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## What's So Special About Patent Law?

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## What's So Special About Patent Law?

### Cover Page Footnote

Frank H. Marks Visiting Associate Professor of Law, George Washington University School of Law. University of Mary Washington, B.S.; Duke Law School, J.D.; Emory University, M.A./Ph.D. I am grateful to Gregory Dolin, William Hubbard, and Kristina Caggiano Kelly for their thoughtful comments on early drafts and to Melody for the time to write.

# What's So Special About Patent Law?

Michael Goodman\*

*The widespread belief that patent law is special has shaped the development of patent law into one of the most specialized areas of the law today. The belief in patent law's exceptionalism manifests itself as two related presumptions with respect to the judiciary: first, that generalist judges who do not have patent law expertise cannot effectively decide patent cases, and second, that judges can develop necessary expertise through repeated experience with patent cases. Congress showed that it acquiesced to both views when it created the Federal Circuit and the Patent Pilot Program. In recent years, however, the Supreme Court has reminded us that the judiciary's difficulty with patent cases is not the law, but is instead that patent cases often involve difficult subject matter, which sometimes requires technical or scientific expertise. While Congress's early attempts to deal with these difficulties focused on courts with legal—rather than technical—expertise, the Supreme Court's recent pronouncements suggest that they should have been doing the reverse. Moreover, to the extent that it is the underlying technology that makes patent cases difficult, that commends the use of an administrative, rather than a judicial, solution. One potentially viable answer to the judiciary's problem with patent law has already been partly implemented in the form of the recently created Patent Trial and Appeal Board. This Article proposes expansion of that solution by making that new entity the exclusive forum for deciding issues of patent validity.*

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## I. THE SPECIALIZATION OF THE PATENT

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## INTRODUCTION

Among legal disciplines, patent law stands a world apart. From the lawyers who practice patent law—the “patent people”—to the judges who decide patent disputes, patent law is becoming an increasingly specialized field.<sup>1</sup> As any patent person will tell you, and

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<sup>1</sup> I use the term “patent people” to refer to those attorneys who have earned their stripes as patent specialists through the act of having spent a significant amount of time practicing patent law, as opposed to “patent attorneys,” a term applicable only to those who have passed the patent bar. See U.S. PATENT & TRADEMARK OFFICE, GENERAL REQUIREMENTS BULLETIN FOR ADMISSION TO THE EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE 1 (2015), [http://www.uspto.gov/sites/default/files/OED\\_GRB.pdf](http://www.uspto.gov/sites/default/files/OED_GRB.pdf) [<https://perma.cc/N6TX-PERX>] (last visited Feb. 12, 2016). Professor Rai refers to patent people as “patent insiders.” See Arti K. Rai, *Competing with the “Patent Court”: A Newly Robust Ecosystem*, 13 CHL.-KENT J. INTELL. PROP. 386, 387 (2014).

most patent outsiders agree, there is just something unique—something special—about patent law. The belief in patent law's exceptionalism manifests itself as two related presumptions applicable to the judiciary: first, that generalist judges who do not have patent law expertise cannot effectively decide patent cases, and second, that judges can develop necessary patent expertise through experience with patent law.<sup>2</sup> Congress showed that it subscribed to both views when it instituted two judicial experiments: first, when it created the Federal Circuit and mandated that almost all patent appeals be directed to that entity, and then again when it created the Patent Pilot Program, through which certain district court judges would be designated to hear more patent cases.<sup>3</sup> The premises underlying those experiments, and the resulting trend toward specialization of patent law, have largely been unchallenged, as even outspoken critics of the specialization of courts have generally agreed that in “complex areas” such as patent law, it may be useful to have specialized adjudication.<sup>4</sup> Recently, however, both the specialization trend and the assumptions upon which it was based have hit a formidable roadblock: the Supreme Court.

While commentators have described the Federal Circuit as “the Supreme Court of patent law,”<sup>5</sup> it has lately become clear that the Supreme Court very much intends to remain supreme with respect to patent law as much as any legal discipline. Unlike the other bodies that deal with patents, the Supreme Court is the one body that Congress is unable to specialize, and it remains composed entirely of generalist judges. Perhaps unsurprisingly, there is significant tension between the highest court and the Federal Circuit. In recent years, the Supreme Court has repeatedly chastised the “patent court” for its overly specialized treatment of patent law and directed that patent law be treated more like other areas of law. The message from the highest court is clear: patent law is not so special.<sup>6</sup> In sending that message, the Court has also sent a second, largely unheard missive: in contrast to the widespread view

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<sup>2</sup> See *infra* Part I.

<sup>3</sup> See *infra* Sections I.A., I.B.

<sup>4</sup> See *infra* note 38.

<sup>5</sup> See *infra* Section I.A.

<sup>6</sup> See *infra* Section II.A.

that non-specialist judges cannot effectively conduct patent cases, the Court's view is that patent law expertise is not necessary to adjudicate patent appeals.<sup>7</sup> Because the Court believes that the law applicable to patents requires no special expertise, the Court has no reason to defer to the judgment of judges whose claims to patent law expertise are based upon repeated exposure to that area of law. Accordingly, the modern Court no longer affords deference to the Federal Circuit based upon its purported patent law expertise.

But just because the Supreme Court does not think patent law is special does not mean the Court does not think there is something special about patent cases. At the same time that the Supreme Court has decried the attempted specialization of patent law, it has lamented its own and other courts' general inability to grasp the nuances of the scientific disciplines that are so often the subject matter of patent cases. As many jurists have noted previously, what is special about patent cases is not the law, but the subject matter underlying patent disputes.<sup>8</sup>

While there have been many previous proposals to deal with the difficult subject matter involved in patent cases, they generally run into the same problems the Court has identified with Congress's previous specialization efforts. Some proposals focus upon the development of legal—rather than technical—expertise, thereby running up against the Court's recent declarations about the lack of need for specialization of that type. Most proposals also involve attempt to specialize the judiciary. As commentators have long noted, the creation of specialized courts leads to certain problems, perhaps inevitably. Accordingly, proposals to specialize the patent judiciary suffer from the same concerns applicable to Congress's efforts to specialize patent law by creating the Federal Circuit and the Patent Pilot Program.

This Article explains why any need for specialization related to patent cases is best achieved at the administrative level and describes one viable solution that has already been implemented. Unlike Congress's moves to specialize patent law by specializing the judiciary, the recent move to specialize patent law by injecting

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<sup>7</sup> See *infra* Section II.B.

<sup>8</sup> See *infra* Part III.

more substantive expertise at the executive agency level will likely be unobjectionable to the Court. The creation of the Patent and Trademark Appeals Board (“PTAB”) and the decision to shift certain issues to that forum, is a form of specialization based upon the difficult technology underlying patent cases, rather than the law. This Article suggests expanding that experiment by making the PTAB the exclusive forum for challenging patent validity. Unlike Congress’s other specialization efforts, in creating the PTAB, Congress has produced a specialized body of administrators who understand the science and technological issues that are often so difficult for judges to grasp, and has focused that expertise where it is most needed: issues of patent validity.

Part I of this Article reviews the congressional efforts to specialize the patent judiciary. Part II explores the tension between those efforts and the Supreme Court, explains why the Supreme Court will not defer to the “Patent Expert” Federal Circuit, and addresses the Court’s realization that the difficult portion part of patent cases is their underlying science and technology. Part III explores previous proposals to inject technical expertise into the judiciary, and why such proposals are unlikely to resolve what ails patent law. Part IV explains why Congress’s creation of the PTAB fulfills many of the aspirations of earlier proposals to create an expert patent court without suffering from the downsides inherent in a specialized patent judiciary, and proposes making the PTAB the exclusive forum for patent validity disputes.

## I. THE SPECIALIZATION OF THE PATENT JUDICIARY

Congress’s modern attempts to specialize patent law began, in 1982, at the appellate level with the creation of the Court of Appeals for the Federal Circuit, a single appellate body to consider all patent appeals.<sup>9</sup> More recently, in 2011, Congress created a Patent Pilot Program (“PPP”) to specialize patent adjudication at the trial level.<sup>10</sup> This Part describes what led to those developments specifi-

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<sup>9</sup> See Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (codified as amended in scattered sections of 28 U.S.C.)

<sup>10</sup> See Pilot Program in Certain District Courts, Pub. L. No. 111-349, 124 Stat. 3674 (2011).

cally while also considering the benefits and costs of judicial specialization more generally.

#### A. *The Federal Circuit*

Historically, there was no expectation that judges in any court either be specialists in a particular area of law or have any particular subject-matter expertise in the areas in which they judge.<sup>11</sup> Rather, judges in the American system have been selected to be generalists, and to sit on generalist courts.<sup>12</sup> Instead of requiring any expertise among the judiciary, the federal judges on the ninety-eight U.S. district courts, the twelve regional courts of appeals, and the Supreme Court, were each appointed based largely upon their general ability as lawyers, and those courts' jurisdiction defined by geography.<sup>13</sup> Those judges were called upon, and assumed to be able, to decide any area of law.<sup>14</sup> In 1961, Judge Henry Friendly sounded a clarion call for change from that status quo, opining:

[W]hereas it was not unreasonable to expect a judge to be truly learned in a body of law that Blackstone compressed into 2400 pages, it is altogether absurd to expect any single judge to vie with an assemblage of law professors in the gamut of subjects, ranging from accounting, administrative law and admiralty to water rights, wills and world law, that may come before his court.<sup>15</sup>

<sup>11</sup> See Diane P. Wood, *Speech, Generalist Judges in a Specialized World*, 50 SMU. L. REV. 1755, 1755-56 (1997).

<sup>12</sup> See, e.g., Guido Calabresi, *The Current, Subtle—and Not So Subtle—Rejection of an Independent Judiciary*, 4 U. PA. J. CONST. L. 637, 639 (2002) (“Judges are generalists who deal with a variety of matters and there are very good reasons why they should do so.”); see generally Edward K. Cheng, *The Myth of the Generalist Judge*, 61 STAN. L. REV. 519 (2008).

<sup>13</sup> See Cheng, *supra* note 12, at 522.

<sup>14</sup> See John M. Walker, Jr., *Comments on Professionalism*, 2 J. INST. FOR STUDY LEGAL ETHICS 111, 113-14 (1999) (“[J]udges should be generalists. Judges should be able to deal with all kinds of cases as we must do under the federal system. We ought to be able to handle different cases with equal skill. We ought to have the judgment to discern when good arguments are being made and when bad arguments are being made.”).

<sup>15</sup> Henry Friendly, *Reactions of a Lawyer—Newly Become Judge*, 71 YALE L.J. 218, 220 (1961).



In an attempt to address the problem he identified, academics began to discuss the costs and benefits of creating specialized courts.<sup>16</sup>

There are numerous hypothesized benefits of the specialization of courts. First, it has been suggested that when a single forum decides all of the cases in a particular area of the law, those decisions should become more uniform over time, thus creating stability within that area of the law.<sup>17</sup> A second, related, benefit of specialization is increased efficiency. The concept is that by assigning certain cases to a specialized court, the caseloads for judges on other courts who no longer need to consider those cases will be reduced.<sup>18</sup> The third benefit most often cited by advocates of the creation of specialized courts is the development of expertise. Succinctly put, the notion is that judges who sit upon specialized courts, and who therefore repeatedly deal in the same area of the law, will become more adept at applying that area of the law.<sup>19</sup> The resulting development of legal expertise, the theory goes, will lead to both increased efficiency, reflected as more rapid resolution of cases by the judges on that court, as well as increased accuracy of the decisions.<sup>20</sup> Both the expertise and efficiency benefits of specialization are thought to be especially impactful when the cases considered by a specialized court are complex or time-consuming.<sup>21</sup>

The critics of judicial specialization, often generalist judges, have expressed a number of concerns about specialization. Judge

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<sup>16</sup> Some particularly pertinent works in the vast literature about the costs and benefits of specialization include: Lawrence Baum, *Probing the Effects of Judicial Specialization*, 58 DUKE L.J. 1667 (2009); Rochelle Cooper Dreyfuss, *Specialized Adjudication*, 1990 BYU L. REV. 377 (1990); Ellen R. Jordan, *Specialized Courts: A Choice?*, 76 NW. U. L. REV. 745 (1981); Richard L. Revesz, *Specialized Courts and the Administrative Lawmaking System*, 138 U. PA. L. REV. 1111 (1990).

<sup>17</sup> See Paul Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 GEO. L.J. 1437, 1447 (2012) (reviewing the benefits proposed by others).

<sup>18</sup> Baum, *supra* note 16, at 1675.

<sup>19</sup> *Id.* at 1676.

<sup>20</sup> Gugliuzza, *supra* note 17, at 1447. Professor Baum describes these benefits as “efficiency, expertise, and uniformity.” Baum, *supra* note 16, at 1675. Professor Dreyfuss categorizes the same benefits into “efficiency reasons” and “administrative reasons.” Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 1 (1989). Regardless of how they are characterized, the posited benefits of specialization are largely the same.

<sup>21</sup> Gugliuzza, *supra* note 17, at 1447.

Richard Posner warns that specialized courts might not be able to attract highly qualified judges, that specialist judges might be susceptible to capture by the bar that regularly practices before them, and that they might be overly sympathetic to the policies furthered by the law they administer.<sup>22</sup> Specifically addressing the potential creation of a court focused upon patent law, Judge Simon Rifkind warned that a specialized patent court might lead to tunnel vision—an inability to see the big picture that results in decisions in conflict with the general body of law—a problem that would prove to be prophetic.<sup>23</sup>

Against this backdrop, and weighing those pros and cons, Congress initiated an experiment with a permanent specialized court at the appellate level and created the Federal Circuit.<sup>24</sup> By saying that the Federal Circuit is a “specialist” or “specialized” court, I mean simply that the court’s jurisdiction is limited by subject matter,<sup>25</sup> and that as a result, the court hears a disproportionate number of a particular type of case than other courts.<sup>26</sup> Federal Circuit Senior Judge Jay Plager insists that the Federal Circuit is not a specialist court because the judges on the court hear many different types of

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<sup>22</sup> See RICHARD A. POSNER, *THE FEDERAL COURTS: CHALLENGE AND REFORM* 254 (1996); see also Dreyfuss, *supra* note 20, at 3.

<sup>23</sup> See Simon Rifkind, *A Special Court for Patent Litigation? The Danger of a Specialized Judiciary*, 37 A.B.A. J. 425 (1951); see also Dreyfuss, *supra* note 20, at 3 (“Even with the best motives, a court’s doctrinal isolation may lead to a body of law out of tune with legal developments elsewhere.”); Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 396–97 (2001); S. Jay Plager, *The United States Court of Appeals, The Federal Circuit, and the Non-Regional Subject Matter Concept: Reflections on the Search for a Model*, 39 AM. U. L. REV. 853, 858–59 (1990) (“The concern is that as the range of cases narrows, the opportunities to see the big picture, or even parts of it, may narrow as well.”).

<sup>24</sup> See Dreyfuss, *supra* note 20, at 3–4 (reviewing the history of the creation of the Federal Circuit, including Congress’s motivation to do so and balancing of these concerns). The D.C. Circuit is also, in part, a specialized court, as that court decides many specialized areas of administrative law that are not decided by the other regional courts of appeal.

<sup>25</sup> See Cheng, *supra* note 12, at 526.

<sup>26</sup> This understanding of the term “specialized” is not new. See, e.g., LeRoy L. Kondo, *Untangling the Tangled Web: Federal Court Reform Through Specialization for Internet Law and Other High Technology Cases*, UCLA J.L. & TECH. 1, 10 n.32 (2002) (“Judges will be referred to as ‘specialized’ if they have professional or in depth on-the-bench training in a particular subject matter of cases or controversies (e.g., drug court ‘specialist’ judges), acquired through significant focused exposure to cases in one area of law.”).

cases and not solely patent appeals.<sup>27</sup> While it is true that the court considers some additional categories of cases, that only means that the court is not *solely* a specialist patent court. There is nothing to say that one cannot be a specialist in more than one thing. After all, Leonardo de Vinci was a specialist in both sculpture and mechanics. In the sense I mean, the Federal Circuit is a specialist patent court as well as a specialist in veterans law, government personnel, and federal contract law.<sup>28</sup>

Of the subject areas that the Federal Circuit considers, patent law was the subject matter Congress had in mind when it conceived the court, and the promise that a specialized court would result in patent law becoming more uniform was the primary impetus for its creation.<sup>29</sup> At the time, patent law was suffering from a fragmentation problem that specialization was thought to rectify.<sup>30</sup> Before the Federal Circuit's creation, a different version of patent law applied depending upon which circuit a litigant was in, with the result that forum shopping was rampant and inventors could not predict whether their patents would be enforced or struck down as invalid.<sup>31</sup> The creation of a single, specialized court was intended to stabilize the law and make it uniform across the country.<sup>32</sup> As the first Chief Judge of the Federal Circuit, Howard Markey, explained: "The challenge to the court and its bar is to create and

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<sup>27</sup> See S. Jay Plager, *The Price of Popularity: The Court of Appeals for the Federal Circuit 2007*, 56 AM. U. L. REV. 751, 754 (2007); S. Jay Plager & Lynne E. Pettigrew, *Rethinking Patent Law's Uniformity Principle: A Response to Nard and Duffy*, 101 NW. U. L. REV. 1735 (2007). Judge Plager also notes that a court could be considered specialized if the "background and training of the judges who make up the court" were uniform, a condition he points out is not met for the Federal Circuit. Plager, *supra*, at 754. Judge Plager is correct that there is nothing specialized about the judges' backgrounds. See *infra* note 48 and accompanying text.

<sup>28</sup> See Gugliuzza, *supra* note 17, at 1461-62 (describing the other aspects of the Federal Circuit's jurisdiction).

<sup>29</sup> See H.R. REP. NO. 97-312, at 23 (1981) ("[T]he central purpose is to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law."); see also *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574 (Fed. Cir. 1984) ("It is, therefore, clear that one of the primary objectives of our enabling legislation is to bring about uniformity in the area of patent law.").

<sup>30</sup> See Dreyfuss, *supra* note 20, at 6-7.

<sup>31</sup> See *id.*

<sup>32</sup> See *id.*; see also Plager, *supra* note 23, at 854-55 ("The impetus behind the establishment of the Federal Circuit was the desire to bring about greater uniformity and coherency in federal decisional law in the areas assigned to the court.").

maintain a uniform, reliable, predictable, nationally-applicable body of law.”<sup>33</sup>

There were also some secondary considerations. For example, many have noted that the court was charged with strengthening patent law, or at least being sympathetic to the policies underlying the patent system.<sup>34</sup> In addition, as noted by proponents of specialization, the creation of a single court to consider patent appeals would remove any tendency of litigants to forum-shop, a problem that was perceived as particularly egregious in patent cases because of differences in the law in the different circuits.<sup>35</sup> Putting patent cases in a separate court would also solve another problem Congress wanted to address. Patent cases were thought to be particularly time-consuming for the regional appellate courts, and Congress was trying to find a way to reduce the caseloads for those courts.<sup>36</sup> To combat the potential dangers of specialization, especially the problem of capture by a specialized bar, Congress gave the court jurisdiction over a number of other types of subject matter in addition to patent law.<sup>37</sup> While there was not, and indeed still

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<sup>33</sup> Howard T. Markey, *The Court of Appeals for the Federal Circuit: Challenge and Opportunity*, 34 AM. U. L. REV. 595 (1985); see also Paul Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1798 (2013) (“Congress gave the Federal Circuit a clear mandate to bring uniformity to patent law. . . .”) (citing H.R. REP. NO. 97-312, at 20–23; S. REP. NO. 97-275, at 5–6 (19810)).

<sup>34</sup> See, e.g., Paul Gugliuzza, *Saving the Federal Circuit*, 13 CHI.-KENT J. INTELL. PROP. 350 (2014); Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900–2000*, 88 CALIF. L. REV. 2187, 2224 (2000) (“[T]he creation of the Federal Circuit had a clear substantive agenda: to strengthen patents.”). Some see this as a weakness of the court. See, e.g., Richard A. Posner, *Will the Federal Courts of Appeals Survive Until 1984? An Essay on Delegation and Specialization of the Judicial Function*, 56 S. CAL. L. REV. 761, 785 (1983) (“Specialists are more likely than generalists to identify with the goals of a government program, since the program is the focus of their career. They may therefore see their function as one of enforcing the law in a vigorous rather than a tempered fashion. In this respect the case for a generalist federal judiciary resembles the case for the jury not despite, but because of, its lack of expertness.”).

<sup>35</sup> See *Holmes Grp. v. Vornado Air Circulation Sys.*, 535 U.S. 826, 840 (2002) (Ginsburg, J., concurring) (“At that appellate level, Congress sought to eliminate forum shopping and to advance uniformity in the interpretation and application of federal patent law.”); see also Dreyfuss, *supra* note 16, at 378.

<sup>36</sup> See Dreyfuss, *supra* note 20, at 2.

<sup>37</sup> See Jay P. Kesan & Gwendolyn G. Ball, *Judicial Experience and the Efficiency and Accuracy of Patent Adjudication: An Empirical Analysis of the Case for A Specialized Patent Trial Court*, 24 HARV. J.L. & TECH. 393, 410 (2011). For a discussion of the other areas within the court’s jurisdiction, see generally Gugliuzza, *supra* note 17.

is not, agreement that specialization of courts is ever an ideal arrangement, there is widespread agreement that whatever benefits there are to a specialized court are especially pronounced in “complex areas” such as patent law.<sup>38</sup> As nearly everyone seems to agree that patent cases are both time-consuming and complex, patent law was thus considered an appropriate, perhaps even ideal, subject matter for an experiment in specialization.<sup>39</sup>

Another consideration in the creation of the Federal Circuit, and the one in which this Article is most interested, is that Congress believed it was creating a court with particular expertise.<sup>40</sup> As Judge Markey colorfully suggested to Congress during hearings about the creation of the Federal Circuit: “[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, or a number of them, than someone who does brain surgery once every couple of years.”<sup>41</sup>

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<sup>38</sup> See Erwin Chemerinsky, *Decision-Makers: In Defense of Courts*, 71 AM. BANKR. L.J. 109, 115 (1997) (“Especially in highly complex areas, a specialized court allows recruitment of judges who have specific background in the field and permits individuals on the bench to develop expertise.”); Sarang Vijay Damle, *Specialize the Judge, Not the Court: A Lesson from the German Constitutional Court*, 91 VA. L. REV. 1267 (2005) (“[A] specialist judiciary will enhance the quality of decisions, especially in complex areas of the law.”); Kesan & Ball, *supra* note 37, at 401 (“A specialized court that allows judges to develop expertise—or judicial human capital—may thus be warranted for some complex areas of law.”); Revesz, *supra* note 16, at 1118 n.32 (“[C]ertain areas are so complex that it is inefficient for a generalist judge to learn about them.”).

<sup>39</sup> See Robin Feldman, *Coming of Age for the Federal Circuit*, 18 GREEN BAG 2D 27, 28 (2014) (“With complex scientific concepts and difficult code-like lingo, patent law is a territory in which few generalists dare to tread . . . .”); see also Dreyfuss, *supra* note 20, at 67 (“[B]oth patent law and the facts to which the law applies are technically abstruse.”); Sue Ann Ganske, *The U.S. Supreme Court Decides Six Patent Cases in 2014, Culminating in Alice Corp. v. CLS Bank International*, 23 TEX. INTELL. PROP. L.J. 183, 201 (2015) (describing patent law as a “complex area of law”); Kesan & Ball, *supra* note 37, at 401 (“[P]atent cases are generally considered to be complex.”); Darrell Issa, *Why I’m Pushing for the Patent Pilot Program*, LAW360 (Jan. 25, 2007), <http://www.law360.com/articles/17234/why-i-m-pushing-for-the-patent-pilot-program> [<https://perma.cc/5KGE-CXTG>] (“[P]atent law is absolutely one of the most complex areas of law.”).

<sup>40</sup> See S. REP. NO. 97-275, at 6 (1981), as reprinted in 198 U.S.C.C.A.N. 11, 16 (describing the court as providing “expertise in highly specialized and technical areas.”) (quoting statement of J. Jon O. Newman).

<sup>41</sup> *Court of Appeals for the Federal Circuit: Hearings Before the Subcomm. on Courts, Civil Liberties & the Admin. of Justice of the H. Comm. on the Judiciary*, 97th Cong. 42–43 (1981) (statement of the Hon. Howard T. Markey, C.J., Court of Customs and Patent Appeals);

Specialization of courts is not, of course, the same thing as specialization of judges, and one can imagine systems of centralized adjudication that do not involve specialist judges.<sup>42</sup> The doctrinal stability and uniformity goals underlying the creation of a specialized court could be accomplished by the mere fact that the decisions are made by a single group of judges, regardless of whether those judges have developed any particular subject-matter expertise. Thus, for the Federal Circuit's patent cases, Judge Friendly's notion of specialization of labor could be achieved regardless of whether the individuals on the court are "patent specialists." Indeed, in an early assessment of whether the Federal Circuit achieved Congress's goals, Professor Rochelle Dreyfuss recognized that "the benefits of specialization appear to lie primarily in giving the court the right mix of cases, not in giving the cases the right kind of judges."<sup>43</sup> As Daniel Meador has noted, the primary purpose of the creation of the Federal Circuit was "not to create a court of experts or specialists,"<sup>44</sup> and as Senior Judge Plager wrote, "[I]t does not follow that if a court specializes in one or more areas of the law, the judges appointed to the court should be specialists in those areas."<sup>45</sup>

Nonetheless, commentators routinely acquiesce in the notion that one of the primary benefits of specialization of the Federal Circuit is the development of patent expertise in the judges that sit upon that court, especially as contrasted with the regional appellate courts, which are thought unable to "generate accuracy because no single court heard enough patent cases to allow (or motivate) its judges to develop the kind of expertise required to develop a sophisticated body of law."<sup>46</sup> In 2008, Professor Dreyfuss explicitly

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*see also* Gugliuzza, *supra* note 33, at 1836 ("[A]nother reason Congress created the Federal Circuit was to provide expert adjudication in complex patent cases.").

<sup>42</sup> *See, e.g.*, Daniel J. Meador, *A Challenge to Judicial Architecture: Modifying the Regional Design of the U.S. Courts of Appeals*, 56 U. CHI. L. REV. 603 (1989) (proposing a rotating panel concept in which generalist judges would rotate through panels that hear only a specific subject matter over time).

<sup>43</sup> Dreyfuss, *supra* note 20, at 24.

<sup>44</sup> Meador, *supra* note 42, at 611–12.

<sup>45</sup> Plager, *supra* note 23, at 858.

<sup>46</sup> Dreyfuss, *supra* note 20, at 66; *see also* Gugliuzza, *supra* note 33, at 1836 ("[A]nother reason Congress created the Federal Circuit was to provide expert adjudication in complex patent cases."); Jeffrey W. Stempel, *Two Cheers for Specialization*, 61 BROOK. L.

called for the Federal Circuit to “press its position as a tribunal with special expertise and to fulfill its role as the near-final authority in patent matters.”<sup>47</sup> It is critical to recognize that the perception that the Federal Circuit is an expert tribunal derives from the notion that the judges develop “expertise” with respect to their patent docket only by virtue of having heard and decided a lot of patent cases; for the most part, the Federal Circuit judges do not have scientific or technical backgrounds.<sup>48</sup> Just like when Congress created the Federal Circuit, the prevailing notion is that simply hearing more of a particular type of case makes a judge an “expert.”<sup>49</sup> In the case of the Federal Circuit, there appears to be a virtual consensus among commentators that they are patent experts by virtue of hearing so many patent cases.<sup>50</sup> It is therefore not

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REV. 67 (1995) (advocating the use of specialized courts to consider issues “over which a generalist bench is unlikely to achieve sufficient expertise and efficiency under its normal caseload”).

<sup>47</sup> Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 823 (2008).

<sup>48</sup> Only seven out of the first thirty-four judges to sit on the Federal Circuit had technical backgrounds. See Dunstan H. Barnes, *Technically Speaking, Does it Matter? An Empirical Study Linking the Federal Circuit Judges' Technical Backgrounds to How They Analyze the Section 112 Enablement and Written Description Requirements*, 88 CHI.-KENT L. REV. 971 (2013). Of the most recent appointments since that publication, Judges Raymond Chen and Kara Stoll have technical backgrounds, while Judges Richard Taranto and Todd Hughes do not, making for a total of nine out of thirty-eight, or less than one-fourth of the judges who have ever sat upon the Federal Circuit with technical backgrounds. See *Judges*, U.S. CT. APPEALS FOR FED. CIR., <http://www.cafc.uscourts.gov/judges> [<https://perma.cc/VK2E-TJT6>] (last visited Feb. 13, 2016). Also, contrary to persistent misconceptions about the Federal Circuit, it is not the case that only Federal Circuit judges with significant patent experience consider patent cases. See, e.g., Ben Klemens, *The Rise of the Information Processing Patent*, 14 B.U. J. SCI. & TECH. L. 1, 16 (2008) (“Only a few judges on the [Federal Circuit] bench hear patent cases, and as is natural, most of those are former prominent patent attorneys.”). In fact, all of the court’s judges are randomly assigned cases from the court’s docket.

<sup>49</sup> See S. REP. NO. 97-275, at 6 (1981), as reprinted in 198 U.S.C.C.A.N. 11, 16.

<sup>50</sup> See Lawrence Baum, *Judicial Specialization and the Adjudication of Immigration Cases*, 59 DUKE L.J. 1501, 1538 (2010) (“Whether or not judges on a specialized court have prior experience in the field of their court’s work, they become specialists once they begin their judicial service.”); Rochelle Cooper Dreyfuss, *The Federal Circuit: A Continuing Experiment in Specialization*, 54 CASE W. RES. L. REV. 769, 770 (2004) (“[S]pecialization can foster expertise, leading to more accurate and efficient decisionmaking.”) [hereinafter Dreyfuss, *A Continuing Experiment*]; William K. Ford, *Judging Expertise in Copyright Law*, 14 J. INTEL. PROP. L. 1, 3 (2006) (“Specialized courts allow judges to gain experience and therefore develop expertise.”); Sapna Kumar, *Expert Court, Expert Agency*, 44 U.C. DAVIS

surprising that in Congress's next step toward specializing patent law, Congress specifically moved to specialize not the courts, but the judges themselves, this time at the district court level.<sup>51</sup>

### B. *The Patent Pilot Program*

After the Federal Circuit's creation, commentators began to complain about the high rate at which that court was reversing patent decisions of the federal district courts, particularly reversals of the meaning of terms in patent claims, known as claim construction.<sup>52</sup> In a series of studies, researchers had demonstrated persistently high reversal rates of nearly a third of cases.<sup>53</sup> To many, that reversal rate was unacceptable, and demonstrated a need to fix

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L. REV. 1547, 1549 (2011) ("Because about one-third of the Federal Circuit's docket is comprised of patent-related cases, the judges of the court have developed broad expertise in patent law."); Daniel J. Meador, *Reducing Court Costs and Delay: An Appellate Court Dilemma and a Solution Through Subject Matter Organization*, 16 U. MICH. J.L. REFORM 471, 482 (1983) (arguing that specialization "improves decision making because each judge can achieve a higher level of expertise on the subjects with which he is regularly dealing"); John B. Pegram, *Should There Be a U.S. Trial Court with a Specialization in Patent Litigation?*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 766, 788 (2000) ("Clearly, the Federal Circuit has developed patent expertise of a higher average level than that previously found in the regional circuits, as a result to deciding over 200 patent appeals per year."); Michael E. Solimine, *The Fall and Rise of Specialized Federal Constitutional Courts*, 17 U. PA. J. CONST. L. 115, 121 (2014) ("[J]udges in those courts are presumably experts and can be counted on to apply and develop the law more coherently on a particular topic."). Indeed, the notion that the Federal Circuit judges are experts in patent law is so widespread that Professor Bock has described the Federal Circuit as suffering from "the curse of expertise." Jeremy W. Bock, *Restructuring the Federal Circuit*, 3 N.Y.U. J. INTELL. PROP. & ENT. L. 197, 204 (2014). It has also been noted that "the court also has a very firm belief in its own expertise." Rochelle C. Dreyfuss, *Abolishing Exclusive Jurisdiction in the Federal Circuit: A Response to Judge Wood*, 13 CHI-KENT J. INTELL. PROP. 327, 342 (2014) [hereinafter Dreyfuss, *Abolishing Exclusive Jurisdiction*]. The court's view of itself as an expert patent court is well demonstrated by *Midwest v. Karavan*. See *Midwest Indus. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 61 (Fed. Cir. 1999) ("[W]e think that as the sole appellate exponent of patent law principles this court should play a leading role in fashioning the rules specifying what patent law does and does not foreclose by way of other legal remedies.").

<sup>51</sup> See *supra* note 10 and accompanying text.

<sup>52</sup> See Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases*, 12 FED. CIR. B.J. 1, 32 (2002); see generally J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 NW. U.L. REV. 1 (2013) (discussing the history of claim construction).

<sup>53</sup> See Anderson & Menell, *supra* note 52, at 33 (collecting and analyzing the empirical studies of claim construction reversal rates).



what was thought to be a broken system.<sup>54</sup> Commentators began to question whether the trial court judges, who often do not have much experience with patent cases, could successfully perform claim construction as they manage the few patent cases assigned to them.<sup>55</sup> The general view is probably well captured by Professor Dreyfuss's assertion that "[a] trial judge who has never read a technical document before is less likely to interpret it correctly, no matter how many expert witnesses are called to testify, than an appellate judge who has extensive experience in dealing with such matters."<sup>56</sup> The prevailing dogma was that district court judges could not effectively handle patent cases.<sup>57</sup>

Among those asserting that district court judges lacked the ability to decide issues of patent law is former Federal Circuit Judge Richard Linn, who proposed, as a solution to district court judges' allegedly poor performance, that the Federal Circuit might sponsor "judicial training programs, hosting judicial seminars, or facilitating the exchange of effective practices in patent cases among trial judges."<sup>58</sup> But as some commentators, including then-professor, now-Federal Circuit judge, Moore suggested, if patent law expertise is acquired by lots of experience, "it seems unlikely that district court judges will have sufficient exposure to patent cases . . . to improve at construing patent claim terms."<sup>59</sup> Accordingly, those who believe that experience deciding patent cases will improve the

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<sup>54</sup> See *id.* at 33–34 (collecting and describing those viewpoints). But see Jeffrey A. Lefstin, *Claim Construction, Appeal, and the Predictability of Interpretive Regimes*, 61 U. MIAMI L. REV. 1033, 1038–39 (2007) (asserting that claim construction reversal rates were not substantially higher than reversal rates in other complex litigation).

<sup>55</sup> See Moore, *supra* note 52, at 19 ("[T]he frequency with which the Federal Circuit judges are construing claims suggests that these judges are developing expertise at the task that will increase their ability to perform it accurately. While individual district court judges construe only a handful of patent claim terms, the Federal Circuit judges perform this task with great frequency.").

<sup>56</sup> Dreyfuss, *supra* note 20, at 48.

<sup>57</sup> See Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 N.C. L. REV. 889, 934 (2001); see also Dreyfuss, *supra* note 47, at 805.

<sup>58</sup> Richard Linn, *The Future Role of the United States Court of Appeals for the Federal Circuit Now that It Has Turned 21*, 53 AM. U. L. REV. 731, 737 (2004).

<sup>59</sup> Moore, *supra* note 52, at 30; see also Pegram, *supra* note 50, at 788 ("U.S. federal district judges on average have insufficient exposure to patent litigation to develop expertise in patent law and patent litigation.").

performance of district court judges have generally suggested the creation of a specialized patent trial court.<sup>60</sup> Advocates of the specialization of courts have noted that the purported benefits to patent law resulting from increased expertise at the Federal Circuit would be even greater at the trial court level, asserting that “[d]espite the creation of a specialized appellate court and the concomitant benefits to patent adjudication, there is reason to believe that the complexity of patent litigation justifies specialization at the trial court level as well.”<sup>61</sup>

Responsive to these suggestions and in an effort to increase the expertise of the judges who decide patent cases at the trial level, Congress created the PPP<sup>62</sup> with the express purpose of “the creation of a patent specialists’ pilot program at the U.S. district court level, which is intended to improve the adjudication of patent disputes.”<sup>63</sup> As Congressman Darrell Issa—who first proposed the PPP—opined, “[N]ot all judges have the interest or expertise to handle complex patent litigation.”<sup>64</sup> The goal, therefore, is to divert patent cases to those judges who express an interest in patent law, in the hopes that those judges will thereby develop patent law expertise as a result.<sup>65</sup> By adopting the PPP, Congress acquiesced in the perceptions that (1) deciding more patent cases will lead to patent law expertise, and (2) that expertise will lead to different, presumptively better, outcomes.<sup>66</sup>

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<sup>60</sup> See Donna M. Gitter, *Should the United States Designate Specialist Patent Trial Judges? An Empirical Analysis of H.R. 628 in Light of the English Experience and the Work of Professor Moore*, 10 COLUM. SCI. & TECH. L. REV. 169, 172 (2009); Moore, *supra* note 57, at 932 (“[A] specialized tribunal would develop expertise in patent law and the resolution of patent cases, increasing its accuracy and efficiency at resolving these cases.”); John B. Pegram, *Should the U.S. Court of International Trade Be Given Patent Jurisdiction Concurrent with That of the District Courts?*, 32 HOUS. L. REV. 67, 71–72 (1995); Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1035 (2003); Arti K. Rai, *Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH L.J. 877, 877 (2002) [hereinafter Rai, *Specialized Trial Courts*].

<sup>61</sup> Kesan & Ball, *supra* note 37, at 414; see also Pegram, *supra* note 50, at 767.

<sup>62</sup> See *supra* note 10 and accompanying text.

<sup>63</sup> H.R. REP. NO. 109-673, at 3 (2006).

<sup>64</sup> Issa, *supra* note 39.

<sup>65</sup> *Id.*

<sup>66</sup> See Dreyfuss, *Abolishing Exclusive Jurisdiction*, *supra* note 50, at 329 (“[T]he judges participating in the [patent pilot] program will likely develop special expertise in local

The view that non-specialist judges cannot effectively conduct patent cases continues to be widespread. In 2010, Professor Dreyfuss maintained that the Federal Circuit, due to its having developed patent law expertise, has a comparative advantage with respect to understanding the facts in patent cases versus both other courts of appeals and trial judges.<sup>67</sup> With respect to trial judges, she asserts that “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.”<sup>68</sup> In another recent article that explores the tension between law and science, Peter Lee begins with the premise that generalist judges “lack the capacity to administer” patent law.<sup>69</sup> That view also extends to the generalist judges who sit on the Supreme Court. As John Golden has opined, comparing the Supreme Court to the Federal Circuit: “The Supreme Court lacks such expertise and has typically demonstrated little in the way of generalist legal craft that can add significant value to the resolution of such substantive questions.”<sup>70</sup> In short, the bulk of the commentary related to patent law, mostly written by “patent people,” continues to assert that “patent people” make better patent law judges.<sup>71</sup> As explored in the next Section, the Supreme Court has not taken kindly to that viewpoint.

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technologies and gain unique perspectives on the problems these industries encounter.”); Adam Shartzter, *Patent Litigation 101: Empirical Support for the Patent Pilot Program’s Solution to Increase Judicial Experience in Patent Law*, 18 FED. CIR. B.J. 191, 194 (2009) (“Judges that are more familiar with patent law will theoretically make better decisions that hold up on appeal to the Federal Circuit.”); Nancy Olson, Comment, *Does Practice Make Perfect? An Examination of Congress’s Proposed District Court Patent Pilot Program*, 55 UCLA L. REV. 745, 751, 762–71 (2008); Issa, *supra* note 39.

<sup>67</sup> See Rochelle Cooper Dreyfuss, *What the Federal Circuit Can Learn from the Supreme Court and Vice Versa*, 59 AM. U. L. REV. 787, 797 (2010).

<sup>68</sup> *Id.*

<sup>69</sup> Peter Lee, *Patent Law and the Two Cultures*, 120 YALE L.J. 2, 6 (2010) (noting that his article “proceeds on the premise that no matter how elegantly policymakers craft patent law, if generalist judges lack the capacity to administer it, the patent system cannot fulfill its objectives”).

<sup>70</sup> John M. Golden, *The Supreme Court as “Prime Percolator”*: A Prescription for Appellate Review of Questions in Patent Law, 56 UCLA L. REV. 657, 660 (2009); see also Lee, *supra* note 69, at 73 (“[S]keptics might doubt the technical competence of the Supreme Court to fully grapple with patent doctrine.”).

<sup>71</sup> See Golden, *supra* note 70, at 660.

## II. THE SUPREME COURT'S RE-ENTRY INTO PATENT LAW

After the creation of the Federal Circuit, the Supreme Court largely left that court to its own devices,<sup>72</sup> an inattention that led to the Federal Circuit being referred to as “the de facto supreme court of patents.”<sup>73</sup> During the decade from 1992–2002, the Court began to hear a few more patent cases, primarily those involving “procedural, jurisdictional, and structural issues rather than substantive patent law.”<sup>74</sup> The relationship between the Federal Circuit and Supreme Court was such that Mark Janis suggested, “Neither the time, temperament, nor resources of the Supreme Court will allow for the implementation of an interventionist approach to patent decision making.”<sup>75</sup> John Duffy described the sporadic attention given by the Supreme Court to patent law during that time period as “a sign not of the Federal Circuit’s failure as a specialized court, but of its great success.”<sup>76</sup> The general view of commentators at the time is well expressed by LeRoy Kondo, who wrote in 2002 that “[o]ver the past quarter century, the U.S. Supreme Court has implicitly given the Federal Circuit its ‘vote of confidence’ in resolving complex technological issues by rarely granting certiorari to hear patent or trademark cases.”<sup>77</sup>

Since 2002, the Court has taken a more active interest in patent law. No longer focusing solely upon procedural issues, the Court began “to dive into the heart of patent law,” as it considered issues “related to the core aspects of patent law.”<sup>78</sup> The Court’s interest in patent law appears to have peaked, so far, during the 2013–2014

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<sup>72</sup> See John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 277 (2002) (describing the history of the Supreme Court’s review of Federal Circuit decisions).

<sup>73</sup> Janis, *supra* note 23, at 387.

<sup>74</sup> Lee, *supra* note 69, at 43; see also Timothy R. Holbrook, *The Supreme Court’s Complicity in Federal Circuit Formalism*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 6 (2003) (“[M]any of the patent cases taken by the Supreme Court are ‘patent cases’ only in the sense that they involve a patent; rarely do they involve substantive patent law.”).

<sup>75</sup> Janis, *supra* note 23, at 395.

<sup>76</sup> Duffy, *supra* note 72, at 284.

<sup>77</sup> Kondo, *supra* note 26, at 18.

<sup>78</sup> Timothy R. Holbrook, *The Return of the Supreme Court to Patent Law*, 1 AKRON INTELL. PROP. J. 1, 2, 25 (2007).

term, when it issued decisions in six patent cases, the most issued in a single term since the creation of the Federal Circuit.<sup>79</sup>

This return of the Supreme Court to patent law has garnered considerable attention, with few describing the courts' recent relationship as cheerfully today as commentators did a decade ago.<sup>80</sup> In contrast to the Court's early foray into patent law, the Court's recent decisions reflect apparent frustration with the Federal Circuit. Some have described the Court's treatment of the Federal Circuit as "disdainful,"<sup>81</sup> whereas even those more hopeful about the two courts' relationship consider the treatment "somewhat bewildering."<sup>82</sup> In addition to reviewing an increasing number of patent cases, the Court has also nearly consistently reversed the Federal Circuit, and has almost always done so unanimously.<sup>83</sup> It is fair to say that the Supreme Court has recently issued a "startlingly strong rebuke of Federal Circuit jurisprudence."<sup>84</sup>

Why the Court has so aggressively stepped in to overturn the Federal Circuit's patent law jurisprudence is the subject of much

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<sup>79</sup> See Kevin R. Casey & Kevin B. Anderson, *The Supreme Court's Six-Pack of Cases*, 27 INTELL. PROP. & TECH. L.J. 9, 9 (2015).

<sup>80</sup> See, e.g., Rebecca S. Eisenberg, *The Supreme Court and the Federal Circuit: Visitation and Custody of Patent Law*, 106 MICH. L. REV. FIRST IMPRESSIONS 28, 28 (2007); Lucas S. Osborn, *Instrumentalism at the Federal Circuit*, 56 ST. LOUIS U. L.J. 419, 419 (2012).

<sup>81</sup> Gretchen S. Sween, *Who's Your Daddy? A Psychoanalytic Exegesis of the Supreme Court's Recent Patent Jurisprudence*, 7 NW. J. TECH. & INTELL. PROP. 204, 204-05 (2009). *But see* Dreyfuss, *supra* note 67, at 793 ("[H]eighted review should not be taken as a criticism of the Federal Circuit.").

<sup>82</sup> Dreyfuss, *supra* note 47, at 808; *see also* Plager, *supra* note 27, at 757 ("[C]uriously . . . the Supreme Court in several other recent cases has inserted itself into the operational aspects of patent law.").

<sup>83</sup> See Dreyfuss, *supra* note 67, at 792 (noting that the Supreme Court "has reversed, vacated, or questioned nearly every" Federal Circuit decision it has reviewed); Gary M. Hoffman & Robert L. Kinder, *Supreme Court Review of Federal Circuit Patent Cases—Placing the Recent Scrutiny in Context and Determining If It Will Continue*, 20 DEPAUL J. ART TECH. & INTELL. PROP. L. 227, 227 (2010) ("[N]early every Federal Circuit patent case to reach the Supreme Court in the past decade has been reversed or vacated in some form.").

<sup>84</sup> Feldman, *supra* note 39, at 31. *But see* Hoffman & Kinder, *supra* note 83, at 229 (asserting that the Court's recent involvement in patent policy is "relatively minor when compared to other eras of Supreme Court review"). According to those commentators, in the grand scheme of things, the Court's "true objective may be a slight adjustment by the high Court, consistent with and reminiscent of philosophies past." Hoffman & Kinder, *supra* note 83, at 228.

scholarly discussion.<sup>85</sup> For some, it looks like the gist of what the Court is doing is attempting to reduce patent rights.<sup>86</sup> While the Federal Circuit is largely seen as being a pro-patentee court, the Supreme Court's involvement has been described as an attempt to level the playing field, and especially to combat the perceived problem created by so-called "patent trolls," firms that assert patent rights but do not produce any goods or services themselves.<sup>87</sup> For others, the explanation for the Court's recent foray into patent law is that the Court has been "systematically favoring holistic standards over formalistic, bright-line rules,"<sup>88</sup> a shift that has been criticized by some,<sup>89</sup> and praised by others.<sup>90</sup> Yet another interpretation is that the Court's patent decisions are an admonition of the Federal Circuit's decision-making process generally and "are messages about coming into the fold of careful and precise legal decision-making."<sup>91</sup> Thus, one proposed solution to the Federal Circuit's Supreme Court dilemma is more careful drafting of its legal decisions.<sup>92</sup>

While I agree that the Court is admonishing the Federal Circuit's decision-making, I believe the explanation for why is more

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<sup>85</sup> See, e.g., Dreyfuss, *supra* note 47, at 793 ("[O]ne really must wonder about this level of activity and whether it is an implicit criticism of the Federal Circuit's work.").

<sup>86</sup> See Steve Seidenberg, *Reinventing Patent Law*, 94-FEB A.B.A. J. 58, 60 (2008); see also Lee, *supra* note 69, at 46 ("[T]he Court's recent interventions have clearly operated to narrow substantive patent rights.").

<sup>87</sup> See, e.g., Rachel Krevans & Daniel P. Munio, *Restoring the Balance: The Supreme Court Joins the Patent Reform Movement*, 9 SEDONA CONF. J. 15 (2008) ("The Supreme Court is endeavoring to re-balance a patent system that the Court may regard as too favorable to patent applicants and owners.").

<sup>88</sup> Lee, *supra* note 69, at 46. Professor Lee's suggestion that the Court prefers standards over rules has been called into question. See Feldman, *supra* note 39, at 29 ("[S]uggesting that the current Supreme Court has a preference for balancing tests and flexible standards would be somewhat surprising on its face . . . . Nor does the notion of a preference for standards over rules fit consistently with decisions over the last few years."). It is also the opposite of Timothy Holbrook's earlier suggestion that the Court's involvement in patent law in 2000–2002 reflected the Court's enabling of the Federal Circuit's shift toward bright-line rules. See Holbrook, *supra* note 74, at 5.

<sup>89</sup> See Holbrook, *supra* note 74, at 5.

<sup>90</sup> See, e.g., David O. Taylor, *Formalism and Anti-Formalism in Patent Law Adjudication: Rules and Standards*, 46 CONN. L. REV. 415, 427 (2013).

<sup>91</sup> Feldman, *supra* note 39, at 29.

<sup>92</sup> See Dreyfuss, *A Continuing Experiment*, *supra* note 50, at 809 ("[T]he Court does not defer because the Federal Circuit's opinions are not very persuasive.").

substantive than that the Federal Circuit has poorly written decisions. Instead, it appears that the Court is sending two distinct, but related, messages: first, that patent *law* is not that special, and second that understanding patent law does not require patent law expertise. Because the kind of “expertise” the Federal Circuit judges have is simply knowledge of patent law, and the Court does not believe that such expertise makes one better able to decide patent law cases, the Court has concluded that the Federal Circuit is owed no special deference on patent law issues. By disagreeing with the commentators that only judges with patent experience can properly apply patent laws, the Supreme Court has called into question one of the reasons Congress created the Federal Circuit and the entire reason for the creation of the PPP.

#### *A. Patent Law Is Not Special*

Over its short history, the Federal Circuit has created various special rules applicable to patents based upon the notion that patent law should somehow be different than other law, thus validating Judge Rifkind’s prediction that a specialized patent court would lead to decisions in conflict with the general body of law.<sup>93</sup> The Supreme Court’s intervention has resulted in a systematic undoing of that jurisprudence, as the Court maintains that the law applicable to patents is no different than the law applicable to other topics. The first message underlying the Supreme Court’s intervention is straightforward: patent law is not that special.

The Court’s realignment of patent law with the rest of the legal world can probably be traced back to procedural decisions the Court issued in 1999 and 2002. In *Dickinson v. Zurko*, the Court held that the Federal Circuit must review the Patent and Trademark Office’s (“PTO”) factfinding under the standards set out by the Administrative Procedure Act (“APA”), just like every other agency.<sup>94</sup> In so holding, the Court explicitly rejected the argument

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<sup>93</sup> See Rifkind, *supra* note 23, at 425; see also Dreyfuss, *supra* note 20, at 3 (“Even with the best motives, a court’s doctrinal isolation may lead to a body of law out of tune with legal developments elsewhere.”); Janis, *supra* note 23, at 396–97. For an interesting analysis of how the Federal Circuit’s insularism was a predictable result of its specialization, see Alan B. Parker, *Examining Distinctive Jurisprudence in the Federal Circuit: Consequences of a Specialized Court*, 3 AKRON INTELL. PROP. J. 269 (2009).

<sup>94</sup> See *Dickinson v. Zurko*, 527 U.S. 150 (1999).

that the Federal Circuit's review of patent law is special, and outside the boundary of the generally applicable APA.<sup>95</sup> In *Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*, the Court held that the Federal Circuit should not have jurisdiction over a case in which the *complaint* does not raise a patent claim, but one is raised as a *counterclaim*.<sup>96</sup> To reach that decision, the Court was again forced to explicitly deal with the argument that Congress's intention to create uniformity within patent law trumps general principles of law.<sup>97</sup> In holding, instead, that the well-pleaded complaint rule applies to control the Federal Circuit just as it does other courts, the Court again rejected the notion that the Federal Circuit and patent law are special.<sup>98</sup>

The Court again undid a Federal Circuit rule based upon the notion that patent law is special in its 2006 *eBay Inc. v. MercExchange, LLC* decision.<sup>99</sup> Whereas the Federal Circuit had established a "general rule"—unique to patent cases—"that a permanent injunction will issue once infringement and validity have been adjudicated,"<sup>100</sup> the Supreme Court held in *eBay*, instead, that the traditional four-factor test for determining whether to issue a permanent injunction applies "with equal force to disputes arising under the Patent Act."<sup>101</sup> The next year, in *MedImmune, Inc. v. Genentech, Inc.*, the Court struck down the Federal Circuit rule that "a patent licensee in good standing cannot establish an Article III case or controversy with regard to the patent's validity, enforceability, or scope" as inconsistent with the Court's jurisprudence concerning application of the Declaratory Judgment Act generally.<sup>102</sup> The Court completed that re-alignment of patent law with the Declaratory Judgment Act in *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, when it rejected the Federal Circuit's conclusion that the

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<sup>95</sup> See *id.* at 163.

<sup>96</sup> See *Holmes Grp. v. Vornado Air Circulation Sys.*, 535 U.S. 826 (2002).

<sup>97</sup> See *id.* at 832.

<sup>98</sup> See *id.* at 832–33.

<sup>99</sup> See *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006).

<sup>100</sup> See *id.* at 393–94 (quoting *eBay, Inc. v. MercExchange, LLC*, 401 F.3d 1323, 1339 (Fed. Cir. 2005)).

<sup>101</sup> *Id.* at 391.

<sup>102</sup> *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 122 (2007).



burden of proving infringement is born by a declaratory judgment plaintiff, rather than the patentee.<sup>103</sup>

The Court next demonstrated that patent law is not special by rejecting the Federal Circuit's exceptional case standards. First, in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, the Court rejected the Federal Circuit's standard for determining when a patent case is exceptional, holding that the standard should be the same as it is in copyright cases.<sup>104</sup> At the same time, the Court rejected the Federal Circuit's conclusion that entitlement to attorney fees must be established by clear and convincing evidence, holding instead that, like other "comparable fee-shifting statutes," the correct standard is preponderance of the evidence.<sup>105</sup> In *Highmark Inc. v. Allcare Health Management System*, the Court completed its reversal of the Federal Circuit's "exceptional case" precedent, holding that, just like fee-shifting statutes outside the patent context, the district court's exceptional case decisions in the patent context must also be reviewed under an abuse of discretion standard.<sup>106</sup> Similarly, in *Commil USA, LLC v. Cicso Systems, Inc.*, the Court drew from contract law, property law, and criminal law to reach its conclusion that a belief in a patent's invalidity is no defense to a charge of inducing patent infringement.<sup>107</sup> The Court again drew on broadly applicable legal principles in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.* when it held that the Federal Circuit must review a district court's claim construction under the clear error standard rather than conducting its own analysis de novo.<sup>108</sup> The explicit basis for that holding is that Rule 52(a)(6) of the Federal Rules of Civil Procedure applies just as much to fact findings in patent cases as in any other type of dispute.<sup>109</sup> The Court further demonstrated that patent law is not as special as the Federal Circuit seemed to think when reviewing a case out of Texas in *Gunn v. Minton*, when it rejected the reasoning of a line of an entire line of

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<sup>103</sup> See *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 846 (2014).

<sup>104</sup> See *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014).

<sup>105</sup> See *id.* at 1758.

<sup>106</sup> See *Highmark Inc. v. Allcare Health Mgmt. Sys.*, 134 S. Ct. 1744, 1747–48 (2014).

<sup>107</sup> See *Commil USA, LLC v. Cicso Sys. Inc.*, 135 S. Ct. 1920, 1930–31 (2015).

<sup>108</sup> See *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015).

<sup>109</sup> See *id.* at 836.

Federal Circuit precedent holding that state law claims alleging legal malpractice in the handling of a patent case must be brought in federal court because they raise “a substantial federal issue.”<sup>110</sup>

The message from the Court is that patent law is no different than other areas of the law. The message, it seems, has started to get out, at least to the direct recipients of the Court’s message: the Federal Circuit judges themselves. As Judge O’Malley recently recognized, the Supreme Court’s message to the Federal Circuit is that “as an Article III court, it is bound by the same civil rules, jurisdictional standards, and common law principles that govern all Article III courts—in other words, that patent litigation must be treated like all other litigation.”<sup>111</sup> In contrast, the Court’s next message, which follows directly from the notion that patent law is not special, has not been widely recognized.

*B. The Supreme Court Does Not Defer to Federal Circuit Expertise*

The Supreme Court’s attention to patent law beyond the procedural and into “the heart of patent law”<sup>112</sup> has “caused consternation in patent circles.”<sup>113</sup> Professor Dreyfuss captures perfectly what appears to be the prevailing sentiment among patent people:

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 . . . .<sup>114</sup>

To Professor Dreyfuss, the problem is “how the Supreme Court can use the generalist knowledge derived from its unique po-

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<sup>110</sup> See *Gunn v. Minton*, 133 S. Ct. 1059, 1063, 1068 (2013) (“Nor can we accept the suggestion that the federal courts’ greater familiarity with patent law means that legal malpractice cases like this one belong in federal court.”).

<sup>111</sup> See Kathleen M. O’Malley, *The Intensifying National Interest in Patent Litigation*, 19 MARQ. INTELL. PROP. REV. 1, 10 (2015); see also Plager, *supra* note 27, at 751 (“One type of case that draws Supreme Court attention is one in which the Circuit strays from generally applicable rules governing litigation in favor of special rules for patent cases.”).

<sup>112</sup> Holbrook, *supra* note 78, at 25.

<sup>113</sup> Dreyfuss, *supra* note 67, at 807.

<sup>114</sup> *Id.* at 794.

sition in a way that takes account of the Federal Circuit's expertise in technology, patents, and licensing."<sup>115</sup> She has suggested that the Supreme Court's attention is not a criticism of the Federal Circuit and that the Court must "figure out how a judiciary largely committed to generalist adjudication should deal with a court that is so differently constituted."<sup>116</sup> Suggesting that it is yet to be determined "under what circumstances a specialized court should be able to 'pull rank' and claim that its expertise gives it a superior perspective,"<sup>117</sup> Professor Dreyfuss asserts that "[w]hat the Supreme Court has not done . . . is face the larger question of expertise head-on."<sup>118</sup>

I disagree. The Court has addressed the patent law expertise question; it has just reached a conclusion that patent people do not like. The analysis can be summarized as follows: first, because patent law is not that difficult or special, understanding and interpreting it does not require any particular legal expertise. Furthermore, because interpreting patent law does not require any particular legal expertise, those judges who have become "specialists" by developing expertise through exposure to patent law should not be given special deference as an "expert" court. Accordingly, the legal opinions of the Federal Circuit judges are no longer entitled to special treatment or deference as an "expert" court. These messages from the Court—that patent law does not require legal expertise and that therefore patent law expertise is not entitled to deference—although intimately related to the first message described above, has not yet been digested by the patent community at large.<sup>119</sup>

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<sup>115</sup> *Id.* at 796.

<sup>116</sup> *Id.* at 794.

<sup>117</sup> *Id.* at 807.

<sup>118</sup> *Id.* at 799.

<sup>119</sup> The Federal Circuit judges also appear not to see a pattern in the Court's pronouncements, instead suggesting that it is related to the importance of patent law to the nation. *See, e.g.,* Plager, *supra* note 27, at 757 ("[C]uriously, though in keeping with the notion that patent law now plays a major economic role in the nation, the Supreme Court in several other recent cases has inserted itself into the operational aspects of patent law."). Still, while patent people generally appear not to appreciate this implication of the Supreme Court's jurisprudence, it is not unappreciated by some practitioners. *See, e.g.,* Jeff Bleich & Josh Patashnik, *Supreme Court Watch: The Federal Circuit Under Fire*, S.F. ATT'Y, Fall 2014, at 42 ("Specialists see patent law as a field that

As already noted, for many years after the Federal Circuit's creation, the Supreme Court implicitly gave the Federal Circuit its "vote of confidence" in resolving patent cases.<sup>120</sup> Indeed, during that period, the Supreme Court was also known to explicitly describe the Federal Circuit as specialists in patent law.<sup>121</sup> Even while the Court required the Federal Circuit to defer more than it had to the PTO in *Dickinson v. Zurko*, the Court also took pains to note that the Federal Circuit was itself "a specialized court" that would review PTO factfinding "through the lens of patent-related experience."<sup>122</sup> That perspective was not to last. If the Court's early lack of attention was a vote of confidence, its attentiveness in recent years suggests the opposite. Even had the Court affirmed the Federal Circuit in the twenty-five patent cases it has taken in the last decade, the excessive attention would still suggest that the Court has concerns about permitting the Federal Circuit to be the final word on patent law issues.

The Court laid the foundation for why the "expert" Federal Circuit need not be given deference when the modern Court took its first substantive look at patent law in 2002 in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*<sup>123</sup> As Professor Duffy documented, the Supreme Court quickly recognized that "while the application of the law to the facts of any particular patent case is difficult, the law being applied need not be."<sup>124</sup> Professor Duffy's analysis is spot on and worth repeating:

For a generalist Court such as the Supreme Court, one immediate problem presented by patent

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transcends traditional law; it requires a carefully trained eye, to know what is indeed an invention and what is not, and rules that give a heightened degree of protection to encourage inventors to keep inventing. Generalists have little sympathy for these attitudes. For them, patent cases require no more special knowledge than any other difficult and high-stakes area—from antitrust to copyright to employment to consumer class actions—where generalist judges are perfectly capable of resolving highly complex and nuanced questions of law.”).

<sup>120</sup> Kondo, *supra* note 26, at 18.

<sup>121</sup> *Cf. Dennison Mfg. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) (“[W]e lack the benefit of the Federal Circuit’s informed opinion on the complex issue of the degree to which the obviousness determination is one of fact.”).

<sup>122</sup> *Dickinson v. Zurko*, 527 U.S. 150, 163 (1999).

<sup>123</sup> *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

<sup>124</sup> Duffy, *supra* note 72, at 331.

cases is that they are likely to involve a great amount of technological detail that the Court is ill-suited to evaluate . . . .

. . . .

The Supreme Court overcame this problem with an elegant solution. It simply asserted that “the precise details of the [invention’s] operation are not essential here.” Here we see a wise precedent for the Court’s involvement in patent cases, and perhaps too in other cases requiring specialized knowledge. The insight is that, while the application of the law to the facts of any particular patent case is difficult, the law being applied need not be. . . . The arguments made before the Court—which concerned the unfairness of a retroactive decision, the need for stability in property rights, the aspiration for precise definitions of property rights, and the practical limits of language—do not require any particular knowledge of technology. A generalist Court can comprehend these matters; indeed, it may have a broader perspective on them than does a court immersed in the details of a specialized field of law.<sup>125</sup>

The Supreme Court was unanimous in *Festo* when it concluded that the en banc Federal Circuit had “ignored the guidance” of the Supreme Court.<sup>126</sup> Even though it is itself a generalist court, the Supreme Court decided that the Federal Circuit had erred in applying substantive patent law and that it did not take a patent law expert to see it.<sup>127</sup> It is notable that the Court has continued to express near unanimity when overturning the Federal Circuit’s patent decisions.<sup>128</sup> In a time when the Supreme Court is sharply divided in other areas of the law, the fact that the Justices see eye-to-eye when holding that the Federal Circuit is wrong speaks volumes about the Court’s lack of confidence in that court’s expertise.

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<sup>125</sup> *Id.* at 329–32 (internal citations omitted).

<sup>126</sup> *See Festo*, 535 U.S. at 739.

<sup>127</sup> *See id.*

<sup>128</sup> *See id.* at 725.

The Court has continued—and expanded upon—this line of thinking from *Festo* to today. In 2006, the Court granted certiorari in *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.*, a case involving 35 U.S.C. § 101, patentable subject matter.<sup>129</sup> While the Court ultimately dismissed the writ as improvidently granted, Justice Breyer, joined by Justices Stevens and Souter, dissented from the denial and in the process called into question the Federal Circuit’s handling of patent law as well as the premise that a generalist court could not do as well: “[A] decision from this generalist Court could contribute to the important ongoing debate, among both specialists and generalists, as to whether the patent system, as currently administered and enforced, adequately reflects the ‘careful balance’ that ‘the federal patent laws . . . embody[y].’”<sup>130</sup> Those Justices left no doubt that they were affirming the position avowed in *Festo*: that generalists can interpret the patent laws as well as specialists.<sup>131</sup>

Were there any doubt remaining about the Court’s belief that it can wade into substantive patent law headfirst, that doubt was disposed of the following year when the Court addressed the law of obviousness in *KSR International Co. v. Teleflex, Inc.*<sup>132</sup> In *KSR*, the Court did not accuse the Federal Circuit of failing to apply generally applicable rules of law to patent law, but instead of failing to understand patent law itself.<sup>133</sup> After explaining that “[t]he flaws in the analysis of the Court of Appeals relate for the most part to the court’s narrow conception of the obviousness inquiry,”<sup>134</sup> the Court went on to detail the Federal Circuit’s errors related both to how patent examiners should assess obviousness and how a “person of ordinary skill in the art” would solve problems or issues fundamental to patent law.<sup>135</sup> In stark contrast to the Court’s earlier description of the Federal Circuit as having an “informed opi-

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<sup>129</sup> See *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 125–26 (2006) (per curiam).

<sup>130</sup> *Id.* at 138 (alteration in original) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* 489 U.S. 141, 146 (1989)).

<sup>131</sup> *Id.*

<sup>132</sup> See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 407 (2007).

<sup>133</sup> See *id.* at 422.

<sup>134</sup> *Id.* at 419.

<sup>135</sup> *Id.* at 418.

nion on the complex issue of the degree to which the obviousness determination is one of fact,<sup>136</sup> in *KSR* the Supreme Court gave no deference to any purported expertise of the Federal Circuit.<sup>137</sup> Rather, the Court described the Federal Circuit's analysis as "constricted" and as containing "fundamental misunderstandings," and it did so unanimously.<sup>138</sup>

Not satisfied to stop there, the Court also fulfilled the promise of the dissenters in *Laboratory Corp.* by reworking the Federal Circuit's understanding of patentable subject matter in a series of recent cases, starting with *Bilski v. Kappos* in 2010,<sup>139</sup> continuing through *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*<sup>140</sup> and *Association for Molecular Pathology v. Myriad Genetics, Inc.*,<sup>141</sup> and culminating in *Alice Corp. v. CLS Bank International*.<sup>142</sup> In the process, the Court expressed dissatisfaction with the Federal Circuit's care of patent law, going out of its way to declare that "nothing in today's opinion should be read as endorsing interpretations of § 101 that the Court of Appeals for the Federal Circuit has used in the past."<sup>143</sup>

As the Court has attacked the Federal Circuit's understanding of the fundamental patent law concepts of patent eligibility and obviousness, it should not be surprising that the Court also gave no deference to—and chastised the Federal Circuit for its misunderstanding of—some other patent law questions. After the Court reversed the Federal Circuit's holding that the patent exhaustion doctrine does not apply to method claims in *Quanta Computer, Inc. v. LG Electronics, Inc.*,<sup>144</sup> the Court stated in its *Limelight Networks, Inc. v. Akamai Technologies, Inc.* decision that "[t]he Federal Circuit's analysis fundamentally misunderstands what it means to infringe a method patent."<sup>145</sup> The Court also rewrote the standard

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<sup>136</sup> *Dennison Mfg. v. Panduit Corp.*, 475 U.S. 809, 811 (1986).

<sup>137</sup> *See KSR Int'l*, 550 U.S. at 398.

<sup>138</sup> *Id.* at 404, 421–22.

<sup>139</sup> *Bilski v. Kappos*, 561 U.S. 593 (2010).

<sup>140</sup> *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

<sup>141</sup> *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

<sup>142</sup> *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014).

<sup>143</sup> *Bilski*, 561 U.S. at 612.

<sup>144</sup> *Quanta Comput., Inc. v. LG Elecs., Inc.*, 553 U.S. 617 (2008).

<sup>145</sup> *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111, 2117 (2014).

for determining when something is indefinite in *Nautilus, Inc. v. Biosig Instruments, Inc.*, after complaining that the Federal Circuit's test had "[f]allen short" of the standard as it was "more amorphous than the statutory definiteness requirement allows."<sup>146</sup>

In general, rather than defer to the Federal Circuit's views "[f]or many substantive issues of patent law . . . the Court has dusted off its own venerable case law for guiding principles, largely ignoring twenty-five years of more recent Federal Circuit decisions."<sup>147</sup> Indeed, even when affirming the Federal Circuit decisions in *Bilski* and *Global-Tech Appliances, Inc. v. SEB S.A.*, the Court rejected the Federal Circuit's description of the applicable law, affirming the conclusions by applying patent law in a very different way than the Federal Circuit had.<sup>148</sup> Collectively, these cases demonstrate a pattern: the Supreme Court, itself a generalist court, has roundly rejected calls for it to defer to the "specialist" Federal Circuit. While the general view of patent commentators is that "[i]t is an odd moment indeed when the Supreme Court feels moved to explain patent infringement to the dedicated patent court of appeals,"<sup>149</sup> it is not odd at all when one takes the position that there is nothing expert about the "specialist" patent appeals court. The law applicable to patents, the Court insists, is not just not special, it is also not any more difficult than other areas of law. Accordingly, there is no reason generalist judges cannot understand the

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<sup>146</sup> *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2131 (2014); *see id.* at 2124 ("In place of the 'insolubly ambiguous' standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."); *id.* at 2130 ("[A]lthough this Court does not 'micromanag[e] the Federal Circuit's particular word choice' in applying patent-law doctrines, we must ensure that the Federal Circuit's test is at least 'probative of the essential inquiry.'" (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997))).

<sup>147</sup> Eisenberg, *supra* note 80, at 30. This is not to say that the Supreme Court's resolution of issues of patent law were necessarily correct or the Federal Circuit's wrong. As Justice Jackson famously said of the Court: "We are not final because we are infallible, but we are infallible only because we are final." *Brown v. Allen*, 344 U.S. 443, 540 (1953) (Jackson, J., concurring). For purposes of this Article, the important point is that in the Court's view, it is as qualified as the Federal Circuit to consider patent law issues.

<sup>148</sup> *See Bilski*, 561 U.S. at 612; *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754 (2011).

<sup>149</sup> Feldman, *supra* note 39, at 34.



law just as well as specialist judges, and no reason to defer to the supposed “expertise” of the Federal Circuit. The Court seems to be saying that in its opinion, specialist patent judges—who are “specialists” only in the sense that they are intimately familiar with the law, as opposed to the underlying facts—are no better at deciding patent cases than are generalists, and may be worse.<sup>150</sup> What the Court has done in its recent foray into patent law is to proclaim, in strong disagreement with the assertions by patent law commentators, that a generalist appellate court can competently understand and apply patent law. To the extent that people think the Supreme Court itself cannot do patent law, the Court has itself forcefully asserted, “Yes, we can.”

As Professor Golden has aptly noted, “[T]he Circuit hears enough patent cases to acquire unquestionable expertise on questions of substantive patent law.”<sup>151</sup> The Supreme Court does not appear to believe the Federal Circuit’s “expertise” in patent law should be deferred to, however.<sup>152</sup> It appears, instead, that the Supreme Court is suggesting that courts who are experts only in the sense that they are specialists in some area of law are not owed deference based upon that expertise. This view is supported by a recent realization that “these trends are occurring across the entirety of the Federal Circuit’s decisions, and not just with regards to pa-

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<sup>150</sup> At least one of the Justices appear to be of the view, shared by some commentators, that the biggest beneficiary of the notion that patent law requires special patent law expertise is the patent bar. *See* Transcript of Oral Argument at 41–42, *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 407 (2007) (“[The TSM test] produces more patents, which is what the patent bar gets paid for, to acquire patents, not to get patent applications denied but to get them granted. And the more you narrow the obviousness standard to these three imponderable nouns, the more likely it is that the patent will be granted.”); *see also* Gugliuzza, *supra* note 33, at 1855 (“[T]his empirical evidence suggests that the creation of the Federal Circuit has increased patent activity generally without unduly favoring either patent holders or accused infringers—an outcome that would seem to please patent lawyers of all stripes.”).

<sup>151</sup> Golden, *supra* note 70, at 660; *see also* Pegram, *supra* note 50, at 788 (“Clearly, the Federal Circuit has developed patent expertise of a higher average level than that previously found in the regional circuits, as a result to deciding over 200 patent appeals per year.”).

<sup>152</sup> The Court’s practice is also inconsistent with the suggestion that the circuits should defer to the expert Federal Circuit. *See* Larry D. Thompson, Jr., *Adrift on a Sea of Uncertainty: Preserving Uniformity in Patent Law Post-Vornado Through Deference to the Federal Circuit*, 92 GEO. L.J. 523, 564–68 (2004).

tent questions.”<sup>153</sup> The Court thus appears to have taken one small step toward joining those who doubt the specialization of judges helps judges reach better decisions.<sup>154</sup>

Jonas Anderson has suggested that the Supreme Court’s involvement in patent law is in reality the Court starting a dialogue with Congress, using the Federal Circuit as an intermediary.<sup>155</sup> If this is a dialogue with Congress, it may be a shot across the bow against the use of specialized courts. If so, Congress does not seem to have gotten the message. After the Court held that the regional courts of appeals could decide certain patent law issues in *Vornado*,<sup>156</sup> Congress responded by strengthening the Federal Circuit’s exclusive jurisdiction over patents.<sup>157</sup> On the other hand, in response to criticism about the Federal Circuit’s exclusivity in another area of its jurisprudence, Congress took a step toward dismantling the specialized court regime by undoing the Federal Circuit’s longstanding exclusive jurisdiction over cases involving the Whistleblower Protection Act.<sup>158</sup> Still, regardless of whether the Court’s pronouncement extends beyond patent law and the Federal Circuit, at least in this one area, the Court has decided that a specialist court is owed no more deference than a generalist one.<sup>159</sup>

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<sup>153</sup> Daniel Kazhdan, *Beyond Patents: The Supreme Court’s Evolving Relationship with the Federal Circuit*, 94 J. PAT. & TRADEMARK OFF. SOC’Y 275 (2012); see also Paul R. Gugliuzza, *Veterans Benefits in 2010: A New Dialogue Between the Supreme Court and the Federal Circuit*, 60 AM. U. L. REV. 1201, 1211–12 (2011) (describing an increase in the Court’s attention to the Federal Circuit’s veteran law jurisprudence).

<sup>154</sup> See Ford, *supra* note 50, at 49 (“[T]his study suggests that specialization does not improve copyright decisions.”); see also POSNER, *supra* note 22, at 254 (“In most areas of federal law at present, there cannot be any assurance that a specialized court, merely by virtue of specializing, would produce better decisions.”); Chad M. Oldfather, *Judging, Expertise, and the Rule of Law*, 89 WASH. U. L. REV. 847, 850 (2012) (“[I]t is unlikely to be the case that the content of specialists’ decisions will differ in some qualitative respect from—or be in some general sense ‘better than’—those of their generalist counterparts.”).

<sup>155</sup> J. Jonas Anderson, *Patent Dialogue*, 92 N.C. L. REV. 1049, 1049 (2014).

<sup>156</sup> See *Holmes Grp. v. Vornado Air Circulation Sys.*, 535 U.S. 826 (2002).

<sup>157</sup> See Leahy–Smith America Invents Act § 19(b), 28 U.S.C. § 1295(a)(1) (2012).

<sup>158</sup> See Whistleblower Protection Enhancement Act of 2007, H.R. 985, 110th Cong. (2007) (codified as amended in scattered sections of 5 U.S.C.).

<sup>159</sup> See Anderson, *supra* note 155, at 1097.

### *C. Implications for the Specialized Patent Judiciary*

Neither the realization that the law applicable to patents is not special, nor the recognition that the Court does not defer to the Federal Circuit, necessarily translates into a recommendation to undo Congress's experiments with specialization in this area or endorsement of proposals to direct patent appeals back to the regional courts of appeal, where they were once decided. While the Court has, I think correctly, called into question the notion that patent law expertise is necessary to decide patent cases, it is ultimately an empirical question whether such experience makes any difference: one that the PPP will help assess. What the Court's foray into patent law teaches at least is that there are serious questions whether to continue to specialize the judiciary based upon expertise in patent law until there is reason to believe that doing so will help.

With respect to the Federal Circuit, it is important to recall that it was created for reasons other than developing patent law expertise in the judges who hear patent appeals.<sup>160</sup> Congress was also—and even more—interested in uniformity and efficiency, both goals that are not undermined by the Court's apparent view that patent law expertise is not a necessary precondition to deciding patent law cases.<sup>161</sup> The Court's view that patent law is not exceptional therefore has only limited implication for the future of specialization of the patent-focused judiciary. Still, policy-makers would be wise to consider the possibility that the Court is correct that increased legal expertise is not the solution to the judiciary's patent dilemma, as they consider structural changes to improve the resolution of patent cases.

## III. WHAT MAKES SOME PATENT CASES DIFFICULT IS THE TECHNOLOGY

### *A. The Technology in Patent Cases Is Often Difficult*

Even while the Court has suggested that generalist judges can apply patent law, the Court has not been sanguine about those

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<sup>160</sup> See Thompson, *supra* note 152, at 525.

<sup>161</sup> See *id.* at 525.

judges' ability to decide patent cases as a whole. Instead, the Court has revealed that whereas it believes that patent *law* is comprehensible by a generalist judiciary, the court recognizes that the *facts* in patent cases are another issue entirely. As Judge Rifkind noted in 1951, that is where patent law gets difficult, because it is not the law that makes patent cases complex, it is the technology.<sup>162</sup> The modern Court discovered that fact for itself when it began to regularly delve into patent cases. In *Mayo*,<sup>163</sup> the Court was forced to consider a case that demanded involvement not only with patent law but also with the scientific facts to which the law was to be applied.<sup>164</sup> Again, the Court gave the Federal Circuit no deference, instead unanimously reversing the Federal Circuit after conducting its own analysis of whether the claimed use of thiopurine drugs in the treatment of autoimmune diseases was a patentable process or an impermissible attempt to claim a fundamental law of nature.<sup>165</sup> But even while doing so the Court conceded, "Courts and judges are not institutionally well suited to making the kinds of judgments needed to distinguish among different laws of nature."<sup>166</sup> To conduct its analysis, the Court relied upon amici it described as medical experts, including the American Medical Association, the American College of Medical Genetics, the American Hospital Association, the American Society of Human Genetics, the Association of American Medical Colleges, and the Association for Molecular Pathology.<sup>167</sup>

The Court was again forced to delve into scientific questions it was not well suited to deal with the following year when assessing the patentability of DNA and cDNA in *Myriad*.<sup>168</sup> Justice Scalia's notable concurrence sums up nicely the concerns of many jurists when dealing with such questions:

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<sup>162</sup> See Rifkind, *supra* note 23, at 425; see also Rai, *Specialized Trial Courts*, *supra* note 60, at 878 ("[T]he complexity of patent law lies not in its legal principles but in the scientific fact-finding required to apply those legal principles properly.").

<sup>163</sup> *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

<sup>164</sup> As the Court stated, it turned to its precedents only to "reinforce[] our conclusion." *Id.* at 1302.

<sup>165</sup> See *id.* at 1289.

<sup>166</sup> *Id.* at 1303.

<sup>167</sup> See *id.*

<sup>168</sup> See *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

I join the judgment of the Court, and all of its opinion except Part I–A and some portions of the rest of the opinion going into fine details of molecular biology. I am unable to affirm those details on my own knowledge or even my own belief. It suffices for me to affirm, having studied the opinions below and the expert briefs presented here, that the portion of DNA isolated from its natural state sought to be patented is identical to that portion of the DNA in its natural state; and that complementary DNA (cDNA) is a synthetic creation not normally present in nature.<sup>169</sup>

Through that admission, Justice Scalia joined a long list of eminent jurists who have recognized their own lack of real subject matter expertise to address the complex scientific and technological questions that sometimes underlie patent cases and have questioned the wisdom of having those questions decided by judges.<sup>170</sup> As Felix Frankfurter observed, “It is an old observation that the training of Anglo-American judges ill fits them to discharge the duties cast upon them by patent legislation.”<sup>171</sup> That sentiment was echoed by Learned Hand, who asked: “How long we shall continue to blunder along without the aid of unpartisan and authoritative scientific assistance in the administration of justice, 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.”<sup>172</sup> Judge Friendly, whose clarion call for change led to the use of specialized courts said that patent cases go “beyond the ability of the usual judge to understand without the expenditure of an inordinate amount of educational effort . . . and, in many instances, even with it.”<sup>173</sup> While those eminent jurists have been described as “express[ing] skepticism about the ability of generalist judges to understand patent disputes,”<sup>174</sup> it is fairer to say that the judges

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<sup>169</sup> *Id.* at 2020 (Scalia, J., concurring).

<sup>170</sup> *See infra* notes 171–174 and accompanying text.

<sup>171</sup> *Marconi Wireless Tel. Co. of Am. v. United States*, 320 U.S. 1, 60–61 (1943).

<sup>172</sup> *Parke–Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 115 (S.D.N.Y. 1911).

<sup>173</sup> HENRY FRIENDLY, *FEDERAL JURISDICTION: A GENERAL VIEW* 156–57 (1973); *see generally* Friendly, *supra* note 15.

<sup>174</sup> Gugliuzza, *supra* note 17, at 1448.

were expressing skepticism about the ability of judges to understand patent disputes, whether they are generalists or specialists. The concern is not that judges don't know enough law; it is that they don't know enough science and have difficulty applying the law to difficult facts.

*B. The Federal Circuit Cannot Be Patent Fact-finders*

One potential resolution to this problem is for the Court to begin to defer more to the Federal Circuit with respect to the technologies underlying patent disputes. In harmony with Professor Dreyfuss' suggestion that "the Federal Circuit's unique responsibility toward patent law argues for a broader scope of review over fact finding," the court could simply choose to defer to that specialist court.<sup>175</sup> Congress included no special deference mechanism when it created the Federal Circuit, however, and the Court has not chosen to create one. Instead, just as the Court has thus refused to defer to the Federal Circuit's expertise over the law applicable to patents, so too the Court has found that the Federal Circuit has no special claim to development of the facts. Instead, the Court has held that the fact-finders, both the PTO and district court judges, are better equipped than the Federal Circuit to apply that law to the facts of individual cases.<sup>176</sup> The Court first did so in 1999, when it held that the Federal Circuit's review of PTO decisions should be under the more deferential APA standard rather than the one the Federal Circuit had been applying.<sup>177</sup> More recently, in a pair of 2014 cases, *Highmark* and *Octane Fitness*, the Court required the Federal Circuit to defer more to the district court decisions about whether a case is exceptional.<sup>178</sup> The next year, in *Teva*, the Court overturned decades of Federal Circuit precedent to limit the Federal Circuit's review of district courts' claim construction decisions.<sup>179</sup>

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<sup>175</sup> Dreyfuss, *supra* note 20, at 61–62.

<sup>176</sup> See *Dickinson v. Zurko*, 527 U.S. 150 (1999).

<sup>177</sup> See *id.*

<sup>178</sup> See *Highmark Inc. v. Allcare Health Mgmt. Sys.*, 134 S. Ct. 1744 (2014); *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014).

<sup>179</sup> See *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 833 (2015).

When it comes to questions of fact, the Court has insisted that if any judge must attempt to resolve difficult technological or scientific factual questions, it is better that it be trial judges rather than appellate judges. While the Court does not appear to believe in the development of expertise when it comes to an area of the law, the Court appears to believe that whatever understanding of the particular scientific issue a district court is able to acquire while dealing with the case is at least better than appellate courts are able to manage. As the Court said in *Teva*:

We have previously pointed out that clear error review is “particularly” important where patent law is at issue because patent law is “a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience.” A district court judge who has presided over, and listened to, the entirety of a proceeding has a comparatively greater opportunity to gain that familiarity than an appeals court judge who must read a written transcript or perhaps just those portions to which the parties have referred.<sup>180</sup>

While the Supreme Court has resolved that the Federal Circuit (as well as the Court itself) should avoid dealing with the facts underlying patent disputes as much as possible and focus on getting the law right, that solution is unavailable to the district courts.<sup>181</sup> As fact-finders, district court judges are required to delve into the facts of many patent disputes.<sup>182</sup> Accordingly, as best it can within the current framework, the Court appears to be shifting patent fact related issues to the court better able to discover such facts. The Court seems to appreciate that getting the facts of a patent case right requires more, not less, understanding of the technology involved. While the Federal Circuit has at times asserted an outsize role in fact-finding in patent cases, and has been encouraged to do

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<sup>180</sup> *Id.* at 838 (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 610 (1950)).

<sup>181</sup> *See id.* at 837.

<sup>182</sup> *See Lee, supra* note 69, at 77.

so by commentators who view that court as an expert tribunal,<sup>183</sup> the Supreme Court has roundly rejected each of the Federal Circuit's attempts to "bring its expertise to bear on the facts that affect the outcome of technologically complex cases."<sup>184</sup> Instead, the Court has shifted those factual issues back to district court judges.

In doing so, the Court does not seem, however, to be giving its stamp of approval to programs, like the PPP, that aim to develop patent law expertise in district court judges. If the Federal Circuit judges are not given deference based upon their very extensive patent law experience, it would be odd indeed to defer to district court judges who have far less patent law experience on that same basis. The Court has decided that district courts should have a greater role in developing the facts of patent law cases not because the district court judges have patent law experience but because they have the time, and the ability to employ experts, to try to understand the science at issue in that particular case.<sup>185</sup> As Professor Lee has noted, the Court's recent decisions "reflect a sentiment that enhancing accuracy may go hand-in-hand with requiring courts to engage more fully with technological context."<sup>186</sup>

Ultimately, the Supreme Court appears to be unwilling to defer to lower court judges on issues of patent law (including either the Federal Circuit or PPP judges) if the specialization reflects only the development of legal expertise, rather than specialization that in some way will help those judges to better understand the facts in patent law cases.<sup>187</sup> Because solely having patent law expertise will not enable judges to decide patent cases any better than generalists, there is no reason to try to develop that expertise in judges.

### *C. Judiciary-Based Solutions Are Unlikely to Resolve the Problem*

The judiciary's problem with patent law, in a nutshell, is that patent fact-finding appears likely to benefit from scientific and

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<sup>183</sup> See Dreyfuss, *supra* note 20, at 61–62.

<sup>184</sup> Dreyfuss, *supra* note 67, at 798.

<sup>185</sup> See Lee, *supra* note 69, at 12.

<sup>186</sup> *Id.* at 46.

<sup>187</sup> The Court's logic is also inconsistent with other proposals to increase the patent experience of judges as a way to increase their "expertise" in dealing with patent cases. See, e.g., Pegram, *supra* note 50, at 788 ("[A]n expected greater volume of patent cases . . . should cause the CIT to develop appropriate expertise in patent law . . .").



technical expertise but judges, both at the district court and appellate level, currently lack that expertise.<sup>188</sup> Having concluded that the technology is, if anything, what may be special about patent law, the question becomes how to better deal with those difficult facts. Despite persistent misconceptions to the contrary, the majority of the judges on the Federal Circuit do not have technical backgrounds, and an even smaller proportion of district court judges have science or engineering expertise.<sup>189</sup> As this Article has detailed, Congress's attempts to specialize the judiciary, both through the creation of the Federal Circuit and the PPP, are not effective solutions to this problem because legal expertise is not what is needed in patent law, a fact to which the Supreme Court has recently called attention.<sup>190</sup>

Various additional proposals have been offered to increase the expertise of the courts dealing with patent cases. Perhaps the most straightforward are proposals simply to appoint more scientists and people with technological expertise to the judiciary. Scott Brewer proposed to have scientifically or technically trained judges decide cases at the trial level where scientific or technical facts are at issue.<sup>191</sup> Similarly, Professor Kondo suggested that “[t]he Federal Circuit, or a division of it, might further evolve to become more specialized in fact in the future through court appointments, approximating a science or patent court.”<sup>192</sup> Indeed, multiple researchers have proposed the creation of a patent court at the trial

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<sup>188</sup> See Kondo, *supra* note 26, at 7 (“Federal judges and juries, with the notable exception of the Federal Circuit, generally lack the scientific expertise arguably necessary to comprehend and decide highly technical intellectual property cases.”). In fact, the Federal Circuit is no exception. As Professor Kondo acknowledges, only a few Federal Circuit judges have a technical or scientific background. *Id.* at 6. Professor Kondo’s attribution of expertise is based solely upon patent law experience, not scientific expertise.

<sup>189</sup> Of the thirty-eight judges who have ever been appointed to the Federal Circuit, only nine have technical backgrounds. See *supra* note 48.

<sup>190</sup> See *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 833 (2015).

<sup>191</sup> See, e.g., Scott Brewer, *Scientific Expert Testimony and Intellectual Due Process*, 107 *YALE L.J.* 1535, 1681 (1998).

<sup>192</sup> Kondo, *supra* note 26, at 87. Among other predicted benefits, he hypothesizes that “increased specialization within the judiciary will result in greater comprehension of technologically complex cases.” *Id.* at 105.

level, both with and without judges who have technical expertise.<sup>193</sup> Commentators who lament the high district court claim construction reversal rate have frequently hypothesized that judges with scientific training may be better at claim construction.<sup>194</sup> Others have proposed increasing the training of judges generally, such that they are prepared for a patent case when one is assigned.<sup>195</sup>

The problems with each of those proposals largely mirror the problems applicable to Congress's previous efforts to specialize the judiciary. Each of the concerns that were expressed when Congress created the Federal Circuit are just as applicable to efforts to create a specialized patent court, including the concerns that the court will become too insular, will develop tunnel vision, will be too pro-patent, and will be subject to capture.<sup>196</sup> In addition, the Supreme Court may be wary of those proposals for the same reasons it appears not to have embraced Congress's patent law specialization efforts. The proposal for directly appointing more technically-trained judges to the Federal Circuit, for example, does not take advantage of the understanding that it is patent fact-finding (as op-

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<sup>193</sup> See Rai, *Specialized Trial Courts*, *supra* note 60, at 896; Gregory J. Wallace, Note, *Toward Certainty and Uniformity in Patent Infringement Cases After Festo and Markman: A Proposal for a Specialized Patent Trial Court with a Rule of Greater Deference*, 77 S. CAL. L. REV. 1383, 1410–15 (2004) (proposing to establish a uniform national patent trial court).

<sup>194</sup> See, e.g., Gitter, *supra* note 60, at 196 (“[T]echnical education or prior experience with patent law may be required.”); David L. Schwartz, *Courting Specialization: An Empirical Study of Claim Construction Comparing Patent Litigation Before Federal District Courts and the International Trade Commission*, 50 WM. & MARY L. REV. 1699, 1731 (2009).

<sup>195</sup> See, e.g., Linn, *supra* note 58, at 737. Similarly, a number of researchers have alluded to the benefits of increased reliance upon technically trained law clerks. While nobody appears to have explicitly proposed an entirely clerk-based solution to the problem of expertise, it has often been noted that the law clerks who serve upon the Federal Circuit, and its predecessor—the United States Court of Customs and Patent Appeals—usually have backgrounds in science and technology. See, e.g., *Gen. Tire & Rubber Co. v. Jefferson Chem. Co.*, 497 F.2d 1283, 1284 (2d Cir. 1974) (“This patent appeal is another illustration of the absurdity of requiring the decision of such cases to be made by judges whose knowledge of the relevant technology derives primarily, or even solely, from explanations of counsel and who, unlike the judges of the Court of Customs and Patent Appeals, do not have access to a scientifically knowledgeable staff.”); Dreyfuss, *supra* note 67, at 797 (2010) (noting that the Federal Circuit “chooses clerks for their technical backgrounds and it can hire staff to advise it on technical matters”). The appointment of law clerks with such expertise is also a central tenet of the PPP. See Issa, *supra* note 39 (“Each of the test courts will be assigned a clerk with expertise in patent law or the scientific issues arising in patent cases . . .”).

<sup>196</sup> See *supra* Section I.A.

posed to patent law) that requires subject-matter expertise.<sup>197</sup> It also fails to account for the Supreme Court's recent pronouncements that the Federal Circuit, as an appellate court, is not in a position to delve into the facts as much as that court has been doing.<sup>198</sup> In light of that recent jurisprudence limiting the ability of the Federal Circuit to delve into the technological underpinnings of patent cases, it seems there is little that a group of scientists on the Federal Circuit could realistically do to improve the adjudication of patent disputes.

Another reason that simply creating an appellate court made up of scientists may not be sufficient to resolve the problem was well described by Judge Rifkind. As he noted, "It is hardly to be supposed that the members of a patent court will be so omniscient as to possess specialized skill in chemistry, in electronics, mechanics and in vast fields of discovery as yet uncharted."<sup>199</sup> That realization is as true of the Federal Circuit as it is a hypothetical patent court, and a concern with the majority of the proposals to inject more expertise into the judiciary. Professor Arti Rai appropriately criticized Professor Brewer's suggestion "because expertise in one area of science or technology does not transfer over to other areas," it "would require selecting a group of judges that was trained in a large variety of different areas of science and technology."<sup>200</sup> Professor Rai also criticized the Federal Circuit on that basis.<sup>201</sup> Her proposal to create a specialized trial court is not, however, immune from that same problem, as she proposes that the judges on a specialized patent trial court would have only a minimal level of familiarity with scientific principles rather than subject-matter expertise pertinent to the technology being considered.<sup>202</sup> Such a proposal seems insufficient in light of a recent study providing preliminary evidence supporting the view that the particular type of scientific or technical expertise that a Federal Circuit judge enjoys makes a difference in how that particular judge decides patent cases in that field. As the study's author notes, "expertise in one technical field

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<sup>197</sup> See *supra* Section III.B.

<sup>198</sup> See *supra* Section III.B.

<sup>199</sup> Rifkind, *supra* note 23, at 426.

<sup>200</sup> Rai, *Specialized Trial Courts*, *supra* note 60, at 894.

<sup>201</sup> See *id.*

<sup>202</sup> See *id.* at 894.

does not connote expertise in all technical fields.”<sup>203</sup> Ultimately, proposals to create a patent court made up of judges who do not have scientific or technical expertise rely upon the notion that the judges will develop expertise through repeated exposure to patent cases. As this article suggests, however, expertise in patent law may not be what is needed in patent cases.

Jeanne Fromer suggests that geography might solve the expertise problem, as different technologies are over-represented in different parts of the country.<sup>204</sup> She hypothesizes that if venue rules were changed to require patent litigation to stay close to home, it will result in repeated judicial exposure to the same type of technology, which will improve a judge’s ability to consider patent cases dealing with that technology.<sup>205</sup> Unfortunately, that proposal depends upon the as yet unproven theory that judges can develop sufficient scientific or technical expertise through repeated exposure to cases involving a particular type of technology, rather than through formal technical education.<sup>206</sup> While that may be true, it does not bode well for the litigants whose cases are the ones in which the judge is learning the technology. Moreover, as Judge Friendly lamented, many patent cases are often beyond the ability of a judge to understand even after the judge has devoted “the expenditure of an inordinate amount of educational effort.”<sup>207</sup> The concern about the amount of training that it may take to educate a judge about the science underlying a particular patent case raises what may be an intractable problem with each of the proposals to inject expertise into patent cases by increasing the scientific acumen of the judiciary. At the end of the day, judges are not scientists, and perhaps we don’t want them to be. Perhaps we want them to focus their efforts instead toward being experts in judging.

Ultimately, judges are already specialists, and their field is the law. In his excellent article written shortly after the creation of the

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<sup>203</sup> Charlie Stiernberg, *Science, Patent Law, and Epistemic Legitimacy: An Empirical Study of Technically Trained Federal Circuit Judges*, 27 HARV. J.L. & TECH. 279, 290 (2013).

<sup>204</sup> See Jeanne C. Fromer, *Patentography*, 85 N.Y.U. L. REV. 1444, 1490 (2010).

<sup>205</sup> See *id.* at 1479 (“[A] patent suit over software has little in common with one over biotechnology, automotive technology, pharmaceutical drugs, or mechanical devices.”).

<sup>206</sup> See *id.* at 1486.

<sup>207</sup> FRIENDLY, *supra* note 173, at 156–57.

Federal Circuit, Judge Richard Posner identifies the fact that in the traditional American system “[o]ur judges are specialized—to judging.”<sup>208</sup> In a footnote he continues: “And, it goes without saying, to the law.”<sup>209</sup> I am not so sure it should go without saying. Perhaps it is better to explicitly proclaim that judges are specialists in the law if only to acknowledge that there is such a specialty. It seems likely that for one to truly become a “specialist” in the law, it helps if one is a generalist with respect to the facts to which that law is to be applied. In other words, it may be that judges can be better judges if we do not ask them also to be specialists in some other skill, or some other area of inquiry. It hardly seems that we will get those individuals who have best learned the specialty of judging if we are also asking them to become experts in biochemistry or particle physics.

The Supreme Court appears to be sympathetic to such notions. As this Article has demonstrated, in recent years the Court has de-emphasized the importance of specializing in patent law while also recognizing that judges are ill-equipped to address scientific questions.<sup>210</sup> Combining those teachings does not suggest that judges should learn more science, but that they should focus upon their judicial role. As at least some justices have directly cautioned, judges should not aspire to become “amateur scientists.”<sup>211</sup> An additional concern with judges being asked to develop technical expertise is that it may not be good policy to give experts, or judges turned experts, the last word on scientific or technical issues, as experts are invariably partisan. As Professor Rai has aptly noted, “In areas of heated scientific controversy, all individuals who are sufficiently knowledgeable to qualify as experts may have already committed themselves to one or the other side of a dispute.”<sup>212</sup> Es-

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<sup>208</sup> Posner, *supra* note 34, at 778.

<sup>209</sup> *Id.* at 778 n.44; *see also* Plager, *supra* note 23, at 858 (“Lawyers who become judges become specialists in judging, regardless of the breadth of cases confronted.”); Wood, *supra* note 11, at 1768 (“[J]udges themselves are specialists in ‘judging.’”).

<sup>210</sup> *See supra* Sections II.B, III.A.

<sup>211</sup> *See* *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 601 (1993) (Rehnquist, J., dissenting); *see also id.* at 599 (recognizing that “definitions of scientific knowledge, scientific method, scientific validity, and peer review” are “matters far afield from the expertise of judges”).

<sup>212</sup> Rai, *Specialized Trial Courts*, *supra* note 60, at 893; *see also* Posner, *supra* note 34, at 782 (“I doubt that patent law, where there is a deep cleavage, paralleling the cleavages in

pecially in patent law, which by definition involves new and nonobvious discoveries,<sup>213</sup> it may be particularly important to ensure that someone who is blessedly unbiased about the underlying science or technology will serve as the final authority about those issues. The judiciary is comprised of exactly those people, experts at judging who are often ignorant of the more subtle nuances of various areas of science.

Perhaps sensitive to these concerns, some researchers have proposed solutions that do not directly involve the Article III judiciary. For example, Edward DiLello has proposed the creation of permanent expert magistrate judges,<sup>214</sup> while Eric Cheng has proposed shifting more patent cases to the International Trade Commission (“ITC”).<sup>215</sup> While those proposals avoid some of the problems associated with an expert judiciary, they may ultimately prove to be unworkable because they are too difficult to implement or involve too great a departure from the status quo for Congress to seriously consider making the necessary changes. Both proposals suffer from the same problem as the proposal to create a patent trial court. As Professor Rai noted, to solve that particular problem would require “a trial court with at least as many specialties and subspecialties as the Patent and Trademark Office.”<sup>216</sup> To solve the expertise problem with magistrate judges would also require the appointment of magistrates with different specialties in each district, as the type of expertise one magistrate judge has may not be transferable to different cases outside that magistrate’s expertise. Professor Rai lamented that “the likelihood of assembling a group of judges competent not only in law but in all of the various

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antitrust law, between those who believe that patent protection should be construed generously to create essential incentives to technological progress and those who believe that patent protection should be narrowly construed to accommodate the procompetitive policies of the antitrust laws, is such an area . . .”).

<sup>213</sup> See 35 U.S.C. §§ 102, 103 (2012).

<sup>214</sup> See Edward V. Di Lello, *Fighting Fire With Firefighters: A Proposal for Expert Judges at the Trial Level*, 93 COLUM. L. REV. 473, 499 (1993) (proposing the creation of permanent expert magistrate judges).

<sup>215</sup> See Eric B. Cheng, *Alternatives to District Court Patent Litigation: Reform by Enhancing the Existing Administrative Options*, 83 S. CAL. L. REV. 1135, 1162 (2010).

<sup>216</sup> Rai, *Specialized Trial Courts*, *supra* note 60, at 894.

fields of scientific and technical endeavor relevant to the patent system is low.”<sup>217</sup>

Another solution, outside the judiciary has also been discussed. Professor Dreyfuss considered the problem not only by analogy to the PTO, but having the PTO itself provide the necessary expertise to the patent system.<sup>218</sup> She recognized that “administrative fact-finding might be preferable to specialized trials,” and that “the scope of re-examination could be expanded to allow the PTO to reinvestigate whether a patent was properly issued.”<sup>219</sup> She did not believe, however, that the PTO was up to the task.<sup>220</sup> But while it may have been a low probability, Congress has crafted a solution that takes advantage of many of the strengths of these proposals by creating the new PTAB within the PTO. As the next Part explores, that entity avoids many of the pitfalls of prior proposals for dealing with the difficulties of patent cases.

#### IV. THE PTAB: A SOLUTION INVOLVING SPECIALIZED ADMINISTRATIVE EXPERTISE

When Congress most recently reformed the patent system, through passage of the America Invents Act (“AIA”), it continued the movement toward specialization of patent law that began with the creation of the Federal Circuit.<sup>221</sup> The newest effort is unlike the previous reforms, however, as in the AIA, Congress did not attempt to specialize the courts or rely solely upon the notion that legal expertise is developed through experience.<sup>222</sup> Instead, this newest specialization effort responds well to the reality that the difficult portion of a patent case is the technology, and finds the necessary expertise to deal with that technology in a judge’s formal

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<sup>217</sup> *Id.*; see also Jeffrey Peabody, *Under Construction: Towards a More Deferential Standard of Review in Claim Construction Cases*, 17 FED. CIR. B.J. 505, 517 (2008) (“The investment in training, time, and money to create a parallel judicial system, replete with trained judges and possibly trained juries, would be massive if not impractical.”).

<sup>218</sup> See Dreyfuss, *supra* note 20, at 74.

<sup>219</sup> *Id.*

<sup>220</sup> See *id.* at 66.

<sup>221</sup> See Leahy–Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified as amended in scattered sections of 35 U.S.C.).

<sup>222</sup> See *supra* Part I.

education.<sup>223</sup> Rather than specialize the judiciary, Congress's most recent specialization to patent law resulted in more patent disputes being shifted to an entity within the executive branch with real subject-matter expertise, the PTAB.<sup>224</sup>

*A. Specialized Expertise to Address Complex Technology*

The PTAB is currently composed of approximately 230 Administrative Patent Judges (“APJ”) appointed by the Secretary of Commerce.<sup>225</sup> Unlike most judges in the federal judiciary, each of those APJs has technical or scientific backgrounds as well as a law degree. Moreover, each of the APJs is hired to handle trials involving a particular type of technology. The qualifications for one recent job posting for a PTAB-APJ, stated that to be considered for the position applicants must possess, in addition to a law degree and experience with patent law, “a bachelor’s or higher degree in the study of engineering, chemistry, or biology” or “[a] thorough knowledge of the physical and mathematical sciences underlying professional engineering” and “[a] good understanding, both theoretical and practical, of the engineering sciences and techniques and their application to professional engineering.”<sup>226</sup> Whereas creating “a trial court with at least as many specialties and subspecialties as the Patent and Trademark Office”<sup>227</sup> may have been impossible within the judiciary, that is precisely what Congress created in the PTAB within the PTO itself. Accordingly, when an issue is considered by the PTAB, the people discussing the issue on both sides of the bench are likely to have some expertise in the technology at issue as well as familiarity with the patent laws.

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<sup>223</sup> See *supra* Part III.

<sup>224</sup> See 35 U.S.C. § 319 (2012). Formally, the PTAB is a redesignation of the old Board of Patent Appeals and Interferences (“BPAI”), albeit with greatly expanded responsibilities.

<sup>225</sup> JAMES DONALD SMITH & SCOTT R. BOALICK, U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD UPDATE 29 (May 14, 2015), [http://www.uspto.gov/sites/default/files/documents/20150514\\_PPAC\\_PTAB\\_Update.pdf](http://www.uspto.gov/sites/default/files/documents/20150514_PPAC_PTAB_Update.pdf) [<https://perma.cc/KEA6-SZNT>].

<sup>226</sup> *Administrative Patent Judge Job Posting*, USAJOBS, <https://www.usajobs.gov/GetJob/ViewDetails/406508200> [<https://perma.cc/YPU4-2LCB>] (last visited Mar. 6, 2016).

<sup>227</sup> Rai, *Specialized Trial Courts*, *supra* note 60, at 894.



While the notion of the development of technical expertise is fairly new to the judiciary, the PTO has long held the view that technical knowledge is necessary to apply patent law to new technologies. Therefore, only registered patent attorneys or agents may practice before the PTO.<sup>228</sup> To become a registered patent attorney or agent, one must both have a particular technical or scientific background as well as pass the “Patent Bar,” the PTO’s “registration examination.”<sup>229</sup> For its part, the PTO also requires that patent examiners have some specialized technical expertise.<sup>230</sup> Unlike the historically generalist court system, the internal workings of the PTO are highly specialized with examiners working within a particular “art unit.” Those distinctive aspects of the PTO are all maintained for the PTAB.

The use of the PTAB to resolve patent issues therefore comports with commentators’ views that patent cases may benefit from increased specialization. Because Congress’s effort has resulted in the appointment of subject-matter experts as patent judges, it fulfills the goals of commentators who proposed solutions such as the creation of a patent court.<sup>231</sup> While the use of technically expert judges is yet a further specialization of patent law, it is quite different from the specialization of the courts and judges that Congress previously attempted, as it is not an effort to make the law special or to create legal expertise through experience, but rather, it is a reaction to the reality that dealing with cutting edge technology is what is special about patent cases. Thus, the PTAB also avoids many of the objections to Congress’s earlier specialization efforts detailed above. The use of an executive agency, rather than the judiciary, to apply patent laws to the technically difficult subject matter of patents addresses many of the concerns of commentators and the Supreme Court. By making an executive agency fulfill that role, the courts remain free to complete the role the Supreme Court envisions, that of unbiased non-experts in technical matters.

The PTAB does not address all of the issues involving technology that may arise in patent cases, however. Instead Congress li-

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<sup>228</sup> See 37 C.F.R. §§ 11.5–.9 (2012).

<sup>229</sup> See U.S. PATENT & TRADEMARK OFFICE, *supra* note 1, at 2.

<sup>230</sup> See *id.* § 11.7(a).

<sup>231</sup> See *supra* Section I.A.

mitted its role to one of addressing issues of a patent's validity. The first major role played by the PTAB is to serve as an appellate body, giving patent applicants an opportunity to obtain a second opinion from the PTO about a patent examiner's decision to deny a patent application. The PTAB's other major role is to conduct adjudications and issue decisions in two types of proceedings created by the AIA: Post-Grant Review ("PGR") and Inter Partes Review ("IPR").<sup>232</sup> The PGR procedure allows someone other than the patent owner to challenge the validity of a patent within nine months after the patent has been issued.<sup>233</sup> The IPR procedure is similar except that the person challenging the patent as invalid may only file the challenge after a PGR has been completed or the time period for filing a PGR has elapsed.<sup>234</sup> The issues the administrative law judges who make up the PTAB may consider are also different between the two proceedings. During a PGR, the PTAB may invalidate a patent based upon any ground that could be raised during a patent infringement trial, whereas during an IPR a patent can be invalidated only if it is not novel, is obvious, or both.<sup>235</sup> Those post-grant proceedings are adversarial in nature, and much like a district court trial, involve discovery and oral argument. They differ from district court trial proceedings, however, in that PTAB decisions are made by a panel of three judges, as opposed to the district court model, which involves a single judge. Importantly, decisions of the PTAB as to a patent's validity have preclusive effect on the party that raises a post-grant challenge, as the petitioner is subject to estoppel in district court. Specifically, once the PTAB issues a final written decision, the petitioner may not assert in any civil action "that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during" the proceed-

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<sup>232</sup> See 35 U.S.C. §§ 6(b), 311-29 (2012). The PTAB is also responsible for conducting proceedings specifically related to challenges to "covered business methods," a provision scheduled to expire in 2020. See Pub. L. 112-29, 125 Stat. 284, 329-30 (2011).

<sup>233</sup> See 35 U.S.C. § 321.

<sup>234</sup> See 35 U.S.C. § 311(c).

<sup>235</sup> Compare 35 U.S.C. § 321(b) (referencing 35 U.S.C. § 282(b)(2) and (3)), with 35 U.S.C. § 311(b). The standards are also different, as PGR's are initiated if the PTAB finds that it is "[m]ore likely than not that at least one of the claims challenged in the petition is unpatentable," whereas an IPR will be permitted if the PTAB finds a "reasonable likelihood that the petition will prevail with respect to at least one of the claims challenged in the petition." Compare 35 U.S.C. § 324, with 35 U.S.C. § 314(a).

ing.<sup>236</sup> The PTAB's decision does not, however, estop parties who are not party to the PTAB proceeding. The PTAB also does not address issues of infringement, which continue to be addressed by district court judges and juries.

### B. *A Proposal to Expand the Role of the PTAB*

By creating the PTAB, and implementing an administrative system to allow for post-grant review of patents, Congress has achieved multiple benefits that commentators previously touted from such a procedure, including cost savings and increased efficiency versus district court proceedings.<sup>237</sup> One very tangible difference is that by statute, PTAB must resolve disputes significantly faster than the normal time it takes to complete district court proceedings.<sup>238</sup> In addition, as this Article describes, the PTAB adds a level of expertise that is often absent from district courts proceedings.<sup>239</sup> Indeed, the potential benefits of expert agency adjudication of patent law issues are so great, that one might think that it makes sense to ask the executive to decide all issues in patent cases; both validity and infringement, and to exclude the courts entirely. Under current law, district court judges continue to decide, in addition to questions of infringement, whether a patent is valid in the first place.<sup>240</sup> A district court is called upon to evaluate patent validity both when a validity defense is raised in a patent infringement suit as well as when an unsuccessful patent applicant sues the PTO in district court directly to obtain a patent.<sup>241</sup> In either procedural posture, a district judge must decide patent validity questions that, as this Article has outlined, the PTAB may be in a better position to address.<sup>242</sup> As a result, there are inefficiencies in the current system, not the least of which is that litigants prepare for the infringement portion of litigation even while the validity of a patent is

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<sup>236</sup> See 35 U.S.C. § 315(e) (inter partes review); 35 U.S.C. § 325(e) (post-grant review).

<sup>237</sup> See, e.g., Stuart Minor Benjamin & Arti K. Rai, *Who's Afraid of the APA? What The Patent System Can Learn from Administrative Law*, 95 GEO. L.J. 269, 270 (2007).

<sup>238</sup> See Karen A. Lorang, *The Unintended Consequences of Post-Grant Review of Patents*, 17 UCLA J.L. & TECH. 1, 22 (2013) (describing the increased efficiency and reduced costs associated with the PTAB versus the district courts).

<sup>239</sup> See *id.* at 24.

<sup>240</sup> See 35 U.S.C. § 145.

<sup>241</sup> See *id.*

<sup>242</sup> See *supra* Section IV.A.

uncertain. Against this backdrop, it is worth considering whether some expansion of the PTAB's role is advisable. Ultimately, I do not advocate quite such an extreme proposal as removing all patent cases from district courts. In my estimation, the PTO could not be authorized to decide cases of alleged patent infringement. On the other hand, expanding the role of the PTAB to address all validity issues—while removing those issues from the courts—is a path forward that has substantial advantages.

Rather than employing the PTAB's expertise to resolve only some portion of validity disputes, one possible solution to the current problem of forcing unequipped district courts to decide patent validity issues is to employ the PTAB's expertise in all circumstances in which patent validity questions arise. Under current law, the PTAB is merely an alternative forum for deciding questions of patent validity.<sup>243</sup> My solution would involve making the PTAB the exclusive forum for raising those questions. Under my proposed structure, the PTAB would address validity questions not only when a party seeks to invoke that forum, but also whenever a patent is asserted in any civil suit and a defendant questions its validity. That could be accomplished either by instituting a system by which district court judges refer validity questions to the PTAB or by requiring a party to raise validity challenges at the PTAB shortly after an infringement suit is filed. Under this proposal, the courts therefore would deal only with issues of infringement.<sup>244</sup>

The reason it is possible to shift only determinations of a patent's validity to the PTAB, as opposed to questions of whether a patent is infringed, is because of the fundamental difference between questions of infringement and validity. As the Supreme Court long ago held, patent infringement is a tort.<sup>245</sup> Like other torts, patent infringement involves a civil suit, which, accordingly, must be decided by Article III courts with access to a jury under the

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<sup>243</sup> See 35 U.S.C. § 134(a).

<sup>244</sup> This proposal would be a case of convergent evolution, as in the German patent system issues of validity are determined by technical courts whereas issues of infringement are handled by generalists. See M.A. Smith et al., *Arbitration of Patent Infringement and Validity Issues Worldwide*, 19 HARV. J.L. & TECH. 299, 334 (2006).

<sup>245</sup> See *Schillinger v. United States*, 155 U.S. 163, 169 (1894).

Seventh Amendment to the Constitution.<sup>246</sup> The same is not true of questions about a patent's validity. Rather, the issue of a patent's validity is an issue between the federal government and the potential patentee, and as such it is a public right.<sup>247</sup> When the federal government grants a patent, the government grants "a bundle of rights," including the right to exclude others from using the claimed invention.<sup>248</sup> Congress grants that monopoly pursuant to its constitutional authority under the Patent Clause.<sup>249</sup> Because the patent rights are created by Congress, they fall within the "public rights" exception to Article III of the Constitution.<sup>250</sup> They may therefore be decided outside the judicial context.<sup>251</sup> In other words, they may be decided outside of the courts created under Article III of the Constitution, and without a jury.<sup>252</sup>

Of course, just because it is constitutionally permissible to transfer authority for deciding patent validity questions from the courts to an administrative entity does not mean that course of action should necessarily be followed. Still, there is reason to think that doing so might be an improvement upon the status quo. Although under this proposal, patent infringement determinations would still be made by district courts, assigning validity determina-

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<sup>246</sup> See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376–77 (1996); see also Philippe Signore, *On the Role of Juries in Patent Litigation (Part 1)*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 791, 795 (2001) ("[W]hy do U.S. courts allow juries to decide patent cases? Because the U.S. Constitution, in its Bill of Rights, requires it.").

<sup>247</sup> See *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604 (Fed. Cir. 1985).

<sup>248</sup> See *Alfred E. Mann Found. for Sci. Research v. Cochlear Corp.*, 604 F.3d 1354, 1360 (Fed. Cir. 2010).

<sup>249</sup> See U.S. CONST. art. I, § 8, cl. 8.

<sup>250</sup> See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 n.5 (1964) ("Patent rights exist only by virtue of statute."); Michael P. Goodman, *Taking Back Takings Claims: Why Congress Giving Just Compensation Jurisdiction to the Court of Federal Claims Is Unconstitutional*, 60 VILL. L. REV. 83, 98–101 (2015) (describing the public rights category as one of the exceptions to Article III).

<sup>251</sup> See, e.g., *Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n*, 430 U.S. 442, 455 (1977) ("[W]hen Congress creates new statutory 'public rights,' it may assign their adjudication to an administrative agency with which a jury trial would be incompatible, without violating the Seventh Amendment's injunction that jury trial is to be 'preserved' in 'suits at common law.' . . . This is the case even if the Seventh Amendment would have required a jury where the adjudication of those rights is assigned instead to a federal court of law instead of an administrative agency.").

<sup>252</sup> See *Stern v. Marshall*, 131 S. Ct. 2594, 2612–13 (2011); see also Mark A. Lemley, *Why Do Juries Decide If Patents Are Valid?*, 99 VA. L. REV. 1673, 1722 (2013).

tions exclusively to the PTAB effectively fills a gap in the courts' ability to decide some of the most difficult issues in patent cases.<sup>253</sup> The Supreme Court has most lamented the judiciary's lack of expertise not in dealing with whether a patent is infringed, but in deciding whether it is valid. From the Court's perspective, "it is often more difficult to determine whether a patent is valid than whether it has been infringed."<sup>254</sup> Accordingly, permitting the executive PTAB to decide validity issues has the benefit of removing from the judiciary to the executive only the type of work that most likely requires subject matter expertise. By limiting the PTAB's jurisdiction to issues of patent validity, Congress has already successfully thread the needle to account for the apparent need for more subject-matter expertise in dealing with patents while also maintaining the generalist ideals of the judiciary by separating the most difficult of the technological questions from the judges.

There are a number of reasons why making the PTAB the exclusive forum for addressing patent validity makes sense. As Professor Stuart Benjamin and Professor Rai, among others, have explained, the cost and efficiency benefits that are achieved by a system of post-grant review are maximized when trial court litigation on patents that survive examination is minimized.<sup>255</sup> As those professors also note, however, when that result is achieved through estoppel-based approaches, like those applicable to PTAB proceedings under the current framework, there is a disincentive for someone to challenge the validity of a patent at the PTAB.<sup>256</sup> If that challenge is unsuccessful, that party, and only that party, is barred from raising validity challenges in an infringement case.<sup>257</sup> In addition, that procedure is inefficient because the unsuccessful challenge that resulted in a finding of patent validity only prevents another validity challenge by the same party, but does not prevent future challenges in district court by other parties.<sup>258</sup> Professors Benjamin and Rai suggest that these inefficiencies can be mitigated by requir-

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<sup>253</sup> See *supra* Section IV.A.

<sup>254</sup> *Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1930 (2015) (quoting *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 99 (1993)).

<sup>255</sup> See Benjamin & Rai, *supra* note 237, at 323.

<sup>256</sup> See *id.* at 324.

<sup>257</sup> See *id.*

<sup>258</sup> See *id.*; see also *supra* note 236 and accompanying text.

ing courts to give strong *Chevron* deference to the agency's post-grant validity determinations.<sup>259</sup> As they note, the effect of that increased deference would be that all parties potentially affected by a patent would feel the effects of the PTAB's decisions, "that all potential infringers would have an incentive to help the administrative opponent" and that the deference would "presumably lead to diminished litigation over these patents."<sup>260</sup> Those beneficial effects would be amplified if the PTAB were the exclusive forum for raising validity questions. All potential infringers have an even stronger incentive to intervene at the PTAB. In addition, rather than only a presumption of reduced litigation, there would necessarily be a reduction. From a district court's perspective, the effect of making the PTAB the exclusive forum for challenging patent validity is that the current statutory mandate to presume the validity of the patents at issue would change from a presumption to an absolute rule. Before a district court spent valuable time deciding whether a patent was infringed, the patent's claims would have already been judged to be valid, as the PTAB's determination of validity, after any associated appeal to the Federal Circuit or Supreme Court, would be the final say on the matter.<sup>261</sup> While a party that is not estopped by a validity decision of the PTAB could, of course, ask the PTAB to again consider that patent's validity, because those proceedings are cheaper and faster than district court proceedings, even duplicative challenges at the PTAB would be more efficient than the current system.<sup>262</sup>

Another benefit of PTAB adjudication is that when its decisions are reviewed, including by the Supreme Court, the decisions are likely to, and should, be afforded considerable deference. While commentators have recognized that the courts historically lack de-

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<sup>259</sup> See Benjamin & Rai, *supra* note 237, at 326–27. They are joined in this proscription by multiple commentators. See, e.g., Doug Lichtman & Mark A. Lemley, *Rethinking Patent Law's Presumption of Validity*, 60 STAN. L. REV. 45, 50 (2007) (“[D]ecisions made as part of that more intense review should be accorded deference by later decision-makers.”); Jacob S. Sherkow, *Administrating Patent Litigation*, 90 WASH. L. REV. 205, 266 (2015) (“[C]ourts can—and should—follow the practice of finding the PTO's and ITC's determinations persuasive, even if not technically binding.”).

<sup>260</sup> Benjamin & Rai, *supra* note 237, at 326–27.

<sup>261</sup> See 35 U.S.C. § 145 (2012).

<sup>262</sup> See Benjamin & Rai, *supra* note 237, at 325.

ference to the PTO, that fact has largely been attributed to the perceived lack of patent experience, technical expertise, or time that patent examiners can apply to reviewing applications.<sup>263</sup> The patent examiners were thought to make errors because of a perceived asymmetry between the knowledge of the patent examiner and the patent applicant.<sup>264</sup> The same criticisms do not appear to have been lodged against the PTAB, and likely will not be, at least to the same extent. Far from the “abbreviated proceedings”<sup>265</sup> that take place during patent examination, the PTAB conducts trial-type proceedings before it issues decisions.<sup>266</sup> The PTAB also sits in three-judge panels in an effort to maintain a high quality of decisions. Finally, as commentators have noted when surveying the qualifications of the ALJs generally “the USPTO is delivering on its goal of recruiting administrative patent judges with strong technical backgrounds and extensive experience practicing patent law.”<sup>267</sup> Accordingly, within the current or expanded framework, the PTAB’s decisions about a patent’s validity should garner substantial deference in the courts.

With respect to the Supreme Court, patent people have been very vocal that the Supreme Court’s involvement in patent law is not helping. As Judge Dyk has related: “At any gathering of the [patent] bar, no tag line of a speech has more assurance of applause than one that importunes the Supreme Court to keep its hands off

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<sup>263</sup> See Joshua L. Sohn, *Can’t the PTO Get a Little Respect?*, 26 BERKELEY TECH. L.J. 1603, 1631 (2011) (collecting and describing criticisms of the PTO).

<sup>264</sup> See Dreyfuss, *supra* note 20, at 66–67; see also Sean B. Seymore, *Patent Asymmetries*, 49 U.C. DAVIS L. REV. 101, 114–38 (2016).

<sup>265</sup> Mark A. Lemley, *Reconceiving Patents in the Age of Venture Capital*, 4 J. SMALL & EMERGING BUS. L. 137, 146 (2000); see also Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U. L. REV. 1495 (2001).

<sup>266</sup> For a detailed description of PTAB procedures, see Eric C. Cohen, *A Primer on Inter Partes Review, Covered Business Method Review, and Post-Grant Review Before the Patent Trial and Appeal Board*, 24 FED. CIR. B.J. 1, 10 (2014).

<sup>267</sup> JENNIFER R. BUSH, FENWICK & WEST LLP, ADMINISTRATIVE PATENT JUDGES: NOT YOUR TYPICAL FEDERAL JUDGE 2 (2014), [https://www.fenwick.com/Fenwick/Documents/Administrative\\_Patent\\_Judges.pdf](https://www.fenwick.com/Fenwick/Documents/Administrative_Patent_Judges.pdf) [<https://perma.cc/EAX8-UPD7>] (last visited Feb. 16, 2016); see also Michael Wagner, *An Introduction to Administrative Patent Judges at the Patent Trial and Appeal Board*, 62 FED. LAW., May 2015, at 36 (“With this broad amount of experience, the PTAB provides a well-rounded perspective and expertise in the area of patent law.”).



the patent law.”<sup>268</sup> If, as some have proposed, the Supreme Court is likely “to bungle the law in a highly technical field such as patent law” then shifting more of the work related to patents to the PTAB may achieve the desirable outcome of increased “neglect by the Court.”<sup>269</sup> The Supreme Court is likely to defer to the PTAB’s factual judgment in a way it has not been willing to defer to the Federal Circuit’s legal judgment. While district courts and the Federal Circuit have generally not afforded the PTO deference in the past, the Court has expressed a willingness to respect and defer to the judgment of the PTO that it has not shown subsidiary courts.<sup>270</sup> The Court has also recently referred to the PTO as “an expert agency” with “special expertise in evaluating patent applications.”<sup>271</sup>

In that way, the PTO, and the PTAB, is no different from the various other administrative agencies whose expertise is given substantial deference by the courts. Just as Environmental Protection Agency (“EPA”) decisions about acceptable pollutant levels are reviewable by courts only to ensure that those decisions are not arbitrary, capricious, or an abuse of discretion—the APA’s standard<sup>272</sup>—the PTO’s decisions about a patent’s validity should be afforded great deference upon review. Indeed, while this discussion has assumed that the Court is correct that there is something special about the subject matter underlying patent cases, that may be true only because patent disputes are one of the few categories of cases in which courts are required to do a more searching review of agency fact finding than that required by the APA.<sup>273</sup> Indeed, the science or technology involved in EPA decisions is often just as difficult to grasp as in patent cases. In actual fact, there may be noth-

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<sup>268</sup> Timothy B. Dyk, *Does the Supreme Court Still Matter?*, 57 AM. U. L. REV. 763, 763 (2008); see also Gene Quinn, *Naked Emperors: A Supreme Court Patent Tale*, IPWATCHDOG (May 31, 2015), <http://www.ipwatchdog.com/2015/05/31/naked-emperors-a-supreme-court-patent-tale/id=58110/> [https://perma.cc/4TUC-BAUN] (last visited Feb. 16, 2016) (“The idea that the Supreme Court is at all capable of understanding—let alone deciding—issues of a technical nature is ridiculous.”).

<sup>269</sup> Duffy, *supra* note 72, at 276.

<sup>270</sup> See *Dickinson v. Zurko*, 527 U.S. 150 (1999).

<sup>271</sup> *Kappos v. Hyatt*, 132 S. Ct. 1690, 1700 (2012); *Microsoft Corp. v. i4i Ltd.*, 131 S. Ct. 2238, 2252 (2011).

<sup>272</sup> See Benjamin & Rai, *supra* note 237, at 283.

<sup>273</sup> See *id.* at 285.

ing special about patent cases except that courts have heretofore been given an overly large role in resolving them. Shifting some of this burden to the executive may lead to the realization that there really isn't anything special about patent cases.

Perhaps the most important benefit of having an executive entity decide questions of validity, while the courts continue to decide questions of patent infringement, derives from the unique status patent validity questions have in our society. As previously noted, unlike disputes about whether a patent has been infringed, patent validity issues involve public rights.<sup>274</sup> That means that unlike questions involving infringement, a validity challenge is a complaint about government conduct. Whereas questions of infringement are private disputes that are largely irrelevant to most Americans, issues related to a patent's validity are question of concern to many, and are properly thought of as public, rather than private, law.<sup>275</sup> Because a patent grant is a monopoly issued from the government, a patent's validity raises issues of public policy and is of legitimate interest to members of the public, including many who may be uninvolved in any particular infringement suit. In the litigation context, those members of the public can rarely, if ever, have their voices heard. Still, the importance of patent validity issues has increasingly resulted in special interest groups trying to get more involved. Indeed, along with the Supreme Court's interest in patent law, special interest groups and the public at large have increasingly been interested in patent law because of the importance of the grant of a patent to society and not only to the litigating parties. In *Myriad*, for example, forty-nine different groups filed amicus briefs to express their views about the patentability of DNA, including the American Medical Association and the AARP,<sup>276</sup> and an incredible sixty-six amicus briefs were filed in *Bilski*.<sup>277</sup> Because anyone who is not the owner of the patent may challenge a patent's

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<sup>274</sup> See *supra* note 250 and accompanying text.

<sup>275</sup> See Megan M. La Belle, *Patent Law as Public Law*, 20 GEO. MASON L. REV. 41, 41–42 (2012).

<sup>276</sup> See *Association for Molecular Pathology v. Myriad Genetics, Inc.*, SCOTUSBLOG, <http://www.scotusblog.com/case-files/cases/association-for-molecular-pathology-v-myriad-genetics-inc/> [https://perma.cc/4W86-H4E9] (last visited Feb. 16, 2016).

<sup>277</sup> See *Bilski v. Kappos*, SCOTUSBLOG, <http://www.scotusblog.com/case-files/cases/bilski-v-kappos/> [https://perma.cc/L6YB-75QN] (last visited Feb. 16, 2016).

validity at the PTAB, special interest groups are now able to get involved in a more significant way than they could before passage of the AIA.<sup>278</sup> And that is a good thing. The involvement by such groups will likely have the effect of ensuring that the PTAB is responsive to the policies underlying the patent laws, in a way that courts, including the Federal Circuit, were not, and could not be.<sup>279</sup> While “allowing parties who would not satisfy federal standing requirements to challenge a patent’s validity and raise novel and unsettled legal questions through the post-grant review process” has been described as an “unintended consequence” of the AIA, it provides an important opportunity to involve the public in those issues of patent law that affect the public generally.<sup>280</sup> Whereas it is inappropriate for courts to decide individual disputes about infringement based upon issues of public policy, administrative agencies are specifically tasked with the role of accounting for public policy as they fill gaps in legislation.<sup>281</sup> It is therefore altogether appropriate that issues of validity be decided by the PTO’s PTAB.

#### CONCLUSION

The law applicable to patent cases is not especially difficult. Rather, the technology underlying patent cases is often what gives the judiciary trouble. Accordingly, Congress’s efforts to develop specialized legal expertise in the judiciary may have been misguided. A better solution to deal with what ails the judiciary about patent disputes is to focus expertise toward addressing the underlying technology. Congress’s latest experiment in specializing the patent bo-

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<sup>278</sup> See 35 U.S.C. § 321(a) (2012). They do not, however, necessarily have standing to appeal the PTAB’s determinations to the Federal Circuit. See *Consumer Watchdog v. Wis. Alumni Research Found.*, 753 F.3d 1258, 1260 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015).

<sup>279</sup> See Craig Allen Nard & John F. Duffy, *Rethinking Patent Law’s Uniformity Principle*, 101 Nw. U. L. REV. 1619, 1620 (criticizing the Federal Circuit for not adequately reflecting “current knowledge regarding the beneficial functions of the patent system in generating technological innovation, the potential problems of patent rights in foreclosing legitimate competition, and the need for predictable rules capable of curtailing litigation costs”). *But see* Plager, *supra* note 27, at 759 (responding to Nard and Duffy by noting that it is not the role of courts to adapt the law to public policy concerns).

<sup>280</sup> Lorang, *supra* note 238, at 16.

<sup>281</sup> See Benjamin & Rai, *supra* note 237, at 280.

dies, the creation of the PTAB, employs specialization at the administrative, rather than the judicial, level and appears to be a viable solution to the judiciary's problem with patent cases. By giving that agency jurisdiction to decide some of the thorniest issues in patent cases, questions about patent validity, Congress has made real progress in this area. The PTAB experiment does not yet go far enough, however. To more fully capture the benefit of administrative expertise, Congress should consider expanding the PTAB's jurisdiction to make it the exclusive forum for challenging the validity of issued patents.