The reading materials for the first class follow. Please note that you only need to read pages R19-R51. You can skim the rest of the pages. We will provide the rest of the course materials during the first class. We are looking forward to meeting everyone on the 22nd.
INTRODUCTION/BACKGROUND
Court Jurisdiction

The United States Court of Appeals for the Federal Circuit was established under Article III of the Constitution on October 1, 1982. The court was formed by the merger of the United States Court of Customs and Patent Appeals and the appellate division of the United States Court of Claims. The court is located in the Howard T. Markey National Courts Building on historic Lafayette Square in Washington, D.C.

The Federal Circuit is unique among the thirteen Circuit Courts of Appeals. It has nationwide jurisdiction in a variety of subject areas, including international trade, government contracts, patents, trademarks, certain money claims against the United States government, federal personnel, veterans' benefits, and public safety officers' benefits claims. Appeals to the court come from all federal district courts, the United States Court of Federal Claims, the United States Court of International Trade, and the United States Court of Appeals for Veterans Claims. The court also takes appeals of certain administrative agencies' decisions, including the United States Merit Systems Protection Board, the Boards of Contract Appeals, the Board of Patent Appeals and Interferences, and the Trademark Trial and Appeals Board. Decisions of the United States International Trade Commission, the Office of Compliance, an independent agency in the legislative branch, and the Government Accountability Office Personnel Appeals Board, and the Department of Justice Bureau of Justice Assistance also are reviewed by the court. The court's jurisdiction consists of administrative law cases (55%), intellectual property cases (31%), and cases involving money damages against the United States government (11%). The administrative law cases consist of personnel and veterans claims. Nearly all of the intellectual property cases involve patents. Suits for money damages against the United States government include government contract cases, tax refund appeals, unlawful takings, and civilian and military pay cases.

The judges of the court are appointed by the President, with the advice and consent of the Senate. Judges are appointed to the court for life under Article III of the Constitution of the United States. There are twelve judges in active service. When eligible, judges may elect to take senior status, which allows them to continue to serve on the court while handling fewer cases than a judge in active service. Each judge in active service employs a judicial assistant and up to four law clerks, while each judge in senior status employs a judicial assistant and one law clerk.

Title 28 of the United States Code, the Federal Rules of Appellate Procedure and the court's Rules of Practice and Internal Operating Procedures govern procedure in the Federal Circuit. Appeals are heard by panels comprised of three judges who are selected randomly for assignment to the panels. Losing parties may seek review of a decision of the Federal Circuit in the Supreme Court of the United States.

Court sessions generally are held during the first week of each month in Washington, D.C. The court also is authorized to hear cases in other cities throughout the United States to meet the needs of litigants in other parts of the country. The court has sat in many other cities during its existence.

The court's work begins when an appeal is docketed by the Clerk of the Court, and is assigned a docket number. The parties to the cases then prepare and file written briefs setting forth their arguments. Parties also may submit materials such as transcripts of testimony and other relevant parts of the record made in the lower tribunal from which the appeal originated. Once all the briefs have been received, the case may be scheduled for oral argument before the court. Each side usually is allotted between 15 and 30 minutes for argument, depending on the nature of the case. During oral argument, the lawyers for the parties present their arguments and answer questions of the judges concerning the issues presented. If the court determines that oral argument is unnecessary, the case is decided by a panel of judges based on the arguments presented in the briefs. In each appeal, the presiding judge of the panel assigns a member of the panel to prepare the court's opinion. The opinion sets out the decision of the court and the reasons for the decision. If the panel determines that its decision will add significantly to a body of law, it issues a precedential opinion. Decisions that do not add significantly to the body of law are issued as nonprecedential. All opinions are made available to the public, and may be obtained from the court's home page on the Internet, the Federal Reporter 3rd Series, Westlaw® and Lexis®.
The senior staff of the court consists of the Circuit Executive and Clerk of Court, the General Counsel, Senior Staff Attorney, Circuit Librarian, Administrative Services Officer, Director of Information Technology, and Chief Circuit Mediator.
RANDALL R. RADER, CHIEF JUDGE

RANDALL R. RADER was appointed to the United States Court of Appeals for the Federal Circuit by President George H. W. Bush in 1990 and assumed the duties of Chief Judge on June 1, 2010. He was appointed to the United States Claims Court (now the U. S. Court of Federal Claims) by President Ronald W. Reagan in 1988. Chief Judge Rader's most prized title may well be "Professors Rader."

As Professor, Chief Judge Rader has taught courses on patent law and other advanced intellectual property courses at The George Washington University Law School, University of Virginia School of Law, Georgetown University Law Center, the Munich Intellectual Property Law Center, and other university programs in Tokyo, Taipei, New Delhi, and Beijing. Due to the size and diversity of his classes, Chief Judge Rader may have taught patent law to more students than anyone else. Chief Judge Rader has also co-authored several texts including the most widely used textbook on U. S. patent law, "Cases and Materials on Patent Law," (St. Paul, Minn.: Thomson/West 3d ed. 2009) and "Patent Law in a Nutshell," (St. Paul, Minn.: Thomson/West 2007) (translated into Chinese and Japanese). Chief Judge Rader has won acclaim for leading dozens of government and educational delegations to every continent (except Antarctica), teaching rule of law and intellectual property law principles.

Chief Judge Rader has received many awards, including the Sedona Lifetime Achievement Award for Intellectual Property Law, 2009; Distinguished Teaching Awards from George Washington University Law School, 2003 and 2008 (by election of the students); the Jefferson Medal from the New Jersey Intellectual Property Law Association, 2003; the Distinguished Service Award from the Berkeley Center for Law and Technology, 2003; the J. William Fulbright Award for Distinguished Public Service from George Washington University Law School, 2000; and the Younger Federal Lawyer Award from the Federal Bar Association, 1983. Before appointment to the Court of Federal Claims, Chief Judge Rader served as Minority and Majority Chief Counsel to Subcommittees of the U.S. Senate Committee on the Judiciary. From 1975 to 1980, he served as Counsel in the House of Representatives for representatives serving on the Interior, Appropriations, and Ways and Means Committees. He received a B.A. in English from Brigham Young University in 1974 and a J.D. from George Washington University Law School in 1978.
PAULINE NEWMAN, CIRCUIT JUDGE

HALDANE ROBERT MAYER, CIRCUIT JUDGE

HALDANE ROBERT MAYER has been a member of the court since 1987. He served as Chief Judge from 1997 to 2004. Born in Buffalo, Judge Mayer was educated in the public schools of Lockport, New York, before attending the United States Military Academy at West Point, from which he graduated with a Bachelor of Science degree in 1963. He earned a law degree in 1971 at the Marshall-Wythe School of Law of The College of William and Mary, where he was editor-in-chief of the William and Mary Law Review as well as a member of Omicron Delta Kappa National Leadership Society. He has served as a director of the William and Mary Law School Association.

Judge Mayer served on active duty in the Army of the United States from 1963 until 1975 in the Infantry and the Judge Advocate General’s Corps. He was awarded the Bronze Star Medal, the Meritorious Service Medal, the Army Commendation Medal with Oak Leaf Cluster, the Combat Infantryman Badge, Parachutist Badge, Ranger Tab, RVN Ranger Combat Badge, and several campaign and service ribbons. He resigned his Regular Army commission to take an Army Reserve commission, retiring in 1985 as a lieutenant colonel.

In 1971, Judge Mayer served as a law clerk for Judge John D. Butzner, Jr., of the United States Court of Appeals for the Fourth Circuit in Richmond, Virginia. He practiced law in Charlottesville, Virginia, in the mid-1970’s, simultaneously serving as an adjunct at the University of Virginia School of Law, as he did again in the 1990’s. He has also been an adjunct at George Washington University National Law Center.

From 1977 through 1980, Judge Mayer was the Special Assistant to the Chief Justice of the United States, Warren E. Burger, after which he returned to private law practice in Washington, D.C., until he became Deputy and Acting Special Counsel (by designation of the President).

S. JAY PLAGER, CIRCUIT JUDGE

S. JAY PLAGER was appointed Circuit Judge by President George H. W. Bush in 1989. Prior to his appointment, Judge Plager served in the Executive Office of the President from 1987 to 1989, as Associate Director of OMB and as Administrator, OIRA. He served as Counselor to the Under Secretary, Department of Health and Human Services from 1986 to 1987. Judge Plager was Dean and Professor, Indiana University School of Law from 1977 to 1984. He was Professor, Faculty of Law, University of Illinois from 1964 to 1977, and from 1958 to 1964 was Professor, Faculty of Law, University of Florida. Judge Plager was Visiting Scholar, Stanford University Law School from 1984 to 1985, Visiting Fellow, Trinity College, and Visiting Professor, Cambridge University in 1980, and Visiting Research Professor of Law, University of Wisconsin from 1967 to 1968. Judge Plager served on active duty in the United States Navy during the Korean Conflict. Judge Plager grew up in New Jersey, where he attended public schools. In 1952, he received an A.B. degree from the University of North Carolina, a J.D. in 1958 from the University of Florida, with high honors, where he was editor-in-chief of the Florida Law Review, and in 1961 an LL.M. from Columbia University. He has three children. Judge Plager assumed senior status in 2000.
ALAN D. LOURIE, CIRCUIT JUDGE

Circuit Judge Alan D. Lourie was appointed to the United States Court of Appeals for the Federal Circuit on April 6, 1990, by President George H. W. Bush. He was formerly Vice President, Corporate Patents and Trademarks, and Associate General Counsel of SmithKline Beecham Corporation.

Born in Boston, Massachusetts, on January 13, 1935, Judge Lourie received his Bachelor's degree from Harvard University (1956), his Master's degree in organic chemistry from the University of Wisconsin (1958), and his Ph.D. in chemistry from the University of Pennsylvania (1965). He received his J.D. degree from Temple University in 1970.

Before being appointed to the court, Judge Lourie had been President of the Philadelphia Patent Law Association, a member of the Board of Directors of the American Intellectual Property Law Association (formerly American Patent Law Association), treasurer of the Association of Corporate Patent Counsel, and a member of the board of directors of the Intellectual Property Owners Association. He was also Vice Chairman of the Industry Functional Advisory Committee on Intellectual Property Rights for Trade Policy Matters (IFAC 3) for the Department of Commerce and the Office of the U.S. Trade Representative. He was a member of the U.S. delegation to the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property, held in Geneva in October and November 1982, and in March 1984. He was chairman of the Patent Committee of the Law Section of the Pharmaceutical Manufacturers Association from 1980 to 1985.

Judge Lourie was awarded the Jefferson Medal of the New Jersey Intellectual Property Law Association for extraordinary contributions to the field of intellectual property law in 1998; was a recipient of the Intellectual Property Owners Education Foundation Distinguished Intellectual Property Professional Award for extraordinary leadership in the intellectual property community and a lifetime commitment to invention and innovation in 2008; was a recipient of the Philadelphia Intellectual Property Law Association's Award for outstanding IP achievement in 2010; was a recipient of the Boston Patent Law Association's Distinguished Public Service Award in 2011; was a recipient of a "lifetime achievement" award from The Sedona Conference in 2011; and recently was a recipient of NYIPLA's 10th Annual Outstanding Public Service Award in 2012.

He was a member of the Judicial Conference Committee on Financial Disclosure from 1990 to 1998 and has been a member of the Committee on Codes of Conduct since 2005. He is a member of the American Intellectual Property Law Association, the American Chemical Society, the Cosmos Club, and the Harvard Club of Washington.

Judge Lourie is married and has two daughters and four grandchildren.
RAYMOND C. CLEVENGER, III, CIRCUIT JUDGE

RAYMOND C. CLEVENGER, III was appointed by President George H. W. Bush in 1990. Judge Clevenger received a B.A. from Yale University in 1959. As a Carnegie Teaching Fellow, he taught European History at Yale College in the 1959-1960 academic year. From 1960 to 1963, he was employed by the Morgan Guaranty Trust Company in New York City. He received an LL.B. from Yale University in 1966. Judge Clevenger served as a law clerk to Mr. Justice White in October Term 1966. Judge Clevenger joined Willmer, Cutler & Pickering in 1967, serving as a partner in the firm from 1974 until his appointment to the bench. Judge Clevenger assumed senior status on February 1, 2006.
ALVIN A. SCHALL, CIRCUIT JUDGE

WILLIAM C. BRYSON, CIRCUIT JUDGE

WILLIAM C. BRYSON was appointed by President William J. Clinton in 1994. Prior to his appointment, Judge Bryson was with the United States Department of Justice from 1973 to 1994. During that period, he served as an Assistant to the Solicitor General [1978-79], Chief of the Appellate Section of the Criminal Division [1975-83], Counsel to the Organized Crime and Racketeering Section [1983-86], Deputy Solicitor General [1986-94], Acting Solicitor General [1989 and 1993], and Acting Associate Attorney General [1994]. He was an Associate at the Washington, DC law firm of Miller, Cassidy, Larroca and Lewin from 1975 to 1978. Judge Bryson served as Law Clerk to the Honorable Henry J. Friendly, United States Court of Appeals for the Second Circuit from 1973 to 1974, and as Law Clerk to the Honorable Thurgood Marshall, Supreme Court of the United States, from 1974 to 1975. Judge Bryson received an A.B. from Harvard College in 1969 and a J.D. from the University of Texas School of Law in 1973.
RICHARD LINN, CIRCUIT JUDGE

Richard Linn was appointed by President William J. Clinton in 1999. Prior to his appointment, Judge Linn was a Partner and Practice Group Leader at the Washington, DC law firm of Foley and Lardner from 1997 to 1999. He was a Partner and head of the intellectual property department at Marks and Murase, L.L.P., from 1977 to 1997. Judge Linn served as Patent Advisor, United States Naval Air Systems Command from 1971 to 1972, was a Patent Agent at the United States Naval Research Laboratory from 1968 to 1969, and served as a Patent Examiner at the United States Patent Office from 1965 to 1968. He was a member of the founding Board of Governors of the Virginia Bar Section on Patent, Trademark, and Copyright Law and served as Chairman in 1975.

In 2000, Judge Linn received the Rensselaer Alumni Association Fellows Award. He was honored in 2006 for dedication, service, and devotion to justice by the Austin Intellectual Property Law Association. Judge Linn was awarded the 2009 New York Intellectual Property Law Association Leadership Award. He also received the 2009 Jefferson Medal from the New Jersey Intellectual Property Law Association "in recognition of meritorious and outstanding contributions in support of the Constitution of the United States of America and furtherance of a fundamental principle thereof—to promote the progress of Science and useful Arts." In 2010, Judge Linn received the Outstanding Public Service Award from the New York Intellectual Property Law Association. In 2011, he was awarded the inaugural Mark Banner Award by the American Bar Association for his contributions to intellectual property law and the A. Sherman Christensen Award by the American Inns of Court Foundation for distinguished, exceptional and significant leadership to the American Inns of Court movement. He served as an Adjunct Professor and Professorial Lecturer in Law at George Washington University Law School from 2001 to 2003, and currently serves on the Law School's Intellectual Property Advisory Board. Judge Linn is a past president of the Giles Sutherland Rich American Inn of Court, a member of the Richard Linn American Inn of Court, a visiting member of the Hon. William C. Conner American Inn of Court, and an honorary lifetime member of the Benjamin Franklin American Inn of Court. He received a B.E.E. from Rensselaer Polytechnic Institute in 1965, and a J.D. from Georgetown University Law Center in 1969.
TIMOTHY B. DYK, CIRCUIT JUDGE

SHARON PROST, CIRCUIT JUDGE

SHARON PROST was appointed by President George W. Bush in 2001. Prior to her appointment, Judge Prost served as Minority Chief Counsel, Deputy Chief Counsel, and Chief Counsel of the Committee on the Judiciary, United States Senate from 1993 to 2001. She also served as Chief Labor Counsel (Minority), Senate Committee on Labor and Human Resources from 1989 to 1993. She was Assistant Solicitor, Associate Solicitor, and Acting Solicitor of the National Labor Relations Board from 1984 to 1989. She was an Attorney at the Internal Revenue Service from 1983 to 1984, and Field Attorney at the Federal Labor Relations Authority from 1980 to 1983. Judge Prost also served as Labor Relations Specialist/Auditor at the United States General Accounting Office from 1976 to 1980 and Labor Relations Specialist at the United States Civil Service Commission from 1973 to 1976. Judge Prost received a B.S. from Cornell University in 1973, an M.B.A. from George Washington University in 1975, a J.D. from the Washington College of Law, American University in 1979, and an LL.M. from George Washington University School of Law in 1984.
KIMBERLY A. MOORE, CIRCUIT JUDGE

KIMBERLY A. MOORE was appointed by President George W. Bush in 2006. Prior to her appointment, Judge Moore was a Professor of Law from 2004-2006 and Associate Professor of Law from 2000 to 2004 at the George Mason University School of Law. She was an Assistant Professor of Law at the University of Maryland School of Law from 1998 to 2000. She served both as an Assistant Professor of Law from 1997 to 1999 and the Associate Director of the Intellectual Property Law Program from 1998 to 1999 at the Chicago-Kent College of Law. Judge Moore clerked from 1995 to 1997 for the Honorable Glenn L. Archer, Jr., Chief Judge of the United States Court of Appeals for the Federal Circuit, and was an Associate at Kirkland & Ellis from 1994 to 1995. From 1988 to 1992, Judge Moore was employed in electrical engineering with the Naval Surface Warfare Center. Judge Moore received her B.S.E.E. in 1990, M.S. in 1991, both from the Massachusetts Institute of Technology, and her J.D. (cum laude) from the Georgetown University Law Center in 1994. Judge Moore has written and presented widely on patent litigation. She co-authored a legal casebook entitled Patent Litigation and Strategy and served as the Editor of The Federal Circuit Bar Journal from 1998 to 2008.
KATHLEEN M. O’MALLEY, CIRCUIT JUDGE

Kathleen M. O’Malley was appointed to the United States Court of Appeals for the Federal Circuit by President Barack Obama in 2010. Prior to her elevation to the Federal Circuit, Judge O’Malley was appointed to the United States District Court for the Northern District of Ohio by President William J. Clinton on October 12, 1994.


During her sixteen years on the district court bench, Judge O’Malley presided over in excess of 100 patent and trademark cases and sat by designation on the United States Circuit Court for the Federal Circuit. As an educator, Judge O’Malley has regularly taught a course on Patent Litigation at Case Western Reserve University Law School; she is a member of the faculty of the Berkeley Center for Law & Technology’s program designed to educate Federal Judges regarding the handling of intellectual property cases. Judge O’Malley serves as a board member of the Sedona Conference; as the judicial liaison to the Local Patent Rules Committee for the Northern District of Ohio; and as an advisor to national organizations publishing treatises on patent litigation (Anatomy of a Patent Case, Complex Litigation Committee of the American College of Trial Lawyers; Patent Case Management Judicial Guide, Berkeley Center for Law & Technology).

Judge O’Malley began her legal career as a law clerk to the Honorable Nathaniel R. Jones, Sixth Circuit Court of Appeals in 1982-1983. She received her J.D. degree from Case Western Reserve University School of Law, Order of the Coif, in 1982, where she served on Law Review and was a member of the National Mock Trial Team. Judge O’Malley attended Kenyon College in Gambier, Ohio where she graduated magna cum laude and Phi Beta Kappa in 1979.
JIMMIE V. REYNA, CIRCUIT JUDGE

Jimmie V. Reyna was appointed to the United States Court of Appeals for the Federal Circuit by President Barack Obama in 2011. Prior to his appointment, Judge Reyna was an international trade attorney and shareholder at Williams Mullen, where, from 1998 to 2011, he directed the firm's Trade and Customs Practice Group and its Latin America Task Force, and served on its board of directors (2006-08, 2009-11). He was an associate and partner at the law firm of Stewart and Stewart (1986-98). From 1981 to 1985, Judge Reyna was a solo practitioner in Albuquerque, New Mexico and, prior to that, an associate at Shaffer, Bult, Thornton & Baehr; also in Albuquerque, New Mexico.

Judge Reyna served on the U.S. roster of dispute settlement panelists for trade disputes under Chapter 19 of the North American Free Trade Agreement, and the U.S. Indicative List of Non-Governmental Panelists for the World Trade Organization, Dispute Settlement Mechanism, for both trade in goods and trade in services.


Judge Reyna is a recipient of the OHTL Award (the highest honor bestowed by the Mexican government for non-Mexican citizens). Other awards include: 100 Influentials, *Hispanic Business Magazine* (2011); 101 Latino Leaders in America, *Latino Leaders Magazine* 2011; Minority Business Leader, *Washington Business Journal*; Extraordinary Leadership, Hispanic National Bar Association (HNBA); Lifetime Honorary Membership, Society of Hispanic Professional Engineers; Distinguished Citizen Award, Military Airlift Command, U.S. Air Force; Spirit of Excellence Award, Albuquerque Hispanic Chamber of Commerce.

Judge Reyna served over a decade of leadership in the HNBA, including as National President (2006-07). He served in various leadership positions in the ABA Sections on International Law and Dispute Settlement. He was a founder and member of the board of directors of the U.S.-Mexico Law Institute, and the Community Services for Autistic Adults and Children Foundation. He currently serves on the Nationwide Hispanic Advisory Council of Big Brothers Big Sisters of America.

He received a B.A. from the University of Rochester in 1975 and a J.D. from the University of New Mexico School of Law in 1978.
EVAN J. WALLACH, CIRCUIT JUDGE

Evan J. Wallach was appointed to the United States Court of Appeals for the Federal Circuit by President Barack Obama in 2011, confirmed by the Senate on November 9, 2011, and assumed the duties of his office on November 18, 2011. Prior to his appointment, he served for sixteen years as a Judge of the United States Court of International Trade, having been appointed to that court by President William J. Clinton in 1995.

Judge Wallach worked as a general litigation partner with an emphasis on media representation at the law firm of Lionel Sawyer & Collins in Las Vegas, Nevada from 1982 to 1995. He was an associate at the same firm from 1976 to 1982.

While working with the firm, Judge Wallach took a leave of absence to serve as General Counsel and Public Policy Advisor to Senator Harry Reid from 1987 to 1988. From 1989 to 1995, he served in the Nevada National Guard as a Judge Advocate. In 1991, while on leave from his firm, he served as an Attorney/Advisor in the International Affairs Division of the Judge Advocate of the Army at the Pentagon.

Judge Wallach, a recognized expert in the law of war, has taught at a number of law schools, including Brooklyn Law School, New York Law School, George Mason University School of Law, and the University of Münster in Münster, Germany.

Judge Wallach has received a number of awards, including: the ABA Liberty Bell Award in 1993; the Nevada Press Association President’s Award in 1994; and the Clark County School Librarians Intellectual Freedom Award in 1995.

Judge Wallach served on active duty in the Army of the United States from 1969 to 1971. During his military career, he was awarded the Bronze Star, the Air Medal, the Good Conduct Medal, the Meritorious Service Medal, the Nevada Medal of Merit, the Valorous Unit Citation, a Vietnam Campaign Medal, and the RVN Cross of Gallantry with Palm.

Judge Wallach received his B.A. in Journalism from the University of Arizona in 1973, his J.D. from the University Of California, Berkeley in 1976, and an LLB with honors in International Law from Cambridge University in 1981.
OFFICE OF THE CIRCUIT EXECUTIVE

Jan Horbaly, Circuit Executive

The Circuit Executive position was established by Chief Judge Glenn L. Archer, Jr. on October 3, 1997. Shortly thereafter, the court submitted a request to the Judicial Conference of the United States that sections 332(e) and (f) of Title 28 of the United States Code be amended to provide for the establishment of a Circuit Executive position. The Judicial Resources Committee recommended to the Judicial Conference that the amendment be adopted, and on September 15, 1998, the Judicial Conference agreed to seek an amendment to 28 U.S.C. § 332 to establish a combined Circuit Executive and Clerk of Court position for the Federal Circuit. On November 13, 2000, Congress enacted The Federal Courts Improvement Act of 2000 (Pub. L. 106–418, 114 Stat. 2410), which provided for the creation of a Circuit Executive and Clerk of Court position for the Federal Circuit.

The new act authorized the Federal Circuit to appoint a Circuit Executive to serve at the pleasure of the court. The Circuit Executive is specifically responsible for the overall administration and management of the Federal Circuit. The Circuit Executive reports directly to the Chief Judge but responds to the needs and interests of the entire court. The Circuit Executive supervises the Assistant Circuit Executive for Administrative Services, the Assistant Circuit Executive for Information Technology, the Circuit Librarian, and the recently–established position of Operations Officer. The Circuit Executive functions as the court’s Chief of Staff, executing and implementing the policies and directives of the Chief Judge and the court while coordinating the activities and management responsibilities of six senior officers and a staff of approximately fifty–five.

In addition, the Circuit Executive works with the Administrative Office of the United States Courts on issues and projects concerning the court, reviews and manages the court’s $21,000,000 budget, participates in activities of the Judicial Conference of the United States with the Chief Judge of the Federal Circuit, and assists the Chief Judge in executing Judicial Conference assignments and policies. Further responsibilities of the Circuit Executive include: conducting long–range planning; accounting for funds received by the court; serving as the court’s disbursing officer; and overseeing the management and maintenance of the court buildings and facilities, which include a food service café, a parking garage and a fitness center. The Circuit Executive is also the court’s principal business manager,
and in that capacity, he supervises capital investment, the acquisition of new equipment and software, and space assignment, renovation and management. He coordinates all special and ceremonial events and is the principal focal point and liaison with outside organizations, public and private.

The Circuit Executive is also Clerk of Court for the Federal Circuit, with overall responsibility for the operations of the Clerk’s Office, exercised through two Assistant Circuit Executive/Chief Deputy Clerks and more than ten deputies. The role of the Clerk’s Office is more fully explained in Part III of this Court History.

Jan Horbaly, who had served as the Clerk of Court since November 25, 1996, was appointed by Chief Judge Archer to be the first Circuit Executive. Mr. Horbaly is an attorney who was in private practice in Washington, D.C. before joining the court. He specialized in Supreme Court practice, federal court litigation, and military law.

In 1990, former Secretary of Labor W. R. Usery, Jr., selected Mr. Horbaly to be executive director of the Coal Commission at the Department of Labor. From 1980 to 1984, Mr. Horbaly served as Special Assistant to the Chief Justice of the United States, Warren E. Burger. Mr. Horbaly previously had been a law clerk to Chief Judge Frank J. Battisti of the United States District Court for the Northern District of Ohio. From 1969 to 1976, Mr. Horbaly served on active duty as a captain in the United States Army. He entered the United States Army Reserve in 1976 and retired as a colonel in 2000. For his service, he has been awarded the Legion of Merit and the Bronze Star. Mr. Horbaly earned a J.S.D. from Yale University, an LL.M. from the University of Virginia Law School, an M.A. from the Woodrow Wilson Department of Government and Foreign Affairs at the University of Virginia, and a J.D. and A.B. from Case Western Reserve University. Mr. Horbaly also is a graduate of the United States Army War College and the United States Army Command and General Staff College.

Since the creation of the Circuit Executive position, the Secretary to the Circuit Executive and Clerk of Court has been Gay Shuler.

The Circuit Executive’s office is on the third floor of the Federal Circuit Annex. The Annex (formerly known as the Cosmos Building), the Dolley Madison House, and the Tayloe House are located next to the main National Courts Building and connect to that building through two locations on the second floor of the building. The Federal Circuit began occupying the three historical townhouses in the early 1990s, and they presently
house the Circuit Executive, the Central Legal Office, parts of the library staff, and two senior judges.
OFFICE OF THE CLERK

Jan Horbaly, Clerk of Court

The Office of the Clerk was described in the Court History (1982–1990). Since 1990, the Clerk's Office continues to function as the court's interface with the bar and public–receiving and filing documents, answering questions, maintaining case files, dockets, and records, preparing the calendar, maintaining the roll of attorneys admitted to practice, and promulgating the court's decisions.

On September 30, 1996, the second Clerk of Court, Mr. Francis X. Gindhart, retired after eleven years at the court. The court appointed Mr. Jan Horbaly to be the next Clerk of Court. He assumed his duties on November 25, 1996. His background is described in the previous section on the Office of the Circuit Executive.

Rules of Practice

New editions of the court's Rules of Practice continue to be published under the Clerk's leadership. Since July 1, 1997, the Federal Circuit's Rules have been published in a column on one side of the page alongside the column containing the corresponding Federal Rule of Appellate Procedure. This format allows practitioners to compare the two sets of rules easily.

In the March 4, 1999 edition of the rules, the court included a CD–Rom version of the Rules of Practice. A set of the court's rules also are posted on the court's website. The CD–Rom version of the court's rules directly benefits the public, parties, and counsel by permitting word searches and completion of forms on the website or a stand alone desktop computer. There continues to be no charge for the rules.

In September 2000, Chief Judge Mayer replaced the court's Rules Advisory Committee with an Advisory Council whose input has extended beyond the rules to other functions. The Advisory Council is more fully described in a section of Part IV to this Court History.

Court Seal and Flag

On February 4, 1999 the judges approved a new court seal. The new court seal was installed in each courtroom and in the conference room adjacent to Courtroom 201.
CENTRAL LEGAL OFFICE

Early in 1998, Chief Judge Mayer created the Central Legal Office (CLO) into which he incorporated the two existing offices that had comprised the court's central legal staff. Thus, the Office of the Senior Technical Assistant (STA) and the Office of the Senior Staff Attorney (SSA), both described in the Court History (1982–1990), became parts of the CLO. The offices of the STA and SSA, while retaining their independent identities, also now work as a unitary entity to serve the court. In that respect, those offices now share responsibility for certain assignments from the court, and the responsibilities and functions of the two offices, outlined in the separate sections below, overlap to some degree. Each office on occasion assists the other and assumes some of the duties of the other, particularly when the expertise of one office is beneficial to the other office and when one office is time-constrained by approaching deadlines.

OFFICE OF THE SENIOR TECHNICAL ASSISTANT

Melvin L. Halpern, Senior Technical Assistant

The major functions of the Office of the STA have not changed since the court's inception. Thus, the STA's office is still responsible to all the judges, collectively, in the sense that any of the judges can utilize that office for its designated duties. The major portion of the STA's time continues to be spent on the court's process of trying to avoid conflict and confusion in precedential opinions. As part of its role in that process, the STA's office, with occasional assistance from the Office of the SSA, will research relevant areas of the law and when necessary prepare appropriate comments on behalf of the CLO. The Office of the STA also continues to assist the SSA in the latter's work on stay motions in patent cases.

Certain minor functions of the Office of the STA have been eliminated or transferred since 1990. Thus, the court's Evaluation Committee has been eliminated, thereby ending the STA's participation on it. Also, the STA's office no longer serves as a liaison between the court and law schools concerning recruitment of law clerks. In addition, the STA's role as the court's Employment Dispute Resolution Coordinator has been transferred to the Office of the SSA.
Since 1990, the Office of the STA has consisted of four Technical Assistants (TAs), including the STA and a Deputy STA. Melvin Halpern continues to be the STA. Marilyn Wennes, the present Deputy STA, has been with the court since 1991. She has an undergraduate degree in biology and a master's degree in biotechnology, and she worked in biology research at a medical school before going to law school. The two other current TAs are Melissa Robertson and Nathan Kelley. Ms. Robertson has an undergraduate degree in chemistry; she came to the court in 1996 after four years with a patent law firm. Mr. Kelley has an undergraduate degree in electrical engineering; he came to the court in the summer of 2000 after working six years in the PTO and one year at a patent law firm. The other TAs at the Federal Circuit since 1990 have been: MaryAnn Lastova (1989 to 1995); Howard Kwon (1991 to 1992); Lisa Alexander (1992 to 1994); Mark Zagorin (1994 to 1996); Raymond Chen (1996 to 1998); and Thomas Stoll (1998 to 2000).

Since 1988, the Secretary in the Office of the STA has been Adrienne M. Parker.

OFFICE OF THE SENIOR STAFF ATTORNEY

Eleanor M. Thayer, Senior Staff Attorney

The Office of the SSA was created in 1990 as a continuation and expansion of the Office of the Motions Staff Attorney. The major functions of the office have not changed since the court's creation of the earlier office in 1984. The court created the office to give the judges more time to read briefs, to prepare for oral arguments, and to write opinions in cases appealed on the merits.

Eleanor M. Thayer has been the SSA, and Earline T. Washington has been the SSA Secretary, since the creation of the office. From that time to the present, the SSA's staff has grown from one staff attorney to its present composition of one supervisory staff attorney and two staff attorneys. The present staff includes J. Douglas Steere, the supervisory staff attorney, and staff attorneys Wendy Levenson Dean and Eileen Vachher. Mr. Steere joined the office as a staff attorney in 1992. Ms. Dean and Ms. Vachher joined the staff in the summer and fall of 2001, respectively.

The original system of rotating preassigned motions panels on a monthly basis continues. The staff attorneys review the motions papers, perform research, prepare draft orders, and
discuss each motion with each motions panel judge, who is presented with all motions papers. Except when the Clerk of Court acts on certain prescribed noncontroversial procedural motions, Fed. Cir. R. 27(h), or when an assigned merits panel of judges acts on motions, all motions are processed through the SSA’s office pending formal final approval of prepared orders by motions panel members. Additionally, the court receives petitions for writs of mandamus and petitions for permission to appeal. The number of motions and petitions filed each year is in the thousands.

In addition to the SSA’s primary responsibility for motions, the SSA assists the court’s Rules Committee, serves on the court’s Advisory Council, acts as the court’s Employment Dispute Resolution Coordinator, and assists the Chief Judge with special projects.

Other attorneys who have served as staff attorneys at the Federal Circuit include: Laureen Kapin, who served from January 1991 until March 1995 and, in the later years, served as supervisory staff attorney; Thomas Aldridge, who served from January 1991 to August 1992; Frances M. Bhambhani, who served from August 1992 to March 1995; Jennifer Buchanan Machovec, who served from March 1995 to February 1997; John Sassaman, who served from April 1995 to October 1998; Panayotis Lambrakopoulos, who served from March 1997 to April 1999; Elizabeth Heaney, who served from November 1998 to August 2000; Stephen M. Mancuso, who served from April 1999 to November 2001; and Jill Willis, who served from September 2000 to July 2001.
The U.S. Court of Appeals for the Federal Circuit: "An Act To establish a United States Court of Appeals for the Federal Circuit, to establish a United States Claims Court, and for other purposes."
96 Stat. 25.
April 2, 1982.

In an effort to promote greater uniformity in certain areas of federal jurisdiction and relieve the pressure on the dockets of the Supreme Court and the courts of appeals for the regional circuits, the Congress in 1982 established what is now the only U.S. court of appeals defined exclusively by its jurisdiction rather than geographical boundaries. The U.S. Court of Appeals for the Federal Circuit assumed the jurisdiction of the U.S. Court of Customs and Patent Appeals and the appellate jurisdiction of the U.S. Court of Claims. The new court was authorized to hear appeals from several federal administrative boards as well. Congress abolished the Court of Customs and Patent Appeals and the Court of Claims, reassigning those courts' 12 judges to serve on the Federal Circuit court. The act of 1982 also established a U.S. Claims Court (now the U.S. Court of Federal Claims).

The establishment of the Federal Circuit followed more than ten years of study and debate over reform of the appellate structure of the federal judiciary. A committee appointed by Chief Justice Warren Burger in 1971 recommended a National Court of Appeals that would decide cases and screen petitions for appeal to the Supreme Court. The 1975 report of the Commission on Revision of the Federal Court Appellate System proposed a like-named court that would determine national law and resolve inter-circuit conflicts by deciding certain categories of cases referred to it by the Supreme Court and the courts of appeals. Although Congress rejected both proposals for a national court of appeals, the studies drew attention to the problems associated with the lack of uniform rulings in specialized areas of jurisdiction. A proposal drafted by the Department of Justice led to President Carter's request in 1979 that Congress establish a court of appeals for a Federal Circuit, to be on the same jurisdictional level as the other U.S. courts of appeals. The proposed court would combine the functions of the Court of Customs and Patent Appeals with those of the Court of Claims, and the president also urged Congress to consider vesting the proposed court with the jurisdiction to promote uniformity and predictability in federal tax cases.

Although the House and Senate failed to complete consideration of the bill before the end of Carter's term, an endorsement by the Judicial Conference and support from business leaders resulted in the reintroduction of the legislation in 1981. In the approved act, Congress extended the jurisdiction of the Federal Circuit to the review of appeals from the U.S. Court of International Trade, the Merit Services Protection Board, the board of contract appeals, and certain administrative decisions of the secretaries of Agriculture and Commerce, as well as all appeals related to patents. Congress rejected the controversial proposals to grant the Federal Circuit court jurisdiction over appeals of tax and environmental cases.
United States Code Annotated
Title 28. Judiciary and Judicial Procedure (Refs & Annos)
Part IV. Jurisdiction and Venue (Refs & Annos)
Chapter 83. Courts of Appeals (Refs & Annos)

28 U.S.C.A. § 1295

§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

Effective: September 16, 2011

Currentness

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—

(1) of an appeal from a final decision of a district court of the United States, the District Court of Guam, the District Court of the Virgin Islands, or the District Court of the Northern Mariana Islands, in any civil action arising under, or in any civil action in which a party has asserted a compulsory counterclaim arising under, any Act of Congress relating to patents or plant variety protection;

(2) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1346 of this title, except that jurisdiction of an appeal in a case brought in a district court under section 1346(a)(1), 1346(b), 1346(e), or 1346(f) of this title or under section 1346(a)(2) when the claim is founded upon an Act of Congress or a regulation of an executive department providing for internal revenue shall be governed by sections 1291, 1292, and 1294 of this title;

(3) of an appeal from a final decision of the United States Court of Federal Claims;

(4) of an appeal from a decision of—

(A) the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to patent applications and interferences, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;

(B) the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. 1071); or

(C) a district court to which a case was directed pursuant to section 145, 146, or 154(b) of title 35;
§ 1295. Jurisdiction of the United States Court of Appeals for the..., 28 USCA § 1295

(5) of an appeal from a final decision of the United States Court of International Trade;

(6) to review the final determinations of the United States International Trade Commission relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337);

(7) to review, by appeal on questions of law only, findings of the Secretary of Commerce under U.S. note 6 to subchapter X of chapter 98 of the Harmonized Tariff Schedule of the United States (relating to importation of instruments or apparatus);

(8) of an appeal under section 71 of the Plant Variety Protection Act (7 U.S.C. 2461);

(9) of an appeal from a final order or final decision of the Merit Systems Protection Board, pursuant to sections 7703(b)(1) and 7703(d) of title 5;

(10) of an appeal from a final decision of an agency board of contract appeals pursuant to section 7107(a)(1) of title 41;

(11) of an appeal under section 211 of the Economic Stabilization Act of 1970;

(12) of an appeal under section 5 of the Emergency Petroleum Allocation Act of 1973;

(13) of an appeal under section 506(c) of the Natural Gas Policy Act of 1978; and


(b) The head of any executive department or agency may, with the approval of the Attorney General, refer to the Court of Appeals for the Federal Circuit for judicial review any final decision rendered by a board of contract appeals pursuant to the terms of any contract with the United States awarded by that department or agency which the head of such department or agency has concluded is not entitled to finality pursuant to the review standards specified in section 7107(b) of title 41. The head of each executive department or agency shall make any referral under this section within one hundred and twenty days after the receipt of a copy of the final appeal decision.

(c) The Court of Appeals for the Federal Circuit shall review the matter referred in accordance with the standards specified in section 7107(b) of title 41. The court shall proceed with judicial review on the administrative record made before the board of contract appeals on matters so referred as in other cases pending in such court, shall determine the issue of finality of the appeal decision, and shall, if appropriate, render judgment thereon, or remand the matter to any administrative or executive body or official with such direction as it may deem proper and just.

Credits


Editors' Notes

AMENDMENT OF SUBSEC. (A)(4)(A)

<Pub.L. 112-29, § 7(c)(2), (e), Sept. 16, 2011, 125 Stat. 314, 315, provided that effective upon expiration of the 1-year period beginning on Sept. 16, 2011, and except as otherwise provided, applicable to proceedings commenced on or after such effective date, subsec. (a)(4)(A) is amended to read:>

<(A) the Patent Trial and Appeal Board of the United States Patent and Trademark Office with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review under title 35, at the instance of a party who exercised that party's right to participate in the applicable proceeding before or appeal to the Board, except that an applicant or a party to a derivation proceeding may also have remedy by civil action pursuant to section 145 or 146 of title 35; an appeal under this subparagraph of a decision of the Board with respect to an application or derivation proceeding shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;>

Notes of Decisions (191)

28 U.S.C.A. § 1295, 28 USCA § 1295

Current through P.L. 112-139 approved 6-27-12
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LECTURE

WHAT THE FEDERAL CIRCUIT CAN LEARN FROM THE SUPREME COURT—AND VICE VERSA.

ROCHELLE COOPER DREYFUSS**

Thank you, Dean Farley, Don Dunner, and the Finnegan firm. I would especially like to thank Michael Carroll for inviting me to deliver this Lecture. It is a real privilege to have been asked, and a pleasure to be here. I would also like to thank him for suggesting that I talk about one of my favorite topics. I have been a student of the Federal Circuit for some time. The statute enacting the court was passed while I was clerking in the Second Circuit for Judge Feinberg, and I have to tell you, the smile on his face when he discovered he would never have to hear another patent case was a beauty to behold.

Also, while I was a law clerk to Chief Justice Burger at the Supreme Court, the hard work of getting the court organized was taking place. Justice Burger took a special interest in judicial administration, so during that period, he spent time with Howard Markey. Markey had been the Chief Judge of the Court of Customs and Patent Appeals, and he was slated to become the First Circuit’s first Chief. The two of them decided that since I had been a chemist before I

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* The Fifth Annual Finnegan Distinguished Lecture on Intellectual Property, presented on Oct. 16, 2009, was hosted by the Finnegan law firm, the American University Washington College of Law (WCL), and the Program on Information Justice and Intellectual Property (PJIP). Introductory remarks from Christine Farley, Associate Dean for Academic Affairs at WCL, from Don Dunner, Partner at the Finnegan firm, and from Michael Carroll, Professor of Law at WCL, have been omitted. This Lecture has been edited.

** Pauline Newman Professor of Law and co-Director of the Engelberg Center on Innovation Law and Policy, New York University School of Law.
went to law school, and because I was interested in patent law, I should be Markey’s inaugural Federal Circuit law clerk. It would have been a lot of fun, but unfortunately my life—my husband and children—were moving back to New York. So I had to decline, and I started to teach at NYU Law School instead. Nonetheless, I remained curious about how the court was faring. And at its fifth anniversary, which was right before I was to get tenure, I decided to write my “tenure piece” on its jurisprudence.¹ Since then, I have revisited the question of the court periodically.

To a student of patents, civil procedure, and legal institutions, the Federal Circuit is a superb subject for academic inquiry because it was actually created as an experiment; there are not too many experiments in law, so this one was pretty special. What happened is this: in the early 1970s, federal appellate dockets had increased to the point where the regional circuits could no longer handle the load. The first impulse was to add new judges to existing circuits. But that would have been of limited help because increasing the number of judges would lead to more intra-circuit inconsistency and would breed more cases for the circuit courts to decide. Adding new circuits was also a possibility, but such an addition would also have been problematic because more circuits would mean new opportunities for inter-circuit splits, and that would breed more cases for the Supreme Court to decide.

The Hruska Commission was convened to study the issue, and in 1973, it conceived the idea of experimenting with specialization—with pulling a class or classes of appeals out of the regional system and funneling them into a special appellate tribunal.² The new court would reduce the dockets of the regional circuits, and it could, in theory, do much more. Its presence could also diminish opportunities for forum shopping and take pressure off the Supreme Court. If it were small enough to speak with a single voice, it could bring more coherence to the law it administered. And, with greater expertise in the field, it might decide cases more efficiently. As Judge Markey told Congress, “[I]f I am doing brain surgery every day, day in and day out, chances are very good that I will do your brain surgery much quicker . . . than someone who does brain surgery once every

couple of years." Although the Hruska Commission report actually made several suggestions for fields that would be appropriate for specialization, patent law was, if you will, “the killer app.”

Way back in 1911, Learned Hand was called upon to decide whether purified adrenaline was patentable subject matter. It was a significant issue then, and the case retains its importance now, because its holding is thought to support patenting in the biotech sector. Significantly, in his rather brilliant opinion, Judge Hand nevertheless ended as follows:

I cannot stop without calling attention to the extraordinary condition of the law which makes it possible for a man without any knowledge of even the rudiments of chemistry to pass upon such questions as these... How long we shall continue to blunder along... no one knows; but all fair persons not conventionalized by provincial legal habits of mind ought, I should think, unite to effect some such advance.

Congress decided, in light of the Hruska Commission Report, that seventy-one years of blundering was enough. The “advance”—the Federal Circuit—would, in one fell swoop, solve the problems the Commission was formed to address, answer Learned Hand’s plea for technologically expert judging in patent cases, and bring that smile to Judge Feinberg’s face.

But it is important to remember that this was an experiment, and it was risky. Specialization had been tried in the past and, for the most part, failed. The poster child was the Commerce Court, which was created in 1910 to review decisions of the Interstate Commerce Commission. The court was so hated—by the railroads, by shippers, by the public—that it was disbanded within three years of its founding (and one of its five judges was also impeached, but that may be a different story).

In fact, there were many reasons to be concerned about specialization. Isolating patent law could favor special interests. Appointments to regional courts—that is, to generalist courts—are so

5. Id. at 115.
highly contested by so many special interest groups that they dilute each other’s effectiveness. But when there is only one field to fight about, those who are better organized and have the most money—which, in this context, is probably patent holders—can “capture” the appointments process so that judges are predisposed to their interests. Even without capture, patent holders would, it was thought, have an advantage. As repeat players, they could manipulate the way that important issues were framed for litigation.

There were also fears that the judges might develop tunnel vision. The saying is, if you have a hammer, everything looks like a nail. In an effort to support innovation, the judges might be so focused on patents, they would ignore non-patent incentives to innovate, such as intellectual curiosity, the availability of prizes, or competition. Furthermore, people were worried about the Federal Circuit’s isolation. They were concerned that the court’s exclusive jurisdiction would take patent law out of the judicial mainstream and deprive the law of the benefits of cross-fertilization.\(^7\) Finally, the bar was worried that there would be difficult boundary problems on the allocation of cases among the appellate courts.

Congress took these concerns seriously. While the Federal Circuit was given authority over all, or, as we will see, nearly all patent appeals, it is not specialized in the traditional sense because there are many other sources of its judicial authority. These include such areas as diverse as contracts, torts, export controls, labor law, and energy issues.\(^8\) Other industries and bar groups are therefore involved in lobbying for appointments, and the judges must stay abreast of non-patent legal developments.

Indeed, from most perspectives, the Hruska Commission’s experiment has been a raging success.\(^9\) The court has now passed the quarter-century mark. The patent industries and the patent bar are delighted with it, and—in what might be the biggest compliment of all—many other countries are copying it.\(^10\) On the whole, the concerns people expressed about specialization have not eventuated. There has been no capture of the appointment process. If anything, there is concern that not enough appointees have had patent

\(^10\) An example is the intellectual property court recently established in Taiwan. See Nicole M. Lin, IP Court Releases First Year Performance, TAI E QUARTERLY, Nov. 2009, at 1–2, available at http://www.taie.com.tw/English/pdf/01305.pdf.
experience. Nor have repeat players distorted the law, and for good reason. People in the research and development business are both producers and users of technology. They do not want overly protective law for the cases where they are accused of infringing, and they do not want overly permissive law for the cases where they are the right holders. To be sure, there were some boundary problems, but the Supreme Court's early interventions largely cleared them up. In United States v. Hohri,11 the Court made it clear that, unlike the Temporary Emergency Court of Appeals (TECA)—another failed experiment in specialization12—the Federal Circuit had "case" rather than "issue" jurisdiction: once a case is properly before the Federal Circuit, it decides all of the issues, not just the patent ones.13 At the same time, in Christianson v. Colt Industries Operating Corp.14 and Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.,15 the Supreme Court withheld Federal Circuit jurisdiction when the patent issues in a case appear only in the defense or in a counterclaim.16 These decisions have the benefit of giving the court a somewhat broader perspective on innovation policy, while also creating an interchange with other national courts.

Most important, however, the Federal Circuit's success can be attributed to the many positive contributions it has made to patent law. Most obviously, for patent appeals, the Federal Circuit is almost the only game in town. As a result, it has eliminated forum shopping and has attained a high degree of national uniformity, and that is a value that the industry positively cherishes. No one will make heavy commitments of time or money if there is uncertainty about what law is going to apply. There are some exceptions here, including, as Kimberly Moore has shown, some forum shopping at the district court level.17 But the situation has vastly improved.

The Federal Circuit has also made a key procedural innovation. In Markman v. Westview Instruments, Inc.,18 the court, with the Supreme Court's approval, eliminated jury trials on claim construction.19 That

12. See Dreyfuss, supra note 6, at 396–99.
13. Hohri, 482 U.S. at 74–76.
19. Id. at 390, 38 U.S.P.Q.2d (BNA) at 1471 ("We accordingly think there is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial . . .").
ruling created more predictability in the interpretation of patent claims, yet another value that the industry holds in high esteem. To be sure, there are still complaints about the continuing indeterminacy of claim construction, but in an empirical study, Jeffrey Lefstin demonstrated that the level of uncertainty in this area specifically is no different than that for contract interpretation generally. Indeed, in another empirical work, Lefstin showed much more: that the Federal Circuit's developed expertise in patent law has made the law more predictable across a whole range of issues, including infringement, validity, and inequitable conduct. And according to Robert Gomulkiewicz, the court has also become highly knowledgeable about the technology business. Because the court sees so many cases about patent transactions, it is now an influential voice within the federal judiciary as a whole on questions involving licensing.

Given the happiness within the bar and within the patent industries, and given the eagerness of other countries to copy the Hruska Commission's experiment, it is perhaps a surprise that lately the Supreme Court has changed its practice. In the first twenty or so years, its review of the Federal Circuit was largely intermittent and confined to procedural issues—cases like Hohri, Christianson, Holmes, and Markman. However, the Court has recently begun to intervene regularly; it has begun to address the substance of patent law; and it has reversed, vacated, or questioned nearly every decision: MedImmune, Inc. v. Genentech, Inc., on standing to challenge a patent; KSR International Co. v. Teleflex Inc., on nonobviousness (inventiveness); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., on the doctrine of equivalents; Merck KGaA v. Integra Lifesciences I, Ltd., on the statutory research exemption; Quanta Computer, Inc. v. LG Electronics, Inc., on patent exhaustion; eBay Inc. v. MercExchange,

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L.L.C., on injunctive relief;\textsuperscript{28} Illinois Tool Works Inc. v. Independent Ink, Inc., on whether patents imply market power;\textsuperscript{29} and Microsoft Corp. v. AT&\texttrademark;T Corp., on the extraterritorial application of U.S. law.\textsuperscript{30} Admittedly, the Court affirmed the Federal Circuit’s decision in J.E.M. Ag Supply v. Pioneer Hi-bred International, on what constitutes patentable subject matter.\textsuperscript{31} However, in Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.,\textsuperscript{32} on a dissent from the dismissal of certiorari, Justice Breyer cast doubt on the Federal Circuit’s subject matter jurisprudence.\textsuperscript{33} And there is yet another subject matter case pending in the Supreme Court—Bilski v. Kappos—where there are similar doubts about the Federal Circuit’s rule.

Significantly, we are in an era in which Supreme Court review is otherwise declining. Furthermore, heightened review of patent cases is happening in the absence of the circuit splits that usually attract Supreme Court attention. Accordingly, one really must wonder about this level of activity and whether it is an implicit criticism of the Federal Circuit’s work.

I, however, am going to argue tonight that heightened review should not be taken as a criticism of the Federal Circuit. The Supreme Court’s interest in patent law is at worst neutral: every circuit comes into focus periodically, and now that the Federal Circuit has come of age, it is taking its turn. More to the point, Supreme Court involvement in Federal Circuit decisions should be regarded as highly salutary, for these two tribunals have a great deal to learn from one another.

What I mean is this. The Federal Circuit must, obviously, learn from the Supreme Court, for it is bound by the Supreme Court’s decisions. But the relationship between these two courts is not simply

\textsuperscript{34} In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d (BNA) 1385 (Fed. Cir. 2008) (en banc), cert. granted sub nom., Bilski v. Doll, 129 S. Ct. 2735 (2009), and argued sub nom., Bilski v. Kappos, No. 08-964 (U.S. argued Nov. 9, 2009).
a matter of judicial hierarchy. They have a great deal in common. Both of these courts are caught in the Hruska Commission's experiment; they must both figure out how a judiciary largely committed to generalist adjudication should deal with a court that is so differently constituted. And both courts are, in a sense, courts of last resort (at least, the Federal Circuit is when the Supreme Court is not so focused on its activities). In that capacity, both have weighty responsibilities regarding the substance of national law and for supervising the courts below them. Of course, they see these problems from different perspectives. Sharing their views—learning from one another—could enhance the operation of the patent system, shed light on the costs and benefits of specialization, ease the path for other specialized courts, and improve judicial administration more generally.

Let me start with the first area of specialization, where there are two distinct problems: the Federal Circuit's relationship to the generalist Supreme Court, which reviews its work, and its relationship to the generalist trial courts, whose work it reviews. I will describe both problems and then discuss the lessons to be learned.

Of these, the harder question is the Federal Circuit's relationship to the Supreme Court. Obviously, the Federal Circuit is subject to Supreme Court review—the same as the other circuit courts—but review here seems particularly intrusive. The judges on the Federal Circuit have built up experience over their years of service, while the Justices of the Supreme Court do not even have a generalist's knowledge of patent law. After all, their own experience on lower court benches could not possibly have given them any perspective on patent law because—and there is some irony here—all the patent cases had been diverted to the Federal Circuit by the time most of them were appointed. Justice Stevens is an exception, and he is approaching retirement.

On the one hand, Supreme Court involvement dilutes the Federal Circuit's hard-won expertise, but on the other hand, the Supreme Court's involvement may be more important in the case of the Federal Circuit than it is for the other courts it reviews. Consider the common law. Although patent law is nominally statutory, it leaves wide gaps for judge-made law. And common law judges make law in an evolutionary and collaborative fashion.

Take the Evarts Act, which established the regional circuits. At the time the Act was passed, the question was whether these new regional circuits would be bound by each other’s law. An approach requiring appellate courts to follow one another’s precedent would have had the benefit of guaranteed national uniformity. Nonetheless, the decision was made to give each circuit judicial independence—that is, to forego national uniformity—so that the law would “percolate,” allowing the fittest rule to survive. “Survival of the fittest” is no longer possible for patent law, because apart from cases in the Holmes or Christianson posture, the only circuit court hearing patent cases is now the Federal Circuit.

If, then, we are going to get evolution in patent law, it has to be through a different mechanism. Supreme Court involvement in patent decisions is one such avenue. There is another reason Supreme Court involvement is necessary: despite congressional attempts to give the Federal Circuit cases outside patent law, patents remain at the core of its docket, at least in the innovation area. The court has little chance to see how patents fit into the economy as a whole. The Supreme Court does have that perspective.

And in the recent group of cases, we see the difference Supreme Court involvement can make at both the micro and the macro level. Thus, at the micro level the Supreme Court has made smallish doctrinal adjustments intended to keep patent law in the mainstream. In eBay, the Court claimed it was making sure that the standards for injunctive relief stay the same across all federal causes of action; in MedImmune, it made the test for standing uniform; in Illinois Tool, it equalized the treatment of antitrust defendants.

At the macro level, the Supreme Court has, essentially, pressed the reset button. Although I earlier described the establishment of the Federal Circuit as an outgrowth of administrative concerns, one can also read the legislative history as revealing a strong interest in strengthening patent value and stemming what was then perceived as

a flight to trade secrecy. The Federal Circuit took this commitment to heart (which, in part, may be why the patent bar has been so pleased with its performance). However, its success has turned into something of a mixed blessing: legal scholars, economists, the Federal Trade Commission, the National Academies, and even some in the patent industries have expressed concern that there are now too many patents, that they cover too much economic activity, that patent quality is declining, and that the high cost of patent litigation is chilling innovation.\(^{41}\)

The Supreme Court has moved in very effectively. For example, by giving district courts discretion over awarding injunctive relief, eBay's limit on permanent injunctive relief should reduce incentives to litigate;\(^ {42}\) KSR, which raised the standard of nonobviousness, relieved concerns about patent quality; Justice Breyer's dissent in LabCorp clearly flagged the problem of patent proliferation. As he stated: "[S]ometimes too much patent protection can impede rather than 'promote the Progress of Science and useful Arts.'"\(^ {43}\)

Of course, many of these changes could have been made by Congress, but as its recent prolonged attempt at patent reform suggests, there can be wisdom in relying on a judicial approach.\(^ {44}\) In sum, that is one problem: figuring out how the Supreme Court can use the generalist knowledge derived from its unique position in a way that takes account of the Federal Circuit's expertise in technology, patents, and licensing.

The other problem is determining the Federal Circuit's role as a specialist appellate court reviewing a generalist trial court. The problem here is that appellate courts generally defer to the factual


\(^{42}\) 547 U.S. at 388, 78 U.S.P.Q.2d (BNA) at 1577.


determinations made by trial courts. In federal courts, deference is required by Rule 52 of the Federal Rules of Civil Procedure and in the run-of-the-mill case, the Supreme Court’s steadfast enforcement of Rule 52 makes sense. After all, the trial court is in a unique position regarding facts; the judge listens to the witnesses and learns about the documentary evidence as it is introduced. But that comparative advantage is diminished in patent cases. After all, most trial judges have very little experience in high-tech cases and some are very uncomfortable with technological complexity.

But the Federal Circuit does not have that problem. Besides, it chooses clerks for their technical backgrounds and it can hire staff to advise it on technical matters. Accordingly, a strong argument can be made that the relationships between these courts should be different. And significantly, the countries that have copied the idea of specialized patent courts have mostly established their patent courts at the trial court level, which is some indication that the real gains from specialization are reaped with respect to fact-finding. If that is true, it would be highly advantageous to find a way for the Federal Circuit to make an equivalent contribution, even though it is an appellate court.

So, those are the two specialization issues—what can the courts learn from one another? Although the Supreme Court is the older institution—and supreme—the fact of the matter is that the Federal Circuit faces these specialization issues more regularly. As a result, it has the most to teach. Starting at the end, with the question of trial court review: since its earliest days, the Federal Circuit has been attentive to the question of effective review of fact-finding. Likely, its concern initially arose because it was Chief Judge Markey’s view that the way to establish the court’s reputation would be to straighten out the mess that was nonobviousness, where the disparate views on the regional circuits had given rise to the most extremely corrosive form of forum shopping. In its earliest nonobviousness cases, the Federal Circuit therefore undertook a detailed examination of the patents in issue, at the prior art, and at their relationship. If it thought the trial court was wrong on nonobviousness, it reversed.

What happened? In Dennison Manufacturing Co. v. Panduit Corp., the Supreme Court held that Rule 52 permits appellate courts to reverse factual findings only when they are clearly erroneous, not

merely wrong.\(^{46}\) And that Rule applied even though the Federal Circuit’s grasp of the facts was clearly better than the trial court’s.

That was a major loss. But the Federal Circuit did not give up on the enterprise both for nonobviousness and in general. Instead, it adopted two other approaches. First, it required the trial courts to apply specific analytical techniques to factual questions. For nonobviousness, for example, it required courts to examine secondary considerations—such things as commercial success and long-felt need.\(^{47}\) Furthermore, it required proof of a teaching, suggestion, or motivation for combining prior art.\(^{48}\) In addition, it started classifying many of the more complex technical issues as questions of law, rather than issues of fact, so that Rule 52 would not bar de novo review.\(^{49}\) The Federal Circuit has, in short, efficiently canvassed the ways in which it can bring its expertise to bear on the facts that affect the outcome of technologically complex cases. Admittedly, by requiring these analytical techniques, it has sacrificed flexibility for predictability. But as we saw, improving predictability has very much pleased the patent industries.

But there is a catch. True, in Markman, the Supreme Court approved the idea of recharacterizing some factual questions as legal determinations.\(^{50}\) But at least in part, it did that because the move fit nicely with the Supreme Court’s own agenda about limiting fact-finding by juries.\(^{51}\) In fact, the Supreme Court is busy dismantling the analytical requirements. In KSR, its own case on nonobviousness, the Supreme Court began by “rejecting the rigid approach of the Court of Appeals.”\(^{52}\) And, many of the amicus briefs in Bilski ask the Court

46. Id. at 811, 229 U.S.P.Q. (BNA) at 749.
47. See, e.g., Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 U.S.P.Q. (BNA) 871, 879 (Fed. Cir. 1987) (noting that evidence of these “secondary considerations may often be the most probative and cogent evidence in the record”).
50. Markman v. Westview Instruments, Inc., 517 U.S. 370, 388–90, 38 U.S.P.Q.2d (BNA) 1461, 1469–70 (1996) (holding that “there is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings, which normally fall within the jury’s domain”).
to similarly reject, as overly rigid, the Federal Circuit's rules on determining patentable subject matter.\textsuperscript{53}

What the Supreme Court has not done, however, is face the larger question of expertise head-on. If it does not like rigid rules, perhaps it should use its power under the Rules Enabling Act\textsuperscript{54} to change Rule 52. Or, if it does not want to engage in that particular experiment with Federal Circuit exceptionalism, it could help the Federal Circuit find the "sweet spot" between rigid rules and standards. Either way, an acknowledgement of the Federal Circuit's attempts to deal with deficiencies in lower courts' handling of technologically complex factual issues could improve patent jurisprudence. Taking lessons from the Federal Circuit might also help the Supreme Court improve adjudication of technical issues in other complex cases, such as antitrust and environmental law.

What about the harder question, the one about the Federal Circuit's relationship to the Supreme Court? How do we get the benefits of Supreme Court intervention without sacrificing the advantages of relying on the Federal Circuit's growing expertise? There are two sub-issues here: When should the Supreme Court intervene—or more accurately, who should decide when the Supreme Court should decide? And, does the Supreme Court owe the Federal Circuit any special regard on substantive patent law questions?

On the first of these issues, I again think that the Supreme Court could learn a great deal from the Federal Circuit. In the past, the Supreme Court has sometimes wasted its time. An example is Pfaff v. Wells Electronics, Inc.,\textsuperscript{55} where the Court reached a perfectly reasonable position on when an invention was "on sale,"\textsuperscript{56} but the decision was no better than the one that the Federal Circuit would have found for itself.\textsuperscript{57} Since the Supreme Court's resources are highly limited,

\begin{itemize}
\item 53. Brief Amicus Curiae of Franklin Pierce Law Center in Support of Certiorari at 3, Bilski v. Kappos, No. 08-964 (U.S. filed Mar. 2, 2009), 2009 WL 2445759 (claiming that Congress, the Supreme Court, and independent entities that have studied patent law "do not advocate limiting the scope of patentable subject matter"); Brief of Amicus Curiae Medistem Inc. in Support of the Petition for a Writ of Certiorari at 6, Bilski v. Kappos, No. 08-964 (U.S. filed Feb. 27, 2009), 2009 WL 564646 ("Narrowing the scope of patentable subject matter forces innovators to use other means of protecting their inventions, such as maintaining the invention as a trade secret."); Brief of John P. Sutton Amicus Curiae Supporting Petitioners at 3, Bilski v. Kappos, No. 08-964 (U.S. filed Feb. 25, 2009), 2009 WL 507782 (supporting certiorari to "clarify the law," but not to "make commodity trading into patentable subject matter").
\item 56. Id. at 57, 48 U.S.P.Q.2d (BNA) at 1642.
\item 57. Janis, supra note 7, at 412.
\end{itemize}
it would be better for it to take the Federal Circuit’s advice on when a case is cert-worthy.

To a certain extent, that is the way the Court appears to be operating. *Festo*, *Merck*, and *Bilski* all featured sharp dissents in the Federal Circuit, and these opinions may have guided the Supreme Court’s decision to hear those cases. I strongly believe that is the right approach: to have the Federal Circuit signal the need for intervention. But I would add two caveats. First, if it is true that the Supreme Court is learning from the Federal Circuit, then the judges of the Federal Circuit need to be careful about what it is they teach. For example, while Supreme Court involvement on patentable subject matter might ultimately be useful, I would rather have waited to see how the new standard the Federal Circuit created in its decision in *Bilski* played out before the Supreme Court weighed in on whether the standard is correct. Further, I would not give the Federal Circuit the only voice in choosing cases to review—the involvement of others (practitioners, the Solicitor General) will remain important. As I noted earlier, the Federal Circuit is not well-positioned to think about how patents fit into the overall economy or to see when patent doctrine has deviated from general rules of law. Accordingly, other voices are necessary on those issues.

What the Supreme Court should do once it intervenes is another issue. Is there reason to give some kind of deference to the Federal Circuit’s decisions on substantive law?

The Supreme Court has certainly assumed that its role here is to be the teacher. For example, it has severely criticized the Federal Circuit on departures from precedent: *KSR* contained that message, and Justice Breyer’s dissent in *LabCorp* was quite explicit. According to Justice Breyer, the Supreme Court “has never made such a statement [referring to the Federal Circuit’s rule in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*] on the patentability of processes] and, if taken literally, the statement would cover instances where this Court has held the contrary.”

Nonetheless, it is hard to see how the Federal Circuit could define its job as merely applying Supreme Court precedent. Technology

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changes rapidly. Since the founding of the Federal Circuit, the biotech and IT industries exploded, the Internet was established, and patent exploitation became a global enterprise. The entire structure of the patent industry changed as universities entered the picture, joint venturing became common, and new forms of patent aggregation were developed. And yet, until KSR, the last case on nonobviousness was 1976; previous to LabCorp, the case on manipulating information was decided in 1981; until Microsoft, there were no Supreme Court cases on electronic distribution of patented materials; until Quanta Computer, there was nothing on modern value-chain licensing.

John Duffy has written about how, even with limited engagement, the Supreme Court can adequately supervise the Federal Circuit. And I have just said that on micro and macro issues, the Supreme Court ought to be the teacher. But should its views always trump? I would argue that the Supreme Court’s testiness about the Federal Circuit’s departures from its precedents is often inappropriate, and that it adversely affects Supreme Court litigation as well. Litigants are forced to rely on language from ancient case law that no one wants to resurrect, when they should be suggesting formulations that address contemporary problems. A good example is the concept of “synergy.”

In certain respects, then, the Supreme Court ought to conceptualize its relationship with the Federal Circuit as more of a dialogue than the product of hierarchy—as I said earlier—as the substitute for percolation. The mechanism for doing that is certainly there. Consider patentable subject matter: first, there was—in Justice Breyer’s words—the Federal Circuit’s “statement” about patentability in State Street. Then came Justice Breyer’s dissent in LabCorp. That spurred a set of Federal Circuit cases, culminating in Bilski, which the Supreme Court then decided to review. Next came Prometheus Laboratory, Inc. v. Mayo Collaborative Service, another subject matter case, and Prometheus will, of course, be followed by the Supreme Court decision in Bilski. So, there is plenty of opportunity for a really good interchange of ideas, and the Supreme Court seems

63. See Dreyfuss, supra note 9, at 808 n.96 (“A good example is [KSR], where the Federal Circuit’s nonobviousness jurisprudence was said to conflict with [Black Rock], and [Sakraida]. However, those cases announced a ‘synergy’ requirement for combination patents which has long been considered unworkable.” (citations omitted)).
64. 581 F.3d 1396, 92 U.S.P.Q.2d (BNA) 1075 (Fed. Cir. 2009).
receptive to that approach. Indeed, even when the Supreme Court reverses the Federal Circuit's decisions, the Court rather significantly leaves implementation questions to the Federal Circuit's discretion.

One could also think about this institutionally. Is the Supreme Court the best institution to be setting mid-range policy, by which I mean crafting the policies relevant to the administration of patent law? In other technical areas, there is an administrative agency that fulfills that function. Now, I have left the U.S. Patent and Trademark Office (USPTO) out of this discussion because it was founded before the Administrative Procedure Act; lacks rule-making authority; and only sees the issues that arise when a patent is issued, not the ones that come up when patented information is used. Perhaps things will change under the new Commissioner, David Kappos, but as currently constituted, the PTO just cannot play the institutional role I am discussing. And as we have seen, Congress is not in a position to do much on this either. So, we have a technically complex set of problems, key to our economic health, and something of a vacuum on the institutional end. Now that all patent cases are before the Federal Circuit, it is uniquely positioned to take on the job of filling that void. But for that to happen, the Federal Circuit has to act like a teacher: it has to explain what policies it is adopting.

This, indeed, is a place where the Federal Circuit could learn from the Supreme Court: not what the mid-level policy ought to be—I would leave that to the Federal Circuit—but how to make it evident what mid-level policies it has chosen and why it has decided to further them. In other words, the Federal Circuit must articulate the theory on which it is relying.

The Supreme Court works very hard to explain what it does. It often describes the alternative ways in which it could decide a case, it identifies the policy choices associated with each alternative, and it explains the theory behind the choice it is making. In part, that may be an outgrowth of confronting circuit court splits—it must explain to each circuit why it chose the rule that it did—but it is even true of


the Supreme Court's patent jurisprudence. For example, KSR laid out the reasons why the nonobviousness standard needed to be elevated, 67 Festo provided justification for retaining the doctrine of equivalents, 68 and in LabCorp, Justice Breyer made his views exceptionally clear: "[S]ometimes too much patent protection can impede rather than 'promote the Progress of Science and useful Arts.'" 69

In contrast, although the Federal Circuit routinely recites policy justifications for the statutory requirements of patent law, it rarely provides insight into the policy rationale for its own decisions. Indeed, some of the judges have publicly suggested that it would be wrong to explain (or even to be motivated by) policy. 70 Now, I have written elsewhere that the reason for denying policy motives may have something to do with the experimental nature of the court. Perhaps it did not want to make waves while it was "on probation" in the public's mind. 71 But after more than twenty-five years, I think it is safe to say that the experiment is over. The court is now part of the fabric of the U.S. judiciary.

Unless the Federal Circuit does a good job articulating, explaining, and justifying policy, it cannot play the institutional role I envision. For example, I just mentioned the potential dialogue on patentable subject matter. But there is a small flaw in the argument: when the Federal Circuit decided Prometheus, it never engaged Breyer's dissent in LabCorp—even though both of the cases were about the same type of invention. 72 Instead, in a footnote, the Federal Circuit dismissed LabCorp, stating that a "dissent is not controlling law" and that the claims in the two cases were "different," but offered no policy-based explanation as to how they were different enough to mandate different

70. See, e.g., Alan D. Lourie, A View from the Court, 75 PATENT, TRADEMARK & COPYRIGHT J. (BNA) 22 (2007) ("[N]ot once have we had a discussion as to what direction the law should take.... We have just applied precedent as best we could determine it to the cases that have come before us."); Paul Michel, Judicial Constellations: Guiding Principles as Navigational Aids, 54 CASE W. RES. L. REV. 757, 758 (2004).
71. Dreyfuss, supra note 9, at 814–27.
results. This is true for other issues as well: Had the Federal Circuit explained why it was ignoring Rule 52 in Panduit, or why it was adopting analytical rules, perhaps the Supreme Court might have taken the problematic nature of its relationship to the trial courts more seriously.

I hasten to add that, to an extent, the Federal Circuit is learning this lesson. An example is the Federal Circuit’s decision in Bilski, which very deliberately and repeatedly referenced Diamond v. Diehr, the Supreme Court’s 1981 decision on the patentability of software. That approach neatly teed up the problem of relying on outdated case law. We will have to see whether the Federal Circuit made the issue of its authority as a specialized court to stray from Supreme Court precedents clear enough for the Supreme Court to consider the problem.

The opinion-writing issue allows me to segue into another area where the courts have a great deal to teach each other, and that is on dealing with the special problems that come from being a court of last resort, with supervisory and administrative responsibilities. Once again, I think the Federal Circuit has something important to teach. The lesson goes back to the question of reviewing district court fact-finding. While I am also somewhat skeptical about over-reliance on rigid rules, the Federal Circuit deserves credit for taking its role in supervising the lower courts seriously. That is what made the court such a success in patent law circles, and there is a lesson there for the Supreme Court. As two of my colleagues, Sam Estreicher and John Sexton noted twenty-five years ago, the Supreme Court’s own docket is cluttered with cases that arise directly from that Court’s failure to provide clear analytical directions. Now that the Supreme Court is taking fewer cases, that failure may become even more serious. Here, the Federal Circuit’s responsiveness could act as a template for the Court.

73. Prometheus, 581 F.3d at 1346 n.3, 79 U.S.P.Q.2d (BNA) at 1085.
75. See Samuel Estreicher & John E. Sexton, A Managerial Theory of the Supreme Court’s Responsibilities: An Empirical Study, 59 N.Y.U. L. Rev. 681, 812 (1984) (“In our view, the Court should act as the manager of the federal judicial system, overseeing the work of the federal and state courts, and intervening only when necessary to resolve fundamental interbranch or federal-state clashes or to render a final resolution of a question that has ripened for decision after percolation in the lower courts.”).
In other respects, however, this is a place where the Supreme Court has more experience, and so the Federal Circuit has much to learn. First, there is the issue of writing informative opinions. One reason to think of the Federal Circuit as filling an institutional vacuum is because it is a court of last resort. As I tell my students, for patent law, the Federal Circuit usually is the Supreme Court. But if it is, it has to act that way. It cannot play a policy role unless it tells us what the policy is. Well-articulated policy is also important for supervising the lower courts. Indeed, it is a tool that might replace at least some of the Federal Circuit’s famous rigidity.\textsuperscript{76} That is, the better the trial court understands the policy that the Federal Circuit is trying to achieve, the more likely it will do what the Federal Circuit thinks is required.

A change might also help to clear the court’s dockets. Federal Circuit judges have complained about appeals that are built around nothing more than minor changes in the wording of its holdings. But if the litigants better understood the underlying policy, these linguistic variations might seem less salient to them.

Another issue concerns what I call the repeat player disadvantage. A problem for courts of last resort, or for a court that has an institutional role in setting policy, is that the law it hands down can require revision. Justice Brennan used to call this “damage control.” A new rule could be wrong, it might be confusingly formulated, or it may wind up applying to situations the court did not foresee. To do damage control, the court must take the issue up again. And therein lies the problem: litigants have to persuade the court to reconsider an issue it has already laid to rest, and that is not always comfortable. Repeat players—attorneys who appear before a court regularly—may not want to annoy the judges and jeopardize their credibility in future cases.\textsuperscript{77} So, for example, John Duffy and Craig Nard note that the number of PTO certiorari petitions plummeted after the Federal Circuit was established.\textsuperscript{78} As the quintessential repeat player, perhaps it has been trying to avoid that kind of friction.

Other litigators may also be facing this issue. It seems to me that one such example is the common law experimental use defense. In \textit{Madey v. Duke University},\textsuperscript{79} the Federal Circuit seemingly reduced

\textsuperscript{76} See Dreyfuss \textit{supra} note 9, at 803 (“The elaboration of policy would make the law more comprehensible, and thus easier to apply reproducibly.”).


\textsuperscript{79} 307 F.3d 1351, 1362, 64 U.S.P.Q.2d (BNA) 1737, 1746 (Fed. Cir. 2002).
the defense quite radically and that has caused a great deal of consternation in the research community. The Court could have done damage control in Merck, which also involved experimentation, 80 and in fact, Judge Newman tried to limit Maday in her separate opinion in that case. 81 But the attorneys in Merck chose to avoid the Maday issue and relied instead on a statutory defense. 82 They won, so they did right by their clients—but their decision has left the scope of the common law exception in doubt for more than half a decade.

How can courts of last resort avoid the repeat player disadvantage? The Supreme Court does it first by recognizing the problem, and second, by dropping footnotes about issues that need reconsideration, by writing dissents, or by granting certiorari on a case raising a problematic issue and then dismissing the case. These actions serve as invitations: they empower otherwise reluctant lawyers to find a good case to bring back an issue for reconsideration in a nice clean case. It is a useful technique, and we do see a few Federal Circuit dissents along those lines. For example, the en banc reconsideration of the written description requirement in Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co. 83 owed much to the persistent opinion writing by Judges Rader and Linn; 84 their dissents to the en banc decision may also lead to Supreme Court consideration of the issue. 85 But more could be done to make these invitations clear. Or, perhaps, what is needed is something different: the Federal Circuit bar needs to learn a lesson from the Supreme Court bar on how to read these tea leaves and act on them.

81. Id. at 877–78, 66 U.S.P.Q.2d (BNA) at 1877 (Newman, J., concurring in part, dissenting in part) (differentiating “research into the science and technology disclosed in patents” from research tools, which are “product[s] or method[s] whose purpose is use in the conduct of research”).
82. Id. at 864, 66 U.S.P.Q.2d (BNA) at 1867 (majority opinion).
To sum up, the Supreme Court’s recent interest in patent law is highly intriguing. It has caused consternation in patent circles. But it should not. There are many questions that these courts need to work through jointly: questions on when specialization is necessary, how it should be provided, under what circumstances a specialized court should be able to “pull rank” and claim that its expertise gives it a superior perspective. By teaching each other the lessons that come from their unique perspectives, these two courts can bring the Hruska Commission’s experiment to fruition and make a truly significant contribution to judicial administration both here in the United States and abroad. Equally important, the Federal Circuit and the Supreme Court can together update patent law to the emerging needs of the “Knowledge Economy.” As a student of both patent law and institutional design, it is a pleasure to watch these cases and this dialogue unfold. Thank you again for giving me the opportunity to talk about one of my favorite subjects.