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Citing Gunn, Texas Court Revives Patent Malpractice Suit

By Jeremy Heallen

Law360, Houston (July 17, 2013, 4:25 PM ET) -- A Texas appeals court revived a patent malpractice suit against a Houston law firm Tuesday, ruling that the case should not have been dismissed by a state trial court in light of the U.S. Supreme Court's decision in *Gunn v. Minton*.

The First District Court of Appeals said that Scott Wonders' suit against Matthews Lawson & Johnson PLLC could proceed, because the high court's February holding in *Gunn* allows state courts to hear malpractice suits involving patents if the case does not raise issues "significant to the federal system as a whole."

As "explained in *Gunn*, the mere fact that a state court may be required to apply federal law in this backward-looking context is not enough to trigger exclusive federal jurisdiction," the appeals court's opinion said. "Something more, demonstrating that the question is significant to the federal system as a whole, and not just the parties, is required."

Representatives for Matthews Lawson & Johnson PLLC, now known as Matthews Lawson PLLC, did not immediately respond to a request for comment Wednesday.

In his 2011 lawsuit, Wonders claims firm attorney William E. Johnson waited more than a year-and-a-half to file a patent application he requested, allowing a subsidiary of Tyco International Ltd. to swoop in and secure its own patent on a similar invention.

Wonders, who worked as a firefighter with the city of Port Arthur, says he created a more efficient compressed air recharge device used for refilling air tanks used by firefighters and scuba divers, and went to Johnson in September 2004 for help patenting his invention.

The next month, Wonders showed off the device, which he called CAMSystem, at the International Association of Fire Chiefs Conference, according to the opinion. Representatives of Scott Technologies Inc., which had been acquired by Tyco three years earlier, were in attendance and had expressed interest in Wonders' CAMSystem, the opinion said.

Wonders said that several months later, he received a draft of his patent application from Johnson in response to repeated inquiries about its status.

But Johnson delayed completing the application and in August 2005, Scott Technologies applied to the U.S. Patent and Trademark Office for a patent on a compressed air system nearly identical to CAMSystem, according to Wonders.

By the time Johnson finally submitted Wonders' application to the USPTO in May 2006, it was allegedly too late for him to challenge Scott Technologies' patent, prompting his malpractice suit against the firm.

A trial court dismissed Wonders' suit, citing the Texas Supreme Court's then-binding decision in *Minton v. Gunn*, which held that Texas state courts lacked jurisdiction over a legal malpractice

lawsuit arising out of the handling of a patent case, because such claims implicated federal law and therefore must be filed in federal court.

While Wonders appealed the dismissal, the U.S. Supreme Court overturned the Texas high court, ruling that a state malpractice claim does not generally “arise under” federal patent law, implicating exclusive federal court jurisdiction.

On Tuesday, the First District Court of Appeals said the same result applied to Wonders’ case.

“Based on the Supreme Court’s decision in Gunn, we conclude that Wonders’ legal malpractice action does not raise a substantial federal question so as to implicate the federal court’s exclusive ‘arising under’ jurisdiction,” the opinion said.

Wonders is represented by Lance Christopher Kassab and David Eric Kassab of the Kassab Law Firm.

Johnson is represented by John G. Gilpin of Thompson Coe Cousins & Irons LLP.

The case is Wonders v. Johnson, et al., case number 01-12-00438-CV, in the First District Court of Appeals for the State of Texas.

--Additional reporting by Jess Davis. Editing by Jeremy Barker.

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