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# The New Federal Circuit Mandamus

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# THE NEW FEDERAL CIRCUIT MANDAMUS

PAUL R. GUGLIUZZA\*

This Article explores an ongoing revolution in the mandamus jurisprudence of the U.S. Court of Appeals for the Federal Circuit, the court of appeals with nearly exclusive jurisdiction over patent cases. Before December 2008, the Federal Circuit had never used the interlocutory writ of mandamus to order a district court to transfer a case to a more convenient forum, denying each one of the twenty-two petitions it had decided on that issue. Since that time, however, the court has overturned eleven different venue decisions on mandamus. Remarkably, ten of those eleven cases have come from the same district court, the U.S. District Court for the Eastern District of Texas. This use of mandamus to repeatedly overturn discretionary, non-appealable rulings of one district court is unprecedented in any federal court of appeals. What makes the Federal Circuit's cases particularly notable is that the court, not long ago, would grant mandamus only on issues governed by Federal Circuit patent law. Because transfer of venue is a non-patent issue controlled by regional circuit law, the recent cases plainly would not warrant mandamus under the court's prior, narrower standard. The court's focus on the Eastern District of Texas is also interesting because of the popular view that the Eastern District is biased in favor of patent holders and denies transfer motions with impunity.

This is the first article to analyze the Federal Circuit's retreat from its original, restrained view of mandamus. It begins by considering why the Federal Circuit initially believed it could grant mandamus on patent issues only, a question previously ignored by the literature. The Article then explores why, in its recent cases, the court has abandoned the view that Federal Circuit mandamus should be limited to issues of patent law. Surprisingly, the Federal Circuit has never explained its reasoning. The Article fills this analytical void and develops a doctrinal, theoretical, and pragmatic rationale for Federal Circuit mandamus on non-patent issues. The Article also offers possible explanations for the Federal Circuit's fixation on the Eastern District of Texas and proposes a new analytical framework for Federal Circuit mandamus—a framework that might emerge if the court were to critically examine its mandamus power.

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## INTRODUCTION

The Federal Circuit's aggressive use of the extraordinary writ of mandamus is making headlines.<sup>1</sup> Under the final judgment rule, litigants in federal court must typically wait to appeal until the district court case is completely resolved.<sup>2</sup> By filing a mandamus petition with an appellate court, however, a litigant may seek immediate review of a district court ruling, even if the district court case remains ongoing.<sup>3</sup> Because mandamus provides an escape hatch from the final judgment rule and can significantly disrupt proceedings in the district court, the Supreme Court has warned that mandamus "is a 'drastic and extraordinary' remedy 'reserved for really extraordinary causes.'"<sup>4</sup>

Consistent with this stringent legal standard, the Federal Circuit, the court of appeals with nearly exclusive jurisdiction over patent cases, grants only about ten

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1. See, e.g., Elizabeth Durham, *Will All Roads Still Lead to the Eastern District of Texas? Transfer Practice After Volkswagen and TS Tech*, 21 INTELL. PROP. & TECH. L.J., July 2009, at 12; Patrick E. Higginbotham, Keynote Address, *EDTX and Transfer of Venue: Move Over, Federal Circuit—Here Is the Fifth Circuit's Law on Transfer of Venue*, 14 SMU SCI. & TECH. L. REV. 191 (2011); Josh Jacobson, *Venue Transfers and Writs of Mandamus: An Emerging Trend*, 30 A.B.A. APPELLATE PRAC. J., Spring 2011, at 11; Mark Liang, *The Aftermath of TS Tech: The End of Forum Shopping in Patent Litigation and Implications for Non-Practicing Entities*, 19 TEX. INTELL. PROP. L.J. 29, 30-32 (2010); Donald W. Rupert & Daniel H. Shulman, *Clarifying, Confusing, or Changing the Legal Landscape: A Sampling of Recent Cases from the Federal Circuit*, 19 FED. CIR. B.J. 521, 523-41 (2010); Recent Case, *Federal Circuit Heightens Standard for Plaintiff Presence That Will Weigh Against Transfer*: In re Zimmer Holdings, Inc., 609 F.3d 1378 (Fed. Cir. 2010), 124 HARV. L. REV. 632, 632 (2010); Jeremiah L. Hart, Note, *Supervising Discretion: An Interest-Based Proposal for Expanded Writ Review of § 1404(a) Transfer of Venue Orders*, 72 OHIO ST. L.J. 139, 174-78 (2011); Elizabeth P. Offen-Brown, Note, *Forum Shopping and Venue Transfer in Patent Cases: Marshall's Response to TS Tech and Genentech*, 25 BERKELEY TECH. L.J. 61, 62-63 (2010); Megan Woodhouse, Note, *Shop 'til You Drop: Implementing Federal Rules of Patent Litigation Procedure to Wear Out Forum Shopping Patent Plaintiffs*, 99 GEO. L.J. 227, 240-44 (2010); Li Zhu, Note, *Taking Off: Recent Changes to Venue Transfer of Patent Litigation in the Rocket Docket*, 11 MINN. J. L. SCI. & TECH. 901, 906-09 (2010).

2. See 28 U.S.C. §§ 1291, 1295(a)(1) (2006) (granting the courts of appeals jurisdiction to review "final decisions" of the district courts).

3. Mandamus is, of course, not the only way to appeal a non-final decision in federal court. Other methods of interlocutory appeal include: (1) pursuing an appeal under 28 U.S.C. § 1292, which explicitly permits interlocutory appeals from a defined class of district court orders; (2) pursuing an appeal under 28 U.S.C. § 1291 through the collateral order doctrine; (3) appealing an order on class certification under Federal Rule of Civil Procedure 23(f); and (4) appealing under any rule promulgated by the U.S. Supreme Court that provides an exception to the final judgment rule, as permitted under 28 U.S.C. § 1292(e). See MICHAEL E. TIGAR & JANE B. TIGAR, FEDERAL APPEALS JURISDICTION AND PRACTICE 65-66 (3d ed. 1999).

4. Cheney v. U.S. Dist. Court, 542 U.S. 367, 380 (2004) (quoting *Ex parte Fahey*, 332 U.S. 258, 259-60 (1947)).

percent of the mandamus petitions it decides.<sup>5</sup> One issue that parties frequently seek to have reviewed on mandamus is whether the district court properly granted or denied a motion to transfer a district court case to a more convenient venue under 28 U.S.C. § 1404(a).<sup>6</sup> Before December 2008, however, the Federal Circuit had never granted a mandamus petition to overturn a transfer decision, denying each one of the twenty-two petitions it had decided on that issue.<sup>7</sup> It is therefore surprising that the Federal Circuit has, on ten occasions since December 2008, granted mandamus to order the U.S. District Court for the Eastern District of Texas to transfer a patent case.<sup>8</sup> During this same time period, the Federal Circuit denied with prejudice ten other petitions from the Eastern District that challenged venue decisions.<sup>9</sup> This represents a comparatively astronomical grant rate of fifty percent. In reviewing the decisions of other district courts, by contrast, the Federal Circuit has largely continued its traditional reluctance to order transfer, denying all but one petition challenging a venue decision.<sup>10</sup>

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5. See *infra* note 16 and accompanying text.

6. See 16 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3935.4 (2d ed. 2011); see also 28 U.S.C. § 1404(a) (2006) (“For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.”).

7. See *infra* note 16 and accompanying text.

8. See *In re* Biosearch Techs., Inc., Misc. No. 995, 2011 WL 6445102 (Fed. Cir. Dec. 22, 2011); *In re* Morgan Stanley, 417 F. App’x 947 (Fed. Cir. 2011) (per curiam); *In re* Verizon Bus. Network Servs. Inc., 635 F.3d 559 (Fed. Cir. 2011); *In re* Microsoft Corp., 630 F.3d 1361 (Fed. Cir. 2011) (per curiam); *In re* Acer Am. Corp., 626 F.3d 1252 (Fed. Cir. 2010); *In re* Zimmer Holdings, Inc., 609 F.3d 1378 (Fed. Cir. 2010); *In re* Nintendo Co., 589 F.3d 1194 (Fed. Cir. 2009); *In re* Hoffmann-La Roche Inc., 587 F.3d 1333 (Fed. Cir. 2009); *In re* Genentech, Inc., 566 F.3d 1338 (Fed. Cir. 2009); *In re* TS Tech USA Corp., 551 F.3d 1315 (Fed. Cir. 2008); see also *In re* Oracle Corp., 399 F. App’x 587, 590 (Fed. Cir. 2010) (granting mandamus, ordering the Eastern District of Texas to conduct a new § 1404(a) analysis under the proper legal standard).

9. See *In re* Apple Inc., Misc. No. 103, 2012 WL 112893 (Fed. Cir. Jan. 12, 2012); *In re* Simpson Strong-Tie Co., 417 F. App’x 941 (Fed. Cir. 2011) (per curiam); *In re* Google Inc., 412 F. App’x 295 (Fed. Cir. 2011); *In re* Wyeth, 406 F. App’x 475 (Fed. Cir. 2010); *In re* Vistaprint Ltd., 628 F.3d 1342 (Fed. Cir. 2010); *In re* Echostar Corp., 388 F. App’x 994 (Fed. Cir. 2010); *In re* Apple Inc., 374 F. App’x 997 (Fed. Cir. 2010) (per curiam); *In re* VTech Commc’ns, Inc., Misc. No. 909, 2010 WL 46332 (Fed. Cir. Jan. 6, 2010); *In re* Volkswagen of Am., Inc., 566 F.3d 1349 (Fed. Cir. 2009); *In re* Telular Corp., 319 F. App’x 909 (Fed. Cir. 2009).

10. The court granted mandamus in *In re Link\_A\_Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011) (per curiam), ordering the case transferred from the District of Delaware to the Northern District of California. Since deciding *TS Tech* in December 2008, the court has denied eight mandamus petitions on venue matters in cases arising from courts besides the Eastern District. See *In re* Bd. of Regents of the Univ. of Tex. Sys., 435 F. App’x 945 (Fed. Cir. 2011); *In re* Xoft, Inc., 435 F. App’x 948 (Fed. Cir. 2011); *In re* Vertical Computer Sys., Inc., 435 F. App’x 950 (Fed. Cir. 2011); *In re* Leggett & Platt, Inc., 425 F. App’x 903 (Fed. Cir. 2011); *In re* Aliphcom, 449 F. App’x 33 (Fed. Cir. 2011); *In re* Voter Verified, Inc., Misc. No. 936, 2010 WL 1816686 (Fed. Cir.

The use of mandamus to supervise the decisions of one district court, the Eastern District of Texas, on one particular issue, transfer of venue, is unprecedented in any federal court of appeals. Indeed, it conforms to no theory of appellate mandamus currently recognized by the literature or by the courts. Commentators have previously identified a “supervisory” theory, under which mandamus serves a didactic purpose by correcting one instance of a significant, erroneous district court practice.<sup>11</sup> But the Federal Circuit’s *repeated* correction of the Eastern District’s discretionary transfer decisions does not fit the supervisory theory, as previously understood. Accordingly, I coin the phrase “supervisory plus” mandamus to describe the aggressive form of writ review recently employed by the Federal Circuit.

Not only is the Federal Circuit’s use of supervisory plus mandamus historically unprecedented, it is at odds with the court’s own case law. In its early days, the Federal Circuit at times disclaimed supervisory authority over district courts and refused to grant mandamus on any issue that did not implicate the court’s patent law, including transfer of venue.<sup>12</sup> The court’s focus on the Eastern District is particularly interesting because of the popular view that the Eastern District is biased in favor of plaintiff-patent holders and denies defendants’ transfer motions with impunity.<sup>13</sup> Even Justice Scalia has criticized the Eastern District, calling it a “renegade jurisdiction[.]” for habitually ruling in favor of patent-infringement plaintiffs.<sup>14</sup>

Remarkably, commentators have not explored the Federal Circuit’s retreat from its original, restrained view of mandamus. In fact, this Article is the first comprehensive study of mandamus in the Federal Circuit.<sup>15</sup> To better understand the evolution of Federal Circuit mandamus, I reviewed every available mandamus decision that the Federal Circuit has issued since Congress created the court in 1982, amounting to over 400 cases.<sup>16</sup> This survey confirmed that

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May. 3, 2010); *In re Affymetrix, Inc.*, Misc. No. 913, 2010 WL 1525010 (Fed. Cir. Apr. 13, 2010) (per curiam); *In re Pfizer Inc.*, 364 F. App’x 620 (Fed. Cir. 2010).

11. See Note, *Supervisory and Advisory Mandamus Under the All Writs Act*, 86 HARV. L. REV. 595, 610 (1973) [hereinafter *Supervisory and Advisory Mandamus*].

12. See *In re Innotron Diagnostics*, 800 F.2d 1077, 1082-85 (Fed. Cir. 1986).

13. See *infra* Part III.A.

14. Transcript of Oral Argument at 11, *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (No. 05-130).

15. Cf. Charles L. Gholz, *CAFC Review of Interlocutory Decisions*, 67 J. PAT. & TRADEMARK OFF. SOC’Y 417, 422-37 (1985) (reviewing and critiquing mandamus decisions from the first three years of the court’s existence).

16. To complete this survey, I reviewed every case (both precedential and not) in the Westlaw Federal Circuit database (CTAF) containing the word “mandamus.” A complete list of the decisions reviewed is on file with the author and supports the statistical assertions made in this Article. Although the exact precision of the Article’s calculations might be affected by decisions not contained in Westlaw’s database, any gaps in coverage appear to be relatively minimal, especially for cases decided in 2000 and after. The research in this Article is current through February 2012.

mandamus has been and remains a difficult remedy to obtain in the Federal Circuit. From 2000 through 2010, the Federal Circuit granted only 23 of the 215 mandamus petitions it decided.<sup>17</sup> Considering the high legal standard for mandamus relief, which is reflected in this data, the Federal Circuit's supervision of the Eastern District's venue decisions is an aberration.

Before examining the Federal Circuit's recent interest in the transfer decisions of the "renegade" Eastern District, however, I begin by uncovering the origins of the Federal Circuit's initial view that it could consider only patent issues on mandamus, a task that no scholar has yet undertaken. I attribute that view in part to the limited appellate subject-matter jurisdiction of the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, and in part to the Federal Circuit's idiosyncratic view that it does not derive its mandamus authority from the same source as the regional circuit courts of appeals.

I then explain why the Federal Circuit was wrong to limit mandamus to patent issues only. In recent years, the court has, in fact, issued mandamus on non-patent issues, such as transfer of venue and the attorney-client privilege.<sup>18</sup> But it has offered only strained readings and unpersuasive distinctions of its older case law, causing the leading treatise on federal jurisdiction and procedure to bemoan the "unsettled" relationship between Federal Circuit and regional circuit writ authority.<sup>19</sup> I fill the analytical void that the Federal Circuit has left by explaining why, as a normative matter, it is beneficial for the Federal Circuit to issue mandamus on non-patent questions. I suggest that Federal Circuit mandamus on these issues simplifies the Federal Circuit's jurisdictional inquiry, helps reduce forum shopping, provides valuable doctrinal guidance to district courts and other interested parties, and helps the Federal Circuit avoid undue specialization.

Because the Federal Circuit has not engaged fundamental questions about the proper scope of mandamus, the court has unthinkingly drifted toward a standard under which it will grant mandamus on any legal question, whether controlled by regional circuit law or Federal Circuit patent law, if the petition satisfies the substantive criteria established by the Supreme Court for granting the writ.<sup>20</sup> In other words, the Federal Circuit's mandamus analysis now resembles that of the regional circuits: The Federal Circuit immediately considers the merits of the

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17. See *supra* note 16 and accompanying text.

18. See, e.g., *In re* TS Tech USA Corp., 551 F.3d 1315 (Fed. Cir. 2008) (granting mandamus on issue of transfer); *In re* Regents of the Univ. of Cal., 101 F.3d 1386 (Fed. Cir. 1996) (granting mandamus on issue of attorney-client privilege).

19. 15A WRIGHT ET AL., *supra* note 6, § 3903.1.

20. See *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 380-81 (2004) (noting that "three conditions must be satisfied before [the writ] may issue": (1) "the party seeking issuance of the writ [must] have no other adequate means to attain the relief he desires"; (2) "the petitioner must satisfy the burden of showing that [his] right to issuance of the writ is clear and indisputable"; and (3) "the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances" (second and third alterations in original) (citations omitted) (internal quotation marks omitted)).

petition without first considering any possible subject-matter limitation.

But, as the Federal Circuit's older mandamus case law recognized, the court is different from the regional circuits in two important respects. First, the Federal Circuit has a unique choice-of-law regime. It applies its own law to questions of substantive patent law, to procedural issues unique to patent law, and to questions of its own jurisdiction.<sup>21</sup> It applies the law of the relevant regional circuit to all other questions.<sup>22</sup> Second, the Federal Circuit has a unique jurisdictional structure, which is nationwide in geographic scope, but, as relevant to this Article, limited in subject matter to cases arising under the patent laws.<sup>23</sup> By skirting its older mandamus case law, rather than confronting it, the Federal Circuit has missed the opportunity to analyze whether these unique characteristics should inform the standard for mandamus relief.

The court's refusal to engage questions about its mandamus power is emblematic of a broader criticism of the Federal Circuit: The court refuses to acknowledge the policy questions that undergird its decisions, resulting in a jurisprudence that is insufficiently sensitive to economic and social concerns.<sup>24</sup> The court's hesitance to explicitly account for fundamental questions of policy leads to doctrinal problems that are well illustrated by the recent venue cases from the Eastern District of Texas: The lack of a clear normative objective may have led the Federal Circuit to vary the applicable legal rules from case to case and to reach different results in factually similar cases.<sup>25</sup>

If the Federal Circuit were to critically examine the role of mandamus in the federal scheme for resolving patent disputes, a clearer, more refined framework for granting the writ might emerge. This framework would account for the uniqueness of the Federal Circuit and the court's superior understanding of the realities of patent litigation. Under the reconceptualized framework for Federal Circuit mandamus that I propose, the court would freely grant mandamus to answer novel and important legal questions that are intertwined with the patent law and that regularly evade appellate review. As for non-patent questions, the Federal Circuit would capitalize on its unique position as the forum for nearly all patent appeals filed nationwide. It would issue mandamus when this unique perspective can provide a useful teaching moment for district courts.

Had the Federal Circuit applied this approach in its recent venue cases, it might have noticed that the Eastern District is, perhaps, not as much of a "renegade jurisdiction" as Justice Scalia and conventional wisdom perceive it to be. Recent studies have undermined the view that it is impossible for defendants

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21. See Joan E. Schaffner, *Federal Circuit "Choice of Law": Erie Through the Looking Glass*, 81 IOWA L. REV. 1173, 1192, 1201 (1996).

22. See *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1573-75 (Fed. Cir. 1984) (per curiam).

23. See 28 U.S.C. §§ 1295(a)(1), 1338(a) (2006).

24. See, e.g., Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1671-75 (2003).

25. See *infra* Part III.B.



to obtain transfer out of the Eastern District.<sup>26</sup> Given the Federal Circuit's nearly exclusive jurisdiction over patent cases, this is something that the Federal Circuit should have known and that could have tempered its decision to take the unprecedented step of granting mandamus ten times in a little over three years. In three more recent venue cases, however, the Federal Circuit has correctly employed its extensive experience with the Eastern District's patent docket, identifying attempts by plaintiffs to manipulate the transfer analysis and recognizing that judicial familiarity with pertinent technology can outweigh considerations of convenience.<sup>27</sup> There is thus some reason to believe that a more thoughtful model of mandamus is emerging in the Federal Circuit.

That said, in December 2011, the court for the first time used mandamus to order a court *besides* the Eastern District of Texas to transfer a patent case.<sup>28</sup> And, in many recent cases, the Federal Circuit has granted or denied mandamus by analogizing or distinguishing its own case law, even though the petitions raise only non-patent issues supposedly governed by regional circuit law.<sup>29</sup> The potential for continued expansion in the Federal Circuit's use of the writ and the large body of precedent the court has created in such a short time underscore the need for a critical assessment of the proper role of mandamus in patent cases.

A brief word on the scope of this Article. The Federal Circuit reviews many decisions besides patent cases from the federal district courts.<sup>30</sup> For example, the court hears appeals from the Patent and Trademark Office, the Court of Federal Claims, and the International Trade Commission, among others.<sup>31</sup> The Federal Circuit sometimes fields mandamus petitions directed toward these other tribunals. And the Federal Circuit has, with very few exceptions, exclusive appellate jurisdiction over those tribunals.<sup>32</sup> By contrast, the authority to review district court judgments is split between the Federal Circuit (in cases arising under the patent laws) and the regional circuits (in all other cases).<sup>33</sup> It is this split of authority that creates the complex jurisdictional, legal, and policy issues that have caused confusion in the Federal Circuit about the proper standard for mandamus relief.<sup>34</sup> Accordingly, this Article focuses primarily on the Federal

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26. See *infra* Part III.A.

27. See *In re* Microsoft Corp., 630 F.3d 1361 (Fed. Cir. 2011) (per curiam); *In re* Vistaprint Ltd., 628 F.3d 1342 (Fed. Cir. 2010); *In re* Zimmer Holdings, Inc., 609 F.3d 1378 (Fed. Cir. 2010).

28. See *In re* Link\_A\_Media Devices Corp., 662 F.3d 1221 (Fed. Cir. 2011) (ordering transfer from the District of Delaware to the Northern District of California).

29. See, e.g., *In re* Apple Inc., Misc. No. 103, 2012 WL 112893 (Fed. Cir. Jan. 12, 2012); *In re* Biotech Techs., Inc., Misc. No. 995, 2011 WL 6445102 (Fed. Cir. Dec. 22, 2011).

30. See generally Paul R. Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 GEO. L.J. (forthcoming 2012) (manuscript at 27-28) (summarizing the Federal Circuit's non-patent jurisdiction), available at <http://ssrn.com/abstract=1945039>.

31. See 28 U.S.C. § 1295(a) (2006 & Supp. 2010).

32. See *id.*

33. See *id.* §§ 1291, 1295(a)(1), 1338.

34. See *In re* Innotron Diagnostics, 800 F.2d 1077, 1083 n.10 (Fed. Cir. 1986) (noting that "[t]he problem of 'serving two masters' does not arise in" cases appealable only to the Federal

Circuit's mandamus jurisprudence in district court patent cases.

The Article proceeds in four parts. Part I provides an overview of mandamus, examining the writ's history from its royal genesis to its present day use as a mechanism of interlocutory appellate review. Part II uncovers the origins of the Federal Circuit's initial view that it could issue mandamus on patent issues only and shows how the Federal Circuit has abandoned that initial view without providing any reasons for doing so. Part III analyzes the Federal Circuit's recent, pathbreaking venue decisions, develops the theory of supervisory plus mandamus, and shows how the recent decisions underscore the need for a reconceptualization of Federal Circuit mandamus. Part IV outlines a rationale for Federal Circuit mandamus on non-patent issues, explores the benefits that would result if the court were to explicitly consider the justifications I outline, and considers some possible limitations on mandamus that are specific to the Federal Circuit. I conclude by urging the court to develop a mandamus framework that acknowledges the Federal Circuit's unique role in the federal system.

#### I. A PRIMER ON APPELLATE MANDAMUS

Mandamus, which literally means "we command,"<sup>35</sup> was one of the prerogative or extraordinary writs of the common law.<sup>36</sup> In short, mandamus requires the person or persons against whom it issues to take (or to refrain from taking) some specified action.<sup>37</sup> Mandamus can be issued by a court against a public official, or by a higher court against a lower court.<sup>38</sup>

Mandamus issued by a higher court against a lower court, referred to as appellate mandamus, is an extraordinary event, especially in the federal court system. By statute, the federal courts of appeals have jurisdiction to review only "final decisions" of the district courts.<sup>39</sup> Through mandamus, however, a litigant may obtain review of district court orders that do not finally resolve the case, often referred to as interlocutory orders. Mandamus thus provides an important escapeway from the final judgment rule. A mandamus petition is, however, potentially disruptive to judicial efficiency because the district court case continues while the appellate court decides the mandamus petition.

Because of this potential for disruption, appellate mandamus had a very limited role in the English common law system and, until the 1950s, in the

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Circuit).

35. BLACK'S LAW DICTIONARY 1046 (9th ed. 2009).

36. Other prerogative writs included prohibition, certiorari, quo warranto, and habeas corpus. See 1 DAN B. DOBBS, LAW OF REMEDIES § 2.9(1) (2d ed. 1993); Edward Jenks, *The Prerogative Writs in English Law*, 32 YALE L.J. 523, 527 (1923).

37. The extraordinary writ that restrains a person from taking some action is technically the writ of prohibition. But modern parlance has combined prohibition and mandamus under the label "mandamus." See TIGAR & TIGAR, *supra* note 3, at 185.

38. See DOBBS, *supra* note 36, § 2.9(1).

39. 28 U.S.C. § 1291 (2006).

American federal system. Appellate mandamus traditionally would issue only to fix errors of a “jurisdictional” nature.<sup>40</sup> Since the late 1950s, however, mandamus has served a much broader function in the federal appellate courts, issuing to correct significant or repeated district court errors on important questions of law, whether jurisdictional or not.<sup>41</sup> To appreciate the Federal Circuit’s struggle with this broader function of appellate mandamus, it is important to first understand the writ’s origins, its current use in appellate practice, and two prominent theories of modern appellate mandamus, “supervisory” and “advisory” mandamus.

### A. Origins of Appellate Mandamus

1. *Mandamus at Common Law.*—The origins of the writ of mandamus are “very obscure,” as one American court noted over a century ago.<sup>42</sup> Mandamus appears to have originated in the personal command (or prerogative) of the English King.<sup>43</sup> In the sixteenth century, however, mandamus emerged as a judicial remedy available to subjects and the Crown alike.<sup>44</sup> It issued on direct petition from the Court of King’s Bench and typically ordered a public authority to carry out a legal duty.<sup>45</sup> This judicial writ “gradually supplanted the old[er] personal command of the sovereign.”<sup>46</sup>

In the sixteenth and seventeenth centuries, “the writ of mandamus was used primarily to compel public authorities to return petitioners . . . to public offices from which they had been unlawfully removed.”<sup>47</sup> Sir Edward Coke’s 1615 opinion for the King’s Bench in *Bagg’s Case*,<sup>48</sup> which is often cited as the “well-head of [m]andamus,”<sup>49</sup> is emblematic of the early use of the writ for restorative purposes. James Bagg, one of the chief burgesses of the borough of Plymouth, had been removed from office for speaking ill of the mayor, Bagg’s fellow burgesses, and other officials.<sup>50</sup> Issuing the writ, Coke emphasized that the borough had acted beyond its authority by removing Bagg without providing him

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40. 16 WRIGHT ET AL., *supra* note 6, § 3932.

41. *See infra* Part I.B.

42. *In re Lauritsen*, 109 N.W. 404, 408 (Minn. 1906).

43. *See* 1 CHESTER JAMES ANTIEAU, *THE PRACTICE OF EXTRAORDINARY REMEDIES* § 2.00 (1987); Leonard S. Goodman, *Mandamus in the Colonies—The Rise of the Superintending Power of American Courts*, 1 AM. J. LEGAL HIST. 308, 309 (1957); S.A. de Smith, *The Prerogative Writs*, 11 CAMBRIDGE L.J. 40, 40-41 (1951).

44. 1 ANTIEAU, *supra* note 43, § 2.00. S.A. de Smith notes that the first reported case involving a judicial writ of mandamus that served a similar purpose to the modern writ was *Middleton’s Case*, (1573) 73 Eng. Rep. 752 (K.B.). *See* de Smith, *supra* note 43, at 50.

45. WILLIAM WADE & CHRISTOPHER FORSYTH, *ADMINISTRATIVE LAW* 616 (9th ed. 2004).

46. *Lauritsen*, 109 N.W. at 409.

47. 1 ANTIEAU, *supra* note 43, § 2.00.

48. (1615) 77 Eng. Rep. 1271 (K.B.).

49. Jenks, *supra* note 36, at 530 (italics omitted); *see also* 1 ANTIEAU, *supra* note 43, § 2.00.

50. *Bagg’s Case*, 77 Eng. Rep. at 1275.

notice and an opportunity to object.<sup>51</sup>

By the early eighteenth century, the writ had developed a broader use than simply restoring public officials to office.<sup>52</sup> Mandamus would issue not only against executive officials, but also against inferior courts.<sup>53</sup> Just as mandamus in *Bagg's Case* restrained the *ultra vires* act of the borough, mandamus would restrain courts from exercising powers beyond their jurisdiction.<sup>54</sup> The writ would also compel courts to exercise jurisdiction with which they had been vested.<sup>55</sup> Blackstone explained:

[Mandamus] issues to the judges of any inferior court, commanding them to do justice according to the powers of their office, whenever the same is delayed. For it is the peculiar business of the court of king's bench to superintend all inferior tribunals, and therein to enforce the due exercise of those judicial or ministerial powers, with which the crown or legislature have invested them: and this not only by restraining their excesses, but also by quickening their negligence . . . .<sup>56</sup>

Mandamus would not, however, lie to correct a decision that was *intra vires*, but erroneous.<sup>57</sup> In other words, mandamus was not a substitute for appellate review.<sup>58</sup>

2. *American Beginnings.*—Early American courts and the first U.S. Congress imported the view that mandamus was an extraordinary remedy designed to fix only jurisdictional errors. Sections 13 and 14 of the Judiciary Act of 1789 codified the federal courts' mandamus power.<sup>59</sup> Section 13 addressed, among other things, the power of the Supreme Court to issue extraordinary writs. It provided that “[t]he Supreme Court . . . shall have power to issue . . . writs of mandamus . . . in cases warranted by the principles and usages of law, to any courts appointed, or persons holding office, under the authority of the United States.”<sup>60</sup> Section 14 similarly vested in the lower federal courts the power to issue mandamus, providing that they “shall have power to issue writs of scire facias, habeas corpus . . . and all other writs not specially provided for by statute,

51. *Id.* at 1280-81.

52. *See de Smith, supra* note 43, at 51.

53. *Id.*

54. *See id.* at 56.

55. *See id.* at 51.

56. 3 WILLIAM BLACKSTONE, COMMENTARIES \*110.

57. *See The Queen v. Justices of London*, [1895] 1 Q.B. 616, 637; *The King v. Justices of Monmouthshire*, (1825) 107 Eng. Rep. 1273, 1275 (K.B.); HALSEY H. MOSES, *THE LAW OF MANDAMUS* 29-30 (1878) (citing cases).

58. *See generally* WADE & FORSYTH, *supra* note 45, at 623 (“Refusal to consider a party’s case . . . has to be distinguished from refusal to accept his argument. . . . If the inferior court or tribunal merely makes a wrong decision within its jurisdiction, . . . mandamus cannot be employed to make it change its conclusion.”).

59. Judiciary Act of 1789, ch. 20, §§ 13, 14, 1 Stat. 73, 80-82.

60. *Id.* § 13, 1 Stat. at 81 (italics omitted).

which may be necessary for the exercise of their respective jurisdictions, and agreeable to the principles and usages of law.”<sup>61</sup>

In view of the requirement that mandamus issue only when consistent with “the principles and usages of law,” the Supreme Court in the eighteenth and nineteenth centuries generally permitted the use of mandamus in the same manner as English courts at common law.<sup>62</sup> The Court also approved mandamus directed to judges of inferior courts.<sup>63</sup> But a litigant could not use a mandamus petition to challenge the correctness of a non-final decision. In other words, mandamus was not a means to evade the rule that only final judgments may be appealed.<sup>64</sup> As the Court noted in *Kendall*, “mandamus does not direct the inferior court *how* to proceed, but only that it *must* proceed, according to its own judgment, to a final determination,” which could then be appealed.<sup>65</sup>

In 1911, Congress recodified the federal courts’ power to issue extraordinary writs.<sup>66</sup> But this recodification simply confirmed the prevailing practice. The notes to the revised sections indicated that, under the new statute, mandamus would remain a means by which a court could “direct a subordinate Federal court to decide a pending cause,”<sup>67</sup> but would “not perform the office of an appeal or writ of error.”<sup>68</sup>

Congress again reorganized and consolidated the judicial code in 1948.<sup>69</sup> In this recodification, the All Writs Act took its present form. Congress eliminated the separate provisions governing mandamus in the Supreme Court and the inferior courts and replaced them with 28 U.S.C. § 1651, which reads (in relevant

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61. *Id.* § 14, 1 Stat. at 81-82 (italics omitted).

62. *See, e.g.*, *United States ex rel. Dunlap v. Black*, 128 U.S. 40, 48 (1888) (noting that mandamus would issue when executive officials “refuse to act in a case at all” or refuse to exercise “a mere ministerial duty”); *Kendall v. United States ex rel. Stokes*, 37 U.S. (12 Pet.) 524, 614, 621 (1838) (approving mandamus directed toward the U.S. Postmaster General); *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 173 (1803) (holding that mandamus was the proper remedy by which William Marbury could seek to compel delivery of his commission as a justice of the peace).

63. *See, e.g.*, *Ex parte Bradstreet*, 32 U.S. (7 Pet.) 634, 648-50 (1833) (mandamus would order an inferior court to reinstate a case that it had dismissed); *Ex parte Crane*, 30 U.S. (5 Pet.) 190, 194 (1831) (mandamus would compel a judge to sign a bill of exceptions); *Ex parte Wood*, 22 U.S. (9 Wheat.) 603, 614-15 (1824) (mandamus would compel a district judge to conduct a trial on the issue of patent validity).

64. *See Bank of Columbia v. Sweeny*, 26 U.S. (1 Pet.) 567, 569 (1828) (Marshall, C.J.) (noting that issuing mandamus to review an interlocutory order “would be a plain evasion of the provision of the Act of Congress, that *final* judgments only should be brought before this Court for re-examination”).

65. *Kendall*, 37 U.S. (12 Pet.) at 622 (emphasis added); *accord* *Gaines v. Relf*, 40 U.S. (15 Pet.) 9, 17 (1841); *Ex parte Hoyt*, 38 U.S. (13 Pet.) 279, 290 (1839); *Ex parte Whitney*, 38 U.S. (13 Pet.) 404, 408 (1839).

66. Judicial Code of 1911, ch. 231, § 234, 36 Stat. 1087, 1156.

67. *Id.* § 234 note.

68. *Id.* § 262 note; *accord id.* § 234 note.

69. Pub. L. No. 80-773, 62 Stat. 869 (1948); *see* S. REP. NO. 80-1559, at 1 (1948).

part): “The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.”<sup>70</sup> Nothing in the legislative history suggests that Congress intended a substantive change to writ practice.<sup>71</sup> The Supreme Court confirmed that the All Writs Act did not affect the courts’ power to issue mandamus.<sup>72</sup> Yet, less than a decade after Congress passed the Act, the federal courts began to use the new statute to justify appellate review of a wide variety of interlocutory orders previously unreviewable under the final judgment rule.

3. *A Coda for the Traditional View.*—As discussed, the Supreme Court had long limited appellate mandamus to (1) “confining” inferior courts to their “prescribed jurisdiction” and (2) “compelling” inferior courts to exercise jurisdiction “when it is [their] duty to do so.”<sup>73</sup> The Court was not referring to “jurisdiction” in a technical sense, however. Rather, the Court’s rule referred to a “more flexible notion of ‘power.’”<sup>74</sup> If a district court “took some definable action [it] was not empowered to take . . . or refused to take some definable action [that] . . . was clearly required,” the error was considered “jurisdictional,” and mandamus would correct it.<sup>75</sup> For example, appellate mandamus would compel a district judge to sign a bill of exceptions (so that an appeal could be taken),<sup>76</sup> to issue a bench warrant,<sup>77</sup> and to unseal deposition testimony and exhibits.<sup>78</sup> In these cases, the lower court had not refused jurisdiction in the modern, technical sense, “*i.e.*, the . . . statutory or constitutional power to adjudicate the case.”<sup>79</sup> It had simply refused to take an action that it had an

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70. 28 U.S.C. § 1651(a) (2006).

71. Rather, the legislative history suggests that Congress viewed as “unnecessary” the separate provisions governing Supreme Court mandamus and the more general writ power of the federal courts when it could accomplish the same effect through the more general and comprehensive language of the All Writs Act. See H.R. REP. NO. 80-308, at A144-45 (1947).

72. See *La Buy v. Howes Leather Co.*, 352 U.S. 249, 255 (1957) (“The recodification of the All Writs Act in 1948 . . . did not affect the power of the [c]ourts of [a]ppeals to issue writs of mandamus . . .”). But cf. *id.* at 265-66 (Brennan, J., dissenting) (noting that § 13 of the Judiciary Act of 1789 granted the Supreme Court power to issue writs of mandamus “in cases warranted by the principles and usages of law” and contrasting the All Writs Act, which is “restricted in its use to aiding the jurisdiction of the appellate court” (citing *In re Josephson*, 218 F.2d 174 (1st Cir. 1954) (Magruder, J.))).

73. *Ex parte Peru*, 318 U.S. 578, 583 (1943).

74. *Supervisory and Advisory Mandamus*, *supra* note 11, at 599.

75. *Id.*

76. *Ex parte Crane*, 30 U.S. (5 Pet.) 190, 194 (1831).

77. *Ex parte United States*, 287 U.S. 241, 250 (1932).

78. *Ex parte Uppercu*, 239 U.S. 435, 440-41 (1915).

79. *Steel Co. v. Citizens for a Better Env’t*, 523 U.S. 83, 89 (1998) (emphasis omitted). See generally Howard M. Wasserman, *The Demise of “Drive-By Jurisdictional Rulings,”* 105 Nw. U. L. REV. COLLOQUY 184, 184 (2011) (discussing the Supreme Court’s recent “uninterrupted retreat from the . . . ‘profligate’ and ‘less than meticulous’ use” of the word “jurisdiction” (quoting

unassailable legal duty to take.<sup>80</sup>

Notwithstanding its loose understanding of “jurisdiction,” the Court, throughout the first half of the twentieth century, insisted that mandamus could not be used to review mere errors of judgment.<sup>81</sup> Yet, at the same time, the Court’s decisions began to hint that mandamus might lie for errors less serious than usurpations of power or ignorance of clear legal duties. In *Ex parte Peru*, for example, the Court, citing the case’s “public importance and exceptional character,” issued mandamus to compel the release of a Peruvian steamship, overturning a district court ruling on sovereign immunity.<sup>82</sup> And in *Los Angeles Brush Manufacturing Corp. v. James*, the Court held that it could issue mandamus to prevent a district court from referring most of its patent cases to a special master.<sup>83</sup>

### B. Appellate Mandamus in the Modern Era

As the Court began to hint at a broader role for appellate mandamus, American civil litigation was beginning a dramatic evolution. The number of cases litigated to a final judgment after trial was declining.<sup>84</sup> Instead of going to trial, parties were increasingly using pretrial motions and the discovery process to “posture themselves for a hard-fought but unappealable settlement.”<sup>85</sup> In other words, cases were increasingly being resolved in ways that, under a strict construction of the final judgment rule, would bypass the appellate courts.

It is therefore not surprising that exceptions to the final judgment rule evolved as well.<sup>86</sup> For example, in the mid-twentieth century, the Supreme Court

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Arbaugh v. Y & H Corp., 546 U.S. 500, 510-11 (2006)).

80. See *United States*, 287 U.S. at 250 (“The authority conferred upon the trial judge to issue a warrant of arrest upon an indictment does not, under the circumstances here disclosed, carry with it the power to decline to do so under the guise of judicial discretion . . .”); *Uppercu*, 239 U.S. at 440 (noting the judge’s “duty” to permit the records to be unsealed); see also *Crane*, 30 U.S. (5 Pet.) at 193 (noting that no precedent existed in which a court issued mandamus to compel a judge to sign a bill of exceptions “because no judge did ever refuse to seal a bill of exceptions; and none was ever refused, because none was ever tendered like this, *so artificial and groundless*” (emphasis added) (internal quotation marks omitted)).

81. See *De Beers Consol. Mines, Ltd. v. United States*, 325 U.S. 212, 217 (1945) (“When Congress withholds interlocutory reviews, [mandamus] can, of course, not be availed of to correct a mere error in the exercise of conceded judicial power. But when a court has no judicial power to do what it purports to do—when its action is not mere error but *usurpation of power*—the situation falls precisely within the allowable use of [mandamus].” (emphasis added)).

82. *Ex parte Peru*, 318 U.S. 578, 586 (1943).

83. *L.A. Brush Mfg. Corp. v. James*, 272 U.S. 701, 706 (1927).

84. See Marc Galanter, *The Hundred-Year Decline of Trials and the Thirty Years War*, 57 STAN. L. REV. 1255, 1257-58 (2005).

85. Adam N. Steinman, *Reinventing Appellate Jurisdiction*, 48 B.C. L. REV. 1237, 1241 (2007).

86. See *id.* at 1240.

created the collateral order doctrine, which permits immediate appeal of orders that resolve crucial issues that are independent of the case's merits.<sup>87</sup> And, in a pair of mid-twentieth century cases, the Court introduced two new models for interlocutory mandamus relief: "supervisory" and "advisory" mandamus. After discussing those models, I conclude this part with a summary of current mandamus doctrine and practice.

1. *Supervisory Mandamus*.—Supervisory mandamus corrects "established bad habits" of the lower courts.<sup>88</sup> This model of appellate mandamus first explicitly appeared in *La Buy v. Howes Leather Co.*<sup>89</sup> In *La Buy*, the Seventh Circuit had issued mandamus to vacate the order of a district judge referring certain antitrust cases to a special master for trial.<sup>90</sup> The district judge, Judge La Buy, referred the cases because of their complexity, the projected length of the trial, and the congestion of the district court's calendar.<sup>91</sup> The Supreme Court affirmed the grant of mandamus, noting that Judge La Buy's reference to a special master "amounted to little less than an abdication of the judicial function depriving the parties of a trial before the court on the basic issues involved in the litigation."<sup>92</sup>

Given that district judges have wide discretion in referring cases to special masters, the assertion that Judge La Buy abdicated his judicial role is questionable.<sup>93</sup> Indeed, in the final portion of its opinion, the Court explicitly acknowledged the idea of supervisory appellate mandamus—the notion that mandamus could be used to strike down "one instance of a significant erroneous practice [that] the appellate court finds is likely to recur."<sup>94</sup> The Court noted that the district court had repeatedly referred cases to special masters, that the

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87. See *Cohen v. Beneficial Indus. Loan Corp.*, 337 U.S. 541, 546 (1949). While I refer to the collateral order doctrine as an exception to the final judgment rule, the Supreme Court has at times insisted that the doctrine "is 'best understood not as an exception to the 'final decision' rule laid down by Congress in § 1291, but as a 'practical construction' of it.'" *Will v. Hallock*, 546 U.S. 345, 349 (2006) (quoting *Digital Equip. Corp. v. Desktop Direct, Inc.*, 511 U.S. 863, 867 (1994)). But see *FirsTier Mortg. Co. v. Investors Mortg. Ins. Co.*, 498 U.S. 269, 274 n.3 (1991) ("An exception to [the final judgment rule] . . . is the 'collateral order doctrine,' which permits appeals under § 1291 from a small class of rulings that do not end the litigation on the merits." (citing *Cohen*, 337 U.S. at 545-47) (emphasis added)); *Coopers & Lybrand v. Livesay*, 437 U.S. 463, 468 (1978) ("To come within the 'small class' of decisions *excepted* from the final-judgment rule . . . , the order must conclusively determine the disputed question, resolve an important issue completely separate from the merits of the action, and be effectively unreviewable on appeal from a final judgment." (citing *Abney v. United States*, 431 U.S. 651, 658 (1977) (emphasis added))).

88. 16 WRIGHT ET AL., *supra* note 6, § 3934.1.

89. 352 U.S. 249 (1957).

90. *Id.* at 250-51.

91. *Id.* at 253.

92. *Id.* at 256.

93. See Charles Alan Wright, *The Doubtful Omniscience of Appellate Courts*, 41 MINN. L. REV. 751, 773-74 (1957).

94. *Supervisory and Advisory Mandamus*, *supra* note 11, at 610.



Seventh Circuit “for years” had admonished that trial courts should seldom refer cases to special masters, and that the Seventh Circuit was clearly at the “end of patience.”<sup>95</sup> The Supreme Court thus approved the use of mandamus to supervise and correct the district court’s bad habit, concluding that “supervisory control of the District Courts by the Courts of Appeals is necessary to proper judicial administration in the federal system” and that “[t]he All Writs Act confers . . . the discretionary power to issue writs of mandamus in the exceptional circumstances existing here.”<sup>96</sup>

Supervisory mandamus thus serves a “corrective and didactic function.”<sup>97</sup> As one commentator put it:

If the court finds that the order represents a practice that is likely to be repeated, it can overturn it whether or not the reason the practice is disapproved is that the lower court may be said to have been without “power” to enter a class of orders into which the order falls.<sup>98</sup>

2. *Advisory Mandamus*.—Only five justices joined the opinion in *La Buy*. Seven years later, however, eight justices joined the Court’s opinion in *Schlagenhauf v. Holder*,<sup>99</sup> which represented another expansion in the availability of mandamus. The case introduced the concept of “advisory” mandamus, which permits interlocutory review of novel and important legal questions.

*Schlagenhauf* arose from a tort suit by passengers of a bus that collided with a tractor-trailer.<sup>100</sup> The district court, on the motion of two defendants, had ordered a third defendant, the bus driver, to submit to a mental and physical examination.<sup>101</sup> The Seventh Circuit denied mandamus but the Supreme Court reversed.<sup>102</sup>

The Court noted in passing that the bus driver argued that the district court “lack[ed] . . . power” to order the examination.<sup>103</sup> But the Court emphasized that the challenged order was “the first of its kind,” and that the case presented a “basic, undecided question,” an “issue of first impression”: whether a defendant could be ordered to undergo examination upon the request of his co-defendants.<sup>104</sup> Under these “unusual” circumstances, the Court determined, mandamus was proper.<sup>105</sup>

Whereas supervisory mandamus helps cure repeated errors in the lower

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95. *La Buy*, 352 U.S. at 258.

96. *Id.* at 259-60.

97. *Will v. United States*, 389 U.S. 90, 107 (1967).

98. *Supervisory and Advisory Mandamus*, *supra* note 11, at 610-11.

99. 379 U.S. 104 (1964).

100. *Id.* at 106.

101. *Id.* at 108-09.

102. *Id.* at 109.

103. *Id.* at 110-11.

104. *Id.*

105. *Id.* at 110.

courts, “advisory mandamus is reserved for big game”<sup>106</sup>: “systemically important issue[s] as to which [the appellate] court has not yet spoken.”<sup>107</sup> Judge Bruce Selya, who has written several notable mandamus opinions,<sup>108</sup> has emphasized that mere novelty is not enough to justify advisory mandamus. Rather, the issue presented must also be “of great public importance, and likely to recur.”<sup>109</sup> In his view, advisory mandamus “should primarily be employed to address questions likely of significant repetition prior to effective review, so that [the court’s] opinion would assist other jurists, parties, or lawyers.”<sup>110</sup>

3. *Current Mandamus Doctrine and Practice.*—Even though *La Buy* and *Schlagenhauf* were not the Supreme Court’s final words on appellate mandamus, the supervisory and advisory models introduced by those cases form the theoretical backbone of modern mandamus doctrine. In the wake of those seminal cases, the Court appeared to retighten the availability of the writ, discounting the advisory rationale for issuing mandamus,<sup>111</sup> and contending that mandamus was inappropriate to review any discretionary decision of a district court.<sup>112</sup> In more recent cases, however, the Court has confirmed that mandamus is a proper remedy to supervise district court practices<sup>113</sup> and to overturn discovery orders that are adverse to claims of privilege.<sup>114</sup> Importantly, the courts of appeals have continued to use mandamus to resolve significant and novel legal issues,<sup>115</sup> and, contrary to the Supreme Court’s instruction, to supervise district

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106. *United States v. Horn*, 29 F.3d 754, 770 (1st Cir. 1994) (Selya, J.); *see also In re Bushkin Assocs., Inc.*, 864 F.2d 241, 247 (1st Cir. 1989) (Selya, J.) (advisory mandamus “is reserved for blockbuster issues, not merely interesting ones”).

107. *In re Atl. Pipe Corp.*, 304 F.3d 135, 140 (1st Cir. 2002) (Selya, J.).

108. *See In re Sony BMG Music Entm’t*, 564 F.3d 1 (1st Cir. 2009); *United States v. Green*, 407 F.3d 434 (1st Cir. 2005); *Atl. Pipe*, 304 F.3d 135; *In re Providence Journal Co.*, 293 F.3d 1 (1st Cir. 2002); *Horn*, 29 F.3d 754.

109. *Horn*, 29 F.3d at 769.

110. *Id.* at 770 (citation omitted) (internal quotation marks omitted).

111. *See Will v. United States*, 389 U.S. 90, 104 n.14 (1967) (distinguishing *Schlagenhauf*, noting that although the case presented “new and substantial” questions the issuance of mandamus was based “on the fact that there was real doubt whether the District Court had any power at all to order a defendant to submit to a physical examination”).

112. *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 36 (1980) (per curiam); *Will v. Calvert Fire Ins. Co.*, 437 U.S. 655, 665-66 (1978) (plurality opinion); *see also Kerr v. U.S. Dist. Court*, 426 U.S. 394, 405 (1976) (denying mandamus on an order compelling the production of privileged documents because of the possibility of in camera review).

113. *See Mallard v. U.S. Dist. Court*, 490 U.S. 296, 309-10 (1989) (overturning district court program requiring attorneys to represent indigent litigants as a condition of bar membership).

114. *See Mohawk Indus., Inc. v. Carpenter*, 130 S. Ct. 599, 607-08 (2009); *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 382-83 (2004).

115. *See, e.g., In re Asbestos Sch. Litig.*, 46 F.3d 1284, 1288 (3d Cir. 1994) (“Mandamus may be especially appropriate to further supervisory and instructional goals, and where issues are unsettled and important.”); *United States v. Bertoli*, 994 F.2d 1002, 1014 (3d Cir. 1993) (noting that mandamus review is appropriate “when fundamental undecided issues . . . implicate not only

court decisions on matters of discretion.<sup>116</sup> Thus, the Supreme Court's post-*La Buy* and *Schlagenhauf* case law has, in general, not impacted the courts of appeals' continued use of supervisory and advisory mandamus.<sup>117</sup>

Of course, there is no categorical distinction between the two theories, as a novel ruling that could initially warrant advisory mandamus may easily become a repeated error appropriate for supervisory mandamus.<sup>118</sup> Conversely, if a lower court's recurring practice is sufficiently "bad" to warrant supervisory mandamus, the court of appeals might not have addressed the issue.<sup>119</sup>

In short, under modern doctrine, the federal courts of appeals will use mandamus to settle important, usually undecided, issues that are likely to arise again in future cases and for which post-judgment review would be inadequate, inefficient, or impossible. Mandamus, used in this fashion, gives lower courts appellate guidance so that mandamus review is unnecessary in future cases raising the same issue.<sup>120</sup> By using the writ sparingly, appellate courts preserve, at least in part, the writ's historically extraordinary character, avoiding undue interference in lower court proceedings but sending a forceful message when the writ does issue.

Appellate courts also continue to issue mandamus for traditional, "jurisdictional" reasons.<sup>121</sup> And since appellate mandamus is a discretionary remedy, different courts have formulated different tests for the writ's issuance. The Supreme Court, for example, has repeatedly stated that "three conditions must be satisfied."<sup>122</sup> First, the party seeking the writ must have "no other

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the parties' interests but those of the judicial system itself"); *In re Société Nationale Industrielle Aérospatiale*, 782 F.2d 120, 123 (8th Cir. 1986) ("[M]andamus review may be appropriate to provide guidelines for the resolution of novel and important questions . . . that are likely to recur."), *vacated on other grounds sub nom. Société Nationale Industrielle Aérospatiale v. U.S. Dist. Court*, 482 U.S. 522 (1987).

116. Prime examples of cases reviewing on mandamus discretionary district court rulings are the venue decisions discussed in Part III.B, *infra*.

117. See *TIGAR & TIGAR*, *supra* note 3, at 193; 16 *WRIGHT ET AL.*, *supra* note 6, § 3934.1.

118. See *United States v. Horn*, 29 F.3d 754, 769 (1st Cir. 1994).

119. *Cf. Supervisory and Advisory Mandamus*, *supra* note 11, at 611 (suggesting that advisory mandamus is merely a variant of supervisory mandamus).

120. See *United States v. Hughes*, 413 F.2d 1244, 1249 (5th Cir. 1969), *vacated as moot sub nom. United States v. Gifford-Hill-Am., Inc.*, 397 U.S. 93 (1970); 16A *WRIGHT ET AL.*, *supra* note 6, §§ 3934, 3934.1.

121. See *supra* Part I.A; see, e.g., *Nixon v. Richey*, 513 F.2d 427, 430 (D.C. Cir. 1975) (per curiam) (ordering that a district judge must immediately consider an application to proceed before a three-judge district court: "We intimate no view as to what in this regard the District Judge should decide. We hold only that he must decide, and decide now."); see also *Sierra Rutile Ltd. v. Katz*, 937 F.2d 743, 751 (2d Cir. 1991) ("Should the district court continue in its refusal to vacate the stay and to exercise jurisdiction over this action upon proper application, such may be the circumstances under which a petition for mandamus might be appropriately . . . granted." (alteration in original) (citation omitted) (internal quotation marks omitted)).

122. *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 380 (2004); *accord Allied Chem. Corp. v.*

adequate means” to obtain the relief sought.<sup>123</sup> Second, the petitioner must show that its right to the writ is “clear and indisputable.”<sup>124</sup> Finally, the court must be satisfied, in its discretion, that the writ is “appropriate” under the circumstances.<sup>125</sup> Perhaps because the “appropriate”-ness standard is rather amorphous, the lower courts have developed more detailed frameworks.<sup>126</sup>

Today, courts review on mandamus a litany of issues, including orders regarding discovery (in particular, the attorney-client privilege);<sup>127</sup> orders regarding transfer of venue;<sup>128</sup> orders on the consolidation or severance of cases for trial;<sup>129</sup> temporary restraining orders;<sup>130</sup> orders denying a jury trial;<sup>131</sup> and judicial and attorney disqualification orders;<sup>132</sup> among many others.<sup>133</sup> The varied function of mandamus in modern appellate practice illustrates the writ’s evolution from its original use of fixing obvious “jurisdictional” errors to a mechanism for supervising district court practices and deciding novel legal issues. In the next part, I examine the evolution of mandamus in the Federal Circuit and how the Federal Circuit has struggled with the supervisory function of mandamus, both because of the court’s unique nationwide jurisdiction and its position as successor to a court of very limited function.

## II. MANDAMUS IN THE FEDERAL CIRCUIT

The limited appellate subject-matter jurisdiction of the Federal Circuit’s predecessor, the Court of Customs and Patent Appeals (CCPA), caused the CCPA to adopt a unique, issue-based framework for evaluating its mandamus

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Daiflon, Inc., 449 U.S. 33, 35-36 (1980) (per curiam); *Kerr v. U.S. Dist. Court*, 426 U.S. 394, 403 (1976).

123. *Cheney*, 542 U.S. at 380-81.

124. *Id.* at 381 (quoting *Kerr*, 426 U.S. at 403).

125. *Id.* (quoting *Kerr*, 426 U.S. at 403).

126. *See, e.g., Bauman v. U.S. Dist. Court*, 557 F.2d 650, 654-55 (9th Cir. 1977) (requiring the court to balance five factors in deciding whether to grant mandamus: (1) whether the party seeking the writ has another adequate means to seek to the desired relief; (2) whether the petitioner will suffer harm that cannot be remedied on appeal; (3) whether the district court’s order is “clearly erroneous as a matter of law”; (4) whether the district court’s error is “oft-repeated”; and (5) whether the district court’s order raises new or important problems or legal issues of first impression).

127. *See, e.g., In re BankAmerica Corp. Sec. Litig.*, 270 F.3d 639, 641 (8th Cir. 2001).

128. *See, e.g., infra* Part III.B. *See generally* 19 JAMES WM. MOORE ET AL., MOORE’S FEDERAL PRACTICE § 204.06[3][a] (Daniel R. Coquillette et al. eds., 3d ed. 2011) (“[T]ransfer orders may be reviewed by mandamus.”); 16 WRIGHT ET AL., *supra* note 6, § 3935.4 (discussing mandamus use in transfer of venue cases).

129. *See, e.g., Garber v. Randell*, 477 F.2d 711, 715 n.2 (2d Cir. 1973).

130. *See, e.g., In re Vuitton Et Fils S.A.*, 606 F.2d 1, 3 (2d Cir. 1979).

131. *See, e.g., Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 511 (1959).

132. *See, e.g., In re Aetna Cas. & Sur. Co.*, 919 F.2d 1136, 1143 (6th Cir. 1990) (en banc).

133. *See* 16 WRIGHT ET AL., *supra* note 6, § 3935.7.

jurisdiction. Although the CCPA's jurisdictional limitations have no analogues in the Federal Circuit, the Federal Circuit nevertheless initially embraced a similarly limited conception of mandamus, stating that it would entertain only petitions that raised questions of patent law. I begin this part by examining the origins of this limited conception and showing how it proved unworkable. I then show how the Federal Circuit's more recent mandamus jurisprudence, which permits a broader use of the writ, fails to confront the rationale of the court's earlier decisions.

#### *A. Mandamus in the Court of Customs and Patent Appeals*

Congress created the CCPA in 1929 and merged it into the Federal Circuit in 1982, when the Federal Circuit was created.<sup>134</sup> The CCPA's subject-matter jurisdiction over patent cases was much more limited than the Federal Circuit's. The CCPA was, in general, limited to reviewing decisions of the U.S. Patent and Trademark Office (PTO); unlike the Federal Circuit, the CCPA did not have jurisdiction over appeals from district court judgments in patent infringement litigation.<sup>135</sup> In addition, CCPA review of PTO actions encompassed only two legal issues: (1) patentability (i.e., whether the patent application satisfied the statutory requirements that the invention be novel, useful, nonobvious, adequately described, and claim patentable subject matter)<sup>136</sup> and (2) priority of invention (i.e., the determination of which party first made the invention and is

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134. See Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, § 122, 96 Stat. 25, 36; 4 DONALD S. CHISUM, CHISUM ON PATENTS § 11.06[3][b][I] (2005). For historical discussions of the creation of the Federal Circuit and comparisons to its predecessor courts, the CCPA and the Court of Claims, see generally Marion T. Bennett, *The United States Court of Appeals for the Federal Circuit—Origins*, in UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY: 1990-2002, at 3, 3-15 (2004) [hereinafter FEDERAL CIRCUIT HISTORY]; Daniel J. Meador, *Origin of the Federal Circuit: A Personal Account*, 41 AM. U. L. REV. 581 (1992).

135. See 28 U.S.C. § 1542 (1970), repealed by Federal Courts Improvement Act of 1982 § 122; Charles L. Gholz, *Patent and Trademark Jurisdiction of the Court of Customs and Patent Appeals*, 40 GEO. WASH. L. REV. 416, 417-20 (1972); Jeffery A. Lefstin, *The Constitution of Patent Law: The Court of Customs and Patent Appeals and the Shape of the Federal Circuit's Jurisprudence*, 43 LOYOLA L.A. L. REV. 843, 848-50 (2010). Near the end of the CCPA's existence, in 1975, Congress granted the court jurisdiction to review decisions of the International Trade Commission (ITC) in proceedings to prohibit the importation of devices that infringe U.S. patents, so-called § 337 proceedings. This jurisdiction gave the court a limited opportunity to consider patent infringement issues in addition to the validity issues it considered when reviewing PTO proceedings. See Trade Act of 1974, Pub. L. No. 93-618, § 341(a), 88 Stat. 1978, 2053-56. In addition to the court's patent and ITC jurisdiction, the CCPA also reviewed PTO decisions in trademark cases, as well as the decisions of the U.S. Customs Court (later renamed the Court of International Trade). See GILES S. RICH, A BRIEF HISTORY OF THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS 1-2 (1980).

136. See 35 U.S.C. §§ 101-03, 112 (2006).

therefore entitled to the patent).<sup>137</sup> Because the CCPA lacked jurisdiction over district court patent cases, it did not decide issues of regional circuit law.<sup>138</sup> In addition, in appeals from interference proceedings (i.e., the contest through which the PTO determines priority of invention),<sup>139</sup> the CCPA could decide *only* questions related to the determination of priority.<sup>140</sup> It could not review PTO determinations on underlying matters such as the proper scope of discovery<sup>141</sup> or other matters of procedure.<sup>142</sup>

The CCPA, like other federal appellate courts, asserted authority to issue mandamus under the All Writs Act.<sup>143</sup> Because of its limited subject-matter jurisdiction, however, the CCPA, before deciding a mandamus petition on the merits, was careful to ensure that it would have appellate jurisdiction over the decision sought to be reviewed. In *Goodbar v. Banner*, for example, the petitioners sought a writ of mandamus directing the Board of Patent Interferences to vacate an order compelling the petitioners to produce certain documents in an interference proceeding.<sup>144</sup> The court immediately turned to the question of jurisdiction, noting that “[t]he All Writs Act is not an independent grant of appellate jurisdiction, and, therefore, the appellate jurisdiction which the writs are ‘in aid of’ must have some other basis.”<sup>145</sup> As to what the “other basis” could be, the court wrote that it “must be found within the subject matter jurisdiction of this court.”<sup>146</sup>

This discussion in *Goodbar* simply recognizes the elementary principle that

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137. See *id.* § 102(g); 28 U.S.C. § 1542 (1970), *repealed by* Federal Courts Improvement Act of 1982 § 122. For applications filed after March 16, 2013, priority will no longer go to the first person to make the invention, but to the first person to file a patent application. See Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(b), 125 Stat. 284, 285-87 (2011) (to be codified at 35 U.S.C. § 102).

138. By contrast, when the Federal Circuit reviews a district court judgment in a patent case, it considers all issues that arose in the underlying proceeding, and applies regional circuit law to non-patent issues and procedural issues not unique to patent law. See *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984) (per curiam).

139. See MANUAL OF PATENT EXAMINING PROCEDURE § 2301 (8th rev. ed. 2010). In 2013, when the priority rule changes from “first to invent” to “first to file,” see *supra* note 137, interference proceedings will be replaced by “derivation” proceedings, which will determine whether a competing application was derived from the applicant’s own invention. See Leahy-Smith America Invents Act § 3(I), Pub. L. No. 112, 125 Stat. 284 (2011) (to be codified at 35 U.S.C. § 135).

140. See 35 U.S.C. § 141 (2006).

141. See *Goodbar v. Banner*, 599 F.2d 431, 435 (C.C.P.A. 1979).

142. See *Morris v. Tegtmeyer*, 655 F.2d 216, 220-21 (C.C.P.A. 1981).

143. See *Loshbough v. Allen*, 404 F.2d 1400, 1405 (C.C.P.A. 1969); Charles L. Gholz, *Extraordinary Writ Jurisdiction of the CCPA in Patent and Trademark Cases*, 58 J. PAT. OFF. SOC’Y 356, 357-58 (1976).

144. *Goodbar*, 599 F.2d at 432.

145. *Id.* at 433 (citing *Roche v. Evaporated Milk Ass’n*, 319 U.S. 21, 23-26 (1943)).

146. *Id.* at 433-34 (emphasis omitted).

courts have mandamus jurisdiction if they could, at some point in the future, entertain an appeal.<sup>147</sup> For the regional circuits, this is usually not a complex inquiry. Since a regional circuit will eventually have appellate jurisdiction over almost any district court case in its circuit, it likewise has mandamus jurisdiction over almost any case. But for the CCPA in cases like *Goodbar*, the jurisdictional inquiry was more complex. The CCPA had jurisdiction to review only certain *issues* that arose in interference proceedings.

In *Goodbar*, for example, the court noted that the petition arose out of a discovery motion in a PTO interference proceeding and that it did not have appellate jurisdiction over PTO decisions on motions.<sup>148</sup> Its appellate jurisdiction over interference proceedings was limited to questions of priority of invention and other issues “ancillary to priority.”<sup>149</sup> Because the discovery issue in *Goodbar* did not relate to the sequence of invention, the court concluded that it lacked jurisdiction over the petition.<sup>150</sup>

In several other cases, the CCPA applied the principle that it would hear on mandamus only issues that were within the court’s appellate subject-matter jurisdiction.<sup>151</sup> When the petition presented an issue that the CCPA would decide on appeal, the court would exercise mandamus jurisdiction.<sup>152</sup> When the court did not have jurisdiction over a ruling presented by mandamus, the court would consider the petition only if the ruling had the effect of obstructing an appeal to the CCPA.<sup>153</sup> Thus, any petitioner seeking mandamus from the CCPA faced the threshold question of whether the issue was within the CCPA’s narrow subject-matter jurisdiction. If not, the court would dismiss the petition.

In 1982, Congress replaced the CCPA with the Federal Circuit. Congress granted the new court appellate jurisdiction over a diverse set of tribunals,

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147. See *Burr & Forman v. Blair*, 470 F.3d 1019, 1027 (11th Cir. 2006) (“The [All Writs] Act does not create subject matter jurisdiction for courts where such jurisdiction would otherwise be lacking. Instead, the Act provides courts with a procedural tool to enforce jurisdiction they have already derived from another source.” (citation omitted)).

148. *Goodbar*, 599 F.2d at 434.

149. *Id.* (citing *Duffy v. Tegtmeyer*, 489 F.2d 745 (C.C.P.A. 1974)).

150. *Id.* at 435.

151. See, e.g., *Morris v. Tegtmeyer*, 655 F.2d 216, 220-21 (C.C.P.A. 1981) (holding that the court lacked jurisdiction over a petition challenging the PTO Commissioner’s decisions about when particular issues would be decided); *Godtfredsen v. Banner*, 598 F.2d 589, 592-93 (C.C.P.A. 1979) (dismissing petition that sought an order directing the Commissioner to allow certain interference counts to proceed and to stop proceedings on other counts), *overruled on other grounds by Hester v. Allgeier*, 646 F.2d 513, 522 (C.C.P.A. 1981).

152. See, e.g., *McNally v. Mossinghoff*, 673 F.2d 1253, 1254 (C.C.P.A. 1982) (exercising jurisdiction over a mandamus petition based on “petitioners’ allegation that; but for the Commissioner’s refusal to revive” the petitioners’ patent application, the “application would properly be in interference” with certain other patents); *Morris v. Diamond*, 634 F.2d 1347, 1350 (C.C.P.A. 1980) (finding jurisdiction over a mandamus petition where the decision of the Commissioner sought to be reviewed was “ancillary to priority”).

153. See *Margolis v. Banner*, 599 F.2d 435, 443-44 (C.C.P.A. 1979).

including the PTO, the Court of Federal Claims, the International Trade Commission, the Merit Systems Protection Board, and later, the Court of Appeals for Veterans Claims.<sup>154</sup>

In addition, Congress granted the new court jurisdiction over appeals from all district court cases arising under the patent laws.<sup>155</sup> Prior to the Federal Circuit's creation, district court patent cases were appealed to that court's regional circuit.<sup>156</sup> But in 28 U.S.C. § 1295(a)(1), Congress provided the Federal Circuit with power to hear appeals from final decisions of district courts if the district court's jurisdiction is based, in whole or in part, on 28 U.S.C. § 1338.<sup>157</sup> Section 1338, in turn, grants the district courts original jurisdiction to hear, among other matters, cases "arising under any Act of Congress relating to patents."<sup>158</sup> Rather than restricting the new court's jurisdiction over district court cases to certain "patent issues" (as was the case with the CCPA), Congress thus empowered the Federal Circuit to decide all issues presented on appeal, whether issues of patent law or not.<sup>159</sup>

To be sure, not all patent law issues are appealed to the Federal Circuit. For example, the Supreme Court has held that cases involving only patent law defenses do not "aris[e] under" the patent laws.<sup>160</sup> But given that the new Federal Circuit's jurisdiction covered the entirety of any case arising under the patent laws, it might have seemed likely that the CCPA's issue-oriented mandamus case law would become obsolete. The Federal Circuit, however, surprisingly perpetuated the CCPA's narrow conception of mandamus.

### *B. The Early Mandamus Decisions of the Federal Circuit*

In its first opinion, the en banc Federal Circuit adopted as binding precedent the jurisprudence of its predecessor courts, including the CCPA.<sup>161</sup> The court had defensible reasons for embracing CCPA precedent. For one, it promoted doctrinal stability in the areas of law in which the Federal Circuit and the

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154. See 28 U.S.C. § 1295(a) (2006 & Supp. 2010); 38 U.S.C. § 7292(c) (2006). For a comprehensive overview of the cases over which the Federal Circuit has appellate jurisdiction, see Gugliuzza, *supra* note 30 (manuscript at 27-28).

155. See 28 U.S.C. §§ 1295(a)(1), 1338(a).

156. See 4 CHISUM, *supra* note 134, § 11.06[3][e].

157. 28 U.S.C. § 1295(a)(1).

158. *Id.* § 1338(a).

159. See *Atari, Inc. v. JS & A Grp., Inc.*, 747 F.2d 1422, 1433-35 (Fed. Cir. 1984) (en banc), *overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1068 & n.5 (1998) (en banc in relevant part).

160. See *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808-09 (1988); see also *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 831-34 (2002) (holding that patent law compulsory counterclaims do not "aris[e] under" the patent laws), *abrogated by Leahy-Smith America Invents Act*, Pub. L. No. 112-29, § 19(a), 125 Stat. 284, 331 (2011) (to be codified at 28 U.S.C. § 1338).

161. *S. Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982) (en banc).



CCPA's jurisdiction overlapped.<sup>162</sup> For another, it would have been burdensome for the Federal Circuit to start anew in areas in which many basic questions of law were settled.<sup>163</sup> But the wholesale adoption of CCPA jurisprudence also caused problems because the court was, for the first time, reviewing district court judgments in patent cases, rather than reviewing agency proceedings only.<sup>164</sup> In particular, the CCPA's narrow mandamus standard, which became the Federal Circuit's mandamus standard in district court patent cases, was incompatible with the new court's broader subject-matter jurisdiction.

In its first published order deciding a petition for a writ of mandamus from a district court, *Baker Perkins, Inc. v. Werner & Pfleiderer Corp.*, the Federal Circuit concluded that it had jurisdiction to decide the mandamus petition because the district court's jurisdiction was based on § 1338, and the Federal Circuit would, accordingly, have jurisdiction over any appeal under § 1295(a)(1).<sup>165</sup> While the court's analysis was correct, its statement of the jurisdictional standard was problematic. The court wrote that "the petitioner must initially show that the action sought to be corrected by mandamus" was within the court's subject-matter jurisdiction.<sup>166</sup> Viewed in context, the reference to "action," is not a reference to the "civil action," i.e., the case commenced in the district court.<sup>167</sup> Rather, "action" refers to the specific action taken or order entered by the district judge and sought to be reviewed. This is made plain not only by the court's citations to CCPA cases, which focused on the *issue* presented via mandamus, but also by the court's explicit reference to the "action sought to be corrected."<sup>168</sup> Simply put, the Federal Circuit's standard seemed to ask the same jurisdictional question as the CCPA formerly did: whether the *issue* to be reviewed was within the court's subject-matter jurisdiction.<sup>169</sup>

Yet there was and is no statutory support for the Federal Circuit to frame a jurisdictional inquiry based on issues. As noted, § 1295(a)(1) grants the court jurisdiction to review all final decisions of the district courts, including all interlocutory orders leading to those final decisions, so long as the district court's jurisdiction is based on § 1338. Unlike in the CCPA's jurisdictional statute, there is no limitation as to which *types* of decisions in patent cases the court may review on appeal. The Federal Circuit, however, compelled at least in part by its wholesale adoption of CCPA precedent, imported the CCPA's narrow conception of mandamus jurisdiction into its case law.

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162. *Id.* at 1371.

163. *Id.* at 1370-71.

164. *See* Lefstin, *supra* note 135, at 868.

165. *Baker Perkins, Inc. v. Werner & Pfleiderer Corp.*, 710 F.2d 1561, 1565 (Fed. Cir. 1983).

166. *Id.* (citing *Godtfredsen v. Banner*, 598 F.2d 589 (C.C.P.A. 1979); *Duffy v. Tegtmeier*, 489 F.2d 745 (C.C.P.A. 1974)).

167. FED. R. CIV. P. 2 ("There is one form of action—the civil action.").

168. *Baker Perkins*, 710 F.2d at 1565 (emphasis added).

169. *See Duffy*, 489 F.2d at 748-49 (exercising mandamus jurisdiction because "the *issue* involved here is one which we might have jurisdiction to decide in the context of our review of a decision of the Board of Patent Interferences" (emphasis added)).

To clearly see the confusion that ensued in the Federal Circuit's early mandamus jurisprudence, it is important to keep in mind that when a court of appeals considers a mandamus petition, it in theory answers three distinct questions (although most cases do not divide up the analysis so neatly). First, the court must decide whether it has jurisdiction over the case.<sup>170</sup> To answer this question in the mandamus setting, the court must decide whether it would have jurisdiction over an appeal at some point in the future.<sup>171</sup> Second, the court must decide if it has the remedial power to grant the writ.<sup>172</sup> The federal courts' power to issue appellate mandamus stems from the All Writs Act, § 1651(a).<sup>173</sup> Third, the court must answer the discretionary question of whether the writ is justified under the circumstances.<sup>174</sup> This final question is often referred to as the "propriety" question, as distinguished from the first two questions of jurisdiction and authority, respectively.<sup>175</sup>

The CCPA cases and *Baker Perkins* involved the first question, that of pure jurisdiction. In its early years, the Federal Circuit was also confused about the source of the courts of appeals' authority to issue the writ. In *Mississippi Chemical Corp. v. Swift Agricultural Chemicals Corp.*, for example, the court used mandamus to order a district court to enter summary judgment of patent invalidity on collateral estoppel grounds.<sup>176</sup> At the end of its order, the court noted that it issued the writ "pursuant to [its] authority under 28 U.S.C. § 1651(a)," the All Writs Act, because, "[u]nlike the other circuit courts of appeals, [it] ha[s] no general supervisory authority over district courts."<sup>177</sup> This language suggests a belief that when the regional circuits and the Supreme Court issue supervisory mandamus, they base their authority on a source besides the All Writs Act—a "general supervisory authority."<sup>178</sup> Around this same time, similar statements appeared in other Federal Circuit cases,<sup>179</sup> as well as in a law review article by

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170. *Cf. Baker Perkins*, 710 F.2d at 1565 ("The All Writs Act is not an independent basis of jurisdiction. . .").

171. *See Roche v. Evaporated Milk Ass'n*, 319 U.S. 21, 25 (1943).

172. *Cf. Brittingham v. Comm'r*, 451 F.2d 315, 317 (5th Cir. 1971) (noting that the All Writs Act "empowers" district courts "to issue writs in aid of jurisdiction previously acquired on some other independent ground").

173. *See* FED. R. APP. P. 21 advisory committee's note (1967 adoption).

174. *Cf. Cheney v. U.S. Dist. Court*, 542 U.S. 367, 380 (2004).

175. *Cf. Supervisory and Advisory Mandamus*, *supra* note 11, at 596 n.7 (distinguishing the propriety question from the jurisdictional question).

176. *Miss. Chem. Corp. v. Swift Agric. Chems. Corp.*, 717 F.2d 1374, 1379-80 (Fed. Cir. 1983) (citing *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313 (1971)).

177. *Id.* at 1380.

178. *Id.*

179. *See In re Precision Screen Machs. Inc.*, 729 F.2d 1428, 1429 (Fed. Cir. 1984) ("Petitioners apparently recognize that this court currently has no . . . supervisory authority over any district court under the Federal Courts Improvement Act of 1982, as might justify a writ of mandamus under certain circumstances by a regional circuit court. Accordingly, petitioners are reduced to proceeding under 28 U.S.C. § 1651, the All Writs Act." (citations omitted)); *accord*

Chief Judge Markey.<sup>180</sup> The primary rationale for this position seems to be that the Federal Circuit, unlike the regional circuits, did not have a judicial council to tend to administrative matters within the circuit.<sup>181</sup>

But regional circuits do not derive mandamus authority from the statute establishing a judicial council. They, like the Federal Circuit, derive it from the All Writs Act. The advisory committee's note to Appellate Rule 21 (which governs mandamus petitions) is clear: "The authority of courts of appeals to issue extraordinary writs is derived from 28 U.S.C. § 1651," the All Writs Act.<sup>182</sup> Yet the Federal Circuit still generally shied away from supervisory mandamus, based on the notion that the regional circuits have a more robust mandamus authority than the Federal Circuit.

Examining the remainder of the Federal Circuit's early mandamus case law only heightens the confusion. In contrast to cases disavowing supervisory authority and expressing jurisdictional limits on Federal Circuit mandamus are other cases that, on issues related to patent law, issued what appeared to be supervisory mandamus.<sup>183</sup> Moreover, the court regularly issued mandamus to serve its traditional purposes, such as reining in a court that was acting beyond its authority<sup>184</sup> or compelling a district court to exercise jurisdiction.<sup>185</sup>

In short, the model of mandamus adopted by the Federal Circuit in its early years was confused.<sup>186</sup> The court limited the issuance of the writ in its supervisory form to issues of patent law, in part because the model was tethered

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Petersen Mfg. Co. v. Cent. Purchasing, Inc., 740 F.2d 1541, 1552 (Fed. Cir. 1984), *overruled on other grounds* by Beatrice Foods Co. v. New Eng. Printing & Lithographing Co., 899 F.2d 1171 (Fed. Cir. 1990) (en banc).

180. See Howard T. Markey, *The Phoenix Court*, 32 CLEV. ST. L. REV. 1, 5 (1983) ("Under the All Writs Act, it may be necessary in a particular case to issue an appropriate order to a lower tribunal to preserve the jurisdiction of the court, but that is not, of course, an exercise of general administrative authority.").

181. See *In re Oximetrix, Inc.*, 748 F.2d 637, 643 (Fed. Cir. 1984) (citing 28 U.S.C. § 332); Markey, *supra* note 180, at 5.

182. FED. R. APP. P. 21 advisory committee's note (1967 adoption).

183. See, e.g., *In re Newman*, 782 F.2d 971, 974 (Fed. Cir. 1986) (vacating district court order that permitted the PTO to test a device for which Newman sought a patent but did not employ the "safeguards" of Rule 34 of the Federal Rules of Civil Procedure); *In re Mark Indus.*, 751 F.2d 1219, 1221-22, 1224-26 (Fed. Cir. 1984) (granting mandamus to vacate district court order that based an inequitable conduct finding and a severe sanction on counsel's failure to follow a "custom" described by the opposing party).

184. See, e.g., *Miss. Chem. Corp. v. Swift Agric. Chems. Corp.*, 717 F.2d 1374, 1380 (Fed. Cir. 1983) (ordering district court to enter judgment on collateral estoppel grounds).

185. See, e.g., *In re Snap-On Tools Corp.*, 720 F.2d 654, 655 (Fed. Cir.) (granting mandamus to compel removal from state court to federal court), *order amended* by 735 F.2d 476 (Fed. Cir. 1983).

186. See Gholz, *supra* note 15, at 422-37 (arguing that the Federal Circuit had, in fact, accepted and exercised supervisory mandamus authority, and that the court had simply "eschew[ed]" use of the phrase "supervisory mandamus").

to the views of the defunct CCPA. And the court insisted that it was “devoid” of supervisory authority over district courts, at least on issues of non-patent law, because of its lack of a judicial council.<sup>187</sup> To make matters even more confusing, the court sometimes suggested that it would *never* consider non-patent issues on mandamus.<sup>188</sup> At other times, the court somewhat tempered this restrictive view, suggesting that it would consider non-patent issues on mandamus, but only if the lower court decision prevented an appeal to the Federal Circuit.<sup>189</sup>

### C. *Innotron’s Limit on Federal Circuit Mandamus*

By the time *In re Innotron Diagnostics*<sup>190</sup> reached the Federal Circuit, the court was obviously unsure about its jurisdiction over mandamus petitions, as well as its power to issue the writ. In attempting to clarify the court’s case law and reconceptualize the role of mandamus in the Federal Circuit, the opinion in *Innotron* limited the writ in patent cases to issues implicating Federal Circuit patent law.<sup>191</sup> Issues of regional circuit law unrelated to the Federal Circuit’s patent jurisprudence would not be eligible for mandamus review.<sup>192</sup>

In *Innotron*, Innotron Diagnostics filed an antitrust suit against Abbott Laboratories in the Central District of California.<sup>193</sup> Abbott then sued Innotron in the same court for patent infringement. The court consolidated the cases and, on Abbott’s motion, ordered that Innotron’s antitrust claims be severed for trial after trial of the patent issues.<sup>194</sup> The Federal Circuit denied Innotron’s mandamus petition, but only after providing an extensive discussion of the role of mandamus in the Federal Circuit.<sup>195</sup>

Writing for the court, Chief Judge Markey noted that the “[u]se of mandamus in exercising ‘supervisory authority’ has been approved ‘in proper circumstances’ by the Supreme Court”<sup>196</sup> and increasingly used by the regional circuits.<sup>197</sup> But, he emphasized, those cases involved courts “having appellate

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187. See *In re Int’l Med. Prosthetics Research Assocs., Inc.*, 739 F.2d 618, 619 (Fed. Cir. 1984).

188. See *Baker Perkins, Inc. v. Werner & Pfleiderer Corp.*, 710 F.2d 1561, 1565 (Fed. Cir. 1983) (noting that “the action sought to be corrected by mandamus is within this court’s statutorily defined subject matter jurisdiction,” citing CCPA cases).

189. See *C.P.C. P’ship v. Nosco Plastics, Inc.*, 719 F.2d 400, 401 (Fed. Cir. 1983) (denying mandamus, noting that “[o]ur jurisdiction to hear the appeal on the merits in this case is not affected by” the decision sought to be reviewed).

190. 800 F.2d 1077 (Fed. Cir. 1986).

191. *Id.* at 1083-84.

192. See *id.*

193. *Id.* at 1078.

194. *Id.* at 1078-79.

195. *Id.* at 1086.

196. *Id.* at 1081 (citing *La Buy v. Howes Leather Co.*, 352 U.S. 249, 255 (1957)).

197. *Id.*

jurisdiction over judgments of district courts whose *location* is within its circuit,” whereas the Federal Circuit’s appellate jurisdiction “is determined by the basis for the district court’s *jurisdiction*.”<sup>198</sup> Chief Judge Markey noted that the Federal Circuit could clearly overturn via mandamus a district court order that would prevent an appeal to the Federal Circuit or that would “otherwise frustrate” the Federal Circuit’s appellate jurisdiction.<sup>199</sup>

He then listed three categories of mandamus petitions for which the inquiry is more complicated:

- (1) [T]hose implicating responsibilities of regional circuit courts for supervising, administering, overseeing, and managing the courts within the circuit (e.g., assignment of judges, adjustment of calendars, transfer of case to another district, reference to master);
- (2) [T]hose that arise in all types of cases, but do not directly implicate the patent or Little Tucker Act doctrinal jurisprudence of this court (e.g., disqualification of counsel); and
- (3) [T]hose that do directly implicate, or are intimately bound up with and controlled by, the patent and Tucker Act doctrinal jurisprudential responsibilities of this court (e.g., separate trial of patent issues; refusal to apply 35 U.S.C. § 282; court-ordered tests for utility).<sup>200</sup>

Because the Federal Circuit lacked supervisory authority over district courts, Chief Judge Markey wrote, “a writ would not be ‘in aid of jurisdiction’ if issued on petitions in categories (1) and (2).”<sup>201</sup> On the other hand, the court might “aid its jurisdiction” by hearing mandamus petitions on issues in category (3).<sup>202</sup> Because Innotron’s petition “challenge[d] an order intimately bound up with and controlled by the law of patents (e.g., the relationship of patent infringement defenses to allegations in ‘patent type antitrust’ claims),” the court determined that Innotron’s petition fell within category (3).<sup>203</sup> Based on this analysis, the court summarized the situations in which it would entertain petitions for a writ of mandamus in a patent case as “those, and only those, in which the patent

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198. *Id.*

199. *Id.* at 1082.

200. *Id.* Under the Tucker Act and Little Tucker Act, the federal government has waived its sovereign immunity from certain types of lawsuits, most notably, contract disputes. *See* 28 U.S.C. §§ 1346, 1491 (2006 & Supp. 2010). Because these cases are appealed almost exclusively to the Federal Circuit, *see id.* § 1295(a)(2)-(3), mandamus petitions filed in Tucker Act and Little Tucker Act cases do not implicate the same issues that arise in mandamus petitions in district court patent cases, which are reviewed by the Federal Circuit in some instances (patent cases), but not others. *See supra* text accompanying notes 30-34.

201. *Innotron*, 800 F.2d at 1082.

202. *Id.*

203. *Id.*

jurisprudence of this court plays a significant role.”<sup>204</sup>

This limited conception mirrors the restrictions imposed by the CCPA. The court in *Innotron* cited CCPA opinions that asked whether the *issue* to be resolved was within the court’s appellate jurisdiction<sup>205</sup> as well as earlier Federal Circuit cases that had themselves relied upon the CCPA’s mandamus jurisprudence.<sup>206</sup> Interestingly, the *Innotron* opinion was written by Chief Judge Markey, who had served as Chief Judge of the CCPA,<sup>207</sup> authored one of the CCPA opinions dismissing a mandamus petition for lack of subject-matter jurisdiction,<sup>208</sup> and denounced a supervisory role for the Federal Circuit.<sup>209</sup>

The court’s holding that it would decide only mandamus petitions in which the Federal Circuit’s patent law plays a role raised an important practical question for prospective mandamus petitioners: How does one seek mandamus review of a question of regional circuit law in a case that would be appealed to the Federal Circuit after judgment? The *Innotron* court hinted that the appropriate tactic might be to seek relief in the regional circuit.<sup>210</sup>

As discussed in more detail below, however, this framework of bifurcated review on mandamus would be at odds with Congress’s grant to the Federal Circuit of appellate jurisdiction over all issues raised in cases arising under the patent laws. On an appeal from a final judgment, the Federal Circuit would have jurisdiction over the entire case, including issues of regional circuit law, which the Federal Circuit would decide in accordance with the law of the appropriate regional circuit.<sup>211</sup> Yet, in *Innotron*, the court suggested that, on mandamus, those very same issues could be decided by petition to the regional circuit. In addition, the bifurcated framework proposed by *Innotron* is inconsistent with contemporaneous Federal Circuit precedent, which held that the Federal Circuit—and only the Federal Circuit—could issue mandamus in cases that were within the court’s exclusive appellate jurisdiction.<sup>212</sup> In light of *Innotron*’s

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204. *Id.* at 1083-84.

205. *Id.* at 1082 n.8 (citing *Godtfredsen v. Banner*, 598 F.2d 589 (C.C.P.A. 1979); *Duffy v. Tegtmeier*, 489 F.2d 745 (C.C.P.A. 1974)).

206. *See id.* (citing *In re Mark Indus.*, 751 F.2d 1219, 1222 (Fed. Cir. 1984); *In re Oximetrix*, 748 F.2d 637, 643 (Fed. Cir. 1984); *Baker Perkins, Inc. v. Werner & Pfleiderer Corp.*, 710 F.2d 1561 (Fed. Cir. 1983)).

207. *See Judge Howard Thomas Markey, in FEDERAL CIRCUIT HISTORY, supra* note 134, at 105-06.

208. *See Fraige v. Parker*, 610 F.2d 795, 796 (C.C.P.A. 1979).

209. *See Markey, supra* note 180, at 5.

210. *See Innotron*, 800 F.2d at 1084 n.13; *see also* 15A WRIGHT ET AL., *supra* note 6, § 3903.1 (“There may be an implication in the *Innotron Diagnostics* opinion that the Federal Circuit believes it appropriate for the regional circuits to exercise writ control of the matters foresworn by the Federal Circuit, even though interlocutory and final judgment appeals will go to the Federal Circuit.” (emphasis added) (citation omitted)).

211. *Innotron*, 800 F.2d at 1084 n.13.

212. *See In re Mark Indus.*, 751 F.2d 1219, 1222 (Fed. Cir. 1984) (noting that, because the district court’s jurisdiction was based on § 1338, the Federal Circuit, “and only [the Federal

questionable reasoning and the odd procedural framework it embraced, it is not surprising that both the Federal Circuit and the regional circuits would strain to avoid its holding.

#### D. *The Early Retreat from Innotron*

For a short time, the Federal Circuit faithfully applied *Innotron* as its mandamus standard.<sup>213</sup> Three years after *Innotron*, however, the Ninth Circuit in *Kennecott Corp. v. U.S. District Court* faced a mandamus petition challenging a ruling that fell squarely within *Innotron*'s unreviewable category (2): an attorney-disqualification ruling in a patent case.<sup>214</sup> Even though the Federal Circuit in *Innotron* stated that it would not entertain mandamus petitions on that issue, the Ninth Circuit transferred the case to the Federal Circuit.<sup>215</sup>

Citing *Innotron*, the Ninth Circuit noted that “the Federal Circuit has taken a restrictive view on the scope of its authority to entertain petitions for mandamus which relate to procedural matters” and, thus, review via mandamus “is effectively unavailable in the Federal Circuit.”<sup>216</sup> The Ninth Circuit observed, however, that in two recent cases involving interlocutory *appeals* under 28 U.S.C. § 1292, the Federal Circuit had reviewed attorney-disqualification issues.<sup>217</sup> Thus, even though the Federal Circuit, under *Innotron*, would not hear the disqualification issue on mandamus, the Ninth Circuit reasoned that the Federal Circuit would “quite likely” hear the issue on an interlocutory appeal.<sup>218</sup>

But even though the district judge had certified the issue for interlocutory appeal, the petitioner had filed only a mandamus petition in the Ninth Circuit.<sup>219</sup> Because the statutory deadline to file a new request for interlocutory appeal in the Federal Circuit had passed, the Ninth Circuit *transferred* the matter to the Federal Circuit with the apparent hope that the Federal Circuit would construe the mandamus petition as an application for interlocutory review.<sup>220</sup>

*Kennecott* illustrates the practical and doctrinal difficulties perpetuated by a restrictive view of Federal Circuit mandamus. First, the Federal Circuit would

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Circuit], has authority to issue a writ appropriately in aid of jurisdiction in this case”).

213. See *In re Calmar, Inc.*, 854 F.2d 461, 463 (Fed. Cir. 1988).

214. *Kennecott Corp. v. U.S. Dist. Court*, 873 F.2d 1292, 1292 (9th Cir. 1989); see *Innotron*, 800 F.2d at 1082 (disclaiming the ability to review on mandamus issues “that arise in all types of cases, but do not directly implicate the patent or Little Tucker Act doctrinal jurisprudence of this court (e.g., disqualification of counsel”).

215. *Kennecott*, 873 F.2d at 1293-94.

216. *Id.* at 1292-93.

217. See *id.* at 1293 (citing *Atasi Corp. v. Seagate Tech.*, 847 F.2d 826 (Fed. Cir. 1988); *Teletronics Proprietary, Ltd. v. Medtronic, Inc.*, 836 F.2d 1332 (Fed. Cir. 1988)).

218. *Id.*

219. *Id.* at 1292-93.

220. See *id.* The Federal Circuit did as the Ninth Circuit hoped. See *Kennecott Corp. v. Kyocera Int'l, Inc.*, Misc. No. 252, 1990 WL 28065, at \*1 (Fed. Cir. Mar. 19, 1990) (accepting jurisdiction and affirming the disqualification decision).

unquestionably have exclusive jurisdiction over an appeal—even an interlocutory appeal—challenging an attorney-disqualification ruling in a case arising under the patent laws. Yet, under *Innotron*, the Federal Circuit would not consider that exact same issue via mandamus.

Second, the Ninth Circuit’s decision to transfer the *Kennecott* case shows that, contrary to *Innotron*’s suggestion, it is highly unlikely that a regional circuit would or could grant mandamus when the district court’s jurisdiction is based on § 1338. As discussed, the “[p]ower to issue writs of mandamus depends on power to entertain appeals when the case ends.”<sup>221</sup> A regional circuit lacks the power to hear an appeal if a district court’s jurisdiction is based on § 1338, so a regional circuit probably could not issue mandamus in that same case.<sup>222</sup> If the Federal Circuit were to persist in denying its mandamus power in such a case, perhaps a regional circuit would be persuaded to issue mandamus based on a pragmatic desire to avoid leaving the petitioner without any possible forum. But, as a purely doctrinal matter, such a practice would be hard to explain.

In light of these shortcomings, the Federal Circuit itself began to look for ways to avoid the framework of *Innotron*. In *In re Regents of the University of California*, the Regents sought mandamus review of an order of the Judicial Panel on Multidistrict Litigation consolidating five pending suits in the Southern District of Indiana.<sup>223</sup> In opposition to the petition, Genentech and Eli Lilly argued that the Federal Circuit lacked jurisdiction to review the transfer orders on mandamus.<sup>224</sup> Indeed, such orders fell squarely within *Innotron*’s unreviewable category (1).<sup>225</sup> But without citing *Innotron* on this point, the court rejected the jurisdictional argument.<sup>226</sup>

The court relied on the following syllogism:

- (1) The Federal Circuit, as a general matter, has authority to issue mandamus in cases that fall within its appellate jurisdiction.<sup>227</sup>
- (2) The Federal Circuit has considered questions of venue “when properly raised,” citing cases in which the Federal Circuit considered the issue of venue *on appeal*.<sup>228</sup>
- (3) Therefore, venue issues are within the Federal Circuit’s jurisdiction

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221. *In re BBC Int’l, Ltd.*, 99 F.3d 811, 813 (7th Cir. 1996).

222. I have been unable to locate any regional circuit decision granting mandamus on a non-patent issue in a patent case on the rationale that the Federal Circuit would not, under *Innotron*, consider that non-patent issue on mandamus.

223. *In re Regents of the Univ. of Cal.*, 964 F.2d 1128, 1129 (Fed. Cir. 1992).

224. *Id.* at 1129-30.

225. *In re Innotron Diagnostics*, 800 F.2d 1077, 1082 (Fed. Cir. 1986) (disclaiming the ability to review on mandamus “transfer of [a] case to another district”).

226. *Regents*, 964 F.2d at 1130.

227. *Id.*

228. *Id.* (citing *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 935 F.2d 1263 (Fed. Cir. 1991); *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574 (Fed. Cir. 1990); *Kahn v. Gen. Motors Corp.*, 889 F.2d 1078 (Fed. Cir. 1989)).



when raised on mandamus.<sup>229</sup>

This conclusion, however, is inconsistent with *Innotron*, which explicitly refused to entertain petitions regarding the “transfer of [a] case to another district.”<sup>230</sup> Moreover, the syllogism is faulty on its face. The propositions (1) that the Federal Circuit has some mandamus authority and (2) that the Federal Circuit decides issues of venue on appeal do not invariably lead to the conclusion that the Federal Circuit will hear issues of venue on mandamus.

As I explain below, the restrictive view of Federal Circuit mandamus espoused by *Innotron* was ill-advised, and the broader view embraced by *Regents* is more desirable as a normative matter.<sup>231</sup> But that does not excuse the Federal Circuit from its institutional obligation to explain why it was departing from past precedent.<sup>232</sup> Moreover, by failing to engage the core question of *why* the court should issue mandamus on non-patent issues, the court missed the opportunity to more closely analyze and define the proper scope of Federal Circuit mandamus.

#### E. *Innotron Practically Overruled*

Although *Regents* initiated the demise of *Innotron*, two regional circuit decisions hastened it. In *In re BBC International Ltd.*, the Seventh Circuit transferred to the Federal Circuit a mandamus petition in a patent case that sought review of, among other things, a decision denying transfer of venue.<sup>233</sup> The court discounted *Innotron* by stating that *Innotron* did not deny authority to issue mandamus on non-patent issues, but simply expressed a “[dis]inclination to use [that] authority.”<sup>234</sup> Likewise, the Ninth Circuit, in *Lights of America, Inc. v. U.S. District Court*, transferred a mandamus petition that challenged a district court action that fell within *Innotron*’s category (1): a reference to a special master.<sup>235</sup> Like the Seventh Circuit, the Ninth Circuit discounted *Innotron* by stating that it merely expressed a “(proper) reluctance” to issue extraordinary writs.<sup>236</sup>

*In re Princo Corp.*<sup>237</sup> presented the Federal Circuit itself with an opportunity

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229. *Id.* (citing *In re Cordis Corp.*, 769 F.2d 733 (Fed. Cir. 1985)). In *Cordis*, a case decided a year before *Innotron*, the court denied a mandamus petition seeking dismissal for improper venue. *See Cordis*, 769 F.2d at 734.

230. *Innotron*, 800 F.2d at 1082.

231. *See infra* Part IV.A.

232. *See* PAUL D. CARRINGTON ET AL., JUSTICE ON APPEAL 31 (1976) (“The integrity of the process requires that courts state reasons for their decisions.”).

233. *In re BBC Int’l Ltd.*, 99 F.3d 811, 812 (7th Cir. 1996).

234. *Id.* at 813.

235. *Lights of Am., Inc. v. U.S. Dist. Court*, 130 F.3d 1369, 1370 (9th Cir. 1997); *see Innotron*, 800 F.2d at 1082 (disclaiming the ability to review on mandamus orders of “reference to master”).

236. *Lights of Am.*, 130 F.3d at 1371.

237. 478 F.3d 1345 (Fed. Cir. 2007).

to confront *Innotron* and reconceptualize the scope of Federal Circuit mandamus. Despite the respondent's citation to *Innotron*, the court in *Princo* granted mandamus, holding that the district court had erroneously refused to stay a patent infringement case pending an investigation by the International Trade Commission.<sup>238</sup> The court acknowledged *Innotron*, but it framed the case not as a limit on Federal Circuit power, but rather as articulating a "discretionary exception" that, "if it exists at all, is exceptionally narrow."<sup>239</sup> Like the courts in *BBC* and *Lights of America*, the court in *Princo* focused on the negative task of explaining why *Innotron* did not apply instead of answering the positive question of why a broad use of mandamus by the Federal Circuit is normatively appropriate.

The lengths to which the courts have gone to distinguish and downplay *Innotron* make clear that its limitations on Federal Circuit mandamus are unworkable. Yet *Innotron* remains on the books and is cited in authoritative treatises.<sup>240</sup> Parties opposing mandamus in the Federal Circuit also continue to cite *Innotron* in support.<sup>241</sup> Given this conflicting case law, the preeminent treatise on federal jurisdiction and procedure laments the "unsettled" relationship between Federal Circuit and regional circuit writ authority.<sup>242</sup>

Not only is this current state of the law confusing to litigants, it reflects no thought about the doctrinal and policy considerations that might define the proper scope of mandamus in the Federal Circuit. The consequence of the Federal Circuit's incessant relegation of *Innotron* is that the court, without engaging in a conscious analysis of the optimal use of its mandamus power, has developed a *de facto* standard under which it will issue mandamus on *any* non-patent issue that arises in a patent case, so long as the petition meets the substantive requirements for the writ.<sup>243</sup> In the next part, I contend that the Federal Circuit's recent venue decisions illustrate the shortcomings of this broad, unthinking approach.

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238. *Id.* at 1347.

239. *Id.* at 1352.

240. See 16 WRIGHT ET AL., *supra* note 6, § 3932 (citing *Innotron* for the proposition that the Federal Circuit "will not . . . use [mandamus] to supervise or oversee the district courts, nor to resolve issues that arise in all types of cases and do not directly implicate the Federal Circuit's patent . . . jurisprudence"); see also ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 1206 nn.252 & 255 (8th ed. 2007).

241. See, e.g., *Princo*, 478 F.3d at 1352; Lear Corp.'s Combined Petition for Panel Rehearing and Rehearing En Banc at 3-5, 10-12, *In re* TS Tech. USA Corp., 551 F.3d 1315 (Fed. Cir. 2009) (Misc. No. 2009-888), 2009 WL 329935; see also Reply in Support of Petition for a Writ of Certiorari at 4 n.4, 7, *MedioStream, Inc. v. Acer Am. Corp.*, 131 S. Ct. 2447 (2011) (No. 10-1090), 2011 WL 1479065.

242. 15A WRIGHT ET AL., *supra* note 6, § 3903.1.

243. See *Princo*, 478 F.3d at 1352.

## III. SUPERVISORY PLUS MANDAMUS

Although the Federal Circuit has never overruled *Innotron*, it continues to expand its use of mandamus. The court's recent, repeated grant of mandamus to overturn the venue decisions of the Eastern District of Texas is an unprecedented use of supervisory mandamus by the Federal Circuit. In pioneering this radical use of the writ, which I identify as a new "supervisory plus" theory of mandamus, the court has let pass by an opportunity to make a clarifying statement about mandamus in the Federal Circuit.

I begin this part with background on the Eastern District of Texas and its surprisingly large patent docket. I then summarize the Federal Circuit's recent venue decisions, highlighting the inconsistencies that flow from the lack of clear, guiding principles for Federal Circuit mandamus on non-patent issues. These inconsistencies, I contend, confirm the need for the reconceptualized model of Federal Circuit mandamus that I describe in Part IV.

*A. Patent Litigation in the Eastern District of Texas—  
the "Renegade Jurisdiction"*

Despite Congress's effort to curb forum shopping in patent cases by creating the Federal Circuit, the court decides only a small fraction of all patent cases.<sup>244</sup> Moreover, even in cases that are appealed, a district judge makes scores of discretionary decisions that are effectively unreviewable on appeal but that, when considered as a whole, significantly impact the outcome of the case.<sup>245</sup> Although district courts are required to apply Federal Circuit law to patent issues, little question exists that patent holders are more likely to win in certain federal judicial districts than in others.<sup>246</sup>

At the fore of the debate over forum shopping is the Eastern District of Texas.<sup>247</sup> One might not expect patent litigation to comprise much of the docket

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244. See Jay P. Kesan & Gwendolyn G. Ball, *How Are Patent Cases Resolved? An Empirical Examination of the Adjudication and Settlement of Patent Disputes*, 84 WASH. U. L. REV. 237, 271 (2006) (noting that about fifteen percent of patent cases are terminated by an appealable court decision); accord Mark A. Lemley, *Where to File Your Patent Case*, 38 AIPLA Q.J. 401, 405 (2010). Thus, at most, only fifteen percent of all patent cases are appealed to the Federal Circuit, although the actual number is certainly smaller. See Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 397 tbl.6 (2000) (indicating that fifty-one percent of patent cases terminated after a trial were appealed).

245. See RICHARD A. POSNER, *THE FEDERAL COURTS: CHALLENGE AND REFORM* 340 (1996).

246. See Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 N.C. L. REV. 889, 892 (2001); see also Ted Sichelman, *Myths of (Un)certainty at the Federal Circuit*, 43 LOYOLA L.A. L. REV. 1161, 1171 (2010) (noting that, while the Federal Circuit has improved doctrinal uniformity, "forum shopping remains a pernicious feature of . . . patent litigation").

247. See Yan Leychkis, *Of Fire Ants and Claim Construction: An Empirical Study of the Meteoric Rise of the Eastern District of Texas as a Preeminent Forum for Patent Litigation*, 9 YALE J.L. & TECH. 193, 195 (2007).

of a court headquartered in Tyler, Texas, with judges also sitting in Marshall (where most of the patent cases are filed),<sup>248</sup> Texarkana, Plano, and Beaumont.<sup>249</sup> Yet, in the past decade, more patent cases have been filed in the Eastern District of Texas than in all but three other large, urban federal judicial districts that are technology centers: the Central District of California (Los Angeles), the Northern District of California (San Francisco), and the Northern District of Illinois (Chicago).<sup>250</sup> Indeed, patent litigation has helped revitalize Marshall's economy, which once thrived on the oil, natural gas, and railroad businesses, but had fallen on hard times by the late 1990s.<sup>251</sup>

Why would so many high-technology cases and high-powered litigants and lawyers end up in the self-proclaimed Pottery Capital of the World?<sup>252</sup> The literature offers two common explanations. The first attributes the Eastern District's patent docket to the court's judges and the local rules they have adopted. Patent cases are often high-stakes affairs that present challenging legal questions. As a result, the cases are highly desirable for judges in a relatively rural area like the Eastern District.<sup>253</sup> Moreover, the Eastern District's judges show great enthusiasm for patent cases.<sup>254</sup> And the court's system for assigning cases to its judges permits plaintiffs to predict with a great deal of certainty which judge will hear their case.<sup>255</sup> In addition, the court was one of the first districts to adopt

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248. See Julie Creswell, *So Small a Town, So Many Patent Cases*, N.Y. TIMES, Sept. 24, 2006, at B1.

249. See Xuan-Thao Nguyen, *Justice Scalia's "Renegade Jurisdiction": Lessons for Patent Law Reform*, 83 TUL. L. REV. 111, 120 (2008) [hereinafter Nguyen, *Renegade Jurisdiction*] (discussing the geography of the Eastern District); U.S. DIST. COURT E. DIST. TEXAS, <http://www.txed.uscourts.gov> (last visited Mar. 2, 2012) (providing information about the court and its judges).

250. Lemley, *supra* note 244, at 405.

251. See Creswell, *supra* note 248.

252. Barry Popik, *Pottery Capital of the World (Marshall Nickname)*, BIG APPLE (Mar. 20, 2008), [http://www.barrypopik.com/index.php/new\\_york\\_city/entry/pottery\\_capital\\_of\\_the\\_world\\_marshall\\_nickname](http://www.barrypopik.com/index.php/new_york_city/entry/pottery_capital_of_the_world_marshall_nickname).

253. See Nguyen, *Renegade Jurisdiction*, *supra* note 249, at 136-38.

254. See *id.* at 136 n.116.

255. See General Order Assigning Civil and Criminal Actions 11-13 (E.D. Tex. Oct. 3, 2011) (indicating, for example, that 95% of patent cases filed in the Tyler division will be assigned to Judge Davis, that 100% of patent cases filed in the Beaumont or Lufkin divisions will be assigned to Judge Clark, and that all cases filed in Marshall and Texarkana will be assigned to Chief Judge Folsom), available at [http://www.txed.uscourts.gov/cgi-bin/view\\_document.cgi?document=20937](http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=20937). With Judge Folsom's retirement in March 2012, the ability to "judge shop" may be somewhat reduced. See General Order Assigning Civil and Criminal Actions 12-3 (E.D. Tex. Jan. 17, 2012) (indicating that civil cases filed in Marshall and Texarkana will be split between Judge Schneider and Judge Gilstrap), available at [http://www.txed.uscourts.gov/cgi-bin/view\\_document.cgi?document=21694](http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=21694). Judicial assignments in the Eastern District might also be affected by the Eastern District's participation in the Patent Pilot Program, which, in essence, allows certain judges to express a preference for hearing patent cases and allows other judges to decline to hear patent cases. See *District Courts Selected for Patent Pilot Program*, ADMIN. OFF. U.S. CTS. (June 7, 2011),

special local rules for patent cases,<sup>256</sup> which have made the court's docket particularly fast-moving.<sup>257</sup> The court's enthusiasm for patent cases, coupled with the restorative effect of patent litigation on Marshall's economy, fueled the popular notion that the judges of the Eastern District were unduly reluctant to transfer patent cases to more convenient fora under § 1404(a).<sup>258</sup> But recent empirical studies have somewhat undermined this notion, suggesting that the Eastern District transfers about the same percentage of its patent cases as other judicial districts.<sup>259</sup>

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[http://www.uscourts.gov/news/newsview/11-06-07/District\\_Courts\\_Selected\\_for\\_Patent\\_Pilot\\_Program.aspx](http://www.uscourts.gov/news/newsview/11-06-07/District_Courts_Selected_for_Patent_Pilot_Program.aspx); see also Pilot Program in Certain District Courts, Pub. L. No. 111-349, 124 Stat. 3674 (2011).

Predictability in the assignment of cases has long been important for litigants choosing a venue in a patent case. In the 1990s, one of the most popular forums for patent litigation was the Alexandria division of the Eastern District of Virginia, due to its fast-moving docket and proximity to Washington, D.C. See Nguyen, *Renegade Jurisdiction*, *supra* note 249, at 132-34. The division's popularity quickly faded, however, after its district enacted a district-wide assignment system for patent cases, under which a patent case filed in Alexandria could be assigned to the Richmond, Newport News, or Norfolk divisions. See Michael W. Robinson, *Recent Developments in Patent Litigation in the Eastern District of Virginia*, VENABLE LLP (Jan. 1, 1999), <http://www.venable.com/recent-developments-in-patent-litigation-in-the-eastern-district-of-virginia-01-01-1999>.

256. See Xuan-Thao Nguyen, *Dynamic Federalism and Patent Law Reform*, 85 IND. L.J. 449, 476-77 (2010) [hereinafter Nguyen, *Dynamic Federalism*]; E.D. TEX. LOCAL R. app. M.

257. See Gregory A. Castanias et al., *Survey of the Federal Circuit's Patent Law Decisions in 2006: A New Chapter in the Ongoing Dialogue with the Supreme Court*, 56 AM. U. L. REV. 793, 983 (2007); see also Andrei Iancu & Jay Chung, *Real Reasons the Eastern District of Texas Draws Patent Cases—Beyond Lore and Anecdote*, 14 SMU SCI. & TECH. L. REV. 299, 305, 313 (2011) (comparing case-resolution times in the Eastern District and other popular patent districts over the past twenty years and concluding that “the Eastern District of Texas historically has had a relatively quicker time to jury verdict than many other popular patent districts” but that “[i]t has not been . . . the fastest”). For a discussion by now-retired Judge T. John Ward of the origins of the patent rules, see Symposium on Emerging Intellectual Property Issues, *The History and Development of the EDTX as a Court with Patent Expertise: From TI Filing, to the First Markman Hearing, to the Present*, 14 SMU SCI. & TECH. L. REV. 253, 255-56 (2011).

258. See 28 U.S.C. § 1404(a) (2006) (permitting transfer “[f]or the convenience of parties and witnesses” and “in the interest of justice . . . to any other district or division where it might have been brought”); Robert A. Matthews, Jr., *Update—Transfer of Venue in the E.D. Texas*, PAT. HAPPENINGS, Dec. 2009, at 4, 4-7, available at <http://www.jdsupra.com/post/documentViewer.aspx?fid=52cc121b-d1f4-4ad5-829b-21dc66802091>; accord Durham, *supra* note 1, at 12; Leychkis, *supra* note 247, at 216; Offen-Brown, *supra* note 1, at 73-74; Zhu, *supra* note 1, at 905-06.

259. See Paul M. Janicke, *Venue Transfers from the Eastern District of Texas: Case by Case or an Endemic Problem?*, LANDSLIDE, Mar.-Apr. 2010, at 16, 18-19 [hereinafter Janicke, *Venue Transfers*] (arguing, based on data from 2006 and 2007, that the view that it was “impossible, or nearly so, to get a patent infringement case transferred out of the Eastern District of Texas . . . had

A second explanation for the Eastern District's popularity stems from the favorable results obtained by plaintiffs in that court. As the court's patent docket exploded during the early 2000s, the court developed a reputation for having juries and judges that were particularly favorable for patent holders.<sup>260</sup> In a famous exchange during oral argument in *eBay, Inc. v. MercExchange, L.L.C.*, Carter Phillips and Justice Scalia both took shots at the Eastern District. Phillips complained that a Federal Circuit rule providing for nearly automatic injunctions upon a finding of infringement was particularly harmful to defendants in the Eastern District because "no patent has ever been declared invalid in that jurisdiction, and no patent has [l]ever been found not to infringe."<sup>261</sup> Justice Scalia responded by stating, "that's a problem with Marshall, Texas" but that it might not be appropriate to strike down the automatic-injunction rule simply "because we have some renegade jurisdictions."<sup>262</sup>

In short, conventional wisdom offers two reasons for the attractiveness of the Eastern District as a patent-litigation forum: (1) a fast-moving docket, often attributed to the court's special patent rules (which stem from the judges' enthusiasm for patent cases) and (2) patent-holder-friendly judges and juries. Mark Lemley has suggested that, as an empirical matter, the basis for the first rationale is currently debatable—the Eastern District might no longer be a

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little validity"); Paul M. Janicke, *Patent Venue and Convenience Transfer: New World or Small Shift?*, 11 N.C. J.L. & TECH. ONLINE 1, 19-23 (2009) [hereinafter Janicke, *Patent Venue*] (reaching a similar conclusion based on data from 2005 to 2008); see also Chester S. Chuang, *Offensive Venue: The Curious Use of Declaratory Judgment to Forum Shop in Patent Litigation*, 80 GEO. WASH. L. REV. (forthcoming 2012) (unpublished manuscript on file with the author) (finding, consistent with Janicke's studies, that the Eastern District grants about forty-eight percent of transfer motions filed in non-declaratory judgment cases); Symposium on Emerging Intellectual Property Issues, *Tribalism and Customary Practices of the EDTX*, 14 SMU SCI. & TECH. L. REV. 239, 247 (2011) (providing discussion by Michael E. Jones, long-time practitioner in the Eastern District, regarding his personal success with transfer motions, noting that the "idea that the judges will never transfer the case is just not true").

260. See Michael H. Baniak et al., *IP Litigation in the 21st Century*, 6 NW. J. TECH. & INTELL. PROP. 293, 298 (2008); Donald R. Dunner, *The U.S. Court of Appeals for the Federal Circuit: Its Critical Role in the Revitalization of U.S. Patent Jurisprudence, Past, Present, and Future*, 43 LOYOLA L.A. L. REV. 775, 781-82 (2010); Leychkis, *supra* note 247, at 206; Daniel Fisher, *Plaintiff Paradise*, FORBES, Aug. 19, 2009, <http://www.forbes.com/forbes/2009/0907/outfront-patent-law-texas-plaintiff-paradise.html>.

261. Transcript of Oral Argument, *supra* note 14, at 10; see also Leychkis, *supra* note 247, at 211-12 tbl.7 (listing patent jury trials in the Eastern District from 1999 to 2006, and showing that no defendant prevailed until two defendants won in the summer of 2006).

262. Transcript of Oral Argument, *supra* note 14, at 10-11. If the Eastern District were truly a "renegade" in that it disregarded the law of patent infringement and validity, one would expect the court to be frequently reversed on appeal. But at least one study suggests that the Eastern District's affirmance rate is actually above average. See Iancu & Chung, *supra* note 257, at 306-07 (calculating that, from 1991 to 2010, the Federal Circuit affirmed in full 61% of appeals from the Eastern District, slightly above the national average for all Federal Circuit patent cases).

“rocket docket.”<sup>263</sup> However, available data tends to support the notion that patent holders fare particularly well in the Eastern District. Out of judicial districts with more than twenty-five patent cases concluded in the past decade, the Eastern District ranks sixth in percentage of wins by claimants.<sup>264</sup> And, almost as importantly, patent cases make it to trial in the Eastern District more frequently than any other district besides the District of Delaware.<sup>265</sup> Because accused infringers in the Eastern District are particularly unsuccessful in prevailing on dispositive pre-trial motions,<sup>266</sup> more cases are ultimately decided by juries, which are relatively sympathetic to claims of patent infringement.<sup>267</sup>

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263. See Lemley, *supra* note 244, at 424 tbl.9, showing that the Eastern District of Texas ranks twenty-eighth among federal judicial districts in time to resolution in patent cases. Lemley reasons that the district’s low ranking “is likely a function of congestion resulting from its popularity as a patent forum.” *Id.* at 415. Lemley’s statistics also show, however, that the Eastern District ranks seventh among judicial districts in time to trial. *Id.* at 419 tbl.7. In part because of the relatively average speed with which the Eastern District currently tries and resolves patent cases, Lemley concludes that the district is overvalued as a forum for patent holders. *Id.* at 428; *accord* Baniak et al., *supra* note 260, at 298. Patent holders may finally be catching on, as the number of patent cases filed in the Eastern District declined from 359 in the twelve-month period ending September 30, 2007, to 322 in the twelve-month period ending September 30, 2008, to 242 in the twelve-month period ending September 30, 2009. See JAMES C. DUFF, JUDICIAL BUSINESS OF THE UNITED STATES COURTS: 2009 ANNUAL REPORT OF THE DIRECTOR 192 tbl.C-11 (2009); JAMES C. DUFF, JUDICIAL BUSINESS OF THE UNITED STATES COURTS: 2008 ANNUAL REPORT OF THE DIRECTOR 197 tbl.C-11 (2008); JAMES C. DUFF, JUDICIAL BUSINESS OF THE UNITED STATES COURTS: 2007 ANNUAL REPORT OF THE DIRECTOR 199 tbl.C-11 (2007); *see also* Offen-Brown, *supra* note 1, at 70 tbl.1 (documenting the Eastern District’s patent case load from 2002 to 2009). *But cf.* Douglas C. Muth et al., *The Local Patent Rules Bandwagon*, 21 INTELL. PROP. & TECH. L.J., Aug. 2009, at 19 (arguing that the enactment of local patent rules in many other districts over the past four years has siphoned cases away from the Eastern District).

In 2010, however, the number of patent-case filings in the Eastern District increased to 446. See JAMES C. DUFF, JUDICIAL BUSINESS OF THE UNITED STATES COURTS: ANNUAL REPORT OF THE DIRECTOR 195 tbl.C-11 (2010) [hereinafter 2010 AO REPORT]. Some of this number may be attributable to an increase in *qui tam* cases alleging false marking. See *Forest Group, Inc. v. Bon Tool Co.*, 590 F.3d 1295, 1304 (Fed. Cir. 2009) (holding that the statutory fine under 35 U.S.C. § 292 for marking as “patented” an unpatented article must be imposed on each individual article falsely marked, up to the statutory maximum of \$500 per article), *abrogated in part by* Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 16(b), 125 Stat. 284, 329 (2011) (to be codified at 35 U.S.C. § 292) (eliminating *qui tam* false marking suits). However, at least one commentator has concluded that, even excluding false marking cases, the Eastern District saw an increase in filings from 2009 to 2010. See James Pistorino, *Concentration of Patent Cases in Eastern District of Texas Increases in 2010*, 81 PAT. TRADEMARK & COPYRIGHT J. (BNA) 803 tbls.2-3 (2011) (using data culled from PACER).

264. Lemley, *supra* note 244, at 424 tbl.9.

265. *Id.* at 419 tbl.7.

266. See Iancu & Chung, *supra* note 257, at 317; Leychkis, *supra* note 247, at 216.

267. See Iancu & Chung, *supra* note 257, at 305.

In short, while the judges and juries of the Eastern District might not be as categorically pro-patent as advocates for infringement defendants might suggest,<sup>268</sup> the available data suggests that a patent holder will, as a general matter, fare better in the Eastern District than in many other district courts.

*B. Federal Circuit Supervision of the Eastern District's Venue Decisions*

Under the conventional view, the Eastern District protected its large patent docket by being disinclined to transfer cases to other districts.<sup>269</sup> Since December 2008, however, the Federal Circuit has seemingly tried to change the Eastern District's perceived reluctance to transfer. Seizing on an en banc opinion of the Fifth Circuit in a tort case,<sup>270</sup> the Federal Circuit has, since December 2008, granted ten mandamus petitions seeking transfer of patent cases out of the Eastern District, after having never ordered transfer on mandamus in the court's first twenty-six years of existence.<sup>271</sup> This dramatic expansion in the availability of an extraordinary writ, coupled with inconsistencies in the court's mandamus case law, warrants a clarifying statement by the Federal Circuit about the standards for mandamus. The need for a clarifying statement is underscored by the court's recent, pathbreaking decision to use mandamus to order a court *besides* the Eastern District of Texas to transfer venue.

1. *The Fifth Circuit Lays the Foundation (Volkswagen).*—The Federal Circuit's mandamus revolution began in the Fifth Circuit, with that court's en banc ruling in *In re Volkswagen of America, Inc.*<sup>272</sup> In a 10-7 decision, the Fifth Circuit granted mandamus and ordered the Eastern District of Texas to transfer to the Northern District of Texas a tort case that arose out of a traffic accident in the Northern District.<sup>273</sup> In reviewing the Eastern District's refusal to transfer,

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268. Compare *id.* (calculating that patentees win seventy-three percent of jury trials in the Eastern District, only slightly above the national average of sixty-eight percent), and Nguyen, *Renegade Jurisdiction*, *supra* note 249, at 138-39, 142-43 (discussing Eastern District rulings and verdicts in favor of accused infringers), with Sam Williams, *A Haven for Patent Pirates*, *TECH. REV.* (Feb. 3, 2006), [http://www.technologyreview.com/printer\\_friendly\\_article.aspx?id=16280](http://www.technologyreview.com/printer_friendly_article.aspx?id=16280) (discussing the views of advocates for infringement defendants, concluding that “plaintiffs have such an easy time winning patent-infringement lawsuits [in the Eastern District] . . . that defendants often choose to settle rather than fight”), and Brief for Amicus Curiae American Intellectual Property Law Association in Support of Petitioners at 1, *In re Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008) (en banc) (No. 07-40058), 2008 WL 7789554 [hereinafter *AIPLA Volkswagen Amicus Brief*] (noting “the widespread belief that the Eastern District of Texas is a plaintiff-friendly venue that provides a substantial litigation advantage to a patent holder”).

269. See, e.g., Janicke, *Patent Venue*, *supra* note 259, at 4.

270. *Volkswagen*, 545 F.3d 304.

271. See *supra* note 16 and accompanying text; cf. *In re Holmes*, Misc. No. 352, 1992 WL 349347, at \*1 (Fed. Cir. Oct. 14, 1992) (granting mandamus petition from denial of transfer, but ordering only that the district court reconsider its initial denial).

272. 545 F.3d 304.

273. *Id.* at 307.



the Fifth Circuit applied the eight public and private interest factors of *Gulf Oil Corp. v. Gilbert*,<sup>274</sup> a seminal *forum non conveniens* case.<sup>275</sup> To the Fifth Circuit, the most critical factors were (1) “the relative ease of access to sources of proof,” (2) “the availability of compulsory process to secure the attendance of witnesses,” (3) “the cost of attendance for willing witnesses,” and (4) “the local interest in having localized interests decided at home.”<sup>276</sup> The Fifth Circuit determined that the Eastern District had misapplied these factors, granted mandamus, and ordered transfer to the Northern District.<sup>277</sup>

Notably, on the “sources of proof” factor, the Fifth Circuit criticized the district court for emphasizing that technological advances in document storage and evidence transportation reduced the difference in convenience between the Northern and Eastern Districts.<sup>278</sup> Accusing the district court of “read[ing] the sources of proof requirement out of the § 1404(a) analysis,” the court emphasized that all of the documents and physical evidence, as well as the accident site, were in the Northern District, favoring transfer.<sup>279</sup> Also, on the “cost of attendance for willing witnesses” factor, the Fifth Circuit stated that it had adopted a “100-mile” rule, which provided that “[w]hen the distance between an existing venue for trial . . . and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled.”<sup>280</sup> Because the trial venue in the Eastern District was 155 miles from Dallas, the Fifth Circuit reasoned that this factor, too, weighed in favor of transfer.<sup>281</sup>

The Fifth Circuit’s traditionalist view of the “sources of proof” factor and its formalistic 100-mile rule could be fairly criticized in an era when e-discovery and e-filing are the reality and travel costs vary based on many factors besides sheer distance.<sup>282</sup> Moreover, the plaintiffs lived in the Eastern District when the accident occurred, and many key witnesses remained there.<sup>283</sup> Although a full critique of *Volkswagen* is beyond the scope of this Article, the salient point as relevant to Federal Circuit mandamus is that the proper outcome of the § 1404(a) analysis was at least debatable. Whether the district court was right or wrong to deny transfer, it is hard to see how Volkswagen’s right to transfer was “clear and

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274. 330 U.S. 501 (1947).

275. *Volkswagen*, 545 F.3d at 315.

276. *Id.* at 315-16 (internal quotation marks omitted). The other *Gulf Oil* factors include: practical problems making trial expeditious and inexpensive, court congestion, the forum’s familiarity with the governing law, and the avoidance of unnecessary conflict-of-laws problems. *Id.* at 315.

277. *Id.* at 316-18.

278. *Id.* at 316.

279. *Id.*

280. *Id.* at 317 (quoting *In re Volkswagen AG*, 371 F.3d 201, 204-05 (5th Cir. 2004) (internal quotation marks omitted)).

281. *Id.*

282. *See id.* at 322 (King, J., dissenting).

283. *See id.*

indisputable,” as the Supreme Court requires for mandamus to issue.<sup>284</sup> Yet the Fifth Circuit granted the writ.

2. *An Unprecedented Grant of Mandamus by the Federal Circuit (TS Tech) and Early Hints at Instability (Telular and Genentech)*.—Although *Volkswagen* was a tort case, the American Intellectual Property Law Association appeared as amicus curiae, urging the Fifth Circuit to grant mandamus because the “plaintiff-friendly” Eastern District was too reluctant to transfer patent cases.<sup>285</sup> And indeed, *Volkswagen* has played a central role in the Federal Circuit’s mandamus revolution. For one, it signaled to the Federal Circuit that the Fifth Circuit was willing to grant the writ in debatable circumstances, especially in cases from the Eastern District. Moreover, because the Federal Circuit had effectively abandoned any Federal Circuit-specific limitations on the availability of mandamus (such as those articulated in *Innotron*), granting mandamus to overturn Eastern District venue decisions now required no more than analogizing to *Volkswagen*, since transfer of venue is a non-patent issue that is controlled by regional circuit law.

That is exactly what the Federal Circuit did in its first mandamus decision granting transfer of venue, *In re TS Tech USA Corp.*, decided in December 2008.<sup>286</sup> In that case, Lear Corp. sued TS Tech in the Eastern District of Texas for patent infringement.<sup>287</sup> TS Tech filed a motion to transfer the case to the Southern District of Ohio, which the district court denied.<sup>288</sup> On TS Tech’s petition for mandamus, the Federal Circuit ordered transfer.<sup>289</sup>

The Federal Circuit hewed very close to *Volkswagen*. In an order written by Judge Rader, the court determined that the Eastern District misapplied three of the four § 1404(a) factors that the district court had misapplied in *Volkswagen*.<sup>290</sup> Notably, on the “cost for witnesses” factor, the court stated that district court ignored the 100-mile rule by downplaying the significance of the additional distance between Texas and the key witnesses, who resided in Ohio, Michigan, and Canada.<sup>291</sup> Moreover, the Federal Circuit, like the Fifth Circuit in *Volkswagen*, determined that the district court “read[] out of the § 1404(a) analysis” the “sources of proof” factor, when it emphasized that many of the

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284. *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 380-81 (2004).

285. AIPLA *Volkswagen* Amicus Brief, *supra* note 268, at 1-2. In response, a group of intellectual property lawyers from the Eastern District filed an amicus brief arguing against mandamus. See Brief for Amicus Curiae Ad Hoc Committee of Intellectual Property Trial Lawyers in the Eastern District of Texas in Support of Respondents at 21, *Volkswagen*, 545 F.3d 304 (No. 07-40058), 2008 WL 7789556 (“The Eastern District has unjustly garnered a reputation as a place where large corporations are dragged against their will, particularly in patent cases, and given a good thrashing. This reputation is largely a myth.”).

286. *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008).

287. *Id.* at 1318.

288. *Id.*

289. *Id.*

290. *Id.* at 1319-21.

291. *Id.* at 1320.

relevant documents were stored electronically.<sup>292</sup>

In the wake of *TS Tech*, the Federal Circuit faced an onslaught of mandamus petitions seeking transfer out of the Eastern District. The court's next mandamus decision was an unpublished order in *In re Telular Corp.*<sup>293</sup> In *Telular*, the court denied a petition seeking transfer from the Eastern District of Texas to the Northern District of Illinois.<sup>294</sup> Although the court again applied Fifth Circuit law, the court emphasized a stringent standard found only in a footnote in *Volkswagen* and found nowhere in *TS Tech*. The court noted that it will not grant a mandamus petition "[u]nless it is clear that the facts and circumstances are without any basis for a judgment of discretion."<sup>295</sup> The court continued: "In other words, we will deny a petition '[i]f the facts and circumstances are rationally capable of providing reasons for what the district court has done.'"<sup>296</sup>

If the courts had emphasized such a stringent standard in *Volkswagen* or *TS Tech*, those cases might have turned out differently. Perhaps the district courts reached the wrong result in those cases, but the courts certainly provided reasons for denying transfer that were at least rational. Justifications such as the ease of transporting evidence and witnesses might not be persuasive to an appellate court deciding the issue de novo, but surely they meet the minimal standard of rationality set forth in *Telular*.

Viewed together, *TS Tech* and *Telular* might hint that, although the Federal Circuit was applying Fifth Circuit law, its mandamus analysis was more dynamic. The Federal Circuit's next significant encounter with mandamus explicitly embraced a more context-sensitive analysis. In *In re Genentech, Inc.*, the defendants sought an order directing the Eastern District of Texas to transfer a patent infringement case brought by Sanofi-Aventis to the Northern District of California.<sup>297</sup> The district court had denied transfer.<sup>298</sup> While the defendants were headquartered in California and several witnesses lived in California, many other witnesses and documents were scattered throughout the United States and Europe.<sup>299</sup> So, the district court reasoned, Texas was a convenient, central location for trial.<sup>300</sup>

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292. *Id.* at 1320-21.

293. 319 F. App'x 909 (Fed. Cir. 2009).

294. *Id.* at 912.

295. *Id.* at 911 (citing *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 317 n.7 (5th Cir. 2008) (en banc)).

296. *Id.* at 911-12 (quoting *Volkswagen*, 545 F.3d at 317 n.7 (alteration in original)).

297. *In re Genentech, Inc.*, 566 F.3d 1338, 1341 (Fed. Cir. 2009). On the same day the court issued *Genentech*, the court decided *In re Volkswagen of America, Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009), in which the court denied a mandamus petition seeking transfer from the Eastern District of Texas to the Eastern District of Michigan. The court emphasized that two other, similar infringement cases were already pending in the Eastern District of Texas. *Id.*

298. *Sanofi-Aventis Deutschland GmbH v. Genentech, Inc.*, 607 F. Supp. 2d 769, 781 (E.D. Tex.), *mandamus granted sub nom. In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009).

299. *Id.* at 775-77.

300. *Id.* at 777.

The Federal Circuit disagreed.<sup>301</sup> Much of the Federal Circuit's opinion concerns the district court's analysis of the convenience to the parties and witnesses. The district court had strictly applied the 100-mile rule, noting that it would be more convenient for European witnesses to travel to Texas than to California.<sup>302</sup> The Federal Circuit criticized the district court on this point, noting instead that the 100-mile rule "should not be rigidly applied" in this case, because the European witnesses would have to travel a long distance regardless.<sup>303</sup> The court applied a similar analysis on the "sources of proof" factor, emphasizing that Sanofi's documents would have to be transported from Europe and the East Coast whether the case was tried in Texas or California.<sup>304</sup>

*TS Tech*, *Telular*, and *Genentech* reveal some doctrinal instability beneath the Federal Circuit's initial foray into reviewing the Eastern District's decisions on transfer of venue. In *TS Tech*, the court deferred to the Fifth Circuit's formalist transfer rules,<sup>305</sup> but in *Genentech* the court downplayed the rigidity of those rules.<sup>306</sup> And, in *Telular*, the court announced a "rationality" standard for mandamus relief<sup>307</sup> that the petitioners in *TS Tech* and *Genentech* would have been hard pressed to meet, had the court applied it.

3. *Instability Entrenched* (Hoffman-La Roche, Nintendo, VTech, Apple, and Acer).—The court next granted transfer in *In re Hoffman-La Roche Inc.*<sup>308</sup> and *In re Nintendo Co.*<sup>309</sup> While *Hoffman-La Roche* presented a reasonably strong case for transfer,<sup>310</sup> *Nintendo* was closer. In *Nintendo*, Motiva, an Ohio corporation, sued Nintendo Co. (a Japanese corporation headquartered in Japan) and Nintendo of America Inc. (a Washington corporation headquartered in Redmond, Washington) (collectively, "Nintendo"), alleging that the Nintendo Wii infringed a patent owned by Motiva.<sup>311</sup> Nintendo sought transfer to the Western District of Washington.<sup>312</sup> Although the district court concluded that the "cost for attendance of willing witnesses factor slightly favor[ed] transfer, and the 'local interest' factor strongly favor[ed] transfer," the district court nevertheless denied transfer because, unlike in *Genentech* and *TS Tech*, Nintendo had not shown that the vast majority of documents and witnesses were located

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301. See *Genentech*, 566 F.3d 1338.

302. *Id.* at 1344.

303. *Id.*

304. See *id.* at 1346.

305. See *In re TS Tech USA Corp.*, 551 F.3d 1315, 1320-22 (Fed. Cir. 2008).

306. See *Genentech*, 566 F.3d at 1344-46.

307. *In re Telular Corp.*, 319 F. App'x 909, 912 (2009).

308. 587 F.3d 1333, 1335 (Fed. Cir. 2009).

309. 589 F.3d 1194, 1201 (Fed. Cir. 2009).

310. In *Hoffman-La Roche*, the Federal Circuit granted transfer from the Eastern District of Texas to the Eastern District of North Carolina. *Hoffman-La Roche*, 587 F.3d at 1335. As in *TS Tech*, the case had no connection to Texas. *Id.* at 1336-37. Rather, much of the evidence was located in North Carolina and many of the key witnesses lived there. *Id.*

311. *Nintendo*, 589 F.3d at 1196-97.

312. *Id.* at 1197.

near the transferee court.<sup>313</sup> Rather, there were witnesses and documents in Japan and at various locations throughout the United States.<sup>314</sup> The Federal Circuit disagreed and ordered transfer.<sup>315</sup>

The Federal Circuit's application of the "cost for witnesses" and "sources of proof" factors in *Nintendo* is debatable. The Federal Circuit claimed that the "cost for witnesses" factor "clearly" favored transfer,<sup>316</sup> but it is hard to see how this is so. Four potential witnesses lived in Washington, four lived in Japan, one lived in Ohio, and one lived in New York.<sup>317</sup> There is no doubt a Washington trial would have been more convenient for the four Washington witnesses. But given that the witnesses from Japan would have to travel a substantial distance regardless (an argument similar to that advanced by the Federal Circuit in granting transfer in *Genentech*) and that the Ohio and New York witnesses would have to travel *farther* for a Washington trial, it is hard to see how this factor "clearly" favored transfer.<sup>318</sup>

Similarly, on the "sources of proof" factor, the Federal Circuit gave substantial weight to Nintendo's claim that most of Nintendo of America's relevant documents were located in Washington.<sup>319</sup> But the record also showed that Nintendo's research and development documents were located in Japan.<sup>320</sup> Thus, many of the relevant documents would have to travel a significant distance, regardless of where the trial was held. Certainly, a trial in Washington may have been marginally more convenient. But it is hard to see how this factor weighed "heavily" in favor of transfer, as the Federal Circuit asserted.<sup>321</sup>

The court's emphasis on the two factors it viewed as particularly important suggests an analysis more complex than simply applying *Volkswagen*. Yet the face of the *Nintendo* opinion does not explicitly reflect consideration of issues specific to the Federal Circuit or to patent litigation. If the court had engaged in this reflection, it might have realized, for example, that it was setting an unusual precedent by granting mandamus a fourth time in six months on the same issue decided by the same district court.

Although the court denied the next two petitions it decided,<sup>322</sup> the decisions still do not reflect any introspection. Instead, they exhibit more doctrinal instability. In *In re VTech Communications, Inc.*, the court, as it had done in *Telular*, presaged its denial of the petition by framing the legal standard much

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313. *Motiva LLC v. Nintendo Co.*, No. 6:08-CV-429, 2009 WL 1882836, at \*6 (E.D. Tex. June 30, 2009), *mandamus granted sub nom. In re Nintendo Co.*, 589 F.3d 1194 (Fed. Cir. 2009).

314. *Id.*

315. *Nintendo*, 589 F.3d at 1196.

316. *Id.* at 1199.

317. *Id.* at 1197.

318. *See id.* at 1199.

319. *Id.*

320. *Id.*

321. *Id.* at 1199-200.

322. *See In re Apple Inc.*, 374 F. App'x 997 (Fed. Cir. 2010); *In re Vtech Commc'ns, Inc.*, Misc. No. 909, 2010 WL 46332, at \*1 (Fed. Cir. Jan. 6, 2010).

more stringently than in cases in which the court had granted petitions.<sup>323</sup> Then, in *In re Apple Inc.*, the court framed the standard in even more stringent terms:

Applying Fifth Circuit law in cases arising from district courts in that circuit, this court has held that mandamus may be used to correct a patently erroneous denial of transfer. That standard is an exacting one, requiring the petitioner to establish that the district court's decision amounted to a failure to meaningfully consider the merits of the transfer motion.<sup>324</sup>

The court has repeated this new, “failure to meaningfully consider the merits” standard in at least two subsequent orders denying mandamus.<sup>325</sup> The stringent standards that the Federal Circuit has sometimes applied in denying mandamus are the simplest illustrations of the need for a clarifying statement by the Federal Circuit about its mandamus standards.

4. *Capitalizing on Federal Circuit Expertise (Zimmer, Microsoft, and Vistaprint).*—While the Federal Circuit may have thus far passed on opportunities to reframe the role of mandamus, some of the court's more recent decisions hint at a more refined analysis. In *In re Vistaprint Ltd.*, for example, the Federal Circuit disclaimed an interpretation of *Nintendo* that would prohibit denying transfer based on judicial economy when all of the convenience factors favor transfer.<sup>326</sup> The court upheld the Eastern District's denial of transfer because, even though many of the relevant witnesses and documents were located in the proposed transferee district (Massachusetts), the Eastern District had substantial experience with the patent-in-suit from prior litigation and a pending case involving the same technology and patent.<sup>327</sup>

The more context-sensitive holding of *Vistaprint*<sup>328</sup> built on the court's prior decision in *In re Zimmer Holdings, Inc.*,<sup>329</sup> which rejected a plaintiff's attempt to manipulate venue by establishing an office in the Eastern District—at the same location as another of its litigation counsel's clients.<sup>330</sup> The district court had denied Zimmer's motion to transfer, refusing to consider whether the plaintiff

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323. *VTech Commc'ns*, 2010 WL 46332, at \*1 (“Unless it is clear that the facts and circumstances are without any basis for a judgment of discretion, we will not proceed further in a mandamus petition to examine the district court's decision. In other words, we will deny a petition ‘[i]f the facts and circumstances are rationally capable of providing reasons for what the district court has done.’” (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 317 n.7 (5th Cir. 2008) (en banc) (alteration in original))).

324. *Apple*, 374 F. App'x at 998-99 (citations omitted).

325. See *In re Simpson Strong-Tie Co.*, 417 Fed. App'x 941, 943 (Fed. Cir. 2011); *In re Echostar Corp.*, 388 F. App'x 994, 995 (Fed. Cir. 2010).

326. *In re Vistaprint Ltd.*, 628 F.3d 1342, 1345-46 (Fed. Cir. 2010).

327. *Id.* at 1346-47.

328. See *id.*

329. 609 F.3d 1378 (Fed. Cir. 2010).

330. *Id.* at 1379.

was actually conducting any business in its Texas office.<sup>331</sup> The Federal Circuit granted mandamus. “Assess[ing] . . . the realities of the case,” the court noted that the Eastern District was convenient only for the plaintiff’s litigation counsel and that the plaintiff had no employees in Texas.<sup>332</sup> Rather, it was a Michigan limited liability corporation with two corporate officers who were both residents of Michigan, where all of its research and development took place.<sup>333</sup> The court found this to be a “classic case” of “gam[ing] the system by artificially seeking to establish venue.”<sup>334</sup>

Similarly, in *In re Microsoft Corp.*, the court determined that the plaintiff’s incorporation in Texas sixteen days before filing suit did not establish the Eastern District as a convenient place for trial.<sup>335</sup> The court made clear that it would not permit manipulation of the § 1404(a) convenience factors by pointing out that the plaintiff’s argument against transfer “rest[ed] on a fallacious assumption: that this court must honor connections to a preferred forum made in anticipation of litigation and for the likely purpose of making that forum appear convenient.”<sup>336</sup>

Cases like *Zimmer* and *Microsoft* represent a thoughtful use of mandamus by the Federal Circuit. The Federal Circuit is in a unique position to observe jurisdictional tricks employed by serial patent litigants, such as non-practicing entities<sup>337</sup> and their counsel. Because it hears nearly all appeals filed in patent cases nationwide, the court is uniquely situated to engage in a context-sensitive transfer analysis that accounts for considerations beyond the cold appellate record and formal legal doctrine. And the sometimes harsh language used by the Federal Circuit in *Zimmer* and *Microsoft* sends a clear teaching message (one of the primary purposes of mandamus) to the Eastern District that it should not permit manipulation of venue.

Similarly, as *Vistaprint* suggests, a context-sensitive analysis on mandamus can and should take account of factors beyond mere convenience that impact whether a case will be brought to a speedy and efficient resolution. Somewhat lost in cases like *Nintendo* and *Genentech*, with their emphasis on the importance of the “access to proof” and “cost to witnesses” factors, is that § 1404(a) makes transfer available not only “[f]or the convenience of parties and witnesses” but also “in the interest of justice.”<sup>338</sup> When, in cases like *Vistaprint*, the court withholds mandamus on the ground that the district court’s expertise with a particular patent or technology trumps convenience, the court hues more closely to the transfer statute.<sup>339</sup> And, of more importance to formulating a cogent theory

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331. *Id.* at 1380.

332. *Id.* at 1381.

333. *Id.*

334. *Id.*

335. *In re Microsoft Corp.*, 630 F.3d 1361, 1365 (Fed. Cir. 2011).

336. *Id.* at 1364.

337. Or, more pejoratively, “patent trolls.” See J. Jason Williams et al., *Strategies for Combating Patent Trolls*, 17 J. INTELL. PROP. L. 367, 368 (2010).

338. 28 U.S.C. § 1404(a) (2006).

339. See *In re Vistaprint Ltd.*, 628 F.3d 1342, 1346-47 (Fed. Cir. 2010).

of Federal Circuit mandamus, the court capitalizes on its own familiarity with the process of patent litigation. A decision like *Vistaprint* recognizes, perhaps as only the Federal Circuit can, that it can be an extraordinary investment of judicial time and the parties' resources to educate a judge on the technology relevant to a particular case.

5. *A New Frontier in the Mandamus Revolution (Link\_A)*.—For the first three years of its mandamus revolution, the Federal Circuit focused exclusively on the Eastern District of Texas. Indeed, one might discount the importance of the Federal Circuit's mandamus cases by noting that they all apply Fifth Circuit law, which embraces a relatively robust role for mandamus in supervising venue decisions.<sup>340</sup> In December 2011, however, the court for the first time used mandamus to order a court besides the Eastern District of Texas to transfer a patent case.

In *In re Link\_A Media Devices Corp.*, Bermuda-based Marvell International had sued Link\_A Media Devices (LAMD) for patent infringement in the District of Delaware.<sup>341</sup> LAMD is incorporated in Delaware but has offices in California, Minnesota, the United Kingdom, and Japan.<sup>342</sup> Claiming that its principal place of business was in the Northern District of California, LAMD sought transfer to that district.<sup>343</sup> The district court denied the motion, but the Federal Circuit, applying Third Circuit law, granted mandamus and ordered transfer.<sup>344</sup> Much like in *TS Tech*, the case from the Eastern District that began the mandamus revolution, the Federal Circuit in *Link\_A* criticized the district court for (1) placing too much weight on the plaintiff's choice of forum and (2) modernizing for an era of electronic discovery and air travel the § 1404(a) factors of "convenience of the witnesses" and "location of the books and records."<sup>345</sup> Interestingly, however, the leading Third Circuit case on transfer of venue (a case that the Federal Circuit cited frequently in *Link\_A*) emphasizes that "the plaintiff's choice of venue should not be lightly distributed."<sup>346</sup> Moreover, that case instructs district courts to consider convenience for the witnesses "but only to the extent that the witnesses *may actually be unavailable* for trial in one of the

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340. See generally Danny S. Ashby et al., *The Increasing Use and Importance of Mandamus in the Fifth Circuit*, 43 TEX. TECH L. REV. 1049, 1050 (2011) (summarizing "[t]he current trend in the Fifth Circuit towards the increased issuance of writs of mandamus," which began in 2003 with the court's decision in *In re Horseshoe Entm't*, 337 F.3d 429 (5th Cir. 2003)).

341. *In re Link\_A Media Devices Corp.*, 662 F.3d 1221, 1221 (Fed. Cir. 2011) (per curiam).

342. *Marvell Int'l Ltd. v. Link\_A Media Devices Corp.*, Civ. No. 10-869-SLR, 2011 WL 2293999, at \*1 (D. Del. June 8, 2011), *mandamus granted sub nom. In re Link\_A Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011).

343. *Id.*

344. *Link\_A*, 662 F.3d at 1221.

345. *Id.* at 1223-24; *cf. In re TS Tech USA Corp.*, 551 F.3d 1315, 1320-21 (Fed. Cir. 2008) (similar).

346. *Jumara v. State Farm Ins. Co.*, 55 F.3d 873, 879 (3d Cir. 1995) (internal quotation marks omitted).



fora.”<sup>347</sup> That case also indicates that the “location of books and records” factor should be “similarly limited to the extent that the files *could not be produced* in the alternative forum.”<sup>348</sup> Despite this seeming flexibility in Third Circuit law and no indication that witnesses or evidence could not appear or be produced in Delaware, the Federal Circuit found that LAMD had a “clear and indisputable” right to transfer.<sup>349</sup>

It is too early to tell whether the expansion of aggressive mandamus review to cases outside the Eastern District of Texas is an emerging trend or an aberration.<sup>350</sup> For this reason, the remainder of this Article focuses mostly on the mandamus decisions arising out of the Eastern District. The potential for expanded use of mandamus supervision, however, reinforces the imperative for the Federal Circuit to critically assess the proper role of the writ in patent litigation, a task I begin in Part IV.

### C. *A Question of Motivation and a New Theory of Mandamus*

Before analyzing the proper role for mandamus in patent litigation, however, I consider in more detail the factors that have instigated the Federal Circuit’s mandamus revolution, focusing mainly on the ten cases from the Eastern District of Texas. In particular, I consider two important theoretical questions. First, why has the Federal Circuit singled out the Eastern District? And, second, must we develop a new theory of appellate mandamus, beyond the jurisdictional, supervisory, and advisory theories, to classify the Federal Circuit’s unparalleled supervision of one district court?

1. *The Federal Circuit’s Motivation.*—The Federal Circuit’s aggressive review of the Eastern District’s venue decisions raises questions about the Federal Circuit’s motivation. Why is the Federal Circuit so closely supervising the venue decisions of the Eastern District? Why has the Federal Circuit not been as aggressive in reviewing venue decisions of other district courts? Although consideration of the court’s motive is admittedly somewhat speculative, I briefly consider three possible explanations to spur conversation on the topic.

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347. *Id.* (emphasis added).

348. *Id.* (emphasis added).

349. *Link\_A*, 662 F.3d at 1221.

350. Except for *Link\_A*, the Federal Circuit has denied every mandamus petition challenging a venue decision by a court besides the Eastern District, *see supra* note 10 and accompanying text, even though some of those cases presented reasonably strong factual arguments for transfer. For instance, in *In re Affymetrix, Inc.*, the Federal Circuit denied a mandamus petition that sought transfer from the Western District of Wisconsin to the Northern District of California, even though the defendant’s employee-witnesses, all six third-party witnesses, the development and marketing documents, and the accused product itself, were located in California. *In re Affymetrix, Inc.*, Misc. No. 913, 2010 WL 1525010, at \*1-2 (Fed. Cir. Apr. 13, 2010); *see also* *Illumina, Inc. v. Affymetrix, Inc.*, No. 09-cv-277-bbc, 2009 WL 3062786, at \*1-2 (W.D. Wisc. Sept. 21, 2009) (district court opinion denying transfer).

For a simple explanation of the court's aggressive actions, one might point to the Eastern District's poor reputation among patent-infringement defendants, who are often large corporations that frequently litigate before the Federal Circuit, and claim that the Federal Circuit has come to the rescue of the corporate interests that have captured the specialized court.<sup>351</sup> A second, more refined explanation might be that the Federal Circuit is displeased with the efforts of district courts, like the Eastern District of Texas, that have informally become judicial centers for patent litigation. One obvious way to fix the numerous perceived problems in modern patent law<sup>352</sup> would be for Congress to change patent law from the top-down. Difficulties with obtaining effective legislative reform,<sup>353</sup> however, have caused some scholars in recent years to explore the possibility of reforming the patent system from the bottom-up by enhancing trial-court familiarity with patent law.<sup>354</sup> Professor Xuan-Thao Nguyen, for example, suggests "local" reform of the patent laws through adoption of local patent rules and development of judicial expertise,<sup>355</sup> commending the Eastern District as "a case study of how a district court has actively transformed itself into a knowledgeable court with strong expertise in solving patent disputes."<sup>356</sup> She notes, however, that Congress and the Federal Circuit have attempted to punish these efforts at local reform, specifically citing the mandamus decisions from the Eastern District of Texas.<sup>357</sup> Indeed, the Chief Judge of the Federal Circuit, Randall Rader, has on multiple occasions expressed his "concern[] that patent litigation is becoming too centralized in a few districts."<sup>358</sup>

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351. Cf. CARRINGTON ET AL., *supra* note 232, at 168 (noting the problem that specialized courts can be dominated by the entities that frequently appear before it).

352. For comprehensive critiques of the modern patent system, see, for example, JAMES BESSEN & MICHAEL J. MEURER, *PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK* (2008); DAN L. BURK & MARK A. LEMLEY, *THE PATENT CRISIS AND HOW THE COURTS CAN SOLVE IT* (2009); ADAM B. JAFFE & JOSH LERNER, *INNOVATION AND ITS DISCONTENTS: HOW OUR BROKEN PATENT SYSTEM IS ENDANGERING INNOVATION AND PROGRESS, AND WHAT TO DO ABOUT IT* (2004).

353. See BURK & LEMLEY, *supra* note 352, ch. 10. Congress has made a handful of changes to the patent statute in the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (to be codified in scattered sections of 28 and 35 U.S.C.). Whether these changes will end the patent crisis remains to be seen, although some are skeptical. See, e.g., *Talk of the Nation: Will Patent Reform Bill Help or Hurt Inventors?*, NPR (Sept. 12, 2011), <http://www.npr.org/2011/09/12/140404985/will-patent-reform-bill-help-or-hurt-inventors> (comments of James Bessen).

354. See, e.g., Jeanne C. Fromer, *Patentography*, 85 N.Y.U. L. REV. 1444, 1447-48 (2010); Nguyen, *Dynamic Federalism*, *supra* note 256, at 474-83.

355. See Nguyen, *Dynamic Federalism*, *supra* note 256, at 474-83.

356. Nguyen, *Renegade Jurisdiction*, *supra* note 249, at 114.

357. See Nguyen, *Dynamic Federalism*, *supra* note 256, at 488 n.254.

358. Interview by Laura Robinson & Erin Gibson with Randall R. Rader, Chief Judge, U.S. Court of Appeals for the Fed. Circuit (Dec. 9, 2010) [hereinafter Interview with Randall R. Rader], available at [http://www.dlapiper.com/interview\\_with\\_the\\_honorable\\_randall\\_r\\_rader](http://www.dlapiper.com/interview_with_the_honorable_randall_r_rader); see also Randall R. Rader, Chief Judge, U.S. Court of Appeals for the Fed. Circuit, *The State of Patent*

This potential hostility to bottom-up reform might inform an analysis of the court's motive in its recent mandamus decisions. More broadly, aggressive Federal Circuit supervision of district court procedure fits a narrative that the Federal Circuit consistently maximizes its power at the expense of other bodies that interact with patent law, such as the district courts, the PTO, and even state courts. While commentators have studied the Federal Circuit's relationships with each of these other bodies individually,<sup>359</sup> future work could synthesize this scholarship into an institutional critique of the Federal Circuit.

In any event, Federal Circuit hostility toward bottom-up patent reform through trial-level expertise might explain why the recent mandamus decisions have been directed at the Eastern District of Texas and the District of Delaware. As Mark Lemley has noted, these two districts stand out among districts with the most patent cases because they are neither population nor technology centers. Rather, the Eastern District of Texas is simply a popular destination for patent plaintiffs, and the District of Delaware is the state of incorporation for many litigants.<sup>360</sup>

Finally, it is impossible to ignore the interest that Chief Judge Rader individually has taken in the Eastern District of Texas. Not only has he publicly expressed concern about the centralization of patent litigation in the Eastern District,<sup>361</sup> he was the author of the order in *TS Tech*, the first Federal Circuit case to order transfer out of the Eastern District.<sup>362</sup> Moreover, in 2010, Chief

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Litigation, Speech at the Fifteenth Annual Eastern District of Texas Bench and Bar Conference (Sept. 27, 2011), in 21 FED. CIR. B.J. 331, 341 (2012) (“[T]he best way for us to strengthen our judicial system is to share and promote other venues.”).

359. See, e.g., Stuart Minor Benjamin & Arti K. Rai, *Who's Afraid of the APA? What the Patent System Can Learn from Administrative Law*, 95 GEO. L.J. 269, 272 (2007) (studying the relationship between the Federal Circuit and the PTO); William C. Rooklidge & Mathew F. Weil, Essay, *Judicial Hyperactivity: The Federal Circuit's Discomfort with Its Appellate Role*, 15 BERKELEY TECH. L.J. 725, 726 (2000) (studying the relationship between the Federal Circuit and the district courts); Christopher G. Wilson, Note, *Embedded Federal Questions, Exclusive Jurisdiction, and Patent-Based Malpractice Claims*, 51 WM. & MARY L. REV. 1237, 1239-40 (2009) (studying the relationship between the Federal Circuit and state courts).

360. Lemley, *supra* note 244, at 407. From 2000 to 2010, the Eastern District of Texas ranked fourth among all judicial districts in the number of patent cases litigated, and the District of Delaware ranked sixth. *Id.* at 405-06 tbl.2. The Central District of California ranked first, the Northern District of California ranked second, the Northern District of Illinois ranked third, and the Southern District of New York ranked fifth. *Id.*

361. See, e.g., Interview with Randall R. Rader, *supra* note 358.

362. *In re TS Tech USA Corp.*, 551 F.3d 1315, 1317-18 (Fed. Cir. 2008). Judge Rader also wrote the order granting mandamus in *In re Nintendo Co.*, 589 F.3d 1194 (Fed. Cir. 2009), and was a member of the panel that issued a per curiam order granting mandamus in *In re Morgan Stanley*, 417 F. App'x 947 (Fed. Cir. 2011). In addition, Judge Rader was a member of the first panel to grant a mandamus petition seeking transfer from a district besides the Eastern District of Texas. See *In re Link\_A\_Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011) (per curiam).

Judge Rader sat by designation in a number of Eastern District patent cases.<sup>363</sup> Although the judge said that his motivation was benign,<sup>364</sup> others have speculated that he was sending a message that the Eastern District is too favorable to patent holders.<sup>365</sup>

There may, of course, be other factors animating the Federal Circuit's recent aggressiveness with the Eastern District of Texas.<sup>366</sup> But because these factors

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363. See *Clearvalue, Inc. v. Pearl River Polymers, Inc.*, 704 F. Supp. 2d 584 (E.D. Tex. 2010); *IP Innovation LLC v. Red Hat, Inc.*, 705 F. Supp. 2d 692 (E.D. Tex. 2010); *Performance Pricing, Inc. v. Google, Inc.*, 704 F. Supp. 2d 577 (E.D. Tex. 2010); *PA Advisors, LLC v. Google, Inc.*, 706 F. Supp. 2d 739 (E.D. Tex. 2010).

364. See Zusha Elinson, *Big Tech Shouts 'Yippee!,' Patent Bar Chattering as Rader Heads to Texas*, CORPORATE COUNSEL, Mar. 15, 2010 (quoting Judge Rader: "It's a place of importance in the patent world and as . . . incoming chief judge of the Federal Circuit, I wanted to make sure that I understand the forces at play . . . I want to work under their rules and understand the pressures they deal with."); see also George C. Beighley, Jr., *The Court of Appeals for the Federal Circuit: Has It Fulfilled Congressional Expectations?*, 21 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 671, 727 (2011) (quoting Judge Rader praising the Eastern District's judges for being "'conscientious in their application of patent law'").

365. See Elinson, *supra* note 364 (discussing Judge Rader's rulings favoring patent-infringement defendants and suggesting that his presence spurred settlements in other cases). Federal Circuit Judge William Bryson has also been presiding over a small number of patent cases in the Eastern District. See Michael C. Smith, *How Many Baylor Lawyers Does It Take to Swear in a Federal Judge?*, EDTEXWEBLOG.COM (Dec. 20, 2011, 6:19 PM), [http://mcsmith.blogs.com/eastern\\_district\\_of\\_texas/2011/12/how-many-baylor-lawyers-does-it-take-to-swear-in-a-federal-judge.html](http://mcsmith.blogs.com/eastern_district_of_texas/2011/12/how-many-baylor-lawyers-does-it-take-to-swear-in-a-federal-judge.html). Judge Bryson's visit appears designed at least in part to assist the Eastern District in processing the cases left behind by the retirement of Judge T. John Ward. See John Council, *Father and Son Reunion*, TEX. LAWYER (Oct. 24, 2011), <http://www.law.com/jsp/tx/PubArticleFriendlyTX.jsp?id=1202519747336&slreturn=1>. This shortage of judges may be remedied with the recent confirmation of Judge Rodney Gilstrap. See Smith, *supra*.

366. For example, it is interesting to note that, when *TS Tech* was decided, proposals were percolating in Congress to amend the venue statute for patent cases. See, e.g., S. 515, 111th Cong. § 8 (2009). These proposals were designed to limit the ability of patent holders to file infringement suits in districts that have only a modest connection to the case, like the Eastern District of Texas in some of the cases discussed in this Article. The recently passed patent reform statute, however, contains minimal revisions to the venue rules. Cf. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 9(a), 125 Stat. 284, 316 (2011) (to be codified in scattered sections of 35 U.S.C.) (changing venue for district court challenges to PTO decisions from the District of Columbia to the Eastern District of Virginia). The Federal Circuit's decisions in *TS Tech* and its progeny might be seen as a successful effort to forestall congressional meddling with the patent litigation system. It also fits a narrative of Federal Circuit hostility toward other entities' efforts to shape patent law. See *supra* note 359 and accompanying text. In fact, these venue cases are not the only recent example of the Federal Circuit directly addressing an issue on which Congress was considering passing legislation. Compare, e.g., *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1335 (Fed. Cir. 2009) (reversing damages award of approximately \$358 million as unsupported by substantial evidence), with S. 515, 111th Cong. § 4 (2009) (requiring the court to specifically identify the

are not discussed in the court's orders, a debate about motives is apt to lapse into speculation.

2. *A New Theory of Mandamus.*—As a theoretical matter, the Federal Circuit's aggressive review of the Eastern District's mandamus decisions does not fit neatly into the jurisdictional, supervisory, or advisory models of mandamus discussed above. Accordingly, I suggest that the Federal Circuit may have created a new, anomalous model of mandamus that I call "supervisory plus" mandamus. It is "supervisory" in the sense that it is mandamus issued to correct a significant, erroneous practice—the Eastern District's repeated misapplication of § 1404(a). But it is supervisory "plus" because the Federal Circuit is doing more than correcting one instance of the practice to send a message to the lower court. It is granting mandamus in every erroneous case it sees.

One example of the supervisory plus theory in action is the recent decision in *In re Verizon Business Network Services Inc.*<sup>367</sup> In that case, the Eastern District had denied a motion to transfer an infringement suit to the Northern District of Texas, emphasizing that the Eastern District had previously heard a suit involving the same patent and, during the course of that suit, had construed many of the patent's claims.<sup>368</sup> On mandamus, the Federal Circuit used the writ for what seemed to be pure error correction.<sup>369</sup> With regard to the fairness and convenience factors, the court emphasized simply that the case was "in many respects analogous to *Volkswagen*."<sup>370</sup> In addition, the court distinguished *Vistaprint* on its facts, noting that, in the case at hand, there was no co-pending litigation.<sup>371</sup> Rather, the prior litigation had concluded five years before the current case was filed.<sup>372</sup> Then, without any significant discussion of the extraordinary, unprecedented, or important nature of the case, the court granted the writ, ordering the case transferred a mere 150 miles west, from Marshall to Dallas.<sup>373</sup>

Not only is the court seemingly using mandamus for pure error correction, it is also now granting relief by simply analogizing to its prior mandamus decisions, even though transfer of venue is an issue supposedly controlled by regional circuit law. For example, in *In re Morgan Stanley*, the court ordered transfer from the Eastern District of Texas to the Southern District of New York.<sup>374</sup> The court pointed out that the plaintiff and twenty-seven of the forty-one defendants were "headquartered in or close by the transferee venue," similar to *Acer*, where the plaintiff and five of the twelve defendants were headquartered

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methodologies or factors for calculating damages that are supported by the evidence), and Leahy-Smith America Invents Act (containing no significant amendment to patent damages law).

367. 635 F.3d 559 (Fed. Cir. 2011).

368. *Id.* at 560-61.

369. *See id.* at 561-62.

370. *Id.* at 561.

371. *Id.* at 562.

372. *Id.*

373. *Id.* at 561-62.

374. *In re Morgan Stanley*, 417 F. App'x 947 (Fed. Cir. 2011) (per curiam).

in the transferee venue.<sup>375</sup> The court also rejected the plaintiff's argument that, because half of the patents-in-suit had been asserted in a prior case in the Eastern District, judicial economy favored denial of transfer.<sup>376</sup> The court analogized to *Zimmer* and *Verizon*, cases the court read to embrace the principle that "the proper administration of justice may be to transfer to the far more convenient venue even when the trial court has some familiarity with a matter from prior litigation."<sup>377</sup> Similar to *Verizon*, the court's order of transfer based on analogy to prior Federal Circuit cases does not look like the grant of extraordinary relief under Fifth Circuit law, but simple interlocutory error correction under Federal Circuit law.<sup>378</sup>

This novel, case-by-case approach to the interlocutory remedy of mandamus is a dramatic reordering of appellate procedure. Liberalizing the standards for interlocutory relief can significantly undermine a trial court's authority, as its decisions are subject to immediate second-guessing on appeal. Indeed, the

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375. *Id.* at 948 (citing *In re Acer Am. Corp.*, 626 F.3d 1252, 1254 (Fed. Cir. 2010)).

376. *See id.* at 949.

377. *Id.* (citing *Verizon*, 635 F.3d 559; *In re Zimmer Holdings, Inc.*, 609 F.3d 1378 (Fed. Cir. 2010)).

378. As in *Morgan Stanley*, in *In re Biosearch Technologies, Inc.*, Misc. No. 995, 2011 WL 6445102, at \*1 (Fed. Cir. Dec. 22, 2011), the Federal Circuit relied heavily on its own mandamus case law and ordered transfer from the Eastern District of Texas to the Northern District of California. *Id.* The court conceded that its prior mandamus decisions were only "persuasive authority for transfer." *Id.* at \*3. But the court nevertheless emphasized that "[i]n analogous situations, where an invention has no connection with Texas, we have determined that the asserted geographical centrality of Texas did not outweigh the many aspects of convenience to the defendant," *id.* (citing *In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009)), and that "in cases such as *In re Nintendo Co.*, 589 F.3d 1194 (Fed. Cir. 2009) and *In re Hoffmann-La Roche*, 587 F.3d 1333 (Fed. Cir. 2009), this court ordered transfer from the plaintiff's chosen Eastern Texas forum, noting 'a stark contrast in relevance, convenience, and fairness between the two venues,'" *id.* (quoting *Hoffmann-La Roche*, 587 F.3d at 1336).

The court has also invoked its own precedent to deny transfer on mandamus. In *In re Apple Inc.*, Misc. No. 103, 2012 WL 112893, at \*2 (Fed. Cir. Jan. 12, 2012), the court emphasized that "measured against cases like *Volkswagen*, *TS Tech*, *Genentech*, and *Acer*, there [was] a plausible argument that Apple," the party seeking transfer, "did not meet its burden of demonstrating . . . that the transferee venue [was] 'clearly more convenient.'" *Id.* The court emphasized that, "[a]s compared to those cases in which [it had] granted mandamus," there were "fewer defendants in the Northern District of California" (the proposed transferee district), "and potential evidence identified in the Eastern District of Texas." *Id.* In addition, in *Apple*, there were defendants and witnesses that, in the court's view, would "find it easier and more convenient to try th[e] case in the Eastern District of Texas" than in the Northern District of California. *Id.*

These decisions, based largely on the Federal Circuit's own case law, raise questions not only about mandamus theory, they more broadly illustrate problems in applying the Federal Circuit's choice of law principles. The court may have good reason to treat as the primary binding authority its own prior mandamus decisions on transfer of venue in the specific context of patent litigation, but under the current choice-of-law regime, it cannot do so.

limited data available suggests that litigants have begun to seek extraordinary relief from the Federal Circuit far more frequently after *TS Tech*. In the three years before *TS Tech*, litigants filed with the Federal Circuit twenty-nine petitions per year on average.<sup>379</sup> In the past two years, by contrast, the annual average has increased to 45.5, an increase of 56.9%.<sup>380</sup>

One might expect that the court would justify its pathbreaking approach—especially an approach that flouts a principle as venerable as the final judgment rule—through considered and explicit discussions of the legal and policy justifications for the new order. Indeed, the relatively permissive standard applied in recent mandamus decisions—fueled by the court’s reliance on its own mandamus precedent—presents the possibility that the court, without critically and transparently weighing the costs and benefits of its approach, may soon find mandamus to be an acceptable means for interlocutory appeal of other significant pre-trial rulings, such as claim construction orders.<sup>381</sup> Yet, remarkably, the

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379. These figures were obtained from the statistics maintained by the Federal Circuit and the Administrative Office of the United States Courts (AO). See *Statistics: Appeals Filed, Terminated, and Pending*, U.S. CT. APPEALS FED. CIRCUIT, <http://www.ca9c.uscourts.gov/the-court/statistics.html> (last visited Mar. 2, 2012).

380. *Id.* The jump in mandamus petitions filed in the Federal Circuit has been so dramatic that, in his usually pro forma annual report, the director of the AO specifically noted that the increase in petitions for writs of mandamus in the Federal Circuit was “related to petitions under 28 U.S.C. § 1404 to transfer patent cases out of the Eastern District of Texas.” 2010 AO REPORT, *supra* note 263, at 18. This swell of appellate mandamus petitions was foreseen by civil procedure scholars who argued against transfer in the Fifth Circuit’s *Volkswagen* case. See Brief of Civil Procedure Law Professors as Amici Curiae in Support of Respondents at 19, *In re Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008) (en banc) (No. 07-40058), 2008 WL 7789555 (“[T]he Panel’s decision wrongly turns appellate courts into a defendant’s ally by making appellate superintendence, by way of appeal or mandamus, a likely prospect following a trial judge’s decision to deny transfer.”).

381. Given the Federal Circuit’s propensity to reverse district court claim construction orders at a high rate, see Sichelman, *supra* note 246, at 1175 fig.1, and the importance of claim construction orders to the determination of infringement, see *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995) (en banc) (Mayer, J., concurring) (“[T]o decide what the claims mean is nearly always to decide the case.”), *aff’d*, 517 U.S. 370 (1996), Congress and some commentators have proposed permitting more frequent pre-judgment appeals of those orders, see S. 515, 111th Cong. § 8 (2009); Craig Allen Nard, *Process Considerations in the Age of Markman and Mantras*, 2001 U. ILL. L. REV. 355, 372-77. Some Federal Circuit judges have seemed willing to allow interlocutory claim construction appeals, see Paul Michel, *Judicial Constellations: Guiding Principles as Navigational Aids*, 54 CASE W. RES. L. REV. 757, 765 (2004) (“[W]e have never taken a position as an institution that we simply will not grant a . . . discretionary interlocutory . . . appeal from a *Markman* ruling. We might . . . We will do so when we get a convincing reason stated in the petition.”); Kathleen M. O’Malley et al., *A Panel Discussion: Claim Construction from the Perspective of the District Judge*, 54 CASE W. RES. L. REV. 671, 685 (2004) (quoting now-Federal Circuit Judge O’Malley, speaking when she was a district judge: “[S]everal of us have attempted to convince the [Federal Circuit] to take interlocutory appeals of

Federal Circuit has not explicitly addressed the broader implications of its aggressive supervision of the Eastern District. Nor has the Federal Circuit considered any Federal-Circuit-specific or patent-litigation-specific constraints on its decisions to order transfer of venue.

Because the court has not acknowledged the context in which the cases arise, the court seems to have overlooked that it might be overzealous in its supervision. Data compiled by Paul Janicke shows that in 2006 and 2007, motions to transfer venue were filed in only 8.3% of Eastern District patent cases,<sup>382</sup> suggesting that defendants do not view the Eastern District as particularly inhospitable. One might argue in response that defendants simply do not file transfer motions in the Eastern District because they have little hope of succeeding. But Janicke's study also raises doubts about whether obtaining transfer out of the Eastern District is as difficult as the conventional wisdom suggests. For example, Janicke shows that the Eastern District, even before *TS Tech*, transferred roughly the same percentage of its patent cases as other district courts.<sup>383</sup>

In any event, the Federal Circuit's analysis could better account for circumstances that it is in a unique situation to understand because of its position as the arbiter of almost all district court patent appeals nationwide. And the Federal Circuit could better explain the reasons for its sub silentio nullification of the final judgment rule in venue cases from the Eastern District.

The Federal Circuit's current model of supervisory plus mandamus is problematic not only from a policy and theoretical perspective. It is also rife with doctrinal inconsistency, such as the varying standard for mandamus relief discussed above. Some of this inconsistency stems from the Federal Circuit's

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certain claim construction decisions—those that are really critical, that are case-dispositive and that are done early in the decision making process.”), even though the court as a whole seems reluctant to do so on a consistent basis, *see Regents of the Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1371 (Fed. Cir. 2008) (granting permission for interlocutory appeal of claim construction order, noting that “[w]hile we have not generally certified motions for interlocutory appeal of claim construction, we determined that it was especially desirable in this case in view of the pendency of [a] related appeal on the denial of the preliminary injunction based on some of the same issues”).

382. Janicke, *Patent Venue*, *supra* note 259, at 23. By comparison, in the Central District of California (a district Janicke describes as “a notoriously poor district” for patent holders), transfer motions were filed in 6.8% of cases. *Id.*

383. *Id.* at 19-23; Janicke, *Venue Transfers*, *supra* note 259, at 16. Nevertheless, one might further argue that the Eastern District's transfer rate should be much higher than the national average because the Eastern District is likely not a convenient forum for many of the cases filed there. *See Janicke, Patent Venue*, *supra* note 259, at 22-23; Janicke, *Venue Transfers*, *supra* note 259, at 16 (showing that the Eastern District denies a higher percentage of transfer motions than other leading patent districts). That argument may hold sway. But my point is merely that the Eastern District's transfer practice is not so clearly aberrational as to warrant supervisory plus mandamus without a frank assessment of the normative justifications for displacement of the final judgment rule.



obligation to apply the Fifth Circuit's formalist transfer law. But the Federal Circuit has shown a willingness to apply its own law in mandamus cases, and the court could use a review of its own case law as a platform for reexamining its own role in the system of mandamus review. More directly, the court could modify or overrule its current choice-of-law regime and transparently treat its own mandamus case law as binding. This way, the court could restart its mandamus law on a clean slate, and more directly engage the considerations that determine whether mandamus is warranted in the specific context of transfer of venue in patent litigation.

In *Innotron*, the court attempted to take account of the court's unique role in the federal judiciary by adopting Federal-Circuit-specific limitations on the writ.<sup>384</sup> The *Innotron* framework, however, was too restrictive. It deprived the public of the many benefits of Federal Circuit mandamus on non-patent issues.<sup>385</sup> By limiting Federal Circuit mandamus to patent-related issues, as the CCPA had done, the framework developed by the nascent Federal Circuit was not well-suited to the court's new role reviewing district court patent cases (as compared with the CCPA's role, which was to review only determinations of the PTO).<sup>386</sup> A reconceptualization would force the court to make sure that its mandamus standard accounts for the realities of modern patent litigation and the Federal Circuit's unique role in the federal system. Moreover, a bold statement regarding Federal Circuit mandamus would provide clarity to litigants and to the regional circuits, and would put *Innotron* to rest once and for all. Finally, in the specific context of transfer of venue, the court could make a clear, direct, and comprehensive statement about when transfer should be granted, hopefully reducing the need for case-by-case supervision of the Eastern District of Texas.

#### IV. A NEW FRAMEWORK FOR FEDERAL CIRCUIT MANDAMUS

In this part, I consider what a reconceptualized version of Federal Circuit mandamus would look like. Setting aside for the moment any specific problems with the Federal Circuit's recent supervision of the Eastern District's venue decisions, I first argue that, as a normative matter, it is generally desirable for the Federal Circuit to issue mandamus on non-patent issues that arise in patent cases. I then outline considerations that might limit this general proposition—restraints the Federal Circuit might realize were it to stop skirting *Innotron* and asserting mandamus authority on all issues raised in patent cases. In outlining these limiting considerations, I return to the Federal Circuit's recent venue decisions and show how this refined standard could be applied to maximize the didactic function of mandamus while preserving district court autonomy and litigation efficiency.

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384. See *In re Innotron Diagnostics*, 800 F.2d 1077, 1080-84 (Fed. Cir. 1986).

385. See *infra* Part IV.A.

386. See Lefstin, *supra* note 135, at 868-69.

*A. The Benefits of Federal Circuit Mandamus on Non-Patent Issues*

There are clear benefits from a regime under which the Federal Circuit issues mandamus on non-patent topics, such as transfer of venue. These benefits are obscured by the current state of the law, where *Innotron* remains on the books, and the courts simply distinguish or, more frequently, ignore it. I focus on four benefits in particular in arguing that Federal Circuit mandamus on non-patent issues is, in general, desirable. As a practical matter, these benefits could be used in arguing that the court should overrule *Innotron* once and for all.

1. *Jurisdictional Simplification.*—By issuing mandamus on non-patent issues, the Federal Circuit simplifies the jurisdictional inquiry on a mandamus petition. As noted, on appeal, the Federal Circuit has jurisdiction so long as the district court’s jurisdiction was based in whole or in part on § 1338.<sup>387</sup> The court in *Innotron* was unclear about whether the limitation on Federal Circuit mandamus was a limit on the court’s jurisdiction, a question of remedial power, or a matter of discretion in resolving the merits of a mandamus petition.<sup>388</sup> Taking *Innotron* (for the moment) to articulate a purely jurisdictional limitation, there would be a separate jurisdictional standard for mandamus petitions only, one that is found nowhere in the Judicial Code. The question is whether “the patent jurisprudence of [the Federal Circuit] plays a significant role” in the decision sought to be reviewed.<sup>389</sup> If that standard is not satisfied, the Federal Circuit has no mandamus jurisdiction, even if the court would have jurisdiction on appeal.

This multi-track jurisdictional scheme is needlessly complex and inefficient.<sup>390</sup> It is one thing to have a higher merits standard for obtaining the extraordinary, interlocutory relief of mandamus than to obtain error correction on appeal. The higher mandamus standard deters frivolous filings and promotes an efficient adjudication process, while still allowing room to answer important questions that regularly evade appellate review. It is quite another thing to create a standard that makes it difficult for litigants and courts to determine *where* a mandamus petition should be filed. Such a standard would lead to extensive argument over the threshold question of the proper court to hear the petition. This argument will, in most instances, be quite wasteful because of the high standard for obtaining mandamus relief on the merits. The standard also engenders delay—not only because the court will have to take time to examine its jurisdiction, but also because cases would sometimes be transferred to or from a regional circuit and rebriefed in the new court.

To be sure, parties sometimes fiercely litigate the question of whether an

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387. 28 U.S.C. § 1295(a)(1) (2006).

388. See *Innotron*, 800 F.2d at 1084.

389. *Id.*

390. Cf. *Beatrice Foods Co. v. New Eng. Printing & Lithographing Co.*, 899 F.2d 1171, 1178 (Fed. Cir. 1990) (en banc) (Newman, J., concurring in the judgment) (arguing, based on considerations of judicial economy, “that there should not be separate appellate routes depending on the claims or issues of a case”).

*appeal* should be heard in a regional circuit or the Federal Circuit.<sup>391</sup> But in the mine-run of patent infringement cases, it is clear that the district court's jurisdiction is based at least in part on § 1338, so there is no serious question of appellate jurisdiction.<sup>392</sup> Conversely, when the jurisdictional inquiry is framed as whether the Federal Circuit's patent jurisprudence plays a significant role, the courts will have to engage in difficult line-drawing exercises that will, in turn, introduce uncertainty into the law.<sup>393</sup>

*Innotron* itself provides an example of difficult line-drawing. The court decided to entertain the mandamus petition in that case because it involved severance of patent claims and patent-related antitrust claims for trial.<sup>394</sup> Yet the court just as easily could have emphasized that the question of severance arises under Federal Rule of Civil Procedure 42(b), which applies to all types of civil claims, patent or not, and thus falls within *Innotron*'s unreviewable category (2): issues that arise in all types of cases and do not directly implicate patent law.<sup>395</sup> The court also could have emphasized that a key consideration in construing Rule 42(b) is judicial economy—the minimization of expense and delay.<sup>396</sup> It could have reasoned that the regional circuit has a much better sense of docket congestion in the district courts in its circuit than the Federal Circuit does, so review of severance decisions is more akin to an administrative matter—properly reviewable in the regional circuit only. If, however, the court had simply held that it had mandamus jurisdiction because it had appellate jurisdiction, this line-drawing problem would not have arisen.

Adoption of the appellate-jurisdiction standard for mandamus petitions does not eliminate controversy about Federal Circuit jurisdiction. But uniting the Federal Circuit's mandamus and appellate jurisdiction standards at least reduces

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391. See, for example, *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800, 806-07 (1988), in which an appeal was transferred from the Federal Circuit to the Seventh Circuit and then back to the Federal Circuit, with each court claiming that it lacked jurisdiction. The Supreme Court, on certiorari to the Federal Circuit, ordered the case transferred back to the Seventh Circuit. *Id.* at 819.

392. See Christopher A. Cotropia, "Arising Under" Jurisdiction and Uniformity in Patent Law, 9 MICH. TELECOMM. & TECH. L. REV. 253, 275-76 (2003).

393. Cf. Ted L. Field, *Improving the Federal Circuit's Approach to Choice of Law for Procedural Matters in Patent Cases*, 16 GEO. MASON L. REV. 643, 677-78 (2009) (noting the importance of legal uniformity and predictability in the Federal Circuit's achievement of Congress's aims in creating the court). The difficulties in defining jurisdictional limits by the subject matter of the case involved are well documented. See, e.g., Charles W. Adams, *The Court of Appeals for the Federal Circuit: More than a National Patent Court*, 49 MO. L. REV. 43, 68 (1984) ("[D]efining a court's jurisdiction in terms of subject matter can lead to wasteful litigation over jurisdictional limits, splitting single disputes between two or more courts, and conflicts with courts of overlapping jurisdiction.").

394. *Innotron*, 800 F.2d at 1083-84.

395. *Id.* at 1082.

396. See FED. R. CIV. P. 42(b) (permitting severance "[f]or convenience, to avoid prejudice, or to expedite and economize"); 9A WRIGHT ET AL., *supra* note 6, § 2388.

uncertainty and the possibility for manipulation through framing choices made by the court and the parties.<sup>397</sup>

2. *Elimination of Forum Shopping by Preventing Bifurcated Appeals.*—In creating the Federal Circuit, Congress sought to reduce forum shopping by restoring uniformity to the patent laws.<sup>398</sup> Federal Circuit mandamus on non-patent issues reduces the incentive to forum shop among district courts in different regional circuits.

Under a standard limiting Federal Circuit mandamus to issues implicating the court's patent jurisprudence, the range of issues considered on mandamus would be narrower than on appeal. On appeal, the Federal Circuit can decide every issue in an entire district court case, including non-patent law issues.<sup>399</sup> On mandamus, however, interlocutory rulings on non-patent law issues would be reviewable only in a regional circuit, if anywhere.<sup>400</sup> This bifurcated appeal process (in which an issue is decided by a regional circuit on mandamus, but by the Federal Circuit on a post-judgment appeal), would provide an incentive for a plaintiff to choose a district court in a regional circuit with a more favorable view on an issue reviewable via mandamus, such as transfer of venue. Thus, through the vehicle of mandamus, a litigant preferring to have the regional circuit decide a particular non-patent question could actually obtain review in a favored appellate forum by filing a mandamus petition, even if that question would be reviewable by the Federal Circuit on appeal from final judgment.

In addition to promoting forum shopping, a system of bifurcated review would encourage litigants to file more mandamus petitions. The denial of mandamus does not have law-of-the-case effect when the case is ultimately appealed.<sup>401</sup> So, under a bifurcated system, a dissatisfied litigant could have an issue reviewed by two different courts at two different times: first, in the regional circuit on mandamus, and second, on appeal in the Federal Circuit.

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397. Cf. Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 59 (1989) (“The rule requiring the [Federal Circuit] to defer to regional law in nonpatent substantive areas does not work well: the line between patent and nonpatent issues is often illusory . . .”); Field, *supra* note 393, at 652 (arguing that the Federal Circuit can choose either its own law or regional circuit law, whichever it prefers, “depending upon whether it defines the issue broadly or narrowly”).

398. See S. REP. NO. 97-275, at 5 (1981); see also *United States v. Hohri*, 482 U.S. 64, 71-72 (1987); *Atari, Inc. v. JS & A Grp., Inc.*, 747 F.2d 1422, 1435 (Fed. Cir. 1984) (en banc), *overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1068 & n.5 (Fed. Cir. 1998) (en banc in relevant part).

399. See *Atari*, 747 F.2d at 1433 (“In creating this court’s jurisdiction, Congress had presented to it two choices: (a) granting this court appellate jurisdiction over only the patent issues in a case (‘issue’ jurisdiction); or (b) granting this court appellate jurisdiction over the entire case (‘arising under’ jurisdiction). Congress specifically and unequivocally rejected the former and chose the latter.” (footnote omitted)).

400. See *Innotron*, 800 F.2d at 1084 n.13.

401. See *Kennedy v. Lubar*, 273 F.3d 1293, 1299 (10th Cir. 2001).

3. *Valuable Doctrinal Guidance.*—In addition, there are valuable doctrinal benefits from a regime in which the Federal Circuit issues mandamus on the same spectrum of issues it considers on appeal. This regime provides the Federal Circuit with more opportunities to rule on issues frequently arising in patent litigation, but not easily remedied on appeal. Questions of attorney-client privilege and change of venue are prime examples of issues that are practically impossible to remedy on appeal (because if they are erroneously decided they will likely be an unreversible harmless error)<sup>402</sup> but that can effectively be reviewed on mandamus.<sup>403</sup>

Rochelle Cooper Dreyfuss has argued that the Federal Circuit's insistence on applying regional circuit law to non-patent issues deprives the public of the court's valuable expertise on issues that, while not formally issues of patent law, the Federal Circuit likely has something useful to say.<sup>404</sup> A similar argument applies in the mandamus context. The Federal Circuit has extensive experience with issues of non-patent law, particularly procedural issues, that arise in patent cases and that might be reviewed on mandamus. If these issues were decided by the regional circuits (or by no court), as would be the case under *Innotron*, lower courts, litigants, and the public would be deprived of the Federal Circuit's input. The Federal Circuit, for example, is particularly well-versed in confidentiality and protective-order issues that arise in patent litigation,<sup>405</sup> as well as attorney-client privilege issues that are not necessarily unique to patent law.<sup>406</sup> Even though the Federal Circuit might formally apply regional circuit law to these issues, precedential Federal Circuit orders would provide valuable doctrinal guidance about how the issues should be resolved in the context of patent litigation.

4. *Avoidance of Specialization.*—A final benefit of Federal Circuit mandamus on non-patent issues is that it might help the court avoid potential problems arising from judicial specialization, such as interest-group capture, "tunnel vision" (i.e., losing sight of basic values at stake and instead developing arcane and intricate doctrine), a lack of prestige of the judicial positions, a lack of deference to trial judges, and a lack of incentive to fully and clearly express legal reasoning.<sup>407</sup> The large number of lower tribunals reviewed by the Federal

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402. See *In re Nat'l Presto Indus., Inc.*, 347 F.3d 662, 663 (7th Cir. 2003).

403. See, e.g., *In re Seagate Tech., LLC*, 497 F.3d 1360, 1366-67 (Fed. Cir. 2007) (en banc) (reviewing via mandamus issues of attorney-client privilege and work product protection).

404. See Dreyfuss, *supra* note 397, at 59.

405. See, e.g., *In re Jenoptik AG*, 109 F.3d 721, 723 (Fed. Cir. 1997) (applying Ninth Circuit law to confidentiality issue).

406. See, e.g., *In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1374 (Fed. Cir. 2001) (applying Eighth Circuit law to privilege issue).

407. See CARRINGTON ET AL., *supra* note 232, at 168; Comm'n on Revision of the Fed. Court Appellate Sys., *Structure and Internal Procedures: Recommendations for Change*, 67 F.R.D. 195, 234-35 (1975). Congress recognized these potential dangers when creating the Federal Circuit. See H.R. REP. NO. 97-312, at 19-23 (1981); S. REP. NO. 97-275, at 6 (1981).

Circuit would seemingly help alleviate specialization problems.<sup>408</sup> Yet some still believe the Federal Circuit has fallen prey to the pitfalls of specialized courts.<sup>409</sup> By considering non-patent issues on mandamus, the Federal Circuit broadens the subject matter of issues it decides and varies the procedural posture in which it makes those decisions. The court's mandamus jurisprudence then develops not in a patent-focused tunnel, but with a broader sense of where the decisions fit in the legal landscape.

### *B. A More Refined Standard*

I have argued that there are significant benefits from Federal Circuit mandamus on non-patent issues. These benefits, however, do not necessarily mean that the proper standard for mandamus in the Federal Circuit is to grant mandamus in every single case that a regional circuit would. Rather, the court should use the discretion inherent in mandamus adjudication to develop a standard that accounts for the court's unique role in the federal system.

In describing a Federal Circuit-specific framework, I begin with the basic premise that significant errors appropriate for mandamus relief (based on the substantive criteria for granting the writ) should not go uncorrected solely because an appeal lies to the Federal Circuit and not a regional circuit. Congress intended the Federal Circuit to have equal status with its sister circuits,<sup>410</sup> so the court should, in general, have the same remedial powers as those courts.<sup>411</sup> The primary differences between the Federal Circuit and its sister circuits are (1) the Federal Circuit's choice-of-law regime, under which it applies regional circuit law to non-patent issues and procedural issues not unique to patent law, and (2) the Federal Circuit's jurisdictional structure, which is nationwide in geographic scope, but limited in subject matter to cases arising under the patent laws. Any

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408. See John M. Golden, *The Supreme Court as "Prime Percolator": A Prescription for Appellate Review of Questions in Patent Law*, 56 UCLA L. REV. 657, 666, 675 (2009).

409. See Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1110 (2003); see also *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 839 (2002) (Stevens, J., concurring in part and concurring in the judgment) ("[O]ccasional decisions by courts with broader jurisdiction will provide an antidote to the risk that the specialized court may develop an institutional bias."). Without offering a final judgment on this issue, I have suggested elsewhere that the mix of cases within the Federal Circuit's jurisdiction may not be ideal. See Gugliuzza, *supra* note 30 (manuscript at 29-61).

410. See S. REP. NO. 97-275, at 2-3 (noting that the Federal Circuit "is on line with other Federal courts of appeals that is, it is not a new tier in the judicial structure"); *In re Roberts*, 846 F.2d 1360, 1362 (Fed. Cir. 1988) (en banc) ("This court is a co-equal member of a system of thirteen appellate courts arranged in a single tier.").

411. See *Beatrice Foods Co. v. New Eng. Printing & Lithographing Co.*, 899 F.2d 1171, 1179 (Fed. Cir. 1990) (en banc) (Newman, J., concurring in the judgment) ("I think it unlikely that the Federal Circuit was intended to have less authority under 28 U.S.C. § 2106 [which provides federal appellate courts with their general remedial authority] than did the courts that received patent appeals before our formation.").

Federal Circuit-specific considerations on mandamus review should flow from these unique characteristics.

I organize my discussion of these considerations around the separate (but sometimes overlapping) theories of mandamus. I first briefly discuss how the Federal Circuit should make full use of mandamus for its traditional, “jurisdictional” purposes. I then contemplate Federal Circuit-specific limitations on mandamus when the court uses the writ for advisory, supervisory, or supervisory plus purposes.

1. *Jurisdictional Mandamus Consistent with § 1338.*—As noted, the traditional role of appellate mandamus was to restrain a court from acting without authority and to compel a court to exercise authority with which it had been vested.<sup>412</sup> Similarly, perhaps the least controversial use of appellate mandamus under the All Writs Act is to ensure that a lower court action does not prevent an appeal—mandamus that is truly “in aid of” the appellate court’s jurisdiction.<sup>413</sup> The Federal Circuit has regularly used mandamus for these “jurisdictional” functions when a district court’s jurisdiction is based on § 1338.<sup>414</sup> The CCPA, likewise, would issue mandamus to set aside rulings obstructing an appeal to the CCPA.<sup>415</sup>

It is hard to see any reason why the Federal Circuit should not continue this practice. The use of mandamus to compel or restrain the acts of a lower court traces its roots to common law practice and serves the valuable function of ensuring that lower federal courts exercise the power given to them by Congress, nothing more and nothing less. The use of mandamus to ensure that district courts do not prevent an appeal to the Federal Circuit is similarly well-grounded. Where Congress has provided a right to appeal (as it has done for patent cases in § 1295), district courts should not be permitted to nullify that right through erroneous rulings.

2. *Advisory Mandamus on Issues Intertwined with Patent Law.*—An important purpose of this Article has been to critique the Federal Circuit’s use of supervisory mandamus, that is, mandamus issued to correct an egregious district court error that is likely to recur. Yet the Federal Circuit, like the other courts of appeals, also issues advisory mandamus, that is, mandamus issued to answer important, unresolved legal questions. Before outlining a reconceptualized model of supervisory mandamus in the Federal Circuit, it is worthwhile to consider how the court’s standards for advisory mandamus might also be clarified.

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412. See *supra* Part I.A.

413. See *McClellan v. Carland*, 217 U.S. 268, 280 (1910) (“[W]here a case is within the appellate jurisdiction of the higher court, a writ of mandamus may issue in aid of the appellate jurisdiction which might otherwise be defeated by the unauthorized action of the court below.”).

414. See, e.g., *In re Cont’l Gen. Tire, Inc.*, 81 F.3d 1089, 1090 (Fed. Cir. 1996) (vacating order compelling alleged infringer to file a reexamination request with the PTO); *In re Snap-On Tools Corp.*, 720 F.2d 654, 655 (Fed. Cir.) (granting mandamus to compel removal from state court to federal court), *order amended by* 735 F.2d 476 (Fed. Cir. 1983).

415. See *Margolis v. Banner*, 599 F.2d 435, 443 (C.C.P.A. 1979).

The object of advisory mandamus is to answer questions of law that cannot await or regularly evade appellate review.<sup>416</sup> Thus, the Federal Circuit's choice-of-law rules are key to determining the optimal scope of advisory mandamus. On most non-patent questions, the Federal Circuit applies regional circuit law.<sup>417</sup> Because the Federal Circuit cannot definitively say what regional circuit law is, the court should be hesitant to issue advisory mandamus on questions of regional circuit law. This is especially true when the issue is completely unrelated to patent law, such as a purely procedural issue the regional circuit has simply not resolved. The Federal Circuit could of course provide some advisory guidance to the parties and the public on such a question, at least until the pertinent regional circuit decides the question. But the Federal Circuit's inability to definitively resolve the question substantially reduces the benefits of the disruptive interlocutory appeal without reducing its costs.

On the other hand, when the issue of regional circuit law is intertwined with the patent law, such as a question of how the attorney-client privilege applies in a patent-specific context, the benefits of the decision increase for two reasons. First, the Federal Circuit may be able to provide guidance that cannot be obtained elsewhere. Because the regional circuits now decide few patent cases, the Federal Circuit is practically the only court that can provide advice on issues of regional circuit law as they arise in patent litigation, such as disputes over the designation and disclosure of confidential technical documents. Second, and relatedly, a regional circuit is less likely to overrule the Federal Circuit's advice on an issue of regional circuit law as it applies in patent litigation. The court may not be presented with a patent case providing the opportunity to overrule the Federal Circuit, and even if it were, the regional circuit might defer to the Federal Circuit's expertise regarding patent litigation.

To be sure, there is no way to clearly define the class of issues that are intertwined with patent law. But the broader point is to focus the court on the costs and benefits of interlocutory review. Mandamus might not be justified on an issue of regional circuit law that is in no way a consequence of the patent claims in the case. The Federal Circuit's decision would provide no definitive guidance and could easily be overruled by the regional circuit. By contrast, when an issue is a direct consequence of the patent claims in the case, the Federal Circuit can provide useful guidance that might outweigh the costs of a disruptive interlocutory appeal.

On questions of pure patent law, the optimal standard for Federal Circuit advisory mandamus is clearer. With the exception of the U.S. Supreme Court, the Federal Circuit is the final judicial arbiter of questions of patent law. Accordingly, the Federal Circuit should issue advisory mandamus on important, unresolved issues of patent law that cannot effectively be reviewed on a post-judgment appeal, a normative recommendation that seems to accord with the

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416. *See supra* text accompanying notes 99-110.

417. *See Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984) (*per curiam*).



court's current practice.<sup>418</sup> The difficult consideration here is defining which questions are worthy of interlocutory review. The Federal Circuit has only briefly alluded to the factors it considers in deciding to issue advisory mandamus. But a reconceptualization of mandamus standards would permit a fuller discussion.

A framework for Federal Circuit advisory mandamus should be stringent enough to deter petitions that are frivolous or filed only as a delay tactic. Yet it should preserve mandamus as an option in cases where the benefits of interlocutory review outweigh the substantial costs of disruption to the trial process. Drawing in part from factors considered important in cases decided by both the Federal Circuit and other courts, a framework for advisory mandamus in the Federal Circuit should impose the following requirements:

- (1) The question presented should be governed by Federal Circuit law or intertwined with the patent law.
- (2) The question presented should be one of first impression. If not, the court should hear the petition only if it intends to reconsider its prior decision.<sup>419</sup>
- (3) The issue should be likely to recur absent a definitive decision.<sup>420</sup>
- (4) The question presented should regularly evade review.<sup>421</sup> A petitioner can satisfy this requirement by showing that the alleged error would likely be held harmless on a post-judgment appeal and is thus unlikely to be raised by a savvy appellant.<sup>422</sup>
- (5) The petitioner should face a threat of immediate irreparable harm if the error is not corrected before appeal. This *immediate* irreparable harm should be something more than the fact that the error might be held harmless on appeal. Disclosure of documents protected by attorney-client privilege is a clear example of an immediate irreparable injury,<sup>423</sup> as is the disqualification of trial counsel,<sup>424</sup> and other examples may exist.
- (6) The question presented should be important; district courts, litigants, and the public should derive significant guidance from its resolution.<sup>425</sup> A prime indicator for a question's importance, and the quantum of guidance that its resolution would provide, is the scope

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418. See, e.g., *In re Deutsche Bank Trust Co. Ams.*, 605 F.3d 1373 (Fed. Cir. 2010) (patent-prosecution bar); *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc) (attorney-client privilege).

419. See, e.g., *Seagate*, 497 F.3d at 1367.

420. See *United States v. Horn*, 29 F.3d 754, 769-70 (1st Cir. 1994) (Selya, J.).

421. See *id.* at 770.

422. See 28 U.S.C. § 2111 (2006).

423. See *In re Regents of the Univ. of Cal.*, 101 F.3d 1386, 1387-88 (Fed. Cir. 1996).

424. See *In re Shared Memory Graphics LLC*, 659 F.3d 1336, 1340 (Fed. Cir. 2011).

425. *In re Bushkin Assocs., Inc.*, 864 F.2d 241, 247 (1st Cir. 1989) (Selya, J.).

of disagreement among the lower courts.<sup>426</sup>

An explicit discussion of these principles, which I have mostly synthesized from existing case law, would spur the court to consider the costs and benefits of an interlocutory decision on mandamus. Of course, it is not necessary for the Federal Circuit to adopt this six-element framework to conduct a thorough analysis of whether advisory mandamus is appropriate. And, because the lines between advisory and supervisory mandamus sometimes blur, the considerations I have outlined can be useful guideposts in deciding a wide array of mandamus petitions. Indeed, most of these elements would be useful to any appellate court refining the proper scope of mandamus, not just the Federal Circuit. My point is only that, if the Federal Circuit were to consciously reassess the role of mandamus, it could elaborate on specific considerations (such as the six I have outlined) that illuminate the costs and benefits of allowing a disruptive interlocutory appeal on an important, unsettled question of law.

3. *Insightful and Didactic Supervisory Mandamus on Non-Patent Questions.*—Returning specifically to supervisory mandamus, it is this use of the writ that has engendered the most confusion in the Federal Circuit, as shown by the courts' retreat from *Innotron*. If the Federal Circuit confronted *Innotron* and critically examined its own supervisory power, it might realize certain, limiting principles that could add significant coherence to the court's mandamus framework.

One possible limiting principle flows from the Federal Circuit's recent supervision of the transfer decisions of the Eastern District of Texas. Typically, courts use supervisory mandamus to fix one instance of an erroneous district court practice and to send a message that the practice is improper.<sup>427</sup> But, with the Eastern District of Texas, the Federal Circuit seems to have lost sight of the extraordinary nature of mandamus, granting the writ in ten similar cases.

This possible overuse of the writ is particularly problematic in the Federal Circuit. Because of the Federal Circuit's nationwide geographic jurisdiction, the court could provide significant guidance to all district courts through a judicious use of the writ. The Federal Circuit arguably dilutes the didactic message when it uses mandamus as what appears to be an error correction device, a perception that is exacerbated when the Federal Circuit grants mandamus by simply analogizing to its own case law on a matter that is supposedly governed by regional circuit law. One Federal Circuit case granting mandamus may be a teaching moment for district courts. For example, the Federal Circuit has made attention-getting statements in mandamus petitions dealing with attorney-client

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426. See *In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1310, 1313 (Fed. Cir. 2011) (holding that false marking claims must be pled with particularity, noting that this was a “question . . . of first impression” about which “trial courts have been in considerable disagreement”); *In re Deutsche Bank Trust Co. Ams.*, 605 F.3d 1373, 1375 (Fed. Cir. 2010) (granting mandamus on “an important issue of first impression in which courts have disagreed”).

427. See *supra* text accompanying notes 88-98.

privilege issues,<sup>428</sup> patent-prosecution bars,<sup>429</sup> and false marking claims.<sup>430</sup> Ten similar, fact-specific mandamus cases, however, may be too much to draw a district court's attention to the Federal Circuit's specific concerns.

The dilutive effect of this "supervisory plus" mandamus might be further enhanced in the Federal Circuit, which, as compared to the regional circuits, has fewer opportunities to informally reinforce the teaching points of its mandamus cases. Commentators have recognized the importance of informal interactions to supervisory mandamus, noting that "a petition for writ of mandamus may provoke one or more court[] of appeals judges to contact the district judge and informally suggest that he or she take steps to correct a problem."<sup>431</sup> While district judges regularly interact with their regional circuit judges outside of the adjudicative process (in circuit judicial conferences and on circuit judicial councils, for example), similar interaction with Federal Circuit judges historically has been rarer.<sup>432</sup> Thus, when issuing mandamus on issues of regional circuit law, the court should be very mindful of the writ's extraordinary character and use the writ carefully. This ensures that in the exceptional case when the writ does issue, district courts nationwide pay full attention to the guidance the Federal Circuit provides.

A counterargument to this point is that a small number of district courts, like the Eastern District of Texas, handle much, if not most, of the patent litigation in the United States. Those courts might understand the relevance of the Federal Circuit's pronouncements on important issues, even if the Federal Circuit is using mandamus so frequently as to make a mere footnote of the writ's extraordinary character. Moreover, the Federal Circuit's pronouncements might not be relevant to district courts that handle almost no patent cases. In short, it might not matter *how* the Federal Circuit is addressing the flaws it sees in certain courts' treatment of patent cases. The courts to which the Federal Circuit's decisions are relevant

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428. See, e.g., *In re Seagate Tech., LLC*, 497 F.3d 1360, 1367 (Fed. Cir. 2007) (en banc); *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 804 (Fed. Cir. 2000).

429. See *Deutsche Bank*, 605 F.3d at 1376.

430. See *BP Lubricants*, 637 F.3d at 1310-12.

431. TIGAR & TIGAR, *supra* note 3, at 193. While the authors concede that "[t]here is only anecdotal evidence on the prevalence of this 'informal mandamus jurisprudence'" they note that "it is frequently discussed at judicial conferences." *Id.* at 193-94.

432. Unlike in the regional circuits, district judges are not heavily involved in the Federal Circuit's judicial conference, see *CAFC Judicial Conference*, PATENT DOCS. (Apr. 9, 2010), <http://www.patentdocs.org/2010/04/cafc-judicial-conference.html>, and the Federal Circuit has no judicial council. That said, Chief Judge Rader's recent stint as a visiting judge in the Eastern District of Texas surely provided some opportunity for informal discussion. See *supra* notes 363-65 and accompanying text. Additionally, district judges who frequently hear patent cases, such as the judges of the Eastern District, have begun in recent years to sit by designation with the Federal Circuit. See *U.S. Court of Appeals for the Federal Circuit: Visiting Judges*, U.S. CT. APPEALS FED. CIRCUIT, [http://www.cafc.uscourts.gov/images/stories/announcements/VJ\\_Chart\\_for\\_Website\\_8.pdf](http://www.cafc.uscourts.gov/images/stories/announcements/VJ_Chart_for_Website_8.pdf) (last visited Mar. 2, 2012) (providing list of visiting judges who have sat with the Federal Circuit).

will invariably pay attention, and those that care little about patent cases will not.

But the simple fact that courts with patent-heavy dockets will likely pay more attention to the Federal Circuit should not excuse the Federal Circuit from maximizing the didactic function of mandamus. Even if the sheer quantity of mandamus petitions granted does not affect the writ's teaching function, the court could still better identify the issues on which supervisory mandamus is needed to teach a clear lesson to the district courts. One guide for the Federal Circuit could be to ensure that the writ issues only when it will effect real change in a district court's practice. In the Eastern District's venue cases, for example, some empirical evidence suggests that, contrary to conventional wisdom, the Eastern District transferred a proportion of its patent cases comparable to other judicial districts.<sup>433</sup> Consequently, special oversight of the court's venue decisions might not have been needed.<sup>434</sup>

By contrast, in other situations, the Federal Circuit's intimate familiarity with patent litigation and its major players might allow the court to see a need for supervision that other courts might miss. For example, in *Zimmer* and *Microsoft*, the court correctly identified the plaintiffs' attempts to manipulate venue.<sup>435</sup> Because the Federal Circuit is uniquely aware of the tactics employed by serial patent litigants (such as non-practicing entities and their counsel), it was not fooled by the plaintiff's establishment of an "office" in Texas<sup>436</sup> or pre-suit incorporation in the state.<sup>437</sup> Moreover, the court used appropriately aggressive language in making clear that plaintiffs may not game the system to establish venue.<sup>438</sup> This language sends a clear message to courts about when transfer should be granted in future cases—exactly what supervisory mandamus is supposed to do. Similarly, in *Vistaprint*, the court drew upon its understanding of the technological complexity of patent litigation to ensure that a patent case remained before a court that was familiar with the technology at issue.<sup>439</sup>

By considering whether its supervision can meaningfully impact a district court's practice, send a clear teaching message, provide unique insight into the

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433. See Janicke, *Patent Venue*, *supra* note 259, at 20-21.

434. To be sure, the data also suggests that the Eastern District denied a higher percentage of transfer motions than other leading patent districts. See *id.* at 22-23. But, for mandamus purposes, what the data shows is that the Eastern District was not so blatantly flouting the law of § 1404(a) as to unquestionably warrant supervisory plus mandamus.

435. *In re Microsoft Corp.*, 630 F.3d 1361, 1365 (Fed. Cir. 2011) (per curiam); *In re Zimmer Holdings, Inc.*, 609 F.3d 1378, 1381-82 (Fed. Cir. 2010).

436. *Zimmer*, 609 F.3d at 1381-82.

437. *Microsoft*, 630 F.3d at 1365.

438. See *id.* at 1364 (rejecting the plaintiff's argument against transfer as "rest[ing] on a fallacious assumption: that this court must honor connections to a preferred forum made in anticipation of litigation and for the likely purpose of making that forum appear convenient"); *Zimmer*, 609 F.3d at 1381 ("This is a classic case where the plaintiff is attempting to game the system by artificially seeking to establish venue by sharing office space with another of the trial counsel's clients.").

439. *In re Vistaprint, Ltd.*, 628 F.3d 1342, 1346-47 (Fed. Cir. 2010).

facts on the ground, or better account for the realities of patent litigation, the Federal Circuit can better identify the cases that warrant the extraordinary remedy of mandamus. The end result of this inquiry may be that the Federal Circuit issues mandamus in fewer venue cases from the Eastern District, where aggressive supervision might be unnecessary, but is more alert to jurisdictional tricks employed by litigants in venues that are vying to replace the Eastern District as the hotbed for patent litigation, such as the Western District of Wisconsin.<sup>440</sup> The court might also use broader and more aggressive language to make the standards for mandamus and for transfer of venue as clear as possible, in an effort to reduce the need for case-by-case supervision of the Eastern District.

In sum, the Federal Circuit's singular nature suggests that the mandamus standards that work for the regional circuits will not necessarily work for the Federal Circuit. A common criticism of the Federal Circuit is that it refuses to engage broader policy concerns in its decisions, and instead develops a formalistic, context-insensitive jurisprudence that inhibits the development of "optimal rules."<sup>441</sup> If the Federal Circuit were to confront *Innotron* and the reasoning behind it, rather than distinguishing, downplaying, or ignoring the case, the court could develop a more refined mandamus framework that accounts for its choice-of-law constraints, its *sui generis* jurisdictional structure, and its superior understanding of the realities of patent litigation.

#### CONCLUSION

Federal Circuit mandamus is at a critical juncture. It has been over twenty years since the court, in *Innotron*, last examined the role of Federal Circuit mandamus in the federal scheme for resolving patent disputes. Because the court has not engaged in any introspection, it has drifted toward a standard under which it will consider any issue of regional circuit law on mandamus, so long as the underlying case would ultimately be appealed to the Federal Circuit. That standard might work for the regional circuits, which are almost always applying their own circuit's law and reviewing a narrow group of district judges with whom they frequently interact. The Federal Circuit, however, with its uniquely broad geographic jurisdiction and uniquely narrow subject-matter jurisdiction, might require a more refined standard.

The repeated issuance of mandamus to the Eastern District of Texas does not reflect any effort to account for the Federal Circuit's uniqueness. Instead, it resembles interlocutory error correction under Federal Circuit law, a model of

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440. Cf. *In re Affymetrix, Inc.*, Misc. No. 913, 2010 WL 1525010, at \*1-2 (Fed. Cir. Apr. 13, 2010) (denying mandamus petition that sought transfer from the Western District of Wisconsin to the Northern District of California, even though the defendant's employee-witnesses, all six third-party witnesses, the development and marketing documents, and the accused product itself, were located in California).

441. E.g., Rochelle Cooper Dreyfuss, *The Federal Circuit as an Institution: What Ought We to Expect?*, 43 LOY. L.A. L. REV. 827, 833-34 (2010).

mandamus that this Article has termed “supervisory plus” mandamus. The court could certainly fix the shortcomings of its mandamus doctrine and practice. It should begin from the premise that Federal Circuit mandamus on non-patent issues is, in general, useful and efficient. The court should be fully aware of the need to use the writ judiciously, and could preserve its didactic function by reserving the writ for situations where, as judged from the Federal Circuit’s unique position as appellate forum for nearly all patent cases, serious change is needed in a district court’s practice. This approach would recognize that the Federal Circuit is a federal appellate court like no other, while also ensuring that mandamus remains an option in those extraordinary situations in which the benefits of immediate review outweigh its substantial costs.