No. 19-58

IN THE

Supreme Court of the United States

XITRONIX CORPORATION,

Petitioner,

v.

KLA-TENCOR CORPORATION, DBA KLA-TENCOR, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

AARON G. FOUNTAIN
Counsel of Record
JOHN M. GUARAGNA
DLA PIPER LLP (US)
401 Congress Ave.
Suite 2500
Austin, TX 78701
(512) 457-7000
aaron.fountain@us.dlapiper.com

Counsel for Respondent

August 23, 2019

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

RULE 29.6 STATEMENT

Respondent KLA-Tencor Corporation (now known as KLA Corporation) has no parent corporation and no publicly traded corporation owns 10% or more of its stock.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

TABLE OF AUTHORITIES—Continued

INTRODUCTION

Xitronix's petition is a follow-on to its petition for certiorari in No. 18-1170. The petition in No. 18-1170 challenged the Fifth Circuit's order transferring the case back to the Federal Circuit. The current petition (No. 19-58) mostly duplicates the petition in No. 18-1170 and is simply directed to the Federal Circuit's judgment summarily affirming the summary judgment against Xitronix on its standalone *Walker Process* claim. *See* Pet. 3 n.1. Both petitions raise only the question of which circuit should have exercised jurisdiction; there is no question relating to the underlying merits of the standalone *Walker Process* claim. In essence, the current petition is just a procedural box-checking exercise for Xitronix with no additional substantive dimension.

By the time KLA filed its brief in opposition to the petition in No. 18-1170, the Federal Circuit already had issued its summary affirmance. There have been no further developments that might affect whether certiorari is appropriate here. Accordingly, this brief in opposition largely duplicates KLA's response in No. 18-1170. The main text remains substantively the same as in the prior response, with updated citations and minor wording changes to fit the current petition and appendix. Several footnotes have been added to respond briefly to points to which Xitronix has given additional emphasis since KLA filed its response in No. 18-1170; the original response had no footnotes. These are the only substantive changes, and they are placed in footnotes for ease of reference.

* * *

Xitronix sought certiorari to end what it predicted would be an otherwise-interminable game of jurisdictional ping pong between the Fifth and Federal Circuits. That prediction proved wrong. Consistent with this Court's instructions in *Christianson v. Colt*, 486 U.S. 800 (1988), the Federal Circuit accepted jurisdiction under the law of the case doctrine because it found the Fifth Circuit's transfer decision plausible. This resolved the jurisdictional question in the case and extinguished the primary basis of Xitronix's request for certiorari. There is accordingly no need for this Court's intervention.

In fact, this Court in *Christianson* emphasized that it would be undesirable to devote any portion of its limited docket to such particularized jurisdictional disputes between two courts of appeals. That is precisely why this Court directed the courts of appeals to employ the tools of the law of the case doctrine to resolve these disputes themselves. The Fifth and Federal Circuits followed those instructions to arrive at a final answer on jurisdiction here. After-the-fact intervention from this Court would erode *Christianson* by encouraging the circuits to look increasingly to this Court to decide routine jurisdictional disputes that they already are equipped to resolve themselves. There is no good reason to turn back the clock in this manner.

Once the principal foundation of its initial petition crumbled, Xitronix has tried to salvage the petition by playing up the Fifth and Federal Circuits' original difference of opinion on jurisdiction. But there is no circuit split that requires this Court's intervention because the courts ultimately agreed that the Fifth Circuit's decision was plausible. On that point, there is no circuit split.

Moreover, the now-resolved jurisdictional dispute arose in a very particular context: an appeal of a final judgment on a standalone *Walker Process* claim that was raised in a plaintiff's complaint and not as a counterclaim to a patent infringement lawsuit. Xitronix piles on layers of speculation that a hypothetical future plaintiff might replicate its peculiar *Walker Process*-only lawsuit in a different regional circuit and ultimately find itself litigating an appeal in that circuit, thus producing a split with the Fifth Circuit. But no such circuit split exists today. And there is no urgent need to foreclose such a remote scenario before it can ever come to pass. In the unlikely event such a circuit split arises, it can be dealt with then, with the benefit of further percolation and something more than a theoretical conflict. This case is not an appropriate vehicle for review.

All that remains of Xitronix's argument is an improper invitation for this Court to legislate. Xitronix effectively asks this Court to overrule *Christianson* and rewrite the relevant jurisdictional statutes to send all appeals concerning *Walker Process* claims to the regional circuits. But Congress chose to use the more general words "arising under" for assessing patent-related jurisdiction. It did not enact the special, bright-line rule for *Walker Process* claims that Xitronix now demands. This Court interpreted and applied that language in *Christianson* more than three decades ago. Nothing in the intervening time has rendered that decision obsolete, nor proven it to be unreasonable or unworkable. Moreover, Congress has not seen fit to overrule *Christianson*—despite having modified the same subsection of the same appellate jurisdictional statute to *enlarge* the Federal Circuit's exclusive jurisdiction in response to a different decision from this Court during that time. Because Congress remains

free to take contrary action, *stare decisis* applies with especial vigor to this Court's precedents interpreting statutes. And because Congress has in fact acted in an adjacent area since *Christianson* was decided, the force of precedent is near its zenith here. Review is unwarranted.

Finally, the Fifth Circuit was correct to transfer the case to the Federal Circuit, and the Federal Circuit correctly accepted jurisdiction under *Christianson*. There can be no serious dispute that, under *Christianson* itself, Xitronix's appeal belongs in the Federal Circuit. The only remaining question was whether *Gunn v. Minton*'s later analysis of the dividing line between state and federal jurisdiction silently modified this Court's *Christianson* holding regarding the allocation of *Walker Process* appeals among the federal courts of appeals in indisputably federal cases. As the Fifth Circuit correctly explained, *Gunn* clearly did not have this effect. Whether viewed afresh or through the lens of *Christianson*'s plausibility standard, there was no error here nor any other reason for this Court's review.

The petition for certiorari should be denied.

BACKGROUND

The background of this case is set forth in detail in the opinions included in the appendix to the petition. The facts most relevant to appellate jurisdiction are summarized below.

Petitioner Xitronix Corporation ("Xitronix") filed a complaint in federal district court alleging a stand-alone claim under *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.*, 382 U.S. 172 (1965). Pet. App. 11a, 39a, 74a-78a. Specifically, Xitronix alleged only a single cause of action for attempted monopolization. *Id.* And the sole theory underlying its claim of

anticompetitive conduct was that Respondent KLA-Tencor Corporation ("KLA") had allegedly prosecuted and obtained a patent through fraud on the United States Patent and Trademark Office. *Id.* No other claims or theories were ever added to the case. *Id.*

Xitronix eventually lost summary judgment on its standalone *Walker Process* claim. Pet. App. 70a-93a. Again, no other claims or antitrust theories were pled in the complaint or litigated in the case. Fraud on the Patent Office was an essential element of Xitronix's only cause of action. The district court ruled that there were no genuine issues of material fact and KLA was entitled to judgment as a matter of law on this claim. *Id.*

Xitronix filed its notice of appeal in the United States Court of Appeals for the Federal Circuit. Pet. App. 16a. Both Xitronix and KLA agreed that the Federal Circuit had jurisdiction over the appeal. Pet. App. 16a, 39a-40a. The parties agreed on this point in the original appeal briefing, in the supplemental briefing that the Federal Circuit ordered before oral argument, at the Federal Circuit oral argument, and in the supplemental briefing that the Federal Circuit ordered to be filed after oral argument. *Id.* On no fewer than these four discrete occasions, Xitronix told the Federal Circuit unequivocally that it had jurisdiction over the appeal.

The Federal Circuit disagreed with the parties on jurisdiction and transferred the case to the Fifth Circuit. Pet. App. 38a-49a. The principal basis for the Federal Circuit's transfer decision was its mistaken view that this Court's decision in *Gunn v. Minton*, 568 U.S. 251 (2013), governed the determination of which federal court of appeals had jurisdiction over

Xitronix's appeal in an indisputably federal lawsuit. Pet. App. 41a-48a.

Suddenly, Xitronix abandoned its oft-stated position that the Federal Circuit had jurisdiction. Pet. App. 17a n.7. Making a complete about-face, Xitronix decided it wanted to be in the Fifth Circuit instead. Xitronix thus opposed KLA's petition for rehearing *en banc*, which the Federal Circuit subsequently denied. Pet. App. 50a-52a.

The Fifth Circuit then applied this Court's framework in *Christianson v. Colt* to determine whether it should accept the transfer under the law of the case doctrine. Pet. App. 8a-37a. The Fifth Circuit found the Federal Circuit's transfer decision implausible. *Id.* The Fifth Circuit reasoned, in short, that the Federal Circuit clearly had exclusive jurisdiction under *Christianson*, that *Gunn* could not be interpreted to have altered this framework, and that the appeal was clearly within the Federal Circuit's jurisdiction even if *Gunn* did apply. *Id.* The Fifth Circuit therefore sent the case back to the Federal Circuit. *Id.*

Xitronix then filed its petition for certiorari in No. 18-1170, based chiefly on the premise that only this Court's intervention could prevent an endless game of jurisdictional ping pong. But Xitronix's petition overlooked a crucial remaining possibility: that the Federal Circuit would find the Fifth Circuit's transfer decision plausible under *Christianson* and therefore accept jurisdiction under the law of the case doctrine.

That is exactly what happened. The Federal Circuit issued an order that, while criticizing certain aspects of the Fifth Circuit's reasoning, found the regional circuit court's transfer order plausible under *Christianson.* Pet. App. 3a-7a. The Federal Circuit therefore accepted

jurisdiction, *id.*, and later affirmed the summary judgment on the merits, Pet. App. 1a-2a.

Xitronix then filed this petition for certiorari from the Federal Circuit's judgment based on the same jurisdictional arguments it made in the pending petition in No. 18-1170.

REASONS FOR DENYING THE PETITION

The petition for certiorari should be denied.

I. There Is No Threat of Endless Jurisdictional Ping Pong

As Xitronix has previously acknowledged, the primary basis for its original petition for certiorari has now evaporated. No. 18-1170, Supp. Pet. Br. 2. The Federal Circuit properly exercised jurisdiction over the matter because it found the Fifth Circuit's transfer decision to be plausible. Pet. App. 3a-7a. This decision terminated what Xitronix had incorrectly predicted would be an interminable game of jurisdictional ping pong between the two courts. It likewise extinguished any potential need for this Court's intervention.

In fact, the process in this case played out as this Court had prescribed in *Christianson*. In *Christianson*, this Court instructed the courts of appeals to apply the law of the case doctrine to transfer decisions and accept jurisdiction where it found a transfer decision plausible. 486 U.S. at 818-19. The Court gave this instruction precisely so that it would not need to intervene in every particularized jurisdictional disagreement between two circuits. *Id.* To grant review would undermine this core tenet of *Christianson* by encouraging the courts of appeals to look increasingly to this Court to decide particularized inter-circuit jurisdictional disputes they are equipped to resolve themselves.

Contrary to Xitronix's suggestion, the Federal Circuit in this case did not simply decide the appeal under protest like it did in *Christianson*. Pet. 17-18. Instead, the Federal Circuit properly examined the Fifth Circuit's decision under *Christianson*'s "plausibility" standard. Pet. App. 3a-7a. While Xitronix plays up the Federal Circuit's criticism of particular *aspects* of the Fifth Circuit's reasoning, Pet. 12-13, the Federal Circuit expressly found the Fifth Circuit's underlying transfer decision to be plausible as a whole, Pet. App. 6a-7a.

That the Federal Circuit and the Fifth Circuit disagreed on jurisdiction as an original matter is unremarkable. The very nature of the plausibility standard means that a court of appeals may accept jurisdiction in cases where, if left entirely to its own devices, it would have rejected jurisdiction. Yet this Court need not intervene to resolve those disagreements. In fact, this Court expressly advised that it should *not* be called upon to resolve these disputes when—as here—the circuits themselves prove up to the task through their use of the law of the case doctrine. *Christianson*, 486 U.S. at 818-19. Intervention into this particularized, now-resolved inter-circuit jurisdictional dispute is therefore unnecessary.

II. There Is No Circuit Split that Matters Here

Deprived of its principal ground for certiorari, Xitronix insists there is still a circuit split that needs to be resolved here. Pet. 13-14. But that is not so. With this particular jurisdictional dispute resolved, any remaining disagreement between the two courts of appeals does not warrant review here.

The Federal and Fifth Circuits initially disagreed on whether the Federal Circuit had exclusive jurisdiction over Xitronix's appeal. Again, there is nothing remark-

able about that. *Christianson* contemplates these types of disagreements and illuminates the proper mechanism to resolve them: accept transfer under the law of the case doctrine if the transfer decision is "plausible." 486 U.S. at 818-19.

It is reasonable to expect that, in most cases, the original transferee court will accept jurisdiction as plausible. But the plausibility standard is not just a rubber stamp, and courts are not supposed to accept jurisdiction out of mere resignation or protest. *See Christianson*, 486 U.S. at 818-19. Here, the Fifth Circuit found the Federal Circuit's original transfer decision implausible. The Federal Circuit then determined the Fifth Circuit's transfer decision to be plausible. Ultimately, therefore, the courts arrived at the same result. The original difference of opinion does not yield a circuit split that requires this Court's intervention.[1]

Xitronix hypothesizes that the Federal Circuit's original transfer decision portends future division. But there is no need to take this case to address these highly speculative concerns.

For example, Xitronix speculates that this issue might arise again between the Fifth Circuit and Federal Circuit. Pet. 16-17. This, of course, would require an appeal arising in exactly the same unusual procedural posture of this case: (1) an antitrust claim that is based *solely* on a *Walker Process* theory of fraud on the Patent Office, (2) where that claim is raised in the plaintiff's

---

[1] In light of these facts, Xitronix's insistence that *Christianson*'s law-of-the-case "failsafe did not work" is incorrect. Pet. 18. It did work: the case is not endlessly ping-ponging back and forth between the circuits, and the Federal Circuit accepted jurisdiction because it found the Fifth Circuit's transfer decision plausible under *Christianson*.

complaint (and not, for example, as a counterclaim to a patent infringement complaint), (3) where there is no other basis for the Federal Circuit's exclusive jurisdiction, and (4) the complaint is filed in a district court within the Fifth Circuit. This remote scenario is hardly a basis for certiorari here.

Nor does this scenario raise the forum-shopping concerns that Xitronix alleges, Pet. 22-23. In the above hypothetical scenario, the case will be transferred to the Federal Circuit regardless of whether the appeal is filed initially in the Fifth Circuit or (as in this case) in the Federal Circuit. And a true conflict will arise only if that future Federal Circuit panel acts in a manner opposite of the panel in this case without *en banc* remediation.

Xitronix also hypothesizes that a carbon-copy lawsuit might generate a conflict if filed in a district court within a regional circuit other than the Fifth Circuit. Pet. 22-23. In that scenario—already highly speculative—it would require the regional circuit to act in a manner contrary to the Fifth Circuit here. If the appeal is filed originally in the regional circuit, it would need to accept jurisdiction. If the appeal is filed originally in the Federal Circuit and then transferred, it would require the regional circuit to find the Federal Circuit's transfer decision plausible. Only then might there be a split of real consequence, and it technically would be among the regional circuits. Such highly-attenuated chains of events hardly justify certiorari in a matter where the case-specific jurisdictional dispute has already been resolved in the manner this Court prescribed in *Christianson.*

III. There Is No Need or Justification to Revisit *Christianson*

The residue of Xitronix's petition is essentially a call for this Court to overrule *Christianson* and rewrite 28 U.S.C. § 1295(a)(1)'s legislative prescription of "arising under" jurisdiction. Reaching beyond the narrow procedural confines of this case—and again contradicting the position it repeatedly urged upon the Federal Circuit—Xitronix now advocates that *all* appeals involving a *Walker Process* theory should go to the regional circuits. At least two fundamental doctrines militate strongly against Xitronix's invitation.

First, Xitronix has not shown why this Court should even contemplate departing from *stare decisis* by overruling *Christianson*. Nothing about the *Christianson* decision has proven conceptually unsound or practically unworkable in the 30-plus years since its issuance. Xitronix nonetheless complains that *Christianson* requires a case-specific analysis of whether an antitrust claim that may be imbued with a patent-law theory falls within or outside the Federal Circuit's jurisdiction. But this hardly justifies overruling longstanding precedent for resolving these questions.

For one thing, in many cases, this line-drawing is not particularly difficult. Here it was easy: Xitronix pled and litigated throughout the case only a single antitrust claim based solely on a *Walker Process* theory of fraud on the Patent Office. *Christianson* provides a clear answer to the question of appellate jurisdiction in such cases. 486 U.S. at 809-813.

Moreover, line-drawing is the essence of the law, and those lines are not always bright. Most of all, the need to draw lines here is a result of Congress's decision to use the phrase "any civil action arising

under [the patent laws]" in 28 U.S.C. § 1295(a)(1). *Christianson* interpreted and applied this statutory language in a manner that has proven workable to resolve jurisdictional issues in this and other cases. Xitronix has not established any of the factors that might warrant an exceptional departure from precedent here. And *stare decisis* applies with "special force" to such statutory interpretation precedents because of Congress's preeminent role in shaping policy through legislation. *Patterson v. McLean Credit Union*, 491 U.S. 164, 172 (1989). Congress can legislatively overrule an interpretive decision of this Court with which it is dissatisfied and, as discussed below, it notably has declined to do so here.

Second, acceptance of Xitronix's argument would effectively rewrite the relevant jurisdictional statutes. Congress gave the Federal Circuit exclusive jurisdiction over appeals in "any civil action arising under [the patent laws]." Xitronix's proposal to send all appeals involving *Walker Process* theories—both "standalone" *Walker Process* claims and "one theory among several" claims—to the regional circuits would effectively amend the statute. *Christianson*'s interpretation of Congress's "arising under" language would be replaced with a judicially-crafted bright-line rule.[2] Xitronix's sweeping

---

[2] In *Gunn*, this Court declined to articulate a bright-line test for whether a case fits the "special and small category" of cases that "arise under" federal law even though federal law did not create the cause of action. 568 U.S. at 258 (observing the contours of prior cases resembled a Jackson Pollock canvas and imposing a four-part test); *see also Grable & Sons Metal Products, Inc. v. Darue Engineering & Mfg.*, 545 U.S. 308, 314 (2005) ("[T]he presence of a disputed federal issue and the ostensible importance of a federal forum are never necessarily dispositive; there must always be an assessment of any disruptive portent in exercising federal jurisdiction."); *Christianson*, 486 U.S. at 821 (observing

request is not a call for genuine judicial decision-making, but rather an improper invitation to engage in judicial legislation. And to what end? Xitronix has not shown that *Christianson* has proven unsound or unworkable—either before or after *Gunn*—such that this extraordinary step is warranted. And even if reform were somehow warranted, Congress is the appropriate forum for Xitronix's petition—not the courts.

Respect for the legislative design is especially warranted here. Congress not only has left the relevant jurisdictional language unchanged in the three-plus decades after *Christianson*, but it also has amended other language in precisely the same statutory subsection in response to a subsequent decision of this Court. Specifically, in the 2011 America Invents Act, Congress amended 28 U.S.C. § 1295(a)(1) to legislatively overrule this Court's decision in *Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*, 535 U.S. 826 (2002). *See* Leahy-Smith America Invents Act sec. 19, Pub L. No. 112-29, 125 Stat. 284, 332 (2011). In that amendment, Congress expanded § 1295(a)(1) to give the Federal Circuit appellate jurisdiction over compulsory patent and plant-variety protection counterclaims. Yet Congress left § 1295(a)(1)'s "arising under" language unchanged and did nothing else to modify the effect of *Christianson*. These circumstances further counsel against certiorari in this case. *See Faragher v. City of Boca Raton*, 524 U.S. 775, 792 (1998) ("And the force of precedent here is enhanced by Congress's amendment to the liability provisions of Title VII since the *Meritor* decision, without providing any modification of our holding.").

---

that "whether a claim arises under the patent laws" has "no single, precise, all-embracing definition") (Stevens, J., concurring).

In sum, once the threat of endless jurisdictional ping pong vanished, so did any potential need for review. Neither the alleged circuit split nor Xitronix's policy arguments justify review—especially in an area where this Court already has extolled the virtue of circuit-level resolution *without* its intervention. The petition therefore should be denied.

IV. Xitronix Overstates the Importance of This Case

The jurisdictional issue in this case is tethered to a particular type of claim arising in an atypical procedural posture. Xitronix has offered no good reason to believe that standalone *Walker Process* claims raised in a complaint, accompanied by no theory of antitrust liability other than alleged fraud on the Patent Office, will be anything more than a very rare occurrence. *See Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1067 (Fed. Cir. 1998) (en banc) ("[A]n antitrust claim premised on stripping a patentee of its immunity from the antitrust laws is typically raised as a counterclaim by a defendant in a patent infringement suit.").

Xitronix misuses Judge Newman's dissent from the denial of rehearing *en banc* as purported evidence that this issue is of great national importance *regardless* of how it is decided. Pet. 24. But that is not what the dissent signifies. Judge Newman's point was simply that if the Federal Circuit were to initiate such a major change in patent jurisdiction, then the court should consider the issue *en banc*. Pet. App. 53a-54a, 68a-69a. A major change of course did not happen here because the Federal Circuit ultimately accepted jurisdiction. So the legitimate concerns raised by Judge Newman's dissent are no longer at stake in this case.

Moreover, if the Federal Circuit's initial decision disclaiming jurisdiction in this case were to become relevant in future litigation and yield a different ultimate result, the Federal Circuit itself may very well choose to resolve the issue *en banc* at that time. In all events, there is no need for this Court to intervene now.[3]

Xitronix's allegations of "widespread national confusion" (Pet. 19) are chimerical. Of the three other circuit cases it cites, only one involved a *Walker Process* theory. *See In re Lipitor Antitrust Litig.*, 855 F.3d 126 (3d Cir. 2017). The Third Circuit resolved that case easily under *Christianson* because the "plaintiffs could obtain relief on their section 2 monopolization claims by prevailing on an alternative, non-patent-law theory." *Id.* at 146. The court expressly noted that it did not need to address any potential question raised by *Gunn*. *Lipitor*, 855 F.3d at 146. The other two cases merely involved fact-specific applications of *Gunn* to state-law claims. *See Seed Co. Ltd. v. Westerman*, 832 F.3d 325 (D.C. Cir. 2016); *MDS (Canada) Inc. v. Rad Source Techs., Inc.*, 720 F.3d 833 (11th Cir. 2013).[4]

---

[3] Indeed, even if Xitronix's prediction that "there will inevitably be more instances in which cases are transferred back and forth between regional circuits and the Federal Circuit" (Pet. 22) were to prove true, then that simply would mean this Court will have opportunities to decide whether a more appropriate vehicle warrants review. For example, in such a hypothetical case, it is possible that neither circuit will find the other's transfer decision plausible—unlike what happened here. A more appropriate vehicle would also involve a petitioner who—unlike Xitronix here—took a consistent position throughout rather than engaging in mid-case forum-shopping.

[4] Rather than "widespread confusion," these cases demonstrate that *Christianson*'s test applies to indisputably federal causes of action that raise embedded patent law issues and that *Gunn*'s test,

Xitronix's policy concerns about calling upon the Federal Circuit to sometimes resolve antitrust claims are also overblown. Pet. 28-29. This can happen in other circumstances, such as when antitrust claims are brought along with or as counterclaims to patent infringement claims. And in these circumstances, Congress has seen fit for the Federal Circuit to exercise exclusive jurisdiction over the entire appeal—not just the patent infringement claims—even where there are no patent-law issues on appeal. *See* 28 U.S.C. § 1295(a)(1). The only legislative policy that is clearly at stake is the need for legal uniformity and judicial expertise in patent cases—not any notion that the Federal Circuit will be any less competent to resolve antitrust issues than the regional circuits. *See Christianson*, 486 U.S. at 813 (noting that "one of Congress' objectives in creating a Federal Circuit with exclusive jurisdiction over certain patent cases was 'to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist[ed] in the administration of patent law'") (citing H.R. Rep. No. 97-312, p. 23 (1981)). If Congress is dissatisfied with the policy decision it made in this regard, then Congress is free to amend the statute it enacted. Xitronix's invitation for this Court to pick up the legislative pen itself should be declined.

---

with its federalism principles, applies to determine whether state law causes of action nevertheless arise under the federal patent laws. *Compare Lipitor*, 855 F.3d at 146 (applying *Christianson* to federal antitrust claim), *with Seed Co.*, 832 F.3d at 331 (applying *Gunn* to state law malpractice claim that satisfied requirements of diversity jurisdiction), and *MDS (Canada)*, 720 F.3d at 841-42 (applying *Gunn* to state law breach of contract claim that satisfied requirements of diversity jurisdiction).

Finally, this case does not involve any of the federalism stakes that animated this Court's decision in *Gunn*. Rather, the case concerns only the allocation of jurisdiction among the federal courts of appeals over indisputably federal claims. And as explained above, there is no need to revisit a matter that this Court settled in *Christianson*—especially where Congress has seen fit to leave *Christianson* alone while abrogating the subsequent *Holmes Group* decision in amending other language in the same statutory subsection.

V. The Federal Circuit Has Jurisdiction In Any Event

Certiorari is unwarranted for all the above reasons. In addition, the Fifth Circuit's decision and the Federal Circuit's ultimate acceptance of jurisdiction were correct.

The Fifth Circuit's decision and Federal Circuit Judge Newman's opinion explain in detail why jurisdiction lies in the Federal Circuit here. Pet. App. 8a-37a, 53a-69a. In short, *Christianson* prescribed the test for determining whether the Federal Circuit has exclusive appellate jurisdiction over a *Walker Process* claim. *See Christianson*, 486 U.S. 809-10 (holding that the Federal Circuit has appellate jurisdiction in "cases in which a well-pleaded complaint establishes either that federal patent law creates the cause of action or that the plaintiff's right to relief necessarily depends on resolution of a substantial question of federal patent law, in that patent law is a necessary element of one of the well-pleaded claims," whereas "a claim supported by alternative theories in the complaint may not form the basis for [Federal Circuit] jurisdiction

unless patent law is essential to each of those theories").[5] This Court's decision in *Gunn* neither expressly nor implicitly revoked this framework for analyzing appellate jurisdiction over *Walker Process* claims.

Rather, *Gunn* involved a state-law legal malpractice claim that contained a patent-related "case within a case." 568 U.S. at 259. This Court defined the issue solely in terms of federal vs. state domains: "The question presented is whether a state law claim alleging legal malpractice in the handling of a patent case must be brought in federal court." *Id.* at 253. The Court likewise defined the broader inquiry in terms of federal vs. state interests: "Does the 'state-law claim necessarily raise a stated federal issue, actually disputed and substantial, which a federal forum may entertain

---

[5] An antitrust claim premised solely on a *Walker Process* theory necessarily depends on the resolution of two substantial questions of federal patent law: (1) whether there has been a fraud on the Patent Office and (2) whether there has been enforcement of a patent. *Walker Process*, 382 U.S. at 174 ("the *enforcement of a patent* procured by *fraud on the Patent Office* may be violative of § 2 of the Sherman Act provided the other elements necessary to a § 2 case are present") (emphasis added). The petition misreads *Christianson* when it incorrectly argues that because a standalone *Walker Process* claim may rise or fall on the "other elements necessary to a § 2 case," the patent procurement and enforcement elements are insubstantial under *Christianson*. Pet. 25-26. *Christianson* also involved a § 2 attempted monopolization claim, which Xitronix notes requires "[attempted] monopolization of a relevant market" even for *Walker Process* claims. Pet. 25-26. Relying on such elements to conclude that the patent law elements can never be substantial under *Christianson* would nullify the *Christianson* test and render the decision nonsensical. Why would the Court have focused the analysis on whether a substantial question of patent law is essential to all theories of recovery if all it needed to do was point to an antitrust element as a basis for sending all such claims to the regional circuits?

without disturbing any congressionally approved balance of federal and state judicial responsibilities'?" *Id.* at 258 (quoting *Grable & Sons Metal Products, Inc. v. Darue Engineering & Mfg.*, 545 U.S. 308, 314 (2005)). The Court then applied a legal test framed in terms of federal vs. state interests: "federal jurisdiction over a state law claim will lie if a federal issue is: (1) necessarily raised, (2) actually disputed, (3) substantial, and (4) capable of resolution in federal court without disrupting the federal-state balance approved by Congress." *Id.* And the Court couched its holding solely in terms of federal vs. state interests: "we are comfortable concluding that state legal malpractice claims based on underlying patent matters will rarely, if ever, arise under federal patent law for purposes of §1338(a). Although such cases may necessarily raise disputed questions of patent law, those cases are by their nature unlikely to have the sort of significance for the federal system necessary to establish jurisdiction." *Id.* at 258-59.

This Court gave no reason to believe that *Gunn*'s element of "capable of resolution in federal court without disrupting the federal-state balance approved by Congress" would govern appellate jurisdiction over indisputably federal standalone *Walker Process* claims like the one Xitronix asserted here. Rather, *Christianson* had already supplied all the tools necessary to resolve the appellate jurisdictional task in cases like this one. There is no plausible reason to believe that, in tackling the deeper issues posed by questions of state vs. federal original jurisdiction in *Gunn*, the Court silently disrupted *Christianson*'s settled allocation of federal appellate jurisdiction over federal antitrust claims involving *Walker Process* theories among the federal courts of appeals. In fact, in *Gunn*, this Court cited *Christianson* for a background legal premise without

once stating or suggesting it was calling into question any aspect of its *Christianson* decision. *Gunn*, 568 U.S. at 257.

To the extent, as Xitronix alleges, there may be some uncertainty about the application of *Gunn* in other contexts, this case is an easy one that does not implicate those other factual scenarios. After all, *Christianson* resolved precisely the jurisdictional question presented by Xitronix's *Walker Process* theory: is patent law a necessary element of Xitronix's antitrust claim? And as the Fifth Circuit explained, there is no plausible argument for regional circuit jurisdiction even if *Gunn*'s state vs. federal framework were applied to this situation. Pet. App. 31a-32a (analyzing forward-looking challenge to validity of patent, requirement that a given statement or omission is "material to patentability," and potential to prescribe standards of conduct for practitioners before the PTO). Regardless of whether a substantial case for certiorari ever arises in those other contexts, this case would be a poor vehicle for advisory guidance on issues not presented.

CONCLUSION

Over thirty years ago, this Court showed the courts of appeals the path to resolve jurisdictional disagreements like the one that arose here without needing this Court's intervention every time. Despite their initial disagreement, the Fifth and Federal Circuits properly resolved the jurisdictional dispute under *Christianson*. There is accordingly no circuit split that matters here. Nor is there any other need for this Court's intervention. The petition for certiorari therefore should be denied.

Respectfully submitted,

AARON G. FOUNTAIN
Counsel of Record
JOHN M. GUARAGNA
DLA PIPER LLP (US)
401 Congress Ave.
Suite 2500
Austin, TX 78701
(512) 457-7000
aaron.fountain@us.dlapiper.com

Counsel for Respondent

August 23, 2019