

Federal Court Has Exclusive Jurisdiction Over Legal Malpractice Action Arising Out of Patent Infringement Claim

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Jan 26, 2012

[Minton v. Gunn, ___ S.W.3d ___, 2011 WL 6276121 \(Tex. 2011\)](#)

Brief Summary

The Supreme Court of Texas held that federal courts have exclusive jurisdiction over a legal malpractice claim arising out of underlying patent infringement litigation.

Complete Summary

A former client brought a state law legal malpractice action against his former attorney, alleging that the lawyer had negligently failed to timely plead and brief the experimental-use exception to an on-sale bar to patentability of the client's software in the client's underlying patent infringement claim. After the trial court granted summary judgment to the former attorney, the client appealed. The appellate court affirmed summary judgment.

The Supreme Court of Texas held that the resolution of a federal issue of the applicability of the experimental-use exception was necessary in the legal malpractice claim, and that the exception was a disputed and a substantial issue in the legal malpractice case. After analyzing the requirements of federal jurisdiction under *Grable & Sons Metal Prods., Inc. v. Darue Eng'g & Mfg.*, 545 U.S. 308, and the U.S. Court of Appeals for the Federal Circuit's 2007 decisions in *Air Measurement Technologies, Inc. v. Akin Gump Strauss Hauer & Feld, LLP*, 504 F.3d 1262 (Fed. Cir. 2007) and *Immunocept, LLP v. Fulbright and Jaworski, LLP*, 504 F.3d 1281 (Fed. Cir. 2007), the Supreme Court of Texas ultimately held that the former client's legal malpractice action arising out of the underlying patent infringement claims was within the exclusive jurisdiction of the federal courts.

Significance of Opinion

This opinion is noteworthy for the fact that along with the majority of courts that have addressed this issue, the Supreme Court of Texas held that legal malpractice claims arising out of patent infringement claims fall within the exclusive jurisdiction of the federal courts, as long as a substantial and disputed issue of patent law is at issue.

For further information, please contact [Terrence P. McAvoy](#).

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