

## **Legal Malpractice Claims Against Prosecuting Attorneys Belong in State Court: *NeuroRepair, Inc. v. Nath Law Group***

Article By:

Vanessa LeFort

---

Addressing whether the federal district court had jurisdiction over state legal malpractice claims relating in part to the prosecution of patent applications, the U.S. Court of Appeals for the Federal Circuit held that the district court did not, and remanded the case to state court. *NeuroRepair, Inc. v. Nath Law Group*, Case No. 13-1073 (Fed. Cir., Jan. 15, 2015) (Wallach, J.).

In 2009, NeuroRepair filed its state legal malpractice suit in San Diego Superior Court against its patent law firm and an individual attorney in the firm. According to NeuroRepair, it was harmed by the defendants, including by being hindered in timely obtaining patents of the same scope it would otherwise have obtained.

The defendants removed the case to federal district court relying on 28 U.S.C. § 1338(a), which gives federal courts original jurisdiction over “any civil action arising under any Act of Congress relating to patents.” After the district court entered judgment in favor of the defendants, NeuroRepair appealed, challenging the district court’s jurisdiction.

Under *Gunn v. Minton*, a U.S. Supreme Court ruling that issued just months after the district court’s entry of judgment, a state cause of action may “arise under” federal patent law if it “involves a patent law issue that is (1) necessarily raised, (2) actually disputed, (3) substantial, and (4) capable of resolution in federal court without disrupting the federal-state balance approved by Congress.” The *Gunn* court explained that “state legal malpractice claims based on underlying patent matters will rarely, if ever, arise under federal patent law for purposes of § 1338(a).”

Applying *Gunn*, the Federal Circuit concluded that the district court lacked jurisdiction over NeuroRepair’s claims. It found that none of the *Gunn* factors were met, except for the “actually disputed” factor, which was met because NeuroRepair’s ability to obtain patents in a timely manner and of the same scope absent the alleged misconduct was disputed.

Turning to the other factors, the Federal Circuit explained that patent law issues were not “necessarily raised” because the complaint set forth multiple bases under which a court could provide relief without ever reaching any patent issue.

The Federal Circuit also found that the patent issues were not “substantial.” To be “substantial,” the

patent issue must be important “to the federal system as a whole,” not just to the parties. As the Court explained, non-exclusive factors that inform the “substantial” inquiry include whether “a pure issue of federal law is dispositive of the case,” and whether “the court’s resolution of the issue will control numerous other cases.” Here, the Federal Circuit concluded there was no dispositive “pure issue of federal law” because the relevant inquiry would likely focus on factual issues, as opposed to “the interpretation of federal law,” and because federal law was involved in only one of several elements needed to prevail and was “perhaps not even the most significant part of the state law cause of action.”

The Federal Circuit also observed that the state court’s resolution of any patent issue was unlikely to “control numerous other cases,” because patent law would apply only to the “hypothetical” issue of determining the validity of initial patent claims that never actually issued, as opposed to “affect[ing] the scope of any live patent” or “requir[ing] resolution of a novel issue of patent law.”

On the last Gunn factor, the Federal Circuit found that to the extent any federal interest was implicated, it did “not outweigh the especially great interests of the state in regulating that state’s lawyers.”

© 2025 McDermott Will & Emery

---

National Law Review, Volume V, Number 56

Source URL: <https://natlawreview.com/article/legal-malpractice-claims-against-prosecuting-attorneys-belong-state-court>