SMU Science and Technology Law Review

Volume 14 | Number 2 Article 9

January 2011

EDTX and Transfer of Venue: Move Over, Federal Circuit - Here is the Fifth Circuit's Law on Transfer of Venue

Patrick E. Higginbotham

Keynote Address

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Move Over, Federal Circuit—Here is the Fifth Circuit's Law on Transfer of Venue

Symposium on Emerging Intellectual Property Issues:

Eastern District of Texas and Patents

Keynote Speaker:

The Honorable Patrick E. Higginbotham, U.S. Court of Appeals for the Fifth Circuit

INTRODUCTION BY DEAN JOHN B. ATTANASIO, SMU DEDMAN SCHOOL OF LAW:

DEAN ATTANASIO: My name is John Attanasio, and I am the Dean of the SMU Dedman School of Law. I would like to welcome you all to our fabulous annual Conference on Intellectual Property conducted by the wonderful and effervescent, Professor Xuan-Thao Nguyen.

Here at SMU Dedman School of Law, we have made a very strong commitment to Intellectual Property. Everyone knows Professor Xuan-Thao Nguyen's reputation. Xuan-Thao has published twenty-two articles and five books. This is her second major conference this semester. The other one is a conference about video games which I personally enjoy, as I am a video games aficionado.

With Xuan-Thao, we are building one of the finest intellectual groups in the country. We have hired two people. One is Keith Robinson, who practiced for seven years at Foley & Lardner, and was a Duke double enrollee as well as a Duke lawyer. The other one is here today. David Taylor has a masters in engineering from Texas A&M, and then he went to Harvard Law School. He worked for seven years at Baker Botts and clerked for the Federal Court of Appeals for the Federal Circuit. We are delighted to add David to our faculty. We also have some of the finest adjuncts in the country teaching at the Law School. Bart Showalter, our own graduate, heads up the IP department at Baker Botts and I am happy to say he has taught here at SMU the entire time I have been here.

At this time, I would like to introduce a dear and wonderful friend of mine and of the law school—Judge Patrick Higginbotham. Judge Higginbotham attended the University of Texas at Arlington and Austin and received his bachelor of arts. He then received his LL.B. from the University of Alabama. Following graduation from law school, he served for three years as Judge Advocate General in the United States Air Force.

In 1964, Judge Higginbotham went into private practice with the Dallas firm of Coke & Coke—where his work was focused on trials and appeals, with one stint as a special prosecutor. In 1975, President Gerald Ford appointed him to the United States District Court for the Northern District of Texas, making him the youngest sitting federal judge in the United States. In 1982, he was appointed to the United States Court of Appeals for the Fifth Circuit by President Ronald Reagan, and he continues to serve on that court.

He has been a tireless mentor and leader as well as a highly-sought-after instructor, lecturer and writer on many very important legal topics. He wrote a critical article in the *SMU Law Review* years ago regarding the work and caseloads of the federal courts, which was based on a keynote address he delivered at the American Law Institute. Judge Higginbotham received a tremendous standing ovation for that keynote address.

Judge Higginbotham has lectured on many topics over time. He served for many years as a faculty member of the Federal Judicial Center and as an adjunct professor and visiting distinguished professor at many different institutions. He has taught Federal Jurisdiction, First Amendment Law, Constitutional Law, and Constitutional Structure at Texas Tech University Law School, the University of Texas Law School, and the University of Alabama Law School—his alma mater. He currently teaches at Saint Mary's Law School. I am proud to say he has taught here at the SMU Dedman School of Law as well for a number of years. It is my great pleasure and honor to welcome back to the law school, Judge Patrick Higginbotham.

JUDGE HIGGINBOTHAM: Thank you, Dean. I started first teaching out here at SMU as an adjunct in 1965. Alan Bromberg was obligated to continue teaching the course Complex Securities Litigation, and then Alan accepted a visiting professorship out at Stanford and left me teaching by myself. I had originally agreed to teach the class together with him. I continued on until recently when I moved my chambers down to Austin, but I continue my long association with SMU. I told Dean Attanasio that if you chart the LSATs, the GPAs, and the other judges of measure, it is a straight up and down line, and I wish that was my stock portfolio. The numbers date back to a time when the law school was blessed by Dean Attanasio joining the institution. He has brought great energy and creativity to the school. He is a nationally recognized scholar. He also blends with other skills, and that skill set in combination is unique, and the Law School is blessed to have him here. His reputation goes across the pond as well. He is well known to the European Court of Justice and to the other legal institutions at a time when it is critical to have those connections.

This morning I sat in on a wonderful panel. I enjoyed listening to this discussion about the Eastern District of Texas. One of the speakers made a comment that jumped out at me. He said you need to talk to these people, and try to find out a story in order to tell patent lawyers how to try a case, or to make a general suggestion that you need a story or a narrative line. Well, there is nothing unique to patent cases.

The ability of a lawyer to communicate depends very much on his ability to find a narrative line. I grew up in the Deep South in Texas where storytelling is part of the culture. Oral history and that form of communication is very powerful. It is also the most powerful teaching tool. Good classroom teachers will take these complex matters and spin them into a story about a narrative line. Lawyers have the ability to discern and to read what they see from a jungle of facts. When you go down to a doctor and have a test for your color vision, they put up on the wall a chart with many pixels. If you can see a seven in that set of numbers, you know you are being tested for the color green. If you see an eight in the chart, you know it is there. But it is the ability of the eye to look at this empty set of meaningless pixels and to see and combine into something of a story. A lawyer has that ability. So do other professions and occupations that have such a quality, the ones that succeed. The ones that can look at this jumble of facts and technical data and take them and see in them a human story. The law is simply not about the abstraction of this particular unique device or chemical formula. It is somewhat about that, but there is also a story in there. There was always a narrative line that put together this particular set of facts, and a good trial lawyer will succeed in that ability.

One of the things I want to do with you first is share a couple of stories from the outset, because in telling you these stories I can then share with you their message and demonstrate to you what a story can do. The first one is a bit exciting, and the second one is a bit lighter.

This first story is a story about a retired Senior Master Sergeant from the United States Marine Corps who, as a boy, had learned to play the bagpipes. He carried that on from time to time in his career. When he finally retired, people recognized his ability and invited him to come and play the bagpipes at the funerals of the boys who came home and the older ones that had passed away. He would go to these funerals and play the bagpipes. For those of you who have had the opportunity to attend those funerals, you know that the music is moving. The man received a call that a service was to be held out at the deceased soldier's family ranch. The man was not exactly sure how to get there. He left to go to the service, and on the way he became confused about this rural route. He lost his way, and he became very worried that time was fleeting. He just wanted to get there. Then, he came around a bend in the road and saw a road going up the hill. He saw this gathering of people and realized, "That's it!" He turned, went in, and said: "I have missed the service." Men were standing around the site with shovels about to dig the grave. He then wondered what he should do. He told himself that he plays for both the deceased and the survivors. He decided to play for the deceased. He took out his material and equipment. The workers stopped and lay on their shovels. He looked at the workers and they nodded to him. He played *Amazing Grace* with such beauty that he started to tear up. The workers started to cry. Everybody cried as he played the beautiful song in tribute. He concluded and then put his gear back together. He turned and walked back. He looked down and saw the concrete encasement. As he walked away, he

heard one of the workers turn to the other one and say: "You know, I've been digging these septic tanks for fifty years . . ."

That is a story about perception and misperception. I want to talk to you about perception and misperception because it flies all over this discussion about transfer cases. What people think *is* out there. What they have heard *is* out there. What they want to believe *is* out there. It is all about perception.

Here is the second story. Some years ago, the gray wolf was placed on the Endangered Species List. I happen to be a fan of wolves. I have read about them, studied them, and admired them. I have not seen a real wolf up close very often, however.

In Wyoming, out in the country, there was a real tension between the ranchers and those people who saw the wolves in a different light—as a creature that needed to be protected. Some saw the wolves through the scope of a .30-30 rifle, and others saw them as loveable, dog-like animals. This tension manifested itself into a political fight. In an effort to quell this collision of forces between the environmental interests and the ranchers, the government issued money to a university to study the problem and at least put the problem on the political backburner before it came back. The money went to the university, and the university did with the monies what they normally do with grant monies: they studied the problem until the grant money ran out. At the conclusion of when the term had run, the university was required to report to the community the results of their study.

So on a Tuesday evening in the cold fall in Cheyenne, three professors came down. This was a small town. They held a meeting in a small room in one of the multi-purpose schoolhouse facilities where there was an auditorium and basketball court, and where PTA meetings were held. On stage was something covered by a tarp. The professors showed up and explained what they had done. They looked into the audience that was predominantly men with a few women who were ranchers. They unveiled this contraption. They said: "You see, this is what happens. You put the bait down at this end, and the wolf walks in from the other end. Then the contraption closes on the wolf, and then you castrate the wolf." There was total silence. Finally, a hand went up and a rancher got to his feet. He was a little nervous. He had his sweat-stained Stetson and his pressed jeans on. The rancher said: "Mister, I appreciate you coming out here and helping us. Mister, I have to say to you that you don't seem to understand the problem. Them wolves, sir, they's *eating* the calves." From that narrative comes this relevant point: if you do not know the problem, your chances of getting the response to the perceived difficulty is greatly reduced.

We put these two stories together, and we come to the question of transfers. A little bit of history helps tremendously to understand the question of transfers. In 1955, at that moment in time, the United States Supreme Court had decided two decisions about *forum non conveniens*. One of them was the famous *Gilbert* decision which enumerated the various factors and considerations to be deployed in considering whether to transfer a case to an-

other court.[1] Of course, you remember that under *forum non conveniens*, before a court decides the maintenance of that case before it—although venue was properly laid—the case should not go forward if the judgment would result in a dismissal of the case. Because dismissal could well result in cessation of the case and be time-barred, the rules were stringent and it was difficult to obtain transfer.

Against that backdrop, Congress enacted section 1404.[2] Immediately there was a debate that in section 1404, the purpose was plainly to provide a means for transfer of cases at the federal level among district courts, to give the power to the United States District Court judges to make that transfer under circumstances which would not carry the same kind of risks that it did under *forum non conveniens*. You can transfer it to another jurisdiction where venue also could have been laid, but it was a transfer and not a dismissal. It certainly did facilitate that transfer by escaping *forum non conveniens*.

The question remained that—if Congress gave us this great guidance—when Congress adopted the measure, Congress said "convenience to the parties, witnesses, and in the interest of justice." Those words have been said by one jurist to be incomprehensible in so far as they were either creating views or you were asking them to be used to decide a case. The question is, "What do they mean?" By using those words—the convenience of the parties, the convenience of the witnesses, and the interests of justice—did Congress incorporate and carry with them the underlying principles of *forum non conveniens*, and to what extent is that so? This divided the courts and within two years of the statute being enacted—keeping in mind that the statute was enacted against the backdrop of *Gilbert* and its companion case—the question reached the United States Supreme Court.[3] Justice Minton wrote for the Court, and Justice Harlan was recused. What the Court decided was that Congress had not incorporated the principles of *forum non conveniens*, although the underlying standards of *forum non conveniens* were brought forward—including a weight to be given to the choice of forum by the plaintiff themselves.

There we have a decision point that comes at the crossroads of the development of the adoption of transfer in 1955, in which the Court plainly sets aside one part of what happened in the law by rejecting a proposed interpretation. There was a dissent in the case written by Justice Clark, and the dissenting justices said they were offended by this notion that these transfers might be conveyed to other districts.

We have come forward over time, and this is now a question of what circumstances a judge should consider in making that decision. We know that the courts always know that the trial court always has discretion—a discretion to decide what is in the interest of justice and what is relevant to the

1. Gulf Oil Corp. v. Gilbert, 330 U.S. 501 (1947).

2. 28 U.S.C. § 1404.

3. Norwood v. Kirkpatrick, 349 U.S. 29 (1955).

convenience of the parties and the witnesses. If we go forward to more recent times, we have seen the Eastern District of Texas emerge as one of the country's choicest sites for patent cases. Many people have said: "What in the world do a bunch of hicks out there know about these cases? They can hardly string a barbwire fence. They are unsophisticated." This is the perception of why so many people are going to the Eastern District. Let me make a suggestion to you about what brought the people there initially, and it is very basic.

I say this to you, and I am now fifty years in the bar. Since I was licensed, I have been in one court or another for that whole time. I have been in Marshall. I have been there as a lawyer. I have been there as a judge. My granddaddy died practicing law on the square in Marshall. I know how to get to Marshall. I showed horses in Marshall. I drive down there. I know something about Volkswagens passing the site. It happens to be five minutes from the Eastern District of Texas, right out here on the LBJ Freeway—and it actually happened. I threw rocks into the Eastern District of Texas. A hundred and forty miles! For heaven's sake, a witness can drive a hundred and forty miles! Well, within the Northern District of Texas—when I was a judge in Dallas—I would have to fly an hour and a half to get to Lubbock in order to handle cases in the Northern District of Texas. It takes as long to drive from Dallas to Fort Worth to try cases sometimes as it does to drive to Marshall, but then a lot of people really do not know those distances. That is not my point. It is not to quarrel with an opinion of our Court. I accept it. It is an opinion that sharply divided our Court, but it sharply divided our Court primarily in the matter of the application of these principles. There is a difference one can say about the weight that should be given to plaintiff's choice, but it is the application of those principles where the Court parted company.

In fairness to the majority opinion, they correctly stated the principles and I agree with all of that, but where the two differ is in the application. Judge King writes a powerful dissent.[4] Judge Jolly writes a very clear majority opinion. There you have it. What is going on there? The problem is that suddenly then, with the Federal Circuit—because it adheres to the laws of the Circuit itself—the litigants certainly received the idea that the Fifth Circuit has really expressed itself, and we can get out of the Federal Circuit if we really want to. The Federal Circuit rapidly got a flock of motions to transfer in the Circuit, and then the Federal Circuit undertook those. They granted the first several of the motions since they were strong cases for transfer. Then they started denying some of the motions, so that it sort of evens out. The question that must be fairly asked is this: what is driving that? Can it really be that this large fight is over whether it is more convenient for witnesses coming in from New York to go on to Marshall or whether they are going to stay in Dallas? What is it? What is the great concern about it? If we are talking about just the extra expense of going over to Marshall, why

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

would you not just say that it is a different judge and they will understand and have a better deal for these kind of things? We will let them decide since it's a matter of discretion. It seems to me that what is in force here is this—and it is part of a larger picture so there is no need for bifurcating it. What this is part and parcel of is a change in the very culture of the United States District Court. It is no longer a trial court in many parts of the country. I have said it and I mean it, but it functions more like a state highway department. They will not try cases. More fundamentally, they will not set the cases for trial because the parties will mediate this case, and if I do not set it for trial, eventually it will settle. And settlement is a better reconciliation, because this is about relationships.

No it is not! It is about property, it is about money, and it is about serious disputes that are vital to the economy and need to be resolved fairly and straight up. Well, what is the injustice that is being perceived here? And I think there is a perception. I think that what is happening is that there is a perception of injustice, of something untoward going on, that has an unfairness about it. Let's put that briefly in perspective.

What about forum shopping? The United State Supreme Court has said—and it is fundamentally the case—that when the plaintiff decides to file suit and lacks venue, he does not do so with an open and generous heart, he does so out of the thought of finding the best place for himself. And the defendant looks at it and says: "If he thinks that is the best place for him, it is probably not the best place for me, maybe I should not be there." They make their own assessment. But the law gives them the right to make that choice. There is nothing illegal, improper, or unjust about a plaintiff deciding to go to a forum where he thinks a jury is more generous—whether he is right or he is wrong—where he thinks the judges are better, or whether he just thinks "that is where I want to be." If there is a flaw in that, it lies with the venue statute.

Now let me just point something out here. The Federal Circuit could have looked at the venue law and said: "Well, we read this to be the same as its own jurisdiction, you can file anywhere you want to, and we preside over this whole domain. And hence the venue is waived, legally it is proper to file there." There has always been a qualification that the courts have enforced, too, that you cannot really vex or harass a person. So it follows that if the plaintiff chooses a forum that he or she or it has no relationship to, the forum is a remote distance, and they have a big pocket book, then it would look like what they were really trying to do is vex or harass the other party. But at least when you start with a set of cases in which the plaintiff is filing in their home district, it would be very, very difficult to say that there is any vexing or harassing happening.

But today the question of what is a home district for a multi-national corporation, in a practical sense, is less than plain. It is a question of witness expense and cost. When you are spending one or two million dollars up to the trial date, that is enough to not really need to worry about the six cents per gallon increase in gasoline. They are worried instead about the question

of relative advantage. Some of the defendants here are persuaded. Some of the people who did not want to go there are persuaded they do not want to be there. Let me first suggest to you why so many try there. Perhaps it is because they had the erroneous view that this particular forum was a giveaway, and that they would in fact get better results there. With that said, I think that the reason that they went there is a very practical one, and it includes several facts of what I said earlier. And that reason is that the judges there have decided that they would run the docket the old-fashioned way. They would get the lawyers in, they would find out how much time they needed, and they would put the case on a track toward trial with a firm trial date. That has been abandoned for many districts in this country, and it is a huge mistake. Because the discipline of having a track toward trial shapes a lot of the development of discovery. It shapes the trial preparation itself. The destination of a decision is enormously important.

Now what happens, of course, is that it is very favorable to a business that may have property—the entitlement of which is being challenged—to bring that resolution either by an agreement with the other side, or having another party determine it. The business needs that done as promptly, and quickly, and as surely as it can be done. That is a very attractive forum. That is a very powerful magnet, particularly when the other district was not offering that. Interestingly enough, when the other districts evaluate this anomaly, for example, of why they chose the other districts—I fairly welcome that. But that is an old-fashioned way of running a docket. I take nothing away from the judges of the Eastern district, because they grew up the way same as I did. That is why I run a trial docket in Dallas the same way as all the other judges. I did not invent it. That is the way it is. It works.

Well, you cannot have it that way with complex cases. I tried complex cases. I tried antitrust cases, securities cases, and indentured company cases. Most of them were week-long trials. And I always wanted a jury, incidentally. I learned as a young lawyer to never trust a judge completely. It was not because they did not understand things. Rather, it was because the judge—by the nature of his business experiences—has all kinds of doors that close when he looks at the cases. For example, the judge says: "Oh, this is another one of these XYZ cases. I have seen a thousand of these things." Well, you don't know it, and the doors close before you. And I never cared for that. I always thought I could talk to the jury and explain to them the difference between injury to competition and injury to a competitor. But there is this perception that somehow there is injustice in these words of the statute at the end of this question, poured into the perception of limits of the choice of the forum. And they say that the limit in one or more circumstances is very powerful.

As we have seen through the mounds of trials in this country, we have increasingly reduced the number of people who are competent to try the cases. I saw that as a lawyer trying antitrust cases, and as I ran into the New York Bar. I found out in a hurry that the last thing they wanted to talk about was trial, and that quickly became the first thing I wanted to talk about. So what has happened is that you now have the patent bar which is a technical

field. I was trying cases as a district judge in patent cases, and the patent bar did not exactly bring a set of trial skills in general. There were a few that were very good, but many of them were very competent engineers. It would be hard for them to find an area. So what happens is that you have a district that follows the rules. If it is a material fact issue it goes to trial. That is not a disaster. That is the way you run the system. Summary judgment was simply for those cases in which you could not settle. It is not the other way around. What has happened in this country is the destination point of litigation is summary judgment. In most districts the destination is not trial. Then what happens to a set of lawyers highly skilled in their patent field who have never tried a lawsuit, if they really own up to the bar and they have a responsibility for that? Such lawyers get thrown into a district in which they face the decimation of trial.

Now one of two things is going to happen: they are going to settle that case, or they are going to have to get some other lawyer to try that case. Do not underestimate the fear of counsel's inability to try lawsuits as a substantial factor in running to escape from a jurisdiction that will put you to trial. Maybe I do not know what I am talking about. That would not be the first time. But you know in your hearts that I speak the truth. So what is happening if you look around? We have new barristers—people who can try lawsuits, and who can put these things together. And they are the ones who are going to be trying cases. It is a smaller number of people. It is not just the patent bar we are talking about. This phenomenon of the demise of trial has huge consequences, and to me this is just one of the manifestations.

So you have the perception of counsel that this is a bad place to be. As part of that, the bugaboo then becomes juries. Many think: "Oh, juries are unpredictable. We cannot depend on that. It is down in East Texas for heaven's sake, we cannot be there." Well, that perception ought to be defensible empirically. As I have read the data, the Eastern District Texas has a higher complete affirmance rate than any of the other districts, period. Well maybe those juries do not know what they are doing, and maybe the judges do not know what they are doing, but that means the Federal Circuit does not know what it is doing, I guess. The wins are balanced. Yes, we speak of jurors down there that value property. Heaven help us. Where does the property lie in this thing?

I was in Albania doing a little government work and sitting there right after Secretary Baker was there. We were sitting at the table and I was talking about First Amendment freedom to the leadership of the new Albanian government. They faced much oppression under Communist regimes for many, many years. It was a terribly poor country. Seated across the table from me was a man who is about my age now, who was scarred from having cigarettes put out in his face while he was in prison. He was a political prisoner who was now free. He did not say much over the three days I was talking on and on about First Amendment freedoms and the Bill of Rights and constitutional issues. The man reached into his pocket and pulled out a slip opinion. I looked at that, and he said through his interpreter: "This is what liberty is about." I looked at it and it was a condemnation decision

written by Justice Scalia, regarding property down in Charleston, South Carolina, where they were going to take the property. And I said: "What do you mean?" He said: "When the government cannot take my property without compensation, that is the root of all other liberties."

So when someone tells me that the survey shows that the folks down in East Texas value property, does this create an injustice to have a case tried there? Is it unjust for somebody to elect to file there because of those values? When you transfer the case out of East Texas on the basis that you are going to save this defendant from an unjust system that cannot be supported by any empirical data, what you are doing is simply giving an advantage to the defendant. Because he wants to bury you—at least to the extent that you are applying the question of relative convenience to parties and witnesses in the sense of which you push it too hard.

The bottom line is that I think that we are working our way through this problem. I think that the Federal Circuit reads *Volkswagen* correctly.[5] That does not set the tone overall for any great principal. It is simply a case where parties started to disagree over the application of some rather amorphous standards and they came out differently. One can argue for both sides of those standards.

But I also say to you that judges, just like lawyers, can fall victim to perceptions and myths. Some may think they are burying a long-lost friend or comrade, when it is actually a septic tank. And some may think that they have the solution to the problem of the wolves. But until you understand the problem, you may not get the answer right.

I really appreciate this job immensely. I love lawyers. I miss the trial court very much. I went over to say "hello" to Judge Barbara Lynn. She was an intern for me when I was in private practice, and she was a star then, too. She would prove to be a very good district judge. We have many of the other judges here. Maybe that is why I like the Northern District of Texas, we get people like that. I am proud of every one of these judges. I know every one of these judges in the Eastern District of Texas. I am not just up here to tell you nice things about these people. They are dedicated jurists, and they call it like they see it. Judge T. John Ward is stepping down. I have known Judge Ward since private practice and am sorry to lose him. I will just single him out for a moment among the really fine circuit judges. I sat with him for ten years deciding redistricting cases. These are politically sensitive issues to say the least. We redrew the thirty-two congressional districts two or three times. Together, we redrew the districts for the state house and the state senate, and we worked closely with that. This is a judge that brings to the task the question of "what is the law?" And then he decides that is the law, and that is the way he is going to apply it. That is true when I look at the opinions of this court, without any exceptions. Do I think they make some mistakes? Yes, they make mistakes, they are like me.

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

As a district judge, I looked at it this way—I am sure Barbara does, and T.J. does, and all these guys do—in general there are three situations that are possible when I rule and then the appellate court rules. If they overrule me, either: I made a mistake, or they made a mistake, or the law changed. And those particular categorizations were not of equal size.

DEAN ATTANASIO: Someday Judge, I will have to go to a lecture you give that does not get a standing ovation. He has a perfect record in his lectures that I have attended, and I am sure all of us appreciate it. Thank you very much for that brilliant lecture. It was very informative as always and very much appreciated, as you can tell, by all of us in the room.