fed. Cir. 1994). The court sought to create a uniform body of Federal Circuit law in the area of jurisdiction and stream of commerce theory to promote judicial efficiency. *Id.* at 1571. The court found the defendant was subject to personal jurisdiction because it placed the product in the stream of commerce, it knew the likely destination of the product, and it should reasonably have anticipated being brought into court there. *Id.* at 1566. *See also Honeywell v. Metz Apparatewerke*, 509 F.2d 1137, 1144–45 (7th Cir. 1975) (holding that the defendant, by placing its product into the stream of commerce, should have reasonably anticipated that injury through infringement would occur where the tort took place and thus the conduct was sufficient to establish minimum contacts to establish personal jurisdiction).

<sup>53</sup> *See Akro Corp. v. Luker*, 45 F.3d 1541, 1545 (Fed. Cir. 1995) (holding that the defendant purposefully directed activities at the residents of the forum by entering into a license agreement with a member of the forum

Jurisdiction over a patent dispute is unique because patent holders own the federally created property right to exclude others from making, using, or selling the patented product.<sup>54</sup> This right is not limited to a specific location, but exists in every district in the United States.<sup>55</sup> A patent holder is injured in every district where an infringing sale was made because that is where the patent owner suffers economic loss.<sup>56</sup> Therefore, a plaintiff can obtain specific jurisdiction over the accused infringer in any district the infringer sells his products because in every district the product is sold the plaintiff suffers injury.

The current jurisdiction and venue laws essentially allow plaintiffs a choice of forum in most patent related cases. Therefore, plaintiffs engage in forum shopping for the most pro-patentee forum. The only option for a defendant to obtain a less pro-patentee forum is to make a motion for transfer of venue.<sup>57</sup> However, motions to transfer venue generally prove ineffective because courts rarely grant transfers in patent cases due to the fact the convenience of litigation in one district is not drastically different from another district.<sup>58</sup>

#### *D. The Policy Against Forum Shopping*

The fact that patent cases are not evenly dispersed throughout the judicial districts suggests patent holders are forum shopping.<sup>59</sup> If courts applied patent law equally and uniformly throughout the districts, there would be no incentive to forum shop.<sup>60</sup>

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creating a continuing obligation to establish sufficient minimum contacts for personal jurisdiction). *See also* Burger King Corp. v. Rudzewicz, 471 U.S. 462, 487 (1985) (holding when a forum seeks to assert personal jurisdiction over a defendant who has not consented to suit in the forum, the fair warning requirement is satisfied if the defendant has purposefully directed his activities at residents of the forum and the litigation results from alleged injuries that arise out of or relate to those activities).

<sup>54</sup> *See Beverly Hills Fan Co.*, 21 F.3d at 1570.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.* at 1571.

<sup>57</sup> Moore, *supra* note 7, at 926.

<sup>58</sup> *See* Datex-Ohmeda, Inc. v. Hill-Rom Servs., 185 F. Supp. 2d 407, 412 (D. DE 2002) (denying transfer because neither party will be unduly inconvenienced in the plaintiff's chosen forum because the locations of books and documents are immaterial for large corporations). *See also* Square D. Co. v. Medar Inc., No. 94-184-SLR, 1994 U.S. Dist. LEXIS 20897, at \*5 (D. DE Aug. 31, 1994) ("As this Court has recognized, however, the effect of modern technology in the fields of transportation and data transference has been to minimize the significance of the 'convenience factors' in the § 1404(a) analysis."); *Datamize, Inc. v. Fidelity Brokerage Servs.*, No. 2:03-CV-321-DF, 2004 U.S. Dist. LEXIS 29100, at \*27 (E.D. Tex. Apr. 22, 2004) ("Moreover, any relevant prior art, whether from Silicon Valley or elsewhere, may easily be submitted to the Court given the convenience of modern-day mail and electronic services."); *Brock v. Baskin-Robbins USA Co.*, 113 F. Supp. 2d 1078, 1089 (E.D. Tex. 2000) (noting the defense arguments that the documentary evidence were located outside the forum were unpersuasive because most documents can be copied and shipped to the Eastern District).

<sup>59</sup> Moore, *supra* note 12, at 892. The presence of forum shopping means consistent and uniform application of patent law is lacking in the court system. *Id.* at 893. *See also* Medtronic Ave, Inc. v. Cordis Corp., No. 2:02-CV-73, 2003 U.S. Dist. LEXIS 26956, at \*7 (E.D. Tex. Mar. 19, 2003) (recognizing the plaintiff chose to bring suit in the Eastern District of Texas because it was the most efficient and economical venue since the case can get to trial faster in the Eastern District than other possible forums).

<sup>60</sup> Moore, *supra* note 12, at 892.

There are many factors a plaintiff takes into account when determining which forum is most advantageous.<sup>61</sup> One factor plaintiffs consider is how many cases were filed and how many went to trial in that district.<sup>62</sup> A plaintiff is attracted to a district that has a high percentage of cases actually reaching trial because settlement will look more attractive to the defendant, who knows trial cannot be avoided.<sup>63</sup> Plaintiffs also consider whether the district rarely grants summary judgment in patent cases.<sup>64</sup> Plaintiffs are inclined to bring cases in districts that do not grant many summary judgment motions because, again, the certainty of trial encourages defendants to settle because trial cannot be avoided by moving for summary judgment.<sup>65</sup>

Whether the district is considered a rocket docket is another factor for the plaintiff to consider. The demands of the strict pretrial schedule forces attorneys on both sides to diligently prepare for trial.<sup>66</sup> With respect to intellectual property litigation, usually the plaintiff seeks immediate injunctive relief because time is of the essence.<sup>67</sup> A rocket docket decreases the overall litigation time, which in turn reduces trial costs for both sides.<sup>68</sup> Most importantly for the plaintiff, out of town defendants have the disadvantage of scrambling to devise a strong defense against plaintiffs who are familiar with the grueling schedule and have already prepared for trial prior to filing.<sup>69</sup>

*Forum non conveniens* provides a method for defendants, upon overcoming a heavy burden, to escape the plaintiff's favorable forum by claiming the plaintiff's choice of forum is unfair.<sup>70</sup> One purpose of this doctrine is to allow the defendant the opportunity to change venue in order to curtail the evils of forum shopping.<sup>71</sup>

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<sup>61</sup> *Id.* at 899. When a plaintiff practices forum shopping he will take the following into account: the experience and knowledge of the judge with respect to patent litigation and prosecution; the local rules of the district; the educational level and biases of the potential jury; and the speed of the docket. *Id.*

<sup>62</sup> See Donald F. Parsons, Jack B. Blumenfeld, Mary B. Graham & Leslie A. Polizoti, *Solving the Mystery of Patentees' "Collective Enthusiasm" for Delaware*, 7 DEL. L. REV. 145, 155 (2004).

<sup>63</sup> *Id.* at 157.

<sup>64</sup> *Id.*

<sup>65</sup> *Id.* See also Julie Creswell, *So Small a Town, So Many Patent Suits*, N.Y. TIMES, Sept 24, 2006, at sec. 3, pg. 1.

SPEED is not the only feature bringing patent holders to Marshall. So, too, is the fact that they usually win. Three-fourths of the cases that come to trial in Marshall are decided in favor of the plaintiff, compared with less than half in New York. The success rate for patent holders in Marshall is a great incentive for defendants to settle matters quickly and privately. Since 1991, the Federal District Court in Marshall has held less than half the number of full patent trials as courts in Los Angeles, New York, Chicago and San Francisco.

*Id.* See, e.g., *Avid Identification Sys. v. Philips Electronics*, No. 2:04-CV-183, 2006 U.S. Dist. LEXIS 30981, at \*8 (E.D. Tex. May 18, 2006) (Judge Ward denying defendant's motion for summary judgment); *Hill v. Amazon.com, Inc.*, No. 2:02-CV-186, 2006 U.S. Dist. LEXIS 3389, at \*21 (E.D. Tex. Jan. 19, 2006) (Judge Ward denying the defendant's three motions for summary judgment).

<sup>66</sup> Heather Russell Koenig, *The Eastern District of Virginia: A Working Solution for Civil Justice Reform*, 32 U. RICH. L. REV. 799, 815 (1998).

<sup>67</sup> *Id.* at 817. ("Patent holder plaintiffs in IP suits often are suing for injunctive relief; thus, the quick time frame is essential.")

<sup>68</sup> *Id.*

<sup>69</sup> *Id.* at 819.

<sup>70</sup> See *First Nat'l Bank v. Guerine*, 764 N.E.2d 54, 59 (Ill. 2002). *Forum non conveniens* is an equitable doctrine that allows a court to decline jurisdiction when another forum with proper jurisdiction and venue would be more fair. *Id.* at 57. Courts must balance private interest factors, such as, the convenience of the parties, the ease of

For example, when it appears the plaintiff's choice of forum was motivated by forum shopping, less deference is given to the plaintiff's choice, which makes it easier for the defendant to succeed in a *forum non conveniens* motion.<sup>72</sup> Factors the court considers in determining whether the plaintiff engaged in forum shopping include: the plaintiff's attempts to win a tactical advantage resulting from local rules; the habitual generosity of juries in that forum; the plaintiff's popularity or defendant's unpopularity in the forum; and the expense to the defendant resulting from litigation in that forum.<sup>73</sup>

Forum shopping increases the cost of litigation by choosing the forum most favorable to the plaintiff's case, rather than choosing the most convenient or closest forum.<sup>74</sup> Furthermore, forum shopping creates a negative perception of the judicial system because it suggests a lack of uniformity.<sup>75</sup> Another concern is that a plaintiff can choose the outcome of the case by selecting the correct forum, which "will defeat the expectations of the defendant or will upset the policies of the state in which the defendant acted."<sup>76</sup>

In *Rayco Manufacturing Co. v. Chicopee Manufacturing Co.*, the judge gave great weight to the fact the plaintiff chose a forum with few contacts to the plaintiff's case.<sup>77</sup> When a plaintiff chooses a forum where the factual circumstances implicated in the suit have little connection with the chosen forum, the plaintiff is open to the charge of forum shopping.<sup>78</sup> The judge disregarded the normal deference to the plaintiff's choice of forum under § 1404(a) in order to discourage forum shopping and granted the defendant's motion to transfer.<sup>79</sup>

In summary, the current venue laws allow plaintiffs in patent cases to choose from a plethora of district courts to file suit. Because patent cases are not evenly dispersed throughout the district courts, plaintiffs do not perceive that all district courts would apply the law to result in the same outcome. In response, plaintiffs forum shop for the district that is most beneficial to their case. Plaintiffs are attracted to the Eastern District of Texas due to the local patent rules that enforce strict pretrial procedures, which are arguably unfavorable to defendants. Notwithstanding the efficiency the local patent rules provide, the resulting forum shopping suggests an unacceptable lack of uniformity within the district courts with respect to patent law.

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access to testimonial, documentary, and real evidence, and all other practical problems that make trial of a case easy, expeditious, and inexpensive to the parties. *Id.* at 58. Public interest factors include the interest in deciding localized controversies, the unfairness of imposing the expense of a trial on the residents of a county with little connection to the dispute in litigation, and the administrative difficulties in adding suits to the congested docket. *Id.* Lastly, the plaintiff's choice of forum should rarely be disturbed. *Id.* at 59.

<sup>71</sup> *Id.* at 61.

<sup>72</sup> *Iragorri v. United Tech. Corp.*, 274 F.3d 65, 72 (2d Cir. 2001) ("the more it appears that the plaintiff's choice of a U.S. forum was motivated by forum-shopping reasons . . . the less deference the plaintiff's choice commands . . .").

<sup>73</sup> *Id.*

<sup>74</sup> Forum Shopping Reconsidered, 103 HARV. L. REV. 1677, 1684 (1990).

<sup>75</sup> *Id.*

<sup>76</sup> *Olmstead v. Anderson*, 400 N.W.2d 292, 303 (Mich. 1987) (citing *Allstate v. Hague*, 449 U.S. 302, 337 (1981)).

<sup>77</sup> See *Rayco Mfg. Co. v. Chicopee Mfg. Corp.*, 148 F. Supp. 588, 591 (S.D.N.Y. 1957).

<sup>78</sup> *Id.* at 593.

<sup>79</sup> *Id.* at 593–94.

## II. ANALYSIS

With a firm understanding of venue and traditional forum shopping policy, this section analyzes the current state of forum shopping policy in the Eastern District of Texas. Part A analyzes the policy in favor of allowing forum shopping through the views of various courts. Part B presents the Eastern District of Texas analysis of motions to transfer and its views of forum shopping. Finally, Part C analyzes the Court of Appeals for the Federal Circuit review of Eastern District's decisions.

### *A. The Policy Supporting Forum Shopping*

The Supreme Court finds forum shopping equal with any other legitimate adversarial technique. For example, in *Keeton v. Hustler Magazine*, the Supreme Court upheld the plaintiff's forum shopping for a district with a favorable statute of limitations, noting it was no different from the litigation strategy of seeking a forum with favorable substantive or procedural rules with a sympathetic jury pool.<sup>80</sup>

Additionally, the Fourth Circuit stated, "there is nothing inherently evil about forum-shopping."<sup>81</sup> The court noted the venue and jurisdiction statutes implicitly, if not explicitly, allow for alternate forums for plaintiffs.<sup>82</sup>

In an adversarial system, a lawyer has an obligation to forum shop when it is necessary to protect the interests of the client.<sup>83</sup> Although, the critics of forum shopping argue it is unfair and inefficient to permit the plaintiff to exploit the forum shopping strategy.<sup>84</sup> However, to address these concerns, there are safeguards already in the system to control unethical forum shopping.<sup>85</sup> The existing venue and jurisdiction statutes control which jurisdictions are fair for the defendant to be haled into court.<sup>86</sup> Furthermore, the defendant has the opportunity to invoke *forum non conveniens* or transfer of venue motions.<sup>87</sup> The Model Code of Professional Responsibility creates an ethical limitation to certain types of forum shopping such as when the intent is to delay or to maliciously injure another.<sup>88</sup> All of these checks are safeguards that currently exist to curb abuses associated with forum shopping.<sup>89</sup> Forum shopping enhances efficiency in the court system when clients benefit from

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<sup>80</sup> *Keeton v. Hustler Magazine, Inc.*, 465 U.S. 770, 779 (1984).

<sup>81</sup> *Goad v. Celotex Corp.*, 831 F.2d 508, 512 n.12 (4th Cir. 1987). The defendant accused the plaintiff of forum shopping for a preferred statute of limitations in Texas, and proposed Virginia's statute of limitation should apply as the new venue. *Id.* at 512. The court rejected the defendant's argument and noted that any complaint about forum shopping should be brought to Congress and not the courts. *Id.*

<sup>82</sup> *Id.* at 512 n.12.

<sup>83</sup> Forum Shopping Reconsidered, *supra* note 74, at 1691; see also Debra Lyn Bassett, The Forum Game, 84 N.C. L. REV. 333, 344 (2006) ("The ethical rules require lawyers to represent clients to the best of their ability, and selecting the forum most favorable to the client's claim is an integral part of vigorous and effective representation. Indeed, the failure to forum shop would, in most instances, constitute malpractice.").

<sup>84</sup> See Forum Shopping Reconsidered, *supra* note 74, at 1690.

<sup>85</sup> *Id.*

<sup>86</sup> See *id.* at 1691.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 1695.

the application of the chosen jurisdiction's substantive law; the net effect is providing a remedy for clients that might not have otherwise existed.<sup>90</sup>

*B. Forum Shopping in the Eastern District of Texas*

The Eastern District of Texas echoes the policy upholding forum shopping.<sup>91</sup> The court has noted the existence of forum choices invites lawyers in an adversarial system to select a forum that serves the client's best interest.<sup>92</sup> In fact, as the court discussed, a plaintiff can chose a court based on the speed of the docket, the discovery procedures, the jury pool, the rules of law applied, or the likelihood a judge presiding in that forum is likely to rule in his favor; the motive of the plaintiff in selecting a forum is irrelevant.<sup>93</sup> The venue statutes are broad and litigants can chose from many jurisdictions to file their suit.<sup>94</sup> The limitation on that choice is governed by 28 U.S.C. § 1404, which ensures the plaintiff has not exceeded the bounds of fairness, convenience, or judicial economy.<sup>95</sup>

*Tinkers & Chance v. Leapfrog Enterprises* sets forth Judge Ward's venue transfer analysis.<sup>96</sup> *Tinkers & Chance* brought suit for infringement against LeapFrog in the Eastern District of Texas and LeapFrog moved to transfer venue to the Northern District of California.<sup>97</sup> Section 1404(a) states: "[f]or 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."<sup>98</sup> Transfer of venue is within the purview of the court.<sup>99</sup> The court applies a two-prong test when considering transfer: first, a court must determine whether the district the movant seeks a transfer is proper; and second, the court must examine factors relating to the convenience of the litigants and those relating to judicial

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<sup>90</sup> See *id.* at 1696.

<sup>91</sup> See, e.g., *Mohamed v. Mazda Motor Corp.*, 90 F. Supp. 2d 757, 772 (E.D. Tex. 2000) (holding the plaintiff's motive in choice of forum is irrelevant for transfer analysis because the Court scrutinizes all forum choices under Section 1404(a), which determines whether the plaintiff has exceeded the bounds of fairness, convenience, and judicial economy).

<sup>92</sup> See *In re Triton Ltd. Secs. Litig.*, 70 F. Supp. 2d 678, 689 (E.D. Tex. 1999) (citing *McCuin v. Texas Power & Light Co.*, 714 F.2d 1255, 1261-62 (5th Cir. 1983) (denying defendant's motion to dismiss for improper venue and alternative motion to transfer venue).

<sup>93</sup> *Id.*

<sup>94</sup> *Texas Instruments, Inc. v. Micron Semiconductor, Inc.*, 815 F. Supp. 994, 996 (E.D. Tex. 1993).

In reality, every litigant who files a lawsuit engages in forum shopping when he chooses a place to file suit. The Court is concerned only with whether the choice of forum is a proper one under the law, and not with the motives of the party selecting the forum. The venue statutes are intentionally broad, and litigants must often make an election from among several options as to where to file a lawsuit. The litigant's right to choose a forum is well established, and there are well-recognized tests under 28 U.S.C. § 1404 to determine whether a party has exceeded the bounds of fairness, convenience, and judicial economy in the selection made.

*Id.*

<sup>95</sup> See *Box v. Ameritrust Texas*, 810 F. Supp. 776, 780 (E.D. Tex. 1992).

<sup>96</sup> *Tinkers & Chance v. Leapfrog Enter.*, No. 2:05-CV-349, 2006 U.S. Dist. LEXIS 10115, at \*2-3 (E.D. Tex. Feb. 23, 2006).

<sup>97</sup> *Id.* at \*1.

<sup>98</sup> *Id.* at \*2-3.

<sup>99</sup> *Id.* at \*3.

administration and economy.<sup>100</sup> Factors relating to the convenience of the litigants include: ease of access to evidence; the availability of witnesses; the cost of attendance of witnesses; and other practical problems that result in an efficient and inexpensive trial.<sup>101</sup> Public interest factors include: the administrative difficulties in managing the case; the local interest in having the case heard in the forum; the forum's familiarity with the applicable law; and the avoidance of conflict of laws.<sup>102</sup>

Tinker & Chance claimed all of its relevant documents were located in Texas and Leapfrog claimed all of its relevant documents were in California.<sup>103</sup> The court held that access and availability of documents are not an issue for convenience for transfer determinations.<sup>104</sup> When deciding whether to transfer, the court noted LeapFrog did not specify any potential witnesses for whom the cost of attending trial would be an issue or any other practical problems resulting from hearing the case in Texas.<sup>105</sup> Furthermore, the court found the local interest of Texas of the admitted sale of the infringing products is relevant.<sup>106</sup> In balancing the relevant factors the court decided against the transfer.<sup>107</sup>

In contrast, in *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, Judge Ward granted Monolithic Power Systems' motion to transfer venue to the Northern District of California.<sup>108</sup> MPS filed for a declaratory judgment in the Northern District of California and shortly thereafter O2 filed suit in the Eastern District alleging infringement against MPS.<sup>109</sup> Furthermore, the presiding judge in the Northern District of California denied O2's motion to transfer because she found O2 engaged in forum shopping when it filed suit in Texas.<sup>110</sup> Because transfer is appropriate when related cases involving the same issues are pending in another court, Judge Ward granted the transfer in the interest of justice.<sup>111</sup>

### *C. The Federal Circuit's Review of Motions to Transfer from the Eastern District of Texas*

The Court of Appeals for the Federal Circuit affirmed the Eastern District's analysis of motions to transfer in *In re D-Link Corp.*<sup>112</sup> The Federal Circuit agreed

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<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at \*4.

<sup>102</sup> *Tinkers & Chance v. Leapfrog Enter.*, No. 2:05-CV-349, 2006 U.S. Dist. LEXIS 10115, at \*4 (E.D. Tex. Feb. 23, 2006).

<sup>103</sup> *Id.* at \*5.

<sup>104</sup> *Id.* at \*6 (stating "increasing ease of storage, communication, copying and transportation of documents. . . is neutral regarding a transfer.").

<sup>105</sup> *Id.* at \*7-8.

<sup>106</sup> *Id.* at \*9.

<sup>107</sup> *Id.* at \*10.

<sup>108</sup> *O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, No. 2:04-CV-359, 2006 U.S. Dist. LEXIS 21870, at \*10 (E.D. Tex. Mar. 28, 2006).

<sup>109</sup> *Id.* at \*6.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at \*8.

<sup>112</sup> *See, e.g., In re D-Link Corp.*, No. 822, 2006 U.S. App. LEXIS 14546, at \*4 (Fed. Cir. June 2, 2006). D-Link argued that the Southern District of New York would be more convenient with respect to witness and evidence. *Id.* at \*3. Network-1 argued California or Taiwan rather than New York would be most convenient. *Id.*

with the Eastern District in finding the defendant's reasons for motion to transfer did not satisfy the heavy burden of proof required by the defendant to take the case away from the plaintiff's choice of forum.<sup>113</sup>

The Court of Appeals for the Federal Circuit generally affirms Eastern District judgments.<sup>114</sup> For example, in *Ericsson, Inc. v. Harris Corp.*, the Federal Circuit affirmed the decision of the Eastern District of Texas granting judgment in favor of the plaintiff on the claims of infringement.<sup>115</sup>

In summary, the Eastern District of Texas approves of forum shopping as part of the adversarial system and as encouraged by the current venue laws. The Federal Circuit also approves forum shopping by upholding decisions from the Eastern District pertaining to transfer of venue. However, a uniform patent system will never be developed unless forum shopping is eliminated.

### III. PROPOSAL

The existence of rocket docket, such as the Eastern District of Texas, is unequivocal evidence of forum shopping. Furthermore, once a defendant is haled into court in the Eastern District of Texas there is little chance of escaping exists, based on the current venue laws. The question becomes how forum shopping should be corrected.

Notwithstanding the fact that forum shopping forces certain districts to gain expertise in patent law, forum shopping is a sign of a serious problem in the patent system.<sup>116</sup> Plaintiffs should be confident that they will receive the same outcome in trial no matter what district they bring their case. Reform is needed to unify patent

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The Court of Appeals held that D-Link did not satisfy the burden of showing that the district court abused its discretion in denying the motion to transfer. *Id.* at \*4.

<sup>113</sup> *Id.*

<sup>114</sup> See, e.g., *Imonex Servs. v. W.H. Munzprufer Dietmar Trenner GMBH*, 408 F.3d 1374, 1381 (Fed. Cir. 2005) (affirming the Eastern District's judgment denying the defendant's JMOL motions on non-infringement and granting a new trial on damages to allow the jury to hear sufficient evidence for damages); *Parental Guide of Texas v. Thomson, Inc.*, 446 F.3d 1265, 1266 (Fed. Cir. 2006) (affirming the decision from the Eastern District of Texas granting summary judgment to the defendant); *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1416 (Fed. Cir. 2004) (affirming the Eastern District's judgment of non-infringement, its denial of the motion for new trial, and its denial of motion for attorney fees); *Minton v. Nat'l Assoc. of Securities Dealers*, 336 F.3d 1373, 1381 (Fed. Cir. 2003) (affirming the Eastern District's grant of summary judgment to the defendant because the plaintiff's patent was invalid). *But see Intirtool, Ltd. v. Texar Corp.*, 369 F.3d 1289, 1298 (Fed. Cir. 2004) (reversing the Eastern District judgment finding it abused its discretion in finding Intirtool's patent invalid and unenforceable because Intirtool had committed inequitable conduct during its prosecution); *IEX Corp. v. Blue Pumpkin Software, Inc.*, 122 F.App'x 458, 470 (Fed. Cir. 2005) (vacating the Eastern District's grant of summary judgment of non-infringement because the district court improperly construed the claims of the patent at issue); *Massachusetts Inst. Tech. and Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1360 (Fed. Cir. 2006) (vacating the Eastern District's grant of summary judgment because the district court erred in claim construction in determining infringement).

<sup>115</sup> See *Ericsson, Inc. v. Harris Corp.*, 146 F.App'x 476, 481 (Fed. Cir. 2005).

<sup>116</sup> See *Parsons*, *supra* note 62, at 148–151 (discussing the reason for Delaware's district court popularity for patent litigation is due to the district's experience with patent cases). Judges with patent expertise are attractive to plaintiffs because they will provide a fair trial dealing with complicated patent issues that might not be understood in all forums where the judges have not received many patent cases and are unfamiliar with intricacies of patent law. *Id.* In this view, forum shopping is the solution to inconsistent application of patent law by creating courts with expertise. *Id.*

law application to ensure consistent and dependable holdings in patent lawsuits in all district courts. Consistent application of patent laws and the integrity of the judicial system outweigh any of the reasons in favor of forum shopping. If public confidence erodes because of inconsistent judgments throughout the district courts, it undermines the entire patent system, which results in a decrease in the value of patents.

This section presents three possible solutions to decrease forum shopping and thereby, unify the patent system: a) adoption of Judge Ward's Patent Rules in every district court; b) creation of a specialized patent court; and c) restructuring the PTO to allow post-grant reviews that courts will defer to under administrative standard of review.

#### *A. Nationwide Adoption of Judge Ward's Patent Rules*

Assuming the patent rules are the reason plaintiffs are drawn to the Eastern District of Texas, forum shopping can be eliminated if every district adopted similar local rules. However, if plaintiffs choose the Eastern District for any other reason, such as for example, Judge Ward's affinity for patent cases or possibly the advantage of a sympathetic jury pool,<sup>117</sup> then plaintiffs will continue to file in the Eastern District regardless of other districts' similar patent rules. Even if other districts adopt similar local rules, the judges in those districts might not have an affinity towards patent cases and, therefore, might not take the time to fully understand all of the intricacies of patent law.<sup>118</sup> One potential reason why Judge Ward is so competent with patent cases is a result of the number of patent cases he has heard. If forum shopping were eliminated and the nation's patent cases were evenly distributed among the district courts, the judges might hear patent cases sporadically. In turn, the judges may forget what they have learned from their first exposure by the time they receive their next in depth patent case. Furthermore, it has been argued the Patent Local Rules of the Northern District of California, which are practically identical to Judge Ward's rules, enhance an information asymmetry between the patentee and accused infringer and should be amended to decrease the prejudice towards the accused infringer.<sup>119</sup> National adoption of similar patent local rules alone is not the ideal solution to eliminate forum shopping.

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<sup>117</sup> See Symposium, *Ideas into Action: Implementing Reform of the Patent System*, 19 BERKELEY TECH. L.J. 1053, 1109 (2004).

<sup>118</sup> See Judge James F. Holderman, *Judicial Patent Specialization: A View from the Trial Bench*, Keynote Address (Fall 2002), in 2002 U. ILL. J.L. TECH. & POL'Y 425, 428 (2002). As confessed by Judge Holderman of the Northern District of Illinois, his colleagues on the district bench dread patent cases because they are unfamiliar with the specific technology and are forced to grapple with conflicting testimony of experts who speak in scientific terminology they are not trained in. *Id.* Judge Holderman advocates a proposal by John Pegram, which is to modify the responsibilities of the U.S. Court of International Trade to hear patent infringement litigation at the trial level. *Id.* at 433.

<sup>119</sup> See Turner, *supra* note 18, at 669. The accused is at a disadvantage because the rules require him to immediately produce of all relevant documents relating to his accused device before the patentee is compelled by the rules to produce the claim construction of his patent. *Id.* Performing claim construction with the evidence of the accused instrumentality in hand gives the patentee the ability to broaden the literal scope of their patent to include the accused device, thereby prejudicing the accused infringer. *Id.* at 651. To balance the power between

### *B. Creating Specialized Patent Courts*

Perhaps a more radical approach is to create a specialized trial court for all patent cases.<sup>120</sup> In essence, patent holders are already creating their own specialized court system by filing suits in certain patent rocket docket.<sup>121</sup> This certainly suggests the need and desire for a specialized patent trial court when almost half of the patent cases filed are in districts known for their patent expertise.<sup>122</sup> Mandating patent cases be heard in a specialized court with patent expertise will eliminate forum shopping and increase accurate, efficient, and consistent adjudication.<sup>123</sup>

The approach of creating a specialized patent court is not new. In fact, the Federal Circuit was created in response to the inconsistencies between the district courts in finding patent validity and for the purpose of eliminating the resulting practice of forum shopping.<sup>124</sup> Initially, the Federal Circuit unified patent law by eliminating appellate level forum shopping and establishing binding precedent over all the district courts that had various standards of patent validity.<sup>125</sup> Early Federal Circuit precedent strengthened the statutory presumption of patent validity.<sup>126</sup> While the validity inquiry was well understood by the district courts, the Federal Circuit's holdings pertaining to infringement were less understood and, therefore, remain inconsistent.<sup>127</sup>

During the deliberation of Congress in developing the Court of Appeals for the Federal Circuit, there were many critics who viewed the adoption of the Federal Circuit as creating a specialized court and advocated instead to resolve the ambiguities of patent law through legislation.<sup>128</sup> The opposition feared the new court would sacrifice diversity resulting from differences in geographical strains of thought and that the new court would undermine the authority of existing regional circuit

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the patentee and the accused, the rules should be amended to mandate binding claim construction by the patentee prior to him receiving any information about the accused device. *Id.* at 671.

<sup>120</sup> See Arti K. Rai, *Patent System Reform: Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH. L.J. 877, 878 (2002); see also Matthew B. Lowrie, *Critical Issues in Managing Patent Litigation*, 44 IDEA 267, 276 (2004) (noting the trend to supplement the current system with patent experts at the trial level by allowing parties to request appointment of a Special Master, with scientific or patent background to assist in managing the case).

<sup>121</sup> See Rai, *supra* note 120, at 880.

<sup>122</sup> See *id.* ("ten district courts that have the highest number of patent cases hear about forty percent of all such cases.").

<sup>123</sup> Rochelle Cooper Dreyfuss, *The Past, Present and Future of the Federal Circuit: The Federal Circuit: A Continuing Experiment in Specialization*, 54 CASE W. RES. 769, 770 (2004). The jurisprudence of the PTO could be expanded to allow rule-making authority. *Id.* at 792. For the PTO to take on more duties, Congress would need to restructure the PTO because currently the PTO finds it difficult to meet the demands of approving patents in an efficient manner. *Id.*

<sup>124</sup> Matthew D. Henry & John L. Turner, *The Court of Appeals for the Federal Circuit's Impact on Patent Litigation*, 35 J. LEGAL STUD. 85, 86 (2006).

<sup>125</sup> *Id.* at 86–87.

<sup>126</sup> *Id.* at 86.

<sup>127</sup> See *id.* at 88.

<sup>128</sup> Honorable Randall R. Rader, *Specialized Courts: The Legislative Response*, 40 AM. U.L. REV. 1003, 1004 (1991).

courts.<sup>129</sup> However, advocates of the new court did not believe it was a specialty court because it would hear a variety of cases outside of patent law.<sup>130</sup>

The Federal Circuit has a vital function in balancing policy concerns and maintaining expertise in patent law that could not be maintained in a specialized court system. Whereas creating a specialized patent court would definitely eliminate forum shopping, a less drastic solution would be best that leaves the Federal Circuit in place.

### *C. Restructuring the Patent and Trademark Office*

This comment supports an intermediate solution that restructures the current system to empower the Patent and Trademark Office (“PTO”) as a fact-finding agency that courts will defer to under administrative review. One problem with the patent system is the institutional structure of focusing the expertise in the appellate level and the inefficiency of allowing the Federal Circuit to review the PTO’s findings of fact with little deference.<sup>131</sup> The Federal Circuit reviews the PTO’s claim constructions, determinations of obviousness, and assessment of the enablement requirement all as questions of law and under de novo standard of review.<sup>132</sup> Even judges on the Federal Circuit who are assisted by technically trained clerks are not trained in every area of science that the patent at issue might arise within.<sup>133</sup> Science is a specialized field and training in one area does not equate to an understanding of areas outside that specific area.<sup>134</sup> However, the Patent and Trademark Office has thousands of specialized scientists spanning many technical areas.<sup>135</sup> It is logical to defer findings of fact to an agency grounded in expertise and efficiency.<sup>136</sup>

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<sup>129</sup> *Id.* at 1005.

<sup>130</sup> *Id.* at 1007. Congress has the power to create courts under either article I or article III of the Constitution. *Id.* at 1010. Congress usually creates courts under Article I, which are single subject matter courts. *Id.* Congress created the Federal Circuit under article III to distinguish it from the specialty courts. *Id.* at 1014. The Federal Circuit hears appeals from the district courts, Boards of Contract Appeals, Court of International Trade, Claims Court, Secretary of Commerce, Court of Veteran Appeal, International Trade Commission, and more. *Id.* at 1013.

<sup>131</sup> See Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1040 (2003). Finding of facts are particularly crucial in patent cases with respect to the scope of the patent and patent validity both of which are determined in light of the objective standard of a person having ordinary skill in the art. *Id.* at 1046. Patents are drafted to an audience of persons having ordinary skill in the art, and most judges are not part of that audience and thus have a difficult time making findings of fact. *Id.*

<sup>132</sup> *Id.* at 1052–54 (“Even in validity inquiries involving nonobviousness and enablement- determinations that the Federal Circuit itself has acknowledged have factual foundations- fact-oriented standards of review are often absent.”).

<sup>133</sup> *Id.* at 1068.

<sup>134</sup> *Id.* at 1069.

<sup>135</sup> *Id.*

<sup>136</sup> *Id.* at 1066; see also *Dickinson v. Zurko*, 527 U.S. 150, 153 (1999) (holding the Administrative Procedure Act standards governing judicial review of findings of fact by federal agencies are applicable with the Federal Circuit reviews findings of fact by the PTO); Dennis J. Harney, *The Obvious Need for Deference: Federal Circuit Review of Patent and Trademark Office Determinations of Mixed Questions of Law and Fact*, 28 DAYTON L. REV. 61, 62 (2002) (advocating one reason against applying administrative law standards of review to the PTO is that the function of the patent system is not to regulate the patent system but to represent the government as the offeror in a private law context); Orin S. Kerr, *Rethinking Patent Law in the Administrative State*, 42 WM. & MARY L. REV. 127, 130 (2000). From a private law perspective the patent system is simply analogous to offer and acceptance in

Notwithstanding the deference the Federal Circuit gives to the PTO in findings of fact involved in obviousness determinations,<sup>137</sup> the court reviews whether the invention would be obvious to an ordinary person skilled in the art under the de novo standard of review.<sup>138</sup> The Federal Circuit's de novo standard of review suggests the Federal Circuit is in a better position to make patentability determinations than the PTO even though the PTO is inherently in the best position to judge patentability.<sup>139</sup> The de novo standard undermines the PTO's authority in patentability determinations and subjects the agency and the patent system to insecurity in a patentee's property right.<sup>140</sup>

The Federal Circuit's expertise lies in its familiarity with patent law and policy, not in findings of facts and application of those facts in highly technical areas.<sup>141</sup> Therefore, the appellate level should be focused on ensuring consistency in patent policy, taking into account conflicting policy that would be neglected in a specialized trial court setting.<sup>142</sup>

The PTO recommends enacting legislation to create a new administrative procedure to allow post-grant review and oppositions of patents that is just short of federal court litigation.<sup>143</sup> The PTO also suggested that its conclusions should receive deference from the appellate court.<sup>144</sup> The Federal Trade Commission, the National Academy of Sciences, and the American Intellectual Property Law Association all

contract law. *Id.* at 139. Congress offers a patent in exchange for the patentee satisfying the statutory requirements of patentability. *Id.* at 141. When a breach of contract claim arises, the patentee claims to have met the statutory requirements and deserves the patent. *Id.* The dispute must be resolved by a neutral court, not the PTO, which is an agent for the offeror. *Id.* By a court deferring to the PTO in a contract dispute, the court is in essence giving deference to the offeror, which is not consistent with contract law. *Id.* at 142. A court's deference to the PTO might discourage inventors from pursuing patents because the offeror is essentially interpreting the terms of the contract and thus creating uncertainty in those terms. *Id.* at 183.

<sup>137</sup> See Rai, *supra* note 131, at 1050 (noting the obvious "inquiry is necessarily based on factual questions regarding the 'scope and content' of the prior invention (known as 'prior art') in the field at the time of invention; 'differences between the prior art and the claims at issue; and 'the level of ordinary skill in the pertinent art.'").

<sup>138</sup> See Craig Allen Nard, *Deference, Defiance, and the Useful Arts*, 56 OHIO ST. L.J. 1415, 1437 (1995) ("According to the Federal Circuit, although a nonobviousness determination entails a number of antecedent factual considerations which are reviewed under the 'clearly erroneous' standard, the ultimate question of nonobviousness is one of law to be reviewed de novo.").

<sup>139</sup> *Id.* at 1499–1500 (advocating more deference to PTO decisions because the PTO is in the best position to take into consideration the research and development in the patentability determination due to the agents' familiarity with industry practices). Furthermore, patentability has been determined by a patent agent and the Board of Patent Appeals before it reaches the district courts. *Id.* at 1507. Therefore, to allow de novo review promotes inconsistency and "inefficiency and call[s] into question the very existence of the PTO." *Id.* at 1508.

<sup>140</sup> *Id.* at 1504. The de novo standard also encourages unnecessary litigation because potential infringers know the patent will be reviewed de novo, in contrast to a situation where the courts gave higher deference to the PTO. *Id.*

<sup>141</sup> Rai, *supra* note 131, at 1089.

<sup>142</sup> See *id.* at 1102. A specialized court system concerns critics in that since the court would only hear patent cases, it would be focused on the policies of protecting the integrity of the patent system and not take into account policy arguments that a general court might invoke such as the policy against antitrusts. *Id.* This concern is lessened if the institutional structure allows the appellate level, familiar but not limited to patent law, to have the responsibility of balancing a full range of policy considerations. *Id.* at 1100.

<sup>143</sup> Symposium, *Implementing Reform of the Patent System: To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy: Executive Summary*, 19 Berkeley Tech. L.J. 861, 869 (2004) (presenting conclusions and recommendations from the FTC and DOJ hearings held over 24 days and involving over 300 panelists).

<sup>144</sup> *Id.* at 870.

support a post-grant opposition hearing where third parties can challenge the validity of patents before an administrative patent judge in a trial environment.<sup>145</sup> It is essential the post-grant review is coupled with high deference from courts to both the findings of fact and law from the PTO in order to promote a uniform system.<sup>146</sup>

However, the PTO needs to be restructured before courts begin to invoke deference.<sup>147</sup> The closest structure to a post-grant review procedure currently in the PTO is the ex partes or inter partes reexamination, which is only available when there are substantial new questions of patentability resulting from patents and printed publications that were not considered in the original patent examination.<sup>148</sup> The reexamination procedure provides another forum besides litigation “for challenging the validity of an issued patent.”<sup>149</sup> The inter partes reexamination was designed to encourage third parties to choose reexamination over litigation by providing the third party with more opportunity to participate in the reexamination by filing written comments and even appealing to the Board of Patent Appeals and Interferences or to the Federal Circuit.<sup>150</sup> However, the inter partes procedure is rarely used because the third party requester is estopped from asserting in litigation the invalidity of a claim based on any ground that was raised or could have been raised during the reexamination proceedings.<sup>151</sup>

Generally in patent litigation, the patentee files suit against an alleged infringer and the alleged infringer then asserts an affirmative defense that the patent at issue is invalid. In adopting the reexamination procedure, Congress suggested that courts grant motions to stay litigation pending the resolution of a reexamination.<sup>152</sup> District courts would benefit by staying litigation when the reexamination eliminates or simplifies issues for trial as well as providing the court with technical expertise for the issues remaining.<sup>153</sup> However, in reality, the reexamination procedure took longer than Congress anticipated and, therefore, did not produce less expensive

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<sup>145</sup> Stuart Minor Benjamin & Arti. K. Rai, *Who’s Afraid of the APA? What the Patent System can Learn from Administrative Law*, 95 GEO. L.J. 269, 321 (2007).

<sup>146</sup> *Id.* at 326.

<sup>147</sup> See Arti. K. Rai, *Ideas into Action: Implementing Reform of the Patent System: Allocating Power over Fact-Finding in the Patent System*, 19 BERKELEY TECH. L.J. 907, 911 (2004). Currently the examiners have an incentive to grant patents since the examiners are evaluated according to the number of final dispositions they record. *Id.* Changing the way examiners are evaluated in combination with increased funding to the PTO would allow the examiners to spend more time in evaluating patent applications. *Id.* The fact-finding associated with denying a patent grant deserves the most deference because the examiner bears the burden of assembling evidence supporting his rejection. *Id.* at 912.

<sup>148</sup> Eric B. Chen, *Applying the Lessons of Re-Examination to Strengthen Patent Post-Grant Opposition*, 10 COMP. L. REV. & TECH. J. 193, 194 (2006) (proposing removal of the statutory estoppel provision in the current inter partes reexamination statutes and analyzing its effects). Ex parte reexaminations may be requested by any person during the patent term on the basis of prior patents or publications and the third-party has limited participation. *Id.* at 195.

<sup>149</sup> *Id.*

<sup>150</sup> *Id.* at 196.

<sup>151</sup> See Mark D. Janis, *Inter Partes Patent Reexamination*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 481, 493–94 (2000) (arguing the inter partes reexamination legislation failed to meet Congress’s purpose of providing an alternative to litigation because the legislation is too limited and its estoppel provisions discourage third parties from choosing reexamination over litigation).

<sup>152</sup> Wayne O. Stacy, *Reexamination Reality: How Courts Should Approach a Motion to Stay Litigation Pending the Outcome of Reexamination*, 66 GEO. WASH. L. REV. 172, 173 (1997).

<sup>153</sup> *Echostar Techs. Corp. v. Tivo, Inc.*, No. 5:05-CV-81 (DF), 2006 U.S. Dist. LEXIS 48431, at \*5–6 (E.D. Tex. July 14, 2006).

trials.<sup>154</sup> Furthermore, it is completely within the trial court's discretion to grant a motion to stay pending the outcome of a reexamination procedure.<sup>155</sup> Factors a court considers in deciding whether to stay litigation until the reexamination has concluded include: "(1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party, (2) whether a stay will simplify the issues in question and trial of the case, and (3) whether discovery is complete and whether a trial date has been set."<sup>156</sup> Notwithstanding the benefits the reexamination could be to the district courts, judges still deny motions to stay particularly when the discovery is complete and the trial date set because the court has already invested its time and resources toward the resolution.<sup>157</sup>

However, if all district courts adopt local patent rules similar to the Eastern District, then the court's concern of having already invested substantial resources would not occur because the patent rules require the defendant to immediately list its affirmative defenses soon after he is served with the complaint. The nationally adopted patent rules should provide the defendant with sufficient time to prepare their defense, so that the local rules are not advantageous only for the plaintiff. If the defendant claims the patent is invalid, then the court should be mandated to issue a stay in litigation pending a post-grant opposition review. The post-grant review would not be limited only prior art of patents and printed publications, but all prior art that raised a substantial issue of patentability would be reviewed.

The Board of Patent Appeals and Interferences ("BPAI") of the PTO is composed of members having expertise in science coupled with a law degree.<sup>158</sup> The BPAI accepts legal briefs, holds hearings, admits evidence, and issues written opinions with authority to remand cases.<sup>159</sup> The BPAI is in the best position owing to members both having a law and science degree, to hear the post-grant opposition to which courts would defer to during trial. The reform would require substantial funding since the PTO is already understaffed and overworked. However, the result in the increase in value of all patents produced from a uniform patent system would outweigh the costs.

The post-grant opposition proceeding should be an accelerated review that is sent immediately to the BPAI so as not to prolong the trial and, therefore, could not be used as a tactical advantage of the moving party. In connection with the local patent rules, the post-grant review would be granted once the parties' final complaints and defenses are considered binding, which is before trial has begun. Therefore, the post-grant review would possibly simplify the issues for trial if not eliminate the need for trial completely. Even more advantageous, would be the BPAI opinion on validity as guidance to the trial court in the highly technical area. The BPAI could also issue a non-binding expert opinion as to whether the defendant's

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<sup>154</sup> Stacy, *supra* note 152, at 173.

<sup>155</sup> See *Soverain Software LLC v. Amazon.com, Inc.*, 356 F. Supp. 2d 660, 662 (E.D. Tex. 2005) ("The district court has the inherent power to control its own docket, including the power to stay proceedings.").

<sup>156</sup> *Id.*

<sup>157</sup> See, e.g., *id.* at 663 ("[T]he possibility of issue simplification, the resources already invested in this case, and the rapidly approaching trial date, the Courts find a stay this late in the proceedings is inappropriate.").

<sup>158</sup> Dennis J. Harney, *The Obvious Need for Deference: Federal Circuit Review of Patent and Trademark Office Determinations of Mixed Questions of Law and Fact*, 28 DAYTON L. REV. 61, 65 (2002).

<sup>159</sup> Jeffrey W. Rennecker, *Ex Parte Appellate Procedure in the Patent Office and the Federal Circuit's Respective Standards of Review*, 4 TEX. INTELL. PROP. L.J. 335, 357 (1996).

product actually infringes the patent at issue because the determination of the scope of the patent is well within the PTO's expertise.

Forum shopping would be eliminated if every district adopted local patent rules that made the defendant's defenses binding early in the pre-trial setting together with the mandatory post-grant review for defenses raising invalidity. The proposal would unify the district courts' treatment of patent cases, thus, eliminating one reason to forum shop. The uniformity of patent law would be achieved since courts would defer to one agency that would consistently determine issues of patent validity.

#### IV. CONCLUSION

The disproportionate amount of patent cases being filed in the Eastern District of Texas is evidence of vast forum shopping that suggests the application of patent law throughout the district courts is inconsistent. In order to unify patent law, all district courts should adopt similar local rules and the BPAI should be restructured to allow for a post-grant review process that courts will defer to under administrative standard of review. The implementation of this proposal would decrease forum shopping and result in more valuable patents.