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[Removal to District Court Proper Where Patent Legal Malpractice Action Involves Substantial Questions of Federal Patent and Trademark Law](#)

February 1st, 2011 by [Mark Hancock](#)

The United States District Court for the Eastern District of California issued a ruling on January 20, 2011 concluding that a legal malpractice action alleging negligent prosecution of a patent fell within the court's exclusive jurisdiction and that, therefore, removal to federal court was proper.

In *Gerawan Farming v. Worrel & Worell* (2011 U.S. Dist. LEXIS 8447, Case No. 1:10cv02011 AWIDLB), a client fruit grower filed a state court legal malpractice action against two law firms, alleging that they prepared and prosecuted various patents in a way that created a risk that a trademark belonging to the client could be damaged or invalidated. The law firms removed the action to federal court on the ground that it had exclusive jurisdiction pursuant to 28 U.S.C. section 1338. The client filed a motion to remand, asserting that any federal issues raised by the complaint were tangential.

In its unpublished decision, the District Court cited *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800, 809 (1988) for the standard that the complaint should be resolved in federal court "if plaintiff's right to relief necessarily depends on resolution of a substantial question of federal patent law." The court then ruled that the removal was proper because, depending on the outcome of a related trademark infringement action, "[p]laintiff will [either have] to prove causation by showing that the use of the trademark in the patent name was the cause of the generic finding and resulting invalidation," or will "have to show that Defendants' use of the trademark in the patent name resulted in [an allegation in the infringement action] that the mark is generic." "Under either scenario," the court reasoned, "plaintiff will be required to undertake an analysis of federal patent and trademark law." The court added that assessing plaintiff's alleged damages "will require interpretation of federal law."