12 Tex. Intell. Prop. L.J. 473

Texas Intellectual Property Law Journal
Spring 2004

Articles

LITIGATING INTELLECTUAL PROPERTY DISPUTES IN TEXAS STATE COURT

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*474 Introduction

Choice of forum is a key tactical decision in any lawsuit. Yet, when it comes to enforcing intellectual property rights, most practitioners automatically choose federal court. Why is this? Perhaps it is because federal courts have exclusive jurisdiction over matters arising from patent, plant variety protection, and copyright laws. Or perhaps it is because intellectual property lawyers with a national practice prefer to work with only one set of civil rules. While there are many benefits to filing in federal court, Texas intellectual property practitioners should consider the strategic advantage of Texas state courts in appropriate circumstances. This paper will first outline certain jurisdictional rules affecting intellectual property cases. It will then address the procedural differences between federal court and Texas state court that should be considered in selecting the best forum.

I. District Court Jurisdiction in the United States

Initially one needs to determine whether there is a choice of forum at all. Intellectual property cases can roughly be divided into three categories: (1) those that must be litigated in federal court (so-called "exclusive jurisdiction"), (2) those that can but need not be asserted in federal court (federal question jurisdiction), and (3) those that might be litigated in federal court, depending on certain factors (for example, diversity of citizenship).

A. Exclusive Jurisdiction

Section 1338(a) of Title 28 of the United States Code provides:

> The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. ***475** Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.[1]

1. Patent Cases

Section 1338(a) grants exclusive jurisdiction to the federal district courts in cases arising under the patent laws. An action "arises under" the federal patent laws if patent law creates the cause of action or is a necessary element of the claim.[2] The

Supreme Court models section 1338(a)'s "arising under" analysis on similar wording in section 1331, the general federal question statute.[3]

Whether a claim "arises under" patent law must be determined from the complaint itself, "unaided by anything alleged in anticipation or avoidance of defenses."[4] A case raising a federal patent law defense does not, for that reason alone, "arise under" patent law, "even if the defense is anticipated in the plaintiff's complaint, and even if both parties admit that the defense is the only question truly at issue in the case."[5] Further, if the complaint alleges as grounds for relief reasons unrelated to patent law, then the claim does not "arise under" those laws.[6] Thus, even if a claim is supported by patent-related theories, section 1338(a) jurisdiction may not be available unless patent law is also at least partly the basis of each of the alternative theories as well.[7] For example, federal courts have held that the following claims are not sufficient to arise under the federal patent laws: patent invalidity raised as a defense,[8] ownership of a patent with an injunction against a non-owner,[9] construction of a patent license agreement,[10] alleged conspiracy to preclude a plaintiff ***476** from exploiting his patent rights,[11] and the determination of an assignor's rights under a patent assignment.[12]

2. Copyright Cases

The classic test for copyright jurisdiction was announced by Judge Friendly:

> Mindful of the hazards of formulation in this treacherous area, we think that an action 'arises under' the Copyright Act if and only if the complaint is for a remedy expressly granted by the Act, e.g., a suit for infringement or for the statutory royalties for record reproduction, . . . or asserts a claim requiring construction of the Act, . . . or, at the very least and perhaps more doubtfully, presents a case where a distinctive policy of the Act requires that federal principles control the disposition of the claim.[13] From this test it is apparent that the court looks only to the complaint to determine whether the plaintiff is suing for a remedy expressly granted by the Copyright Act. Federal jurisdiction will exist for an injunction against future infringements, a claim for statutory damages, or a claim requiring construction of one of the Act's provisions.[14] Further, federal jurisdiction will also lie where the objective of the complaint is to determine whether a work is for hire[15] or one of joint authorship.[16]

However, suits involving contractual matters, such as those to enforce a license to pay royalties on a copyrighted work, must be brought in state court, absent some other basis for federal jurisdiction.[17] In determining whether an action lies purely in contract, the courts look to see whether the primary objective of the litigation is to determine the effect or validity of an assignment. If so, no federal jurisdiction exists.[18] Other courts have looked to the "essence" or "gist" of the claim to determine whether the plaintiff's case involves a genuine issue of infringement.[19] Example of copyright-related suits not sufficient to establish federal jurisdiction include ***477** a construction of an assignment of royalties under a copyright license,[20] an action to invalidate contractual rights pertaining to copyright,[21] an action to enforce arbitration of a contract involving copyright,[22] an action for breach of warranty involving a determination of infringement of a third party's copyright,[23] and an action to determine the validity of a copyright assignment.[24]

B. "Arising Under" Jurisdiction

The Judicial Code also confers federal jurisdiction over actions arising under federal trademark law.[25] However, federal courts do not possess exclusive jurisdiction over such actions.[26] Where an infringement action is based on a federally registered trademark, for example, the action may be brought in either a state or federal court, as may a false advertising or anti-dilution action based on the Lanham Act.[27] A potential plaintiff may therefore choose to bring a Lanham Act claim in either forum-- subject, of course, to the defendant's ability to remove the case from state to federal court.

In a state court action for federal trademark infringement, the court may rule on the scope and validity of the federal registration,[28] but all questions of validity and infringement of federally registered trademarks are controlled by federal law.[29] A state court does not have the power to determine whether a particular mark can be registered in the federal system.[30]

***478** Federal district courts also have original (but not exclusive) jurisdiction over actions asserting a claim of unfair competition when joined with a substantial and related claim under any of the copyright, patent, plant variety protection, or trademark laws.[31] These include causes of action such as trade secret claims,[32] misuse of confidential information,[33] and certain interference with contract claims.[34] A "substantial" claim for purposes of section 1338(b) is one that is capable of

withstanding a motion to dismiss for lack of jurisdiction, even though it may not be able to withstand a motion to dismiss on the merits.[35] Alternatively, an unfair competition claim is "substantial" unless it is clearly immaterial and made solely to obtain jurisdiction.[36]

C. Other Jurisdictional Bases

Mentioned so far are actions arising under the laws or constitution of the United States. All other actions--that is, all actions not "arising under" federal law--require an independent jurisdictional basis to get into federal court. Intellectual property actions falling under this rubric include state law unfair competition, state law trademark, breach of license, intellectual property ownership disputes, covenants not to compete, misappropriation of trade secrets, tortious interference, trade disparagement, and state law trademark dilution. In these situations, federal court jurisdiction must rest on another basis, such as diversity of citizenship jurisdiction.[37] Without such additional basis, no forum choice is available, and the case must remain in state court.

D. When Forum Selection Is Made

The possibility of choosing between federal and state court arises in two situations. From the plaintiff's side, the decision must be made before initial filing of the suit. From the defendant's side, the decision is made in the context of removing the case to federal court. In general, the defendant has 30 days from initial ***479** notification to decide whether to remain in state court or remove the case to federal court.[38] Cases not removed during this period remain in state court.

II. Factors

Whether to choose federal court or state court for eligible intellectual property suits is a complex question. There are several factors affecting such a decision for a Texas-based cause of action.

A. Injunctive Relief

One of the key strategic determinants of where to file includes an assessment of whether a temporary restraining order (TRO) or preliminary injunction will be sought. The purpose of injunctive relief is the same in state and federal court: to preserve the status quo pending a trial on the merits.[39] Case law in Texas defines the status quo as the last, actual, peaceable, non-contested status that preceded the controversy.[40] State and federal forums each require the plaintiff to show that it has a probable right to the relief it seeks upon final trial[41] and that there is a potential for irreparable injury to the plaintiff unless the court grants an injunction.[42] Federal courts have added two additional elements: (1) the threatened injuries to the plaintiff outweigh any damage the injunction might cause to the defendant, and (2) the injunction will not disserve the public interest.[43] Texas courts and statutes have added two additional requirements: (1) there is no other adequate remedy at law available,[44] and (2) the grounds for the injunction fall within statutory guidelines.[45]

***480** There are other procedural advantages for choosing Texas state courts. Parties in state court are entitled to a contested hearing for injunctions.[46] In contrast, federal courts often decide such issues solely on affidavits and documents, eschewing live testimony.[47] Proceeding in state court thus allows a plaintiff with a story to tell to present its witnesses live rather than merely in written form. Additionally, the party seeking a temporary injunction in Texas has to obtain a bond to protect the enjoined party. Rule 684 of the Texas Rules of Civil Procedure makes a temporary injunction issued without the posting of a bond void.[48] Fifth Circuit precedent, on the other hand, permits temporary injunctions issued without any bond or security.[49]

Certain types of intellectual property cases necessitate injunctive relief. These types of cases include enforcement of covenants not to compete and non-disclosure agreements, protection of trade secrets and other proprietary information, bringing to a halt trademark infringement and dilution, and ending a competitor's false advertising. In such cases the issuance of a temporary restraining order clearly shifts the momentum in favor of the plaintiff. While the object of a TRO is the same in both state and federal court--preservation of the status quo pending decision on a temporary injunction[50]--the culture of those courts on this subject is much different. Plainly put, a litigant is much more likely to obtain a TRO (ex ***481** parte or otherwise) in a Texas state court than in a federal court. Indeed, one of the best techniques to reverse a plaintiff's injunctive momentum in state court is to remove the case to federal court where the TRO will likely be cancelled. A party seeking to

obtain (or defeat) a TRO should keep this in mind when selecting the proper forum.

B. Parallel Proceedings

Another factor to consider is whether parallel litigation exists in another state. This is relevant both for determining application of res judicata principles and also for potential transfer and consolidation of the two cases. The United States Constitution's Full Faith and Credit Clause[51] is implemented by the federal full faith and credit statute.[52] The Supreme Court has interpreted this law to require federal courts to "give to a state-court judgment the same preclusive effect as would be given that judgment under the law of the State in which the judgment was rendered."[53] Texas state courts adhere to this interpretation.[54]

The general federal rule for application of res judicata principles between competing suits is the "first to judgment" rule.[55] Again, this rule also applies in Texas state court.[56] Under this rule--promulgated by the Restatement (Second) of Judgments--the order of filing of the two suits is irrelevant; instead, the first case to reach judgment will preclude the other suit no matter when the case was filed.[57]

Consider this scenario: A sues B in federal court for breach of contract in California. B believes that A has misappropriated its trade secrets but would prefer to litigate the case in Texas. Should B file in state or federal court? The key distinction here is the availability in federal court of a transfer under section 1404(a).[58] ***482** Under this section, for example, a filing by B in a Texas federal court would allow A to move for a transfer of venue of the second action to California for consolidation with the earlier case.[59] If B were to file in a Texas state court, on the other hand, the case could not be transferred or consolidated with the first one. A would be left to seek an abatement or dismissal in Texas state court--a more difficult proposition. This means that B should carefully craft its state court petition in Texas to ensure that it does not state any grounds for federal jurisdiction, since a removal by A to federal court in Texas will set the case up for transfer entirely out of Texas.

C. Venue

The general federal venue rule provides that an individual defendant must be sued in a district where one of three requirements are satisfied. First, the defendant may be sued where any defendant resides, if all defendants reside in the same state.[60] Second, the defendant may be sued where a substantial part of the events giving rise to the action arose.[61] Finally, a defendant may be sued where any defendant is subject to personal jurisdiction at the time the action is commenced, if there is no district in which the action may otherwise be brought.[62]

Under federal law, residence of an individual is equivalent to permanent residence or legal domicile.[63] This is a fact question.[64] A corporate defendant is deemed to reside in any judicial district in which it is subject to personal jurisdiction at the filing of the action.[65] If a state has more than one district, a defendant corporation is deemed to reside in a specific district in that state if it meets two requirements: (1) it is subject to personal jurisdiction in the state at the time the action ***483** is commenced, and (2) its contacts with that district are sufficient to subject it to personal jurisdiction were that district a separate state.[66] If no such district exists, the defendant corporation is deemed to have its residence in the district in which it has the most significant contacts.[67]

Texas law, on the other hand, sets up a system of mandatory and permissive venue. If a mandatory venue rule applies, the suit must be brought pursuant to that provision.[68] Mandatory venue rules cover, inter alia, suits involving libel, slander, or invasion of privacy,[69] suits primarily seeking injunctive relief against a party,[70] and suits arising from a written contract specifying venue and involving a "major transaction."[71] If venue is not mandated, the plaintiff can file in any county in which venue is permitted by specific statute or under the general venue rule.[72] Specific permissive venue statutes cover, inter alia, suits involving breach of warranty[73] and suits involving a contract to be performed in a particular Texas county.[74]

The general Texas venue statute requires that suit be brought in the county in which (1) all or a substantial part of events or omissions giving rise to the claim occurred, (2) the defendant resides at the time the cause of action accrued, if the defendant is a natural person, or if the defendant is not a natural person, in the county of the defendant's principal office in Texas, and 3) if neither of the preceding provisions apply, the plaintiff's county of residence at the time the cause of action accrued.[75] A corporation's "principal office" is defined to be the location where "the decision makers for the organization within this state conduct the daily affairs of the organization."[76]

***484** In multiple party cases in state court, each plaintiff must establish proper venue independently of all other plaintiffs.[77] If not, each cause of action of that plaintiff must be transferred to another county, unless a four part statutory test is met.[78] If the plaintiff establishes proper venue against one defendant, proper venue is established as to the remaining defendants in all claims arising out of the same transaction or occurrence or series of transactions or occurrences.[79] If the plaintiff joins multiple claims arising from the same transaction and one is governed by a mandatory venue provision, that provision controls venue for the suit.[80]

In federal court cases involving multiple claims and parties, the general rule is that venue must be proper as to each defendant and claim.[81] The doctrine of "pendent venue," however, allows venue that is proper for a federal claim to be proper for other claims if all the claims pleaded arose out of the same transaction or occurrence.[82]

Determination of the most advantageous court based on the previously stated rules is detailed and fact specific. While federal venue is generally broader (at least as against corporate defendants), the Texas practitioner should make this decision on a case-by-case basis.

D. Protective Order

Another factor to consider is whether the litigation will involve disclosure of proprietary information or trade secrets. Federal courts are authorized to issue protective orders to shield such information from public view.[83] To carry its burden, the proponent must show both that the information sought is a trade secret and that its disclosure might be harmful.[84] The burden then shifts to the party seeking discovery to establish that the disclosure of trade secrets is relevant and necessary to the action.[85] The district court should balance the requesting party's need for the ***485** trade secrets against the claim of injury of the responding party resulting from disclosure.[86]

In Texas state court, trade secret protection is found in Texas Rule of Evidence 507, which provides:
A person has a privilege, which may be claimed by the person or the person's agent or employee, to refuse to disclose and to prevent other persons from disclosing a trade secret owned by the person, if the allowance of the privilege will not tend to conceal fraud or otherwise work injustice. When disclosure is directed, the judge shall take such protective measure as the interests of the holder of the privilege and of the parties and the furtherance of justice may require.[87] Under Rule 507, once a party resisting discovery establishes that the information is a trade secret, the burden shifts to the party seeking the information to establish that the information sought is necessary for a fair adjudication of the party's claims. "If the requesting party meets this burden, the trial court should ordinarily [order production] of the information, subject to an appropriate protective order."[88] The party seeking discovery should indicate the facts that are expected to be discovered and explain how they will assist in preparation of the party's case.[89] If the trial court orders disclosure of a trade secret, the affected party may seek relief by mandamus.[90]

An additional step in state court is found in Texas Rule of Civil Procedure 76a. Under this rule, all court records are presumed to be open to the general public and can be sealed only upon satisfying all the requirements therein.[91] Discovery exchanged between the parties in a trade secret case is not normally considered to constitute court records[92] unless the discovery concerns matters that have a probable adverse effect on the general public health or safety, operation of government, ***486** or administration of public office.[93] Before limiting disclosure of documents (such as those claimed to be trade secrets), the trial court is required to determine that such documents do not constitute court records under the rule.[94] Thus, practitioners in intellectual property cases that could be construed to involve matters of public health or safety will have more difficulty shielding proprietary information in state court.

E. Personal Jurisdiction

In federal court, once a jurisdictional question is raised, it is the plaintiff's burden to persuade the court that jurisdiction is proper.[95] In contrast, state court rules place the entire burden of disproving personal jurisdiction on the defendant.[96] In a case involving close questions of personal jurisdiction, this can be an important factor in forum choice.

F. Discovery Procedures

1. Generally

The scope of discovery is also different between federal and state court. In federal court, ignoring the effect of local rules, each party is limited to ten depositions of seven hours each and not more than twenty-five interrogatories.[97]

Texas state court has a more detailed system. Upon filing an action, the plaintiff is required to select a discovery level or plan for controlling the remainder of the suit.[98] Level I plans are limited to cases in which the amount in controversy does not exceed $50,000.[99] Discovery in such cases begins when suit is filed and continues until 30 days before the date set for trial.[100] Each side is limited to a total of 6 hours of deposition examination, unless agreement to increase the time is reached.[101] In Level I discovery only 25 interrogatories are permitted.[102] Level II ***487** discovery--which are the default plan if none is specified--have a 50 hour limit on depositions per side; interrogatories are limited to 25.[103] The discovery period begins when suit is filed and generally continues until the earlier of 30 days before trial or nine months after the earlier of the date of the first deposition or the due date of the first response to written discovery.[104] In Level 3 discovery the court is required upon motion to issue a discovery control plan for the case. The plan must include certain information and discovery limitations.[105] The Level 3 plan is the most similar to the federal practice.

2. Initial Disclosures

Federal Rule of Civil Procedure 26 requires an initial meeting between counsel for the parties to discuss case management issues.[106] The parties are required to attempt in good faith to agree on a proposed discovery plan and to submit to the court a report outlining this plan.[107] Rule 26 also requires the automatic disclosure of certain information, including identification of persons with knowledge of relevant facts, all documents which support the claims or defenses of the responding party, certain expert information, computation of damages claimed by the responding party (with supporting documentation), and insurance or indemnity agreements.[108] These disclosures must be made within fourteen days of the initial Rule 26(f) meeting of counsel.[109]

The Texas state court practice is somewhat different. While there is no automatic disclosure requirement, a different type of discovery instrument--the request for disclosure--triggers an obligation on the responding party to provide certain information. The information that must be provided in response includes identification of persons with relevant knowledge and potential parties, the correct names of the parties to the suit, the legal theories and general factual bases of the responding party's claims or defenses, the amount and method of calculating economic damages, certain expert witness information, indemnity and insurance agreements, settlement ***488** agreements affecting the suit, witness statements, and relevant medical records and bills (for personal injury cases).[110] State law recognizes no objections to this inquiry.[111]

3. Pretrial Disclosures

In federal court a party is further required to disclose, at least 30 days before trial, the following: an identification of trial witnesses, an identification of depositions intended to be offered into evidence, and an identification of exhibits the party intends to or may offer at trial.[112] Within 14 days of such disclosure, the opposing party may serve and file its objections to the deposition designations, and, together with grounds, objections to trial exhibits.[113] With limited exceptions, objections not made in this fashion are waived.[114]

Texas state court has no analogous rule other than the provision in Rule 166 for the court to order trial-oriented disclosures.[115] The Texas rules do allow the discovery through interrogatories of a party's trial witnesses.[116] Additionally, production of documents by a party in Texas state court authenticates the document for use against that party at trial unless, within 10 days of notice that the opposing party intends to use the document, the producing party objects to the authenticity of the document, stating the specific basis for objection.[117]

4. Expert Disclosures

The Federal Rules require the disclosure--at least 90 days prior to trial--of the identity of testifying experts.[118] The disclosure must, in the case of retained experts or in-house experts whose normal role is to provide testimony, be accompanied by a written report. The report must also include a complete statement of all opinions of the expert and the basis of same, the data which the expert considered, any exhibits summarizing or supporting the opinion, and a list of the witness's ***489** qualifications, compensation, publications in the previous 10 years, and testimony given in the previous 4 years.[119] In federal court, the ordinary rule is that the party seeking discovery pay the expert's fee for the time spent responding to discovery and

depositions.[120]

If requested, a party in a Texas state court proceeding that retained an expert is required to provide, at least 90 days prior to the close of discovery, the expert's current resume and bibliography, documents and data provided to or prepared by the expert in anticipation of testimony, the expert's opinions and the basis for the opinions, and any identifying information.[121] Importantly, there is no requirement in Texas state court that an expert prepare a report; rather, the court must order preparation of the report.[122] Furthermore, a party in state court must pay for its own expert's time in preparing for and attending the expert's own deposition.[123]

5. Compulsory Process For Witnesses

Another difference lies in the discovery procedures for out-of-state witnesses. Under federal law, an attorney may issue and sign a subpoena on behalf of "a court for a district in which a deposition or production is compelled by the subpoena, if the deposition or production pertains to an action pending in a court in which the attorney is authorized to practice."[124] A motion to quash or enforce the subpoena must be brought in the district of the witness's residence.[125]

In Texas state court, on the other hand, the deposition of a witness in another state or foreign country may be taken by notice, letter rogatory, letter of request, agreement of the parties, or court order.[126] Note that while simply forwarding a Texas deposition notice is convenient, there is no mechanism to compel attendance at the deposition if the witness is uncooperative. The most common method is issuance of a letter rogatory (or commission) from a Texas court requesting that the applicable foreign court summon the witness for testimony and cause the testimony to be reduced to writing.[127] In such a case, Texas counsel will likely have to retain ***490** counsel in the witness's forum to file a miscellaneous action in that forum, have a subpoena issued out of that case, and then serve the witness. This added time and expense in state court becomes important in large intellectual property cases with witnesses in multiple states.

6. Duty To Supplement

Both federal and Texas state courts require supplementation of written discovery responses if the responding party learns that the response is incorrect or incomplete.[128] Both also require the supplementation of expert reports and deposition transcripts, though in Texas state court the duty is limited to changes in the expert's mental impressions or opinions.[129] Texas requires that additions or corrections to disclosure of the identification of witnesses and "persons with knowledge" be in the form of amended or supplemental responses, rather than the broader standard of disclosure "in writing" or "in the discovery process" used by the federal courts.[130] Failure in a Texas state proceeding to supplement identification of witnesses and persons with knowledge at least 30 days prior to trial creates a presumption that the omitted persons cannot testify at trial.[131]

7. Privilege

In Texas, the rules regarding evoking privilege are quite involved in comparison to their federal counterparts. Pursuant to the Texas Rules of Civil Procedure, "[a] party should not object to a request for written discovery on the grounds that it calls for production of material or information that is privileged."[132] Instead, the "party who claims that material or information responsive to written discovery is privileged may withhold the privileged material or information from the response."[133] The party must state--either in the discovery response or in a separate document--that information responsive to the request has been withheld based on privilege along with the privilege asserted.[134]

After receiving a response indicating that material has been so withheld, the party seeking discovery in Texas state court may serve a written request that the ***491** withholding party identify the information withheld.[135] The withholding party must then, within 15 days, identify in writing for each withheld document facts sufficient to support the privilege and the specific privileges claimed.[136] The rule also requires that a party may withhold its lawyer's files without providing any notice.[137] Finally, Texas law mandates that privileges are not waived by inadvertent production of privileged material so long as within 10 days of learning of the inadvertent production the producing party amends the response, identifies the material produced, and claims privilege.[138] In such a case the requesting party must promptly return the specified information.[139]

In federal court, when a party withholds allegedly privileged information, the party is required to object on the basis of privilege and describe the nature of the documents, communication, or things not produced in a manner sufficient to enable other parties to examine the basis for the privilege.[140] The Fifth Circuit analyzes waiver by inadvertent discovery production on a case-by-case basis.[141]

G. Summary Judgment

Another key difference between state and federal court which has an impact on forum choice is the likelihood or desirability of disposition by summary judgment or motion to dismiss. Federal district judges have between one and three law clerks to assist them with motions and trials. State court judges at the trial level generally have no law clerks. Accordingly, the federal level has more resources to comb through lengthy and complicated motion briefing, perhaps giving such motions a better likelihood of being granted. In state court, the trial judge will have little or no help in sifting through pretrial motions prior to decision. Accordingly, attorneys whose cases are based in shades of meaning or nuance might consider the federal venue.

H. Use Of Magistrate Judges And Visiting Judges

Under Federal Rule of Civil Procedure 72 and the Federal Magistrates Act, a United States district court may transfer certain pretrial motions to a magistrate ***492** judge without the parties' agreement.[142] These matters include discovery motions[143] and sanctions.[144] On these matters, the ruling of the magistrate judge will be reversed by the district court only if clearly contrary to the law.[145] If consent of the parties is not obtained, rulings on dispositive matters, such as motions for summary judgment,[146] and applications for temporary injunctive relief,[147] are in the form of recommendations only.[148] Recommendations by a magistrate judge do not take effect until the district court enters an order accepting the recommendation.[149] If a timely objection is filed, the district court must make a de novo determination of the recommendation, though no second evidentiary hearing is required.[150] If the parties agree, a district court can assign a case for disposition of all phases by a magistrate judge.[151]

Texas does not have positions directly analogous to magistrate judges, although associate judges and "visiting judges" bear similarity. A sitting state district judge can assign to an associate judge any civil case or portion of a civil case.[152] Once the case is assigned, the associate judge is empowered to hear evidence, conduct hearings, examine witnesses, and perform all other acts that are necessary and proper for the efficient performance of the duties required by the order of referral.[153] After receiving notice of an associate judge's decision, but no later than the third day of the notice, either party has the right to file an appeal in the referring court.[154] Decisions of the associate judge are tried de novo in the referring court, and except by leave of court, no additional evidence is heard.[155]

***493** A visiting judge in Texas--referred to as an "assigned judge" in the statute--is a retired or former judge appointed to the case by the presiding judge of the administrative region.[156] Unlike an associate judge and a magistrate judge, once the case is assigned to a visiting judge, the assigned judge has the full power and authority of a sitting judge.[157] A party must object to the assignment of a visiting judge by the earlier of 7 days of receiving notice of the assignment or the date of the first hearing or trial in the case, including pretrial hearings.[158] Parties are allowed only one such objection during the pendency of the case unless the visiting judge was defeated in the last primary or general election.[159] In this case, there is no limit to the number of objections lodged.[160]

I. Voir Dire

Voir dire, or jury selection, is frequently different in federal and state courts. Texas courts allow counsel broad latitude to examine the jurors on matters relevant to the trial.[161] Voir dire in Texas state court is linked to the constitutional right to a fair trial.[162] A state trial court's decision preventing examination of a juror is more likely to be reversed than one allowing examination.[163] In Texas district court, each side is given six peremptory strikes, while in county court the parties are limited to three.[164]

In federal court, local rules often require parties to submit proposed voir dire questions to be posed by the judge.[165] While voir dire should be conducted to permit the parties to make reasoned peremptory challenges and challenges for cause,[166] federal courts have discretion to perform the voir dire examination on their own to the exclusion of the parties.[167] In many federal district courts, it is common practice ***494** for the district judge to conduct the entire voir dire examination.[168] Each side is given three peremptory strikes.[169]

J. Use Of Deposition Transcripts At Trial

One significant difference between federal and state court involves the use of deposition transcripts. In state court, a deposition taken in the same proceeding as the trial is not hearsay, and the deponent need not be unavailable for the transcript to be used as evidence.[170] The deposition can be used for any purpose in the "same proceeding,"[171] which includes a proceeding in a different court involving the same subject matter and the same parties or their representatives or successors in interest.[172]

Federal court allows the use of depositions for impeachment purposes irrespective of witness availability[173] and against an adverse party or its representative.[174] Other uses of the deposition transcript, such as presenting substantive evidence of one's own witnesses, however, are permitted only if the witness is "unavailable."[175]

K. Open Cross Examination

In federal court, the scope of cross-examination is limited to the matters covered by the direct examination, unless leave of court is granted.[176] In Texas state court, cross examination is "wide open," meaning that the cross is not limited to the subject matter of the preceding examination but can inquire into any subject relevant to the case, including credibility.[177] This means that in Texas calling an opposing witness live during your case in chief permits the opponent to obtain any and all evidence from that witness in the middle of your case. In Texas state courts, ***495** calling adverse opponents live is a risky proposition, which is why deposition transcripts are frequently preferred.[178]

L. Facts Underlying Expert Testimony

The test for admissibility of expert testimony in state and federal court is similar.[179] One difference between the forums is the treatment of facts underlying expert testimony. In federal court, facts or data that are otherwise inadmissible are not disclosed to the jury unless the court determines that their probative value outweighs their prejudicial effect.[180] In Texas state court, underlying facts or data--otherwise inadmissible--can be offered by the proponent of the expert unless "the danger that they will be used for a purpose other than as explanation or support for the expert's opinion outweighs their value as explanation or support or are unfairly prejudicial."[181]

M. Jury Issues

Another factor to consider in forum selection is whether a jury is desired. Texas state courts empanel a jury of twelve and require a majority of ten to reach a verdict.[182] Federal courts generally require between six and twelve persons on the jury but mandate that the decision be unanimous.[183] There are other procedural differences. In federal cases, a party must demand a jury within ten days of "service of the last pleading directed to the issue" on which the jury is demanded.[184] In most cases, a party's jury demand in federal court is timely if served within ten days of the defendant's answer to the complaint[185] or a plaintiff's reply to counterclaim,[186] or ten days after removal of the case from state court.[187] A jury demand in Texas state court is timely so long as it is filed--with the applicable jury fee--at least ***496** thirty days prior to trial.[188] Thus, the decision whether to request a jury can be delayed much longer in state court.

Finally, consideration of the jury pool is appropriate. Cases in Texas state court draw venire from the county in which the court sits;[189] federal courts, on the other hand, draw jurors from multiple counties within that court's district and division.[190] This is an important consideration where counties with very different attitudes towards lawsuits sit adjacent to each other. Where the county is favorable to the plaintiff, a filing in state court limits the potential jurors to that county. On the other hand, if for venue purposes the plaintiff is required to file in a distinctly unfriendly county, filing in federal court may dilute the unfriendly county's jurors with jurors from other counties still within the federal court's district and division. A defendant considering removal should similarly consider this factor.

III. Conclusion

From the foregoing it is apparent that some significant differences remain between the Texas state and federal court systems. While suits for patent or copyright infringement remain exclusive to federal courts, many intellectual property cases--including causes of action arising under both federal and state law--can potentially be brought in Texas state court. The question of which court is most suitable for a particular case is complex and depends on specific facts and circumstances.

A review of the aforementioned factors will assist the practitioner in obtaining the best possible procedural environment for his or her case.

Footnotes

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[1] 28 U.S.C. 1338(a) (2000) (emphasis added).

[2] Scherbatskoy v. Halliburton Co., 125 F.3d 288 291(5th Cir. 1997); see Christianson v. Colt Indus. Operating Corp., 486 U.S. 800, 808-09 (1988); Logan v. Burgers Ozark Country Cured Hams, Inc., 263 F.3d 447, 451 (5th Cir. 2001).

[3] Christianson, 486 U.S. at 808.

[4] Franchise Tax Bd. of the State of Cal. v. Construction Laborers Vacation Trust for S. Cal., 463 U.S. 1, 10 (1983) (quoting Taylor v. Anderson, 234 U.S. 74, 75-76 (1914)); see Louisville & Nashville R.R. Co. v. Mottley, 211 U.S. 149, 152-53 (1908).

[5] Franchise Tax Bd., 463 U.S. at 14.

[6] Id. at 26.

[7] See, for example, Howery v. Allstate Ins. Co., 243 F.3d 912, 918 (5th Cir. 2001) (holding that no federal jurisdiction exists where alleged violation of federal statute was only one of several bases for a Texas Deceptive Trade Practices claim).

[8] Pratt v. Paris Gas Light & Coke Co., 168 U.S. 255, 258 (1897); see also Lear, Inc. v. Adkins, 395 U.S. 653, 660 (1969) (holding that a state court must hear the issue of patent validity if raised by a defendant in breach of license suit).

[9] New Marshall Engine Co. v. Marshall Engine Co., 223 U.S. 473, 479-80 (1912).

[10] Studiengesellschaft Kohle, m.b.H. v. Hercules, Inc., 105 F.3d 629, 632 (Fed. Cir. 1997).

[11] Hess v. Petrillo, 259 F.2d 735, 736 (7th Cir. 1958).

[12] Robb Container Corp. v. Sho-Me Co., 566 F. Supp. 1143 (N.D. Ill. 1983).

[13] T.B. Harms Co. v. Eliscu, 339 F.2d 823, 828 (2d Cir. 1964).

[14] See Muse v. Mellin, 212 F. Supp. 315, 318 (S.D.N.Y. 1962), aff'd per curiam, 339 F.2d 888 (2d Cir. 1964) (no jurisdiction because suit was dispute between assignees about interpretation of their interests in renewal term, not about construction of the Act or infringement); Peay v. Morton, 571 F. Supp. 108, 112 (M.D. Tenn. 1983).

[15] See RX Data Corp. v. Dep't of Soc. Servs., 684 F.2d 192, 196 n.1 (2d Cir. 1982); Royalty Control Corp. v. Sanco, Inc., 175

U.S.P.Q. (BNA) 641, 642 (N.D. Cal. 1972).

[16] Goodman v. Lee, 815 F.2d 1030, 1031-32 (5th Cir. 1987) (plaintiff's claim that she was a joint author "clearly involves the application and interpretation of the copyright ownership provisions of section 201(a)"); Lieberman v. Chayefsky, 535 F. Supp. 90, 91-92 (S.D.N.Y. 1982).

[17] For example, Danks v. Gordon, 272 F. 821, 827-28 (2d Cir. 1921); Golden W. Melodies, Inc. v. Capitol Records, Inc., 79 Cal. Rptr. 442, 445 (Cal. Ct. App. 1969).

[18] See T.B. Harms, 339 F.2d at 825.

[19] See Topolos v. Caldewey, 698 F.2d 991, 993-94 (9th Cir. 1983).

[20] Yount v. Acuff Rose-Opryland, 103 F.3d 830, 834 (9th Cir. 1996).

[21] Dolch v. United Cal. Bank, 702 F.2d 178, 180-81 (9th Cir. 1983).

[22] Saturday Evening Post Co. v. Rumbleseat Press, Inc., 816 F.2d 1191, 1195 (7th Cir. 1987).

[23] Stamps v. Mills Music, Inc., 92 N.Y.S.2d 79, 81-82 (N.Y. Sup. Ct. 1949).

[24] Peay v. Morton, 571 F. Supp. 108, 112 (M.D. Tenn. 1983).

[25] 28 U.S.C. § 1338(a).

[26] See Pioneer First Fed. S&L Ass'n v. Pioneer Nat'l Bank, 659 P.2d 481, 487 (Wash. 1983) ("By granting exclusive jurisdiction over patent and copyright cases, but expressly granting only original jurisdiction in trademark matters, the inevitable conclusion is that states may hear claims arising under the Federal Trademark Act.").

[27] See 15 U.S.C. § 1125 (1999); Aquatherm Indus. v. Fla. Power & Light Co., 84 F.3d 1388, 1394 (11th Cir. 1996) ("Federal courts do not have exclusive jurisdiction over an action brought under the Lanham Act."); Deats v. Joseph Swantak, Inc., 619 F. Supp. 973 (N.D.N.Y. 1985).

[28] 15 U.S.C. § 1119 (2000).

[29] Clairol, Inc. v. Gillette Co., 389 F.2d 264, 268 n.9 (2d Cir. 1968); Huber Baking Co. v. Stroehmann Bros. Co., 252 F.2d 945, 952 n.16 (2d Cir. 1958); B.F. Goodrich Co. v. A.T.I. Caribe, Inc., 366 F. Supp. 464, 467 n.2 (D. Del. 1973); Dell Publ'g Co. v. Stanley Publ'n, Inc., 172 N.E.2d 656, 661 (1961).

[30] In re Mariott Corp., 517 F.2d 1364, 1369 (C.C.P.A. 1975) ("That a state court has refused, correctly or incorrectly, to enjoin use of a mark by a subsequent user within that state, because it considered the mark unavailable for exclusive use, or for other reasons, cannot of itself bar federal registration of the mark to the first user in interstate commerce."); Ultronic Sys. Corp. v. Ultronix, Inc., 217 F. Supp. 89, 91, (D. Del. 1963).

[31] 28 U.S.C. § 1338(b) (2000).

[32] For example, ISC-Bunker Ramo Corp. v. Altech, Inc., 765 F. Supp. 1310, 1328-29 (N.D. III. 1990); Rohm and Haas Co. v. Adco Chem. Co., 689 F.2d 424, 429 n.4 (3d Cir. 1982); A. H. Emery Co., v. Marcan Prods. Corp., 389 F.2d 11, 20 n.9 (2d Cir. 1968).

[33] For example, Sims v. W. Steel Co., 551 F.2d 811, 819 (10th Cir. 1977); Schreyer v. Casco Prods. Corp., 190 F.2d 921, 924 (2d Cir. 1951).

[34] For example, ISC-Bunker Ramo Corp., 765 F. Supp. at 1328-29.

[35] A.H. Emery Co., 389 F.2d at 20 n.10.

[36] Id.

[37] See 28 U.S.C. § 1332 (2000).

[38] 28 U.S.C. §§ 1441 (2000 & Supp. 2002), 1446(b) (2000).

[39] Univ. of Tex. v. Camenisch, 451 U.S. 390, 395 (1981); Alliance Bond Fund, Inc. v. Grupo Mexicano de Desarrollo, S.A., 143 F.3d 688, 692 (2d Cir. 1998), rev'd on other grounds, 527 U.S. 308 (1999).

[40] State v. S.W. Bell Tel. Co., 526 S.W.2d 526, 528 (Tex. 1975); Universal Health Servs., Inc. v. Thompson, 24 S.W.3d 570, 577 (Tex. App.-Austin 2000, no pet.).

[41] U.S. v. Microsoft Corp., 147 F.3d 935, 943 (D.C. Cir. 1998); DSC Comm. Corp. v. DGI Techs., Inc., 81 F.3d 597, 600 (5th Cir. 1996); Tenet Health Ltd. v. Zamora, 13 S.W.3d 464, 468 (Tex. App.-Corpus Christi 2000, pet. dism'd).

[42] Sampson v. Murray, 415 U.S. 61, 88 (1974); DSC Comm., 81 F.3d at 600; Universal Health, 24 S.W.3d at 577.

[43] DSC Comm., 81 F.3d at 600; Plains Cotton Coop. Ass'n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1259 (5th Cir. 1987).

[44] McGlothlin v. Kliebert, 672 S.W.2d 231, 232 (Tex. 1984); see Fasken v. Darby, 901 S.W.2d 591, 592 (Tex. App.-El Paso 1995, no pet.). For a legal remedy to be adequate, it must give the plaintiff complete and final relief. See Universal Health, 24 S.W.3d at 577; Henderson v. KRTS, Inc., 822 S.W.2d 769, 773 (Tex. App.-Houston [1st Dist.] 1992, no writ). If the defendant is unable to pay damages or damages cannot be calculated, injunctive relief may be appropriate. Tex. Indus. Gas v. Phoenix Metallurgical Corp., 828 S.W.2d 529, 533 (Tex. App.-Houston [1st Dist.] 1992, no writ); Universal Health, 24 S.W.3d at 577; Surko Enters., Inc. v. Borg-Warner Acceptance Corp., 782 S.W.2d 223, 225 (Tex. App.-Houston [1st Dist.] 1989, no writ).

[45] Tex. Civ. Prac. & Rem. Code Ann. § 65.011 (Vernon 1997). The statute permits injunctions in the following circumstances:
(1) when the plaintiff is entitled to the relief demanded, and all or part of the relief requires the restraint of some act prejudicial to the plaintiff; (2) when a party performs or is about to perform an act relating to the subject of pending litigation, in violation of the rights of the plaintiff, and that act would tend to render the judgment in that litigation ineffectual; (3) when the applicant is entitled to an injunction under the principles of equity and the laws of the Texas relating to injunctions; (4) when a cloud would be placed on the title of real property being sold under an execution against a party having no interest in the real property; or (5) when irreparable injury to real or personal property is threatened irrespective of any remedy at law. Id.

[46] See Atkinson v. Arnold, 893 S.W.2d 294, 297 (Tex. App.-Texarkana 1995, no writ) ("[A] writ of injunction is not granted upon the

averments of the petition alone, but upon sworn and competent evidence admitted upon a full hearing.") (citing Magnolia Petroleum Co. v. State, 218 S.W.2d 855, 857 (Tex. Civ. App.-Austin 1949, writ ref'd n.r.e.).

47 For example, Kaepa, Inc. v. Achilles Corp., 76 F.3d 624, 628 (5th Cir. 1996)("If no factual dispute is involved [in the temporary injunction application], . . . no oral hearing is required; under such circumstances the parties need only be given 'ample opportunity to present their respective view of the legal issues involved."') (citing Commerce Park at DFW Freeport v. Mardian Constr. Co., 729 F.2d 334, 341 (5th Cir. 1984)).

48 Tex. R. Civ. P. 684; see also Goodwin v. Goodwin, 456 S.W.2d 885, 885-86 (Tex. 1970); Lancaster v. Lancaster, 291 S.W.2d 303, 308 (Tex. 1956); Williams v. Bagley, 875 S.W.2d 808, 810 (Tex. App.-Beaumont 1994, no writ).

49 For example, Kaepa, 76 F.3d at 628; Corrigan Dispatch Co. v. Casa Guzman, S.A., 569 F.2d 300, 302-03 (5th Cir. 1978).

50 Granny Goose Foods, Inc. v. Brotherhood of Teamsters, 415 U.S. 423, 439 (1974); Cannan v. Green Oaks Apts., Ltd., 758 S.W.2d 753, 755 (Tex. 1988).

51 U.S. Const. art. IV, § 1.

52 28 U.S.C. § 1738 (2000).

53 Migra v. Warren City Sch. Dist. Bd. Of Educ., 465 U.S. 75, 81 (1984); see also Kremer v. Chem. Const. Corp., 456 U.S. 461, 466 (1982).

54 Mayhew v. Caprito, 794 S.W.2d 1, 2 (Tex. 1990); Villanueva v. Office of the Att'y Gen., 935 S.W.2d 953, 956 (Tex. App.-San Antonio 1996, writ denied); Maxfield v. Terry, 885 S.W.2d 216, 218 (Tex. App.-Dallas 1994, writ denied) (citing Durfee v. Duke, 375 U.S. 106, 110 (1963)) ("The United States Supreme Court interprets this provision [U.S. Const. art. IV, § 1] to mean that a state must give another state's judgment at least the res judicata effect it would receive in the state rendering the judgment.").

55 Ellis v. Amex Life Ins. Co., 211 F.3d 935, 937-38 (5th Cir. 2000); see also U.S. ex rel. Barajas v. Northrop Corp., 147 F.3d 905, 909 (9th Cir. 1998) ("The date of rendition of the judgment is controlling for purposes of res judicata . . ."); Unger v. Consol. Foods Corp., 693 F.2d 703, 705 (7th Cir. 1982) ("As between two actions pending at the same time, the first of two judgments has preclusive effect on the second.").

56 In re Hansler, 988 F.2d 35, 38 (5th Cir. 1993); Mower v. Boyer, 811 S.W.2d 560, 563 n.2 (Tex. 1991).

57 Restatement (Second) of Judgments § 14 cmt. a (1998).

58 28 U.S.C. § 1404(a) (2000).

59 In re Transaction Sys. Architects, Inc., 232 F.3d 905 (unpublished table decision), available at No. 609, 2000 U.S. App. LEXIS 5103, at *2-3 (Fed. Cir. 2000). Note that when a district court has jurisdiction over all parties involved, it may enjoin later filed actions. Decker Coal Co. v. Commonwealth Edison Co., 805 F.2d 834, 843 (9th Cir. 1986); U.S. v. Oregon, 657 F.2d 1009, 1016 n.17 (9th Cir. 1981).

60 28 U.S.C. § 1391(a)(1) & (b)(1) (2000); Deutsch v. U.S. Dept. of Justice, 881 F. Supp. 49, 53 (D.D.C. 1995).

61 28 U.S.C. § 1391(a)(2) & (b)(2) (2000); Friedman v. Revenue Mgmt. of N.Y., Inc., 38 F.3d 668, 671 (2d Cir. 1994).

[62] 28 U.S.C. § 1391(a)(3) (2000); Richards v. Aramark Servs., Inc., 108 F.3d 925, 928 (8th Cir. 1997). The referenced third prong of the test is for cases founded solely on diversity of citizenship. 28 U.S.C. § 1391(a)(3). For other cases, the third prong permits venue in "a judicial district in which any defendant may be found, if there is no district in which the action may otherwise be brought." Id.

[63] Shaw v. Quincy Mining Co., 145 U.S. 444, 449 (1892); Manley v. Engram, 755 F.2d 1463, 1466 n.3 (11th Cir. 1985); see also Ellingburg v. Connett, 457 F.2d 240, 241 (5th Cir. 1972).

[64] See Hill v. Gregory, 241 F.2d 612, 613-14 (7th Cir. 1957).

[65] 28 U.S.C. § 1391(c) (2000); see Peay v. Bellsouth Med. Assistance Plan, 205 F.3d 1206, 1210 n.3 (10th Cir. 2000); 15 Charles A. Wright et al., Federal Practice and Procedure § 3811 (2d ed. 1986).

[66] 28 U.S.C. § 1391(c) (2000); Union Planters Bank, N.A. v. EMC Mortgage Corp., 67 F. Supp. 2d 915, 918 (W.D. Tenn. 1999).

[67] Union Planters Bank, 67 F. Supp. 2d at 918.

[68] Tex. Civ. Prac. & Rem. Code Ann. §§ 15.001(b), 15.002(a) (Vernon 2002).

[69] Id. § 15.017.

[70] Id. § 65.023(a) (Vernon 1997); In re Continental Airlines, Inc., 988 S.W.2d 733, 736 (Tex. 1998); Billings v. Concordia Heritage Ass'n., Inc., 960 S.W.2d 688, 693 (Tex. App.-El Paso 1997, writ denied).

[71] Tex. Civ. Prac. & Rem. Code Ann. § 15.020 (Vernon 2002). "Major transaction" includes deals exceeding one million dollars in value but excluding personal, family, or household purposes and also excluding personal injury and wrongful death settlements. Id. at § 15.020(a).

[72] Id. § 15.001(b).

[73] Id. § 15.033.

[74] Id. § 15.035(a); see Midland Nat'l Life Ins. Co. v. Bridges, 889 S.W.2d 17, 19 (Tex. App.-Eastland 1994, writ denied); Trafalgar House Oil & Gas, Inc. v. De Hinojosa, 773 S.W.2d 797, 798 (Tex. App.-San Antonio 1989, no writ).

[75] Tex. Civ. Prac. & Rem. Code Ann. § 15.002(a).

[76] Id. § 15.001(a).

[77] Id. § 15.003(a) (Vernon 2002 & Supp. 2004).

[78] Id.

[79] Id. § 15.005 (Vernon 2002).

[80] Id. § 15.004.

[81] Sheppard v. Jacksonville Mar. Sup., Inc., 877 F. Supp. 260, 269 (D.S.C. 1995); Davis v. Advantage Int'l, Inc., 818 F. Supp. 1285, 1286 (E.D. Mo. 1993); Michael C. Smith et al., O'Connor's Federal Rules: Civil Trials 97 (2002 ed.).

[82] Beattie v. U.S., 756 F.2d 91, 100-01 (D.C. Cir. 1984); Phila. Musical Soc'y, Local 77 v. Am. Fed'n of Musicians, 812 F. Supp. 509, 517 n.3 (E.D. Pa. 1992).

[83] Fed. R. Civ. P. 26(c)(7); for example, Sega Entm't Ltd. v. Accolade, Inc., 977 F.2d 1510, 1532 (9th Cir. 1993); Centurion Indus., Inc. v. Warren Steurer & Assocs., 665 F.2d 323, 325 (10th Cir. 1981).

[84] Heat & Control, Inc. v. Hester Indus., Inc., 785 F.2d 1017, 1025 (Fed. Cir. 1986).

[85] Id. (quoting Centurion, 665 F.2d at 325-26).

[86] Id.; see Katz v. Batavia Marine & Sporting Supplies, Inc., 984 F.2d 422, 424-25 (Fed. Cir. 1993); Centurion, 665 F.2d at 325.

[87] Tex. R. Evid. 507.

[88] In re Cont'l Gen. Tire, Inc., 979 S.W.2d 609, 613 (Tex. 1998).

[89] In re Cont'l Tire N. Am., Inc., 74 S.W.3d 884, 886 (Tex. App.-Eastland 2002, orig. proceeding).

[90] Id.

[91] Gen. Tire, Inc. v. Kepple, 970 S.W.2d 520, 523 (Tex. 1998). See generally Michol O'Connor et al., O'Connor's Texas Rules: Civil Trials 269-72 (2001 ed.). In order to seal public records, there must be a showing of a specific, serious, and substantial interest which clearly outweighs the presumption of openness and any probable adverse effect that sealing will have upon the general public health or safety; and no less restrictive means than sealing records will adequately and effectively protect the specific interest asserted. Tex. R. Civ. P. 76a(1); Kepple, 970 S.W.2d at 523. The party seeking the sealing order must post public notice and the court must hold a public hearing. Tex. R. Civ. P. 76(a)(3).

[92] Tex. R. Civ. P. 76a(2)(c); Eli Lilly & Co. v. Marshall, 829 S.W.2d 157 (Tex. 1992).

[93] Tex. R. Civ. P. 76a(2)(c); Kepple, 970 S.W.2d at 523; Upjohn Co. v. Freeman, 906 S.W.2d 92, 95 (Tex. App.-Dallas 1995, no writ).

[94] Marshall, 829 S.W.2d at 158; Chandler v. Hyundai Motor Co., 829 S.W.2d 774, 774-75 (Tex. 1992).

[95] For example, Metro. Life Ins. v. Robertson-Ceco Corp., 84 F.3d 560, 567 (2d Cir. 1996). Personal jurisdiction must be established for the judicial district in which a corporate defendant is sued. 28 U.S.C. § 1391(c); Milwaukee Concrete Studios, Ltd. v. Fjeld Mfg. Co., 8 F.3d 441, 445-46 (7th Cir. 1993).

[96] See CSR Ltd. v. Link, 925 S.W.2d 591, 596 (Tex. 1996); Siskind v. Villa Found. for Educ., Inc., 642 S.W.2d 434, 438 (Tex. 1982).

[97] Fed. R. Civ. P. 30(a)(2)(A), 30(d)(2), & 33(a).

[98] Tex. R. Civ. P. 190.1.

[99] Id. 190.2(a).

[100] Id. 190.2(c)(1).

[101] Id. 190.2(c)(2).

[102] Id. 190.2(c)(3).

[103] Id. 190.3(b)(2) & (3).

[104] Tex. R. Civ. P. 190.3(b)(1).

[105] Id. 190.4(b). ("The plan must include: (1) a date for trial or for a conference to determine a trial setting; (2) a discovery period during which either all discovery must be conducted or all discovery requests must be sent, for the entire case or an appropriate phase of it; (3) appropriate limits on the amount of discovery; and (4) deadlines for joining additional parties, amending or supplementing pleadings, and designating expert witnesses.").

[106] Id. 26(f).

[107] Id.

[108] Fed. R. Civ. P. 26(a)(1). Note that certain cases are exempted from these requirements. Id. at (a)(1)(E).

[109] Id.

[110] Tex. R. Civ. P. 194.2.

[111] Tex. R. Civ. P. 194.5. Responses to requests for disclosure that were later amended are inadmissible and cannot be used for impeachment. Tex. R. Civ. P. 194.6.

[112] Fed. R. Civ. P. 26(a)(3).

[113] Id.

[114] Id. The only objections which survive are relevance (Fed. R. Evid. 402) and unfair prejudice (Fed. R. Evid. 403).

[115] See Tex. R. Civ. P. 166. The court can order, inter alia, exchange of witness lists, expert witness designations, proposed facts and law, proposed jury questions, exhibits, and objections.

[116] Id. 192.3(d). Witnesses whose sole purpose is impeachment or rebuttal are excluded.

[117] Id. 193.7.

[118] Fed. R. Civ. P. 26(a)(2). Generally a party cannot discover the facts known by a consulting expert unless it is impractical to obtain facts or opinions on the same subject by other means. See Fed. R. Civ. P. 26(b)(4)(B); Braun v. Lorillard, Inc., 84 F.3d 230, 236 (7th Cir. 1996).

[119] Fed. R. Civ. P. 26(a)(2)(B).

[120] Id. 26(b)(4)(C); Louisiana Power & Light Co. v. Kellstrom, 50 F.3d 319, 332-33 (5th Cir. 1995).

[121] Tex. R. Civ. P. 194.2 (f); id.195.2. The 90 day rule applies to parties seeking affirmative relief; experts for other parties need disclose to this information 60 days before the end of discovery.

[122] Id. 195.5.

[123] Id. 195.7.

[124] Fed. R. Civ. P. 45(a)(3); Amgen, Inc. v. Kidney Ctr., Ltd., 95 F.3d 562, 564 (7th Cir. 1996); Mann v. Univ. of Cincinnati, 824 F. Supp. 1190, 1201 (S.D. Ohio 1993).

[125] Fed. R. Civ. P. 45(c); Houston Bus. Journal, Inc. v. Office of Comptroller, 86 F.3d 1208, 1212 (D.C. Cir. 1996).

[126] Tex. R. Civ. P. 201.1(a).

[127] Tex. R. Civ. P. 201.1(c).

[128] Fed. R. Civ. P. 26(e)(1); Tex. R. Civ. P. 193.5. Supplementation is not required in federal court if the information was otherwise "made known to the other parties during the discovery process or in writing," nor in state court if in writing, on the record at a deposition, or through other discovery responses. Fed. R. Civ. P. 26(e)(1); Tex. R. Civ. P. 193.5(a).

[129] Fed. R. Civ. P. 26(e)(1); Tex. R. Civ. P. 195.6.

[130] Compare Tex. R. Civ. P. 193.5(a) with Fed. R. Civ. P. 26(e)(1).

[131] Tex. R. Civ. P. 193.5(b). An exception is made for named parties, who are presumed to have knowledge of relevant facts. Id. 193.6(a).

[132] Id. 193.2(f).

[133] Id. 193.3(a).

[134] Id.

[135] Id. 193.3(b)

[136] Id.

[137] Tex. R. Civ. P. 193.3(c).

[138] Id. 193.3(d).

[139] Id.

[140] Fed. R. Civ. P. 26(b)(5). In federal question cases, federal common law describes the bounds of privilege. Virmani v. Novant Health Inc., 259 F.3d 284, 286 n.3 (4th Cir. 2001); Pearson v. Miller, 211 F.3d 57, 66 (3d Cir. 2000). In diversity cases, the court will use the privilege law of the state in which it sits. Fed. R. Evid. 501; In re Avantel, S.A., 343 F.3d 311, 323 (5th Cir. 2003).

[141] Allgood v. R.J. Reynolds Tobacco Co., 80 F.3d 168, 172 (5th Cir. 1996).

[142] 28 U.S.C. § 636(b) (2000).

[143] For example, Commodity Futures Trading Comm'n v. Noble Metals Int'l, Inc., 67 F.3d 766, 770 (9th Cir. 1995).

[144] Gomez v. Martin Marietta Corp., 50 F.3d 1511, 1519-20 (10th Cir. 1995).

[145] 28 U.S.C. § 636(b)(1)(A); Fed. R. Civ. P. 72(a); Castillo v. Frank, 70 F.3d 382, 385-86 (5th Cir. 1995).

[146] 28 U.S.C. § 636(b)(1)(A).

[147] Id. § 636(b)(1)(B).

[148] Id.

[149] Stripling v. Jordan Prod. Co., 234 F.3d 863, 868 (5th Cir. 2000).

[150] 28 U.S.C. § 636(b)(1)(C); Fed. R. Civ. P. 72(b) advisory committee's note.

[151] 28 U.S.C. § 636(c)(1) (2000); Fed. R. Civ. P. 73(a); Reiter v. Honeywell, Inc., 104 F.3d 1071, 1073 (8th Cir. 1997).

[152] Tex. Gov't Code Ann. § 54.506 (Vernon 1998 & Supp. 2004).

[153] Id. at § 54.508.

[154] Id. at § 54.510(b).

[155] Id. at § 54.510(e).

[156] Id. at § 74.054 (Vernon 1998 & Supp. 2004); id. at § 74.056 (Vernon 1998).

[157] Id. at § 74.059 (Vernon 1998).

[158] Tex. Gov't Code Ann. § 74.053(c) (Vernon 1998 & Supp. 2004).

[159] Id. at § 74.053(b) (Vernon 1998); id at § 74.053(d) (Vernon 1998 & Supp. 2004).

[160] Id. at § 74.053(b).

[161] Babcock v. N.W. Mem. Hosp., 767 S.W.2d 705, 709 (Tex. 1989); Tex. Employers Ins. Assoc. v. Loesch, 538 S.W.2d 435, 440 (Tex. App.-Waco 1976, writ ref'd n.r.e.).

[162] Babcock, 767 S.W.2d at 709.

[163] For example, Babcock, 767 S.W.2d at 708-09.

[164] Tex. R. Civ. P. 233; Perkins v. Freeman, 518 S.W.2d 532, 533 (Tex. 1974).

[165] For example, S. D. Tex. Loc. R. app. B, P 14 (A)(1).

[166] Cimino v. Raymark Indus., Inc., 151 F.3d 297, 323 (5th Cir. 1998).

[167] Fed. R. Civ. P. 47(a); Hicks v. Mickelson, 835 F.2d 721, 725 (8th Cir. 1987); see U.S. v. Sherwood, 98 F.3d 402, 407 (9th Cir. 1996).

[168] Hicks, 835 F.2d at 725.

[169] 28 U.S.C. § 1870 (2000); Fed. R. Civ. P. 47(b).

[170] Tex. R. Civ. P. 203.6(b); Tex. R. Evid. 801(e)(3).

[171] Tex. R. Civ. P. 203.6(b).

[172] Id.

[173] Fed. R. Civ. P. 32(a)(1); Davis v. Freels, 583 F.2d 337, 342 (7th Cir. 1978).

[174] Fed. R. Civ. P. 32(a)(2).

[175] Id. 32(a)(3). Recognized grounds include: (1) that the witness is dead; (2) that the witness is more than 100 miles from the place of trial (unless the absence was procured by the party offering the deposition); (3) that the witness cannot attend due to age, illness, infirmity or incarceration; (4) that the party offering the deposition has been unable to subpoena the witness; or (5) under other exceptional circumstances.

[176] Fed. R. Evid. 611(b).

[177] Tex. R. Evid. 611(b); CPS Int'l, Inc. v. Harris & Westmoreland, 784 S.W.2d 538, 543 (Tex. App.-Texarkana 1990, no writ).

[178] See discussion supra, section II.J.

[179] Compare Kumho Tire Co., Ltd. v. Carmichael, 526 U.S. 137 (1999) and Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579 (1993) with Gammill v. Jack Williams Chevrolet, Inc., 972 S.W.2d 713 (Tex. 1998) and E.I. du Pont de Nemours & Co. v. Robinson, 923 S.W.2d 549 (Tex. 1995).

[180] Fed. R. Evid. 703.

[181] Tex. R. Evid. 705(a) & (d). If disclosed to a jury, a limiting instruction shall be given by the court upon request. Id. 705(d).

[182] Texas Const. art. V § 13; Tex. Gov't Code Ann. § 62.201(Vernon 1998); Tex. R. Civ. P. 292.

[183] Fed. R. Civ. P. 48.

[184] Id. 38(b); Irvin v. Airco Carbide, 837 F.2d 724, 727 (6th Cir. 1987).

[185] McAfee v. Martin, 63 F.3d 436, 437 (5th Cir. 1995).

[186] McCarthy v. Bronson, 906 F.2d 835, 840 (2d Cir. 1990), aff'd, 500 U.S. 136 (1991).

[187] Fed. R. Civ. P. 81(c).

[188] Tex. R. Civ. P. 216; Bell Helicopter Textron, Inc. v. Abbott, 863 S.W.2d 139, 140 (Tex. App.-Texarkana 1993, writ denied).

[189] Tex. Gov't Code Ann. § 62.001 (Vernon 1998 & Supp. 2004), id. § 62.004 (Vernon 1998).

[190] 28 U.S.C. § 1863(b)(3) (2000).

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