NOTE: This disposition is non-precedential.

United States Court of Appeals for the Federal Circuit

STEPHEN E. BYRNE,
Plaintiff-Appellant,

v.

WOOD, HERRON & EVANS, LLP, DAVID S. STALLARD,
KEVIN G. ROONEY, THEODORE R. REMAKLUS,
P. ANDREW BLATT, AND WAYNE L. JACOBS,
Defendants-Appellees.

2011-1012

Appeal from the United States District Court for the Eastern District of Kentucky in case no. 08-CV-0102, Judge Danny C. Reeves.

Decided: November 18, 2011

JAMES A. JABLONSKI, Law Office of James A. Jablonski, of Denver, Colorado, argued for plaintiff-appellant.

J. ROBERT CHAMBERS, Wood, Herron & Evans, L.L.P., of Cincinnati, Ohio, argued for defendants-appellees.

Before LOURIE, GAJARSA,* and O'MALLEY, *Circuit Judges.*

Opinion for the court filed by *Circuit Judge* O'MALLEY. *Circuit Judge* LOURIE joins Sections I, III, and IV of the opinion and concurs only in the result of Section II.

O'MALLEY, *Circuit Judge.*

Stephen Byrne appeals from the district court's grant of summary judgment for Wood, Herron & Evans, LLP, and several lawyers from that law firm (collectively, "WHE"), on Byrne's claim for legal malpractice. The district court granted summary judgment for WHE on the sole ground that Byrne failed to offer technical expert testimony in opposition to WHE's motion for summary judgment, a finding the court made after *sua sponte* striking portions of Byrne's own affidavit relating to technical matters. Although Byrne is the inventor named on the patent at the center of this malpractice action, the court found that Byrne is not a person of ordinary skill in the art and, thus, not qualified to opine on technical aspects of the invention and prior art. Because the district court abused its discretion in striking Byrne's affidavit without identifying the relevant level of skill in the art and without considering that inventors normally possess at least ordinary skill in the field of invention, we *vacate* and *remand* the district court's decision for consideration of the merits of WHE's summary judgment motion.

I. BACKGROUND

This is a legal malpractice action in which Stephen Byrne alleges that WHE was negligent in failing to secure broader patent protection for his invention, which relates to an improvement to a grass and weed trimmer used in landscaping. Byrne alleges that, as a result of WHE's negligence, he was unsuccessful in a patent infringement lawsuit against Black & Decker Corporation and related entities (collectively, "Black & Decker"). Because the

* Judge Gajarsa assumed senior status on July 31, 2011.

present appeal involves a narrow procedural issue, we only briefly recite the relevant factual background.

A. Byrne's Invention

In 1989, Byrne was operating a landscaping company in which workers used flail trimmers, also called string trimmers, to trim around trees and fences and to edge sidewalks and curbs. After complaints about the appearance of lawn-edging work, Byrne developed an improvement to the flail trimmers. Specifically, Byrne's invention was the inclusion of a combined guide and guard mounted on the trimmer near the flail to allow uniform cutting, visually indicate where the flail was cutting, and stabilize the flail. Byrne retained WHE to prepare and prosecute a patent application for his invention, resulting in the issuance of United States Patent No. 5,115,870 ("the '870 patent") on May 26, 1992. Subsequently, Byrne sought and obtained a reissue patent, U.S. Patent No. RE 34,815 ("the '815 patent"), which: (1) expanded the scope of the claims by claiming a flail stabilizing surface; and (2) eliminated the limitation, in some claims of the '870 patent, that the guide rotate.

Claim 24 of the '815 patent is representative of the claims at issue in the underlying infringement action and recites:

> 24. A trimmer for edging grass along a fixed reference surface, said trimmer comprising:
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> * * * *
>
> a dual function flexible flail trimmer guide and guard means mounted on said trimmer inboard of said flexible flail means for guiding said flexible flail means along said reference surface while shielding a user from debris generated by said flexible flail means,
>
> said guide and guard means having an outer-circumferential edge defined by a circumferential

> lip extending radially outwardly therefrom, said circumferential lip having an outer periphery and *a generally planar outboard flail stabilizing surface* . . ., said stabilizing surface being disposed within a path of rotation of said flail means,
>
> wherein said flail means extends radially outwardly from said outer periphery of said circumferential lip as said flail means rotates.

'815 patent col.11 ll.17-40 (emphasis added). The "generally planar" language emphasized above is at the heart of the infringement action and Byrne's legal malpractice claim.

B. Underlying Infringement Action

In late 2004, after unsuccessful licensing negotiations, Byrne sued Black & Decker in the United States District Court for the Eastern District of Kentucky, alleging that Black & Decker's sale of a string trimmer containing a U-shaped wire edge guard infringed the '815 patent. *See* Complaint, *Byrne v. Black & Decker Corp.*, Case No. 2:04-cv-262 (E.D. Ky. Dec. 30, 2004), ECF 1. The district court ultimately granted summary judgment of non-infringement to Black & Decker, finding that the U-shaped wire guard did not meet the "generally planar . . . surface" limitation of the '815 patent, a limitation that was present in each of the claims Byrne asserted. *Byrne v. Black & Decker Corp.*, 80 U.S.P.Q.2d 1686, 2006 WL 1117685, *5 (E.D. Ky. Apr. 27, 2006). On appeal, this court affirmed the district court's grant of summary judgment based on a different construction of the "generally planar . . . surface" limitation that is not relevant for purposes of the present appeal. *Byrne v. Black & Decker Corp.*, No. 2006-1523, 2007 WL 1492101 (Fed. Cir. May 21, 2007).

C. Current Malpractice Action

On May 14, 2008, Byrne filed a legal malpractice action in Kentucky state court against WHE, which WHE

timely removed to the United States District Court for the Eastern District of Kentucky.[1] *See* Notice of Removal, *Byrne v. Wood, Herron & Evans, LLP*, Case No. 2:08-cv-102 (E.D. Ky. May 30, 2008), ECF 1. Byrne moved to remand the case for lack of subject matter jurisdiction, a motion the district court denied. *See Byrne v. Wood, Herron & Evans, LLP*, 2008 WL 3833699 (E.D. Ky. Aug. 13, 2008). The court found that, although legal malpractice is a state law claim, it requires a "suit within a suit" analysis that turns on substantial questions of patent law, thus giving rise to jurisdiction under 28 U.S.C. § 1338. *Id.* at *4 (citing *Air Measurement Techs., Inc. v. Akin Gump Strauss Hauer & Feld, LLP*, 504 F.3d 1262, 1269 (Fed. Cir. 2007)). Accordingly, the case proceeded in federal court.

In its report from the parties' Rule 26(f) discovery planning conference, WHE informed the court that it planned to file an early motion for summary judgment and requested that the court stay all discovery. In response to this request, the district court stayed discovery, with the exception of requests for admission and written interrogatories, and noted that WHE would file its summary judgment motion within thirty days. In December 2008, WHE filed a targeted motion for summary judgment, arguing that the undisputed prosecution history of the '815 patent demonstrates that the patent examiner would not have allowed the asserted claims without the "planar" limitation. In addition, WHE argued that Byrne was aware of and affirmatively signed statements authorizing the inclusion of the term "planar" in the patent. WHE did not submit any expert testimony in support of

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[1] Byrne's original complaint also named another law firm and individual lawyers from that firm as defendants, but he settled his dispute with those defendants, and they have been dismissed from this action. *See* Agreed Partial Entry of Dismissal, *Byrne v. Wood, Herron & Evans, LLP*, Case No. 2:08-cv-102 (E.D. Ky. Sept. 23, 2008), ECF 22.

its motion.

Byrne opposed WHE's motion, arguing that the proper inquiry is not whether the particular patent examiner in this case would have allowed the patent without the "planar" limitation, but whether a hypothetical claim without the "planar" limitation *could* have issued. In support of his opposition, Byrne submitted two affidavits: one from William Kiesel, a patent attorney, and another from Byrne himself. Kiesel's opinion discussed the standard of care for a patent attorney and WHE's alleged negligence, as well as the scope of the prior art Bartholomew patent (U.S. Patent No. 4,091,536), on which the examiner relied in rejecting some of Byrne's original claims. Byrne's affidavit primarily related to the nature of his invention, the scope of the Bartholomew patent, and the novel features of his invention that were independent of the "planar" limitation.

WHE moved to strike portions of both the Kiesel and the Byrne affidavits, arguing that Kiesel was not qualified to provide expert testimony as to the technical aspects of the invention and prior art, and that portions of Byrne's affidavit should be stricken because they contradict the record or are irrelevant. Notably, WHE did not challenge whether Kiesel was qualified to opine on the standard of care for a patent prosecutor, and it did not argue that Byrne was not a person of ordinary skill in the art or otherwise unqualified to offer expert testimony. In response, Byrne argued that the Kiesel and Byrne affidavits complement and rely on each other, such that they "work together as they should, each supporting the other with respect to technical matters and patent matters." Plaintiff's Response to Defendant's Motion to Strike Portions of the Affidavit of William David Kiesel at 2, *Byrne v. Wood, Herron & Evans, LLP*, Case No. 2:08-cv-102 (E.D. Ky. Mar. 9, 2009), ECF 67. As it relates to his own affivadit, Byrne expressly argued that he was a person of at least ordinary skill in the art and qualified to testify as an expert because he was the inventor of the '815 patent, and

because he had substantial experience in the design, manufacture and use of string trimmers.

Initially, the district court granted WHE's motion to strike Kiesel's affidavit, *sua sponte* deciding that Kiesel was "not qualified to provide expert testimony on the issue of legal malpractice in the patent application process." *Byrne v. Wood, Herron & Evans, LLP*, 2009 WL 2382415, at *3 (E.D. Ky. July 30, 2009). It reached this decision despite the fact that Kiesel had worked as a patent attorney for 40 years, written and prosecuted over 500 patent applications, served as an adjunct professor of patent law, and previously prepared expert reports or provided expert testimony on patent-related issues, including in four legal malpractice cases. The court found that, because Kentucky law requires expert testimony on the standard of care in a malpractice action unless it is so obvious as to be familiar to a lay person, Byrne could not defeat summary judgment without such testimony. *Id.* at *2 (citing *Stephens v. Denison*, 150 S.W.3d 80, 82 (Ky. Ct. App. 2004). Accordingly, the court granted summary judgment to WHE. *Id.* at *6. The court also denied WHE's motion to strike Byrne's affidavit as moot. *Id.*

Byrne moved for reconsideration of the court's ruling, citing relevant case law regarding expert testimony and providing a supplemental affidavit from Kiesel. After considering Byrne's new argument and supplemental material, the district court vacated its decision and reconsidered WHE's motion for summary judgment. *Byrne v. Wood, Herron & Evans LLP*, 2010 WL 3394678, at *1 (E.D. Ky. Aug. 26, 2010). In its ultimate decision, the court found that Kiesel was qualified to provide testimony "regarding the standard of care in the patent application process" and struck only the portions of Kiesel's affidavit relating to technical aspects of the Byrne patent and the prior art. *Id.* at *5.

The court, however, *sua sponte* determined that Byrne was not a person of ordinary skill in the art, though it did

so without identifying the requisite level of skill. Based on that conclusion, the court struck the portions of Byrne's affidavit purporting to provide expert testimony, finding that "Byrne provides no information from which the Court could conclude that he is qualified to testify as an expert on this subject." *Id.* at *7. It noted that "[t]he sum of Byrne's qualifications, as set forth in his affidavit, are a bachelor of science degree in an unspecified area of study and experience 'operating a landscaping company that maintained the lawns of apartment complexes and condominiums.'" *Id.* The district court also found that, even if Byrne was a person of ordinary skill in the art, he is not necessarily qualified as an expert. *Id.* (citing *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363 (Fed. Cir. 2008)). Once the district court struck the technical aspects of Kiesel's affidavit and excluded Byrne as an expert entirely, Byrne's opposition was devoid of any technical expert testimony. Accordingly, the district court granted Defendants' motion for summary judgment.

Despite previously reconsidering its decision on Kiesel's expert qualifications, the district court warned Byrne "that any request for reconsideration of the Court's ruling on the ground that he had no notice the Court would consider his qualifications as an expert would not be well-taken" because Kentucky law requiring expert testimony is well established. *Id.* at *7 n.7. Byrne nonetheless filed a motion for reconsideration, in which he identified portions of the record on summary judgment demonstrating that he was a person of at least ordinary skill in the relevant art of string trimmers. The court denied his motion the next day in a summary order. Byrne filed a timely notice of appeal. [2]

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[2] After WHE filed its summary judgment motion, Byrne amended his complaint to add a second claim of legal malpractice arising from the underlying litigation as well as a claim for breach of fiduciary duty. Accordingly, the court treated WHE's motion as a motion for partial summary judgment. Following the district court's order

II. JURISDICTION

On appeal, Byrne initially argues that this court should narrow its jurisdictional case law by excluding from the scope of 28 U.S.C. § 1338 legal malpractice cases that involve only hypothetical patent claims. In its reply brief, however, he abandons that argument after acknowledging that our case law forecloses it. *See Davis v. Brouse McDowell, L.P.A.*, 596 F.3d 1355 (Fed. Cir. 2010) (finding jurisdiction over a legal malpractice action involving missed deadlines in which no patent actually issued). Byrne is correct that our case law, as it currently reads, supports the district court's jurisdiction over Byrne's state law malpractice claim and, by extension, our jurisdiction to hear this appeal. Although we must adhere to our precedent, we believe this court should re-evaluate the question of whether jurisdiction exists to entertain a state law malpractice claim involving the validity of a *hypothetical* patent, for the reasons discussed below.

The question of whether 28 U.S.C. § 1338 provides jurisdiction over a claim that on its face arises under state law necessarily requires us to determine whether hearing the case in a federal forum would "disturb[] any congressionally approved balance of federal and state judicial responsibilities." *Grable & Sons Metal Prods., Inc. v. Darue Eng'g & Mfg.*, 545 U.S. 308, 314 (2005). That balance is less likely to be upset when the case presents a "nearly pure issue of law" rather than one that is "fact-bound and situation-specific," and where resolution of the federal question is "both dispositive of the case and . . . controlling in numerous other cases." *Empire Health-*

granting WHE's motion, the parties stipulated to the dismissal of Byrne's remaining claims as well as to the dismissal of WHE's counterclaim to recover approximately $22,000 in unpaid attorneys' fees. *See* Stipulation of Dismissal, *Byrne v. Wood, Herron & Evans, LLP*, Case No. 08-cv-102 (E.D. Ky. Sept. 28, 2010), ECF 93. The dismissal, therefore, resulted in a final judgment of all claims in this action.

choice Assurance, Inc. v. McVeigh, 547 U.S. 677, 700-01 (2006) (quotation marks and citations omitted). Indeed, it is only the "special and small category" or "slim category" of cases in which a state law cause of action will trigger federal jurisdiction. *Id.* at 699, 701; *see also* R. Fallon, Jr., John F. Manning, D. Meltzer, & D. Shapiro, Hart and Wechsler's The Federal Courts and The Federal System 798-99 (6th ed. 2009) (noting that in only four cases has the Supreme Court upheld jurisdiction under 28 U.S.C. § 1331 in which no federal cause of action is alleged, and examples in lower courts remain infrequent).[3]

Against this backdrop, it is difficult to see the federal interest in determining the validity of a hypothetical patent claim that is ancillary to a state law malpractice action. The outcome of such determinations invariably will rest on case-specific inquiries comparing prior art against patent claims that have not and will never issue. As such, these determinations, which involve only *application* and not *interpretation* of patent law, have little or no bearing on other cases. On the other hand, finding federal jurisdiction over malpractice cases involving questions of hypothetical patent claims opens the federal courthouse to an entire class of actions, thereby usurping state authority over this traditionally state law tort issue. *See Grable*, 545 U.S. at 318 (explaining the concern in

[3] Although *Grable* and *Empire Healthchoice* involved federal question jurisdiction under 28 U.S.C. § 1331, the "arising under" language in § 1331 has the same meaning as it does in § 1338. *See Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808-09 (1988). The recent passage of the Leahy-Smith America Invents Act also does not change this analysis because the jurisdictional amendments in that legislation do not alter the "arising under" language that is at the core of this issue. *See* Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 19, 125 Stat. 284, 331-32 (2011). The amendments to §§ 1295 and 1338, moreover, do not apply to this particular case because they are effective only for actions commenced on or after the date of enactment. *Id.* at § 19(e).