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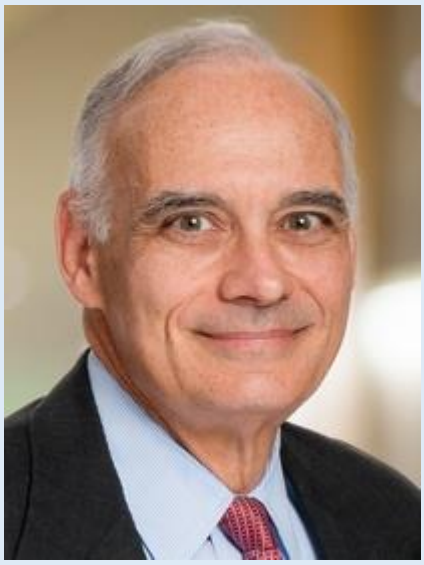
MVP: Hughes Hubbard's James Dabney

Law360, New York (December 14, 2017, 3:21 PM EST) -- Hughes Hubbard & Reed LLP's James Dabney persuaded the U.S. Supreme Court to put limits on where patent lawsuits can be filed, a decision that upended almost 30 years of established practice and has changed the patent litigation map, earning him a spot among Law360's 2017 Intellectual Property MVPs.



James Dabney
Hughes Hubbard

HIS BIGGEST ACCOMPLISHMENT THIS YEAR:

Dabney was lead counsel for TC Heartland LLC, a liquid sweetener maker that challenged the Federal Circuit's broad interpretation of the patent venue statute after it was sued by Kraft Foods Group Brands LLC.

In a unanimous May decision, the justices rejected a rule that effectively allowed patent lawsuits to be filed anywhere a defendant does business. The court said lawsuits must be filed where the defendant is incorporated or has a regular and established place of business.

"Any Supreme Court case is going to tend to be important, but this is one where it affects almost every patent case," Dabney said.

The decision has led to a drop in cases being filed in the Eastern District of Texas, a venue with a reputation for being friendly to plaintiffs, and there has been a noticeable uptick in cases filed in Delaware and California. It has also forced courts to grapple with other issues, including what constitutes a regular and established place of business.

HIS BIGGEST CHALLENGE THIS YEAR:

The Supreme Court victory aside, Dabney said his biggest challenge came in a case in Delaware federal court while defending Costco Wholesale Corp. against allegations it sold windshield wiper products that infringed various patents.

The patents had originally been issued to Robert Bosch GmbH, but, prior to litigation, they were assigned to a subsidiary and the plaintiff in the lawsuit, Robert Bosch LLC. Dabney persuaded the court to award his client attorney's fees after the plaintiff failed to timely produce certain documents held by its German parent.

Under the ruling, foreign patent owners cannot evade discovery obligations by assigning patents to, and then suing in the name of, their subsidiaries.

"This is a pattern that I'm seeing more and more," Dabney said. "So I hope that I have blazed a trail for other litigants faced with this kind of discovery abuse to make a little more robust arguments as to why they're entitled to get these kinds of discovery materials."

WHAT MOTIVATES HIM:

Dabney said that, in the last two decades in particular, he has come to believe there is an instability in patent law that grows out of conflict between Supreme Court and lower court precedent.

"It was that perception on my part that led me to teach a course on the subject at Cornell University Law School and make a career out of adding to the usual tools of the trade and the knowledge of this body of Supreme Court patent precedent that, for too long, was not really paid much attention to," he said.

TC Heartland marked the third time that Dabney, who teaches a course called "Conflicts in Patent Law and Practice" at Cornell, has won Supreme Court reversal of a Federal Circuit decision on the issue of patent law or procedure.

In a 2002 decision in Holmes Group v. Vornado, the justices overturned case law concerning the Federal Circuit's appellate jurisdiction. And in 2007, in KSR v. Teleflex, the high court decided the Federal Circuit was applying too rigid a standard for determining whether a patent is obvious.

HIS ADVICE FOR YOUNGER ATTORNEYS:

Dabney said his first years in practice were valuable learning experiences, having had an opportunity to work with people who were eager to be teachers. Younger attorneys, he said, should learn from someone whose work they admire.

"Rather than giving the name of a book to read or some work habit, that's the best thing I can suggest to someone," he said.

— As told to Matthew Bultman

Law360's MVPs are attorneys who have distinguished themselves from their peers over the past year through high-stakes litigation, record-breaking deals and complex global matters. A team of Law360 editors selected the 2017 MVP winners after reviewing more than 1,000 submissions.