No. _____

In the
Supreme Court of the United States

WARSAW ORTHOPEDIC, INC., MEDTRONIC, INC., MEDTRONIC SOFAMOR DANEK, INC.,

Petitioners,

v.

RICK C. SASSO, M.D.,

Respondent.

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

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Pursuant to 28 U.S.C. §1338(a), federal courts have *exclusive* jurisdiction over all cases arising under federal patent law; that jurisdiction is exclusive of state courts, which are *explicitly prohibited* from adjudicating such cases. Petitioners brought this suit in federal court seeking a declaration that its products were not covered by valid patent claims and thus they did not owe respondent damages. The district court assumed it had exclusive jurisdiction to hear petitioners' claims, but "abstain[ed]" from resolving them—deferring instead to a "mirror image" Indiana state-court proceeding respondent had brought against petitioners, in which the state trial court essentially held a patent infringement trial, addressing, *inter alia*, issues of claim construction and PTO cancellation of the same patent claims. On appeal, the Federal Circuit went even further than the district court: It explicitly *held* in a precedential opinion that the district court had exclusive jurisdiction, such that the Federal Circuit (and not the Seventh Circuit) had exclusive appellate jurisdiction. But despite holding that the federal courts had *exclusive* jurisdiction over this federal patent-law dispute, the Federal Circuit held the district court could properly "abstain" from resolving the parties' federal patent-law dispute in deference to the ongoing state-court proceedings.

The question presented is:

Whether a federal court with exclusive jurisdiction over a claim may abstain in favor of a state court with no jurisdiction over that claim.

PARTIES TO THE PROCEEDING

Petitioners Warsaw Orthopedic, Inc., Medtronic, Inc., and Medtronic Sofamor Danek, Inc., were plaintiffs in the district court and appellants in the Federal Circuit. Respondent Rick C. Sasso, M.D. was defendant in the district court and appellee in the Federal Circuit.

CORPORATE DISCLOSURE STATEMENT

Petitioners are subsidiaries of Medtronic plc. No other publicly held company owns 10% or more of petitioners' stock.

STATEMENT OF RELATED PROCEEDINGS

Warsaw Orthopedic, Inc. v. Sasso, No. 19-1583 (Fed. Cir. opinion and judgment issued Oct. 14, 2020; mandate issued Nov. 20, 2020).

Warsaw Orthopedic, Inc. v. Sasso, No. 3:18-cv-437 (N.D. Ind. opinion and order entered Jan. 31, 2019; judgment entered Feb. 4, 2019).

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Other Authorities

PETITION FOR WRIT OF CERTIORARI

The Federal Circuit's decision below is a walking contradiction. It holds (correctly) that the federal courts here had exclusive jurisdiction over a patent-based dispute between the parties. Indeed, that holding was essential to the Federal Circuit's (as opposed to the Seventh Circuit's) appellate jurisdiction. But in the very next breath it blesses the district court's decision to "abstain" from resolving that patent-based dispute, in deference to the pending "mirror image" state law proceedings involving the same patents. That makes no sense. It is axiomatic that where federal courts have *exclusive* jurisdiction, that jurisdiction is exclusive of state-court jurisdiction. Thus, when a federal court recognizes that it has exclusive jurisdiction (as the Federal Circuit plainly did below), it cannot abstain from exercising that jurisdiction on the ground that some other court, *which lacks jurisdiction*, is considering the same issues. That is what it means for jurisdiction to be *exclusive*—there is no room for some other court to be involved, much less any ground for the court with exclusive jurisdiction to abstain in deference to the court without jurisdiction. The decision in this precedential opinion thus represents a remarkable departure from the basic notion of exclusive jurisdiction, not to mention settled law and common sense.

For nearly eight decades, this Court has made it clear that although district courts have discretion to abstain from hearing declaratory judgment actions, they may only abstain in favor of a competing state proceeding if the claims at issue "can better be settled

in the proceeding pending in the state court." *Wilton v. Seven Falls Co.*, 515 U.S. 277, 282 (1995) (quoting *Brillhart v. Excess Ins. Co. of Am.*, 316 U.S. 491, 495 (1942)). Whatever the proper bounds of that doctrine where state and federal courts have *concurrent* jurisdiction, it cannot be said that an issue "can better be settled" in state court when the state court *lacks jurisdiction altogether*—as the Federal Circuit necessarily held when it confirmed the federal courts' exclusive jurisdiction. Unsurprisingly, lower courts have uniformly held (until now) that a federal court with exclusive jurisdiction cannot abstain in favor of a competing state-court proceeding, precisely because the state court by definition lacks jurisdiction and so cannot provide an adequate—let alone superior—forum for resolving the parties' dispute. The decision below, thus, is not only illogical, but also breaks abruptly from the consensus view and cannot be reconciled with this Court's settled jurisprudence.

The Federal Circuit's exclusive jurisdiction determination cannot be dismissed as dictum or an imprecision. Its determination that federal courts have sole and exclusive jurisdiction over the dispute between Medtronic and Sasso was central to the Federal Circuit's holding and essential to its jurisdiction. If the matter did not arise under federal patent law, then the Federal Circuit could not have concluded that *it* (rather than the Seventh Circuit) had appellate jurisdiction. And yet, despite its clear holding of exclusive jurisdiction, it blessed abstention in favor of competing state-court proceedings that—under the Federal Circuit's own reasoning—had *no jurisdiction* to resolve the parties' dispute. That cannot be squared with the basic notion of exclusive

jurisdiction, or with this Court's governing decisions in *Wilton* and *Brillhart*, or with the principles this Court has adopted and the lower courts have applied in the context of *Colorado River* abstention. Indeed, the one consistent thread that runs through all the various strains of abstention doctrine is that a court with exclusive jurisdiction cannot abstain in deference to a court with no jurisdiction at all.

The decision below is not only wrong, but also dangerous—particularly because its incoherence is now binding precedent in all patent cases throughout the country. It unsettles what should be settled, and severely undermines Congress' measured decision to assign certain categories of cases *exclusively* to federal courts, inviting state courts to intrude where Congress has forbidden them to tread. This case itself dramatically illustrates the potential consequences: By abstaining, the Federal Circuit left core, complicated federal patent-law issues to be resolved by a state trial court that heard expert testimony on patent scope, issued its own decision construing the relevant patent claims, determined the legal relevance of PTO cancellation, delivered jury instructions on patent coverage, and eventually rendered a hundred-million-dollar award, by misapplying federal-law principles and precedents.

The prospect of state-court "*Markman* hearings" is not a happy one, and this case perfectly exemplifies the inevitable consequences of the jurisdictional incoherence that will become the law of the land if the decision below is permitted to stand. Whether by summary reversal or plenary review, this Court should reaffirm the straightforward principle that a

federal court with exclusive jurisdiction cannot abstain in deference to a state court with no jurisdiction whatsoever.

OPINIONS BELOW

The Federal Circuit's precedential decision is reported at 977 F.3d 1224 and reproduced at App.1-16. The district court's opinion is unreported, but available at 2019 WL 428574 and reproduced at App.17-27.

JURISDICTION

The Federal Circuit exercised jurisdiction under 28 U.S.C. §1295(a)(1), which provides that it has "exclusive jurisdiction" over "an appeal from a final decision of a district court … in any civil action arising under … any Act of Congress relating to patents," and issued its opinion on October 14, 2020. This Court has jurisdiction under 28 U.S.C. §1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant statutory provisions are reproduced in the appendix.

STATEMENT OF THE CASE

A. Sasso Sues Medtronic on Patent-Based Claims in Indiana State Court.

1. Medtronic is a leading medical technology company that provides healthcare products, services, and solutions for doctors and patients around the globe. As part of its research and development process, Medtronic regularly works with doctors and surgeons to develop new medical devices to treat a wide variety of health conditions.

In 1998, Medtronic began working with Sasso on a system to anchor and align screws and plates in the cervical spine during surgery. *See Warsaw Orthopedic, Inc. v. Sasso*, 162 N.E.3d 1, 6, 8 (Ind. Ct. App. 2020). The resulting product became known as the Vertex System. *Id.* at 8.

In 1999, Medtronic and Sasso signed an agreement known as the "Vertex Agreement," under which Sasso gave Medtronic his rights in the Vertex system and associated intellectual property. *Id.* at 8-9. In exchange, Medtronic agreed to pay Sasso a 2% royalty on net sales of the relevant "Medical Device" for eight years from the first commercial sale of that device, or "if the Medical Device is covered by a valid claim of an issued U.S. patent arising out of the Intellectual Property Rights" provided in the agreement, then for the life of the patent. *Id.* at 9. In 2002, the U.S. Patent and Trademark Office ("PTO") issued Patent No. 6,485,491 ("the '491 patent"), naming Sasso among its inventors and Medtronic as the assignee. *Id.* at 9-10.

Medtronic and Sasso partnered on another spinal-surgery invention involving a facet screw delivery system. *Id.* at 6. In November 1999, Medtronic and Sasso signed a second agreement, the "Facet Screw Agreement," under which Sasso gave Medtronic ownership rights to the screw delivery system and associated intellectual property in exchange for a 2.5% royalty on net sales of that device. *Id.* at 6-7.

Section 7 of the Facet Screw Agreement, titled "'Term of Agreement," provided that the agreement "shall expire upon the last to expire of the patents included in Intellectual Property Rights, or if no

patent application(s) issue into a patent having valid claim coverage of the Medical Device, then seven (7) years from the Date of First Sale of the Medical Device." *Id.* at 7; *see* App.3. The agreement further provided that Medtronic was "free to continue manufacturing, marketing and selling Medical Device(s) after expiration of this Agreement without further payment to Dr. Sasso." 162 N.E.3d at 7. The Facet Screw Agreement defined "Medical Device" as "any device, article, system, apparatus or product including the Invention," and defined the "Invention" as "any product, method or system relating to a facet screw instrumentation and a headless facet screw fixation system as described in Schedule A." *Id.* at 6-7 nn.4, 6.

In September 2001, the PTO issued Patent No. 6,287,313 ("the '313 patent"), with Sasso as the sole inventor and Medtronic as the assignee. *Id.* at 7. The PTO later issued a continuation of the '313 patent as Patent No. 6,562,046 ("the '046 patent"). App.3.

2. In August 2013, Sasso sued Medtronic in Indiana state court, claiming that Medtronic had breached the Vertex Agreement by failing to pay him the full royalties he was owed under that agreement. App.17. Medtronic removed the action to federal district court, explaining that Sasso's claims were subject to exclusive federal jurisdiction because they arose under federal patent law. App.17-18; *see* 28 U.S.C. §1338. The district court responded with a one-sentence order remanding the case back to Indiana state court. C.A.App.885. Medtronic had no opportunity to seek appellate review of that remand order, because "[a]n order remanding a case to the

State court from which it was removed is not reviewable on appeal or otherwise." 28 U.S.C. §1447(d).

3. After the case was remanded to state court, Sasso amended his complaint to add new claims alleging that Medtronic also breached the Facet Screw Agreement. App.18; *see* App.3 & n.3. Sasso asserted that the '313 and '046 patents have valid claims that cover various Medtronic products, and that he was accordingly entitled to royalties on all of those products for the life of those patents. *See* C.A.App.49-53, 62-63.

Medtronic moved to dismiss for lack of subject matter jurisdiction, explaining that Sasso's new claims (like his old claims) were subject to exclusive federal jurisdiction because they necessarily raised substantial and disputed questions of federal patent law—namely, the proper construction of the '313 and '046 patents. C.A.App.962-82. The Indiana trial court denied the motion, relying largely on the fact that the district court had previously remanded the case to state court (before Sasso added his new Facet Screw Agreement claims). C.A.App.1289-90; *see* App.18.

The state trial court proceeded to preside over a case that was largely indistinguishable from routine federal patent litigation—except that it took place in an Indiana state court. To pursue his theory that he was entitled to additional royalties because the '313 and '046 patents covered various Medtronic products, Sasso took extensive discovery regarding those patents' claim coverage, including a Rule 30(b)(6) deposition of Medtronic that was almost entirely devoted to that topic. *See* C.A.App.785-98. Sasso's

expert reports likewise offered detailed opinions on claim coverage, including claim charts showing in detail how (in their view) each element of the relevant patent claims appeared in Medtronic products. *See* C.A.App.639-672. The state trial court likewise treated the litigation as a patent case, even going so far as to issue a *Markman* order construing disputed terms in the patent claims at issue. C.A.App.1878-80 ("The Court recognizes that claim construction is a matter of law reserved for the Court, not the jury.… Accordingly, the Court construes the disputed terms as follows[.]" (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996))).

B. Medtronic Files This Action Invoking Exclusive Federal Jurisdiction, but the District Court Abstains.

1. Shortly after receiving Sasso's expert reports disclosing his broad construction of the patent claims at issue, Medtronic filed a declaratory judgment action in the U.S. District Court for the Northern District of Indiana, to obtain *definitive* rulings on the construction and validity of the relevant claims of the '313 and '046 patents—as only a *federal* court *should* be able to provide—and a declaration that Medtronic did not breach the Facet Screw Agreement because the patents do not contain any valid claim covering any of Medtronic's products. C.A.App.17-32; *see* App.4-5. As the district court and both parties recognized, those declaratory judgment claims presented the "mirror image" of Sasso's state-court claim. App.19; *see* Sasso.C.A.Br.28. In an effort to obtain a federal forum to consider these federal patent claims, Medtronic also took the extraordinary step of filing requests with the

PTO for ex parte reexaminations of its *own* patents, specifically some of the claims of the '313 and '046 patents, on the ground that those claims were invalid under Sasso's construction. App.8; *see* C.A.App.332-33.

Three months later, Sasso filed a motion asking the district court to abstain from hearing Medtronic's claims or stay its proceedings until the completion of the state-court action. He argued that the district court lacked jurisdiction over Medtronic's claims; that it should abstain from hearing Medtronic's claims under *Colorado River Water Conservation District v. United States*, 424 U.S. 800 (1976), which permits a federal court in exceptional circumstances to abstain in favor of a parallel state proceeding; and that Medtronic's claims were barred by the *Rooker-Feldman* doctrine, which bars litigants from seeking appellate review of a state-court judgment in a federal district court, *see Rooker v. Fidelity Trust Co.*, 263 U.S. 413 (1923); *D.C. Court of Appeals v. Feldman*, 460 U.S. 462 (1983). C.A.App.806-35.

2. Meanwhile, the Indiana trial court proceeded to hold what was in effect a patent infringement trial before a jury on Sasso's claims against Medtronic. Throughout that trial, from his opening statement on, Sasso made clear that the issue of patent claim scope was critical to his case. *See, e.g.*, C.A.App.1947 (presenting Sasso's view of the key "elements" of claim 26 of the '313 patent). Sasso presented testimony from two experts on issues of patent law, including one whose entire testimony related to patent claim coverage. *See* C.A.App.1972-2050, 2059. And Sasso himself testified that the invention he assigned to

Medtronic under the Facet Screw Agreement was covered by claim 26 of the '313 patent, which he described as "incredibly broad" and "really really broad." C.A.App.2125; *see* App.4. Despite allowing that testimony, however, the state court precluded Medtronic from arguing that any patent claim with the broad scope that Sasso asserted would be invalid. App.4. The state court maintained that ruling even after the PTO, shortly before the state-court trial ended, issued notices of intent to cancel (*i.e.*, invalidate) the relevant claims. *See* Notice of Intent to Issue Ex Parte Reexamination Certificate, No. 90/014,131 (Nov. 26, 2018); Notice of Intent to Issue Ex Parte Reexamination Certificate, No. 90/014,171 (Nov. 20, 2018). And it maintained that ruling even in the face of Sasso's closing argument, in which Sasso told the jury that the '313 patent "is in force today"—despite the PTO's notices of intent to cancel the relevant claims. Tr.Vol.12 at 40, *Warsaw*, 162 N.E.3d 1.

The trial ended with the state court delivering detailed jury instructions on patent law and patent claim coverage (including four pages borrowed from the Federal Circuit Bar Association pattern instructions), as well as its own construction of the relevant terms in the '313 patent claims. C.A.App.2141-45. Those instructions informed the jury, inter alia, that it would "need to understand the role of patent claims" to decide the case; that it would "need to understand what each claim covers in order to decide whether … there is claim coverage for any Medtronic devices"; that it was the state trial court's role "to define the terms of the claims," and that the jury was required to apply the state trial court's

definitions. C.A.App.2141-42. The trial court also elaborated on the distinction between product claims and process claims, the distinction between independent and dependent claims, and the effects of those distinctions on patent coverage. C.A.App.2143-45.

Based on the state court's extensive instructions on federal patent-law issues, and its construction of the relevant patent claims, the jury found that Medtronic had breached both the Vertex Agreement and the Facet Screw Agreement, and awarded Sasso over $112 million in damages. App.4; App.19. The state court entered judgment in accordance with that verdict. App.19. Shortly thereafter, the PTO issued the reexamination certificates canceling the relevant claims, making those patent claims invalid *ab initio*. App.8; *see Fresenius USA Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330 (Fed. Cir. 2013).

3. After the state-court trial concluded, Sasso returned to the federal district court and requested leave to submit supplemental briefing on the effect of the state-court judgment. App.19; *see* C.A.App.1906-08. The district court granted Sasso's request, and *sua sponte* asked the parties to address an additional issue that Sasso had never raised: whether the court should abstain from hearing Medtronic's claims for declaratory relief under the *Wilton-Brillhart* doctrine, as an exercise of its discretion under the Declaratory Judgment Act. App.19-20.

After receiving the parties' supplemental briefs, the district court chose to "abstain," and dismissed the action under the *Wilton-Brillhart* doctrine. App.20-21. The court assumed for purposes of its decision that

Medtronic's claims (and Sasso's mirror-image state-court claims) did arise under federal patent law, and so that federal courts had exclusive jurisdiction over those claims. App.20-21. Nevertheless, the district court concluded that "a declaratory judgment would serve no legitimate purpose here" in light of the state trial court decision and ongoing state-court appeals. App.20, App.22-23.

The district court acknowledged Medtronic's argument that a federal court with exclusive jurisdiction cannot abstain in favor of a state court that lacks jurisdiction. App.24. But it rejected that argument, holding that rule applied only to *Colorado River* abstention and not to *Wilton-Brillhart* abstention. App.24-26. Instead, the district court held, "[t]he existence of exclusive federal jurisdiction" was at most a "relevant factor to consider" under *Wilton* and *Brillhart* in deciding whether to abstain in favor of state court proceedings that *lacked* jurisdiction. App.25 n.5.

C. The Federal Circuit Holds There Is Exclusive Federal Patent-Law Jurisdiction Over the Dispute but Nevertheless Approves Abstention.

1. Medtronic appealed the district court's decision to the Federal Circuit. In response, Sasso urged the Federal Circuit to dismiss the appeal, arguing that neither the district court nor the Federal Circuit had jurisdiction because Medtronic's claims (the mirror image of Sasso's own state court claims) did not arise under the federal patent laws. App.9. In the alternative, he argued that even assuming the district court had exclusive jurisdiction over the parties'

dispute, it was nevertheless correct to abstain in light of the Indiana proceedings.

In a precedential decision, the Federal Circuit began by squarely rejecting Sasso's jurisdictional argument, holding that Medtronic's claims arose under the federal patent laws and therefore were within the district court's exclusive original jurisdiction and the Federal Circuit's own exclusive appellate jurisdiction. App.9-10. By federal law, the federal district courts have exclusive original jurisdiction of "any civil action arising under any Act of Congress relating to patents," 28 U.S.C. §1338(a), and the Federal Circuit has corresponding exclusive jurisdiction of any "appeal from a final decision of a district court … in any civil action arising under … any Act of Congress relating to patents," 28 U.S.C. §1295(a)(1). App.9 n.4. That exclusive jurisdiction, the Federal Circuit explained, extends not only to cases where federal patent law creates the underlying right of action, but also to cases in which federal patent-law issues are "(1) necessarily raised, (2) actually disputed, (3) substantial, and (4) capable of resolution without disrupting the federal-state balance approved by Congress." App.9 (quoting *Gunn v. Minton*, 568 U.S. 251, 258 (2013)).

Applying that standard, the Federal Circuit held, "the issues of validity and claim scope" presented in Medtronic's claims (and Sasso's mirror-image state-court claims) were "well-pleaded in this declaratory complaint, are actually disputed, are substantial to the federal system as a whole, and the federal-state judicial balance would not be disrupted by the district court's exercise of declaratory jurisdiction." App.10.

The parties' dispute was therefore "within the district court's jurisdictional authority," and the Federal Circuit had jurisdiction to hear Medtronic's appeal. App.10. As the Federal Circuit's opinion makes clear, its holding that the claims here arose under the federal patent laws was critical to the court's ability to hear this case at all; otherwise, the Federal Circuit would have lacked jurisdiction and would have been required to dismiss the appeal or transfer it to the Seventh Circuit. App.9-10; *see* 28 U.S.C. §1631 (authorizing transfer).

2. Despite correctly holding that the parties' dispute arose under the federal patent laws, such that the district court had exclusive jurisdiction to adjudicate it, the Federal Circuit nevertheless concluded that the district court did not abuse its discretion by "abstaining" in favor of the state-court proceedings—proceedings in which the courts necessarily *lacked jurisdiction*. App.10-16.

The Federal Circuit recognized that abstention in general "is an extraordinary and narrow exception to the duty of a District Court to adjudicate a controversy properly before it," and is appropriate "only in the exceptional circumstances where the order to the parties to repair to the state court would clearly serve an important countervailing interest." App.11-12 (quoting *Colorado River*, 424 U.S. at 813). Moreover, the Federal Circuit acknowledged that courts applying *Colorado River* abstention have uniformly held that "a federal proceeding should not be stayed in favor of a state proceeding when the federal proceeding includes a claim over which federal courts

have exclusive jurisdiction." App.12; *see Cottrell v. Duke*, 737 F.3d 1238, 1248 (8th Cir. 2013).

Yet, despite recognizing that uniform precedent, the Federal Circuit dismissed it as inapplicable on the theory that the district court here applied the *Wilton-Brillhart* standard rather than *Colorado River*. App.12. The Federal Circuit did not attempt to explain why dismissing a claim over which the district court had *exclusive* jurisdiction would ever be appropriate under *Wilton* and *Brillhart* or any other theory of abstention. Nor did it explain how, given its conclusion that the patent-law claims at issue were subject to exclusive federal court jurisdiction, "the claims of all parties in interest can satisfactorily be adjudicated in the state court proceeding," as required by *Wilton* and *Brillhart*. App.13 (brackets omitted) (quoting *Wilton*, 515 U.S. at 283); *see Brillhart*, 316 U.S. at 495. Tellingly, the Federal Circuit did not cite any cases in which a federal court with exclusive jurisdiction had nevertheless found it proper to abstain in favor of state court proceedings that (by definition) lacked jurisdiction.

3. The Federal Circuit's decision did not go unnoticed. Less than two months later, the Indiana Court of Appeals affirmed the Indiana trial court's $112 million judgment for Sasso, rejecting the argument that the state trial court lacked subject-matter jurisdiction because the federal courts have exclusive jurisdiction over this patent dispute. Despite recognizing that the Federal Circuit had reached the exact opposite conclusion, and had held that the federal courts *do* have exclusive jurisdiction over this dispute, the Indiana Court of Appeals

discounted that jurisdictional holding in light of the Federal Circuit's abstention holding, concluding that the Federal Circuit's ultimate decision to approve abstention "weigh[ed] against a finding of exclusive federal jurisdiction." *Warsaw*, 162 N.E.3d at 16.

This petition follows.

REASONS FOR GRANTING THE PETITION

The Federal Circuit's holding that a federal district court with *exclusive* subject-matter jurisdiction over a dispute may nonetheless abstain in favor of state-court proceedings over the same subject matter—over which the state court by definition lacks jurisdiction—cannot be sustained. After all, *exclusive* federal jurisdiction means jurisdiction that is *exclusive of* state-court adjudication. There can be no mistake that is what Congress meant in 28 U.S.C. §1338(a): Congress was not only explicit that *only* federal district courts would have jurisdiction over *any* action arising under *any* act of Congress *relating to* patents, but expressly added that "[n]o State court shall have jurisdiction" over any such "claim for relief." That text and the basic notion of what *exclusive* jurisdiction means should have been the beginning and end of any temptation for federal courts to "abstain" in favor of ongoing state-court proceedings.

Indeed, that is exactly what this Court concluded nearly 80 years ago. Although federal district courts have discretion to decide whether to hear a declaratory judgment action, they may properly abstain in favor of a competing state proceeding only if the issues presented "can better be settled in the proceeding pending in the state court." *Wilton*, 515 U.S. at 282 (quoting *Brillhart*, 316 U.S. at 495). But

where Congress has provided that state courts can have *no* jurisdiction at all, it is a jurisdictional oxymoron to abstain in favor of state-court proceedings. By definition the matter cannot be "settled"—much less "better settled"—in state-court proceedings when the state court has no jurisdiction to proceed. Neither the district court nor the Federal Circuit offered a coherent justification for abstaining in favor of proceedings without a valid jurisdictional basis.

The district court, for its part, merely assumed it had jurisdiction. But it failed to recognize it was assuming *exclusive* jurisdiction, which makes its abstention decision incoherent. The Federal Circuit did the district court one better. It affirmatively held it had exclusive jurisdiction, which was essential to its appellate jurisdiction vis-à-vis the Seventh Circuit, and still abstained in favor of state court proceedings in a matter where it had necessarily just concluded that "[n]o State court shall have jurisdiction." To state that proposition is to refute it. The very idea that a court can recognize exclusive federal-court jurisdiction in one breath, but then in the next abstain from adjudicating the case in favor of a state court that—by definition—has *no jurisdiction* over the dispute, "sounds absurd, because it is." *Sekhar v. United States*, 570 U.S. 729, 738 (2013).

In addition to being at war with the basic notion of exclusive jurisdiction, the decision runs afoul of this Court's precedents and departs from the approach taken by every other court of appeals to consider the issue. The governing decisions in *Wilton* and *Brillhart* make unmistakably clear that when a district court is

considering whether to abstain from hearing a declaratory judgment claim in favor of a pending state proceeding, the key question is whether that state proceeding will provide an adequate forum for resolving that claim. Where the federal court has exclusive jurisdiction, the answer to that question is easy: a state court cannot possibly provide an adequate forum for a claim it lacks jurisdiction to decide. Nothing about that reasoning is limited to any particular abstention doctrine. The same result follows from this Court's decisions in the analogous *Colorado River* context, where both this Court and the federal courts of appeals have repeatedly made clear that abstaining in favor of a state court that lacks jurisdiction is "clearly … inappropriate." *Colorado River*, 424 U.S. at 809.

The Federal Circuit's departure is not only egregious, but consequential. That precedential decision, which now governs all patent cases throughout the country, disregards Congress' express decision to bar state courts from adjudicating any civil action arising under the patent law, permitting abstention in favor of just such proceedings. In so doing, it introduces confusion into what was a settled area of the law, and more fundamentally upsets Congress' ability to set aside entire categories of cases for the federal courts *exclusively* to decide. Indeed, the Federal Circuit decision provoked only confusion in the Indiana Court of Appeals, which discounted the Federal Circuit's exclusive-jurisdiction holding by pointing to its abstention holding. Allowing this decision to stand will encourage both federal-court abdication and state-court encroachment on turf Congress plainly reserved for the federal courts.

Whether by summary reversal or plenary review, this Court should grant review and reverse.

I. The Federal Circuit Departed From Settled Precedent And Fundamentally Erred By Simultaneously Finding Exclusive Federal Jurisdiction And Allowing Abstention In Favor Of Ongoing State-Court Proceedings.

The decision below reached two conclusions: 1) the federal courts have exclusive jurisdiction over this dispute; and 2) the district court did not abuse its discretion by abstaining in favor of ongoing state-court proceedings. They cannot both be right. Exclusive jurisdiction means jurisdiction exclusive of state-court proceedings. By losing sight of that basic reality, the Federal Circuit issued an incoherent decision that sets a dangerous precedent.

By statute, the federal district courts "shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents," and "[n]o State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents." 28 U.S.C. §1338(a). That explicit statutory text sets out a simple and mandatory rule: patent cases can only be adjudicated in federal court, not in state court. As the Federal Circuit correctly recognized in a ruling on which its appellate jurisdiction depended, that rule squarely applies here. Because this case necessarily raises "issues of [patent] validity and claim scope" that "are actually disputed, are substantial to the federal system as a whole, and the federal-state judicial balance would not be disrupted by the district court's exercise of declaratory jurisdiction," it arises under the federal patent laws,

and so can *only* be heard in federal court. App.10; *see Gunn*, 568 U.S. at 258.

Despite correctly recognizing the district court's exclusive jurisdiction over this case (and its own exclusive appellate jurisdiction), the Federal Circuit nevertheless failed to take that to its logical (and statutorily preordained) conclusion, instead allowing the district court to *abstain in favor of pending state-court proceedings* that by definition *lacked jurisdiction*. That decision is as wrong as it sounds.

Jurisdiction that is exclusively vested in federal courts is entirely divested from state courts. The jurisdictional inquiry is binary—like an on/off switch. When jurisdiction exclusively lies in federal court, it cannot lie in state court, and a federal court therefore cannot "abstain" in favor of a prohibited state court adjudication. It is just that simple. The Federal Circuit's decision to the contrary cannot be reconciled with this Court's governing decisions in *Wilton* and *Brillhart*, with the analogous teachings of *Colorado River* and its progeny, or with basic legal principles.

A. The Decision Below Cannot Be Reconciled With *Wilton* and *Brillhart*.

By allowing the district court to abstain in favor of state proceedings that lack jurisdiction, the Federal Circuit contravened the very precedents on which it primarily relied. Although *Wilton* and *Brillhart* recognize that a district court has substantial discretion in deciding whether to hear a declaratory judgment suit, they also make inescapably clear that a district court cannot exercise that discretion in favor of an alternative forum that cannot resolve the parties' claims. *Wilton*, 515 U.S. at 282-83; *Brillhart*, 316 U.S.

at 494-96. The Federal Circuit's decision cannot be reconciled with that established rule.

1. This Court first addressed the scope of a district court's discretion to abstain from hearing a declaratory action in *Brillhart*, decided less than a decade after the federal Declaratory Judgment Act was passed. 316 U.S. at 494-98; *see* Act of June 14, 1934, 48 Stat. 955 (codified as amended at 28 U.S.C. §2201). In *Brillhart*, an insurer sought a declaratory judgment in federal court that it was not liable under state law on a policy it had issued. 316 U.S. at 493. The district court dismissed the suit based on the existence of a state-court garnishment proceeding involving the same policy, "without considering whether the claims asserted by the [insurer] could under Missouri law be raised in the pending garnishment proceeding." *Id.* at 494.

This Court held that the district court had abused its discretion by dismissing the suit without determining whether the insurer's claims could be heard in the pending Missouri proceeding. While the district court "was under no compulsion to exercise [its] jurisdiction" to grant declaratory relief, its discretion to abstain was not limitless. *Id.* Instead, "in determining whether the District Court should assume jurisdiction and proceed to determine the rights of the parties," the critical question was whether "all the matters in controversy between the parties could be fully adjudicated" in the pending state-court proceeding. *Id.* at 494-95. The district court should therefore have "ascertain[ed] whether the questions in controversy between the parties to the

federal suit" could "better be settled in the proceeding pending in the state court." *Id.* at 495.

That inquiry, the Court explained, would entail examining "the scope of the pending state court proceeding," including "whether the claims of all parties in interest can satisfactorily be adjudicated in that proceeding." *Id.* at 495. Because the district court "did not consider whether" the claims raised in the federal declaratory judgment suit "could adequately be tested in the garnishment proceeding pending in the Missouri state court," it abused its discretion by abstaining in favor of that state proceeding. *Id.* at 495-96.

2. This Court reinforced the same principles a half-century later in *Wilton*. Like *Brillhart*, that case again involved an insurer seeking a declaratory judgment in federal court to determine its liability under state law on one of its policies. 515 U.S. at 279-80; *see id.* at 282 (noting that the circumstances in *Wilton* and *Brillhart* were "virtually identical"). The district court observed that a pending state-court suit involving the same parties "encompassed the same coverage issues," and abstained in favor of that parallel state-court suit. *Id.* at 280.

This Court granted certiorari to decide (*inter alia*) whether the district court's decision to abstain was governed by the discretionary standard set out in *Brillhart*, or instead by the narrower test adopted in *Colorado River*, under which a district court must generally exercise its jurisdiction absent "exceptional circumstances." *Id.* at 279, 281; *see Colorado River*, 424 U.S. at 817-18. Relying on the plain text of the Declaratory Judgment Act, which provides that a

court "*may*" provide declaratory relief, 28 U.S.C. §2201(a) (emphasis added), the Court held that the discretionary *Brillhart* standard applied. *Wilton*, 515 U.S. at 286-87.

At the same time, the Court again emphasized that the district court's discretion was not boundless. In particular, the Court repeated the limitations on a district court's discretion to abstain from hearing a declaratory suit that it had set forth in *Brillhart*. It explained once again that "[t]he question for a district court presented with a suit under the Declaratory Judgment Act" is "'whether the questions in controversy between the parties to the federal suit … can better be settled in the proceeding pending in the state court.'" *Id.* at 282 (quoting *Brillhart*, 316 U.S. at 495). And it likewise reiterated that in deciding whether to abstain, the district court "should examine 'the scope of the pending state court proceeding,'" including "'whether the claims of all parties in interest can satisfactorily be adjudicated in that proceeding.'" *Id.* at 282-83 (quoting *Brillhart*, 316 U.S. at 495).

To be sure, district courts have somewhat more discretion to abstain from granting declaratory relief than to abstain from other cases within their jurisdiction. *E.g.*, *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 136 (2007) (remanding for district court to consider abstaining from issuing declaratory judgment in a patent case based on "competing accusations of inequitable conduct"); *see also* App.26 (citing cases). But they have *no discretion* to abstain *because of* a state-court case that *cannot* actually resolve the parties' dispute. When a state court lacks jurisdiction (because Congress has instead vested

exclusive jurisdiction in the federal courts), then by definition, it cannot adjudicate a dispute.

3. The decision below wholly ignored those critical limitations on abstention. Like the district court in *Brillhart*, the district court here made no attempt to determine whether the patent-based claims in this declaratory judgment suit could be adequately resolved in the pending state-court proceedings; on the contrary, it specifically refrained from resolving whether it had exclusive jurisdiction over those claims. App.20-21. That failure alone should have required the Federal Circuit to reverse. *See Wilton*, 515 U.S. at 282-83; *Brillhart*, 316 U.S. at 495-96.

The Federal Circuit, however, compounded the error: it explicitly held that the district court *did* have exclusive jurisdiction over those claims, which by definition means the state courts *cannot* resolve them, and yet nevertheless held that the district court had discretion to abstain in favor of the state court proceeding. App.9-10, 16. That holding is not only illogical, but cannot possibly be reconciled with *Wilton* and *Brillhart*. Where a federal court has exclusive jurisdiction over a claim, it necessarily follows that the claim cannot "better be settled in [a] proceeding pending in the state court"—indeed, it cannot be settled *at all* in the state courts. *Wilton*, 515 U.S. at 282 (quoting *Brillhart*, 316 U.S. at 495). Similarly, a claim over which the federal courts have exclusive jurisdiction is by definition outside "the scope of the pending state court proceeding" and cannot "satisfactorily be adjudicated in that proceeding." *Id.* at 283 (quoting *Brillhart*, 316 U.S. at 495). The

principles announced in *Wilton* and *Brillhart* thus unequivocally bar a district court with exclusive jurisdiction from abstaining in deference to a "mirror image" state court proceeding, precisely because the state court lacks jurisdiction to adjudicate the dispute.

Given this Court's clear precedents in *Wilton* and *Brillhart*, it should come as no surprise that, as far as petitioners are aware, every court to consider this issue—other than the courts below—has uniformly declined to abstain from hearing a declaratory judgment action within its exclusive jurisdiction because a competing state court proceeding is pending. *See Carlin Equities Corp. v. Offman*, 2007 WL 2388909, at *3-4 (S.D.N.Y. Aug. 21, 2007); *Sabre Oxidation Techs., Inc. v. Ondeo Nalco Energy Servs. LP*, 2005 WL 2171897, at *3-4 (S.D. Tex. Sept. 6, 2005); *Epling v. Golden Eagle/Satellite Archery, Inc.*, 17 F.Supp.2d 207, 209-10 (W.D.N.Y. 1998); *see generally* 10B Fed. Prac & Proc. Civ. §2758 (4th ed. 2020) (recognizing that under *Wilton* and *Brillhart*, "numerous courts have … held" that a federal declaratory action should proceed if it "will provide [a] more comprehensive solution" than the state-court suit). Indeed, courts have often recognized that the mere presence of a federal issue—even without exclusive federal jurisdiction—can weigh heavily against abstention under *Wilton* and *Brillhart* (both of which involved only state-law issues), implying *a fortiori* that abstention is inappropriate when federal jurisdiction over that federal issue is exclusive. *E.g.*, *Sherwin-Williams Co. v. Holmes Cty.*, 343 F.3d 383, 394-97 (5th Cir. 2003); *Verizon Commc'ns, Inc. v. Inverizon Int'l, Inc.*, 295 F.3d 870, 873 (8th Cir. 2002); *Youell v. Exxon Corp.*, 74 F.3d 373, 376 (2d Cir. 1996);

see also Moses H. Cone Mem'l Hosp. v. Mercury Constr. Corp., 460 U.S. 1, 26 (1983) (in the *Colorado River* context, "the presence of federal-law issues must always be a major consideration weighing against" abstention). By contrast, neither the Federal Circuit, nor the district court, nor Sasso's briefs below identified *any* case in which a federal court with exclusive jurisdiction over a federal claim has been permitted to abstain in favor of a state court lacking jurisdiction.

B. The Decision Below Cannot Be Reconciled With *Colorado River* and Its Progeny.

The Federal Circuit's precedential decision is likewise irreconcilable with the decisions this Court has issued in the analogous *Colorado River* abstention context. Although a district court has more discretion to abstain from hearing a declaratory judgment action than it has to abstain under *Colorado River*, *see Wilton*, 515 U.S. at 282-88, that broader discretion must still be exercised in accordance with "the teachings and experience concerning the functions and extent of federal judicial power," *id.* at 287 (quoting *Pub. Serv. Comm'n of Utah v. Wycoff Co.*, 344 U.S. 237, 243 (1952)); *see also Kelly v. Maxum Specialty Ins. Grp.*, 868 F.3d 274, 285 n.10 (3d Cir. 2017) (recognizing that while *Wilton-Brillhart* abstention and *Colorado River* abstention are distinct, "both require evaluating similar factors").

Like *Wilton* and *Brillhart*, *Colorado River* rested on "considerations of 'wise judicial administration, giving regard to conservation of judicial resources and comprehensive disposition of litigation.'" 424 U.S. at

817 (brackets omitted) (quoting *Kerotest Mfg. Co. v. C-O-Two Fire Equip. Co.*, 342 U.S. 180, 183 (1952)); *cf. Wilton*, 515 U.S. at 288 ("considerations of practicality and wise judicial administration"). In *Colorado River*, the district court abstained from deciding a water-rights dispute in favor of pending state-court proceedings. 424 U.S. at 806. The Court held that in light of the "virtually unflagging obligation of the federal courts to exercise the jurisdiction given them," a federal court should only abstain in favor of a concurrent state proceeding in "exceptional" circumstances. *Id.* at 817-18.

But before reaching its "exceptional circumstances" test for matters subject to concurrent jurisdiction, the *Colorado River* Court first addressed a threshold issue: whether the state court had jurisdiction to decide the claims raised in the federal proceeding. 424 U.S. at 809-13. That threshold issue was controlling, the Court explained, because abstention in favor of the pending state-court proceeding "clearly would have been inappropriate if the state court had no jurisdiction to decide those claims." *Id.* at 809. So it is here. Although federal courts may not be required to resolve *all* declaratory actions arising under federal patent law, at a minimum they cannot abstain due to concurrent state-court proceedings that *lack* jurisdiction over such patent disputes.

This Court made a similar point in *Moses H. Cone*. Applying *Colorado River*, the Court explained that abstention in favor of a pending state-court proceeding is only appropriate if "the parallel state-court litigation will be an adequate vehicle for the complete

and prompt resolution of the issues between the parties." *Moses H. Cone*, 460 U.S. at 28. Indeed, if there is "any substantial doubt" that the state court will provide an adequate forum to resolve the parties' dispute, it would be "a serious abuse of discretion" to abstain. *Id.* A "dismissal or stay of the federal suits would have been improper if there was no jurisdiction in the concurrent state actions to adjudicate the claims at issue[.]" *Arizona v. San Carlos Apache Tribe of Ariz.*, 463 U.S. 545, 559-60 (1983). *Colorado River* and its progeny thus confirm the same rule as *Wilton* and *Brillhart*: where a district court has exclusive jurisdiction over a party's claims, it cannot properly abstain from deciding those claims in favor of a state court that has no jurisdiction to resolve them.

That rule has also been consistently recognized and followed by the federal courts of appeals—at least until the decision below. In the *Colorado River* context, at least four circuits have uniformly held that a federal court with exclusive jurisdiction cannot properly abstain in favor of concurrent state-court proceedings. *See Cottrell v. Duke*, 737 F.3d 1238, 1245-48 (8th Cir. 2013) ("[W]e join the Second, Seventh, and Ninth Circuits and hold that the *Colorado River* doctrine may not be used to stay or dismiss a federal proceeding in favor of a concurrent state proceeding when the federal proceeding contains a claim over which Federal courts have exclusive jurisdiction."); *Medema v. Medema Builders, Inc.*, 854 F.2d 210, 212-15 (7th Cir. 1988); *Andrea Theatres, Inc. v. Theatre Confections, Inc.*, 787 F.2d 59, 62-64 (2d Cir. 1986); *Silberkleit v. Kantrowitz*, 713 F.2d 433, 435-36 (9th Cir. 1983); *see also Kruse v. Snowshoe Co.*, 715 F.2d 120, 124 (4th Cir. 1983); *Cotler v. Inter-County*

Orthopaedic Ass'n, P.A., 526 F.2d 537, 539, 542 (3d Cir. 1975). By contrast, *no* court has ever permitted abstention under these circumstances, either in the *Colorado River* context or the *Wilton-Brillhart* context—again, until the decisions below. *See Cottrell*, 737 F.3d at 1245.

The Federal Circuit recognized that courts have routinely held abstention in favor of state-court proceedings improper under *Colorado River* when a federal court has exclusive jurisdiction. App.12 (citing *Cottrell*, 737 F.3d at 1248). But remarkably, the Federal Circuit then failed to explain why the same rule would not apply equally here—particularly given that *Wilton* and *Brillhart* likewise focus on whether the parties' claims "'can better be settled in the proceeding pending in the state court.'" *Wilton*, 515 U.S. at 282 (quoting *Brillhart*, 316 U.S. at 495). The Federal Circuit's lack of any response to the "'teachings and experience concerning the functions and extent of federal judicial power'" found in *Colorado River* and its progeny, unmistakably underscores its dramatic departure here from the relevant "considerations of practicality and wise judicial administration." *Wilton*, 515 U.S. at 287-88 (quoting *Wycoff*, 344 U.S. at 243).

C. The Decision Below Contradicts Basic Legal Principles and Has No Reasoned Justification.

1. The decision below not only conflicts with this Court's precedent and decisions from other circuits following that precedent, but is also plainly incorrect as a matter of first principles. Most obviously, allowing a federal court with exclusive jurisdiction to

defer to competing state-court proceedings that necessarily *lack* jurisdiction contravenes Congress' express judgment that the claims at issue should be heard in federal court and not in state court.

Permitting a district court to abstain from hearing a declaratory action over which it has exclusive jurisdiction in favor of a competing state-court proceeding "would run counter to Congress' determination, reflected in grants of exclusive federal jurisdiction, that federal courts should be the primary fora for handling such claims." *Andrea Theatres*, 787 F.2d at 63; *accord Schaffer Transp. Co. v. United States*, 355 U.S. 83, 88 (1957) (discretion "must be exercised in conformity with the declared policies of the Congress"). That is especially true in the patent context, where Congress not only made unambiguously clear that "[n]o State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents," 28 U.S.C. §1338(a), but went further and placed exclusive appellate jurisdiction in a single court, in order "'to provide a consistent jurisprudence and a uniform body of patent law.'" *Atari, Inc. v. JS & A Grp., Inc.*, 747 F.2d 1422, 1428 (Fed. Cir. 1984) (en banc) (quoting H.R. Rep. No. 97-312, at 41 (1981)), *overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059 (Fed. Cir. 1998); *see* 28 U.S.C. §1295. Whatever reasons a district court may have for wishing to defer to state proceedings, they cannot justify ignoring "'Congress's intent in committing [patent claims] to exclusive federal jurisdiction.'" *Cottrell*, 737 F.3d at 1246 (quoting *Medema*, 854 F.2d at 214 n.2).

2. The Federal Circuit never confronted the stark tension between its holding that the district court had exclusive jurisdiction and its holding that the district court could permissibly defer to a state court that had *no* jurisdiction. Indeed, none of the Federal Circuit's reasons for permitting abstention ultimately makes sense on its own terms.

First, it is no answer to say that the district court lacked power to vacate the existing state trial court decision. *See* App.22. That is beside the point: Once the Federal Circuit had (correctly) determined that this case fell within exclusive federal jurisdiction, *see* App.9-10, it necessarily followed that the existence of that state-court case provided no basis for declining to exercise jurisdiction exclusively entrusted to the federal courts. As this Court (and the Indiana courts) have long recognized, if a court "acts without authority, its judgments and orders are regarded as nullities." *Hickey's Lessee v. Stewart*, 44 U.S. 750, 762 (1845); *see Emmons v. State*, 847 N.E.2d 1035, 1038 (Ind. Ct. App. 2006) (recognizing the "universal principle as old as the law that the proceedings of a court without jurisdiction are a nullity and its judgment void").

Indeed, the Federal Circuit made the opposite error from what it had made in *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800 (1988). There, the Federal Circuit insisted that it lacked jurisdiction, but proceeded to decide the merits. *Id.* at 807. This Court reversed, holding that the Federal Circuit could not first conclude it lacked jurisdiction and then "extend its jurisdiction where none exists." *Id.* at 818. Here the Federal Circuit concluded that

the federal courts *had* exclusive jurisdiction, but nevertheless allowed the district court *not* to exercise that exclusive jurisdiction solely because state courts had (wrongly) reached the opposite conclusion in ongoing proceedings. The Federal Circuit was wrong in *Christianson* to assert jurisdiction it did not have, and it is wrong again now to decline jurisdiction that federal courts exclusively have.[1]

The remainder of the rationales put forth by the Federal Circuit, and the district court before it, cannot be reconciled with the conclusion that federal courts have exclusive jurisdiction, because they all are premised on some degree of deference to the state courts' adjudication and decision-making. Nothing supports requiring Medtronic to wait until the erroneous Indiana judgment is reversed before it can even begin to seek resolution of the parties' dispute in the only proper forum. *Contra* App.24.

Whatever the state courts may have been (improperly) doing, Medtronic remained entitled to have its dispute adjudicated in the only forum that can actually resolve this dispute, and also foreclose potential future claims that Sasso might bring with respect to the same patents, by definitively construing the claims and determining validity and the effect of PTO cancellation. That concern is not hypothetical, as

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[1] Because the federal courts have exclusive jurisdiction over this case, the Indiana trial court's incorrect assertion of jurisdiction has no preclusive effect. *See, e.g.*, 13D Fed. Prac. & Proc. Juris. §3536 (3d ed. 2020) ("[W]hen a federal statute has vested exclusive jurisdiction of a particular type of case in the federal courts, the finding by a state court that it has jurisdiction over such a case will not preclude collateral attack[.]").

Sasso has continued to sue Medtronic. *See Sasso v. Warsaw Orthopedic, Inc.*, No. 43D01-1903-PL-20 (Ind. Sup. Ct. filed Mar. 13, 2019).

At bottom, no principle of law or logic supports the Federal Circuit's decision to permit abstention in favor of a state-court proceeding where the federal courts have exclusive jurisdiction. This Court should grant review and correct that profound error, either summarily or following argument.

II. The Consequences Of The Decision Below Warrant Further Review.

The Federal Circuit's precedential decision is not only wrong, but has serious and widespread consequences that warrant this Court's immediate review.

First, as a doctrinal matter, the decision below creates confusion and disuniformity in what was until now clear and consistent law. *See supra* pp.20-29.

Second, by condoning state-court adjudication of cases that Congress assigned to exclusive federal jurisdiction, the decision below simultaneously invites abdication and encroachment, both of which produce endless jurisdictional snarls. This case itself provides the perfect example: Once the Federal Circuit affirmed the district court's decision to abstain, the state court of appeals was emboldened to treat that abstention ruling as support for the trial court's jurisdictional grab, affirming a $112 million award in a case that the state courts should never have heard. *Warsaw*, 162 N.E.3d at 15-16. The Federal Circuit's erroneous approach to abstention invites parties in future cases who (like the parties here) are denied access to an exclusive federal forum to "spend years

litigating claims [in state court] only to learn that their efforts and expense were wasted in a court that lacked jurisdiction." *Christianson*, 486 U.S. at 818.

Last, but far from least, the decision below undermines Congress' judgment to entrust cases arising under the patent laws to the federal courts (with appeal only to the Federal Circuit), destroying Congress' design for ensuring uniformity in a complicated regime that involves the intersection of private disputes and public-agency action. Once again, this case provides the perfect example. The Indiana courts here adjudicated countless federal patent-law issues that fell well outside their jurisdiction—from hearing expert testimony and argument on claim construction, to construing Medtronic's patent claims as a matter of law, to delivering jury instructions on patent coverage, to adjudicating the effect of the PTO's reexamination and invalidation of relevant claims. *See supra* pp.7-11. By Congress' express mandate, cases turning on such federal patent-law issues should be decided exclusively (and consistently) by the federal courts, not through scattershot adjudication in the courts of fifty different states subject to review only in this Court. This novel and illogical expansion of abstention not only invites but encourages state-court disputes that should have never been in state court in the first place. That is precisely the opposite of what Congress enacted in §1338 and §1295.

CONCLUSION

This Court should grant the petition for certiorari.

Respectfully submitted,

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