

Certifying Questions in Patent Cases

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ABSTRACT: The Federal Circuit is unique among the courts of appeals in that it routinely applies the precedent of other circuits as binding law. Specifically, the Federal Circuit applies its own prior decisions to issues that are “unique to” or “pertain to” patent law. But, for nonpatent issues, the Federal Circuit applies the precedent of the numbered, regional circuit in which the district court is located. Issues governed by regional circuit law in patent cases include matters of civil procedure, attorney-client privilege, substantive claims under copyright law, trademark law, antitrust law, and more.

Numerous scholars have criticized the Federal Circuit’s choice-of-law regime because it makes the law unstable and results hard to predict, undermining the legal uniformity Congress created the Federal Circuit to provide. Yet proposals to change the Federal Circuit’s choice-of-law rules have been around for decades and the circuit has shown little interest in reform. Indeed, there are good (though not bulletproof) reasons for the Federal Circuit to look to regional circuit law on issues that arise in patent and nonpatent cases alike, rather than developing a distinct body of law that district courts must apply in patent cases—or to patent claims—only.

Given that regional circuit law is here to stay at the Federal Circuit, this Article proposes a novel, procedural solution to the problems that arise when regional circuit law provides no clear answer to a question on which it governs: the Federal Circuit should certify that question to the regional circuit. Certification would promote accuracy and predictability because the Federal Circuit would not need to guess about regional circuit law, as it does now. Similarly, because the Federal Circuit doesn’t have jurisdiction over every

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patent-related case filed in federal court, we might also allow the regional circuits to certify unsettled questions of patent law to the Federal Circuit.

Importantly, an intercircuit certification procedure would be easy to implement: no legislation would be required. The Federal Circuit and the regional circuits could simply adopt local rules allowing certified questions, similar to the rules that currently allow federal courts to certify questions of state law to state supreme courts. And though Article III's case-or-controversy requirement and the Federal Circuit's exclusive statutory jurisdiction might present obstacles to intercircuit certification, those obstacles can likely be surmounted so long as the underlying dispute remains live and the Federal Circuit sends only discrete questions of nonpatent law to the regional circuits.

INTRODUCTION 793

I. PATENT LITIGATION, THE FEDERAL CIRCUIT, AND CHOICE OF LAW..... 797

 A. PATENT LITIGATION AND THE FEDERAL CIRCUIT 797

 B. FEDERAL CIRCUIT CHOICE OF LAW..... 800

II. GUESSING ABOUT “WHAT THE LAW IS”: TRANSFER OF VENUE 802

 A. TRANSFER CASE LAW..... 802

 1. Transfer Basics..... 803

 2. Transfer Precedent, or, the Lack Thereof 807

 B. EMPIRICAL PROOF..... 811

 1. Lack of Precedential Decisions 812

 2. Treating Nonprecedential Decisions as Precedent 813

III. GUESSING ABOUT “WHAT THE LAW IS”: BEYOND TRANSFER 817

 A. NONPATENT CLAIMS 817

 1. Copyright 817

 2. Antitrust 818

 B. ATTORNEY-CLIENT PRIVILEGE 820

 C. MORE GUESSING GAMES 823

IV. CERTIFIED QUESTIONS TO THE REGIONAL CIRCUIT: A NEXT-BEST SOLUTION 824

 A. CHANGING THE FEDERAL CIRCUIT’S CHOICE-OF-LAW RULES IS UNREALISTIC AND MAY BE UNWARRANTED 824

 B. THE MODEL: CERTIFICATION OF UNSETTLED STATE-LAW ISSUES TO STATE SUPREME COURTS..... 825

 C. THE PROPOSAL AND ITS BENEFITS..... 827

 D. OBJECTIONS AND RESPONSES..... 829

 E. POTENTIAL EXPANSION: CERTIFIED QUESTIONS TO THE FEDERAL CIRCUIT..... 834

CONCLUSION	835
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INTRODUCTION

Patent law. It’s a field that conjures up thoughts of artificial intelligence, self-driving electric cars, life-saving biotechnologies, and the much-maligned “patent troll.”¹

Yet one of the hottest issues in patent law right now? Whether litigants can use the extraordinary writ of mandamus to obtain interlocutory appellate review of district court decisions on motions to transfer venue for convenience purposes under 28 U.S.C. § 1404(a).²

WAIT! Don’t stop reading! Venue transfer is such an important and contentious issue in patent disputes that it recently attracted the attention of the Senate Judiciary Committee³ and Chief Justice Roberts.⁴ That’s in part because, for the past decade, nearly half of all patent disputes nationwide have been filed in just two federal district courts: the Eastern and Western Districts of Texas, with the vast majority of those cases being filed in the surprising locales of Marshall (population 23,000) and Waco (a city that, until not long ago, was better known for being the home of Dr. Pepper than for patent litigation).⁵

The tech companies that are often sued in Marshall and Waco—Apple, Google, Samsung, Microsoft, and the like—are usually eager to have their cases transferred away from those plaintiff-friendly patent litigation hotbeds, preferably to a district closer to home on the West Coast.⁶ When those defendants’ transfer motions are denied, which isn’t unusual in the Texas

1. See Mark A. Lemley & A. Douglas Melamed, *Missing the Forest for the Trolls*, 113 COLUM. L. REV. 2117, 2118 (2013).

2. See J. Jonas Anderson, Paul R. Gugliuzza & Jason A. Rantanen, *Extraordinary Writ or Ordinary Remedy? Mandamus at the Federal Circuit*, 100 WASH. U. L. REV. 327, 346 (2022); see also 28 U.S.C. § 1404(a) (2018) (“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 . . .”).

3. Letter from Patrick Leahy & Thom Tillis, Sens., to C.J. John Roberts, Presiding Officer, Jud. Conf. of the U.S. (Nov. 2, 2021), <https://www.patentprogress.org/wp-content/uploads/2021/11/11.2-TT-PL-Ltr-to-Judicial-Conference-re-Patent-Forum-Shopping-Final.pdf> [<https://perma.cc/SYMH-gRFS>].

4. C.J. JOHN G. ROBERTS, JR., 2021 YEAR-END REPORT ON THE FEDERAL JUDICIARY 3–5 (2021), <https://www.supremecourt.gov/publicinfo/year-end/2021year-endreport.pdf> [<https://perma.cc/3P7K-MTD2>].

5. See J. Jonas Anderson & Paul R. Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 DUKE L.J. 419, 437–448 (2021).

6. Paul R. Gugliuzza, Jonas Anderson & Jason Rantanen, *Who Escapes Texas? And Where Do They Go? Mandamus Petitioners and Transferee Courts in Patent Venue Disputes*, PATENTLY-O (June 17, 2022), <https://patentlyo.com/patent/2022/06/mandamus-petitioners-transferee.html> [<https://perma.cc/Z2qU-JYLF>].

courts preferred by patentees,⁷ they use the seemingly obscure mechanism of mandamus⁸ to seek immediate review by the Federal Circuit, which hears all appeals nationwide in cases “arising under” patent law.⁹ Since 2008, the Federal Circuit has decided more than one hundred mandamus petitions seeking transfer of venue; by contrast, the regional circuits *combined* hear no more than a handful every year.¹⁰ And the Federal Circuit grants mandamus petitions seeking transfer out of the Eastern or Western Districts of Texas nearly forty percent of the time¹¹—a high grant rate for a writ that is one of the common law’s “extraordinary” writs and that, under Supreme Court precedent, is supposed to be “a ‘drastic and extraordinary’ remedy ‘reserved for really extraordinary causes.’”¹²

Despite the importance of venue-transfer litigation and the frequency with which it occurs in patent cases, there is practically no binding appellate precedent on the topic. That is because of the choice-of-law rules applied by the Federal Circuit. Transfer of venue, like other procedural issues in patent cases, is governed not by the precedent of the Federal Circuit—the court that will decide any appeal. Rather, the Federal Circuit has decreed that nonpatent issues in patent cases are governed by the precedent of the regional circuit in which the district court is located.¹³ (So, for patent cases in Texas, the Fifth Circuit.) But not only are transfer disputes rarely decided by the regional circuits, the regional circuits, because of the Federal Circuit’s exclusive jurisdiction over patent cases, *never* decide transfer disputes *in the context of patent litigation*. As we show below, the Federal Circuit compounds this lack of binding authority by rarely designating its own venue mandamus decisions as precedential (whether or not those decisions would be binding on lower courts as a formal matter).¹⁴ All of this leads district judges, litigants, and sometimes even the Federal Circuit itself, to effectively guess about what the law is on an issue that can be hugely important in patent cases.¹⁵

7. Paul R. Gugliuzza & Jonas Anderson, *Guest Post: How It Started . . . How It’s Going: Venue Transfers in the Western District of Texas*, PATENTLY-O (Oct. 28, 2021), <https://patentlyo.com/patent/2021/10/startedhow-transfers-district.html> [<https://perma.cc/8ZPX-7C3M>].

8. Obscure only to those who do not closely follow developments in federal appellate jurisdiction! See Adam N. Steinman, *Reinventing Appellate Jurisdiction*, 48 B.C. L. REV. 1237, 1242 (2007) (“Using either the collateral order doctrine or appellate mandamus, federal appellate courts have exercised review over every kind of interlocutory order imaginable.”).

9. 28 U.S.C. § 1295(a)(1).

10. Anderson et al., *supra* note 2, at 344–46.

11. *Id.* at 345.

12. *Cheney v. U.S. Dist. Ct.*, 542 U.S. 367, 380 (2004) (quoting *Ex parte Fahey*, 332 U.S. 258, 259–60 (1947)).

13. See *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 55 F.4th 1332, 1339 (Fed. Cir. 2022).

14. See *infra* Section II.B.

15. For an example of a district judge lamenting this state of affairs, see *Motion Offense, LLC v. Google LLC*, No. 21-cv-00514, 2022 WL 5027730, at *1, *4 (W.D. Tex. Oct. 4, 2022) (stating that “[t]he Court’s decision turns on whether it should apply traditional Fifth Circuit transfer law or apply the Federal Circuit’s interpretations of Fifth Circuit transfer law” and that “this Court

And venue is not the only issue on which the Federal Circuit's choice-of-law regime requires courts and litigants to guess about what the law is. Below, we catalogue examples from fields as varied as antitrust law, copyright law, trademark law, the law of attorney-client privilege, various issues of procedure, and more.¹⁶ For now, the point is that a system in which there is basically no binding precedent on important issues in high-stakes patent cases is . . . not optimal.

Indeed, many scholars have criticized the Federal Circuit's choice-of-law regime, arguing that it creates instability in the law and unpredictability in results.¹⁷ One obvious fix would be for the Federal Circuit to change its choice-of-law rules so that more issues are governed by the nationwide precedent the circuit creates.¹⁸ But proposals to change the Federal Circuit's choice-of-law rules have been around for decades, yet the circuit has shown little interest in reform. Indeed, there are good (though not bulletproof) reasons for the Federal Circuit to look to regional circuit law on various issues that arise in both patent and nonpatent cases alike, rather than developing unique bodies of law that district courts must apply in patent cases—or to patent claims—only.¹⁹

Given that regional circuit law is here to stay in patent litigation, this Article proposes a novel, procedural solution to the problems that arise when the Federal Circuit must decide a question on which the relevant circuit's law

cannot and does not overrule the reasoning of the Federal Circuit in a patent case. Although the Federal Circuit issues unpublished, nonprecedential transfer opinions, the Federal Circuit frequently cites these opinions as though they precedentially interpret Fifth Circuit law”).

16. See *infra* Part III.

17. See, e.g., Jennifer E. Sturiale, *A Balanced Consideration of the Federal Circuit's Choice-of-Law Rule*, 2020 UTAH L. REV. 475, 477 (“The Federal Circuit’s choice-of-law rule has prompted criticism from scholars and commentators, particularly as the rule relates to procedural law. Most have noted the incoherence, inconsistent application, and unworkability of the rule.”); Peter J. Karol, *Who’s at the Helm? The Federal Circuit’s Rule of Deference and the Systemic Absence of Controlling Precedent in Matters of Patent Litigation Procedure*, 37 AIPLA Q.J. 1, 42 (2009) (“[U]nder the Rule, the Federal Circuit is never in a position to tackle a procedural issue head on. Rather, the Rule is applied by analogizing from other circuit precedent in cases that are not on-point.”); Kimberly A. Moore, *Juries, Patent Cases, & A Lack of Transparency*, 39 HOUS. L. REV. 779, 800 (2002) (“[U]nder this rule, if regional circuit law ought to apply, and the regional circuit has not spoken to a particular issue, the Federal Circuit is left to predict how the regional circuit would rule on the issue”); Joan E. Schaffner, *Federal Circuit “Choice of Law”: Erie Through the Looking Glass*, 81 IOWA L. REV. 1173, 1221 (1996) (“Under the current Federal Circuit approach, if the regional circuit court has not spoken on a legal issue for which the Federal Circuit defers to regional circuit law, the Federal Circuit must predict how that court would decide the issue. This approach is contrary to the ‘principle of competence,’ creates unnecessary complexity in the resolution of the issue, and can be unfair to the parties.” (footnotes omitted)); Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 59 (1989) (arguing that “[t]he rule requiring the CAFC to defer to regional law in nonpatent substantive areas does not work well” in part because “there is no regional law on some of the issues the CAFC faces[] and referring to the law of the regional circuits poses the potential for significantly distorting the development of the law”).

18. This is a common thread of many proposals in the articles cited in the preceding footnote.

19. See *infra* Section IV.A.

provides no clear answer: The Federal Circuit should certify questions to the relevant circuit so the Federal Circuit can obtain an authoritative answer about what regional circuit law is on the matter in question. A certification regime would promote more accurate decision-making because the Federal Circuit would not need to guess about regional circuit law on an unsettled legal point. And it would aid in predictability because it would eliminate any chance of the Federal Circuit adopting unique (or, some might say, “exceptionalist”²⁰) rules of nonpatent law to be applied only in cases that fall within its appellate jurisdiction.

To that end, a similar regime that would allow the regional circuits to certify unsettled questions of patent law to the Federal Circuit is worth considering. The Supreme Court has recently restricted the class of patent-related cases that “arise under” federal patent law (and so are subject to the Federal Circuit’s exclusive jurisdiction),²¹ meaning that the regional circuits are sometimes confronted with patent issues that arise in the context of tort claims,²² breach of contract claims,²³ antitrust claims,²⁴ and more.

Importantly, an intercircuit certification procedure would be easy to implement: no legislation would be required. The Federal Circuit and the regional circuits, through a majority vote of the courts’ active judges, could simply adopt local rules permitting certified questions, similar to the local rules that allow federal courts to certify questions of state law to state supreme courts.²⁵ And though Article III’s case-or-controversy requirement and the Federal Circuit’s exclusive statutory jurisdiction might present obstacles to certification from one federal court to another in patent cases, those obstacles can likely be surmounted so long as the underlying dispute remains live²⁶ and the Federal Circuit sends only discrete questions of nonpatent law to the regional circuits.²⁷

20. *E.g.*, Peter Lee, *The Supreme Assimilation of Patent Law*, 114 MICH. L. REV. 1413, 1416 (2016) (“[T]he Supreme Court’s recent patent jurisprudence reflects a project of eliminating ‘patent exceptionalism’ and assimilating patent doctrine to general legal principles.”).

21. *See* *Gunn v. Minton*, 568 U.S. 251, 258, 260 (2013).

22. *E.g.*, *Seed Co. v. Westerman*, 832 F.3d 325, 331 (D.C. Cir. 2016).

23. *E.g.*, *MDS (Can.) Inc. v. Rad Source Techs., Inc.*, 720 F.3d 833, 841 (11th Cir. 2013).

24. *Cf.* *Xitronix Corp. v. KLA-Tencor Corp.*, 916 F.3d 429, 444 (5th Cir. 2019) (refusing, arguably erroneously, to decide a patent-related antitrust claim); *see also* Paul R. Gugliuzza, *Rising Confusion About “Arising Under” Jurisdiction in Patent Cases*, 69 EMORY L.J. 459, 494–97 (2019) [hereinafter Gugliuzza, *Rising Confusion*] (criticizing the Fifth Circuit’s decision in *Xitronix*).

25. *See infra* Section IV.C.

26. *See, e.g.*, *Spencer v. Aetna Life & Cas. Ins. Co.*, 611 P.2d 149, 151 (Kan. 1980) (“This [certified] question arises from an actual case and controversy and although presented as a question of law, it neither violates the case or controversy requirement nor the separation of powers doctrine on advisory opinions.”).

27. *See, e.g.*, *Shebestor v. Triple Crown Insurers*, 826 P.2d 603, 606 n.4 (Okla. 1992) (“By answering a state-law question certified by a federal court, we may affect the outcome of federal litigation, but it is the federal court who hears and decides the cause.”). For a more detailed discussion of our responses to possible objections to a certification regime, *see infra* Section IV.D.

Despite significant scholarship on Federal Circuit procedure generally²⁸ and the court's choice-of-law regime specifically,²⁹ the idea of certifying questions from the Federal Circuit to the regional circuits has received almost no scholarly attention, garnering only a brief, bearish mention in a single law review article.³⁰ And yet, as we argue, certification is a realistic and reasonably efficient way to solve the problem of key legal issues that frequently arise in patent litigation, such as transfer of venue, being governed by essentially no precedent at all.

The remainder of this Article proceeds as follows. Part I provides necessary background on patent litigation, the Federal Circuit, and the choice-of-law rules the circuit has developed. Part II begins dissecting the problems with those rules, focusing on the issue on which the Federal Circuit's choice-of-law regime has caused the most difficulty: transfer of venue. Part III continues the critique, highlighting "guesses" courts have had to make because of the Federal Circuit's choice-of-law regime in fields as varied as copyright, antitrust, attorney-client privilege, and more. Part IV presents our reform proposal, under which the Federal Circuit would certify unsettled questions of nonpatent law to the regional circuits. It also considers the possibility of allowing the regional circuits to certify questions of patent law to the Federal Circuit. And it engages objections to the certification procedure we propose.

I. PATENT LITIGATION, THE FEDERAL CIRCUIT, AND CHOICE OF LAW

To understand why choice of law *matters* in patent disputes, it's helpful to first understand a bit about the federal courts' jurisdiction over patent cases, the Federal Circuit as an institution, and the choice-of-law principles the court has developed.

A. PATENT LITIGATION AND THE FEDERAL CIRCUIT

As every law student learns in first-year civil procedure, the federal courts have subject matter jurisdiction over cases "arising under" federal law.³¹ The statute granting the federal courts subject matter jurisdiction over patent cases specifically, 28 U.S.C. § 1338(a), uses language similar to the general federal question statute, giving the district courts original jurisdiction over any case "arising under any Act of Congress relating to patents."³² But, unlike the

28. For an extensive bibliography, see Ryan Vacca, *The Federal Circuit as an Institution*, in 2 RESEARCH HANDBOOK ON THE ECONOMICS OF INTELLECTUAL PROPERTY LAW 104, 155-57 (Peter S. Menell & David L. Schwartz eds., 2019).

29. See *supra* note 17.

30. See Peter S. Menell, *API Copyrightability Bleak House: Unraveling and Repairing the Oracle v. Google Jurisdictional Mess*, 31 BERKELEY TECH. L.J. 1515, 1593 (2016) (dismissing the possibility because congressional action would be needed and definitive answers would require the regional circuit to convene en banc); see also *infra* Section IV.D (responding to those objections).

31. 28 U.S.C. § 1331.

32. *Id.* § 1338(a).

general federal question statute, § 1338(a) makes the federal courts' jurisdiction over patent cases *exclusive*, providing that “[n]o State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents.”³³ The Federal Circuit’s jurisdictional statute, § 1295(a)(1), also employs this “arising under” language, granting the court exclusive jurisdiction over appeals from district courts in any case “arising under” patent law.³⁴

The courts have interpreted the “arising under” language in all of these statutes identically.³⁵ In other words, the analysis of whether a case arises under federal law generally or under patent law specifically will usually look the same—the only difference will be the consequence of that ruling. If a case arises under federal law generally, the state and federal courts will have concurrent jurisdiction, and appellate jurisdiction will lie in the regional circuit encompassing the district court. But if a case arises under patent law specifically, federal jurisdiction is exclusive, and any appeal will be heard by the Federal Circuit.³⁶

In many patent-related disputes, it’s plain that the case “arises under” patent law and so is subject to the exclusive jurisdiction of the federal district courts and, on appeal, the Federal Circuit. A case in which a plaintiff asserts a claim of patent infringement, for example, indisputably arises under patent law.³⁷ The same goes for a case including a claim seeking a declaratory judgment that a patent is invalid or not infringed.³⁸

But many cases that don’t include claims about patent infringement or validity nevertheless implicate patent law and therefore potentially “arise

33. *Id.*

34. *Id.* § 1295(a)(1).

35. *See, e.g.,* *Gunn v. Minton*, 568 U.S. 251, 257 (2013) (“Adhering to the demands of ‘[l]inguistic consistency,’ we have interpreted the phrase ‘arising under’ in both sections identically, applying our § 1331 and § 1338(a) precedents interchangeably.” (alteration in original) (quoting *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808–09 (1988))); *Xitronix Corp. v. KLA-Tencor Corp.*, 882 F.3d 1075, 1079 (Fed. Cir. 2018) (“While the parties argue *Gunn* is inapplicable because it concerns district court jurisdiction over state claims, the indistinguishable statutory language of §§ 1295 and 1338 requires our careful consideration of *Gunn* in interpreting our jurisdictional statute.”).

36. There is one minor way in which the jurisdictional analysis under the general federal question statute, § 1331, and the patent-specific statute, § 1338(a), differs. That difference involves the so-called well-pleaded complaint rule. Under the Supreme Court’s decisions interpreting § 1331 (most famously, *Louisville & Nashville R.R. v. Mottley*, 211 U.S. 149, 152 (1908)), the federal question providing the basis for jurisdiction must appear in the plaintiff’s well-pleaded complaint, that is, in the plaintiff’s statement of its own claims. Neither federal issues raised in defense, nor federal counterclaims, will create federal question jurisdiction. *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 831 (2002). In patent cases, by contrast, Congress has partially relaxed the well-pleaded complaint rule, providing that patent law counterclaims do, in fact, cause a case to arise under patent law. *See Leahy-Smith America Invents Act*, Pub. L. No. 112-29, § 19(a), 125 Stat. 284, 331 (2011). Patent law defenses, however, remain insufficient.

37. 13D CHARLES ALAN WRIGHT, ARTHUR R. MILLER, EDWARD H. COOPER & RICHARD D. FREER, *FEDERAL PRACTICE AND PROCEDURE* § 3582 (3d ed. 2023).

38. *Id.*

under” patent law for jurisdictional purposes. For example, plaintiffs often base antitrust claims on patent-related conduct.³⁹ Though patent-related antitrust claims are usually (but not always) asserted under federal statutes such as the Sherman Act, claims created by state law can raise patent issues, too.⁴⁰ Common examples include suits for breach of a patent licensing contract,⁴¹ tort claims based on false allegations of patent infringement,⁴² and malpractice claims against lawyers who litigated a prior infringement dispute or who prosecuted a patent.⁴³

It’s often unclear whether these patent-related cases arise under patent law for the purpose of triggering the federal district courts’ and the Federal Circuit’s exclusive jurisdiction. For several decades, the Federal Circuit held that cases involving claims created by state law or by a federal law besides the Patent Act nevertheless arose under patent law any time the case required the court to *apply* patent law.⁴⁴ But, in 2013, the Supreme Court overturned the Federal Circuit’s precedent. In *Gunn v. Minton*, the Court held that malpractice claims against patent attorneys “will rarely, if ever, arise under federal patent law” because they implicate only backward-looking, case-specific issues that are not important “to the federal system as a whole.”⁴⁵

Though the *Gunn* decision limited the federal district courts’ and the Federal Circuit’s exclusive jurisdiction over cases involving nonpatent claims with patent issues embedded in them, the Federal Circuit still sometimes has jurisdiction over cases that don’t involve any live patent claims at all. That’s because the Federal Circuit’s appellate jurisdiction, like district court jurisdiction, is based on the plaintiff’s “well-pleaded complaint.” So, if the complaint alleges, say, both copyright and patent infringement,⁴⁶ or both

39. See, e.g., *Ark. Carpenters Health & Welfare Fund v. Bayer AG*, 604 F.3d 98, 104 (2d Cir. 2010) (bringing antitrust challenge to a “reverse payment” settlement of patent litigation); *In re Ciprofloxacin Hydrochloride Antitrust Litig.*, 544 F.3d 1323, 1331 (Fed. Cir. 2008) (appealing different issue in the same litigation).

40. See, e.g., *Eon Lab’s, Inc. v. Smithkline Beecham Corp.*, 298 F. Supp. 2d 175, 177 (D. Mass. 2003) (asserting federal and state antitrust claims based on the defendant’s conduct in enforcing a patent).

41. See generally Amelia Smith Rinehart, *The Federal Question in Patent-License Cases*, 90 IND. L.J. 659, 662–68 (2015) (citing numerous case examples).

42. See generally Paul R. Gugliuzza, *Patent Trolls and Preemption*, 101 VA. L. REV. 1579, 1588–90 (2015) [hereinafter Gugliuzza, *Patent Trolls*] (citing case examples).

43. See generally *Gunn v. Minton*, 568 U.S. 251 (2013) (malpractice case); see also Paul R. Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1809–15 (2013) [hereinafter Gugliuzza, *The Federal Circuit*] (citing additional malpractice cases).

44. See, e.g., *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1329 (Fed. Cir. 1998); *Additive Controls & Measurement Sys., Inc. v. Flowdata, Inc.*, 986 F.2d 476, 478–79 (Fed. Cir. 1993).

45. *Gunn v. Minton*, 568 U.S. 251, 258, 260 (2013).

46. E.g., *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1353 (Fed. Cir. 2014).

trade dress and patent infringement,⁴⁷ any appeal will go to the Federal Circuit—even if the nonpatent claims are the only claims left in the case by the time an appeal occurs.⁴⁸

For the purpose of this Article on Federal Circuit choice of law, two key points are important to take away from this discussion of patent litigation and jurisdiction. First, the Federal Circuit often must decide nonpatent issues that arise in cases that include (or had included) claims arising under patent law. These include both substantive nonpatent issues, such as issues of copyright, antitrust, trademark law, and more, as well as the trans-substantive issues that arise in any sort of federal litigation, such as questions about procedure, jurisdiction, standards of proof, standards of appellate review, and more.

Second, the regional circuits sometimes must decide patent-law issues embedded within cases in which no claim arises under patent law. Those sorts of cases include, but are not limited to, patent licensing disputes (where the patent's validity or infringement might be key to determining whether the license contract has been breached), patent-related tort cases (such as claims for legal malpractice against a patent attorney), and patent-related antitrust cases (including claims that a patentee has obtained or enforced a patent in anticompetitive ways).⁴⁹

B. FEDERAL CIRCUIT CHOICE OF LAW

Because the Federal Circuit often must decide issues of nonpatent law, the question arises: What precedent governs those decisions? Shortly after Congress created the Federal Circuit, the court announced that it would apply its own precedent to questions of substantive patent law but would apply the precedent of the relevant regional circuit on all other issues.⁵⁰ In a later, en banc decision, the court broadened the applicability of its own precedent to nonpatent issues, holding that its precedent would control (1) “if the issue ‘pertain[s] to patent [law],’”⁵¹ (2) “if [the issue] ‘bears an essential relationship to matters committed to [the Federal Circuit’s] exclusive control by statute,’”⁵²

47. *Cf. Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 828 (2002) (involving a claim for trade dress infringement and a counterclaim for patent infringement prior to promulgation of the America Invents Act). For further discussion of the America Invents Act, see *supra* note 36.

48. *E.g., Oracle Am.*, 750 F.3d at 1353.

49. *See Gugliuzza, Rising Confusion*, *supra* note 24, at 463.

50. *Atari, Inc. v. JS & A Grp., Inc.*, 747 F.2d 1422, 1439–40 (Fed. Cir. 1984), *overruled in relevant part by Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059 (Fed. Cir. 1998).

51. *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part) (alteration in original) (quoting *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1575 (Fed. Cir. 1984)).

52. *Id.* (quoting *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 858–59 (Fed. Cir. 1991)).

or (3) “if [the issue] ‘clearly implicates the jurisprudential responsibilities of [the] court in a field within its exclusive jurisdiction.’”⁵³

The main reason the Federal Circuit has given to justify its convoluted choice-of-law regime is that it’s simple for the district courts to apply. As the circuit put it in its first case announcing the distinction between patent and nonpatent issues: “It would be at best unfair to hold in this case that the district court, at risk of error, should have ‘served two masters,’ or that it should have looked, Janus-like, in two directions in its conduct of that judicial process.”⁵⁴

Yet federal courts of appeals are usually not bound by other circuits’ law,⁵⁵ and good reasons exist for criticizing the Federal Circuit’s choice-of-law doctrine. Most notably, it’s not easy to predict where the circuit will draw the line between patent and nonpatent matters (or matters that “pertain to” patent law and those that don’t).⁵⁶ Moreover, the court doesn’t always articulate its choice-of-law rules consistently, and it has applied different bodies of law to the same issue in different cases.⁵⁷ Attorney-client privilege, for instance, is sometimes governed by Federal Circuit law and sometimes by regional circuit law.⁵⁸ And, as we discuss in more detail below, when the regional circuit has not decided an issue governed by regional circuit law, the Federal Circuit takes the anomalous step of predicting how the regional circuit *would* rule, rather than declaring the content of federal law.⁵⁹ Most fundamentally, one might question the entire notion of “circuit law,” given that what the federal

53. *Id.* (quoting *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987)).

54. *Atari*, 747 F.2d at 1439; *accord Midwest Indus.*, 175 F.3d at 1359 (“When we apply regional circuit law to nonpatent issues, we do so in order to avoid the risk that district courts and litigants will be forced to select from two competing lines of authority based on which circuit may have jurisdiction over an appeal that may ultimately be taken, and to minimize the incentive for forum-shopping by parties who are in a position to determine, by their selection of claims, the court to which an appeal will go.”).

55. *See Dreyfuss, supra* note 17, at 38 n.219.

56. *See Moore, supra* note 17, at 800–01.

57. *See, e.g., Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1055 n.5 (Fed. Cir. 2001) (noting that “there appears to be some confusion over whether evidentiary rulings in patent cases should be reviewed under the law of the regional circuit or under Federal Circuit law” and comparing cases); *Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1368 n.13 (Fed. Cir. 2009) (stating that “[t]here may be some question as to whether this court reviews jury instructions relating to patent law under our own law or regional circuit law” and comparing cases).

58. *Compare In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 804 (Fed. Cir. 2000) (applying Federal Circuit law when the allegedly privileged document “relate[d] to an invention . . . consider[ed] for possible patent protection”), *with Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1350–51 (Fed. Cir. 2005) (applying regional circuit law in determining whether waiver of privilege extended to communications concerning the on-sale bar of the Patent Act). And, if the underlying legal claim arises under state law, *state* privilege law may govern. *See* FED. R. EVID. 501 (“[I]n a civil case, state law governs privilege regarding a claim or defense for which state law supplies the rule of decision.”); *Home Indem. Co. v. Lane Powell Moss & Miller*, 43 F.3d 1322, 1328 (9th Cir. 1995) (“Because Alaska state law supplied the rule of decision with respect to the claims in this case, Alaska privilege rules had to be applied.”).

59. *E.g., Wi-LAN, Inc. v. Kilpatrick Townsend & Stockton LLP*, 684 F.3d 1364, 1368 (Fed. Cir. 2012); *see also infra* Parts III–IV.

courts of appeals are really doing is interpreting and applying a uniform body of *federal* law, as filtered through a particular circuit's precedents.⁶⁰

But, taking the courts at their word that there *is* such a thing as “circuit law,”⁶¹ a more efficient approach might be for Federal Circuit law to apply to all matters in cases that arise under patent law—that is, to all matters in all cases that fall within the Federal Circuit's appellate jurisdiction. That simple, bright-line approach would eliminate litigation over which circuit's law applies and seemingly enhance predictability. Indeed, the current choice-of-law rules can lead to the strange result that a long line of Federal Circuit decisions on a particular nonpatent issue that frequently arises in patent cases—such as transfer of venue—are not actually binding authority because the issue is technically governed by regional circuit law.

II. GUESSING ABOUT “WHAT THE LAW IS”: TRANSFER OF VENUE

Despite those problems, the Federal Circuit has shown little interest in rethinking its choice-of-law regime. The reality that regional circuit law is here to stay in patent litigation is what motivates the law reform proposal at the center of this Article: allowing the Federal Circuit to certify questions of nonpatent law to the regional circuits.

Before sketching that proposal, however, we should more clearly define the problem we're trying to solve: It's not just the general confusion created by the Federal Circuit's choice-of-law regime. Rather, it's the specific problem of courts and litigants having to *guess* about what the law is because there's no authoritative precedent on an issue that is ostensibly governed by regional circuit law.

We begin in this Part by discussing the legal issue on which the Federal Circuit's choice-of-law regime has left a void of binding precedent in many recent cases: transfer of venue for convenience purposes under 28 U.S.C. § 1404(a). We illustrate the difficulties that have arisen with both a qualitative analysis of the relevant case law and a quantitative snapshot of the Federal Circuit's citation practices and its tendencies around designating venue decisions as precedential or not.

A. TRANSFER CASE LAW

The most important and high-profile example of inapposite—or nonexistent—regional circuit case law being crucial to patent litigation is on the issue of venue transfer.

60. See Thomas B. Bennett, *There Is No Such Thing as Circuit Law*, 107 MINN. L. REV. 1681, 1685–86 (2023).

61. Jennifer E. Sturiale, *The Other Shadow Docket: The JPML's Power to Steer Major Litigation*, 2023 U. ILL. L. REV. 105, 144 (noting that the “practical realit[y]” is that “federal law is not, in fact, uniform” and “[s]o, as a practical matter,” federal courts must sometimes choose between different approaches to questions of federal law).

1. Transfer Basics

Some background about why venue transfer is one of the most fiercely contested issues in all of patent litigation: In the early 2000s, aided by Federal Circuit precedent that allowed patentees to sue corporate defendants for patent infringement practically anywhere in the country,⁶² federal district judges began actively trying to attract patent cases to their courthouses.⁶³ The motivations for that judicial behavior are opaque—why would a judge who is paid a fixed salary and has life tenure seek out *more* work?—but likely include a desire for the intellectual challenge of patent disputes, the increased prestige or attention a judge gets from being known as a “patent judge,” and the economic rewards to the local community.⁶⁴ The early winner in the court competition for patent cases was the Eastern District of Texas and, in particular, the division of that court in the city of Marshall.⁶⁵ Patentees came to favor the Eastern District due to the rapid speed at which cases proceeded toward trial, a perception of a property rights–favoring jury pool, and the high rate of success for patentees both on dispositive motions and at trial.⁶⁶

For those same reasons, accused infringers—often West Coast–based tech companies—were eager to get *out* of the Eastern District of Texas.⁶⁷ The primary route for a defendant to seek transfer in the federal judicial system is 28 U.S.C. § 1404(a), which gives a court discretion to transfer a case to any other district “[f]or the convenience of parties and witnesses, in the interest of justice.”⁶⁸ The federal courts have drawn on Supreme Court precedent to develop a long list of “public interest” and “private interest” factors to use in making the transfer decision, looking at things like: the location of witnesses and evidence, the likely time to resolution, and the local interest in the case.⁶⁹ But the Eastern District of Texas was reluctant to transfer away the patent cases it had worked hard to attract.⁷⁰ And district court

62. See *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1584 (Fed. Cir. 1990).

63. J. Jonas Anderson, *Court Competition for Patent Cases*, 163 U. PA. L. REV. 631, 634–35 (2015); Daniel Klerman & Greg Reilly, *Forum Selling*, 89 S. CAL. L. REV. 241, 243 (2016).

64. Paul R. Gugliuzza & J. Jonas Anderson, *Why Do Judges Compete For (Patent) Cases?*, 65 WM. & MARY L. REV. (forthcoming 2024) (manuscript at 8), <https://ssrn.com/abstract=4331055> [https://perma.cc/6Q72-PHU7].

65. See Jonas Anderson, *Judge Shopping in the Eastern District of Texas*, 48 LOY. U. CHI. L.J. 539, 547 (2016).

66. Julie Creswell, *So Small a Town, So Many Patent Suits*, N.Y. TIMES (Sept. 24, 2006), <https://www.nytimes.com/2006/09/24/business/24ward.html> (on file with the *Iowa Law Review*).

67. Sam Williams, *A Haven for Patent Pirates*, MIT TECH. REV. (Feb. 3, 2006), <https://www.technologyreview.com/2006/02/03/229717/a-haven-for-patent-pirates-2> (on file with the *Iowa Law Review*).

68. 28 U.S.C. § 1404(a).

69. See *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) (citing *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 241 n.6 (1981)).

70. See Brian J. Love & James Yoon, *Predictably Expensive: A Critical Look at Patent Litigation in the Eastern District of Texas*, 20 STAN. TECH. L. REV. 1, 17 tbl.5 (2017).

transfer decisions, because they are not case-ending final judgments, normally can't be reviewed on appeal for quite a while.⁷¹

Enter the extraordinary writ of mandamus. Latin for “we command,” mandamus is one way a disappointed litigant can seek immediate review of a district court transfer decision, on the ground that a postjudgment appeal can't remedy the harm it suffers—namely, enduring trial in an inconvenient forum.⁷²

Reasonable minds might differ on whether trial in Texas instead of, say, California, is so inconvenient as to justify disrupting the usual process of appellate review, particularly for multinational corporations worth billions if not trillions of dollars.⁷³ But, in 2008, the U.S. Court of Appeals for the Fifth Circuit, sitting en banc in *In re Volkswagen of America, Inc.*, granted mandamus in a tort case pending in the Eastern District of Texas because the case arose out of a traffic accident in the Northern District of Texas, where many of the witnesses lived and much of the evidence was located.⁷⁴

Volkswagen was not a patent case; it was a personal injury case alleging products liability. Yet the Fifth Circuit mandamus dispute attracted several amicus briefs from patent lawyers, some arguing for transfer,⁷⁵ others arguing against⁷⁶—all clearly aware of the potential consequences of the Fifth Circuit's ruling for patent litigation in the Eastern District of Texas. After all, transfer of venue, as a nonpatent issue, is governed by the law of the circuit in which the district court sits.⁷⁷

And indeed, in late 2008, barely two months after the Fifth Circuit's decision in *Volkswagen*, the Federal Circuit relied heavily on *Volkswagen* to grant mandamus and order transfer of venue in a patent case for the first time ever.⁷⁸ Specifically, in *In re TS Tech USA Corp.*, the Federal Circuit ordered the

71. See *Mohawk Indus., Inc. v. Carpenter*, 558 U.S. 100, 106 (2009) (“Our admonition reflects a healthy respect for the virtues of the final-judgment rule. Permitting piecemeal, prejudgment appeals, we have recognized, undermines ‘efficient judicial administration’ and encroaches upon the prerogatives of district court judges, who play a ‘special role’ in managing ongoing litigation.” (quoting *Firestone Tire & Rubber Co. v. Risjord*, 449 U.S. 368, 374 (1981))).

72. 16 CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE AND PROCEDURE § 3935.4 (3d ed. 2023).

73. For a critical take on the use of mandamus to transfer patent litigation, see Gene Quinn, *Mandamus and the Battle over Venue in Modern America*, IPWATCHDOG (Feb. 7, 2022, 4:15 PM), <https://www.ipwatchdog.com/2022/02/07/mandamus-and-the-battle-over-venue-in-modern-america> [<https://perma.cc/M7JR-J59M>].

74. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 307 (5th Cir. 2008) (en banc).

75. Brief for Amicus Curiae Am. Intell. Prop. L. Ass'n in Support of Petitioners, *In re Volkswagen*, 545 F.3d 304 (2008) (No. 07-40058), 2008 WL 7789554, at *1.

76. Brief for Amicus Curiae AD Hoc Comm. of Intell. Prop. Trial Laws. in the E. Dist. of Tex. in Support of Respondents, *In re Volkswagen*, 545 F.3d 304 (2008) (No. 07-40058), 2008 WL 7789556, at *1.

77. *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 836 (Fed. Cir. 2003).

78. See Paul R. Gugliuzza, *The New Federal Circuit Mandamus*, 45 IND. L. REV. 343, 346 (2012) [hereinafter Gugliuzza, *Federal Circuit Mandamus*].

Eastern District of Texas to transfer an infringement suit to the Southern District of Ohio, which was closer to the witnesses and physical evidence.⁷⁹

In the wake of *TS Tech*, the Federal Circuit granted numerous mandamus petitions seeking transfer out of the Eastern District of Texas.⁸⁰ Yet patent cases continued to amass in the district. By 2015, the court was receiving over 2,500 patent cases annually, up from about three hundred in 2006, and nearly fifty percent of all patent cases filed nationwide.⁸¹

The Eastern District's reign as the undisputed capital of U.S. patent litigation ended with a 2017 Supreme Court ruling, *TC Heartland LLC v. Kraft Foods Group Brands LLC*, which overturned Federal Circuit case law that had permitted a patentee to file suit in practically any federal court in the country.⁸² *TC Heartland* markedly reduced the number of patent cases filed in the Eastern District of Texas.⁸³ In 2018 the Eastern District received fourteen percent of patent cases filed nationwide, and, in 2019 and 2020, it received nine percent.⁸⁴

TC Heartland's restrictions on venue encouraged other districts, most notably, the Western District of Texas, to compete to hear patent cases.⁸⁵ Unlike the mostly rural Eastern District, the Western District contains the tech hub of Austin, where many frequent patent infringement defendants (Google, Apple, Samsung, and the like) have established offices and, therefore, venue is more likely to be proper.⁸⁶

Though Austin provides a hook for venue in the Western District, most infringement cases have been filed one hundred miles north of Austin, in the Western District's Waco Division. One of us has explained elsewhere the reasons for Waco's meteoric rise as the most sought-after venue for patent plaintiffs.⁸⁷ In brief, it's due to the efforts of the lone district judge who sits in Waco, Judge Alan Albright. Since he was appointed to the bench in 2018, he has spoken at patent law conferences,⁸⁸ given speeches at dinners hosted by

79. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1317–18 (Fed. Cir. 2008).

80. *See* Gugliuzza, *Federal Circuit Mandamus*, *supra* note 78, at 346 (noting that the Federal Circuit granted ten transfer mandamus petitions in Eastern District patent cases between 2008 and 2011).

81. Anderson & Gugliuzza, *supra* note 5, at 438, 443–44.

82. *TC Heartland LLC v. Kraft Food Grp. Brands LLC*, 581 U.S. 258, 270 (2017).

83. Anderson & Gugliuzza, *supra* note 5, at 443.

84. *Id.*

85. *Id.* at 445.

86. *See* 28 U.S.C. § 1400(b) (permitting a patent infringement suit to be filed “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”).

87. Anderson & Gugliuzza, *supra* note 5, at 452–76.

88. *See, e.g.*, Scott Graham, *Judge Albright Sounds Ready to Resume Patent Trials in Texas*, LAW.COM (Dec. 11, 2020, 7:59 PM), <https://www.law.com/texaslawyer/2020/12/11/judge-alb-right-sounds-ready-to-resume-patent-trials-in-texas> (on file with the *Iowa Law Review*).

patent valuation companies,⁸⁹ appeared on law firm webcasts about patent litigation,⁹⁰ and presented at numerous patent bar events,⁹¹ all with the purpose of encouraging patentees to file suit in his court.⁹²

And those efforts have succeeded. In 2016 and 2017, the Western District's Waco Division received a total of five patent cases.⁹³ In 2021, it received nearly a thousand—over twenty percent of all patent cases filed nationwide.⁹⁴ Though recent changes to how the Western District assigns cases among its judges have curbed filings there slightly, in 2022, the district received 867 patent cases—two hundred more than the next busiest district (the District of Delaware).⁹⁵ Judge Albright alone received 678 of those cases—down from the 932 he received in 2021 but still almost twice as many as the judge who received the second most filings (Judge Rodney Gilstrap in the Eastern District of Texas (366)).⁹⁶

Just like in the Eastern District of Texas, accused infringers have been regularly filing motions to transfer venue out of the Western District of Texas.⁹⁷ The reasons are the same: the accused infringers are often West Coast-based tech companies for whom litigation in California would be more convenient—and offer a home-field advantage.⁹⁸ But those motions have frequently been denied.⁹⁹

In his first three years on the bench, Judge Albright decided roughly sixty contested motions to transfer venue away from the Western District; he granted only about a quarter of them.¹⁰⁰ By comparison, other districts with large dockets of patent cases grant about half of the transfer motions they

89. See, e.g., Scott Graham, *Skilled in the Art: Viasat Demands \$9M in Fees—and \$2 in Punitives + How Far Can Judges Go in Touting Their Districts?*, LAW.COM (Sept. 3, 2019, 9:00 PM), <https://www.law.com/2019/09/03/skilled-in-the-art-viasat-demands-9m-in-fees-and-2-in-punitives-how-far-can-judges-go-in-touting-their-districts> (on file with the *Iowa Law Review*).

90. See, e.g., Scott Graham, *Skilled in the Art: Less Is More When It Comes to IP Trials*, LAW.COM (Dec. 18, 2020, 8:22 PM), <https://www.law.com/2020/12/18/skilled-in-the-art-less-is-more-when-it-comes-to-ip-trials> (on file with the *Iowa Law Review*).

91. See, e.g., Britain Eakin, *New West Texas Judge Wants His Patent Suits Fast and Clean*, LAW360 (Oct. 25, 2019, 8:54 PM), <https://www.law360.com/articles/1213867/new-west-texas-judge-wants-his-patent-suits-fast-and-clean> (on file with the *Iowa Law Review*).

92. See Tommy Witherspoon, *Waco Becoming Hotbed for Intellectual Property Cases with New Federal Judge*, WACO TRIB.-HERALD (Jan. 18, 2020), https://www.wacotrib.com/news/local/waco-becoming-hotbed-for-intellectual-property-cases-with-new-federal-judge/article_obcd75bo-07c5-5e70-b371-b20e059a3717.html [<https://perma.cc/XS7Q-JU6L>].

93. Anderson & Gugliuzza, *supra* note 5, at 421.

94. Ryan Davis, *Albright Transfer Drama Will Keep Eyes on Texas in 2022*, LAW360 (Dec. 17, 2021, 2:17 PM), <https://www.law360.com/articles/1448846/albright-transfer-drama-will-keep-eyes-on-texas-in-2022> (on file with the *Iowa Law Review*).

95. LEX MACHINA, LEXISNEXIS, PATENT LITIGATION REPORT 2023 at 9 (2023).

96. *Id.*

97. Anderson et al., *supra* note 2, at 343–44.

98. *Id.*

99. *Id.*

100. Anderson & Gugliuzza, *supra* note 5, at 461.

receive—and many of those districts are located in places with a stronger connection to the case than Waco.¹⁰¹ Numerous defendants who have lost motions to transfer out of Waco, like those who unsuccessfully sought transfer out of Marshall, have petitioned for mandamus from the Federal Circuit.

Some numbers for context: from 2008 through 2021, the Federal Circuit decided 128 mandamus petitions seeking transfer.¹⁰² A remarkable eighty percent of those petitions (102) arose from patent lawsuits in the Eastern or Western Districts of Texas.¹⁰³ In all 102 of those petitions, then, the Federal Circuit was obligated to apply Fifth Circuit law to the question of whether transfer should be granted.¹⁰⁴ Over that fourteen-year period, the Federal Circuit granted nearly forty percent of the transfer mandamus petitions it received in cases out of the Eastern and Western Districts of Texas—far above the Federal Circuit’s reversal rate in normal, postjudgment appeals (which hovers around twenty to twenty-five percent),¹⁰⁵ and an indisputably high rate for a traditionally “extraordinary” writ.¹⁰⁶

2. Transfer Precedent, or, the Lack Thereof

With that background about patent venue out of the way, we can return to choice of law. Despite the Federal Circuit having decided over one hundred cases governed by Fifth Circuit venue transfer law in the past decade-plus, Fifth Circuit precedent on the issue is sparse. Indeed, from 2019 through 2021, there was only one mandamus decision granting transfer of venue in *any* regional circuit.¹⁰⁷ Moreover, the few Fifth Circuit cases that do exist don’t easily apply to patent disputes. *Volkswagen*, for instance, was a products liability case arising out of a car crash.¹⁰⁸ In patent infringement cases, however, the alleged wrongdoing is often national (if not global) and ongoing. Yet, like a products liability case, an accused product or process may have a discrete geographical location where it was developed. In such cases, does the

101. Love & Yoon, *supra* note 70, at 17 tbl.5.

102. Anderson et al., *supra* note 2, at 365.

103. *Id.*

104. See, e.g., *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1318 (Fed. Cir. 2021) (“In reviewing transfer decisions, we look to the applicable regional circuit law, in this case the law of the Fifth Circuit . . .”).

105. See Paul R. Gugliuzza, Jonathan Remy Nash & Jason Rantanen, *Expertise, Ideology, and Dissent* 29 tbl.3 (2023) (unpublished manuscript) (on file with authors) [hereinafter Gugliuzza et al., *Expertise, Ideology, and Dissent*].

106. Indeed, in transfer disputes arising from district courts *besides* the Eastern and Western Districts of Texas, the Federal Circuit granted mandamus only 11.5 percent of the time (in three of twenty-six cases). Anderson et al., *supra* note 2, at 365.

107. See Paul R. Gugliuzza, Jonas Anderson & Jason Rantanen, *Opinions Without Law: Federal Circuit Mandamus Decisions on Transfer of Venue*, PATENTLY-O (June 15, 2022) [hereinafter Gugliuzza et al., *Opinions Without Law*], <https://patentlyo.com/patent/2022/06/opinions-mandamus-decisions.html> [<https://perma.cc/W9YK-BUXB>].

108. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 307 (5th Cir. 2008) (en banc).

“national” character of the alleged tort mean that any district is as good as any other? Or should courts give weight to where the accused product was developed and favor transfer to those districts? And how should courts act in scenarios when the accused product was mostly developed in the proposed transferee district, but some product work was also done in the transferor district?

Simply reciting Fifth Circuit transfer law doesn’t answer those questions. One of the key factors the Fifth Circuit (like most other circuits) uses in transfer decisions is “the local interest in having localized interests decided at home.”¹⁰⁹ In *Volkswagen*, the Fifth Circuit held that this factor favored transfer to the district where the car was purchased and the car crash took place.¹¹⁰ In a pregnancy-discrimination case, the Fifth Circuit held that this factor favored intradistrict transfer to the division where the employee worked and the alleged discrimination occurred.¹¹¹ By contrast, in a *qui tam* case involving allegedly improper Medicaid billings, the Fifth Circuit held that this factor did not favor transfer from one Texas district to another “because this case concerns Planned Parenthood operations—and the provision of Medicaid funds—statewide.”¹¹² These Fifth Circuit precedents may all be sensible, but they say little about how the local interest factor should apply to, say, a patent case about a software product that is sold and downloadable nationwide, was predominantly developed in Silicon Valley, yet had some secondary development work conducted in Texas.¹¹³

Accordingly, the Federal Circuit has struggled to apply the Fifth Circuit’s local interest factor to patent litigation. The Federal Circuit’s 2020 split decision in *In re Apple Inc.* illustrates that difficulty. *Apple* involved an infringement suit filed in the Waco Division of the Western District of Texas accusing Apple devices that run iOS and macOS-based operating systems of infringing a patent that allegedly covered the management of software updates.¹¹⁴ Apple sought transfer to the Northern District of California, the district court denied transfer, and Apple petitioned for mandamus from the Federal Circuit.¹¹⁵

The Federal Circuit granted Apple’s petition.¹¹⁶ The majority ruled that the local interest factor favored transfer because the accused products were predominantly developed in the Northern District of California, not Texas.¹¹⁷

109. *Id.* at 315 (quoting *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004)).

110. *Id.* at 317.

111. *In re Radmax, Ltd.*, 720 F.3d 285, 290 (5th Cir. 2013); *North v. Radmax, Ltd.*, No. 12-cv-00405, 2013 WL 12146460, at *1 (5th Cir. Mar. 25, 2013) (order denying motion to dismiss).

112. *In re Planned Parenthood Fed’n of Am., Inc.*, 52 F.4th 625, 632 (5th Cir. 2022).

113. *Compare, e.g., In re Apple Inc.*, 818 F. App’x 1001, 1004 (Fed. Cir. 2020) (order denying petition for transfer), with *In re Apple Inc.*, 979 F.3d 1332, 1332 (Fed. Cir. 2020) (order granting petition for transfer).

114. *See In re Apple Inc.*, 979 F.3d at 1335–36.

115. *Id.* at 1336.

116. *Id.* at 1347.

117. *Id.* at 1345.

The Federal Circuit acknowledged that Apple had a large and growing presence in the Western District of Texas but emphasized that most of Apple's Texas activity was not specifically linked to the accused products and thus warranted little or no weight in the transfer analysis.¹¹⁸

Judge Moore dissented and took issue with the majority's treatment of the local interest factor. Contrary to the majority, Judge Moore gave significant weight to Apple's presence in the Western District, which included eight thousand employees, plans to add another five to fifteen thousand employees, and a company-owned hotel.¹¹⁹ Moreover, while Judge Moore acknowledged that the accused products were mostly developed in the Northern District of California, she noted that Apple performed accounting and revenue activities for the accused products in the Western District of Texas, had employees who helped deliver content to the accused products in the Western District, and hosted some content-delivery servers in Dallas (which is not in the Western District but is closer to Waco than the Northern District of California).¹²⁰

Notably absent from both the majority's and the dissent's analyses was any discussion of how the Fifth Circuit has *actually applied* the local interest factor. The majority penned a single line drawing from the Fifth Circuit's *In re Volkswagen* decision about how the local interest "factor [looks] to a forum's 'connections with the events that gave rise to th[e] suit.'"¹²¹ But the majority made no attempt to analogize to the facts of any Fifth Circuit precedent. For its part, the dissent stated that "[n]either [the Federal Circuit] nor the Fifth Circuit has held that an accused infringer's general presence in a district is irrelevant."¹²² Well, of course not: How would the Fifth Circuit ever have a chance to decide that question, which is specific to patent litigation?

Apple illustrates a crucial problem with the application of regional circuit law in patent cases: There may be no on-point decisions to analogize to. This is a particularly notable shortcoming on an issue, like transfer of venue, that is case-specific, fact-intensive, and essentially a common law question. As Peter Karol has explained:

[A] basic tenet of our common law tradition [is] the requirement that one look to like cases for guidance. There is a very practical reason, of course, why one cites to a case that is as factually close as possible. Closer cases are more trustworthy. The law is a sensitive organism, and one is best served by following precedent with like facts so as not to import accidentally reasoning more applicable to a

118. *Id.* at 1345–46.

119. *Id.* at 1351 (Moore, J., dissenting).

120. *Id.*

121. *Id.* at 1345 (majority opinion) (second alternation in original) (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 318 (5th Cir. 2008) (en banc)).

122. *Id.* at 1352 (Moore, J., dissenting).

different fact pattern. It is at its own peril that any court looks to an incongruent case for guidance. Thus, a system that forces litigants and courts to rely on inapposite cases should be heavily disfavored.¹²³

Unfortunately, the rule requiring the Federal Circuit to apply regional circuit law forces the Federal Circuit to extrapolate from inapposite cases—or from no cases at all, as *Apple* illustrates.

District courts weighing transfer motions in patent cases have also expressed frustration with this dynamic, particularly when they believe the Federal Circuit has incorrectly applied regional circuit transfer law in the patent context. In the recent case of *Motion Offense, LLC v. Google LLC*, for example, Judge Albright of the Western District of Texas was faced with a motion to transfer venue to the Northern District of California.¹²⁴ He catalogued several Federal Circuit cases in which the Federal Circuit, in his view, had misapplied Fifth Circuit precedent.

For example, according to Judge Albright:

- The Fifth Circuit only gives significant weight to courts' ability to compel third-party witnesses to testify if there is a showing that the witnesses are unwilling to testify voluntarily.¹²⁵ But the Federal Circuit presumes that third-party witnesses are unwilling to voluntarily testify.¹²⁶
- Under Fifth Circuit law, the “ease of access to sources of proof” factor weighs against transfer from Texas to California when the plaintiff's documents are mostly located in Texas and the defendant's documents are scattered among California and other states.¹²⁷ But in Federal Circuit cases applying Fifth Circuit law, this fact pattern favors transfer.¹²⁸
- Under Fifth Circuit law, the “convenience to witnesses” factor looks primarily to the raw distance witnesses must travel, with more distance equating greater inconvenience.¹²⁹ But in Federal Circuit cases applying Fifth Circuit law, mileage differences are insignificant if either forum would require the witnesses to be away from their homes for a similar stretch of time.¹³⁰

123. Karol, *supra* note 17, at 41.

124. *Motion Offense, LLC v. Google LLC*, No. 21-cv-00514, 2022 WL 5027730, at *1 (W.D. Tex. Oct. 4, 2022).

125. *Id.* at *4–5 (citing *Indusoft, Inc. v. Taccolini*, 560 F. App'x 245, 249 (5th Cir. 2014)).

126. *Id.* (citing *In re Apple Inc.*, No. 2021-181, 2021 WL 5291804, at *3 (Fed. Cir. Nov. 15, 2021)).

127. *Id.* at *6 (citing *Def. Distributed v. Bruck*, 30 F.4th 414, 434 (5th Cir. 2022)).

128. *Id.* at *7 (citing *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *7 (Fed. Cir. Oct. 6, 2021)).

129. *Id.* (citing *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 316–17 (5th Cir. 2008) (en banc)).

130. *Id.* at *7–9 (citing *In re Google LLC*, No. 2021-170, 2021 WL 4427899, at *4 (Fed. Cir. Sept. 27, 2021)).

- Under Fifth Circuit law, a court should give “paramount weight” to the existence of any related lawsuits pending in the transferor forum.¹³¹ But in Federal Circuit cases applying Fifth Circuit law, a court can only give ordinary weight to this factor.¹³²
- Under Fifth Circuit law, the “local interest” factor assigns significant weight to the Western District of Texas when the plaintiff is based in another Texas district and the defendant has ties to the state.¹³³ But in Federal Circuit cases applying Fifth Circuit law, “none of [a defendant’s] general local ties to Texas matter and . . . a Texas patent plaintiff’s ties beyond the WDTX do not matter.”¹³⁴

The tenor of the opinion in *Motion Offense* leaves little doubt that Judge Albright viewed the pertinent Federal Circuit authorities as incorrect applications of Fifth Circuit law. As he summarized, “[t]he Court’s decision turns on whether it should apply traditional Fifth Circuit transfer law or apply the Federal Circuit’s interpretations of Fifth Circuit transfer law.”¹³⁵ Recognizing that the Federal Circuit would be the court reviewing his decision, Judge Albright concluded that “[t]his Court cannot ignore or overrule cases from the Federal Circuit. Only because of those Federal Circuit cases, this Court GRANTS Defendant’s Motion to Transfer.”¹³⁶

Judge Albright raised another complaint about the Federal Circuit’s transfer decision in his *Motion Offense* opinion—namely, the Federal Circuit’s tendency to designate its transfer decisions as nonprecedential yet cite them as if they were binding precedent.¹³⁷ Indeed, as we show next, the Federal Circuit’s practices with regard to designating its transfer mandamus decisions as precedential or not and to how it cites its prior transfer decisions are additional shortcomings of the Federal Circuit’s choice-of-law regime.

B. EMPIRICAL PROOF

This Part of the Article takes an empirical tack in highlighting the shortcomings of the Federal Circuit’s choice-of-law regime.¹³⁸ We first discuss

131. *Id.* at *10 (citing *In re Volkswagen of Am., Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009)).

132. *Id.* at *9–10 (citing *In re NetScout Sys., Inc.*, No. 2021-173, 2021 WL 4771756, at *5 (Fed. Cir. Oct. 13, 2021)).

133. *Id.* at *12 (citing *Def. Distributed v. Bruck*, 30 F.4th 414, 435–36 (5th Cir. 2022)).

134. *Id.* at *13 (citing *In re Google*, 2021 WL 4427899, at *5–6).

135. *Id.* at *1.

136. *Id.*

137. *Id.* at *4 (“Although the Federal Circuit issues unpublished, nonprecedential transfer opinions, the Federal Circuit frequently cites these opinions as though they precedentially interpret Fifth Circuit law.”).

138. Consistent with best practices on data accessibility, all of our data is available in an online, public archive. See Robin Feldman, Mark A. Lemley, Jonathan S. Masur & Arti K. Rai, *Open Letter on Ethical Norms in Intellectual Property Scholarship*, 29 HARV. J.L. & TECH. 339, 348 (2016); Jason M. Chin et al., *The Transparency of Quantitative Empirical Legal Research (2018–2020)* 5 (Bos. Univ. Sch. of L., Rsch. Paper No. 4034599, 2021), <https://ssrn.com/abstract=4034599> [https://

how, perhaps *because of* its choice-of-law regime, the Federal Circuit issues few precedential opinions in mandamus transfer disputes and how the results of the cases it designates as precedential are not representative of overall outcomes. Second, we show how the Federal Circuit cites its own nonprecedential transfer mandamus decisions with surprising frequency and gives them heavy weight in future rulings. These practices cause surprise for litigants, make it difficult to say what the law is, and, over the long term, could strain trust in the court. Our data make clear the need for more certain answers on legal questions in patent cases that are governed by regional circuit precedent.

1. Lack of Precedential Decisions

As noted above, from 2008 through 2021, the Federal Circuit issued 128 mandamus decisions on transfer of venue under § 1404(a).¹³⁹ Yet the court designated only nineteen of those decisions—less than fifteen percent—as precedential.¹⁴⁰ By contrast, in normal, postjudgment appeals, the Federal Circuit designates decisions as precedential more than twice as frequently, over thirty percent of the time.¹⁴¹ In seeking an explanation for that disparity, choice of law is an obvious candidate: Federal Circuit decisions on transfer of venue technically aren't binding precedent, so why designate the decisions as precedential? But even that justification isn't wholly persuasive because the Federal Circuit's interpretations of Fifth Circuit transfer law would at least be binding on future panels *of the Federal Circuit*.¹⁴²

The small number of precedential mandamus transfer decisions is exacerbated by the fact that those decisions disproportionately grant mandamus. Of the nineteen precedential mandamus transfer decisions since 2008, fifteen granted the writ, and only four denied it, for a grant rate of

perma.cc/9L5E-AHPK]. Our data is accessible at *Replication Data for: Certifying Questions in Patent Cases*, HARV. DATAVERSE (2023), <https://dataverse.harvard.edu/dataset.xhtml?persistentId=doi:10.7910/DVN/BMRWVT> [<https://perma.cc/J6F2-C3NF>].

139. See *supra* text accompanying note 102.

140. Gugliuzza et al., *Opinions Without Law*, *supra* note 107. The Federal Circuit decides appeals in one of three ways: by issuing a precedential opinion, by issuing a nonprecedential opinion, or by affirming without a written opinion. Gugliuzza et al., *Expertise, Ideology, and Dissent*, *supra* note 105, at 18. Precedential decisions make law—they bind future panels of the court and can be overturned only by the Federal Circuit sitting en banc or by the Supreme Court. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988). The Federal Circuit issues nonprecedential decisions, by contrast, when it thinks the disposition will not significantly advance the law. See U.S. CT. OF APPEALS FOR THE FED. CIR., INTERNAL OPERATING PROCEDURES 17 (2022). Affirmance without opinion is permissible in five circumstances outlined in Federal Circuit Rule 36. The purpose of the rule is to allow quick disposition of “easy” cases, such as cases where the basis for affirmance is that the factual record adequately supports the judgment below. See FED. CIR. R. 36(a)(1)–(3). Though the Federal Circuit decides roughly a third of all appeals with no opinion under Rule 36, Gugliuzza et al., *Expertise, Ideology, and Dissent*, *supra* note 105, at 47 tbl.9, the court does not use Rule 36 to decide mandamus petitions.

141. Gugliuzza et al., *Expertise, Ideology, and Dissent*, *supra* note 105, at 39 tbl.3.

142. Gugliuzza, *The Federal Circuit*, *supra* note 43, at 1848–50 (discussing the Federal Circuit's use of its own case law on issues governed by regional circuit precedent).

seventy-nine percent.¹⁴³ Overall, however, the Federal Circuit grants venue mandamus petitions only thirty-two percent of the time.¹⁴⁴ In nonprecedential mandamus decisions, the grant rate is substantially lower: twenty-six grants, eighty-three denials, a grant rate of twenty-four percent.¹⁴⁵ Thus, the Federal Circuit’s precedential mandamus transfer decisions provide an inaccurate impression of what the court is in fact doing in those types of disputes.¹⁴⁶

The lack of binding precedent on venue-related mandamus—and its unrepresentative nature—illustrate two key problems with the Federal Circuit’s choice-of-law rules. First, some legal issues that frequently arise in patent cases are not governed by the (often ample) Federal Circuit decisions on the issue. That leaves litigants and district courts to either guess about what the law is or to pretend that nonprecedential Federal Circuit decisions are, in fact, binding authority. In a field of law in which predictability is supposedly paramount,¹⁴⁷ that is not an ideal state of affairs. Second, the Federal Circuit’s determinations about whether to designate a ruling as precedential or nonprecedential distort perceptions about what the court is really doing.¹⁴⁸

2. Treating Nonprecedential Decisions as Precedent

There are even more problems to highlight. To begin with, even the small number of “precedential” Federal Circuit decisions on transfer aren’t technically binding because issues of transfer, in patent cases, are governed by regional circuit law. So the Federal Circuit’s “precedential” transfer decisions are, at most, binding only insofar as they *interpret* Fifth Circuit transfer law.

Even more troubling, the Federal Circuit often cites its own nonprecedential transfer decisions as if they were binding interpretations of Fifth Circuit law. That practice has become more common the past few years, with a flood of

143. Gugliuzza et al., *Opinions Without Law*, *supra* note 107.

144. Anderson et al., *supra* note 2, at 361.

145. Gugliuzza et al., *Opinions Without Law*, *supra* note 107.

146. For comparison, in regular, postjudgment appeals from 2008 through 2021, forty-seven percent of precedential opinions didn’t affirm the lower tribunal, as compared to an overall nonaffirmance rate of twenty-two percent. See Paul R. Gugliuzza, Jonas Anderson & Jason Rantanen, *The Federal Circuit’s Precedent/Outcomes Mismatch*, PATENTLY-O (July 5, 2022), <https://patentlyo.com/patent/2022/07/circuits-precedent-outcomes.html> [<https://perma.cc/QWF3-WJYX>].

147. See Colleen V. Chien, *Predicting Patent Litigation*, 90 TEX. L. REV. 283, 296 (2011).

148. It’s worth noting that venue mandamus isn’t the only issue on which there’s a significant disparity in outcomes in precedential versus nonprecedential decisions. See, e.g., Paul R. Gugliuzza & Mark A. Lemley, *Can a Court Change the Law by Saying Nothing?*, 71 VAND. L. REV. 765, 767 (2018) [hereinafter Gugliuzza & Lemley, *Saying Nothing*] (finding that the Federal Circuit upholds the validity of a patent over a challenge on patentable subject matter grounds about twenty percent of the time when it decides the case in a precedential opinion but that, in nonprecedential opinions and summary affirmances under Federal Circuit Rule 36, the court upholds the validity of a patent challenged as lacking patentable subject matter less than two percent of the time).

mandamus petitions seeking transfer out of Judge Albright's courtroom in the Western District of Texas.

Drawing on a dataset one of us built for a recent article on the Federal Circuit's mandamus practice,¹⁴⁹ we looked at every Federal Circuit ruling on a mandamus petition challenging a decision to deny transfer under § 1404(a) from 2008, the year of the Federal Circuit's first-ever mandamus transfer grant in *In re TS Tech USA Corp.*,¹⁵⁰ through 2021: 113 rulings in total. We then examined the citations in those rulings to prior Federal Circuit and Fifth Circuit decisions.¹⁵¹

Overall, the numbers are interesting but not terribly concerning. In the 113 Federal Circuit mandamus transfer decisions from 2008 through 2021, 60.2 percent of the citations (660 of 1096) were to precedential Federal Circuit decisions, 27.6 percent (303 of 1096) were to precedential decisions from the governing regional circuit, and 12.1 percent (133 of 1096) were to nonprecedential Federal Circuit decisions—perhaps a higher rate of citation than we might expect for decisions that are not technically “the law,” but nothing eyebrow raising.

That has changed over the past few years, however. In the thirty mandamus decisions the Federal Circuit issued from 2019 through 2021 overturning a § 1404(a) transfer ruling by Judge Albright, *over a quarter of the citations were to nonprecedential decisions*. Specifically, 58.2 percent of citations (280 of 481) were to precedential Federal Circuit decisions, 16.6 percent (80 of 481) were to precedential decisions from the Fifth Circuit—which, to be clear, is actually the “governing” law in these cases—and a whopping 25.2 percent (121 of 481) were to nonprecedential Federal Circuit decisions.

The Federal Circuit's citation of nonprecedential decisions on transfer is much different than the court's practice in other areas in which the law consists mainly of prior judicial decisions. Take, for instance, patentable subject matter. That doctrine, in brief, limits the patentability of “[I]aws of nature, natural phenomena, and abstract ideas.”¹⁵² Since the Supreme Court (controversially) reinvented the doctrine in 2010,¹⁵³ it has been used mainly to preclude patents on computer software and medical diagnostic

149. See Anderson et al., *supra* note 2, at 346–51.

150. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1322–23 (Fed. Cir. 2008).

151. Some additional notes on methodology: In calculating the numbers of citations, we counted only citations within the analytical portion of the Federal Circuit's ruling and only in the portion of the court's analysis addressing the § 1404(a) transfer issue specifically. We ignored citations in “citing” or “quoting” parentheticals. We hand counted the citations, so it's possible we missed or misclassified a small number of them. But the numbers are sufficiently large (1096 relevant citations across 113 decisions) that a few errors, if they exist, wouldn't affect the overall results. Our full dataset is available online. See *supra* note 138.

152. See *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

153. See *Bilski v. Kappos*, 561 U.S. 593, 596 (2010).

tests.¹⁵⁴ For our purposes, the key point is that the doctrine is an entirely judge-made exception to patentability, so courts decide the issue in a common law fashion, analogizing to and distinguishing from prior cases¹⁵⁵—just like how they decide transfer of venue.

But the Federal Circuit almost never cites its rather large number of nonprecedential opinions on patentable subject matter. From 2008 through 2021, the Federal Circuit issued 223 opinions addressing the issue of patentable subject matter.¹⁵⁶ Of those 223 opinions, 115 were precedential and 108 were nonprecedential. Yet citations to nonprecedential decisions were almost nonexistent in those 223 patentable subject matter opinions. Specifically, 56.6 percent of citations (3,496 of 6,174) were to precedential Federal Circuit opinions, 42.2 percent (2,604 of 6,174) were to Supreme Court opinions, and only 1.2 percent (74 of 6,174) of citations in Federal Circuit decisions on patentable subject matter were to nonprecedential Federal Circuit opinions.

In the Federal Circuit's venue mandamus decisions, it's not just the numbers but the substance of the rulings that reflect the Federal Circuit's heavy reliance on prior nonprecedential decisions. For instance, in granting a mandamus petition filed by Apple (in a different case from the one we discussed above), the Federal Circuit chided Judge Albright for "erroneously discount[ing]" the location of third-party witnesses in the transfer analysis.¹⁵⁷ The Federal Circuit quoted from its prior nonprecedential ruling in *In re HP, Inc.* for the proposition that "there [is] 'no basis to discount' third-party entities . . . 'just because individual employees [i.e., witnesses] were not identified'" in the transfer motion.¹⁵⁸ The Federal Circuit's ruling in *Apple* also relied on and quoted from two prior, nonprecedential decisions involving Google to reject Judge Albright's treatment of the location of party witnesses in the transfer analysis.¹⁵⁹

154. See Paul R. Gugliuzza & Mark A. Lemley, *Myths and Reality of Patent Law at the Supreme Court*, 103 B.U. L. REV. (forthcoming 2024) (manuscript at 19) [hereinafter Gugliuzza & Lemley, *Myths and Reality*], <https://ssrn.com/abstract=4304442> [<https://perma.cc/YC5V-Y22E>].

155. Gugliuzza & Lemley, *Saying Nothing*, *supra* note 148, at 803.

156. To develop this dataset of patentable subject matter decisions, we used the issue coding from Jason Rantanen's Compendium of Federal Circuit Decisions. *The Compendium of Federal Circuit Decisions*, THE FED. CIR. DATA PROJECT, <https://fedcircuit.shinyapps.io/federalcompendium> [<https://perma.cc/BAV9-Y6XK>]. We then counted citations in the same way we counted them in § 1404(a) transfer decisions, *supra* note 151, limiting our counts to the portions of the opinion analyzing patentable subject matter and counting citations to Supreme Court opinions, rather than regional circuit opinions (which are irrelevant on a question of substantive patent law that is governed by Federal Circuit precedent). And we ignored the 164 cases on patentable subject matter that the Federal Circuit decided without issuing any opinion at all pursuant to Federal Circuit Rule 36. See *supra* note 140.

157. *In re Apple Inc.*, No. 2021-181, 2021 WL 5291804, at *3 (Fed. Cir. Nov. 15, 2021).

158. *Id.* (quoting *In re HP Inc.*, 826 F. App'x 899, 903 (Fed. Cir. 2020)).

159. *Id.* (citing *In re Google LLC*, No. 2021-171, 2021 WL 4592280, at *5 (Fed. Cir. Oct. 6, 2021); *In re Google LLC*, No. 2021-170, 2021 WL 4427899, at *4 (Fed. Cir. Sept. 27, 2021)).

Indeed, one of those Google decisions itself relied on the Federal Circuit's prior nonprecedential ruling in *In re TracFone Wireless, Inc.* in granting transfer, writing that "[t]his case fits squarely within that line of precedent"—the "line of precedent" consisting of two cases: the Federal Circuit's precedential decision in the *Apple* case we discussed in detail above and the nonprecedential decision in *TracFone*.¹⁶⁰

Similarly, in granting mandamus in *In re Juniper Networks*—a precedential decision—the Federal Circuit cited its prior nonprecedential decision in *In re Hulu* five times, concluding that "this case is a very close cousin of our recent decisions in *Samsung* [precedential] and *Hulu* [nonprecedential], and the disposition of this case is largely dictated by the disposition of those cases."¹⁶¹

Perhaps the most stunning treatment of nonprecedential mandamus decisions by the Federal Circuit is *In re Pandora Media, LLC*, which actually contains more citations to nonprecedential Federal Circuit rulings than to precedential Federal Circuit rulings.¹⁶² The Federal Circuit's determination that Judge Albright erred by disregarding the subpoena power of the proposed transferee court was based entirely on three nonprecedential rulings: a 2014 case involving *Apple*, the *Hulu* case mentioned above, and a 2018 case involving *HP*.¹⁶³ The Federal Circuit in *Pandora* also leaned on the nonprecedential rulings in *TracFone* and *Google* in criticizing how Judge Albright analyzed considerations about convenience for potential witnesses, noting that "we held in *TracFone* and *Google* that the litigation should be conducted where more witnesses could testify without leaving their homes or their regular places of business."¹⁶⁴

In short, the lack of binding precedent on venue-related mandamus—as well as the way the Federal Circuit treats its prior nonprecedential rulings—illustrates the problematic nature of the Federal Circuit's choice-of-law rules. Those rules have created an unstable situation in which the Federal Circuit effectively treats its own nonprecedential decisions as binding precedent because of the dearth of analogous Fifth Circuit case law to draw on.

160. *In re Google*, 2021 WL 4427899, at *5 (citing *In re TracFone Wireless, Inc.*, 852 F. App'x 537, 539 (Fed. Cir. 2021) (order granting writ of mandamus); *In re Apple Inc.*, 979 F.3d 1332, 1342 (Fed. Cir. 2020)).

161. *In re Juniper Networks, Inc.*, 14 F.4th 1313, 1322–23 (Fed. Cir. 2021) (citing generally *In re Samsung Elecs. Co.*, 2 F.4th 1371 (Fed. Cir. 2021); *In re Hulu, LLC*, No. 2021-142, 2021 WL 3278194 (Fed. Cir. Aug. 2, 2021)).

162. See generally *In re Pandora Media, LLC*, No. 2021-172, 2021 WL 4772805 (Fed. Cir. Oct. 13, 2021).

163. *Id.* at *3 (citing *In re Apple, Inc.*, 581 F. App'x 886, 889 (Fed. Cir. 2014); *Hulu*, 2021 WL 3278194, at *4; *In re HP Inc.*, No. 2018-149, 2018 WL 4692486, at *3 n.1 (Fed. Cir. Sept. 25, 2018)).

164. *Id.* at *6 (citing *TracFone*, 852 F. App'x at 539–40; *Google*, 2021 WL 4427899, at *5).

III. GUESSING ABOUT “WHAT THE LAW IS”: BEYOND TRANSFER

Though transfer mandamus is the area in which the Federal Circuit’s choice-of-law rule has wreaked the most havoc, it’s not the only area in which courts and litigants must essentially guess about what the law is because the governing regional circuit law is inapposite or nonexistent. Rather, that dynamic repeats both on issues of nonpatent substantive law (such as copyright and antitrust) as well as on trans-substantive or procedural issues, such as the attorney-client privilege.

A. NONPATENT CLAIMS

1. Copyright

The most prominent recent example from copyright law is the long-running *Oracle v. Google* litigation that arose out of the Northern District of California, was appealed twice to the Federal Circuit, and was ultimately resolved by the Supreme Court.¹⁶⁵ Entire law review articles have been written on the case,¹⁶⁶ and we don’t need to do a deep dive into it. In brief, Oracle sued Google for both patent infringement and copyright infringement.¹⁶⁷ Oracle’s copyright claims alleged that Google’s Android operating system infringed the copyright in Oracle’s application programming interface (“API”) packages for the Java software platform.¹⁶⁸ In a 2014 opinion, the Federal Circuit held that the declaring code and organizational structure for the API packages were eligible for copyright protection.¹⁶⁹ And, in a 2018 opinion, the Federal Circuit held that Google’s use of Oracle’s code and structure was not protected by the fair use doctrine.¹⁷⁰ Both opinions purported to apply the copyright law of the relevant regional circuit: the Ninth Circuit.

But the Federal Circuit’s application of Ninth Circuit law was based on a significant amount of extrapolation. The Federal Circuit’s 2014 opinion acknowledged that “it does not appear that the Ninth Circuit has addressed the precise issue” of whether “a set of commands to instruct a computer to carry out desired operations may contain expression that is eligible for copyright protection.”¹⁷¹ And its 2018 opinion prefaced the standard-of-review section by saying that “[w]hile this section of most appellate opinions

165. See generally *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021) (holding that “Google’s copying of the Sun Java API was a fair use of that material as a matter of law”).

166. See, e.g., Menell, *supra* note 30, at 1519–20 (arguing that “the Federal Circuit’s 2014 decision in *Oracle v. Google* misinterpreted Ninth Circuit law”); Mark A. Lemley & Pamela Samuelson, *Interfaces and Interoperability After Google v. Oracle*, 100 TEX. L. REV. 1, 3 (2021) (arguing that the Federal Circuit’s decision in *Oracle v. Google* “wrongly extended copyright protection to APIs”).

167. *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1186–88 (Fed. Cir. 2018).

168. *Id.*

169. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1381 (Fed. Cir. 2014).

170. *Oracle Am., Inc.*, 886 F.3d at 1211.

171. *Oracle Am., Inc.*, 750 F.3d at 1367.

presents easily resolvable questions, like much else in the fair use context, that is not completely the case here.”¹⁷² The Federal Circuit noted that the facts of the case “differ materially” from the existing Ninth Circuit precedents addressing when copying of software code constitutes fair use.¹⁷³ The Supreme Court ultimately reversed the Federal Circuit’s fair use opinion—but without overturning any of the Ninth Circuit precedents that the Federal Circuit cited,¹⁷⁴ suggesting that the Federal Circuit misapplied governing Ninth Circuit law.

Oracle v. Google, in short, illustrates how billions of dollars can turn on the Federal Circuit’s application of unsettled—or nonexistent—regional circuit law.¹⁷⁵

2. Antitrust

Antitrust issues can also present unsettled questions of regional circuit law that the Federal Circuit must decide. *In re Independent Service Organizations Antitrust Litigation* is but one example. That case arose from Xerox’s policy of refusing to sell patented parts and copyrighted manuals, or to license copyrighted software, to entities that were not end-users of Xerox copying machines.¹⁷⁶ A group of independent service organizations (companies that maintain and repair Xerox machines) sued Xerox in the U.S. District Court for the District of Kansas, alleging that Xerox’s policy violated antitrust law.¹⁷⁷

The district court granted summary judgment to Xerox on the plaintiffs’ antitrust claims, holding that “if a patent or copyright is lawfully acquired, the patent or copyright holder’s unilateral refusal to sell or license its patented invention or copyrighted expression is not unlawful exclusionary conduct under the antitrust laws.”¹⁷⁸ The district court also ruled that “the right holder’s intent in refusing to deal . . . [is] irrelevant to antitrust law.”¹⁷⁹

172. *Oracle Am., Inc.*, 886 F.3d at 1191.

173. *Id.* at 1210 (“We do not conclude that a fair use defense could never be sustained in an action involving the copying of computer code. Indeed, the Ninth Circuit has made it clear that some such uses can be fair. We hold that, given the facts relating to the copying at issue here—which differ materially from those at issue in *Sony and Sega*—Google’s copying and use of this particular code was not fair as a matter of law.” (citation omitted)).

174. See generally *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021) (holding that “Google’s copying of the Sun Java API was a fair use of that material as a matter of law”).

175. See Adam Liptak, *Supreme Court Backs Google in Copyright Fight with Oracle*, N.Y. TIMES (May 3, 2021), <https://www.nytimes.com/2021/04/05/us/google-oracle-supreme-court.html> (on file with the *Iowa Law Review*) (“The Supreme Court on Monday sided with Google in a long-running copyright dispute with Oracle over software used to run most of the world’s smartphones. The 6-to-2 ruling, which resolved what Google had called ‘the copyright case of the decade,’ spared the company from having to face claims from Oracle for billions of dollars in damages.”).

176. *In re Indep. Serv. Orgs. Antitrust Litig. CSU, LLC v. Xerox Corp.*, 203 F.3d 1322, 1324 (Fed. Cir. 2000).

177. *Id.*

178. *Id.*

179. *Id.*

On appeal, the Federal Circuit applied its own law to the question of whether Xerox's refusal to sell patented parts violated antitrust law.¹⁸⁰ But it applied the law of the regional circuit (the Tenth Circuit) to the question of whether Xerox's refusal to sell or license *copyrighted* materials violated antitrust law.¹⁸¹ This presented an unsettled question under Tenth Circuit law. As the Federal Circuit explained:

The Tenth Circuit has not addressed in any published opinion the extent to which the unilateral refusal to sell or license copyrighted expression can form the basis of a violation of the Sherman Act. We are therefore left to determine how that circuit would likely resolve the issue; the precedent of other circuits is instructive in that consideration.¹⁸²

The Federal Circuit then identified a circuit split. On one side was the First Circuit, which had held that "an author's desire to exclude others from use of its copyrighted work is a presumptively valid business justification."¹⁸³ The First Circuit further held that the presumption could only be rebutted in "rare cases" and that the copyright-holder's "subjective motivation in asserting its right to exclude" is irrelevant, "in the absence of any evidence that the copyrights were obtained by unlawful means or were used to gain monopoly power beyond the statutory copyright granted by Congress."¹⁸⁴

On the other side was the Ninth Circuit. Like the First Circuit, the Ninth Circuit employed a presumption that the copyright holder's desire to exclude was a valid business justification for a failure to deal.¹⁸⁵ However, as compared to the First Circuit, the Ninth Circuit "extended the possible means of rebutting the presumption to include evidence that the defense and exploitation of the copyright grant was merely a pretextual business justification to mask anticompetitive conduct."¹⁸⁶ In this analysis, an inquiry into the copyright holder's subjective motivation was highly relevant.¹⁸⁷

The Federal Circuit called the Ninth Circuit's approach "a significant departure from the First Circuit's central premise that rebutting the presumption would be an uphill battle and would only be appropriate in those rare cases in which imposing antitrust liability is unlikely to frustrate the objectives of the Copyright Act."¹⁸⁸ The Federal Circuit ultimately held that:

180. *See id.* at 1325–28.

181. *Id.* at 1325.

182. *Id.* at 1328.

183. *Id.* at 1329 (quoting *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1187 (1st Cir. 1994)).

184. *Id.*

185. *See id.* (citing *Image Tech. Servs., Inc. v. Eastman Kodak Co.*, 125 F.3d 1195, 1219 (9th Cir. 1997)).

186. *Id.*

187. *See id.*

188. *Id.*

[T]he First Circuit's approach is more consistent with both the antitrust and the copyright laws and is the standard that would most likely be followed by the Tenth Circuit in considering the effect of Xerox's unilateral right to refuse to license or sell copyrighted manuals and diagnostic software on liability under the antitrust laws.¹⁸⁹

The Federal Circuit "therefore reject[ed] [plaintiffs'] invitation to examine Xerox's subjective motivation in asserting its right to exclude under the copyright laws for pretext, in the absence of any evidence that the copyrights were obtained by unlawful means or were used to gain monopoly power beyond the statutory copyright granted by Congress."¹⁹⁰

Xerox presents an example of the Federal Circuit: (1) identifying an unsettled issue of antitrust law that had never been addressed by the governing regional circuit, (2) identifying two other circuits that took divergent approaches to the issue, and (3) essentially guessing which approach the governing regional circuit would take. Almost needless to say, that is an odd approach for a federal court of appeals to take on an unsettled issue of federal law.

B. ATTORNEY-CLIENT PRIVILEGE

Unsettled issues of regional circuit law can also appear in privilege disputes at the Federal Circuit. The case of *Wi-LAN, Inc. v. LG Electronics, Inc.* presents an example.¹⁹¹ *Wi-LAN* arose from a patent lawsuit filed by Wi-LAN against LG Electronics.¹⁹² During licensing discussions before the litigation began, Wi-LAN forwarded to LG a copy of a letter written by Wi-LAN's outside counsel at Kilpatrick Townsend (the "Townsend letter").¹⁹³ The Townsend letter opined that LG was practicing Wi-LAN's patented technology.¹⁹⁴ As the Federal Circuit later explained, "[t]here is no dispute that Wi-LAN's disclosure of the letter to LG was intentional. Apparently, Wi-LAN hoped that the letter's reasoning would convince LG to revise its position and begin paying royalties."¹⁹⁵

Wi-LAN's gambit was unsuccessful. The parties' licensing negotiations broke down, and Wi-LAN sued LG for patent infringement.¹⁹⁶ LG responded by serving a subpoena on Kilpatrick Townsend, asking "for documents and testimony relating to the subject matter of the Townsend letter. LG's view . . . was that any privilege Wi-LAN might have had over that material was absolutely waived by its voluntary disclosure of the Townsend letter."¹⁹⁷

189. *Id.*

190. *Id.*

191. *See generally* *Wi-LAN, Inc. v. LG Elecs., Inc.*, 684 F.3d 1364 (Fed. Cir. 2012).

192. *Id.* at 1366.

193. *Id.* at 1367.

194. *Id.*

195. *Id.*

196. *Id.*

197. *Id.*

Kilpatrick Townsend resisted the subpoena, arguing that “in fairness, any waiver of the attorney-client privilege should be limited to the Townsend letter itself” and should not extend to other, undisclosed attorney-client communications on the same subject.¹⁹⁸ The district court agreed with LG, rejected Kilpatrick Townsend’s arguments, and held Kilpatrick Townsend in contempt for refusing to comply with the subpoena.¹⁹⁹

As framed by the Federal Circuit on appeal, the issue was whether extrajudicial disclosure of one privileged communication (the Townsend letter) automatically waived privilege over other undisclosed communications on the same subject matter, or whether a court must engage in “fairness balancing” to determine whether the interests of fairness required disclosure of such undisclosed communications.²⁰⁰ Because this presented a privilege dispute not unique to patent law, the Federal Circuit applied the law of the relevant regional circuit, in this case, the Ninth Circuit.²⁰¹ The Federal Circuit, however, acknowledged “that the Ninth Circuit has not spoken squarely on this issue, i.e., whether fairness balancing is either required or proscribed” in cases where extrajudicial disclosure of one privileged communication allegedly waives privilege over related communications.²⁰² Thus, the Federal Circuit stated that “[o]ur task is to analyze the Ninth Circuit’s law and determine what that court would hold, were the question presented to it.”²⁰³

The Federal Circuit ultimately predicted that the Ninth Circuit would hold that fairness balancing is required.²⁰⁴ It first noted that the Ninth Circuit had approvingly cited, “though never adopted in its entirety,” the Second Circuit’s decision in *In re von Bulow*, which applied fairness balancing to extrajudicial privilege waivers.²⁰⁵ The Federal Circuit then cited authority from other circuits applying fairness balancing and predicted that the Ninth Circuit would give significant weight to that authority.²⁰⁶

Judge Reyna issued a separate *dubitante* opinion (Latin for “having doubts”).²⁰⁷ His brief opinion is worth reproducing in full as it vividly captures the uncertain state of Ninth Circuit law on the matter in question:

The majority embarks on a winding course as it explores Ninth and other regional circuit case law, and evidentiary rules. At the start of

198. *Id.*

199. *Id.* at 1367–68.

200. *Id.* at 1368–69.

201. *Id.* at 1368.

202. *Id.* at 1369.

203. *Id.*

204. *Id.*

205. *Id.* at 1370 (citing *In re von Bulow*, 828 F.2d 94 (2d Cir. 1987)).

206. *Id.* at 1373.

207. *Id.* at 1374 (Reyna, J., *dubitante*); see also *Dubitante*, MERRIAM-WEBSTER (11th ed. 2003) (defining *dubitante* as “having doubts . . . used of a judge who expresses doubt about but does not dissent from a decision reached by a court”).

its journey, the majority recognizes, ‘The parties do agree that the Ninth Circuit has not spoken squarely on this issue, i.e., whether fairness balancing is either required or proscribed in this case.’

Still, the majority discerns a trend in the law and on that basis takes a guess that the Ninth Circuit, if its hand were at the helm, would hold that there must be a fairness balancing in the context of express extrajudicial waivers.

I examine the trend and find in it no gates that lead to secure blue water. Indeed, I find that even a route that lies opposite the route charted by the majority is as good a route as any.

Thus, while instinct tells me the majority could be correct, I am concerned that our heading is not based on an accurate bearing. As I cannot prove or disprove our result, I go along with the majority—but with doubt.²⁰⁸

Judge Reyna’s doubt was well-founded. For starters, while the Federal Circuit in *Wi-LAN* relied chiefly on three Ninth Circuit cases that cited *von Bulow*, two of those Ninth Circuit cases didn’t even mention fairness balancing in the relevant portion of their opinions. Instead, they addressed the question of which communications covered the same subject matter as the disclosed communication.²⁰⁹ Meanwhile, the third Ninth Circuit case that cited *von Bulow* held that *von Bulow* was “not . . . particularly useful” and “that the law in this area is not as settled as [one of the parties] would have us believe.”²¹⁰ Moreover, the Federal Circuit in *Wi-LAN* engaged in questionable reasoning by framing the legal issue as a binary choice of “whether Ninth Circuit law *bars or mandates* fairness considerations when determining the scope of an express extrajudicial waiver of the attorney-client privilege.”²¹¹ Yet there is an obvious middle ground: The Ninth Circuit might *allow* district courts to engage in fairness balancing but not *require* them to do so. The Federal Circuit in *Wi-LAN* did not even consider that option.

In short, *Wi-LAN* is a striking example of a Federal Circuit panel that forged ahead on an unsettled issue of regional circuit law and decided the

208. *Wi-LAN*, 684 F.3d at 1374 (footnote omitted) (citation omitted).

209. See *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992) (“As this court has held, the disclosure of information resulting in the waiver of the attorney-client privilege constitutes waiver ‘only as to communications about the matter actually disclosed.’ Pennzoil was not required, as a result of the limited disclosure, to provide Chevron with every document or communication that touched on the more general tax deferral question.” (citation omitted)); *United States v. Mendelsohn*, 896 F.2d 1183, 1189 (9th Cir. 1990) (“The district court was careful to confine the attorney’s testimony to the subject of Mendelsohn’s limited waiver. This case is therefore distinguishable from those in which a limited waiver was urged as a ground for opening a much larger field.”).

210. *Bittaker v. Woodford*, 331 F.3d 715, 720 & n.5 (9th Cir. 2003) (en banc).

211. *Wi-LAN*, 684 F.3d at 1373 (emphasis added).

issue on grounds so shaky that one of its own judges called the decision a “guess” that could as easily have gone the opposite way.²¹²

C. MORE GUESSING GAMES

By now we’ve hopefully made the point that, because of its choice-of-law rules, the Federal Circuit (as well as lower courts and litigants) must sometimes guess about the content of regional circuit law that applies in a patent case. But at least two additional points are worth briefly making.

First, the Federal Circuit can, if it chooses, tweak its choice-of-law rules to *avoid* guessing about the content of regional circuit law. *Midwest Industries, Inc. v. Karavan Trailers, Inc.* provides an example.²¹³ That case presented a question about whether certain automobile trailer mechanisms could be protected as trade dress even though they were also claimed in a patent.²¹⁴ In prior decisions, the Federal Circuit had held that it would apply regional circuit law to determine whether patent law preempts or conflicts with rights created by state law or other federal laws, such as trademark law.²¹⁵ In *Midwest Industries*, however, the Federal Circuit decided it would apply its own law to those questions because it is the Federal Circuit’s “responsibility to decide what patent law permits and prohibits.”²¹⁶ The Federal Circuit ultimately held that trade dress protection could be available, regardless of any patent protection.²¹⁷ More importantly for the purpose of this Article, the maneuver meant the Federal Circuit didn’t have to guess what the regional circuit (in the *Midwest Industries* case, the Eighth Circuit) would have decided in light of (1) ongoing disagreement among the circuits²¹⁸ and (2) an intervening Supreme Court case decided *after* the Eighth Circuit’s most pertinent decision on the issue.²¹⁹

Second, even if the relevant regional circuit law is well-established, and even if the choice-of-law rules are well-settled, the parties and lower courts might still have to guess about how the Federal Circuit will *frame* the issue in the choice-of-law analysis. *Revision Military, Inc. v. Balboa Manufacturing Co.*, for example, presented a question about the standard for granting a preliminary injunction against patent infringement.²²⁰ The district court, viewing the standard for a preliminary injunction as a nonpatent procedural issue,

212. *Id.* at 1374 (Reyna, J., *dubitante*).

213. *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1360–64 (Fed. Cir. 1999) (en banc in relevant part).

214. *Id.* at 1358.

215. *Id.* (citing *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1029, 1033 (Fed. Cir. 1985)).

216. *Id.* at 1360–61.

217. *See id.* at 1364.

218. *See id.* (noting disagreement between various circuits and the Tenth Circuit).

219. *See id.* at 1363–64 (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 154, 163 (1989); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1214–15 (8th Cir. 1976)).

220. *Revision Mil., Inc. v. Balboa Mfg. Co.*, 700 F.3d 524, 526 (Fed. Cir. 2012).

applied the Second Circuit's standard (which requires the plaintiff to show a "clear" or "substantial" likelihood of success on the merits" when the plaintiff "seeks 'an injunction that will alter . . . the status quo'") and denied the motion.²²¹ On appeal, however, the Federal Circuit framed the issue as patent-specific, reasoning "that a preliminary injunction *enjoining patent infringement* . . . 'involves substantive matters unique to patent law and, therefore, is governed by the law of this court.'"²²² Because Federal Circuit precedent requires the plaintiff to show only that success on the merits is "more likely than not," the Federal Circuit vacated the district court's denial of the injunction.²²³

IV. CERTIFIED QUESTIONS TO THE REGIONAL CIRCUIT: A NEXT-BEST SOLUTION

One solution to these problems would be for the Federal Circuit to reconsider its choice-of-law regime, which, on the one hand, can be complex, unpredictable, and subject to manipulation and, on the other hand, can be a purely academic exercise for nonpatent issues on which the law is uniform among the circuits. Instead, the Federal Circuit could apply its own precedent to all federal issues that arise in patent cases,²²⁴ or at least to all procedural or trans-substantive issues the Federal Circuit must decide.²²⁵ Yet the case against applying regional circuit law in patent cases isn't bulletproof, for reasons we explain next. Moreover, as a practical matter, it's unlikely the Federal Circuit's choice-of-law rule will change any time soon. So, we propose a simple-to-administer judicial process: The Federal Circuit should certify unsettled questions of regional circuit law to the regional circuits, just like it currently certifies unsettled questions of state law to state supreme courts.²²⁶

A. CHANGING THE FEDERAL CIRCUIT'S CHOICE-OF-LAW RULES IS UNREALISTIC AND MAY BE UNWARRANTED

Proposals to reform the Federal Circuit's choice-of-law regime have been percolating since the court's earliest days.²²⁷ Those proposals have been catalogued elsewhere,²²⁸ so we won't dwell on their specifics. Rather, only two points are key to our analysis. First, despite the plethora of proposals to reform

221. *Id.* at 525 (citing *Doninger v. Niehoff*, 527 F.3d 41, 47 (2d Cir. 2008)).

222. *Id.* (emphasis added) (quoting *Hybritech Inc. v. Abbott Lab'ys*, 849 F.2d 1446, 1451 n.12 (Fed. Cir. 1988)).

223. *Id.*

224. Dreyfuss, *supra* note 17, at 44-45.

225. Karol, *supra* note 17, at 3; Moore, *supra* note 17, at 800.

226. *See infra* note 245 (citing case examples).

227. *See, e.g.*, Dreyfuss, *supra* note 17, at 44-45.

228. *See, e.g.*, Sturiale, *supra* note 17, at 477-78 nn.16-19.

Federal Circuit choice of law, the court has shown no interest in making any more than minor tweaks to its choice-of-law regime.²²⁹

Second, though applying Federal Circuit law to a wider range of issues might reduce the need to “guess” about what the law is, it could raise new difficulties. Most notably, it could be hard for a district court to apply Federal Circuit law on, say, a procedural issue in a patent case and regional circuit law on the exact same issue in nonpatent cases. That’s doubly true when—as in many of the case examples we’ve invoked in this Article—the patent and nonpatent claims are joined together in the *very same case*. Likewise, if the expanded reach of Federal Circuit precedent were limited to procedural or trans-substantive issues,²³⁰ there would be obvious difficulties drawing lines between those issues and matters of substantive nonpatent law.²³¹

B. THE MODEL: CERTIFICATION OF UNSETTLED STATE-LAW ISSUES TO STATE SUPREME COURTS

We propose a solution that would leave Federal Circuit choice-of-law rules, for better or worse, untouched: The Federal Circuit could improve the quality and certainty of its decisions on issues governed by regional circuit law by certifying unsettled issues to the relevant regional circuit.

Before unpacking the specifics of that proposal, it’s worth discussing the model we draw on, namely, the established process by which federal courts certify unsettled issues of state law to the relevant state supreme court. The federal courts of appeals use the certification procedure regularly. One recent study of the Third, Sixth, and Ninth Circuits identified 130 questions certified by those three courts from 2010 through 2018.²³² Though comprehensive statistics covering all fifty states are hard to come by, it seems safe to estimate

229. *E.g.*, *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1360–61 (Fed. Cir. 1999) (en banc in relevant part) (expanding Federal Circuit law to govern questions of preemption by federal patent law).

230. *Cf.* Schaffner, *supra* note 17, at 1228 (proposing that “the Federal Circuit should exercise independent judgment over all legal issues that either (1) impact upon the patent-related primary activity of the parties or (2) relate to patent policy and invoke the special expertise of the Federal Circuit”).

231. Additionally, any proposal to expand the applicability of Federal Circuit law would have to confront the reality that the Federal Circuit’s case law on matters outside the substantive core of patent law has often been criticized. *See* Peter S. Menell & Ella Corren, *Design Patent Law’s Identity Crisis*, 36 *BERKELEY TECH. L.J.* 1, 118 (2021) (criticizing the court’s stewardship of design patent law); Menell, *supra* note 30, at 1562 (copyright law); Gugliuzza, *Patent Trolls*, *supra* note 42, at 1583–84 (the law of preemption); Gugliuzza, *The Federal Circuit*, *supra* note 43, at 1797 (various procedural and jurisdictional issues); *see also* Gugliuzza & Lemley, *Myths and Reality*, *supra* note 154, at 7–8 (finding that the Supreme Court reverses the Federal Circuit much more frequently on jurisdictional and procedural issues than on substantive patent issues).

232. Jason A. Cantone & Carly Giffin, *Certified Questions of State Law: An Empirical Examination of Use in Three U.S. Courts of Appeals*, 53 *U. TOL. L. REV.* 1, 33–34 (2021).

that, overall, the federal courts certify to state courts about one hundred questions per year, give or take.²³³

Surprisingly, there's no federal statute authorizing federal courts to certify questions to state courts.²³⁴ The procedure originated in a statute passed by the Florida Legislature in 1945²³⁵ authorizing the Florida Supreme Court to adopt rules allowing certified questions from federal courts.²³⁶ But, according to Judge Bruce Selya, "the statute lay moribund for over a decade,"²³⁷ until the U.S. Supreme Court issued a 1960 opinion praising it and suggesting that the Fifth Circuit use it to certify a question on remand.²³⁸ In fact, the Supreme Court suggested that federal courts could seek authoritative state-law pronouncements from state courts "[e]ven without such a facilitating statute."²³⁹

In the years since, every state except North Carolina has allowed their state supreme courts to accept certified questions from federal courts, either by legislation or court rule.²⁴⁰ Notably, twenty-five states that allow certified questions have done so by court rule alone, without any enabling state statute.²⁴¹ For their part, several federal courts (including four federal courts of appeals) have adopted rules allowing them to *pose* certified questions to state supreme courts.²⁴²

But federal courts have certified questions to state supreme courts even when the certifying court does not have a rule on the matter. For example, the Eleventh Circuit recently certified a question to the Florida Supreme

233. See JASON A. CANTONE & CARLY GRIFFIN, FED. JUD. CTR., CERTIFICATION OF QUESTIONS OF STATE LAW IN THE U.S. COURTS OF APPEALS FOR THE THIRD, SIXTH, AND NINTH CIRCUITS (2010–2018) 12, tbl.A1 (2020), https://www.fjc.gov/sites/default/files/materials/52/Certification%20of%20Questions%20of%20State%20Law_Third-Sixth-Ninth%20Circuits.pdf [<https://perma.cc/PE8J-N4C4>] (reporting between sixty-nine and ninety-nine certified questions received per year from 2012 through 2016 by courts in roughly thirty-five states).

234. Bennett Evan Cooper, *Certification of Questions of Law to State Supreme Courts*, REUTERS (June 22, 2021, 2:46 PM), <https://www.reuters.com/legal/legalindustry/certification-questions-law-state-supreme-courts-2021-06-22> [<https://perma.cc/7AP2-R793>] ("[C]ertification is a creature of state statutes and court rules, not federal law; federal courts simply decide whether to avail themselves of this resource.").

235. Just seven years after the Supreme Court's decision in *Erie Railroad Co. v. Tompkins*, 304 U.S. 64, 78 (1938), which obligated the federal courts to apply state law in cases where state law provides a rule of decision.

236. Hon. Bruce M. Selya, *Certified Madness: Ask a Silly Question . . .*, 29 SUFFOLK U. L. REV. 677, 680 (1995) (citing FLA. STAT. ch. 25.031 (1995)).

237. *Id.*

238. *Clay v. Sun Ins. Off. Ltd.*, 363 U.S. 207, 212 (1960) ("The Florida Legislature, with rare foresight, has dealt with the problem of authoritatively determining unresolved state law involved in federal litigation by a statute which permits a federal court to certify such a doubtful question of state law to the Supreme Court of Florida for its decision.").

239. See *id.*

240. Cooper, *supra* note 234.

241. Judith S. Kaye & Kenneth I. Weissman, *Interactive Judicial Federalism: Certified Questions in New York*, 69 FORDHAM L. REV. 373, app. A at 422–23 (2000).

242. See 2D CIR. R. 27.2; 3D CIR. R. 110.1; 7TH CIR. R. 52; 10TH CIR. R. 27.4.

Court, citing the provisions of Florida law allowing the Florida Supreme Court to accept certified questions.²⁴³ But the Eleventh Circuit did not cite any Eleventh Circuit rules allowing it to *make* a certified question request because no Eleventh Circuit rule exists on that point.²⁴⁴ Importantly for our purposes, the Federal Circuit has also certified questions to state supreme courts²⁴⁵ even though there is no Federal Circuit rule addressing that practice.²⁴⁶

In sum, federal courts have long felt free to certify questions to state supreme courts as long as the state has a law or court rule allowing it to accept certified questions—whether or not the state has enshrined the practice in statutory law and whether or not the certifying federal court has a rule on point.

C. THE PROPOSAL AND ITS BENEFITS

Drawing on the established practice of federal courts certifying questions of unsettled state law to state courts, the Federal Circuit should similarly certify unsettled questions of regional circuit law to the relevant regional circuit. Instituting this procedure would be easy: The regional circuits, like many state courts, could adopt rules allowing them to accept certified questions from the Federal Circuit.²⁴⁷ The Federal Circuit, for its part, would not even need to adopt a rule allowing it to *pose* certified questions (though the better practice might be for the Federal Circuit to do so).²⁴⁸

243. *Dream Defs. v. Governor of Fla.*, 57 F.4th 879, 893–94 (11th Cir. 2023); *accord* *Cascade Health Sols. v. PeaceHealth*, 515 F.3d 973, 975 (9th Cir. 2008) (mem.) (certifying question to the Oregon Supreme Court from another federal court of appeals with no rule on point), *vacated*, 542 F.3d 668 (2008) (mem.).

244. *Dream Defs.*, 57 F.4th at 893.

245. *See, e.g.*, *Preston v. Marathon Oil Co.*, 684 F.3d 1276, 1285 (Fed. Cir. 2012); *Klamath Irrigation Dist. v. United States*, 532 F.3d 1376, 1377–78 (Fed. Cir. 2008); *Chevy Chase Land Co. v. United States*, 158 F.3d 574, 575–76 (Fed. Cir. 1998); *cf.* *Toews v. United States*, 376 F.3d 1371, 1381 (Fed. Cir. 2004) (refusing to certify a question to the California Supreme Court because “[w]e are left with no doubt as to the proper application of the state’s law to these facts”).

246. There was initially perhaps some doubt about whether the Federal Circuit could certify questions to state courts, but one of the Federal Circuit’s predecessor courts, the Court of Claims, did it, and the Federal Circuit has since followed suit, as illustrated by the cases cited in the preceding footnote. *See* *Smith v. Johnson Propeller Co.*, No. 95-1406, 1996 WL 202674, at *8 (Fed. Cir. Apr. 24, 1996) (Smith, J., dissenting) (“Although the question whether an issue of state law should be certified to the state’s highest court is a case of first impression in the Federal Circuit, we are not without precedent in this regard. The inquiry arose on at least two occasions before one of our predecessor courts. In one instance, the question was certified; in the other it was not.” (citing *Isaacson, Rosenbaum, Spiegelman & Friedman, PC v. United States*, 221 Ct. Cl. 831 (1979); *A–B Cattle Co. v. United States*, 219 Ct. Cl. 624 (1979))).

247. Enacting a local rule merely requires the assent of a majority of the court’s active judges. *See* FED. R. APP. P. 47(a)(1) (“Each court of appeals acting by a majority of its judges in regular active service may, after giving appropriate public notice and opportunity for comment, make and amend rules governing its practice.”).

248. *See* Megan M. La Belle, *The Local Rules of Patent Procedure*, 47 ARIZ. ST. L.J. 63, 122–23 (2015) (discussing the benefits of transparency in drafting and adopting local procedural rules).

It's worth noting that an effective certified question regime from the Federal Circuit to the regional circuits would, realistically, require action from only three regional circuits: the Third, Fifth, and Ninth because patent litigation is highly concentrated in district courts in those circuits. According to the latest numbers available on Docket Navigator, in 2022, 74.4 percent of all patent cases nationwide were filed in district courts in the Third, Fifth, and Ninth Circuits.²⁴⁹

Allowing certified questions from the Federal Circuit to the regional circuits would ease the problems we identified above. When the Federal Circuit is weighing a mandamus petition on venue transfer, for example, it would not need to strain to analogize to Fifth Circuit precedents with dissimilar and unilluminating fact patterns. Nor would it need to rely on its own prior nonprecedential decisions as if they were binding law. Instead, the Federal Circuit could simply ask the Fifth Circuit how Fifth Circuit transfer factors should apply to, say, a patent case in which the defendant has a large presence in Texas but the accused product was mostly developed elsewhere. Likewise, when the Federal Circuit is faced with an *Oracle v. Google* situation—where billions of dollars hinge on unsettled issues of Ninth Circuit copyright law—the Federal Circuit could certify questions to the Ninth Circuit to resolve key points of legal ambiguity.

Allowing certified questions from the Federal Circuit to the regional circuits would provide many of the same benefits as the existing federal-state certification regime. Certifying questions from federal courts to state courts promotes uniformity in the law²⁵⁰ and comity among courts.²⁵¹ It also promotes a sense of fairness by assuring litigants that key legal issues will be decided by the court most qualified (or at least most entitled) to decide them.²⁵² And it gives the receiving court more opportunity to develop its own law by applying it to factual scenarios that it might not otherwise encounter.²⁵³

249. DOCKET NAVIGATOR, <https://search.docketnavigator.com/patent/search> (accessed Sept. 24, 2023) (search “cases by year,” limit the results to cases filed in district courts in those three circuits in 2022—2,839 cases—and compare to the overall number of district court cases filed in 2022—3,816).

250. See John Macy, Note, *Give and Take: State Courts Should Be Able to Certify Questions of Federal Law to Federal Courts*, 71 DUKE L.J. 907, 919 (2022) (stating that certification “allows for unresolved legal issues to be answered by the same body whether they arise in federal or state court, which enhances uniformity and could reduce forum shopping”).

251. See John B. Corr & Ira P. Robbins, *Interjurisdictional Certification and Choice of Law*, 41 VAND. L. REV. 411, 457 (1988).

252. Macy, *supra* note 250, at 920; see also Jonathan Remy Nash, *Examining the Power of Federal Courts to Certify Questions of State Law*, 88 CORNELL L. REV. 1672, 1698 (2003) (“[C]ertification offers a federalism benefit to litigants in the form of ‘fairness.’ Specifically, it provides federal court litigants the benefit of a resolution of their case based upon definitive state law, as determined by the state high court.”).

253. Macy, *supra* note 250, at 919.

D. OBJECTIONS AND RESPONSES

There are of course objections to a Federal-Circuit-to-regional-circuit certified question procedure, but we think they are ultimately unpersuasive. First off, as we've discussed, congressional action would not be essential.²⁵⁴ A statute could, however, be helpful, not just in assuring the federal courts of appeals about the legality of the process, but also in clarifying that regional circuits deciding certified questions of nonpatent law that arise in patent cases aren't intruding on the Federal Circuit's exclusive jurisdiction (a topic we'll return to shortly).

Another objection might relate to the difficulty of getting a "definitive" pronouncement about the law from the regional circuit. As Peter Menell noted in discounting the possibility of the Federal Circuit certifying questions to the regional circuits, "[u]nlike the highest court in a state, regional circuits typically sit in panels smaller than the full bench," and so it could be "unduly cumbersome" to obtain a controlling, en banc decision on the relevant issue.²⁵⁵ Yet there's no reason why a certified question would require an answer from the en banc regional circuit. Rather, the regional circuit could answer the certified question through a regular three-judge panel, just as three-judge panels routinely issue binding rulings on circuit law.²⁵⁶ Indeed, some state supreme courts (such as Delaware's) also generally sit in three-judge panels comprising less than the entire court,²⁵⁷ and those courts have often used three-judge panels to answer certified questions from federal courts.²⁵⁸ A regional circuit could handle certified questions from the Federal Circuit in the same way. Of course, if the regional circuit determined that a certified question involved an issue of exceptional importance or might entail overruling

254. Menell, *supra* note 30, at 1593.

255. *Id.*

256. See generally 21 C.J.S. *Courts* § 200 (2023) (noting that "panels of appellate courts are bound by previous decisions until overturned by a higher court or the court en banc" and "one three-judge panel does not have the authority to overrule another three-judge panel of the court").

257. *The Supreme Court of Delaware: Oral Arguments*, DEL. CTS., <https://courts.delaware.gov/he lp/proceedings/supreme.aspx> [<https://perma.cc/XK5C-NPDH>] ("The justices usually sit in panels of three justices to decide most cases . . .").

258. See, e.g., *Waters v. United States*, 787 A.2d 71, 71 (Del. 2001); *E.I. DuPont de Nemours & Co. v. Fla. Evergreen Foliage*, 744 A.2d 457, 458 (Del. 1999); *Potter v. Peirce*, 688 A.2d 894, 895 (Del. 1997); *Riblet Prods. Corp. v. Nagy*, 683 A.2d 37, 37 (Del. 1996); *United States v. Anderson*, 669 A.2d 73, 74 (Del. 1995); *Rales v. Blasband*, 634 A.2d 927, 929 (Del. 1993). The New Hampshire Supreme Court has also used three-judge panels to answer certified questions from federal courts. See, e.g., *Brown v. Saint-Gobain Performance Plastics Corp.*, No. 2022-0132, 2023 WL 2577257, at *1, *3 (N.H. Mar. 21, 2023); *EnergyNorth Nat. Gas, Inc. v. Certain Underwriters at Lloyd's*, 934 A.2d 517, 518, 528 (N.H. 2007); *EnergyNorth Nat. Gas, Inc. v. Underwriters at Lloyd's*, 848 A.2d 715, 717, 725 (N.H. 2004). And the District of Columbia Court of Appeals has done the same. See, e.g., *Republic of Sudan v. Owens*, 194 A.3d 38, 39 (D.C. 2018); *Sturdza v. United Arab Emirates*, 11 A.3d 251, 252 (D.C. 2011); *Holmes v. Amerex Rent-A-Car*, 710 A.2d 846, 847 (D.C. 1998).

circuit precedent, it could choose to assemble the en banc court, just as the Delaware Supreme Court sometimes does to answer certified questions.²⁵⁹

One might also object that asking the federal courts of appeals to answer certified questions would be tantamount to seeking advisory opinions from those courts.²⁶⁰ Advisory opinions are forbidden by Article III of the U.S. Constitution, which limits the judicial power of the United States to “cases” and “controversies.”²⁶¹ Yet any Federal Circuit appeal underlying a certified question would present an Article III case or controversy. If a regional circuit answered a certified question in service of such an appeal, the regional circuit would be playing a role in resolving a live dispute; it would not be issuing an advisory opinion, which Justice Frankfurter famously (if verbosely) defined as:

[S]uch advance expressions of legal judgment upon issues which remain unfocused because they are not pressed before the Court with that clear concreteness provided when a question emerges precisely framed and necessary for decision from a clash of adversary argument exploring every aspect of a multifaceted situation embracing conflicting and demanding interests²⁶²

Rather, a regional circuit answering a certified question of nonpatent law would be deciding a hotly disputed, critically important question between litigation adversaries—particularly when, as it should, the Federal Circuit limits certification to questions that are likely to be dispositive of the appeal at issue.²⁶³

259. See, e.g., *NAF Holdings, LLC v. Li & Fung (Trading) Ltd.*, 118 A.3d 175, 176 (Del. 2015). The recent trend in the Delaware Supreme Court has been to use the full en banc court to answer certified questions from the federal courts. Yet the Delaware Supreme Court Rule on point (DEL. R. SUP. CT. 41 (2015)) is silent on whether certified questions should be answered by the en banc court or a three-judge panel, and the court’s practice in the recent past was to answer such questions through three-judge panels. See *supra* notes 257–58 and accompanying text.

260. See *Selya*, *supra* note 236, at 685 (arguing that “federal courts would likely resist the fiction that certified questions are not advisory opinions”); cf. *Nash*, *supra* note 252, at 1676 (suggesting that certification from federal court to state court may violate both Article III and the diversity statute).

261. U.S. CONST. art. III, § 2; *Carney v. Adams*, 141 S. Ct. 493, 498 (2020) (“The Constitution grants Article III courts the power to decide ‘Cases’ or ‘Controversies.’ We have long understood that constitutional phrase to require that a case embody a genuine, live dispute between adverse parties, thereby preventing the federal courts from issuing advisory opinions.” (citation omitted)).

262. *United States v. Fruehauf*, 365 U.S. 146, 157 (1961).

263. See *Quilez-Velaz v. Ox Bodies, Inc.*, 823 F.3d 712, 721 (1st Cir. 2016) (“Because the issue is determinative of Quilez’s appeal, we find ‘the prudent course is to certify the question to that court better suited to address the issue.’” (quoting *Pagán-Colón v. Walgreens of San Patricio, Inc.*, 697 F.3d 1, 18 (1st Cir. 2012))); cf. *Sahara Coal Co. v. Fitts*, 39 F.3d 781, 784 (7th Cir. 1994) (Posner, C.J.) (“The Director of the Office of Workers’ Compensation Programs . . . invites us to resolve an esoteric issue concerning proof of causation . . . but admits that the resolution would not affect the outcome of this case. The Director is asking for an advisory opinion, useful in future cases but irrelevant to this one, and we are not authorized to issue such opinions.”).

Indeed, the U.S. Supreme Court itself may answer certified questions from the federal courts of appeals.²⁶⁴ The Supreme Court is an Article III court, and it can answer certified questions in an appeal that is pending in a different Article III court.²⁶⁵ If the Supreme Court may act in this manner congruent with Article III, then the regional circuits should be able to do so as well.²⁶⁶

The analogy isn't perfect, admittedly, because the Supreme Court will eventually have jurisdiction (or the opportunity to exercise jurisdiction) over any case pending in the federal courts of appeals,²⁶⁷ while the regional circuits would never otherwise have jurisdiction over an appeal in a case arising under patent law. And the Supreme Court may also, by statute, decide more than simply the certified question: it can "require the entire record to be sent up for decision of the entire matter in controversy."²⁶⁸ But that statute is permissive—§ 1254(2) also allows the Supreme Court to answer certified questions *without* deciding the underlying case—just as we propose for intercircuit certification. Moreover, the Supreme Court's certification jurisdiction has existed since 1802,²⁶⁹ and the Court has never indicated that certification, though rarely used today, raises Article III concerns.²⁷⁰

264. See 28 U.S.C. § 1254 ("Cases in the courts of appeals may be reviewed by the Supreme Court . . . [b]y certification at any time by a court of appeals of any question of law . . . as to which instructions are desired, and upon such certification the Supreme Court may give binding instructions or require the entire record to be sent up for decision of the entire matter in controversy."); SUP. CT. R. 19(1) ("A United States court of appeals may certify to this Court a question or proposition of law on which it seeks instruction for the proper decision of a case."); see also Aaron Nielson, *The Death of the Supreme Court's Certified Question Jurisdiction*, 59 CATH. U. L. REV. 483, 484 (2010) ("[T]here already is a law that allows federal appellate courts to ask the Supreme Court questions, and there has been such a law in some form for over 200 years! Unfortunately, despite its potential utility . . . today 'there are few lawyers (and perhaps few circuit judges) who even know' that this statutory 'option' exists." (footnotes omitted) (quoting Edward A. Hartnett, *Questioning Certiorari: Some Reflections Seventy-Five Years After the Judges' Bill*, 100 COLUM. L. REV. 1643, 1712 (2000))).

265. Though the Rule 19 certification process has been used rarely in recent years, the reasons are pragmatic, not constitutional. See STEPHEN M. SHAPIRO, KENNETH S. GELLER, TIMOTHY S. BISHOP, EDWARD A. HARTNETT & DAN HIMMELFARB, *SUPREME COURT PRACTICE* 9-3 (11th ed. 2019) ("The disfavor with which the Court regards certificates may result from its fear that unrestricted use of the certification process would frustrate the Court's discretionary power to limit its review to cases it deems worthy. For if the courts of appeals were free to request instructions from the Supreme Court on any doubtful question, the effect might be to vest in them a substantial part of the discretion to determine what cases the Supreme Court should hear.")

266. Though certification to the Supreme Court is authorized by federal statute (28 U.S.C. § 1254(2)) and court rule (SUP. CT. R. 19), neither court rules nor statutes can overcome the constitutional bar on advisory opinions imposed by Article III.

267. 28 U.S.C. § 1254(1).

268. *Id.* § 1254(2).

269. See 17 CHARLES ALAN WRIGHT, ARTHUR R. MILLER, EDWARD H. COOPER & VIKRAM DAVID AMAR, *FEDERAL PRACTICE AND PROCEDURE* § 4038 (3d ed. 2023).

270. See *id.*

In short, it's possible that Article III could be interpreted to bar the certification regime we propose. But we think the better interpretation of Article III—informed by the numerous practical benefits of certification of questions of regional circuit law in patent cases—would permit it.²⁷¹

Indeed, some states limit their courts' jurisdiction to live cases and controversies, similar to Article III.²⁷² Yet, as noted, every state supreme court, save one will entertain certified questions from the federal courts, even though many of those state courts have had to navigate state law prohibitions on advisory opinions.²⁷³

One common objection to certification in the federal-court-to-state-court context is delay: It takes time for the certifying court to formulate its order, for the receiving court to decide the certified question (or to decline to decide it), and for the certifying court to then resolve the case upon its return.²⁷⁴ It is certainly reasonable for a court, when deciding whether to certify a question in a given case, to consider whether the delay to the litigants is worth the potential payoff.²⁷⁵ But we don't think concerns about delay justify *forbidding* the Federal Circuit from certifying questions to the regional circuits.

271. For a cogent argument that answers to certified questions don't amount to advisory opinions, see Hon. William G. Bassler & Michael Potenza, *Certification Granted: The Practical and Jurisprudential Reasons Why New Jersey Should Adopt a Certification Procedure*, 29 SETON HALL L. REV. 491, 521–22 (1998) (“[A]nswering a certified question contains none of the evils typically associated with rendering an advisory opinion . . . for the obvious reason that the certified question is litigated in an adversarial posture.”).

272. See, e.g., *Plan Helena, Inc. v. Helena Reg'l Airport Auth. Bd.*, 226 P.3d 567, 568–69 (Mont. 2010); *Hamm v. Norfolk S. Ry. Co.*, 52 So.3d 484, 500 (Ala. 2010) (Lyons, J., concurring); *State ex rel. Morrison v. Sebelius*, 179 P.3d 366, 378 (Kan. 2008); *Brod v. Agency of Nat. Res.*, 936 A.2d 1286, 1289 (Vt. 2007); *State v. Lead Indus. Ass'n, Inc.*, 898 A.2d 1234, 1237 (R.I. 2006); *US Ecology, Inc. v. State Dep't of Env't Quality*, 601 N.W.2d 775, 779–80 (Neb. 1999).

273. See generally *Corr & Robbins*, *supra* note 251, at 422 (discussing the relevant case law and concluding: “Most state high courts thus have sought and found one way or another around the advisory opinion objection to certification. Some of the answers . . . speak more to practical considerations than to rigorous judicial analysis. In fact, the sheer variety of answers to the advisory opinion issue suggests that no single, entirely satisfactory answer to that objection exists. The clear preponderance of opinion that answers to the objection can be found, however, suggests that concerns about rendering advisory opinions will not be a significant barrier to certification in the future.”).

274. See J. Skelly Wright, *The Federal Courts and the Nature and Quality of State Law*, 13 WAYNE L. REV. 317, 325–26 (1967) (discussing the costs and benefits of certification).

275. See *Lindenberg v. Jackson Nat'l Life Ins. Co.*, 919 F.3d 992, 993 (6th Cir. 2019) (Clay, J., concurring in the denial of hearing en banc) (discussing the court's “established practice of trusting panels to exercise their experience, discretion, and best judgment to determine when certification is appropriate”). Similarly, the Federal Circuit, in deciding whether to certify a question of nonpatent law to the regional circuits, might consider whether the nonpatent issues are cleanly severable from any patent issues raised in the case. See Jonathan Remy Nash, *The Uneasy Case for Transjurisdictional Adjudication*, 94 VA. L. REV. 1869, 1885–90 (2008) (raising concerns about severability of certified questions in the state/federal context). In most patent cases that would be candidates for certification, however, the severability concerns ought to be minimal: Venue analysis, for instance, doesn't involve much if any consideration of the merits of the underlying patent infringement claims, and nonpatent substantive issues that come to the

To begin with, Federal-Circuit-to-regional-circuit certification could save time and expense in the long run by definitively resolving an issue of regional circuit law that recurs frequently in patent cases. Think about the hundred-plus venue cases the Federal Circuit has decided in the past decade or so, all raising similar questions of Fifth Circuit law.²⁷⁶ Moreover, the Tenth Circuit ultimately *did* decide the issue of antitrust law the Federal Circuit guessed about in the *Xerox* case discussed above.²⁷⁷ Though the Tenth Circuit said the Federal Circuit guessed correctly, sixteen years elapsed between the Federal Circuit's initial guess and the Tenth Circuit's definitive answer in a separate case.²⁷⁸ A certification regime could have provided a definitive Tenth Circuit answer far sooner.

The available evidence indicates that it takes state courts ten to twelve months to answer a certified question.²⁷⁹ So, appeals involving certified questions undoubtedly pend for longer than the average case.²⁸⁰ But a certification delay of months or even a year is not massive in the scheme of things, particularly in a patent case that, in many instances, will have already been litigated to a final judgment and that presents legal questions close enough to warrant a certified question.

Finally, as we noted at the outset of this Section, a skeptic might object that allowing regional circuits to answer certified questions from the Federal Circuit would violate the statutory provision giving the Federal Circuit exclusive jurisdiction over patent appeals.²⁸¹ But this objection is unpersuasive because a court does not assume jurisdiction over a case simply by answering a certified question.²⁸² This can be seen most clearly from the fact that the Federal Circuit routinely certifies questions to state supreme courts,²⁸³ even though state supreme courts have no jurisdiction over the types of appeals entrusted to the Federal Circuit's exclusive jurisdiction.²⁸⁴ As the Oklahoma

Federal Circuit, such as copyright issues, are often standalone claims that don't have anything to do with patent law.

276. See *supra* Section III.A.

277. See *supra* Section III.A.

278. *SOLIDFX, LLC v. Jeppesen Sanderson, Inc.*, 841 F.3d 827, 842 (10th Cir. 2016).

279. Cantone & Giffin, *supra* note 232, at 47.

280. The Federal Circuit's median disposition time for an entire case—from notice of appeal to final decision—ranges between twelve and fifteen months in any given year. See U.S. CT. OF APPEALS FOR THE FED. CIR., *MEDIAN DISPOSITION TIME FOR CASES DECIDED BY MERITS PANELS* (2022), <https://cafc.uscourts.gov/wp-content/uploads/reports-stats/disposition-time/MedDispTimeMERITS-LineChart-FY22.pdf> [<https://perma.cc/QB2U-5XTZ>].

281. 28 U.S.C. § 1295(a)(1).

282. Selya, *supra* note 236, at 685 (“When a question is certified, the responding court does not assume jurisdiction over the parties or over the subject matter.”).

283. See *supra* note 255 and accompanying text.

284. See 28 U.S.C. § 1338(a) (“No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents . . .”). For an analysis questioning whether certification from federal court to state court is consistent with the federal courts' obligation to decide diversity cases, see Nash, *supra* note 252, at 1729.

Supreme Court noted in responding to an argument about its lack of jurisdiction over a question certified by a federal district court: “By answering a state-law question certified by a federal court, we may affect the outcome of federal litigation, *but it is the federal court who hears and decides the cause.*”²⁸⁵ Similarly, in the patent context, a regional circuit might affect the outcome of patent litigation, but it would be the Federal Circuit that ultimately decides the case.

E. POTENTIAL EXPANSION: CERTIFIED QUESTIONS TO THE FEDERAL CIRCUIT

One final point deserves mention. Namely, if we begin allowing certified questions from the Federal Circuit to the regional circuits, it might make sense to also allow certified questions in the other direction—from the regional circuits to the Federal Circuit. It’s relatively rare that the regional circuits need to decide issues of Federal Circuit law or patent law, but situations do arise.

One example involves so-called *Walker Process* claims—antitrust claims based on the defendant’s act of procuring a patent through fraud on the U.S. Patent and Trademark Office (“PTO”).²⁸⁶ Determining whether a defendant committed fraud on the PTO raises issues of patent law, including, whether the PTO would have issued the patent but-for the defendant’s misrepresentations.²⁸⁷ Yet the Federal Circuit currently takes the view that *Walker Process* claims do not fall within its jurisdiction and has even transferred *Walker Process* claims to the regional circuits²⁸⁸ (though some regional circuits have disagreed).²⁸⁹ More broadly, when a patent-related antitrust claim is premised on both patent and alternative nonpatent grounds, the appeal goes to the regional circuit because patent law is not a *necessary* ingredient of the plaintiff’s well-pleaded complaint.²⁹⁰ The upshot is that, in adjudicating patent-related

285. *Bonner v. Okla. Rock Corp.*, 863 P.2d 1176, 1178 n.3 (Okla. 1993) (citing *Shebester v. Triple Crown Insurers*, 826 P.2d 603, 606 n.4 (Okla. 1992); *Scott v. Bank One Tr. Co.*, 577 N.E.2d 1077, 1079 n.2 (Ohio 1991)); *see also* Bassler & Potenza, *supra* note 271, at 510 n.95 (“[C]ertification does not involve the exercise of jurisdiction by the answering court.” (citing *Bonner*, 863 P.2d at 1176 n.3)).

286. *See* *Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*, 382 U.S. 172, 174 (1965).

287. *See, e.g., Xitronix Corp. v. KLA-Tencor Corp.*, 916 F.3d 429, 441 (5th Cir. 2019) (“[T]he fraud element of Xitronix’s claim can be adjudicated only with reference to patent law. *Walker Process* requires showing that a given statement or omission was ‘material to patentability.’” (quoting *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1364 (Fed. Cir. 1998))); *accord* *Xitronix Corp. v. KLA-Tencor Corp.*, 882 F.3d 1075, 1078 (Fed. Cir. 2018) (“We acknowledge that a determination of the alleged misrepresentations to the PTO will almost certainly require some application of patent law.”); *In re Lipitor Antitrust Litig.*, 855 F.3d 126, 145 (3d Cir. 2017) (“*Walker Process* fraud has for some time been considered by courts to present a substantial question of patent law.”).

288. *Xitronix*, 882 F.3d at 1078–80 (transferring *Walker Process* appeal to the Fifth Circuit).

289. *Xitronix*, 916 F.3d at 441–44 (transferring the same appeal back to the Federal Circuit).

290. *See Lipitor*, 855 F.3d at 146 (noting that “here, plaintiffs could obtain relief on their section 2 monopolization claims by prevailing on an alternative, non-patent-law theory, namely, that Pfizer and Wyeth monopolized the market in their respective branded drugs by engaging in

antitrust claims, it could be useful for the regional circuits to certify any unclear issues of patent law to the Federal Circuit.

There are also situations beyond antitrust in which regional circuits need to decide issues of Federal Circuit patent law. For example, in *Gunn v. Minton*, the Supreme Court held that an attorney malpractice claim is not within the Federal Circuit's jurisdiction even when the alleged malpractice was by a patent attorney working on a patent matter.²⁹¹ After *Gunn*, it's the regional circuits that hear appeals alleging malpractice in patent litigation or patent prosecution (assuming the plaintiffs have some avenue into federal court, such as diversity jurisdiction).²⁹² The same goes for any other tort, contract, or statutory claim that has an issue of patent law embedded within it.²⁹³

The primary reason for the creation of the Federal Circuit was to create uniformity in patent law.²⁹⁴ It harms that uniformity for the regional circuits to decide unsettled or difficult issues of patent law. And it would vindicate congressional design and policy if the regional circuits were allowed to certify unsettled or difficult issues of patent law to the Federal Circuit.

CONCLUSION

Our proposal is simple, so we'll keep our conclusion simple, too. A certification process between the Federal Circuit and the regional circuits would be legal, easy to institute, and a valuable tool for courts and litigants. The Federal Circuit and the regional circuits should make it a reality post-haste.

a reverse-payment settlement" and "the presence of non-patent-law theories of liability supporting the *Lipitor* and *Effexor* plaintiffs' monopolization claims vests jurisdiction over their appeals in this Court, not the Federal Circuit"); *In re DDAVP Direct Purchaser Antitrust Litig.*, 585 F.3d 677, 684–87 (2d Cir. 2009) (similar holding and logic).

291. *Gunn v. Minton*, 568 U.S. 251, 264–65 (2013).

292. *See, e.g., Seed Co. Ltd. v. Westerman*, 832 F.3d 325, 331 (D.C. Cir. 2016).

293. *See Gugliuzza, Rising Confusion, supra* note 24, at 462–63 (cataloguing examples).

294. *See, e.g., S. REP. NO. 97-275*, at 5 (1981).