IMPROVING THE FEDERAL CIRCUIT'S APPROACH TO CHOICE OF LAW FOR PROCEDURAL MATTERS IN PATENT CASES

BY TED L. FIELD[a]

[a] Visiting Assistant Professor of Law, Chicago-Kent College of Law; of counsel, Banner & Witcoff, Ltd. J.D., *summa cum laude*, John Marshall Law School, 2002; M.S., Northwestern University, 1990; B.A., University of Illinois at Chicago, 1987.

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INTRODUCTION

Congress created the U.S. Court of Appeals for the Federal Circuit in 1982 when it enacted the Federal Court Improvements Act of 1982 ("FCIA").[1] The FCIA gave the Federal Circuit exclusive jurisdiction over appeals of patent decisions of the district courts.[2] An important purpose of Congress in creating the Federal Circuit was to bring

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[1] *E.g.*, Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 3 (1989) (citing Pub. L. No. 97-164, 96 Stat. 25); Lee Petherbridge & R. Polk Wagner, *The Federal Circuit and Patentability: An Empirical Assessment of the Law of Obviousness*, 85 TEX. L. REV. 2051, 2056-57 (2007) (citing same).

[2] 28 U.S.C. § 1295(a)(1) (2000). But the Supreme Court in *Vornado* held that "[n]ot all cases involving a patent-law claim fall within the Federal Circuit's jurisdiction." Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 834 (2002). *See generally* Christopher A. Cotropia, *"Arising Under" Jurisdiction and Uniformity in Patent Law*, 9 MICH. TELECOMM. & TECH. L. REV. 253, 279-85 (2003) (summarizing the *Vornado* case); Larry D. Thompson, Jr., *Adrift on a Sea of Uncertainty: Preserving Uniformity in Patent Law Post-*Vornado *Through Deference to the Federal Circuit*, 92 GEO. L. J. 523, 540-63 (2004) (describing the *Vornado* decision and analyzing whether it was correctly decided). Under *Vornado*, the Federal Circuit has jurisdiction only where "a patent-law claim appears on the face of the plaintiff's well-pleaded complaint." 535 U.S. at 834. Thus, the Federal Circuit does not have jurisdiction over patent-law claims that arise solely in counterclaims. *See id.*

The Federal Circuit also hears appeals from the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office. 28 U.S.C. § 1295(4)(A) (2000). Moreover, "[p]artly out of recognition of the dangers of specialization," the FCIA "supplemented [the Federal Circuit's] jurisdiction with adjudicatory authority in such diverse areas as trademark, tariff and customs law, technology transfer regulations, and government contract and labor disputes." Dreyfuss, *supra* note 1, at 4 (footnotes omitted); *accord* Charles W. Adams, *The Court of Appeals for the Federal Circuit: More Than a National Patent Court*, 49 MO. L. REV. 43, 82 (1984). *See generally id.* at 65-75 (describing the Federal Circuit's jurisdiction); Joseph R. Re, *Brief Overview of the Jurisdiction of the U.S. Court of Appeals for the Federal Circuit Under § 1295(a)(1)*, 11 FED. CIR. B.J. 651 (2002) (same); Adam E. Miller, Note, *The Choice of Law Rules and the Use of Precedent in the Federal Circuit: A Unique and Evolving System*, 31 OKLA. CITY U. L. REV. 301, 304-10 (2006) (same).

national uniformity to patent law.[3] Before the creation of the Federal Circuit, "patent cases [were] inconsistently adjudicated" by the regional circuit courts of appeals.[4] Business leaders contended that this inconsistent adjudication led to uncertainty, and this uncertainty stifled innovation.[5] Thus, the FCIA created the Federal Circuit to "provid[e] for uniformity of doctrinal development in the patent area."[6] Moreover, Congress hoped

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[3] *See, e.g.*, S. REP. NO. 97-275, at 2-6 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 12-16; *see also Vornado*, 535 U.S. at 838 (Stevens, J., concurring in part and concurring in the judgment); Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359-60 (Fed. Cir. 1999) (en banc in relevant part); Dreyfuss, *supra* note 1, at 2-4; Joan E. Schaffner, *Federal Circuit "Choice of Law": Erie Through the Looking Glass*, 81 IOWA L. REV. 1173, 1178 (1996).

[4] S. REP. NO. 97-275, at 5, 1982 U.S.C.C.A.N. at 15; *accord, e.g.*, H.R. REP. NO. 97-312, at 20-21 (1981); Adams, *supra* note 2, at 57; Dreyfuss, *supra* note 1, at 6-7; Henry J. Friendly, *The "Law of the Circuit" and All That*, 46 ST. JOHN'S L. REV. 406, 413 (1972); *see* Petherbridge & Wagner, *supra* note 1, at 2057.

The problem of inconsistent patent adjudication among the circuits existed for many years before creation of the Federal Circuit. For example, in 1899, one commentator noted:

> [T]he appellate court of each circuit takes on a local color. That of one circuit is avowedly opposed to patents and sustains not one in twenty, thereby encouraging infringements and tending to throw the whole patent system into disrepute; that in another is liberally inclined toward patents, going, perhaps, in some instances, to extremes to sustain them, with the result of localizing litigation and congesting business in that particular court.

Melville Church, *Reasons Why the Appellate Jurisdiction of the Supreme Court in Patent Causes Should Be Restored*, 8 YALE L.J. 291, 292-93 (1899).

[5] Petherbridge & Wagner, *supra* note 1, at 2058.

[6] S. REP. NO. 97-275, at 5, 1982 U.S.C.C.A.N. at 15.

that this "uniformity [would] reduce the forum-shopping that [was] common to patent litigation."[7]

The Federal Circuit faces a unique choice-of-law question because it is virtually unique "in that its jurisdiction is defined in terms of subject matter rather than geography."[8] This uniqueness creates the choice-of-law problem that the court faces.[9] Normally, in a non-patent-related case, a district court applies the procedural-law[10] precedent of the regional circuit court that reviews the district court's decisions. However, because the Federal Circuit reviews all cases in which a patent-related claim was raised in the well-pleaded complaint, rather than the regional circuit court, a choice-of-law question arises: What precedent should the district courts and Federal Circuit apply to procedural issues in patent cases—that of the regional circuit or the Federal Circuit?

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[7] *Id.*

[8] *Id.* at 3, 1982 U.S.C.C.A.N. at 13; *accord* Charles L. Gholz, *Choice of Law in the United States Circuit Court of Appeals for the Federal Circuit*, 13 AM. INTELL. PROP. L. ASSOC. Q.J. 309, 309 (1985); S. Jay Plager & Lynne E. Pettigrew, *Rethinking Patent Law's Uniformity Principle: A Response to Nard and Duffy*, 101 NW. U. L. REV. 1735, 1735 (2007); Miller, *supra* note 2, at 301. Another appellate court whose jurisdiction was defined by its subject matter rather than geography was the Temporary Emergency Court of Appeals ("TECA"), which existed from 1970 through 1993. *See* Texas Am. Oil Corp. v. United States Dep't of Energy, 44 F.3d 1557, 1562-63 (Fed. Cir. 1995) (en banc). For a description of the formation and abolishment of TECA, as well as its jurisdiction and its choice-of-law rules for procedural matters, see *infra* note 295.

[9] Gholz, *supra* note 8, at 309; Schaffner, *supra* note 3, at 1176-78; Thompson, *supra* note 2, at 581; *see* Dreyfuss, *supra* note 1, at 38.

[10] This article addresses only the issue of choice of procedural law. It does not address the related issue of choice of substantive law.

Under its current choice-of-law rules, the Federal Circuit's purported default rule is to apply the procedural law[11] of the regional circuit of the district court where the case was heard.[12] But where a particular procedural matter sufficiently implicates substantive patent law, the court instead purportedly applies its own law.[13] Although this rule may seem straightforward on its face, in actuality, problems have arisen in the application of this rule. For one thing, the Federal Circuit has articulated this test in many different ways over the years.[14] And this inconsistent articulation has led to inconsistent application.[15] Indeed, the Federal Circuit has inconsistently applied its choice-of-law rules both within particular issues (i.e., intra-issue inconsistency) and between different issues (i.e., inter-issue inconsistency). As a result, district courts and litigants in patent cases often cannot be sure which law applies to a particular procedural issue.

This article evaluates the Federal Circuit's current choice-of-law rules for procedural issues in patent cases and contrasts these current rules with other possible

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[11] This article uses terminology such as "regional-circuit law" and "Federal Circuit law" because the Federal Circuit uses this same terminology. *See, e.g.*, Biomedical Patent Mgmt. Corp. v. California, Dep't of Health Servs., 505 F.3d 1328, 1334 (Fed. Cir. 2007); Elecs. for Imaging, Inc. v. Coyle, 340 F.3d 1344, 1348 (Fed. Cir. 2003); Schaffner, *supra* note 3, at 1775 n.8. However, this terminology is not completely accurate because the Federal Circuit is not actually choosing between the law of different jurisdictions but instead is "addressing a choice between exercising its own independent judgment or deferring to another circuit's judgment on a legal issue." *Id.*

[12] *See, e.g.*, Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part).

[13] *See, e.g.*, *id.*

[14] *See* Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 856 (Fed. Cir 1991).

[15] *See infra* Part II (discussing the Federal Circuit's inconsistent application of its choice-of-law rules).

rules. Other possibilities include the following: (1) applying Federal Circuit law to all issues that "either impact upon the patent-related primary activity of the parties or . . . relate to patent policy and invoke the special expertise of the Federal Circuit";[16] (2) determining whether to apply regional-circuit or Federal Circuit law by using an "essential-relationship spectrum";[17] (3) applying regional-circuit law to all procedural issues in patent cases; and (4) applying Federal Circuit law to all procedural issues in patent cases. To evaluate these different possibilities, this article considers how each of them advances or retards the institutional interests, needs, and goals of the players involved—namely, the Federal Circuit, the district courts, and litigants.

This article begins in Part I by discussing how the Federal Circuit's choice-of-law approach in procedural matters first arose and developed. Next, in Part II, this article examines how the Federal Circuit has applied its choice-of-law rules inconsistently and improperly. In Part III, this article then considers possible ways to improve the Federal Circuit's choice-of-law rules for procedural matters in patent cases. Finally, this article ultimately concludes that the Federal Circuit should abandon its current choice-of-law rules and instead adopt a rule whereby Federal Circuit law would apply to all procedural issues in patent cases.

[16] Schaffner, *supra* note 3, at 1228.

[17] Sean M. McEldowney, Comment, *The "Essential Relationship" Spectrum: A Framework for Addressing Choice of Procedural Law in the Federal Circuit*, 153 U. PA. L. REV. 1639, 1673-76 (2005).

I. ORIGINS OF THE FEDERAL CIRCUIT'S CHOICE-OF-LAW APPROACH

Soon after the creation of the Federal Circuit, the court recognized that an issue existed concerning whether to apply Federal Circuit law or regional-circuit law to procedural matters in patent cases. To address this issue, the Federal Circuit developed rules to determine which law to apply to a particular procedural issue. This Part looks at how the Federal Circuit's choice-of-law rules for procedural matters in patent cases first arose and developed. Part I.A begins by discussing the *Litton* case, in which the Federal Circuit first recognized the existence of its choice-of-law problem. Next, Part I.B discusses the *Panduit* case, in which the Federal Circuit articulated a choice-of-law rule for procedural matters for the first time.

A. *LITTON*: RECOGNITION OF THE CHOICE-OF-LAW PROBLEM

Although Congress apparently never anticipated that this choice-of-law problem would arise,[18] in 1984 the Federal Circuit first recognized the existence of the choice-of-law problem in *Litton Systems, Inc. v. Whirlpool Corp.*[19] In *Litton*, the issue that arose was what standard of review the court should apply in reviewing the issue of likelihood of confusion under the Lanham Act.[20] The case was tried in the Eighth Circuit,[21] which considered likelihood of confusion to be a fact issue, and thus applied the clearly

[18] Gholz, *supra* note 8, at 310.

[19] 728 F.2d 1423 (Fed. Cir. 1984) *overruled on other grounds by* Two Pesos, Inc. v. Taco Cabana, Inc, 505 U.S. 763 (1992).

[20] *Id.* at 1445.

[21] The case was tried in the U.S. District Court for the District of Minnesota, *id.* at 1426, which is in the Eighth Circuit, 28 U.S.C. § 41 (2000).

erroneous standard.[22] However, under Federal Circuit precedent at the time, likelihood of confusion was an issue of law reviewed de novo.[23] Thus, the stage appeared to be set for the Federal Circuit to formulate a rule governing choice of law for procedural matters not relating to patent law.

However, the Federal Circuit sidestepped the issue.[24] The court first noted that it had "yet to issue an opinion on which rule it [would] follow in a Lanham Act case where the district court was located in a circuit having a precedent differing from one [the court] later established."[25] The court then recognized that it did not have to decide this issue in this case because the court held that the district court had committed reversible error under either standard.[26] Thus, the court concluded that "[a] decision as to the exact level of error which is necessary for reversal . . . must await a case where resolution is necessary."[27] However, a case in which the Federal Circuit had to decide the issue of which law to apply to a non-patent-related procedural issue arose later that same year.

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[22] *Litton*, 728 F.2d at 1445 (citing SquirtCo v. Seven-Up Co., 628 F.2d 1086, 1091 (8th Cir. 1980)).

[23] *Id.* (citing Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1569 (Fed. Cir. 1983)).

[24] *Id.*

[25] *Id.* The court also noted that neither of the parties "appear[ed] to have recognized the problem . . . , for neither party . . . raised the issue." *Id.*

[26] *Id.*

[27] *Id.*

B. *PANDUIT*: GENESIS OF CHOICE-OF-LAW RULES FOR PROCEDURAL MATTERS

The Federal Circuit had its first opportunity to articulate a choice-of-law standard for procedural matters not relating to patent law in *Panduit Corp. v. All States Plastic Manufacturing Co.*[28] At issue in *Panduit* was a district court's grant of a motion to disqualify counsel.[29] Before reviewing the district court's decision, the Federal Circuit first decided whether it would apply its own law to the issue or the law of the regional circuit.[30] The court held that it would apply the law of the regional circuit to procedural matters[31] "that are not unique to patent issues."[32] In doing so, the court relied on the policy of "minimizing confusion and conflicts in the federal judicial system."[33]

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[28] 744 F.2d 1564 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985); *see* Schaffner, *supra* note 3, at 1182 ("The Federal Circuit first addressed the choice of law issue in depth in Panduit Corp. v. Allstates [sic] Plastic Manufacturing Co.").

[29] *Id.* at 1571. The court also considered as a threshold issue whether the court had jurisdiction to review the district court's decision motion to disqualify counsel. *Id.* The court held that it did have jurisdiction and relied on precedent of the Court of Customs and Patent Appeals that the grant of such a motion "is an immediately appealable decision." *Id.* at 1572. However, a year later, the U.S. Supreme Court reached the opposite conclusion and held that "orders disqualifying counsel in civil cases, as a class, are not sufficiently separable from the merits to qualify for interlocutory appeal." Richardson-Merrell, Inc. v. Koller, 472 U.S. 424, 440 (1985).

[30] *See Panduit*, 744 F.2d at 1572-76.

[31] The court defined "procedure" as "the judicial process for enforcing rights and duties recognized by substantive law and for justly administering remedy and redress for disregard or infraction of them." *Id.* at 1574 n.12 (quoting Sibbach v. Wilson & Co., 312 U.S. 1, 14 (1941)).

[32] *Id.* at 1574-75.

[33] *Id.* at 1574.

In recognizing the existence of the choice-of-law problem, the court noted that its "jurisdictional grant . . . places practitioners and district courts in a unique posture: they are accountable to two different courts of appeals."[34] The court further noted that district courts must apply Federal Circuit law to substantive patent matters but apply regional-circuit law to non-patent-related substantive matters.[35] Moreover, the court recognized that these requirements

> create[] a problem that was possibly unforeseen by Congress. That problem is which law must a district court apply in matters that are procedural in nature such as the attorney disqualification question in the instant case. In a case where this court does not have appellate jurisdiction, the district court would be deciding that question in light of the law of its regional circuit court. Since we have jurisdiction to review all matters in a case that is appealable to us, the district court would then be obligated to decide that question in light of our precedents.[36]

The court emphasized that "[s]uch bifurcated decisionmaking is not only contrary to the spirit of [the court's] enabling legislation but also the goal of the federal judicial system to minimize confusion and conflicts."[37]

The court began by considering the legislative history of the court's enabling statute.[38] The court pointed out that one of its chief objectives "is to bring about uniformity in the area of patent law."[39] The court reasoned that "[t]he fundamental

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[34] *Id.* at 1573.

[35] *Id.*

[36] *Id.*

[37] *Id.*

[38] *Id.* at 1574.

[39] *Id.*

underpinning for uniformity was Congress' abhorrence of conflicts and confusion in the judicial system . . . , and it must remain the spirit and guiding principle of this court."[40] The court concluded that because its "mandate is to eliminate conflicts and uncertainties in the area of patent law, [it] must not, in doing so, create unnecessary conflicts and confusion in procedural matters."[41]

The court next considered this same policy of minimizing conflicts and confusion as a general goal of the judicial system apart from the court's enabling statute.[42] The court reasoned that to reduce conflicts and confusion, attorneys and district court judges should not have to follow two sets of law on procedural questions having nothing to do with patent-law uniformity depending upon whether the case was a patent case to be appealed to the Federal Circuit or a non-patent case to be appealed to the local regional circuit.[43] The court further reasoned that

> [a]lthough the adoption of this policy could on occasion require this court to reach disparate results in procedural matters in light of disparate viewpoints from the regional circuit courts, it is nonetheless preferable for the twelve judges of this court to handle such conflicts rather than for countless practitioners and hundreds of district judges to do so. The task of deciding issues in light of different laws is no worse than the existing duty of federal judges to decide diversity cases or pendent state matters in view of state law.[44]

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[40] *Id.*

[41] *Id.* at 1575.

[42] *Id.* at 1574.

[43] *Id.*

[44] *Id.* at 1575.

Thus, the court concluded that "as a matter of policy, . . . the Federal Circuit shall review procedural matters[] that are not unique to patent issues[] under the law of the particular regional circuit court where appeals from the district court would normally lie."[45] The court observed that it would follow regional-circuit precedent on issues where such precedent exists.[46] However, the court noted that where such regional-circuit precedent does not exist concerning a particular issue, the court must "predict how that regional circuit would have decided the issue in light of the decisions of that circuit's various district courts, public policy, etc."[47] Moreover, the court observed that "[t]he exact parameters of [the court's choice-of-law] ruling [concerning procedural matters] will not be clear until such procedural matters are presented to [the] court for resolution."[48] Ultimately, in *Panduit*, the court applied the law of the regional circuit in reviewing the district court's order granting the motion to disqualify counsel.[49]

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[45] *Id.* at 1574-75 (footnote omitted). Additionally, the court noted that it would apply only its own precedent in cases where the Federal Circuit "has exclusive jurisdiction over all appeals from a particular court," such as the Court of International Trade and the Claims Court. *Id.* at 1575 (emphasis omitted).

[46] *Id.*

[47] *Id.*

[48] *Id.*

[49] *Id.* at 1576.

II. THE FEDERAL CIRCUIT HAS ARTICULATED AND APPLIED ITS CHOICE-OF-LAW RULES INCONSISTENTLY AND IMPROPERLY

After the Federal Circuit first announced its choice-of-law rules in *Panduit*, the court began to follow an inconsistent and "meandering path" in articulating these rules.[50] Indeed, the court itself noted that these rules have "been variously and inconstantly phrased."[51] The court observed that between 1984 and 1990, it had articulated its choice-of-law rules in at least nine different ways,

> ask[ing], respectively, whether the procedural issue: (1) "is one 'over which this court does not have exclusive appellate jurisdiction'"; (2) "concerns a 'subject which is not unique to patent law'"; (3) "is 'not specific to our statutory jurisdiction'"; (4) "may be 'related' to 'substantive matters unique to the Federal Circuit'"; (5) "'will come on appeal to this court [in most cases involving the issue]' thereby putting us in a 'good position to create a uniform body of federal law' on the issue"; (6) is one for which "there is existing and expressed uniformity among the circuits," in which case "we have generally conformed our law to that of the regional circuits, without regard to the

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[50] McEldowney, *supra* note 17, at 1665; *see also* Kenneth R. Adamo et al., *Survey of the Federal Circuit's Patent Law Decisions in 2000: Y2K in Review*, 50 AM. U. L. REV. 1435, 1486 (2001) ("The line between procedural issues that pertain to patent law and those that do not can . . . be very difficult to discern."); Dreyfuss, *supra* note 1, at 40 ("The indeterminacy of the CAFC's line drawing has led different panels to reach inconsistent conclusions on whether regional law or Federal Circuit law applies to given procedural issues."); Schaffner, *supra* note 3, at 1181 ("[T]he Federal Circuit still has failed to articulate a consistent [choice-of-law] doctrine."); Thompson, *supra* note 2, at 582 (describing the Federal Circuit's choice-of-law rule as "by no means a bright-line rule capable of easy reference); McEldowney, *supra* note 17, at 1645 ("[T]he Federal Circuit's choice-of-law doctrine remains elusive and ever-changing."); Miller, *supra* note 2, at 330 ("[T]he Federal Circuit is not currently living up to its goal of minimizing confusion and conflicts in the federal judicial system and has created increased uncertainty in its choice of law rules."); *cf.* Gholz, *supra* note 8, at 315 (predicting in 1985 that "categorizing all procedural issues one way or the other is going to require metaphysical decisions of exceptional delicacy").

[51] Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 856 (Fed. Cir 1991); *see* Schaffner, *supra* note 3, at 1186 (citing *Biodex*, 946 F.2d at 856); McEldowney, *supra* note 17, at 1666; Miller, *supra* note 2, at 301.

> relationship of the issue to our exclusive jurisdiction"; (7) "involves an interpretation of the Federal Rules of Civil Procedure or the local rules of the district court"; (8) "'involv[es] substantive matters unique to the Federal Circuit," in which case "we apply to related procedural issues the law of this circuit"; and finally, (9) goes " to our own appellate jurisdiction."[52]

In 1999, in *Midwest Industries, Inc. v. Karavan Trailers, Inc.*,[53] the Federal Circuit summarized its current choice-of-law rules for procedural issues in patent cases.[54] The court stated that it applies Federal Circuit law to a procedural issue if the issue (1) "pertain[s] to patent law,"[55] (2) "bears an essential relationship to matters committed to our exclusive control by statute,"[56] or (3) "clearly implicates the jurisprudential responsibilities of this court in a field within its exclusive jurisdiction."[57]

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[52] McEldowney, *supra* note 17, at 1665 (footnotes omitted; all alterations except the first in original) (quoting *Biodex*, 946 F.2d at 855-57).

[53] 175 F.3d 1356 (Fed. Cir. 1999) (en banc in relevant part).

[54] *Id.* at 1359.

[55] *Id.* at 1359 (citing Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574-75 (Fed. Cir. 1984)).

[56] *Id.* (citing Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 858-59 (Fed. Cir. 1991)).

[57] *Id.* (citing Gardco Mfg., Inc. v. Herst Lighting Co., 820 F.2d 1209, 1212 (Fed. Cir. 1987)). In *Midwest Industries*, the court considered whether to apply its own law or that of the regional circuit to a substantive issue—"whether principles of patent law foreclose . . . claims under section 43(a) of the Lanham Act and under Iowa state trademark law"—rather than a procedural issue. *Id.* at 1361. The court overruled its own precedent on this issue and concluded that it should apply Federal Circuit law. *Id.* The court discussed its choice-of-law rules for procedural matters to support the proposition that the court has "applied [its] law beyond the limits of substantive patent law and into areas in which the disposition of nonpatent-law issues is affected by the special circumstances of the patent law setting in which those issues arise." *Id.* at 1359-60.

Although this articulation of the choice-of-law rule may seem on the surface relatively straightforward,[58] a fundamental problem exists with this test: the Federal Circuit can apply whichever law that it wants to any issue depending upon whether it defines the issue broadly or narrowly.[59] Where the court narrowly defines an issue as a patent-related issue, the issue necessarily is sufficiently related to substantive patent law such that Federal Circuit law applies.[60] Conversely, where the court broadly defines the same issue, the issue necessarily is not sufficiently related to substantive patent law, so the court applies regional-circuit law.[61] For example, in *In re Spalding Sports Worldwide, Inc.*,[62] the court defined the issue as "whether the invention record [was] protected by attorney-client privilege" and reasoned that an "invention record relates to an invention submitted for consideration for possible patent protection" and thus "clearly implicates substantive patent law."[63] In contrast, in a similar factual situation in *Fort James Corp. v. Solo Cup Co.*,[64] the court defined the issue broadly as a "question[] of attorney-client privilege and waiver of attorney-client privilege" and thus applied

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[58] *See* Kimberly A. Moore, *Juries, Patent Cases, & Lack of Transparency*, 39 HOUS. L. REV. 779, 800 (2002).

[59] *See* McEldowney, *supra* note 17, at 1666 (contending, for example, that defining an issue narrowly as "[r]eview of a jury verdict on the question of patent validity" results in the application of Federal Circuit law, whereas defining the same issue broadly as "review of a jury verdict" would likely result in the application of regional-circuit law (emphasis removed)).

[60] *See id.*

[61] *See id.*

[62] 203 F.3d 800 (Fed. Cir. 2000).

[63] *Id.* at 804; *see infra* Part II.C (discussing *Spalding* and the court's approach to attorney-client privilege issues).

[64] 412 F.3d 1340 (Fed. Cir. 2005).

regional-circuit law.[65] Thus, how the court defines the issue can affect which law it applies.

Importantly, regardless of how the Federal Circuit has articulated its choice-of-law rules, the court's application of these rules has been inconsistent.[66] These inconsistent applications include both intra- and inter-issue inconsistencies. Indeed, the court has applied its choice-of-law rules inconsistently within particular procedural issues (i.e., intra-issue inconsistencies), as well as inconsistently between different procedural issues that the court should seemingly treat the same (i.e., inter-issue inconsistencies). In many cases, the court simply ignores the choice-of-law issue altogether.[67] Even in certain areas where the court consistently applies its own law, the court should arguably be applying regional-circuit law under the court's current choice-of-law rules.

The remainder of this Part provides examples of areas where the Federal Circuit has inconsistently applied its existing choice-of-law rules. First, Part II.A discusses intra- and inter-issue inconsistencies in the court's choice-of-law approach to cases[68] involving case-dispositive motions, including motions to dismiss, motions for summary judgment,

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[65] *Id.* at 1346; *see infra* Part II.C (discussing *Fort James* and the court's approach to attorney-client privilege issues).

[66] *See* Moore, *supra* note 58, at 800; McEldowney, *supra* note 17, at 1669; Miller, *supra* note 2, at 301.

[67] *See* McEldowney, *supra* note 17, at 1645.

[68] This article focuses solely on patent cases appealed to the Federal Circuit from district courts. This article does not consider patent cases appealed from other tribunals such as the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office or the Court of International Trade because the Federal Circuit always applies its own law when reviewing the decisions of these tribunals. *See* Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

and motions for judgment as a matter of law ("JMOL"). Second, Part II.B considers choice-of-law inconsistencies relating to the waiver of post-verdict JMOL motions. Third, Part II.C concerns inconsistencies in the court's approach to choice of law relating to attorney-client privilege. Fourth and finally, Part II.D discusses issues to which the Federal Circuit consistently applies its own law but arguably should apply regional-circuit law under its existing choice-of-law rules.

A. CASE-DISPOSITIVE MOTIONS

The Federal Circuit's approach to choice of law for case-dispositive motions has been inconsistent both within particular types of motions and between different types of motions. First, Part II.A.1 discusses intra-issue inconsistencies in the court's approach to motions to dismiss for failure to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6). Second, Part II.A.2 considers intra-issue inconsistencies in the court's approach to motions for summary judgment. Third, Part II.A.3 discusses intra-issue inconsistencies in the court's approach to post-trial motions for judgment as a matter of law. Fourth and finally, Part II.A.4 analyzes the court's inter-issue inconsistencies in its approach to Rule 12(b)(6) motions to dismiss, JMOL motions, and summary-judgment motions.

1. Motions to Dismiss Under Federal Rule of Civil Procedure 12(b)(6)

In the majority of cases, the Federal Circuit applies the law of the regional circuit in patent cases involving a motion to dismiss for failure to state a claim under Rule 12(b)(6) of the Federal Rules of Civil Procedure.[69] Indeed, the Federal Circuit has

[69] FED. R. CIV. P. 12(b)(6).

applied regional-circuit law in 63% of the cases examined.[70] However, the Federal Circuit applied its own law in 37% of these cases.[71]

Illustrative of a case in which the Federal Circuit applied regional-circuit law in reviewing a Rule 12(b)(6) motion to dismiss is *McZeal v. Sprint Nextel Corp.*[72] In *McZeal*, the Federal Circuit first noted that "[a] motion to dismiss for failure to state a claim upon which relief can be granted is a purely procedural question not pertaining to patent law."[73] The court then stated that "on review [it would] apply the law of the regional circuit."[74] The court next went on to state the standard of decision for a Rule 12(b)(6) motion, citing Fifth Circuit precedent for support.[75] This approach seems proper under the Federal Circuit's existing choice-of-law rules. Indeed, a motion to dismiss is purely a procedural motion, and the Federal Circuit has no reason under its existing choice-of-law rules to apply its own precedent for this issue.

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[70] Out of thirty Rule 12(b)(6) cases examined, the Federal Circuit applied regional-circuit law in nineteen of those cases. To locate these cases, we performed the following search in the Westlaw Federal Circuit database: <"12(b)(6)" /p review>. This search yielded forty-eight hits. We eliminated cases that did not pertain to patent law. We also eliminated cases on appeal from courts other than district courts, such as the Court of Claims and the Court of International Trade, because the Federal Circuit always applies its own law when reviewing the decisions of these courts. *See Panduit*, 744 F.2d at 1575.

[71] Out of the thirty cases examined, the Federal Circuit applied its own law in eleven of those cases. *See supra* note 70 (discussing research methodology).

[72] 501 F.3d 1354 (Fed. Cir. 2007).

[73] *Id.* at 1355-56.

[74] *Id.* at 1356.

[75] *Id.* (citing United States v. Humana Health Plan of Texas, Inc., 336 F.3d 375, 379 (5th Cir. 2003); Copeland v. Wasserstein, Perella & Co., 278 F.3d 472, 477 (5th Cir. 2002); Taylor v. Books A Million, Inc., 296 F.3d 376, 378 (5th Cir. 2002)).

Nevertheless, the Federal Circuit often applies its own law in Rule 12(b)(6) cases. Interestingly, in all the cases examined in which the Federal Circuit applied its own law, the court ignored the choice-of-law issue altogether.[76] For example, in *Xechem International, Inc. v. University of Texas M.D. Anderson Cancer Center*,[77] the court cited two Federal Circuit cases in support of the court's statement of the standard of review for a Rule 12(b)(6) motion.[78] Moreover, one of these cases indirectly relied on a Federal Circuit case that cited Sixth Circuit law.[79] But in *Xechem*, the trial took place in the Fifth Circuit,[80] not the Sixth Circuit. Thus, when the court in *Xechem* relied on a case that indirectly relied on Sixth Circuit law, the court introduced yet another inconsistency over and above ignoring its existing choice-of-law rules, under which it should have applied the law of the Fifth Circuit to the issue.

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[76] *See, e.g.*, Xechem Int'l, Inc. v. Univ. of Texas M.D. Anderson Cancer Ctr., 382 F.3d 1324, 1326-27 (Fed. Cir. 2004); Univ. of W. Virginia Board of Trustees v. Vanvoorhies, 278 F.3d 1288, 1326-27 (Fed. Cir. 2002).

[77] 382 F.3d 1324 (Fed. Cir. 2004).

[78] *Id.* at 1326 (citing Boyle v. United States, 200 F.3d 1369, 1371 (Fed. Cir. 2000); Young v. AGB Corp., 152 F.3d 1377, 1379 (Fed. Cir. 1998)).

[79] *Xechem* cites *Young v. AGB Corp.*, 152 F.3d 1377, 1379 (Fed. Cir. 1998). *Young*, in turn, cites *Abbott Laboratories v. Brennan*, 952 F.2d 1346, 1353 (Fed. Cir. 1991), and *Abbott* cites a Sixth Circuit case, *Howard v. Chesapeake & Ohio Ry. Co.*, 812 F.2d 282, 287 (6th Cir. 1987).

Moreover, in *Young*, the court reviewed the dismissal of a claim under Rule 12(b)(6) by the Trademark Trial and Appeal Board ("TTAB"). *Id.* However, *Xechem*, the case that cited *Young*, was a patent case before a district court, not a trademark case before the TTAB. *Xechem*, 382 F.3d at 1326. Thus, the *Xechem* court should have chosen a patent-related case before a district court instead of *Young*.

[80] The trial took place in the Southern District of Texas, *Xechem*, 382 F.3d at 1326, which is in the Fifth Circuit, 28 U.S.C. § 41 (2000).

Importantly, the Rule 12(b)(6) cases in which the Federal Circuit applies its own law cannot be reconciled with its existing choice-of-law rules. These cases are not cases where the issue "pertain[s] to patent law," "bears an essential relationship to matters committed to [the Federal Circuit's] exclusive control by statute," or "clearly implicates the jurisprudential responsibilities of [the Federal Circuit] in a field within its exclusive jurisdiction."[81] Instead, in these cases, the Federal Circuit simply fails to consider the choice-of-law issue. If the court were consistent in following its existing choice-of-law rules, it would always apply regional circuit law in cases involving the review of a motion to dismiss under Rule 12(b)(6).

2. *Motions for Summary Judgment*

In the great majority of cases, the Federal Circuit applies its own law when reviewing a grant or denial of summary judgment motions relating to patent law. Indeed, the Federal Circuit has applied its own law in 92% of the summary judgment cases

[81] Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359-60 (Fed. Cir. 1999) (en banc in relevant part).

examined.[82] In the vast majority of these cases, the court seemingly ignores the choice-of-law issue.[83]

However, inconsistency nonetheless exists in that the Federal Circuit applied regional-circuit law in 8% of these cases.[84] Indeed, a line of cases exists in which the court expressly states that regional-circuit law applies to the review of a grant or denial of summary judgment.[85] To support this proposition, all these cases directly or indirectly rely on *Chamberlain Group, Inc. v. Skylink Technologies, Inc.*[86] Such reliance is misplaced, however. In *Chamberlain*, the Federal Circuit reviewed the grant of a

[82] Out of 186 summary judgment cases examined, the Federal Circuit applied its own law in 172 of those cases. To locate these cases, we performed the following search in the Westlaw Federal Circuit database: <"summary judgment" /s review>, restricted to cases decided in 2004 or later. This search yielded 1,541 hits. We eliminated cases that did not pertain to patent law. We also eliminated cases on appeal from courts other than district courts, such as the Court of Claims and the Court of International Trade, because the Federal Circuit always applies its own law when reviewing the decisions of these courts. *See* Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

[83] For example, a typical case in which the Federal Circuit ignored the choice-of-law issue and applied its own law was *Intamin Ltd. V. Magnetar Technologies, Corp.*, 483 F.3d 1328 (Fed. Cir. 2007). In *Intamin*, as in most all summary judgment cases, the Federal Circuit merely cites its own precedent with respect to the summary judgment standard and summary judgment issues and ignores the possibility that regional-circuit law may apply. *Id.* at 1333 (citing Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1315 (Fed. Cir. 1998)).

[84] Out of 186 summary judgment cases since 2004, the Federal Circuit applied regional-circuit law in 14 of those cases. *See supra* note 82 (discussing research methodology).

[85] *See, e.g.*, Planet Bingo, LLC v. Game Tech. Int'l, Inc., 472 F.3d 1338, 1341 (Fed. Cir. 2006); MicroStrategy Inc. v. Business Objects, S.A., 429 F.3d 1344, 1349 (Fed. Cir. 2005); Broadcast Innovation, L.L.C. v. Charter Communications, Inc., 420 F.3d 1364, 1366 (Fed. Cir. 2005).

[86] 381 F.3d 1178 (Fed. Cir. 2004).

summary judgment on copyright claims only.[87] Thus, subsequent patent cases involving summary judgment should not have relied on this case in which summary judgment on solely a non-patent matter was at issue. In addition to this line of cases relying on *Chamberlain*, several other cases exist where the Federal Circuit applied regional-circuit law without explicitly stating a rule but instead merely citing regional-circuit law.[88] No justification exists, and the Federal Circuit offers none, for why the court reviews a small but significant number of summary judgment patent cases under the law of the regional circuit while reviewing all others under its own law.

3. Post-Trial Motions for Judgment as a Matter of Law

The Federal Circuit has been inconsistent in the law that it applies when reviewing grants or denials of post-trial motions for judgments as a matter of law ("JMOL"). The court by default applies the law of the regional circuit for the standards of decision and review associated with motions for JMOL in patent cases.[89] Indeed, the court applied regional-circuit law in 84% of the JMOL patent cases examined.[90] Illustrative of a case in which the Federal Circuit applied regional-circuit law in the

[87] *Id.* at 1181.

[88] *See, e.g.*, Cook Biotech, Inc. v. Acell, Inc., 460 F.3d 1365, 1372 (Fed. Cir. 2006) (citing FED. R. CIV. P. 56(c); Scaife v. Cook County, 446 F.3d 735, 739 (7th Cir. 2006)).

[89] *E.g.*, BBA Nonwovens Simpsonville, Inc. v. Superior Nonwovens, LLC, 303 F.3d 1332, 1336 (Fed. Cir. 2002).

[90] Out of 128 cases involving JMOL examined, the court applied regional-circuit law in 107 of those cases. To locate these cases, we performed the following search in the Westlaw Federal Circuit database: <JMOL "judgment as a matter of law">, restricted to cases decided after May 1999. We eliminated cases that did not pertain to patent law, and we also eliminated cases on appeal from courts other than district courts.

JMOL context is *PharmStem Theraputics, Inc. v. ViaCell, Inc*.[91] In *PharmStem*, the district court denied the accused infringer's motion for JMOL for anticipation, obviousness, and indefiniteness.[92] In reviewing the denial of this JMOL motion, the court applied the law of the Third Circuit to both the standard of review and the standard of decision.[93] Significantly, the court applied regional-circuit law even though the underlying issues were substantive patent issues.[94]

However, in a sizable number of cases, the Federal Circuit applies its own law to these same issues and ignores the choice-of-law issue altogether.[95] Indeed, the Federal Circuit applied its own law in 16% of the 128 JMOL cases examined.[96] Illustrative of these cases is *Cook Biotech Inc. v. Acell, Inc.*[97] In *Cook Biotech*, the district court denied the defendant's motion for JMOL of noninfringement.[98] In addressing the standard of review for JMOL, the court merely stated that it "review[s] the district court's denial of a

[91] 491 F.3d 1342 (Fed. Cir. 2007).

[92] *Id.* at 1359.

[93] *Id.*

[94] *See PharmStem*, 491 F.3d at 1359-60.

[95] *See, e.g.*, Pods, Inc. v. Porta Star, Inc., 484 F.3d 1359, 1366 (Fed. Cir. 2007); Acumed LLC v. Stryker, Corp., 483 F.3d 800, 804 (Fed. Cir. 2007); Cook Biotech Inc. v. Acell, Inc., 460 F.3d 1365, 1371 (Fed. Cir. 2006).

[96] Out of 128 cases involving JMOL decided by the Federal Circuit since May 1999, the court applied its own law in 21 of those cases. *See supra* note 90 (discussing research methodology).

[97] 460 F.3d 1365 (Fed. Cir. 2006).

[98] *Id.* at 1371.

motion for JMOL de novo," citing only a Federal Circuit case for support.[99] The court then quoted Federal Rule of Civil Procedure 50(a)(1) for the standard of decision for JMOL motions.[100] Significantly, nowhere did the court address the choice-of-law issue or reconcile the abundant precedent for applying regional-circuit law in reviewing a JMOL issue.[101]

4. *Inter-Issue Inconsistencies in the Federal Circuit's Approach to Rule 12(b)(6) Motions to Dismiss , JMOL Motions, and Summary-Judgment Motions*

In addition to the intra-issue inconsistencies in the Federal Circuit's approach to reviewing Rule 12(b)(6), summary judgment, and JMOL cases,[102] inter-issue inconsistencies also exist in the court's approach to these three types of cases. For Rule 12(b)(6) and JMOL motions, the default is for the court to apply regional-circuit law,[103] whereas for summary judgment motions, the court almost always applies its own law.[104]

Surprisingly, these inter-issue inconsistencies exist even though these three procedural devices are very similar. They are all potentially case dispositive. Moreover, the standards of decision and review for these three procedural devices are not issues that "pertain to patent law," "bear[] an essential relationship to matters committed to [the

[99] *Id.* (citing Rodime, PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1301 (Fed. Cir. 1999)).

[100] *Id.* (quoting FED. R. CIV. P. 50(a)(1)).

[101] *See id.*

[102] *See supra* Part II.A (discussing intra-issue inconsistencies in the Federal Circuit's approach to the choice-of-law issue for case-dispositive motions).

[103] *E.g.*, McZeal v. Sprint Nextel Corp., 501 F.3d 1354, 1355-56 (Fed. Cir. 2007).

[104] *See supra* note 82 and accompanying text.

Federal Circuit's] exclusive control by statute," or "clearly implicate[] the jurisprudential responsibilities of [the Federal Circuit] in a field within its exclusive jurisdiction."[105] Thus, under the Federal Circuit's existing choice-of-law rules, the court should treat all three of these motions the same and apply regional-circuit law.

Additionally, motions for JMOL and summary judgment are particularly similar, and no good reason exists why the Federal Circuit's choice-of-law approach should be so different between them. Indeed, the Supreme Court has recognized the similarity between post-verdict JMOL and summary judgment motions, observing that the summary judgment standard "mirrors the standard for [post-verdict JMOL motions] under Federal Rule of Civil Procedure 50(a), which is that the trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict."[106] Because of this similarity between motions for JMOL and summary judgment, the Federal Circuit should apply the same choice-of-law approach to both.

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[105] Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359-60 (Fed. Cir. 1999) (en banc in relevant part).

[106] Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1986). Indeed, the "genuine issue" standard for summary judgment "is very close to the "reasonable jury" standard for post-verdict JMOL. *Id.* at 251. The Court further noted that

> [t]he primary difference between the two motions is procedural; summary judgment motions are usually made before trial and decided on documentary evidence, while directed verdict motions are made at trial and decided on the evidence that has been admitted. In essence, though, the inquiry under each is the same: whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law.

Id. at 251-52 (citation and internal quotation marks omitted).

Indeed, no good reason exists for the Federal Circuit to treat the choice-of-law issue differently for Rule 12(b)(6), JMOL, or summary-judgment motions.

B. Waiver of Post-Verdict JMOL Motion

An additional example of an area in which the Federal Circuit has been inconsistent in its choice-of-law approach is in reviewing whether a party has waived the right to make a post-verdict JMOL motion on an issue by failing to sufficiently raise the issue in a pre-verdict JMOL.[107] The Federal Circuit's inconsistency in this area is even more pronounced than within the different case-dispositive motions.[108] Indeed, of twelve cases reviewing this issue since 1996, the court has applied its own law in 50% of these cases while applying regional-circuit law in 50% of these cases.[109] Surprisingly, the court applied its own law in 50% of the cases even though the purported default rule for review of this issue is to apply the law of the regional circuit.[110]

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[107] Under Rule 50 of the Federal Rules of Civil Procedure, to preserve a post-verdict JMOL motion, a party must first move for JMOL at the close of all evidence before the case is submitted to the jury. FED. R. CIV. P. 50(b); *see, e.g.*, Duro-Last, Inc. v. Custom Seal, Inc. 321 F.3d 1098, 1106 (Fed. Cir. 2003). If a party fails to sufficiently move for JMOL with respect to a particular issue, then that party waives its right to assert a post-verdict JMOL motion with respect to that issue. *Id.*

[108] *See supra* Part II.A (discussing inconsistencies in the Federal Circuit's approach to Rule 12(b)(6), summary-judgment, and post-verdict JMOL motions).

[109] Out of twelve cases examined involving JMOL waiver decided by the Federal Circuit, the court applied its own law in six of those cases and applied regional-circuit law in six of those cases. To locate these cases, we performed the following search in the Westlaw Federal Circuit database: <(JMOL "judgment as a matter of law") /p waive!>, restricted to cases decided in 1996 or later. We eliminated cases that did not pertain to patent law. We also eliminated cases on appeal from courts other than district courts.

[110] *E.g.*, Duro-Last, Inc. v. Custom Seal, Inc., 321 F.3d 1098, 1106 (Fed. Cir. 2003).

An example of a case in which the Federal Circuit applied regional-circuit law to the issue of JMOL waiver is *Zodiac Pool Care, Inc. v. Hoffinger Industries, Inc.*[111] In *Zodiac Pool*, the district court "rejected [the patentee's] argument that [the accused infringer] waived its right to JMOL on the issue of [doctrine-of-equivalents] infringement by not renewing its motion at the close of trial."[112] The court applied Eleventh Circuit law to this issue, stating: "We must respect the precedent of the Eleventh Circuit on this issue, because this court defers to the law of the regional circuits on matters of procedural law."[113] The court then described the Eleventh Circuit's approach to the JMOL waiver argument: "The Eleventh Circuit has taken a liberal view of what constitutes a motion for a directed verdict."[114] Under this standard, the court then concluded that the accused infringer had sufficiently raised the issue of infringement under the doctrine of equivalents in its post-verdict motion for JMOL.[115] Thus, the Federal Circuit affirmed the district court's decision on this issue.[116]

On the other hand, the Federal Circuit applied its own law to a JMOL-waiver issue in *Duro-Last, Inc. v. Custom Seal, Inc.*[117] In *Duro-Last*, the accused infringer argued that the patentee "waived its right to file a post-verdict JMOL motion on

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[111] 206 F.3d 1408 (Fed. Cir. 2000).

[112] *Id.* at 1416.

[113] *Id.*

[114] *Id.* (internal quotation marks omitted).

[115] *Id.*

[116] *Id.*

[117] 321 F.3d 1098 (Fed. Cir. 2003).

obviousness because its pre-verdict JMOL motion raised only the issues of inequitable conduct and the on-sale bar."[118] The Federal Circuit began by noting that the parties disagreed over whether Federal Circuit or regional-circuit law should apply to this issue.[119] The court then observed that by default, the court should apply regional-circuit law when reviewing the issue of JMOL waiver.[120] However, the court reasoned that the instant case should be an exception to this general rule.[121] In doing so, the court defined the issue narrowly: "This case . . . involves the specific question of whether a pre-verdict JMOL motion directed to inequitable conduct and the on-sale bar is sufficient to preserve the right to a post-verdict JMOL motion directed to obviousness."[122] Thus, the court concluded that it should apply its own law to the issue.[123] The court then held that the patentee's pre-verdict JMOL motion on inequitable conduct and the on-sale bar was not sufficient to preserve a post-trial JMOL motion on obviousness.[124]

Notably, in most of the cases in which the Federal Circuit applied its own law, the court ignored the choice-of-law issue altogether.[125] For example, a typical example

[118] *Id.* at 1106.

[119] *Id.*

[120] *Id.*

[121] *Id.*

[122] *Id.*

[123] *Id.*

[124] *Id.* at 1106-08.

[125] *See, e.g.*, Union Carbide Chems. v. Shell, 308 F.3d 1167, 1178 (Fed. Cir. 2002); Sw. Software, Inc. v. Harlequin, Inc., 226 F.3d 1280, 1289 (Fed. Cir. 2000).

occurred in *Southwest Software, Inc. v. Harlequin Inc.*[126] In *Southwest Software*, the court considered whether the accused infringers had properly preserved their right to a post-verdict JMOL motion.[127] Without even mentioning the choice-of-law question, the court merely recited that "[f]ailing to properly move for JMOL at the close of the evidence precludes a challenge to the sufficiency of the evidence underlying fact findings," citing a Federal Circuit case for support.[128] The court then went on to hold that the accused infringers waived their right to a post-verdict JMOL motion by not properly advancing a pre-verdict JMOL motion.[129] Interestingly, however, when later reviewing the denial of the patentee's motion for a new trial, the court did consider the choice-of-law issue and decided to apply regional-circuit law to that issue.[130] No apparent reason exists for why the court ignored the choice-of-law question for one issue and addressed it for the other issue.

The choice-of-law issue can be especially important for the issue of post-verdict JMOL waiver because different circuits have different standards for determining this issue. Indeed, some circuits apply a liberal standard, while other circuits apply a strict

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[126] 226 F.3d 1280 (Fed. Cir. 2000).

[127] *Id.* at 1290.

[128] *Id.* (citing Young Dental Mfg. Co. v. Q3 Special Prods., Inc., 112 F.3d 1137, 1141 (Fed. Cir. 1997)).

[129] *Id.*

[130] *Id.*

standard.[131] Thus, the choice-of-law decision in a case involving this issue could easily be outcome determinative.

Interestingly, a recent Supreme Court case involved the Federal Circuit's choice-of-law rules concerning an issue related to the waiver of a post-verdict JMOL motion. In *Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc.*,[132] the Court addressed the issue of whether a party has waived the right to challenge the sufficiency of the evidence where the party failed to file a post-verdict motion for JMOL, but where the party did file a JMOL motion under Rule 50(a) of the Federal Rules of Civil Procedure before the case was submitted to the jury.[133] Significantly, the Court noted that "in the instant case [the Federal Circuit] was bound to apply the law of the Tenth Circuit"[134] rather than the law of the Federal Circuit. Under Federal Circuit law, "failure to present the district court with a post-verdict motion precludes appellate review of sufficiency of the evidence."[135] In contrast, under Tenth Circuit law, a party could challenge the sufficiency of the evidence on appeal without filing a post-verdict motion for JMOL "as long as that party filed a

[131] *Compare, e.g.*, Logan v. Burgers Ozark County Cured Hams Inc., 263 F.3d 447, 457 (5th Cir. 2001) ("Instead of insisting that parties strictly comply with this procedural requisite, we approach[ ] this requirement with a liberal spirit." (internal quotation marks omitted; alteration in original)), *with* Farley Transportation Co. v. Santa Fe Trail Transportation Co., 786 F.2d 1342, 1346 (9th Cir. 1985) ("A strict application of Rule 50(b) obviates the necessity for a court to engage in a difficult and subjective case-by-case determination of whether a failure to renew a motion for directed verdict at the close of all the evidence has resulted in such prejudice to the opposing party under the particular circumstances of that case.").

[132] 546 U.S. 394 (2006).

[133] *Id.* at 398-99.

[134] *Id.*

[135] *Id.* at 398.

Rule 50(a) motion prior to submission of the case to the jury."[136] The Supreme Court reversed the Tenth Circuit's rule as applied by the Federal Circuit.[137] This case seems to be the only time that "the Supreme Court has indirectly considered a regional circuit's rule of law through the Federal Circuit's application of that rule under choice of law principles."[138]

C. ATTORNEY-CLIENT PRIVILEGE

In the area of attorney-client privilege, the Federal Circuit has been relatively consistent in applying its existing choice-of-law rules in patent cases. But even so, inconsistencies nonetheless have arisen.

Although the Federal Circuit sometimes applies regional-circuit law and sometimes applies Federal Circuit law to attorney-client-privilege issues in patent cases, the court has consistently followed its own choice-of-law rules for the most part.[139] For the issue of attorney-client privilege,[140] the Federal Circuit applies regional-circuit law by

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[136] *Id.* at 399.

[137] *Id.*

[138] Miller, *supra* note 2, at 319.

[139] *But cf.* Rhodia Chimie v. PPG Indus., Inc., No. 01-389-KAJ, slip op. at 5 n.4 (D. Del. Oct. 8, 2003) ("There is some question of whether the scope of waiver effected by reliance on an advice-of-counsel defense is a matter to be governed by Federal Circuit or regional circuit case law."). In *Rhodia*, the district court concluded that "[t]he better reasoned approach recognizes that questions of waiver are not unique to patent law and are a matter of either state law, as to claims and defenses that arise under state law, or precedent from the regional circuits." *Id.*

[140] This issue includes the applicability of the attorney-client privilege, the waiver of privilege, and the scope of such a waiver.

default.[141] The court applied regional-circuit law in 64% of the patent cases examined involving attorney-client privilege,[142] whereas it applied Federal Circuit law in only 27% of these cases.[143] However, for the most part, the court seems to consistently follow its choice-of-law rules in choosing whether to apply regional-circuit or Federal Circuit law. Indeed, where the privilege issue truly does not involve substantive patent law, the court normally applies regional-circuit law.[144] Conversely, where the privilege issue does involve substantive patent law, the court applies its own law,[145] as it should under its existing choice-of-law rules.

For example, the Federal Circuit properly applied regional-circuit law according to its current choice-of-law rules in *GFI, Inc. v. Franklin Corp.*[146] and *In re Pioneer Hi-Bred International, Inc.*[147] In both of these cases, the privilege issue had nothing to do

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[141] *E.g.*, Fort James Corp. v. Solo Cup Co., 412 F.3d 1340, 1346 (Fed. Cir. 2005).

[142] Out of eleven patent cases involving attorney-client privilege decided by the Federal Circuit since January 2000, the court applied regional-circuit law in seven of those cases. To locate these cases, we performed the following search in the Westlaw Federal Circuit database: <privilege! & patent!>, restricted to cases decided since January 2000. We then eliminated cases that did not involve patents, cases that involved other types of privilege besides attorney-client privilege, and results that were otherwise spurious.

[143] Out of eleven patent cases involving attorney-client privilege decided by the Federal Circuit since January 2000, the court applied its own law in three of those cases. *See supra* note 142 (discussing research methodology).

[144] *E.g.*, GFI, Inc. v. Franklin Corp., 265 F.3d 1268, 1272 (Fed. Cir. 2001).

[145] *See In re* Seagate Tech., LLC, 497 F.3d 1360, 1367-68 (Fed. Cir. 2007) (en banc); *In re* EchoStar Commc'ns Corp., 448 F.3d 1294, 1298 (Fed. Cir. 2006); *In re* Spalding Sports Worldwide, Inc., 203 F.3d 800, 803-04 (Fed. Cir. 2000).

[146] 265 F.3d 1268.

[147] 238 F.3d 1370.

with substantive patent law. Thus, in both of these cases, the Federal Circuit decided to apply regional-circuit law.[148]

Conversely, an example of a patent case in which the Federal Circuit applied its own law involving attorney-client privilege is *In re Spalding Sports Worldwide, Inc.*.[149] In *Spalding*, the accused infringer charged the patentee with inequitable conduct in procuring the patent-in-suit.[150] The accused infringer sought to compel the disclosure of the invention record for the patented invention.[151] The court characterized "invention records" as follows:

> Invention records are standard forms generally used by corporations as a means for inventors to disclose to the corporation's patent attorneys that an invention has been made and to initiate patent action. They are usually short documents containing space for such information as names of inventors, description and scope of invention, closest prior art, first date of conception and disclosure to others, dates of publication, etc.[152]

The district court ordered the patentee to disclose the invention record, and the patentee sought a writ of mandamus from the Federal Circuit to prevent disclosure of the invention record on the grounds that it was protected by attorney-client privilege.[153]

The Federal Circuit decided to apply its own law to the issue of "whether the invention record [was] protected by attorney-client privilege."[154] The court reasoned that

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[148] *GFI*, 265 F.3d at 1272; *Pioneer Hi-Bred*, 238 F.3d at 1374 n.3.

[149] 203 F.3d 800 (Fed. Cir. 2000).

[150] *Id.* at 802.

[151] *Id.*

[152] *Id.* at 802 n.2.

[153] *Id.* at 803.

"a determination of the applicability of the attorney-client privilege to [the] invention record clearly implicate[d], at the very least, the substantive patent issue of inequitable conduct."[155] The court also noted that the issue was "unique to patent law because the invention record relates to an invention submitted for consideration for possible patent protection" and thus "clearly implicate[d] substantive patent law."[156] Thus, the court applied its own law.[157]

Although the Federal Circuit has been relatively consistent in applying its existing choice-of-law rules to attorney-client-privilege issues in patent cases, inconsistencies nonetheless have arisen. For example, in *Fort James Corp. v. Solo Cup Co.*,[158] the court applied regional-circuit law,[159] even though the situation was similar to that in *Spalding*, where the court applied its own law.[160] In *Fort James*, the accused infringer argued that the patent-in-suit was invalid for violation of the on-sale bar of 35 U.S.C. § 102(b).[161] Additionally, the accused infringer charged the patentee with inequitable conduct in procuring its patent for failing to disclose information relating to the on-sale bar.[162]

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[154] *Id.* at 804.

[155] *Id.* at 803-04.

[156] *Id.* at 804.

[157] *Id.*

[158] 412 F.3d 1340 (Fed. Cir. 2005).

[159] *Id*. at 1346.

[160] 203 F.3d at 803-04.

[161] 412 F.3d at 1343.

[162] *Id.*

The procedural issue in *Fort James* concerned whether an "invention disclosure statement" discussing the claimed invention remained protected by attorney-client privilege.[163] The issue arose when the accused infringer identified a document that the patentee had produced that referred to an underlying opinion of counsel.[164] The accused infringer requested this opinion, and the patentee produced it along with four other documents that it had previously withheld as privileged.[165] These documents included "additional opinions of counsel regarding the applicability of the on-sale bar . . . and correspondence with counsel indicating how the claimed invention was discovered and estimating when customers would have seen or used the product."[166] The accused infringer sought an additional document identified on the withheld-documents log as an "[i]nvention disclosure statement" authored by one of the inventors named on the patent-in-suit and sent to the patentee's in-house counsel.[167] The accused infringer contended that the patentee had waived attorney-client privilege by producing the opinion documents, and that the additional document fell within the scope of this waiver—"namely the conception and commercialization of the claimed invention."[168] In considering whether the additional document remained protected by the attorney-client

[163] *Id.* at 1349.

[164] *Id.* at 1343.

[165] *Id.*

[166] *Id.*

[167] *Id.* (alteration in original).

[168] *Id.*

privilege, the court applied the law of the regional circuit.[169] Without giving its reasoning, the court merely stated: "This court applies the law of the regional circuit, here the Seventh Circuit, with respect to questions of attorney-client privilege and waiver of attorney-client privilege."[170] The court went on to cite cases of the Seventh Circuit in analyzing the district court's "errors."[171]

The court's decision to apply regional-circuit law in *Fort James* seemingly clashes with its decision to apply Federal Circuit law in *Spalding*. The "invention disclosure statement" at issue in *Fort James*[172] seems very similar to the "invention record" at issue in *Spalding*.[173] The "invention disclosure statement" in *Fort James* was authored by one of the named inventors and sent to in-house counsel;[174] similarly, the "invention record" in *Spalding* "was submitted by the inventors of the [patent-in-suit] to [the patentee's] corporate legal department."[175] Additionally, the "invention disclosure statement" in *Fort James* was a "communication[] concerning the inventor's recognition and development of the invention,"[176] which described technical aspects of the claimed invention,[177] presumably to allow the patentee's in-house counsel to determine whether

[169] *See id.* at 1346, 1350.

[170] *Id.* at 1346.

[171] *See id.* at 1350.

[172] *Id.* at 1344.

[173] 203 F.3d at 802 & n.2.

[174] 412 F.3d at 1344.

[175] 203 F.3d at 805 (emphasis omitted).

[176] 412 F.3d at 1350-51 (characterizing the subject matter waived by the patentee).

[177] *Id.* at 1344.

the invention was patentable. Likewise, the "invention record" in *Spalding* revealed technical information about the invention[178] and "was prepared and submitted primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application."[179] Thus, the subject matter at issue in both these cases was essentially the same.

Moreover, just as in *Spalding*, the court in *Fort James* had to consider substantive patent law in deciding the privilege issue. In *Spalding*, the court applied its own law because the privilege issue "implicate[d] . . . the substantive patent issue of inequitable conduct,"[180] and because "the invention record relate[d] to an invention submitted for consideration for possible patent protection," which "clearly implicate[d] substantive patent law."[181] Likewise, in *Fort James*, the privilege issue required the court to delve into substantive issues regarding the on-sale-bar requirement of 35 U.S.C. § 102(b).[182] Moreover, inequitable conduct was at issue in *Fort James*,[183] just as it was in *Spalding*.[184] Despite the similarities between the factual and legal issues involved in *Fort James* with those in *Spalding*, the Federal Circuit applied regional-circuit law in *Fort James* and seemingly ignored the court's earlier decision in *Spalding*.

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[178] *See* 203 F.3d at 802 & n.2.

[179] *Id.* at 806.

[180] *Id.* at 803-04.

[181] *Id.* at 804.

[182] 412 F.3d at 1350-51.

[183] *Id.* at 1343.

[184] 203 F.3d at 802.

D. Issues to Which the Federal Circuit Consistently Applies Its Own Law but Arguably Should Apply Regional-Circuit Law Under Its Existing Choice-of-Law Rules

The Federal Circuit consistently applies its own law to several procedural issues when they arise in patent cases. However, even though these cases may be internally consistent, the Federal Circuit's decision to apply its own law to these issues is not necessarily consistent with the court's existing choice-of-law rules for procedural matters in patent cases. These issues where the Federal Circuit consistently applies its own law include (1) preliminary injunctions, (2) personal jurisdiction, (3) whether declaratory-judgment jurisdiction exists, (4) "whether particular materials are relevant for purposes of discovery in a patent case," and (5) "whether a patentee is entitled to have the issue of inequitable conduct tried in the jury trial that the patentee has demanded on the issue of infringement."[185] As examples of these types of issues where the Federal Circuit consistently applies its own law but arguably should apply regional-circuit law, Part II.D.1 below discusses preliminary injunctions, and Part II.D.2 discusses personal jurisdiction.

1. Preliminary Injunctions

One issue to which the Federal Circuit consistently applies its own law is whether a patentee is entitled to a preliminary injunction.[186] Early in the life of the Federal Circuit

[185] Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part).

[186] *Id.*

in *Hybritech Inc. v. Abbott Laboratories*,[187] the court decided to apply its own law in preliminary injunction cases.[188] The court reasoned:

> We note that confusion exists on the issue whether . . . Federal Circuit of regional circuit law provides the standards governing the issuance of an injunction pursuant to § 283. Because the issuance of an injunction pursuant to this section enjoins "the violation of any right secured by a [sic] patent, on such terms as the court deems reasonable," a preliminary injunction of this type, although a procedural matter, involves substantive matters unique to patent law and, therefore, is governed by the law of this court.[189]

Since *Hybritech*, the court only rarely has discussed the choice-of-law issue with respect to preliminary injunctions.[190] Instead, since *Hybritech*, the court has consistently applied its own law in patent cases without discussing the choice-of-law issue.[191]

Applying its own law, the Federal Circuit follows the "traditional four-part test" to determine whether a party is entitled to a preliminary injunction.[192] Under this test, the "the moving party must demonstrate [1] a reasonable likelihood of success on the merits, [2] irreparable harm in the absence of a preliminary injunction, [3] a balance of hardships

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[187] 849 F.2d 1446 (Fed. Cir. 1988).

[188] *Id.* at 1451 n.12.

[189] *Id.* (citing and quoting 35 U.S.C. § 283).

[190] *See* Mylan Pharm., Inc. v. Thompson, 268 F.3d 1323, 1329 (Fed. Cir. 2001) (discussing the choice-of-law issue); Mikohn Gaming Corp. v. Acres Gaming, Inc., 165 F.3d 891, 894 & n.3 (Fed. Cir. 1998) (same); Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc., 908 F.2d 951, 952-53 (Fed. Cir. 1990) (same).

[191] *E.g.*, E.I. du Pont de Nemours & Co. v. MacDermid Printing Solutions, L.L.C., 525 F.3d 1353, 1358 (Fed. Cir. 2008); Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., 357 F.3d 1319, 1324-25 (Fed. Cir. 2004); Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys., 132 F.3d 701, 704-05 (Fed. Cir. 1997).

[192] *See* Morton Denlow, *The Motion for a Preliminary Injunction: Time for a Uniform Federal Standard*, 22 REV. LITIG. 495, 515 (2003).

tipping in its favor, and [4] the injunction's favorable impact on the public interest."[193] Under the Federal Circuit's test, "[t]hese factors, taken individually, are not dispositive; rather, the district court must weigh and measure each factor against the other factors and against the form and magnitude of the relief requested."[194] However, to succeed, the movant must establish "both of the first two factors, i.e., likelihood of success on the merits and irreparable harm."[195]

Under the court's existing choice-of-law rules, although the Federal Circuit consistently applies its own law to the preliminary-injunction issue, the Federal Circuit could just as easily have decided to apply regional-circuit law to the issue. Indeed, the Federal Circuit acknowledges that a preliminary injunction is "a matter of procedural law not unique to the exclusive jurisdiction of the Federal Circuit."[196] Moreover, the *procedural* aspects of the preliminary-injunction determination do not involve "substantive matters unique to patent law."[197] Thus, under its existing choice-of-law rules, the Federal Circuit could have decided to apply regional-circuit law to the standard of decision for preliminary injunctions.

It is true that there are *substantive* aspects of the preliminary-injunction factors that are unique to patent law. However, because these aspects are actually applications of

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[193] *Nat'l Steel Car*, 357 F.3d at 1324-25.

[194] Amazon.com, Inc. v. Barnesandnoble.com, 239 F.3d 1343, 1350 (Fed. Cir 2001).

[195] *Id.* (emphasis omitted).

[196] Mikohn Gaming Corp. v. Acres Gaming, Inc., 165 F.3d 891, 894 (Fed. Cir. 1998).

[197] Hybritech Inc. v. Abbott Laboratories, 849 F.2d 1446, 1451 n.12 (Fed. Cir. 1988).

substantive law, the Federal Circuit could apply its own law to the substantive aspects while applying regional-circuit law to the procedural aspects of the preliminary-injunction determination. For example, the Federal Circuit could still apply its own law to the substantive issues involved in determining the movant's showing of likelihood of success on the merits.[198] But the remainder of the preliminary-injunction factors do not necessarily involve "substantive matters unique to patent law."[199] Determining irreparable harm,[200] the balance of hardships, and the public interest[201] may involve factual matters related to patent law, but they do not necessarily involve substantive

[198] Under Federal Circuit law, to establish a likelihood of success on the merits, the patentee must show that (1) the patentee will likely prove that the accused infringer infringes the claims at issue, and (2) the patentee "will likely withstand [the accused infringer's] challenges to the validity and enforceability of the . . . patent." *Amazon.com*, 239 F.3d at 1350.

[199] *Hybritech*, 849 F.2d at 1451 n.12.

[200] The irreparable-harm factor can involve substantive patent law. Under current Federal Circuit law, a special rule for patent cases exists: a presumption of irreparable harm arises where the patentee clearly shows a likelihood of success on the merits. *See Amazon.com*, 239 F.3d at 1350. The accused infringer can rebut this presumption by showings "such as a finding that future infringement is no longer likely, that the patentee is willing to forgo its right to exclude by licensing the patent, or that the patentee had delayed in bringing suit." Pfizer, Inc. v. Teva Pharms., USA, Inc., 429 F.3d 1364, 1381 (Fed. Cir. 2005). Even though the determination of irreparable harm may involve substantive patent law, under its existing choice-of-law rules, the court could nonetheless have decided to apply regional-circuit law to the irreparable-harm standard, in conjunction with applying Federal Circuit law to the substantive patent law issues involved, such as the rebuttable presumption of irreparable harm.

[201] Like irreparable harm, the determination of the injunction's effect on the public interest also may involve substantive issues of patent law. In deciding the public-interest factor, the Federal Circuit has held that it is in the public interest to enforce a valid patent. *See, e.g.*, Abbott Labs. v. Andrx Pharms., Inc., 452 F.3d 1331, 1348 (Fed. Cir. 2006). But even though the determination of the public-interest factor may involve substantive patent law, under the Federal Circuit's existing choice-of-law rules, the court could nonetheless have decided to apply regional-circuit law to the public-interest standard, in conjunction with applying Federal Circuit law to the substantive patent law issues involved.

patent law. As Professor Schaffner has suggested, "[a]lthough the factual setting may require the court to apply the legal standard to facts which may be unique to the patent context," the Federal Circuit should normally apply the regional-circuit legal standard to these facts.[202]

Importantly, the choice of whether to apply regional-circuit or Federal Circuit law in a motion for a preliminary injunction may be outcome determinative. Unlike some procedural issues for which the circuit courts of appeals apply uniform standards, the circuits do not apply a uniform standard for granting or denying a motion for preliminary injunction.[203] Most circuits use "some version of the traditional four-part test" to determine whether to grant a motion for preliminary injunction.[204] However, other circuits use "a two-part test that focuses on a balancing of the different factors."[205] One circuit even "uses a sliding-scale method" involving "a five-part test."[206] Even among the majority of circuits that use the traditional four-part test, the circuits apply this test

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[202] Schaffner, *supra* note 3, at 1203-04. However, Professor Schaffner nonetheless argues that the Federal Circuit should apply its own law to preliminary-injunction determinations because such determinations "affect the patent-related primary activities of the parties." *Id.* at 1204; *see also infra* Part III.C.1 (discussing Professor Schaffner's proposal for reforming the Federal Circuit's choice-of-law doctrine).

[203] Denlow, *supra* note 192, at 507.

[204] *Id.* at 515. The circuits that use "some version of the traditional four-part test" are the First, Third, Fourth, Fifth, Sixth, Eighth, Tenth, Eleventh, D.C. and Federal Circuits. *Id.*

[205] *Id.* These circuits that use the two-part test include the Second and Ninth Circuits. *Id.*

[206] *Id.* The Seventh Circuit uses the five-part test. *Id.*

differently.[207] For example, all circuits generally consider success on the merits as part of the test.[208] "However, [the circuits decide] this issue . . . in many different ways, ranging among a 'probability' of success, a 'likelihood' of success, a 'possibility' of success, 'raising a serious question' going to the merits, and a 'better than negligible' chance of success."[209] Thus, the requirements of a particular regional circuit's standard might be quite different than the requirements of the Federal Circuit's standard.[210] Therefore, the choice-of-law issue may be outcome determinative for motions for preliminary injunction.

2. *Personal Jurisdiction*

Another issue to which the Federal Circuit consistently applies its own law is whether personal jurisdiction comports with the constitutional requirements of due process.[211] The court first decided to apply its own law to this issue in *Beverly Hills Fan Co. v. Royal Sovereign Corp.*[212] in 1994. The personal-jurisdiction issue in *Beverly Hills*

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[207] *Id.* at 508; *see also* Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc., 908 F.2d 951, 952 (Fed. Cir. 1990) ("That courts generally agree on these four factors has not led to uniform agreement on how the factors are applied in a given case.").

[208] Denlow, *supra* note 192, at 516.

[209] *Id.*

[210] *See id.*

[211] Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part); *see also, e.g.*, Graphic Controls Corp. v. Utah Med. Prods., Inc., 149 F.3d 1382, 1385 (Fed. Cir. 1998). The Federal Circuit applies its own law only "[w]ith regard to the federal constitutional due process analysis of the defendant's contacts with the forum state in patent cases." *Graphic Controls*, 149 F.3d at 1385. However, the court applies state and regional-circuit law "in interpreting the meaning of state long-arm statutes." *Id.* at 1386.

[212] 21 F.3d 1558 (Fed. Cir. 1994).

Fan involved the stream-of-commerce theory.[213] The patentee argued that even though personal jurisdiction is a procedural issue not unique to patent law, the court should nonetheless apply its own law because the issue "is intimately related to substantive patent law."[214] The court agreed.[215] The court first recognized that it normally applied regional-circuit law "to procedural matters that are not unique to patent law."[216] But the court reasoned that "[a]lthough in one sense the due process issue in this case is procedural, it is a critical determinant of whether and in what forum a patentee can seek redress for infringement of its rights."[217] The court also justified applying its own law to the issue of personal jurisdiction by noting that there was a lack of uniformity in the application of the stream-of-commerce theory by other circuits, as well as within the Fourth Circuit.[218] Finally, the court concluded:

> The creation and application of a uniform body of Federal Circuit law in this area would clearly promote judicial efficiency, would be consistent with our mandate, and would not create undue conflict and confusion at the district court level. Under circumstances such as these, we have held we owe no special deference to regional circuit law.[219]

Thus, for these reasons, the Federal Circuit applied its own law to the issue of personal jurisdiction.

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[213] *Id.* at 1564.

[214] *Id.*

[215] *Id.*

[216] *Id.*

[217] *Id.*

[218] *Id.*

[219] *Id.* at 1564-65.

Although the Federal Circuit consistently applies its own law to the issue of personal jurisdiction, the court's decision under its existing choice-of-law rules to apply its own law is arguably incorrect.[220] Instead of applying its own law, the Federal Circuit should arguably apply regional-circuit law to this issue[221] under its existing choice-of-law rules for three reasons. First, the fact that personal jurisdiction is "a critical determinant of whether and in what forum a patentee can seek redress for infringement of its rights"[222] does not alone warrant the application of Federal Circuit law. Second, the lack of uniformity throughout the circuits should be irrelevant in the determination the court is supposed to make under its existing choice-of-law rules. Third and finally, the fact that there was no "apparent uniformity on the issue within the Fourth Circuit"[223] should also not have led the court to apply its own law.

First, the court never explains how the fact that personal jurisdiction in a patent case "is a critical determinant of whether and in what forum a patentee can seek redress for infringement of its rights"[224] warrants the application of Federal Circuit law. Indeed,

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[220] *See* Schaffner, *supra* note 3, at 1202; *cf.* McEldowney, *supra* note 17, at 1675 ("According to this [comment's] proposal, . . . personal jurisdiction . . . should be resolved under regional circuit precedent.").

[221] Even if the Federal Circuit were to apply the regional circuits' standards for personal jurisdiction and the regional circuits' interpretations of Supreme Court precedent, the Federal Circuit could nonetheless apply its own law to subissues involving substantive patent law. For example, the court could apply its own law to the issue of whether particular activity amounted to a sale or offer to sell under 35 U.S.C. § 271(a). As another example, the court could apply its own law in determining that "for the purposes of long-arm jurisdiction, the location of an infringing sale would qualify as the situs of injury in a patent suit." Schaffner, *supra* note 3, at 1203.

[222] *Beverly Hills Fan*, 21 F.3d at 1564.

[223] *Id.*

[224] *Id.*

personal jurisdiction in any type of case is always "a critical determinant of whether and in what forum a [plaintiff] can seek redress for"[225] whatever rights it seeks to vindicate. Thus, this determination is not unique to patent law.[226] Furthermore, the Federal Circuit could apply this logic and apply its own law to any issue it wanted. For example, the court could reason that a Rule 12(b)(6) motion to dismiss for failure to state a claim "is a critical determinant of whether . . . a patentee can seek redress for infringement of its rights"[227] and thus apply its own law to the issue. However, the court's default rule is to apply regional-circuit law to Rule 12(b)(6) motions to dismiss.[228] Thus, the court's reasoning in *Beverly Hills Fan* is inconsistent with its existing choice-of-law rules.

Second, the court's reasoning that the lack of uniformity throughout the circuits justifies the application of Federal Circuit law is irrelevant in the determination the court is supposed to make under its existing choice-of-law rules. Under these rules, the court is supposed to determine whether the issue is sufficiently tied to substantive patent law to justify applying Federal Circuit law instead of regional-circuit law.[229] The court's rules do not ask the court to take into account whether there is uniformity among the circuits. Indeed, where there is complete uniformity on an issue, the choice-of-law determination will not even matter because the Federal Circuit's law will necessarily be the same as that

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[225] *Id.*

[226] Schaffner, *supra* note 3, at 1202.

[227] *Beverly Hills Fan*, 21 F.3d at 1564.

[228] *E.g.*, McZeal v. Sprint Nextel Corp., 501 F.3d 1354, 1355-56 (Fed. Cir. 2007); *see also supra* Part II.A.1 (discussing the court's treatment of the choice-of-law issue for Rule 12(b)(6) motions).

[229] *See* Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc in relevant part).

of the pertinent regional circuit. Only where there is at least some lack of uniformity does it matter which circuit's law the court applies. Thus, again the court's reasoning does not fit with its existing choice-of-law rules.

Third and finally, the court incorrectly justified its decision to apply its own law to the personal-jurisdiction issue in *Beverly Hills Fan* by reasoning that there was no "apparent uniformity on the issue within the Fourth Circuit."[230] In a case where there is no uniformity within the relevant regional circuit, under the Federal Circuit's existing choice-of-law rules, the court must "predict how that regional circuit would have decided the issue in light of the decisions of that circuit's various district courts, public policy, etc."[231] The court is not supposed to throw up its hands and apply its own law. Indeed, as Professor Schaffner has observed:

> The court appears to suggest that the more confusion exists among the regional circuits on an issue, the more likely the Federal Circuit is to intercede and add its own interpretation to the existing confusion. However, it is unclear how the development of the stream of commerce theory implicates the patent laws or would benefit from the expertise of the Federal Circuit's independent treatment.[232]

Thus, once more the court's reasoning in *Beverly Hills Fan* does not fit with its existing choice-of-law rules.

The issue of personal jurisdiction is an issue where the choice between applying regional-circuit law and Federal Circuit law could make a difference. It is true that the

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[230] *Beverly Hills Fan*, 21 F.3d at 1564..

[231] Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574-75 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

[232] Schaffner, *supra* note 3, at 1202.

Supreme Court has provided binding rules to the courts of appeals concerning the basic contours of when personal jurisdiction comports with constitutional due-process requirements.[233] However, differences in the treatment of subissues may still exist. For example, in *Beverly Hills Fan*,[234] the Federal Circuit noted that although the stream-of-commerce theory was widely accepted by federal courts, "the theory comes in several variants[, and] the regional circuits have not reached a uniform approach to this jurisdictional issue."[235] Another example occurred in *Schwanger v. Munchkin, Inc.*[236] In *Schwanger*, the Federal Circuit reversed the district court's grant of a motion to dismiss for lack of personal jurisdiction[237] where the district court had "erroneously applied Sixth Circuit law"[238] instead of Federal Circuit law. When the court applied its own law to the due-process analysis, it reached the opposite result as the district court had reached

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[233] Important Supreme Court personal-jurisdiction cases include, for example, (1) *International Shoe Co. v. Washington*, 326 U.S. 310 (1945); (2) *World-Wide Volkswagen Corp. v. Woodson*, 444 U.S. 286 (1980); (3) *Burger King Corp. v. Rudzewicz*, 471 U.S. 462 (1985); and (4) *Asahi Metal Industry Co. v. Superior Court of California, Solano County*, 480 U.S. 102 (1987).

[234] 21 F.3d 1558.

[235] *Id.* at 1564.

[236] No. 99-1049, 1999 WL 820449 (Fed. Cir. Oct. 7, 1999) (per curiam) (unpublished).

[237] *Id.* at *1.

[238] *Id.* at *5.

applying regional-circuit law.[239] Thus, in *Schwanger*, the choice-of-law issue was outcome-determinative.[240]

III. DIFFERENT APPROACHES AND POSSIBLE IMPROVEMENTS TO THE FEDERAL CIRCUIT'S CHOICE-OF-LAW RULES FOR PROCEDURAL ISSUES IN PATENT CASES

This Part evaluates several possible approaches that the Federal Circuit could take regarding its choice-of-law rules for procedural issues in patent cases. Part III.A begins by discussing the important interests, needs, and goals of the institutions and players involved in patent litigation—namely, the Federal Circuit, the district courts, and litigants. The remainder of this Part then evaluates several different approaches to the choice-of-law issue by considering how each approach furthers or retards these institutional interests. Part III.B evaluates the Federal Circuit's current choice-of-law rules. Next, Part III.C discusses previous suggestions by other commentators for improving the Federal Circuit's choice-of-law rules. Part III.D then considers the possibility of applying regional-circuit law to all procedural issues in patent cases. Finally, Part III.E, analyzes the possibility of applying Federal Circuit law to all procedural issues in patent cases.

[239] *Id.* at *5-*6.

[240] *But cf.* HollyAnne Corp. v. TFT, Inc., 199 F.3d 1304, 1306, 1307-10 (Fed. Cir. 1999) (reaching the same result with respect to personal jurisdiction under Federal Circuit law as the district court did when it improperly applied Eighth Circuit law).

A. INSTITUTIONAL INTERESTS OF THE FEDERAL CIRCUIT, DISTRICT COURTS, AND LITIGANTS

To evaluate the possible ways to improve the Federal Circuit's approach to the choice-of-law issue, it is important to consider the interests, needs, and goals of the institutions and players involved.[241] Weighing these sometimes competing interests, needs, and goals will help to determine the merits of possible proposals for reform. Therefore, this Subpart discusses the institutional interests of (1) the Federal Circuit, (2) the district courts, and (3) litigants with respect to the choice of procedural law in patent cases.

1. Federal Circuit

The Federal Circuit has a set of institutional interests, needs, and goals with respect to the choice-of-law issue. These interests, needs, and goals include (1) promoting uniformity and (2) predictability while (3) reducing forum shopping, (4) avoiding overspecialization, and (5) using independent judgment to decide cases correctly.

The first institutional interest of the Federal Circuit is for uniformity,[242] which promotes predictability[243] and reduces undesirable forum shopping.[244] When Congress

[241] *See* Schaffner, *supra* note 3, at 1208-09 (discussing the interests of the Federal Circuit and the regional courts); McEldowney, *supra* note 17, at 1653-63 (discussing the interests of "potential litigants, courts, and the effectiveness and quality of the law itself"); *cf.* Note, *Securing Uniformity in National Law: A Proposal for National Stare Decisis in the Courts of Appeals*, 87 YALE L.J. 1219, 1240-46 (1978) (balancing the institutional needs of the Supreme Court and the courts of appeals to analyze a proposal for implementing national stare decisis in the courts of appeals).

[242] *See* Joseph F. Weis, Jr., *Disconnecting the Overloaded Circuits: A Plug for a Unified Court of Appeals*, 39 ST. LOUIS U. L.J. 455, 458 (1995) ("As has frequently been said, the importance of uniformity in the application of law is an important part of our jurisprudence.").

established the Federal Circuit with the FCIA, one of the important reasons was to bring national uniformity to patent law.[245] Indeed, the FCIA gives the Federal Circuit "a mandate to achieve uniformity in patent matters."[246] Such uniformity is important because it can "promote a more efficient market [and] create a predictable and stable legal regime."[247] Uniformity is desirable in not only substantive law but in procedural law, as well.[248] Therefore, the Federal Circuit must strive to promote uniformity in both substantive and procedural law.

Uniformity leads to predictability, and increasing predictability is another important interest of the Federal Circuit.[249] Indeed, "[i]f all patent cases were resolved predictably and uniformly by the district courts, there would be . . . a reduction in litigation because parties would be more likely to settle if they could accurately forecast

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[243] *See* Schaffner, *supra* note 3, at 1178.

[244] *See* Richard L. Marcus, *Conflicts Among Circuits and Transfers Within the Federal Judicial System*, 93 YALE L.J. 677, 677 (1984).

[245] *See* S. REP. NO. 97-275, at 2-6 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 12-16; *see also* Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 838 (2002) (Stevens, J., concurring in part and concurring in the judgment); Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359-60 (Fed. Cir. 1999) (en banc in relevant part); Dreyfuss, *supra* note 1, at 2-4; Schaffner, *supra* note 3, at 1178.

[246] Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

[247] Schaffner, *supra* note 3, at 1178.

[248] *See id.* at 1208; *see also* Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 857 (Fed. Cir 1991); *Panduit*, 744 F.2d at 1574.

[249] *See* Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1620 (2007); McEldowney, *supra* note 17, at 1655.

outcome."[250] In general, unpredictable rules lead to increased transaction costs.[251] Importantly, even if conflicting interpretations of a legal rule do not actually occur, "the mere possibility of conflict . . . breeds uncertainty, which leaves 'individuals . . . in doubt as to what rule will be applied to their transactions.'"[252] Thus, "[i]t is usually more important that a rule of law be settled, than it be settled right."[253] Therefore, the Federal Circuit has an important interest in achieving predictability.

Where uniformity and predictability exist, the opportunity for forum shopping is reduced. And reducing forum shopping is another important interest of the Federal Circuit.[254] In spite of the Federal Circuit's interest in reducing forum shopping, the practice remains common in patent litigation today.[255] The traditional "evils of forum shopping" include "(1) the notion that forum shopping reflects inequity in the legal system and (2) the premise that forum shopping is inefficient."[256] Although forum shopping may traditionally be thought of as springing from differences in substantive

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[250] Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 N.C. L. REV. 889, 893 (2001).

[251] *Id.* at 928 n.134.

[252] Note, *supra* note 241, at 1219 n.2 (second omission in original) (quoting U.S. COMMISSION ON REVISION OF THE FEDERAL COURT APPELLATE SYSTEM, STRUCTURE AND INTERNAL PROCEDURES: RECOMMENDATIONS FOR CHANGE, at 14 (1975)).

[253] Di Santo v. Pennsylvania, 273 U.S. 34, 42 (1927) (Brandeis, J., dissenting); *accord* McEldowney, *supra* note 17, at 1662-63; *see* Dreyfuss, *supra* note 1, at 8; Weis, *supra* note 242, at 462 & n.34 (quoting *Di Santo*, 273 U.S. at 42).

[254] Beverly Hills Fan Co. v. Royal Sovereign Corp., 21 F.3d 1558, 1565 n.13 (Fed. Cir. 1994).

[255] Moore, *supra* note 250, at 892; Nard & Duffy, *supra* note 249, at 1668.

[256] Moore, *supra* note 250, at 924 (footnote omitted).

law,[257] differences in procedural law may also give rise to forum shopping in patent litigation.[258] Indeed, patent litigation counsel seek not only the forum with the most favorable substantive law, but also the forum having "the most favorable law as to the possibly outcome-determinative non-patent procedural . . . issues."[259] Therefore, the Federal Circuit has a strong interest in reducing opportunities for forum shopping with respect to both substantive and procedural issues.

Another interest of the Federal Circuit is avoiding overspecialization.[260] When it created the Federal Circuit with the FCIA, Congress sought to ensure that the court would

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[257] *See* McEldowney, *supra* note 17, at 1661.

[258] *Beverly Hills Fan*, 21 F.3d at 1565 n.13; Gholz, *supra* note 8, at 314; Moore, *supra* note 250, at 892; *see* Edward K. Cheng, *Independent Judicial Research in the* Daubert *Age*, 56 DUKE L.J. 1263, 1311-12 (2007); *cf.* Carol Rice Andrews, *The Personal Jurisdiction Problem Overlooked in the National Debate About "Class Action Fairness,"* 58 SMU L. REV. 1313, 1324 (2005) ("[S]tates may apply their own procedural law—and thereby provide forum shopping incentives to class counsel . . . ."); Glenn S. Koppel, *Toward a New Federalism in State Civil Justice: Developing a Uniform Code of State Civil Procedure Through a Collaborative Rule-Making Process*, 58 VAND. L. REV. 1167, 1191-92 (2005) (contending that differences in state procedural rules lead to forum shopping between states); Emil Petrossian, *In Pursuit of the Perfect Forum: Transnational Forum Shopping in the United States and England*, 40 LOY. L.A. L. REV. 1257, 1261 (2007) ("Like substantive law, disuniformity in procedural laws [between nations] engenders forum shopping."). *But see* McEldowney, *supra* note 17, at 1661 (contending without support that "common perceptions hold that variations in procedural law are far less likely to induce forum shopping than variations in substantive law").

[259] Gholz, *supra* note 8, at 314.

[260] Atari, Inc. v. JS & A Group, Inc., 747 F.2d 1422, 1436-37 (Fed. Cir. 1984) (en banc); *cf.* Charles R. Haworth, *Circuit Splitting and the "New" National Court of Appeals: Can the Mouse Roar?*, 30 SW. L.J. 839, 858 (1976) (contending that in judicial reform, "[s]pecialization of courts and judges must be avoided"); Maurice Rosenberg, *Planned Flexibility to Meet Changing Needs of the Federal Appellate System*, 59 CORNELL L. REV. 576, 588 (1974) ("An appellate judge should not be assigned duties so narrow that they will repel the ablest judges, or foster a narrow, slit-viewed approach.").

not be overspecialized.[261] Overspecialization presents several potential problems.[262] One such potential problem is that a specialized court may be more susceptible to "the threat of 'capture' by narrow interest groups."[263] Another potential problem is that a specialized court "may act to aggrandize the importance of [its] jurisdiction."[264] Moreover, "judges in [a] specialized court[] might develop 'tunnel vision' and lose the generalist perspective necessary to integrate their specialty into the legal mainstream."[265] Yet another concern is that "judges on [a] specialized court[] might not exercise appropriate judicial restraint and might substitute their judgment for that of trial judges."[266] Finally, judges on an overspecialized court "may develop an institutional bias."[267] Thus, the Federal Circuit has an interest in avoiding overspecialization.

The Federal Circuit also has an interest in using its independent judgment to decide cases correctly. Federal courts of appeals normally have the duty, the power, and the ability to decide issues of federal law correctly, and they normally do not accept another circuit's interpretation of a federal rule of law without independently addressing

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[261] S. REP. NO. 97-275, at 6 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 16; H.R. REP. NO. 97-312, at 19 (1981).

[262] *See* Nard & Duffy, *supra* note 249, at 1628 n.40.

[263] *Id.* at 1628; *accord* Adams, *supra* note 2, at 59.

[264] Nard & Duffy, *supra* note 249, at 1628.

[265] Adams, *supra* note 2, at 59.

[266] *Id.*

[267] Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 839 (2002) (Stevens, J., concurring).

the merits of that rule.[268] Thus, "the true federal interest is having the court which decides the case apply its own interpretation of federal law."[269] "This principle follows naturally from the structure of appellate review established by the Evarts Act,"[270] the act that established the federal courts of appeals in 1891.[271] The Evarts Act required each circuit to use its independent judgment in interpreting federal law rather than defer to the precedent of other circuits.[272] Although this structure produces conflicts in interpretation between the circuits, these conflicts can be beneficial "because the views of the different courts are thought to percolate, leading to soundly fashioned legal rules."[273]

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[268] *In re* Korean Air Lines Disaster, 829 F.2d 1171, 1175 (D.C. Cir. 1987) (quoting Marcus, *supra* note 244, at 702); Thompson, *supra* note 2, at 574; *see* Schaffner, *supra* note 3, at 1205 (citing and quoting Marcus, *supra* note 244, at 702); *see also* Friendly, *supra* note 4, at 413 ("One circuit will follow another or others when it is persuaded, has no strong views either way, or considers immediate nationwide uniformity to be unusually important, but generally not when it firmly believes the other circuit or circuits have been wrong."). Professor Marcus calls this the "principle of competence" because although federal courts may not be competent to decide issues of state law, federal courts are "presumptively competent to decide" issues of federal law. Marcus, *supra* note 244, at 702.

[269] Marcus, *supra* note 244, at 696; *see also* Schaffner, *supra* note 3, at 1205 (citing and quoting Marcus, *supra* note 244, at 696).

[270] Marcus, *supra* note 244, at 702-03.

[271] *Id.* at 686 (citing The Circuit Court of Appeals Act of 1891, ch. 517, 26 Stat. 826).

[272] Dreyfuss, *supra* note 1, at 45; Rochelle Cooper Dreyfuss, *The Federal Circuit: A Continuing Experiment in Specialization*, 54 CASE W. RES. L. REV. 769, 789 (2004); Marcus, *supra* note 244, at 686; Kimberly Jade Norwood, *Double Forum Shopping and the Extension of* Ferens *to Federal Claims that Borrow State Limitation Periods*, 44 EMORY L.J. 501, 540 (1995); Schaffner, *supra* note 3, at 1195; Thompson, *supra* note 2, at 564-65.

[273] Dreyfuss, *supra* note 1, at 45; *accord* Schaffner, *supra* note 3, at 1196-97; Thompson, *supra* note 2, at 567.

The Federal Circuit shares this interest in applying its independent judgment along with the courts of appeals for the regional circuits. Although the Federal Circuit was created in 1982 under the FCIA[274] rather than in 1891 under the Evarts Act, the FCIA establishes the Federal Circuit as a coordinate court to the regional courts of appeals.[275] Because it is on equal footing with the regional circuits, the Federal Circuit must also have a duty to use its independent judgment in interpreting federal rules of law. Indeed, courts and commentators have described this duty as belonging to all courts.[276] Therefore, like all courts, the Federal Circuit has an interest in using its independent judgment in interpreting federal law to arrive at what it perceives as the correct result.

2. *District Courts*

Like the Federal Circuit, the district courts also have their own set of institutional interests with respect to the choice of law for procedural matters in patent cases. In general, the role of a district court is to "dispos[e] of cases by trial or settlement with fairness and with the optimum blend of prompt decision and rightness of result."[277] In particular, with respect to the choice-of-law issue, district courts have an interest in (1) maintaining uniformity in trial management and (2) predictability as to which law to apply.

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[274] *E.g.*, Dreyfuss, *supra* note 1, at 3 (citing Pub. L. No. 97-164, 96 Stat. 25); Petherbridge & Wagner, *supra* note 1, at 2056-57 (citing same).

[275] S. REP. NO. 97-275, at 2-3 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 12-13; H.R. REP. NO. 97-312, at 18 (1981).

[276] *See* Mast, Foos, & Co. v. Stover Mfg. Co., 177 U.S. 485, 488 (1900); Menowitz v. Brown, 991 F.2d 36, 40 (2d Cir. 1993); Weis, *supra* note 242, at 459-60 (citing *Mast, Foos*, 177 U.S. at 488; *Menowitz*, 991 F.2d at 40).

[277] Friendly, *supra* note 4, at 406-07.

District courts have an interest in maintaining uniformity in trial management. Indeed, the Federal Circuit has stated that "the policy of achieving uniformity in district court management of trials has been a significant factor in [the court's] occasional deference to regional circuit law."[278] The court has recognized the district courts' interest in maintaining uniformity in trial management:

> Dealing daily with . . . procedural questions in all types of cases, a district court cannot and should not be asked to answer them one way when the appeal on the merits will go to the regional circuit in which the district court is located and in a different way when the appeal will come to [the Federal Circuit].[279]

Thus, in an ideal world, district court judges would prefer to always apply the familiar procedural law of their regional circuits rather than applying possibly unfamiliar Federal Circuit law.[280]

Additionally, district courts have an interest in predictability as to which law to apply. Importantly, a district court must know whether to apply the law of the Federal Circuit or its own regional circuit to a particular procedural issue in a patent case.[281] The Federal Circuit's choice-of-law problem places the district court in danger of having to

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[278] Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 856 (Fed. Cir 1991); *accord In re* Int'l Med. Prosthetics Research Assocs., 739 F.2d 618, 620 (Fed. Cir. 1984); Schaffner, *supra* note 3, at 1208.

[279] *Int'l Med. Prosthetics*, 739 F.2d at 620; *accord Biodex*, 946 F.2d at 856 (quoting *Int'l Med. Prosthetics*, 739 F.2d at 620).

[280] McEldowney, *supra* note 17, at 1655; *see* Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985); Schaffner, *supra* note 3, at 1218.

[281] McEldowney, *supra* note 17, at 1647-48, 1654-55; Miller, *supra* note 2, at 328.

"serve[] two masters" and to "look[], Janus-like,[282] in two directions in its conduct of [the] judicial process."[283] Thus, it is important for the district court to know which law to apply to a given issue.

3. Litigants

Litigants, too, have their own set of interests with respect to the choice of law for procedural matters in patent cases. These interests include (1) predictability as to which law the court will apply to a particular procedural issue and (2) uniformity in procedural law.

Like the district courts,[284] litigants in patent cases have an important interest in predictability as to which law the court will apply to a particular procedural issue. In

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[282] "In Roman mythology, Janus (or Ianus) was the god of gates, doors, doorways, beginnings, and endings." Wikipedia, http://en.wikipedia.org/wiki/Janus%28mythology%29 (last visited July 31, 2008). Significantly, "Janus was usually depicted with two heads (not faces) looking in opposite directions." *Id.*

[283] Atari, Inc. v. JS & A Group, Inc., 747 F.2d 1422, 1439 (Fed. Cir. 1984) (en banc); *accord* Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985); Schaffner, *supra* note 3, at 1218; McEldowney, *supra* note 17, at 1654-55. In *Panduit*, the Federal Circuit noted:

> Where, as here, a procedural question that is independent of the patent issues is in dispute, practitioners within the jurisdiction of a particular regional circuit court should not be required to practice law and to counsel clients in light of two different sets of law for an identical issue due to the different routes of appeal. An equal, if not more important, consideration is that district judges also should not be required to decide cases in this fashion.

Id. (footnote omitted).

[284] See *supra* Part III.A.2 (discussing the institutional interests of the district courts with respect to the choice-of-law issue in patent cases).

fact, "[a] litigant's primary concern is often predictability of the law."[285] And this predictability applies to procedural law as well as substantive law.[286] Indeed, predictability can sometimes be more important in procedural law than in substantive law.[287] Moreover, predictability can reduce the cost of litigation.[288] Patent litigation is very expensive.[289] Therefore, litigants have an interest in predictable rules that can reduce litigation expenses.[290]

Additionally, like the district courts, litigants have an interest in uniformity of procedural law. However, unlike the district courts, litigants have an interest in nationwide uniformity rather than uniformity within a particular district.[291] "[C]onsumers of patent law are intercircuit actors."[292] Moreover, the practice of patent-

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[285] McEldowney, *supra* note 17, at 1653; *accord* Miller, *supra* note 2, at 328.

[286] McEldowney, *supra* note 17, at 1654.

[287] *Id.* For example, a court may apply a procedural rule and hold that a party has waived attorney-client privilege over a large set of documents that the party would like to keep secret. *Id.* Such documents might then be available to the public, and they might hurt the party in future litigation. *Id.* In contrast, a ruling of patent invalidity, for instance, affects only that one patent. *Id.* Thus, "[p]rocedural questions can impact every aspect of a company's activities, whereas patent outcomes might only implicate the value of a particular patent." *Id.*

[288] Nard & Duffy, *supra* note 249, at 1620.

[289] *E.g.*, Moore, *supra* note 250, at 891.

[290] Nard & Duffy, *supra* note 249, at 1620.

[291] Gholz, *supra* note 8, at 316. *But see* Schaffner, *supra* note 3, at 1201 ("[A]lthough having a consistent set of procedural rules for all patent cases nationwide might make patent attorneys' lives a bit easier, today many attorneys practice nationwide and are accustomed to following the procedural rules of the local trial forum.").

[292] Rochelle Cooper Dreyfuss, *Specialized Adjudication*, 1990 BYU L. REV. 377, 419; *accord* Schaffner, *supra* note 3, at 1211 (quoting Dreyfuss, *supra*, at 419).

litigation attorneys is nationwide.[293] Therefore, in an ideal world, litigants would prefer a nationwide "uniform body of procedural law applicable in all cases appealable to the Federal Circuit."[294]

B. THE FEDERAL CIRCUIT'S CURRENT CHOICE-OF-LAW RULES

The Federal Circuit could continue to follow its current choice-of-law rules.[295] However, these rules fail to fulfill almost all of the important institutional interests,

[293] Gholz, *supra* note 8, at 316; *accord* Dreyfuss, *supra* note 1, at 45; Schaffner, *supra* note 3, at 1201.

[294] Gholz, *supra* note 8, at 316.

[295] Another court that followed the Federal Circuit's current choice-of-law rules was the Temporary Emergency Court of Appeals ("TECA"), which was a specialized court that existed from 1970 through 1993. *See* Texas Am. Oil Corp. v. United States Dep't of Energy, 44 F.3d 1557, 1562-63 (Fed. Cir. 1995) (en banc); Thompson, *supra* note 2, at 546-47. Like the Federal Circuit, the TECA's jurisdiction was defined by its subject matter rather than geography. *See Texas Am. Oil*, 44 F.3d at 1562; Thompson, *supra* note 2, at 546-47. Congress created the TECA with the Economic Stabilization Act of 1970 ("ESA"). *Texas Am. Oil*, 44 F.3d at 1562 (citing Pub. L. No. 91-379, 84 Stat. 799 (1970), codified at 12 U.S.C. § 1904 note). The ESA "authorized the President to stabilize prices, rents, wages, and salaries, and to establish priorities for use and allocation of petroleum products." *Id.* The district courts had trial jurisdiction under the ESA, and the TECA had appellate jurisdiction over ESA issues. *Id.* at 1563. The purpose of creating the TECA was "to funnel into one court all the appeals arising out of the District Courts and thus gain in consistency of decision." *Id.* at 1562. Although the ESA authority expired in 1974, most of the ESA was "incorporated by reference into . . . the Emergency Petroleum Allocation Act (EPAA), which was enacted in response to nationwide shortages of petroleum products due to the 1973 Arab oil embargo." *Id.* (citing Pub. L. No. 93-159, 87 Stat. 627 (1973), codified at 15 U.S.C. §§ 751 et seq.). In 1981, the EPAA "expired . . . pursuant to a sunset provision." *Id.*. In 1992, jurisdiction over remaining ESA cases was transferred to the Federal Circuit, and the TECA was abolished in 1993. *Id.*; 13 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3508 n.33 (2008). Interestingly, the TECA followed *Panduit* in deciding that it would "follow the law of the particular regional circuit court where appeals from the district court would normally lie in matters not unique to the [TECA's] special jurisdiction." Consumers Power Co. v. United States Dep't of Energy, 894 F.2d 1571, 1579 (Temp. Emer. Ct. App. 1990) (per curiam) (citing Sun Tek Indus. V. Kennedy Sky Lites, Inc., 848 F.2d 179 (Fed. Cir. 1988); *Panduit*, 744 F.2d 1564) (applying Sixth Circuit law to the issue of whether to award attorney fees and costs).

needs, and goals of the Federal Circuit, district courts, and litigants.[296] For example, the current rules do not meet the Federal Circuit's, district courts', and litigants' interest in uniformity. Indeed, the current rules do not fulfill the Federal Circuit's and litigants' interest in achieving uniformity in patent cases[297] because different procedural rules may apply to patent cases with similar factual and legal issues brought in different districts, thus potentially leading to different outcomes. Additionally, the current rules do not fulfill the district courts' interest in maintaining uniformity in trial management[298] because district courts must sometimes apply regional-circuit law and sometimes apply Federal Circuit law on procedural issues in patent cases. Although the current rules give lip service to avoiding or reducing this concern, district courts nonetheless remain in danger of having to "serve[] two masters" and to "look[], Janus-like, in two directions in its conduct of [the] judicial process."[299] Moreover, the current rules fail to fulfill the interest of litigants in achieving nationwide uniformity in procedural law[300] because litigants, who are typically nationwide actors,[301] are potentially subject to different procedural law in each regional circuit in which they become involved in a patent case.

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[296] *See* Moore, *supra* note 58, at 801 ("Like other commentators, I find the Federal Circuit's current choice of law rules unsatisfying . . . .").

[297] *See supra* pp. 50-51 (discussing the Federal Circuit's interest in achieving uniformity).

[298] *See supra* pp. 56-56 (discussing the district courts' interest in maintaining uniformity in trial management).

[299] Atari, Inc. v. JS & A Group, Inc., 747 F.2d 1422, 1439 (Fed. Cir. 1984) (en banc).

[300] *See supra* p. 58 (discussing litigants' interest in achieving nationwide uniformity).

[301] Dreyfuss, *supra* note 292, at 419; Gholz, *supra* note 8, at 316.

Likewise, the current rules do not meet the Federal Circuit's, district courts', and litigants' interest in predictability.[302] The lack of predictability engendered by the current rules leads to increased transaction costs for litigants.[303] Every procedural rule in a patent case has choice of law as a threshold issue, and the lack of predictability under the court's current rules necessarily requires attorneys and district courts to perform more legal research and analysis than should be necessary to determine which law applies.

Furthermore, as discussed in detail in Part II above, the Federal Circuit has inconsistently articulated its choice-of-law rules for procedural issues in patent cases.[304] This inconsistent articulation has made the rules difficult to apply, thus decreasing the predictability of which law applies to a particular issue. That the current choice-of-law rules are difficult to apply is evidenced by the fact that even in some areas where the court consistently applies its own law, the court should arguably be applying regional-circuit law under the court's current choice-of-law rules, as discussed in detail in Part II.D above.[305] Moreover, under the current rules, either regional-circuit or Federal Circuit law can apply to almost any issue depending upon whether the court defines the

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[302] *See supra* pp. 50-51, 56, 57-58 (discussing the Federal Circuit's, district courts', and litigants' interest in predictability).

[303] *Cf.* Moore, *supra* note 250, at 928 n.134 ("Many commentators have lamented the increased transaction costs caused by unpredictable, fuzzy, or muddy rules.").

[304] *See supra* pp. 12-13 (discussing the Federal Circuit's inconsistent articulation of its choice-of-law test for procedural issues in patent cases).

[305] *See supra* Part II.D (giving examples of issues where the Federal Circuit consistently applies its own law but should arguably apply regional-circuit law under the current choice-of-law rules).

issue broadly or narrowly,[306] thus further reducing predictability. Additionally, as described in detail in Parts II.A–C above, the court's application of these rules has been inconsistent.[307] The court has applied its choice-of-law rules inconsistently both within particular procedural issues and between different procedural issues that the court should seemingly treat the same.[308] Indeed, in many cases, the court simply ignores the choice-of-law issue altogether.[309] All these factors show that the Federal Circuit's current choice-of-law rules have failed to yield predictability.

Because the court's current choice-of-law rules do not fulfill the interests of uniformity and predictability, the court's current rules do nothing to prevent or reduce forum shopping on procedural issues.[310] Reducing forum shopping is an important interest of the Federal Circuit.[311] Because the court's rules require district courts to apply regional-circuit law for many procedural issues, litigants must "consider which regional

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[306] *See* McEldowney, *supra* note 17, at 1666; *supra* notes 59-65 and accompanying text.

[307] *See* Dreyfuss, *supra* note 1, at 40; Moore, *supra* note 58, at 800; Miller, *supra* note 2, at 328.

[308] *See supra* Part II.A (discussing inconsistencies in the Federal Circuit's choice-of-law approach to Rule 12(b)(6) motions to dismiss, motions for summary judgment, and post-trial motions for judgment as a matter of law); *supra* Part II.B (discussing inconsistencies in the court's approach to the issue of waiver of post-verdict JMOL motions); *supra* Part II.C (discussing inconsistencies concerning issues relating to attorney-client privilege).

[309] *Cf.* McEldowney, *supra* note 17, at 1645 ("In its choice-of-procedural-law opinions, the court seems anxious to reach the underlying substance of each suit, and is content to dispose of the choice of procedural law casually and quickly.").

[310] *See* Dreyfuss, *supra* note 1, at 42.

[311] Beverly Hills Fan Co. v. Royal Sovereign Corp., 21 F.3d 1558, 1565 n.13 (Fed. Cir. 1994); *see supra* pp. 51-52 (discussing the Federal Circuit's interest in reducing forum shopping).

circuit has the most favorable law as to the possibly outcome-determinative non-patent procedural or substantive issues."[312] Indeed, one commentator predicted in 1985 that the court's choice-of-law rules would bring "back the bad old days of forum shopping" as in the time before the creation of the Federal Circuit, though "in a less exacerbated form."[313]

Finally, the court's current choice-of-law rules do not promote the Federal Circuit's interests in avoiding overspecialization and using independent judgment to decide cases correctly.[314] The current rules do nothing to help the court avoid overspecialization because they require the court to develop its own procedural law only in issues that sufficiently relate to patent law, as opposed to allowing the court to develop its own law on a wide variety of non-patent procedural issues. Likewise, the current rules do not allow the Federal Circuit to use its independent judgment to interpret non-patent-related procedural rules correctly. For example, a problem can arise where a regional circuit has interpreted a non-patent-related procedural rule differently from other circuits.[315] In such a case, the Federal Circuit would be bound to follow the regional circuit's arguably incorrect interpretation, even though the regional circuit itself would have the power to overrule its previous incorrect interpretation.[316] Thus, the Federal Circuit's current choice-of-law rules do not meet the Federal Circuit's interests in

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[312] Gholz, *supra* note 8, at 314.

[313] *Id.*

[314] *See supra* pp. 52-55 (discussing the Federal Circuit's interests in avoiding overspecialization and using independent judgment to decide cases correctly).

[315] Gholz, *supra* note 8, at 315.

[316] *Id.*

avoiding overspecialization or using its independent judgment to correctly interpret non-patent-related procedural rules.

Therefore, for these reasons, the Federal Circuit's current choice-of-law rules are far from satisfactory. They fail to fulfill the Federal Circuit's interests in promoting uniformity and predictability, reducing forum shopping, avoiding overspecialization, and using independent judgment to decide cases correctly. Moreover, they fail to promote the district courts' interests in maintaining uniformity in trial management and predictability as to which law to apply. Finally, the fail to achieve the interest of patent litigants in predictability and nationwide uniformity in procedural law.

C. Previous Suggestions for Improving the Federal Circuit's Choice-of-Law Rules for Procedural Issues in Patent Cases

A few commentators have proposed changes to the Federal Circuit's approach to the choice-of-law issue for procedural matters in patent cases. Several commentators have proposed that the Federal Circuit should apply its own law and not regional-circuit law to all procedural matters in patent cases.[317] For example, then-Professor Moore, now Judge Moore, suggested:

> Like other commentators, I find the Federal Circuit's current choice of law rules unsatisfying and believe this avenue is ripe for further research into whether a blackletter rule—wherein Federal Circuit law would apply to all procedural issues in patent cases—might be superior to the current choice of law rules.[318]

[317] *See* Dreyfuss, *supra* note 1, at 44-46; Gholz, *supra* note 8, at 314-317; Moore, *supra* note 58, at 800-01; *see also* Schaffner, *supra* note 3, at 1217 (citing Dreyfuss, *supra* note 1, at 43-45; Gholz, *supra* note 8, at 317).

[318] Moore, *supra* note 58, at 801 & n.98 (2002) (footnote omitted) (citing Dreyfuss, *supra* note 1, at 61-62, 64; Gholz, *supra* note 8, at 314; Schaffner, *supra* note 3, at 1192).

This article discusses the proposal to apply Federal Circuit law to all procedural issues in detail in Part III.E below. This Subpart focuses on two additional proposals: (1) applying Federal Circuit law to all issues that "either impact upon the patent-related primary activity of the parties or . . . relate to patent policy and invoke the special expertise of the Federal Circuit";[319] and (2) determining whether to apply regional-circuit or Federal Circuit law by using an "essential-relationship spectrum."[320]

1. *Apply Federal Circuit Law to All Issues that "Either Impact upon the Patent-Related Primary Activity of the Parties or . . . Relate to Patent Policy and Invoke the Special Expertise of the Federal Circuit"*[321]

In 1996, Professor Schaffner proposed 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 thus invoke the expertise of the Federal Circuit's judgment."[322] She proposed that the Federal Circuit apply regional-circuit law to all other issues.[323] She contended that her proposal best fulfilled what she called the "two fundamental considerations relevant to this inquiry: (1) uniformity in the treatment of 'like cases' and (2) the special interests of the Federal Circuit and the regional district and circuit courts."[324] Under Professor Schaffner's

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[319] Schaffner, *supra* note 3, at 1228.

[320] McEldowney, *supra* note 17, at 1673-76.

[321] Schaffner, *supra* note 3, at 1228.

[322] *Id.* at 1210.

[323] *Id.* at 1217-20.

[324] *Id.* at 1206.

proposal, the Federal Circuit would apply regional-circuit law to more procedural issues than the court does now under its current choice-of-law rules.[325]

Professor Schaffner's proposed choice-of-law doctrine has certain drawbacks in that it does not meet many of the interests of the Federal Circuit and litigants. For one thing, her proposal gives too much weight to the district courts' preference to apply familiar regional-circuit law to procedural issues.[326] Rather than seeking uniform procedural rules for all patent cases nationwide, Professor Schaffner's proposal defines "the relevant 'community' which should be treated uniformly [as] 'cases litigated in the regional district court' rather than 'cases appealed to the Federal Circuit.'"[327] Thus, her proposal meets the district courts' interest in uniformity in trial management very well. But her proposal does not meet the Federal Circuit's and litigants' interest in nationwide uniformity of procedural issues.[328] Accordingly, her proposal would also not promote the interest of reducing forum shopping.[329] Under her proposal, parties would still have the opportunity to shop for the regional circuit that interprets outcome-determinative procedural law most favorably to their interests.

Moreover, although Professor Schaffner's proposal may provide more predictability than the Federal Circuit's current test, it nonetheless would not provide

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[325] *Id.* at 1178-79.

[326] *See id.* at 1218.

[327] *Id.* at 1219-20.

[328] *See supra* pp. 50-51, 58 (discussing the Federal Circuit's and litigants' interest in nationwide uniformity of procedural issues in patent cases).

[329] *See supra* pp. 51-52 (discussing the Federal Circuit's interest in reducing forum shopping).

sufficient predictability to meet the interests of the Federal Circuit, district courts, and litigants.[330] Under her proposal, the Federal Circuit would still apply regional-circuit law to some procedural issues[331] and its own law to others.[332] Although her proposed test is better articulated than the Federal Circuit's nebulously articulated test, her proposed test would likely still suffer from inconsistent application. Instead of determining whether a procedural issue was sufficiently related to patent law to justify applying Federal Circuit law, under Professor Schaffner's proposal courts would have to determine whether an issue "affect[s] the patent-related primary activity of the parties . . . and invoke[s] the expertise of the Federal Circuit."[333] District courts and the Federal Circuit might have difficulty making this determination, leading to inconsistency.

Additionally, Professor Schaffner's proposal would not allow the Federal Circuit to use independent judgment in deciding procedural issues.[334] Indeed, under her proposal, the Federal Circuit would apply regional-circuit law to more issues than it

[330] *See supra* pp. 50-51, 56, 57-58 (discussing the Federal Circuit's, district courts', and litigants' interest in predictability).

[331] *See* Schaffner, *supra* note 3, at 1217-20 ("Federal Circuit deference to regional circuit law is sometimes appropriate.").

[332] *See id.* at 1214.

[333] *Id.* at 1216.

[334] *See supra* pp. 53-55 (discussing the Federal Circuit's interest in using independent judgment in deciding procedural issues).

currently does.[335] Thus, her proposal would not meet the Federal Circuit's interest in using its independent judgment to decide issues correctly.[336]

Finally, Professor Schaffner published her proposal in 1996. In the twelve years since then, neither the Federal Circuit nor Congress have shown any interest in adopting her proposal.[337] Thus, to achieve reform in choice of law for procedural issues in patent cases, something different is necessary.

2. *Use an "Essential-Relationship Spectrum" to Determine Which Law to Apply*

In 2005, Sean M. McEldowney proposed that the Federal Circuit should use what he calls an "essential-relationship spectrum" to determine which law to apply.[338] Under his proposal, "[a]t one end of this 'essential relationship' spectrum are questions that bear no relationship to patent law."[339] In contrast, "[a]t the other end are questions that are themselves substantive patent law questions."[340] For each procedural issue, the Federal Circuit would have to place that issue "in its proper place, relative to other points on this conceptual spectrum."[341] Somewhere on the spectrum would be the "point of

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[335] Schaffner, *supra* note 3, at 1178-79.

[336] *But see* McEldowney, *supra* note 17, at 1672 n.140 (criticizing Professor Schaffner's proposed test because it "would seemingly leave the Federal Circuit free to continue [its] over-expansive review of procedural questions").

[337] The Federal Circuit has never cited Professor Schaffner's article, according to a Westlaw KeyCite of the article performed on August 4, 2008.

[338] *See* McEldowney, *supra* note 17, at 1673-76 (describing his proposal).

[339] *Id.* at 1674.

[340] *Id.*

[341] *Id.* (emphasis removed).

demarcation" that would define issues to which the court would apply its own law and the issues to which the court would apply regional-circuit law.[342] He describes this "point of demarcation" as the point at which "the impact of a particular procedural question on substantive patent law becomes sufficiently essential to warrant the Federal Circuit meddling with procedural law despite the risk that such meddling will introduce uncertainty."[343] Significantly, Mr. McEldowney contends that "the Federal Circuit should give maximum deference to regional circuit precedent and substantially limit its own independent judgment on procedural issues."[344]

Mr. McEldowney's proposal suffers from some of the same drawbacks as Professor Schaffner's proposal.[345] Like Professor Schaffner's proposal, Mr. McEldowney's proposal gives too much weight to the district courts' preference to apply familiar regional-circuit law to procedural issues.[346] Indeed, his proposal meets the district courts' interest in uniformity in trial management[347] very well. But his proposal does not meet the Federal Circuit's and litigants' interest in nationwide uniformity of procedural issues.[348] Accordingly, his proposal would also not promote the interest of

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[342] *Id.*

[343] *Id.*

[344] *Id.* at 1675.

[345] *See supra* Part III.C.1 (discussing Professor Schaffner's proposal).

[346] *See* McEldowney, *supra* note 17, at 1675 ("[M]y proposal is for maximum deference [to regional-circuit law] . . . .").

[347] *See supra* pp. 56-56 (discussing the district courts' interest in uniformity in trial management).

[348] *See supra* pp. 50-51, 58 (discussing the Federal Circuit's and litigants' interest in nationwide uniformity of procedural issues in patent cases).

reducing forum shopping.[349] Under his proposal, as with Professor Schaffner's proposal, parties would still have the opportunity to shop for the regional circuit that interprets outcome-determinative procedural law most favorably to their interests.[350]

Furthermore, Mr. McEldowney's proposal would not provide sufficient predictability to meet the interests of the Federal Circuit, district courts, and litigants.[351] Under his proposal, the Federal Circuit would still apply regional-circuit law to some procedural issues and its own law to others.[352] Importantly, however, the Federal Circuit and district courts would have difficulty determining where to place particular issues on the essential-relationship spectrum.[353] Indeed, courts would likely have just as much or

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[349] *See supra* pp. 51-52 (discussing the Federal Circuit's interest in reducing forum shopping).

[350] *See* Gholz, *supra* note 8, at 316.

[351] *See supra* pp. 50-51, 56, 57-58 (discussing the Federal Circuit's, district courts', and litigants' interest in predictability).

[352] *See* McEldowney, *supra* note 17, at 1675.

[353] *Cf. id.* ("Of course, the question remains: where is the 'essential relationship' point on the spectrum (i.e., where is the line of demarcation between the proper realm of the Federal Circuit and the regional circuits)?"). To determine where this point lies on the spectrum, Mr. McEldowney's test would require courts to "account for all relevant policy concerns in defining this point of demarcation." *Id.* But courts would have difficulty applying a test like this one that requires them to consider and balance multiple policy concerns and place issues on a spectrum. *See* E. Trans-Waste of Maryland, Inc. v. United States, 27 Fed. Cl. 146, 152 (1992) (describing areas of "the law dealing with a spectrum rather than a bright line" as "giv[ing] courts pause" and noting that "such spectrum tests are difficult or impossible to apply objectively to cases in the middle"); *cf., e.g.*, Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 115 (5th Cir. 1979) ("Although these categories [of trademark distinctiveness] are meant to be mutually exclusive, they are spectrum-like and tend to merge imperceptibly from one to another. For this reason, they are difficult to define and, quite frequently, difficult to apply."); John B. Fowles, *The Utility of a Bright-Line Rule in Copyright Law: Freeing Judges from Aesthetic Controversy and Conceptual Separability in* Leicester v. Warner Bros., 12 UCLA ENT. L. REV. 301, 317-18 (2005) (describing "Denicola's spectrum" in copyright law, which is "a sliding scale between art and utility," as "conceptually difficult to apply").

even more difficulty placing issues on a spectrum than applying the Federal Circuit's current choice-of-law rules. Thus, Mr. McEldowney's proposal likely would not increase predictability, which is one of the most important interests of the Federal Circuit, district courts, and litigants.

Finally, as with Professor Schaffner's proposal, Mr. McEldowney's proposal would not allow the Federal Circuit to use independent judgment in deciding procedural issues.[354] Indeed, his proposal calls for "maximum deference" to regional-circuit law.[355] Thus, his proposal would not meet the Federal Circuit's interest in using its independent judgment to decide issues correctly. In summary, Mr. McEldwoney's proposal fails to meet many of the important interests, needs, and goals of the Federal Circuit, district courts, and litigants.

D. APPLY REGIONAL-CIRCUIT LAW TO ALL PROCEDURAL ISSUES IN PATENT CASES

One way to eliminate the unpredictability and inconsistency inherent in the Federal Circuit's current choice-of-law rules would be for the court to apply regional-circuit law to all procedural issues, even if those issues were related or unique to patent law. This solution is far from ideal, however. Indeed, no commentators have proposed that the court adopt this solution. This solution, as a bright-line rule, would have the advantage of satisfying the Federal Circuit's, district courts', and litigants' interest in

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[354] *See supra* pp. 53-55 (discussing the Federal Circuit's interest in using independent judgment in deciding procedural issues).

[355] McEldowney, *supra* note 17, at 1675.

predictability.[356] And applying regional-circuit law to all procedural issues would also satisfy the district courts' interest in maintaining uniformity in trial management[357] because district courts would always apply familiar regional-circuit law under this solution. But there are disadvantages to this solution that outweigh these two advantages.

Significantly, applying regional-circuit law to all procedural issues would inhibit the Federal Circuit's interest in promoting uniformity in patent law.[358] One of the most important reasons that Congress created the Federal Circuit with the FCIA was to bring national uniformity to patent law.[359] If the Federal Circuit were to apply regional-circuit law to important, outcome-determinative procedural issues that are unique or essentially related to patent law, the court would fail to achieve its mandate to bring uniformity to patent law. In contrast, by applying its own law to these types of procedural issues, the court "is building a more robust body of patent-related precedent and applying its 'special expertise' in patent law to a great array of issues that intersect with patent law."[360]

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[356] *See supra* pp. 50-51, 56, 57-58 (discussing the Federal Circuit's, district courts', and litigants' interest in predictability).

[357] *See supra* pp. 56-56 (discussing the district courts' interest in maintaining uniformity in trial management).

[358] *See* McEldowney, *supra* note 17, at 1641; *supra* pp. 50-51 (discussing the Federal Circuit's interest in achieving uniformity).

[359] *See, e.g.*, S. REP. NO. 97-275, at 2-6, 1982 U.S.C.C.A.N. at 12-16; Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

[360] Janice M. Mueller, *At Sea in a Black Box: Charting a Clearer Course for Juries Through the Perilous Straits of Patent Invalidity*, 1 J. MARSHALL REV. INTELL. PROP. L. 3, 18 (2001).

Accordingly, by applying its own law, the court is fulfilling its mandate by "fashion[ing] a body of nationally uniform patent and 'patent-intersecting' law."[361]

Moreover, applying regional-circuit law to all procedural issues would not promote other important interests of the Federal Circuit, district courts, and litigants. For one thing, doing so would not allow the Federal Circuit to fulfill its interest in reducing forum shopping[362] because a given procedural issue might have multiple interpretations in the different regional circuits. Thus, parties would have even more of an opportunity to seek the forum "having the most favorable law as to the possibly outcome-determinative non-patent procedural . . . issues."[363] Additionally, applying regional-circuit law to all procedural issues would not advance the Federal Circuit's interest in avoiding overspecialization and using independent judgment to correctly decide these issues.[364] Finally, the interest of litigants in nationwide uniformity of procedural laws in patent cases[365] would suffer in this solution. Therefore, for these reasons, applying regional-circuit law to all procedural issues in patent cases is not an improvement over the court's current choice-of-law rules.

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[361] *Id.* at 19.

[362] *See supra* pp. 51-52 (discussing the Federal Circuit's interest in reducing forum shopping).

[363] Gholz, *supra* note 8, at 314.

[364] *See supra* pp. 52-55 (discussing the Federal Circuit's interests in avoiding overspecialization and using independent judgment to decide cases correctly).

[365] *See supra* p. 58 (discussing litigants' interest in achieving nationwide uniformity).

E. APPLY FEDERAL CIRCUIT LAW TO ALL PROCEDURAL ISSUES IN PATENT CASES

A promising solution to the problems of inconsistency and unpredictability with the Federal Circuit's current choice-of-law rules would be for the court to apply its own law to all procedural issues, regardless of whether these issues were related to substantive patent law. This proposal would advance the interests of achieving nationwide uniformity in patent cases, increasing predictability, reducing forum shopping, allowing the Federal Circuit to avoid overspecialization, and increasing the Federal Circuit's opportunities to use its independent judgment. Although this proposal has potential drawbacks, these drawbacks are likely not enough to offset the advantages of adopting this proposal.

Adopting the proposal to apply Federal Circuit law to all procedural issues would promote the Federal Circuit's and litigants' interest in uniformity.[366] Under this proposal, the Federal Circuit would be able to develop uniform procedural law that would apply in all patent cases.[367] Moreover, parties and their counsel specializing in patent litigation would benefit from such uniform nationwide procedural law.[368]

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[366] *See supra* pp. 50-51, 58 (discussing the Federal Circuit's and litigants' interest in nationwide uniformity in procedural law).

[367] *But see* Schaffner, *supra* note 3, at 1201 ("The Federal Circuit improperly exercises independent judgment over certain procedural issues under the guise of providing uniformity to patent litigation practice. . . . Exercising independent judgment merely aggravates the perceived drawback of intercircuit conflict by unnecessarily adding to the nonuniformity of federal law."). However, Professor Schaffner's contentions do not sufficiently recognize that nationwide uniformity in patent litigation practice may be desirable, *see infra* Part III.A.3, and that there may be advantages to nonuniformity of federal law, *see* Dreyfuss, *supra* note 1, at 45 (discussing the advantages of nonuniformity because "the views of the different courts are thought to percolate, leading to soundly fashioned legal rules"); Thompson, *supra* note 2, at 567.

[368] *See* Gholz, *supra* note 8, at 316.

Moreover, this proposal would promote the Federal Circuit's, district courts', and litigants' interest in predictability.[369] This proposal is for a bright-line rule, which would eliminate the inconsistent application of the Federal Circuit's current choice-of-law rules. This proposal would reduce transaction costs for district courts and litigants, who currently must perform legal research for each procedural issue concerning the threshold issue of whether Federal Circuit or regional-circuit law applies. These transaction costs are particularly wasteful given that the choice of law does not matter for many procedural rules that have uniform nationwide interpretations. Additionally, this proposal would foster predictability by freeing the Federal Circuit and district courts from having to predict how a regional circuit would decide a particular procedural issue that was previously undecided in that circuit, which courts must do now under the Federal Circuit's current choice-of-law rules.[370] Such predictions are quite difficult for courts to make,[371] so eliminating these types of decisions would do much to increase predictability.

Increasing uniformity and predictability with this bright-line rule would also reduce opportunities for forum shopping.[372] The ideal way to reduce forum shopping on procedural issues would be "to eliminate variation in the ways that the district courts

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[369] *See supra* pp. 50-51, 56, 57-58 (discussing the Federal Circuit's, district courts', and litigants' interest in predictability).

[370] Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985); *see* Dreyfuss, *supra* note 1, at 43.

[371] *See* Dreyfuss, *supra* note 1, at 42; Dreyfuss, *supra* note 272, at 790-91; *cf.* Thompson, *supra* note 2, at 587 ("[P]rediction of open issues of state law is undeniably complex.").

[372] *See supra* pp. 51-52 (discussing the Federal Circuit's interest in reducing forum shopping).

resolve patent cases."[373] Although it is "likely impossible" to eliminate all such variation,[374] this proposal would nonetheless help reduce forum shopping. Under this proposal, all district courts would apply the same Federal Circuit law to all procedural issues. Thus, there would be no variation in the interpretation of procedural law between districts, and parties would have less incentive to forum shop.

Moreover, this proposal would help the Federal Circuit fulfill its interest in avoiding overspecialization and exercising its own independent judgment on all issues.[375] Indeed, by applying its own law to all procedural issues, the Federal Circuit would have the opportunity to expand its area of independent judgment to general, non-patent procedural law.[376] Although having one more voice interpreting procedural law along with the regional circuits would slightly decrease nationwide uniformity across all cases (i.e., not just patent cases), such variation may be desirable "because the views of the different courts are thought to percolate, leading to soundly fashioned legal rules." [377]

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[373] Moore, *supra* note 250, at 932.

[374] *Id.* Even if the Federal Circuit were to apply its own uniform, nationwide law to all procedural issues in patent cases, some variation between different courts would still exist because "[t]he human element of the administration of justice cannot be eliminated from the legal system." *Id.*

[375] *See supra* pp. 52-53, 53-55 (discussing the Federal Circuit's interest in avoiding overspecialization and exercising independent judgment).

[376] *Cf.* Schaffner, *supra* note 3, at 1215 ("Allowing independent judgment over a variety of [substantive] legal issues comprising a patent-related case promotes the interest of the Federal Circuit by preventing the court from becoming too specialized and plagued by the problems which such specialization might create."). *But see id.* at 1218 ("[T]he Federal Circuit exercises independent judgment on a host of other issues which allows the court enough latitude so the court does not become too specialized.").

[377] Dreyfuss, *supra* note 1, at 45; *accord* Marcus, *supra* note 244, at 690; Thompson, *supra* note 2, at 567. *But see* Schaffner, *supra* note 3, at 1218 ("[T]he

Moreover, variation between circuits in the interpretation of federal law "is a natural consequence of the Evarts Act, which established regional circuits that have power to interpret federal law independently."[378]

Although the proposal that the Federal Circuit should apply its own law to all procedural issues advances many important interests of the Federal Circuit, district courts, and litigants, this proposal does have potential drawbacks. These potential drawbacks include that this proposal would hurt the district courts' interest in uniformity in trial management, and practitioners and district court judges might have difficulty in learning and applying unfamiliar Federal Circuit law to procedural issues in patent cases. But these drawbacks are not enough to offset the advantages of adopting this proposal.

One potential drawback in having the Federal Circuit apply its own law to all procedural issues is that doing so would hurt the district courts' interest in uniformity in trial management.[379] Indeed, the Federal Circuit has expressed concern that if district courts had to apply Federal Circuit law to procedural issues, then district courts would be forced to "serve[] two masters"[380] and have to "answer [procedural questions] one way

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Federal Circuit's unique expertise will not add significantly to the 'percolation' of these issues.").

[378] Dreyfuss, *supra* note 1, at 45. Although the Federal Circuit was created in 1982 under the FCIA rather than in 1891 under the Evarts Act, Dreyfuss, *supra* note 1, at 3, the FCIA establishes the Federal Circuit as a coordinate court to the regional courts of appeals. S. REP. NO. 97-275, at 2-3 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 12-13; H.R. REP. NO. 97-312, at 18 (1981). Thus, the Federal Circuit should also have the power to interpret federal law independently.

[379] *See supra* pp. 56-56 (discussing the district courts' interest in uniformity in trial management).

[380] Atari, Inc. v. JS & A Group, Inc., 747 F.2d 1422, 1439 (Fed. Cir. 1984) (en banc).

when the appeal on the merits will go to the regional circuit . . . and in a different way when the appeal will come to [the Federal Circuit]."[381] Although this concern is real, under the Federal Circuit's current choice-of-law rules, district courts already are forced to "serve[] two masters"[382] because they must apply regional-circuit law to certain procedural issues and apply Federal Circuit law to other procedural issues. Moreover, because of the inconsistent application of the current rules, district courts do not even know which master to serve on a given issue.[383] At least under the proposal that the Federal Circuit should apply its own law to all procedural issues, district courts would know that they must apply Federal Circuit law to all procedural issues in patent cases.[384] Thus, even though this proposed rule would not advance the district courts' interest in uniformity in trial management, this rule is nonetheless superior to the existing rules.[385]

Another concern the Federal Circuit has had with respect to applying its own law to procedural issues is that practitioners and district court judges would have difficulty in

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[381] *In re* Int'l Med. Prosthetics Research Assocs., 739 F.2d 618, 620 (Fed. Cir. 1984).

[382] *Atari*, 747 F.2d at 1439.

[383] *See* McEldowney, *supra* note 17, at 1647-48.

[384] District courts and parties will know early in a litigation whether to apply regional-circuit or Federal Circuit law to all procedural issues because they will know early in the litigation whether the appeal will go to the regional circuit or to the Federal Circuit. *See* Gholz, *supra* note 8, at 316; *cf.* Schaffner, *supra* note 3, at 1215-16 ("[U]nder most circumstances, Federal Circuit jurisdiction over the appeal will be established early in the litigation; thus, the district court will be on notice that [substantive] Federal Circuit precedent should guide its decision." (footnote omitted)).

[385] Dreyfuss, *supra* note 1, at 41 (contending that the inconsistency in the Federal Circuit's application of its choice-of-law rules "will, ultimately, be as difficult for practitioners and trial judges as a rule allowing the CAFC to announce its own law on procedural matters"); *id.* at 45 ("Although . . . the same district court would apply different law to different cases, this should not be a dispositive obstacle.")

learning and applying unfamiliar Federal Circuit law to these issues. Indeed, in *Panduit*, the Federal Circuit reasoned that it is better for the relatively few Federal Circuit judges to have to learn and apply regional-circuit law "than for countless practitioners and hundreds of district judges to do so."[386] However, this view is wrong for both practitioners and district court judges. It is wrong for practitioners because the court's reasoning incorrectly "suggests that the practice of law is primarily divided on a geographical basis (i.e., that a majority of patent cases are tried by lawyers who are practitioners within the jurisdiction of a particular regional circuit court who try both patent case and non-patent cases)."[387] But in reality, "consumers of patent law are intercircuit actors,"[388] and the practice of patent-litigation attorneys is nationwide.[389] Therefore, it would actually be easier for patent-litigation attorneys practicing nationwide to learn a single, nationwide body of Federal Circuit procedural law for patent cases rather than to have to learn the procedural law of all the different regional circuits.[390]

Furthermore, the Federal Circuit's view that it is better for its judges to learn and apply regional-circuit law "than for . . . hundreds of district judges to do so"[391] is also wrong. District court judges are certainly capable of learning and applying Federal

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[386] Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1575 (Fed. Cir. 1984), *overruled on other grounds*, Richardson-Merrell, Inc. v. Koller, 472 U.S. 424 (1985).

[387] Gholz, *supra* note 8, at 316 (internal quotation marks omitted).

[388] Dreyfuss, *supra* note 292, at 419.

[389] Dreyfuss, *supra* note 1, at 45; Gholz, *supra* note 8, at 316; Schaffner, *supra* note 3, at 1201.

[390] *See* Gholz, *supra* note 8, at 316.

[391] *Panduit*, 744 F.2d at 1575.

Circuit procedural law. For one thing, they already do so today for procedural issues to which the Federal Circuit applies its own law under its current choice-of-law rules. Moreover, in *Panduit*, the Federal Circuit reasoned that it can learn and apply regional-circuit law because it already must "review[] pendent matters in light of state law."[392] But this reasoning applies at least equally to district courts. Indeed, all courts must apply the law of different jurisdictions in a variety of settings.[393] Thus, there is no reason that district courts are not capable of applying unfamiliar Federal Circuit law to procedural issues in patent cases.

Moreover, the parties in a patent case would be in a position educate the district-court judge as to what the law of the Federal Circuit is concerning applicable procedural issues. Because patent-litigation attorneys practice nationwide,[394] presumably they would become quite familiar with Federal Circuit procedural law. Where procedural issues arise pre- and post-trial, the parties could educate the court as to the applicable

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[392] *Id.*

[393] Dreyfuss, *supra* note 1, at 45; Gholz, *supra* note 8, at 316; *see also, e.g.*, Voda v. Cordis Corp., 476 F.3d 887, 906 (Fed. Cir. 2007) (Newman, J., dissenting) ("Precedent illustrates myriad situations in which the courts have determined and applied foreign law . . . ."); Hays v. Bryan Cave LLP, 446 F.3d 712, 714 (7th Cir. 2006) ("[T]here is nothing unusual about a court having to decide issues that arise under the law of other jurisdictions . . . ."); Miller v. Pilgrim's Pride Corp., 366 F.3d 672, 674 (8th Cir. 2004) ("[F]ederal courts regularly apply the laws of foreign jurisdictions . . . ."); Sanchez v. U.S. Airways, Inc., No. CIV.A. 99-6586, 2001 WL 793304, at *3 n.2 (E.D. Pa. July 13, 2001) ("[C]ourts are required to apply the law of other jurisdictions every day . . . ."); Engel v. W.R. Berkley Corp., No. CIV.3:00CV1779-H, 2001 WL 238113, at *8 (N.D. Tex. Mar. 6, 2001) ("Courts are frequently called upon to apply the laws of other jurisdictions in diversity cases . . . ."); De Lage Landen Fin. Servs., Inc. v. Cardservice Int'l., Inc., No. CIV. A. 00-2355, 2000 WL 1593978, at *2 (E.D. Pa. Oct. 25, 2000) ("Federal judges routinely apply the law of various jurisdictions.").

[394] Dreyfuss, *supra* note 1, at 45; Gholz, *supra* note 8, at 316; Schaffner, *supra* note 3, at 1201.

Federal Circuit law in their briefs.[395] Furthermore, for complicated evidentiary rulings likely to arise during trial, parties could make use of motions in limine.[396] Parties could thus educate the district court on the Federal Circuit's procedural law using briefs in support of these motions in limine, giving district court judges adequate time to learn and properly apply Federal Circuit law.[397] Finally, district-court judges likely would not have difficulty applying Federal Circuit law to procedural issues that arise during trial.[398]

[395] For example, full briefing is the normal practice for pre-trial motions such as motions to dismiss or for summary judgment, as well as for post-trial motions such as motions for a new trial or judgment as a matter of law.

[396] *See* Charles W. Gamble, *The Motion* in Limine: *A Pretrial Procedure That Has Come of Age*, 33 ALA. L. REV. 1, 8 (1981); *cf.* Gentry v. Mangum, 466 S.E.2d 171, 180 (W. Va. 1995) ("Rule 103(c) of the [West Virginia] Rules of Evidence permits and encourages pretrial motions *in limine* as the appropriate procedure for determining the admissibility of time consuming and difficult evidentiary issues.").

[397] Gamble, *supra* note 396, at 8. Motions in limine for these types of evidentiary issues are useful because

> [t]he motion *in limine* has the advantage of raising evidentiary issues prior to trial that the judge might otherwise be called upon to decide during the heat and hurry of litigation. This less hurried pace, especially when the motion is accompanied by a brief or memorandum, should permit the trial judge a greater opportunity to study the question in light of the cited authorities.

Id. (footnotes omitted).

[398] To address the concern that it would be too difficult for district court judges to apply unfamiliar Federal Circuit law to procedural issues that arise during the heat of trial, the proposal to apply Federal Circuit law to all procedural issues could be modified. Under this modified proposal, courts would apply Federal Circuit law to all procedural issues except those that a district court judge must make "on the fly" at trial, such as the admissibility of evidence. *See* Friendly, *supra* note 4, at 407 n.6. District court judges would thus be able to apply familiar regional-circuit law to issues that arise at trial. And district court judges would have to apply Federal Circuit law only to issues where the "concern that district courts not be required to apply two sets of substantive or procedural laws during trial, depending on the appellate path ultimately taken, [would] not [be] at issue." Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 859 (Fed. Cir 1991);

These issues are likely to be simpler than those with which the district-court judge would have already dealt in motions in limine. And Federal Circuit procedural law likely would not differ from regional-circuit law for many issues, making it easy for district court judges to apply Federal Circuit law. Thus, district court judges would be fully capable of properly applying Federal Circuit law to all procedural issues in patent cases.

Therefore, the proposal that the Federal Circuit apply its own law to all procedural issues would advance the interests of achieving nationwide uniformity in patent cases, increasing predictability, reducing forum shopping, allowing the Federal Circuit to avoid overspecialization, and increasing the Federal Circuit's opportunities to use its independent judgment. Although this proposal has potential drawbacks, these drawbacks are likely not enough to offset the advantages of adopting this proposal.

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see also Manildra Milling Corp. v. Ogilvie Mills, Inc., 76 F.3d 1178, (Fed. Cir 1996) (citing *Biodex*, 946 F.2d at 859) ("In the present case, however, the impact on the district court's management of an ongoing trial will not be great because the . . . issue arises only after the trial has been completed. Thus, defining this term as a matter of Federal Circuit law does not interfere with the district court's ability to manage the majority of the trial according to regional circuit law.").

This modified proposal has the advantage of being for a bright-line rule, and it better fulfills the interest of the district courts in uniformity in trial management and applying familiar law. However, this modified proposal also has several important disadvantages. For example, although this modified proposal is for a bright-line rule, it might be more confusing and difficult to apply than the straightforward proposed rule in which the Federal Circuit would always apply its own law to procedural issues. It also seems somewhat arbitrary to make choice-of-law determinations based on when an issue arises during litigation. Additionally, this modified proposal might be subject to something akin to forum shopping where parties might seek favorable Federal Circuit law for trial issues by filing motions in limine they otherwise might not file. Furthermore, this modified proposal would not advance the interest of nationwide uniformity in procedural law in patent cases, it would not reduce forum shopping as much as applying Federal Circuit law to all procedural issues would, and it would also not fulfill the Federal Circuit's interest in avoiding overspecialization and using independent judgment as much as applying Federal Circuit law to all procedural issues would. Thus, this modified proposal is likely not superior than the proposal to apply Federal Circuit law to all procedural issues.

CONCLUSION

Because of its unique jurisdiction, the Federal Circuit faces a unique situation with respect to choice of law for procedural issues in patent cases. The court's current rule is to apply the law of the regional circuit to an issue unless that issue sufficiently implicates substantive patent law. However, the Federal Circuit has not consistently articulated this rule. Accordingly, the court has not applied this rule consistently. Indeed, both intra- and inter-issue inconsistencies have arisen.

Instead, the Federal Circuit should apply its own law to all procedural issues in patent cases, even if those issues are not related to substantive patent law. This solution would advance the interests of achieving nationwide uniformity in patent cases, increasing predictability, reducing opportunities for forum shopping, and allowing the Federal Circuit to avoid overspecialization and increase its opportunities to use its independent judgment. Although under this solution, district courts would have to apply relatively unfamiliar Federal Circuit law to procedural issues in patent cases instead of more-familiar regional-circuit law, the benefits of this proposed solution outweigh the disadvantages. Indeed, district courts today already must apply Federal Circuit law to some procedural issues. However, because of the Federal Circuit's inconsistent application of its choice-of-law rules, district courts today often do not know which law to apply. Thus, district court judges would benefit from the predictability that this solution would bring. And district court judges are up to the task. District court judges are just as competent and capable of applying Federal Circuit law to procedural issues as the Federal Circuit judges are of applying regional-circuit law to particular procedural issues. Finally, patent litigants would benefit greatly from the nationwide uniformity and

increased predictability that this solution would bring. Therefore, the Federal Circuit should decide en banc to apply its own law to all procedural issues in patent cases.