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## Lawyering Within the Domain of Expertise

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# LAWYERING WITHIN THE DOMAIN OF EXPERTISE

*David McGowan\**

## INTRODUCTION

Suppose the Food and Drug Administration (FDA) drug approval process was structured as criminal trials are structured and FDA lawyers embraced the epistemology of such trials—who's to say what is safe and effective? That's up to the jury. Would you feel better about the drugs you take?

Possibly you think the question absurd. You might say that the different procedures have served different purposes and have been thought to implicate different values. True enough, historically, but no rule of reason makes it so. Technology, such as DNA matching, affects whether and how to try criminal cases, and there is no reason to think the influence of technology will lessen. The best approach to the question would be to argue that we do not want drug approvals to resemble criminal trials, but that nothing follows from this fact—which doesn't answer the question.

So, would you feel better?

This Article uses the history of patent prosecution to assess the relationship between the practice of law and the claim of an administrative agency to possess and to employ expertise. By “expertise” I mean knowledge and procedures supported by consensus sufficient to justify the use of words like “fact” and “science.” Expertise is a premise of certain types of regulation in the modern administrative state. It is essential to one of the main promises of administration, which is that through rational inquiry, we can learn the truth of the matter about some topic and then regulate according to that truth. Expertise is more important to some forms of regulation than to others, and it cannot answer all questions, but the concept is useful when analyzing the roles lawyers play in the regulatory state.

An initial qualification is in order and will be elaborated later. An agency that promises to use expertise to get at the truth might not do so. It might not have expertise in the first place; even if it does, it may bend to the political winds rather than use it. My argument is different. It is that where

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\* Lyle L. Jones Professor of Competition and Innovation Law, University of San Diego School of Law. My thanks to my colleagues at the University of San Diego, where I presented this Article, and in particular to Ted Sichelman and Maimon Schwarzschild for their helpfully skeptical comments. Any mistakes are my fault. This Article is part of a larger colloquium entitled *Lawyering in the Regulatory State* held at Fordham University School of Law. For an overview of the colloquium, see Nancy J. Moore, *Foreword: Lawyering in the Regulatory State*, 84 *FORDHAM L. REV.* 1811 (2016).

an agency *claims* expertise, that claim will lead it to give lawyers appearing before it less leeway than lawyers generally have.

Agency officials claiming to exercise expertise need information to which they may apply it. A patent examiner charged with deciding whether a claimed invention is novel and nonobvious relative to the prior art needs to know what that art includes. The FDA needs to know whether a drug is safe and effective, and it requires data demonstrating these points. Within the domain of expertise, therefore, firms and persons are subordinate to an agency's larger regulatory mission. Their role is largely to provide information the experts need and, possibly after some argument, to do what the experts say. An agency claiming expertise is likely to think lawyers should subordinate their skills to its mission as well.

#### I. THE UNEVEN RELATIONSHIP BETWEEN PATENT EXAMINATION AND EXPERTISE

Rule 56 of the Patent and Trademark Office (PTO) asserts that “[a] patent by its very nature is affected with a public interest.”<sup>1</sup> The rule imposes on “[e]ach individual associated with the filing and prosecution of a patent application” a “duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.”<sup>2</sup> “Each individual” includes “[e]ach attorney or agent who prepares or prosecutes the application.”<sup>3</sup> The PTO's more recently enacted Rule 11.106(b)(2) permits lawyers to disclose confidential or privileged information to the extent reasonably necessary to prevent a client from engaging in “inequitable conduct” before the PTO.<sup>4</sup>

In contrast to the excessive notoriety surrounding the SEC's Sarbanes-Oxley Rules, the PTO's Rule 56 has received comparatively little attention since it was first adopted in 1977. The PTO's broad rule of permissive disclosure, adopted in the PTO's 2013 revision of its rules, has received even less. In part, this is because patent prosecution is *ex parte*, and there is a plausible analogy between the PTO rules and the general principle that in *ex parte* proceedings lawyers must disclose material facts.<sup>5</sup> But PTO practice long predates the American Bar Association Model Rules, and, unlike *ex parte* practice in litigation, in the first instance, patent prosecution is one-sided by design.

We begin with the experience that led to the adoption of the PTO rules. As Jerry Mashaw has written, “[T]he first independent agency at the national level was not the [Interstate Commerce Commission], but the

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1. 37 C.F.R. § 1.56 (2015).

2. *Id.*

3. *Id.* § 1.56(c)(2).

4. *Id.* § 11.106(b)(2).

5. MODEL CODE OF PROF'L CONDUCT r. 3.3(d) (AM. BAR ASS'N 2015).

Patent Office, created ninety-seven years earlier,”<sup>6</sup> and we can learn much from its evolution.

*A. Patents and Pigeonholes:  
Strict but Informal Review from 1789 to 1793*

Article 1, section 8 of the U.S. Constitution gives Congress the power to grant inventors, for a limited time, the exclusive right to their discoveries.<sup>7</sup> The power to grant patents differs from some other forms of regulation—a patent is something an inventor asks for, while many regulations are imposed by agencies on the unwilling. Nevertheless, patents regulate competition in making, using, and selling inventions, and it is their purpose to do so.<sup>8</sup>

When the first Congress convened, aspiring patentees took the logical step of petitioning Congress directly for an act granting exclusive rights.<sup>9</sup> John Churchman was one aspirant; he averred that “by several years’ labor, close application, and at great expense,” he had discovered magnetic means for deriving longitude from a given latitude.<sup>10</sup> He asked “that a law may pass for vesting in the petitioner, his heirs and assigns, an exclusive right of vending of spheres, hemispheres, maps, charts, and tables, on his principles of magnetism, throughout the United States.”<sup>11</sup>

Congress acted decisively: it appointed a committee. Committee members met with Churchman to hear about his invention. Churchman brought a map and globe illustrating his ideas, and the committee was impressed enough to recommend that he be granted exclusive rights.<sup>12</sup> Congress was not going to appoint committees for every petition, though, and it discovered the virtues of delegation in short order. It tabled Churchman’s petition and drafted legislation to kick the patent problem to the Executive.<sup>13</sup>

The 1790 Patent Act (“the 1790 Act”) created a board comprised of the Attorney General and the Secretaries of State and War to review applications, which would be granted with two of the three votes.<sup>14</sup> The relevant officials were Thomas Jefferson, Edmund Randolph, and General

6. Jerry L. Mashaw, *Recovering American Administrative Law: Federalist Foundations, 1787–1801*, 115 *YALE L.J.* 1256, 1260 (2006).

7. U.S. CONST. art. I, § 8.

8. See generally Mark A. Lemley, *Taking the Regulatory Nature of IP Seriously*, 92 *TEX. L. REV.* 107 (2014).

9. See P.J. Federico, *The First Patent Act*, 14 *J. PAT. OFF. SOC’Y* 237, 237–38 (1932).

10. *Id.* at 239.

11. *H.R. JOURNAL*, 1st Cong., 1st Sess. 14 (1789). He also sought “the patronage of Congress to enable him to perform a voyage to Baffin’s Bay, for the purpose of making magnetical experiments . . . .” Federico, *supra* note 9, at 239. This petition caused congressional knees to jerk in different directions. James Madison, busily espousing strict limitations on national power to oppose Hamilton’s financial plans, wanted to send Churchman to Baffin Bay. *Id.* at 240.

12. *Id.* at 239–40.

13. *Id.*

14. See, e.g., LEONARD D. WHITE, *THE FEDERALISTS: A STUDY IN ADMINISTRATIVE HISTORY* 136–37 (1948).

Henry Knox.<sup>15</sup> They called themselves the “Board of Arts”;<sup>16</sup> others called them the Patent Commission or Patent Board.<sup>17</sup> The 1790 Act instructed the board to grant patents only to petitions that claimed inventions the board judged “sufficiently useful and important” to deserve a patent.<sup>18</sup>

This first move toward administration was modest, and procedures were flexible.<sup>19</sup> Petitions for patents were “noted in the minute book, in which petitions are filed together in the desk up stairs in one of the pigeon holes [sic].”<sup>20</sup> Another pigeonhole held petitions decided and drafts of patents to be issued. “Some of the specifications are in said desk, and others in the closet.”<sup>21</sup> The Board of Arts met monthly to read applications.<sup>22</sup> The board required applicants to submit specifications according to forms; applicants with a lawyer used one form and applicants doing it themselves used another.<sup>23</sup> In doubtful cases, Jefferson decided whether a specification was clear enough.<sup>24</sup> Specifications were delivered to members of the Board of Arts at home and were sent from one member to another as read.<sup>25</sup>

Administration was informal but hands-on. A letter from Jefferson to a professor of chemistry at the University of Pennsylvania provides an example:

Congress having referred to me a petition from a person of the name of Isaacs, setting forth that he has discovered an easy method of rendering sea-water potable, I have had a cask of sea-water procured, and the petitioner has erected a small apparatus in my office, in order to exhibit his process. Monday morning 10 [o’]clock is fixed on as the time for doing it. It would give me great satisfaction to be assisted on the occasion by your chemical knowledge . . . .<sup>26</sup>

Apart from the delightful vision of Jefferson spitting out unpurified seawater in his office, this example reflects the informal and relatively ad hoc nature of the early patent system. The need for expertise was acute, and Jefferson knew as well as anyone that he was not qualified, and did not

15. KENNETH W. DOBYNS, *THE PATENT OFFICE PONY: A HISTORY OF THE EARLY PATENT OFFICE* 23 (1994).

16. *Id.*; Letter from Thomas Jefferson to Henry Knox (July 22, 1791), <http://founders.archives.gov/documents/Jefferson/01-20-02-0307> [<https://perma.cc/Q5CR-B7P4>].

17. DOBYNS, *supra* note 15, at 23.

18. Patent Act of 1790, ch.7, § 1, 1 Stat. 109–12.

19. Further Memoranda from Henry Remsen, Jr. (1792), <http://founders.archives.gov/documents/Jefferson/01-17-02-0099-0010#TSJN-01-17-0136-fn-0001-ptr> [<https://perma.cc/G29X-9YG9>].

20. *Id.*

21. *Id.*

22. *Id.*

23. *Id.*

24. *Id.*

25. See Letter from Thomas Jefferson to Henry Knox, *supra* note 16. Under the 1790 Act, these were due upon issuance of the grant; in the 1793 Act, they were due with the application. Patent Act of 1790, ch. 7, § 2, 1 Stat. 109–12; Patent Act of 1793, ch. 11, § 3, 1 Stat. 318–23.

26. Letter from Sec’y of State to James Hutchison (Mar. 12, 1791), <http://founders.archives.gov/?q=potable%20Author%3A%22Jefferson%2C%20Thomas%22&s=1111311113&sa=&r=3&sr=> [<https://perma.cc/8KCP-CBB8>].

have the time, to pass on every invention claimed in any field. In 1792, Jefferson asked to be relieved from this duty.<sup>27</sup>

Under Jefferson's leadership, the Board of Arts was said to have "extremely high ideals as to the standard and dignity of the grant."<sup>28</sup> The board reviewed applications rigorously and demanded proof that the application specified an invention worthy of a patent.<sup>29</sup> Disappointed applicants had no right of appeal, so they were no happier than Jefferson.<sup>30</sup> The system "was considered by the industrial classes to be inimical to their welfare."<sup>31</sup> Given Jefferson's own views, it seems too strong to say that "the act of 1793 was passed at their instance,"<sup>32</sup> but it does seem that both sides of the application process were happy to see the end of the system put in place by the 1790 Act.

The country's first experience with patent grants yielded two lessons relevant here. From the start, the procedures distinguished between inventors represented by counsel and inventors prosecuting their own applications. The advantages of counsel waned in the next period of administration but were later revived and persist to this day. And examination strained the patience and resources of administrators and frustrated applicants. This tension, too, persists under all forms of examination.

### B. Registration:

#### *The Cure for Strict Review Is No Review, 1793 to 1836*

The 1793 Patent Act ("the 1793 Act") allocated authority over patents to the State Department but eliminated substantive review of petitions. Section 3 of the Act required that inventors swear an oath that, to their knowledge, they were the true inventor of the discoveries claimed in the petition.<sup>33</sup> Section 1 of the 1793 Act required novelty—that the petition claim a "new and useful" invention, but absent examination enforcement of this term rested on the oath.<sup>34</sup> The 1793 Act is commonly said to have instituted a system of registering rather than examining petitions.<sup>35</sup>

27. Letter from Thomas Jefferson to Hugh Williamson (Apr. 1, 1792), <http://founders.archives.gov/?q=%22hugh%20williamson%22%20Author%3A%22Jefferson%2C%20Thomas%22&s=1211311111&sa=&r=12&sr=> [https://perma.cc/27E7-GNSF].

28. William I. Wyman, *The Patent Act of 1836*, 1 J. PAT. OFF. SOC'Y 203, 203 (1918); see also Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), <http://founders.archives.gov/documents/Jefferson/03-06-02-0322> [https://perma.cc/9BTU-LXH8]. In this letter, Jefferson states very modern conceptions of novelty and equivalence. *Id.*

29. See Wyman, *supra* note 28, at 203.

30. *Id.*

31. *Id.*

32. *Id.*; cf. Daniel Preston, *The Administration and Reform of the U.S. Patent Office, 1790–1836*, 5 J. EARLY REPUBLIC 331, 347 n.32 (1985) (arguing that inventors and manufacturers were not influential in securing reforms of the deficiencies soon apparent under the 1793 Act).

33. Patent Act of 1793, ch. 11, § 3, 1 Stat. 318–23.

34. *Id.* § 1.

35. See *The Patent Act of 1836*, 18 J. PAT. OFF. SOC'Y 91 (1936). The 1793 Act said only that it "shall and may be lawful" for the Secretary of State to issue patents to persons

Both the 1790 and 1793 Acts required inventors to deliver written descriptions and models of their inventions, but patent granting remained informal. A vast bureaucracy it was not. Until 1802, all patent work was performed by one clerk in the State Department, whose work did not fill “over a dozen pigeonholes.”<sup>36</sup> In 1802, Jefferson put William Thornton in charge of patents.<sup>37</sup> Thornton “exercised an autocratic control of the affairs of the Patent Office” for the next twenty-six years.<sup>38</sup>

During this time, inventors commonly wrote their own petitions and made their own models.<sup>39</sup> Inventors who could not make the trip to Washington sometimes gave their materials to legislators, who presented them on behalf of their constituents.<sup>40</sup> Thornton sought to help inventors understand the paperwork that would be required to register their inventions. In March 1811, he issued a pamphlet that must be among the earliest American guides to administrative procedure.<sup>41</sup> Thornton advised prospective applicants to study prior art and consult experts if needed to ensure the supposed invention would be practicable, provided a form for the petition, described what the specification should do, emphasized the need for specific drawings, and suggested that draftsmen sign their drawings so future petitioners would know where to go for work that met the standards of the office.<sup>42</sup>

Congressional indifference partly explains why Thornton ran the office on his own terms. The 1793 Act did not create a separate patent office, so Thornton was technically a State Department clerk. In 1818, Congress approved a salary for a Superintendent of Patents, but it was lower than that paid to other department heads.<sup>43</sup> Thornton’s first clerk worked his first

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who “shall allege” creation of a new and useful invention, Patent Act of 1793 § 1, but the language was interpreted to make issuance essentially a matter of right subject to compliance with form. Letter from Thomas Jefferson to Frederick Guyer (Apr. 26, 1793), <http://founders.archives.gov/?q=patent%20Author%3A%22Jefferson%2C%20Thomas%22&s=1111311113&r=62> [https://perma.cc/22DJ-UX99] (“I suppose it had escaped your notice that that board was discontinued by the late Congress, and that the business of issuing patents was referred to the department of state, from which they are given out as a matter of right on the party’s complying with certain conditions required by the law.”). Sources documenting the position that the office had no power to reject an application complying with formal requirements are collected in John F. Duffy, *The FCC and the Patent System: Progressive Ideals, Jacksonian Realism, and the Technology of Regulation*, 71 U. COLO. L. REV. 1071, 1125 n.214 (2000). The 1793 Act also provided for resolution of interfering applications, a response to competing applications for steamboat technology under the 1790 Act. *The Patent Act of 1793*, 18 J. PAT. OFF. SOC’Y 77, 79 (1936).

36. George W. Evans, *The Birth and Growth of the Patent Office*, in 22 RECORDS OF THE COLUMBIA HISTORICAL SOCIETY 105, 108 (John B. Lamer ed., 1919).

37. *Id.*

38. *Id.*

39. Kara W. Swanson, *The Emergence of the Professional Patent Practitioner*, 50 TECH. & CULTURE 519, 524 (2009).

40. *Id.*; Robert C. Post, “*Liberalizers*” Versus “*Scientific Men*” in the Antebellum Patent Office, 17 TECH. & CULTURE 24, 29 n.14 (1976).

41. The pamphlet is reprinted in a note. See *Patents*, 6 J. PAT. OFF. SOC’Y 97, 98 (1923).

42. *Id.* at 101–02.

43. Preston, *supra* note 32, at 335.

year without pay and had to petition Congress for a salary.<sup>44</sup> Thornton and his wife sometimes copied out patents at their home in the evenings.<sup>45</sup> Errors were sometimes made in patents and Thornton would correct them for free, a fact that came to light when it was discovered that “[t]he Department of State, the Patent Office, and the Treasury all had annual lists of patents issued, all three were different, and none agreed with the annual receipts.”<sup>46</sup>

The 1793 Act was an invitation to perfidy, piracy, and confusion. In a letter to Isaac McPherson, famous today for its invocation of what we now would call the theory of public goods, Jefferson lamented the abandonment of expert review, even as limited as it had been under the 1790 Act, in favor of the inexpert processes of litigation. Referring to preissuance examination, he wrote:

[I]nstead of refusing a patent in the first instance, as the board was authorised to do, the patent now issues of course, subject to be declared void on such principles as should be established by the courts of law. [T]his business however is but little analogous to their course of reading, since we might in vain turn over all the lubberly volumes of the law to find a single ray which would lighten the path of the Mechanic or Mathematician. [I]t is more within the information of a board of Academical professors, and a previous refusal of patent would better guard our citizens against harrassment [sic] by lawsuits. [B]ut England had given it to her judges, and the usual predominancy of her examples carried it to ours.<sup>47</sup>

Jefferson’s customary Anglophobia is on display here, but so is his conviction, earned through practice as well as brilliance, that *ex ante* expert review is preferable to the more capacious inquiries judges would allow in court.

### *C. The 1836 Act and the Ideal of Expertise*

Substantive examination occurred before 1836 but was irregular and arguably inconsistent with the thrust of the 1793 Act.<sup>48</sup> The Senate report accompanying the bill that became the 1836 Act chronicled the deficiencies of the registration approach:

1. A considerable portion of all the patents granted are worthless and void, as conflicting with, and infringing upon one another, or upon, public rights . . . .

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44. *Id.* at 336.

45. *Id.*

46. *Id.* at 339.

47. Letter from Thomas Jefferson to Isaac McPherson, *supra* note 28.

48. S. DOC. NO. 24-338, at 3 (1836). The charge of inconsistency refers to Thornton’s occasional refusal to register patents “in cases notoriously without merit.” Wyman, *supra* note 28, at 210; *see also* Preston, *supra* note 32, at 343 (“[T]he secretary repeatedly told him that no matter how correct his judgment of the worth of an application, the law required him to issue the patent. Thornton never accepted this verdict.”).



2. The country becomes flooded with patent monopolies, embarrassing to bona fide patentees, whose rights are thus invaded on all sides; and not less embarrassing to the community generally, in the use of even the most common machinery and long-known improvements in the arts and common manufactures of the country.
3. Out of this interference and collision of patents and privileges, a great number of lawsuits arise, which are daily increasing in an alarming degree, onerous to the courts, ruinous to the parties, and injurious to society.
4. It opens the door to frauds, which have already become extensive and serious. It is represented to the committee that it is not uncommon for persons to copy patented machines in the model-room; and, having made some slight immaterial alterations, they apply in the next room for patents. There being no power given to refuse them, patents are issued of course. Thus prepared, they go forth on a retailing expedition, selling out their patent rights . . . [S]everal hundred thousand dollars, it is estimated, are paid annually for void patents, many of which are thus fraudulently obtained.<sup>49</sup>

Delay in processing petitions provided Congress the motivation needed to change the system. Senator John Ruggles, an inventor himself, was irked by the delay and proposed congressional action.<sup>50</sup> Ruggles chaired a committee to deal with the situation.<sup>51</sup> He solicited the views of Henry Ellsworth, son of former Chief Justice Oliver Ellsworth and then-Superintendent of Patents, as to what should be done to reform the office.<sup>52</sup> Ellsworth emphasized the need for expertise: “If scientific men could be induced to take an office in the patent bureau, as examiners of patents, their examinations, aided by a suitable library, would detect almost every interference or want of novelty.”<sup>53</sup>

Ellsworth got what he wanted. Under the 1836 Act an inventor’s claims would be examined rather than accepted.<sup>54</sup> As Ruggles wrote early the next year, following the fire that consumed the Patent Office in December 1836, an examiner had to be “fully acquainted with the principles of the invention for which a patent is sought,” willing and able to investigate “all that has been before known or invented either in Europe or America, on the

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49. S. DOC. NO. 24-338, at 3 .

50. *Id.* at 3–4.

51. DOBYNS, *supra* note 15, at 97.

52. *Id.*

53. *Report of Henry L. Ellsworth to the Select Committee on the Patent Laws*, 8 MECHANICS’ MAG. & J. MECHANICS’ INST. 175, 178 (1836).

54. Section 6 of the 1836 Act carried forward the requirement of an inventor’s oath, and the pamphlet provided a form for that oath. The form required an inventor to aver that “he verily believes himself to be the original and first inventor of” the invention and that “he does not know or believe the same was ever before known or used.” THE PATENT LAWS OF THE UNITED STATES, TOGETHER WITH INFORMATION FOR PERSONS HAVING BUSINESS TO TRANSACT AT THE PATENT OFFICE 20 (1849), <https://archive.org/details/patentlawsofunit00/unit> [<https://perma.cc/43GS-NA79>].

particular subject presented for his examination,” and capable of determining “how far the invention interferes in any of its parts with other previous inventions or things previously in use.”<sup>55</sup> These tasks often were difficult because applicants employed “skilful [sic] and persevering council [sic] to urge and enforce by argument new views of the principles of his invention, who sometimes brings to his aid much mechanical astuteness.”<sup>56</sup> As if all this were not enough, examiners needed “a familiar knowledge of the statute and common law on the subject, and the judicial decisions both in England and our own country, in patent cases.”<sup>57</sup>

One commentator, himself a chief clerk of the office in the early twentieth century, linked the 1836 reforms to rational (scientific) administration more generally, writing that the Patent Act of 1836 (“the 1836 Act”) placed “the means for ascertaining and decreeing rights of property in ideas and promoting the objects of a system of patent protection . . . on an intelligent, scientific and adequate basis . . . .”<sup>58</sup> That assessment was too rosy, as we will see, but under the 1836 Act, the Patent Office did become an administrative agency in a sense recognizable today—and well before the modern administrative state began to take shape. The 1836 Act created the office of Commissioner of Patents, and Ellsworth became the first Commissioner, overseeing a chief clerk, an examining clerk, three additional clerks, a machinist, and a messenger.<sup>59</sup>

The prospect of examination created demand for professionals who could prepare an inventor’s petition with an eye to examination and represent the inventor’s interests during the examination. Within months of the 1836 Act’s adoption, a well-known scientific figure and former Superintendent of Patents, Dr. Thomas Jones, opened an office and begun to advertise his services to aspiring patentees.<sup>60</sup> When Congress authorized a second examiner’s position in 1837, Jones filled it. He kept the job for a year before resuming his private practice.<sup>61</sup> During his brief return tenure, he appears to have examined applications he had drawn up.<sup>62</sup> The examination system became law in July 1836; by January 1837, as we have seen, Ruggles already was referring to the practice of employing “skilful [sic] and persevering council [sic] to urge and enforce by argument new views of the principles of his invention.”<sup>63</sup>

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55. S. BILL NO. 107, report at 6 (1837).

56. *Id.*

57. *Id.*

58. Wyman, *supra* note 28, at 209.

59. Patent Act of 1836, ch. 357, § 2, 5 Stat. 117 (1836). Ellsworth asked for these positions in his message to Congress. *Report of Henry Ellsworth to the Select Committee on the Patent Laws*, *supra* note 53, at 181.

60. DOBYNS, *supra* note 15, at 110; Swanson, *supra* note 39, at 525; Post, *supra* note 40, at 27, 29.

61. Post, *supra* note 40, at 29.

62. *Id.* at 29 n.15.

63. S. BILL NO. 107, report at 6 (1837).

*D. Inventors, Agents, and the Ideal of Service*

The ideal of disinterested expertise waxed at the Patent Office during this period. Yet the ideal created its own challenges. Thomas was only the first of many Patent Office officials to construct the early equivalent of the revolving door of administration. Keller himself remained in the office until 1844 when, Congress having refused requests to increase pay, he resigned and formed a patent agency with John J. Greenough, a former department draftsman.<sup>64</sup> (Samuel B. Morse was a client.<sup>65</sup>) Perhaps because of his familiarity with the models, Keller was a strict examiner. At the beginning of the application era, he denied three-quarters of the applications he reviewed.<sup>66</sup> His approach to patentability became more liberal when he became an agent.<sup>67</sup>

As Robert Post has shown, Keller's shift reflected tension between "scientific" administration of the patent system and a more service-oriented approach focused on inventors rather than invention.<sup>68</sup> In 1837, Ellsworth stated his intention "to err (if at all) on the side of liberality, leaving the parties affected to the courts, to contest their doubtful rights,"<sup>69</sup> but the grant rate before 1857 was almost always 50 percent or lower,<sup>70</sup> sinking as low as 31 percent in 1853.<sup>71</sup> This fact is likely attributable in part both to the qualifications of the examiners and to their willingness to employ their expertise.<sup>72</sup> Keller in particular had seen the deficiencies of registration first hand and had taken a direct role in drafting and securing adoption of the examination system. He likely intended that these reforms be given full effect.

At first, examiners had the sort of "extensive scientific attainments" Senator Ruggles thought they needed.<sup>73</sup> But qualified examiners capable of exercising disinterested expertise were not an unqualified blessing for applicants and their counsel. Such examiners "often proved most resourceful at ferreting out evidence on which to base rejections for lack of novelty. For a time, such men thoroughly dominated the examining corps. . . . [T]heir philosophical proclivities ultimately rendered them anathema to the patrons of the Patent Office."<sup>74</sup>

Inventors and their counsel formed an effective interest group, and they were perfectly capable of expressing their dissatisfaction with expert

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64. Post, *supra* note 40, at 32.

65. *Id.* at 32 n.26.

66. *Id.* at 29.

67. *Id.*

68. *See id.*

69. H.R. DOC. NO. 25-112, at 2 (1838).

70. Post, *supra* note 40, at 32.

71. *Id.* at 50.

72. The concurrent rise of the patent practitioner should have lessened the extent to which rejections were based on errors of form.

73. *See* Post, *supra* note 40, at 28 (quoting Senator Ruggles); *see also* S. REP. NO. 28-150, at 6 (1844) ("[I]f there is any bureau where are needed scientific attainments of a high order, it is in the Patent Office.").

74. Post, *supra* note 40, at 29.

examination. Over time, patent agents became an organized and effective lobby, with the *Scientific American* as a useful podium.<sup>75</sup> The magazine was then owned by Orson Munn and Alfred Beach and affiliated with Munn & Co., a leading patent agency.<sup>76</sup> The combination was complementary. For example, *Scientific American* reprinted the “Information to Persons Having Business to Transact at the Patent Office” pamphlet, together with insertions by *Scientific American* advertising its services as a patent agent.<sup>77</sup>

Inventors were a relatively concentrated group compared to consumers, and patent agents were more concentrated still. Patent agents’ interests also differed from inventors’ interests in important ways. Ruggles’s assessment of the benefits of examination pointed out that an examiner could point applicants to prior art and to issued patents that might undercut the economic value of an applicant’s invention even if he obtained a patent.<sup>78</sup> Rigorous examination might deflate false hope and prevent inventors from sinking costs into litigation that would be doomed to failure.<sup>79</sup> Patent agents, on the other hand, had a substantial stake in securing issuance of a patent without regard to the subsequent value of the patent. This interest would be bounded only by the risk that examination would become so lax that patents in general might fall into disrepute, deflate in value, and thereby reduce demand for the agents’ services.<sup>80</sup> In any given case, an agent would prefer to secure a grant and declare that they had done their job, regardless of litigation nightmares that might follow from issuance of overlapping and conflicting claims.<sup>81</sup>

Patent commissioners found it in their interest to reassure inventors. Ellsworth left in 1845.<sup>82</sup> His successor, Edmund Burke, wrote that “[a]n examiner should be a living encyclopedia of science,”<sup>83</sup> but he was equally concerned with inventors’ welfare. His 1846 report asserts that “it cannot be denied that, upon the principles of abstract justice, the inventor has a complete and unquestionable claim to the fruits of his discoveries until his labors and sacrifices are adequately remunerated,” and he recommended

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75. *Id.* at 34.

76. *Id.*

77. Herbert C. Wamsley, *The Rulemaking Power of the Commissioner of Patents and Trademarks (Part 1)*, 64 J. PAT. OFF. SOC’Y 490, 500 (1982).

78. S. DOC. NO. 24-338, at 3-4 (1836).

79. *Id.*

80. *Cf.* Swanson, *supra* note 39, at 530 (“[M]any agents charged only upon the successful issuance of a patent. This contingent fee structure created an incentive for an agent to draft the application in the form that would be most easily granted, rather than in that which would best protect the invention.”).

81. *Id.*

82. *Post*, *supra* note 40, at 33.

83. H.R. DOC. NO. 29-140, at 4 (1846). Burke was a New Hampshire lawyer and newspaperman. He served in Congress from 1839 to 1845, whereupon he was appointed commissioner. N.J. Brumbaugh, *Edmund Burke, Commissioner of Patents, 1845 to 1849*, 1 J. PAT. OFF. SOC’Y 584 (1918).

that, in litigation, patents be treated as conclusive rather than presumptive evidence of validity (novelty), subject to fraud-based defenses.<sup>84</sup>

Demand for patents created tension with the ideal of expert examination. By 1848, congressional debates over expanding the office staff devolved into arguments over how hard the work really was and what salary was required to attract competent examiners. The Senate passed legislation adding two examiners and raising the salary to \$2500 per year.<sup>85</sup> The House opted for \$2000; Andrew Johnson of Tennessee argued against increases and actually moved for a reduction in the Commissioner's salary.<sup>86</sup> The Senate held firm; Senator Westcott argued that the office had already lost five examiners who commanded twice their salary in private practice.<sup>87</sup> Congress authorized the additional positions at the higher salary, but Burke's report for 1848 emphasized that the grant rate had gone up in recent years.<sup>88</sup> And when it came time to fill the new jobs, Secretary of State Buchanan reviewed the political sympathies of the candidates.<sup>89</sup> The writing was on the wall.

In 1849, Thomas Ewbank replaced Burke, and the Patent Office moved from the jurisdiction of the State Department to the newly created Department of the Interior.<sup>90</sup> As Kara Swanson has noted, Ewbank's first report reflected ambivalence toward patent agents.<sup>91</sup> Ewbank asserted that "[t]he superiority of our system consists also in the rejection of intricate legal forms, so that every inventor of ordinary capacity may make out and pass through the office his own papers, without the intervention of attorney or agent."<sup>92</sup> He also lumped agents with a certain class of inventors who "speculated upon" the office and found it "cheaper to give the office ten dollars for the investigation of a case than to purchase the necessary books and examine for themselves."<sup>93</sup> Recently out of office, Burke himself may have elaborated on this charge. An unsigned article in *Scientific American* insisted that, though the office was constantly accused of "partiality and corruption,"

these charges mainly emanated, not from inventors, but from agents and patent pirates; and if such charges are now made, we have no doubt they

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84. H.R. DOC. NO. 29-52, at 5 (1847).

85. H.R. DOC. NO. 30-59 (1849).

86. Excerpts from CONG. GLOBE, 30th Cong., 1st Sess., reprinted in *Debate on a Bill to Increase Force and Salaries in the Patent Office*, 1 J. PAT. OFF. SOC'Y 588, 593 (1919).

87. *Id.* at 594.

88. H.R. DOC. NO. 30-59 ("Before I assumed the duties of Commissioner, more than half the applications were patented. During the last four years, not quite half of those which have been examined have been patented, and now the proportion of applications patented to those rejected is about two to three.").

89. Post, *supra* note 40, at 41.

90. *Id.* at 37, 39.

91. Swanson, *supra* note 39, at 528-29. The quotation in the text emphasizes simplicity for inventors, but dealing with experienced professionals was simpler for patent examiners. *Id.* at 528 ("When dealing with former office employees, the examiners could address a score of cases in one meeting with a savvy practitioner, instead of painstakingly explaining the patent law to first-time inventor after first-time inventor.").

92. H.R. DOC. NO. 31-20, at 514-15 (1850).

93. *Id.* at 10.

in the main proceed from like sources. . . . [S]uch persons . . . are the pests of scientific improvement, instead of its promoters. Instead of trammelling the hands of the Commissioner, Congress should give him power to expel from the office, and disqualify from all future business intercourse with it, patent agents, when guilty of offenses which disqualify them from doing business in any respectable court of justice.<sup>94</sup>

It is fair to read this rejoinder as seeking to divide inventors from agents and align the office with the comparatively sympathetic interests of inventors. By raising the prospect of disqualifying patent agents, this comment asserted the primacy of examination, and thus of expertise, over the tactics of agents. As is usually the case, such an assertion would not be necessary unless the tactics were effective. Agents could hardly be expected to take such criticism lying down, and in its next issue, *Scientific American* fired back:

The business of the Patent Office, as it respects decisions upon applications, is conducted upon a system of erratics. Applications are granted or rejected, according to the *state of mind* the examiners may be in. There are four chief examiners in the Patent Office, each a feudal baron on his own domain. Their decisions, therefore, sometimes resemble boys shooting marbles along the four sides of a rectangle. One has acquired for himself the glorious title of “the guillotine.” He knows every thing that was, is, and is not, and never will be. It certainly looks singular to see men making decisions, which resemble a dance of crooked sticks. Decisions are sometimes made in the Patent Office, which amount in substance to boxing the bones and throwing the compass overboard.<sup>95</sup>

An anonymous correspondent writing as “Daclede” extended the attack on the “guillotine” examiner, whom he identified as William Fitzgerald:

The province of an examiner is precisely similar to that of a clerk in a mercantile house, to whom the head of the establishment would refer a bill for examination when presented at the counter for payment . . . . Give me a vacillating, simple headed enthusiast, in fact, anybody, to reason with, in preference to a dogmatic examiner.<sup>96</sup>

The charge of decision by “erratics” denied that the office exercised expertise. This rejoinder implicitly asserts that objective decisions would be predictable and that the supposed lack of predictability proved the absence of expert decision making. At bottom, however, the responses were more concerned with insisting that *Scientific American*—and, by extension, agents—were the true representatives of inventors’ interests and that the office was the true enemy.

Ewbank faced bigger challenges than skirmishing statements in magazines. His 1851 report defended the Patent Office from oversight and greater control by the Department of Interior, and he framed his arguments by appealing to expertise as against political expedience.<sup>97</sup> Again enlisting

94. *The Patent Office, and Reform of the Patent Laws*, SCI. AM., June 15, 1850, at 307.

95. *Patent Office and Reform of the Patent Laws*, SCI. AM., June 22, 1850, at 317.

96. *Patent Office Reform*, SCI. AM., Dec. 28, 1850, at 118.

97. S. Doc. No. 32-118, at 10 (1852).

the interests of inventors, Ewbank insisted that the Patent Office should not be subordinate to political appointees such as the head of the Department of Interior, men who “have no time to devote to it, and who, from education, habits, profession, and feelings, can have little or no active sympathies with interests represented in it, or with the class of citizens with whom it has most to do . . . .”<sup>98</sup> He insisted that “there is an increasing desire among inventors and patentees, mechanics, manufacturers and others” that the Patent Office should not be subordinate to the Interior Department because, “[e]xclusively devoted to the progress of science and art,” the office needed to be “wholly freed from political influences . . . . To suppose the business of this office can be carried on, if its desks are occupied, as in some departments, by persons even of general qualifications, instead of special fitness, is a great mistake.”<sup>99</sup>

Ewbank argued that examiners

ought not to be harassed with calls to answer complaints preferred to the Department of Interior, and often to the President, by disappointed applicants and their friends; by parties stimulated with promises of large sums, made payable on the issue of a patent; and by agents and speculators, smarting under the loss of such contingent fees.<sup>100</sup>

Again seeking to divide agents from inventors, Ewbank maintained that “[t]here is no disposition in the office to refuse patents; the feeling is the very reverse. . . . [I]t is absurd to suppose that refusals are wantonly made, there being no possible motive to refuse a patent, but every inducement to grant one. When doubts exist, the benefit is always given to the applicant.”<sup>101</sup>

An annual report is a feeble weapon against the array of foes Ewbank identified, the grievances they asserted, and the ears they bent. His insistence that the office was not too disposed to deny applications reflects the narrative his foes had created and the strength it was gaining. That narrative aimed toward increasing the grant rate, and if standards had to be loosened and the ideal of expertise had to be swept aside, so be it.

Ewbank’s ire toward patent agents is particularly instructive. He conceived of “inventors and patentees, mechanics, [and] manufacturers” as his constituents, not agents.<sup>102</sup> His version of the *Information to Persons Having Business to Transact* pamphlet stated that inventors could deal with the Patent Office without agents, that agents received no greater consideration than inventors, and, to the contrary, that the office might consider “imperfectly prepared” submissions “*when such papers are prepared by the inventor himself*.” But, if an agent be employed, it is presumed that he is qualified for the business he has undertaken without

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98. *Id.*

99. *Id.*

100. *Id.* at 11.

101. *Id.*

102. *Id.*

calling on the office for instructions.”<sup>103</sup> But Ewbank was in a bind: agents helped inventors navigate the bureaucracy created in the 1836 Act, and at least some agents worked on contingency. Combined with disappointed applicants, these agents and their networks appear to have been a potent political force—potent enough, at any rate, to provoke Ewbank’s appeal for independence.<sup>104</sup>

Ewbank was gone in 1852,<sup>105</sup> to be replaced in 1853 by Judge Charles Mason. Mason worked Congress well, and by 1856, the office had thirty-six examiners and assistant examiners.<sup>106</sup> But in his report that year, Mason worried about the scale of the office and the inability of the Commissioner to pay close attention to the work—particularly the rejections—of the examiner corps. Mason was a former judge, not a scientist, and he lamented that “very few of our lawyers have ever turned their attention in this direction. The law relating to patents is less understood by the profession than any other branch of that noble science.”<sup>107</sup>

Mason continued to emphasize flesh and blood inventors rather than the abstract scientific conception of novelty. He stressed that patentability decisions were not

matters of trivial moment; at least they are not so to the individual most immediately interested. To him, the offspring of his mental energies are something more than property; they are his children, for whom he has labored through much of the fairest portion of life’s meridian, and on whom he relies for consolation and support in the evening of its decline.<sup>108</sup>

His concern for inventors manifested itself as a bias in favor of traditional adjudication rather than administrative procedure as the final forum for patentability decisions.

Mason’s preference for legal over technical expertise reflected a shift away from the premise of expert inquiry. That is not what goes on in courts, as Jefferson pointed out in his letter to McPherson years before.<sup>109</sup>

103. *Information to Persons Having Business to Transact with the Patent Office*, reprinted in H.R. DOC. NO. 32-102, at 516 (1853). Agents, predictably, protested. Charles Grafton Page et al., *Some of the Written Rules of the Patent Office*, 1 AM. POLYTECHNIC J. 119, 120 (1853) (“Without assigning any reason whatever, the Patent Office enforces the law upon one class of men, patent agents, and discards it for another, viz., inventors who choose to put their applications in an imperfect condition. In the absence of a reason we have a right to the inference that such a rule was made to serve some personal ends.”). Page was a well-regarded former examiner. See Post, *supra* note 40, at 38. Swanson puts first publication of this language in 1850. Swanson, *supra* note 39, at 529 n.36.

104. *Information to Persons Having Business to Transact with the Patent Office*, reprinted in H.R. DOC. NO. 32-102, at 516. The political influence of the patent bar is explored in Andrew P. Morriss & Craig Allen Nard, *Institutional Choice & Interest Groups in the Development of American Patent Law: 1790–1870* (Case Legal Studies, Research Paper No. 08-24, 2008; Univ. Ill. Law & Econ., Research Paper No. LE07-007, 2008), <http://ssrn.com/abstract=1262970> [<https://perma.cc/2R2N-V4CY>].

105. Post, *supra* note 40, at 43.

106. *Id.* at 47.

107. S. REP. NO. 34-20, at 5 (1856).

108. *Id.*

109. See Letter from Thomas Jefferson to Isaac McPherson, *supra* note 28.



Yet Mason recommended that Congress consider returning to “former practices of the office, making the duties of the examiners simply advisory, and allowing a patent in all cases, provided the applicant should finally insist upon it, notwithstanding the opinion of the [Patent Office] as to its invalidity.”<sup>110</sup> As Mason put it, his proposal

would render the same high order of qualifications and experience less absolutely essential in the examining corps. Most of the legal controversies now arising in the [Patent Office] would be turned over to the courts of law, which are not only so much better qualified to adjudicate, but which possess the necessary machinery to investigate and conduct such matters, so as to lead to a result more satisfactory than can be done here.<sup>111</sup>

The following year, Mason recommended that Congress consider (re)adopting a procedure akin to *scire facias*.<sup>112</sup> In 1857, he noted an increase over the prior year in patents granted and praised the American system as avoiding the evils of registration or overly strict examination. His office eschewed “that stern, unsympathizing, distrusting temper, which would receive the inventor as a stranger beneath the roof of this magnificent edifice, which has been reared at once as a monument to his genius, and as a depository of the trophies of his labors.”<sup>113</sup> Instead, under Mason, the office welcomed “the inventor as a friend and patron, in that frank and free conference with him enjoined by law, kindly and anxiously sifts from his invention its minutest patentable features . . . .”<sup>114</sup>

Patent agents were duly appreciative. When Mason resigned, *Scientific American* wrote that “[h]e was prompt and fearless in his decisions. He believed that the Patent laws were instituted for the benefit and encouragement of inventors, and he interpreted them accordingly . . . . Much of his time was devoted to the repeal of decisions by illiberal examiners.”<sup>115</sup> For his part, upon leaving the Patent Office Mason wrote a nice blurb to *Scientific American* praising the Munn agency as having worked on one quarter of the patents issued during his tenure.<sup>116</sup> Five months later, he was working for Munn.<sup>117</sup>

James Holt replaced Mason and took solicitousness for inventors to new heights. The patent laws, he argued,

should be liberally construed, having ever in view the great end they were designed to subserve . . . . That office, in my judgment, would be

110. S. REP. NO. 34-20, at 5. Mason did recommend that such patents give notice of the Patent Office’s negative opinion and that Congress might give existing patentees the right to contest issuance of a patent the Patent Office felt interfered with a previous grant. *Id.*

111. *Id.* at 6. Whether such rights existed was the question at issue in such cases.

112. H.R. DOC. NO. 34-65, at 5–6 (1857). Part I.F discusses the *scire facias* doctrine and its history in the patent acts. *See infra* notes 174–78 and accompanying text.

113. H.R. DOC. NO. 35-32, at 2 (1858).

114. *Id.*

115. *The Late Commissioner of Patents*, SCI. AM., Sept. 12, 1857, at 8.

116. *Judge Mason to the Scientific American Patent Agency*, SCI. AM., Aug. 29, 1857, at 402.

117. DOBYNS, *supra* note 15, at 149.

forgetful of its mission, and disloyal to one of the highest interests of humanity, were it to permit itself to be entangled in a mesh of mere words, or palsied by doubts, born of intricate metaphysical disquisitions. It has to do with the substance of things, and to deal with the earnest, ingenuous, practical intellect of the age, and it should be dealt with frankly, not perplexing and discouraging inventors, by subtle distinctions, but kindly taking them by the hand, as the benefactors of their race, and strewing, if possible, their pathway with sunshine and with flowers.<sup>118</sup>

Patent agents liked that idea. *Scientific American* noted that Holt's view represented a departure from historical practices—a view it thought more “liberal” than before.<sup>119</sup> It drew a line between new examiners, who got Holt's message and followed it, and the old “croakers,” who remained stubbornly mired in old ways.<sup>120</sup> To the extent one may infer the views of patent agents from the opinions of *Scientific American* at the time, Holt's administration emboldened them. The prospect that they could take prosecution matters on contingency with a high probability of getting a patent of some scope issued must have been intoxicating.

The implications of the situation were made clear two years later, in Commissioner Bishop's annual report. In 1859, he asked Congress to amend the law so that interferences were resolved in favor of the first to file either a caveat (a form of provisional application) or an application.<sup>121</sup> He conjectured that his proposal would “be sanctioned by most men of standing and respectability,” but that “a certain class of patent agents, who seek to make profit by aiding dishonest men in annoying and robbing honest inventors of their just rights rather than by an honorable practice of their profession, may endeavor to defeat any amendment of the law which will diminish litigation, fraud, perjury, and corruption.”<sup>122</sup> He regretted “that the present law affords so many facilities for the dishonest practices of such men, by whom innocent inventors are continually plundered.”<sup>123</sup>

Bishop revived the traditional practice of asking for more examiners, asserting, “Rather than suffer the business of the office to become seriously delayed we have been compelled to grant patents upon hasty examinations. As a natural consequence, many things have been patented which ought to have been rejected.”<sup>124</sup> But the tide had turned. “Of the twelve principal examiners in the office when Holt took over, five had been removed by early 1858 and all but two of the rest before the war.”<sup>125</sup> Conventional politics played a role—the Civil War loomed on the horizon, after all, and some examiners were “Black Republicans”—but Post argues convincingly

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118. *Commissioner Holt's Decision*, SCI. AM., Nov. 14, 1857, at 78.

119. *Id.*

120. *State of Affairs at the Patent Office*, SCI. AM., Dec. 26, 1857, at 125.

121. H.R. DOC. NO. 36-299, at 6 (1860).

122. *Id.*

123. *Id.*

124. *Id.*

125. Post, *supra* note 40, at 49.

that “liberalization” of standards and the consequent reduction in emphasis on “scientific” examination was important, too.<sup>126</sup>

In 1860, *Scientific American* praised the “very marked change” in the office over the preceding three years and noted that “its officers, with few exceptions, exhibit in their official views and actions a uniform and commendable liberality of disposition toward inventors.”<sup>127</sup> When, a few months later, Commissioner Thomas proposed a “Revising Board” of two examiners, to whom other examiners would have to justify decisions to issue patents, a correspondent to *Scientific American* objected that the examiners appointed “have been educated in the illiberal old school practice of the [Patent] Office, which prevailed as far back as 1850, 1851, and 1852, when terror to the inventor reigned triumphant.”<sup>128</sup> The editors added a footnote explaining that

[i]t was in these years that two thirds of the applications for patents were rejected. In 1853 Judge Mason was appointed to the Commissionership, and he soon brought about a new order of things, by impressing upon the Examiners the fact that it was their duty to see on what points in an invention placed before them a patent could be allowed, instead of studying to discover on what grounds they could reject an application.<sup>129</sup>

*Scientific American* complained that, in the first week of results after the new board began its work, only thirty patents issued, compared to a previous weekly rate of one hundred.<sup>130</sup> Thomas lasted only ten months before moving to President Buchanan’s cabinet as Secretary of the Treasury.<sup>131</sup> The revisory board turned out to be toothless and in any event lasted barely longer than Thomas.<sup>132</sup>

*Scientific American*, and doubtless inventors and agents as well, wanted to have its cake and eat it too. It wanted highly qualified examiners whose reputations would command deference from courts, but who would help applicants get patents, not point out the lack of novelty of their inventions. Political hacks could satisfy the second condition, but endangered the first. In 1861, it protested that “we have earnestly contended against debasing the Patent Office into a political cesspool, to be groveled in by a mess of loafers, such as hang about Custom Houses and other hot beds of political corruption.”<sup>133</sup> It complained that

[t]he Patent Office has gradually become demoralized, and is losing that dignified position which it enjoyed even but a short time ago, some of its attaches being unfitted, either mentally or morally, to fill the places they

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126. *Id.*

127. *New Arrangements at the Patent Office*, SCI. AM., July 2, 1860, at 10.

128. *Trouble at the Patent Office—“Revising Board” Appointed*, SCI. AM., Nov. 3, 1860, at 299.

129. *Id.*

130. *New Order of Things at the Patent Office*, SCI. AM., Nov. 10, 1860, at 313.

131. DOBYNS, *supra* note 15, at 154.

132. *Letter from Washington*, SCI. AM., June 1, 1861, at 342.

133. *The New President and the Commissioner of Patents*, SCI. AM., Mar. 9, 1861, at 153.

now occupy; and inventors have become, in some degree, disgusted with the whole concern.<sup>134</sup>

The Patent Act was amended in 1861, in part to secure “greater uniformity of action in the grant and refusal of letters” by appointing

three examiners-in-chief . . . to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent.<sup>135</sup>

Congressional debate over the provision raised the question whether such appointees could in fact be expected to be disinterested experts. New Hampshire Senator John Hale scoffed at the idea that

these examiners will be scientific men, legal men, men that are well qualified. Does not the Senator know, and does not everybody who knows anything about the Patent Office know, that it is just as much a piece of party machinery as the Supreme Court is, or any other department of the Government?<sup>136</sup>

Hale’s criticism implied that examination of prospective patent examiners did not interfere with political considerations.<sup>137</sup> A correspondent writing as “Aquinas” expressed similar views in *Scientific American*, complaining that the Patent Office,

[i]n spite of the good intentions of the Commissioner[,] . . . is becoming more and more, under its present regime, an asylum for deaf and dumb fossils and political hacks. . . . [C]annot the inventor’s interest be better served than by stuffing mere politicians into technical places for which they have no fitness?<sup>138</sup>

In 1866, *Scientific American* complained that “Jefferson’s rule, ‘Is he honest? [I]s he faithful?’[,] has given way to the more dangerous rule, ‘Is he a good party man, has he political influence?’”<sup>139</sup>

The second half of the nineteenth century tended to confirm these assessments. Between 1869 and 1901, five former members of Congress became patent commissioners.<sup>140</sup> Three of these were lame ducks who had lost an election; the commissioner’s post was a sinecure granted by soon-to-be-former colleagues.<sup>141</sup> Between 1861 and 1877, the three-member board of appeals had fifteen members.<sup>142</sup> In 1877, Commissioner Spear complained that “[u]nder such conditions it must appear inevitable that

134. *Id.*

135. The Patent Act, ch. 88, § 2, 12 Stat. 246 (1861) (emphasis omitted).

136. CONG. GLOBE, 36th Cong., 1st Sess. 1732 (1860).

137. For an assessment of such examination, see *Caveat Fees and Applications for Patents*, SCI. AM., Apr. 27, 1861, at 266.

138. *Condition of the Patent Office*, SCI. AM., July 27, 1861, at 54.

139. *The Commissioner of Patents*, SCI. AM., Oct. 13, 1866, at 253.

140. LEONARD D. WHITE, *THE REPUBLICAN ERA: 1869–1901: A STUDY IN ADMINISTRATIVE HISTORY* 223 (1958).

141. *Id.*

142. *Id.* at 224.

there could not have been uniformity or the constant exercise of the wisest discretion in the granting of patents. The whole tendency has been toward an excessive issue of patents, and there is need of constant supervision.”<sup>143</sup>

*E. The Pendulum Swings Back*

By 1868, the tide began to shift again, and the notion of expertise and the attendant prospect of rigorous examination were again at the center of the debates. In his 1867 report, Commissioner Theaker wrote that “to some the thorough acquaintance of an examiner with his class is simply regarded as a possible obstacle in the way of obtaining a patent.”<sup>144</sup> Commissioner Foote announced merits-based cleaning of the stables in 1869.<sup>145</sup> He wrote that he was “unable to attribute the extraordinary increase of the last few years in the number of patents issued to an equal increase of real improvements; for I apprehend that much of apparent prosperity has arisen from the allowance of patents that should never have been granted.”<sup>146</sup> He complained that examiners’ decisions were subject to rigorous review when they denied an application, but

[a]n examiner’s action receives no such scrutiny when he allows a patent. If he be pressed for time, or be indifferent as to his duties, he may put an end to his labors by a simple indorsement [sic]. If he lacks capacity, there will then be no exposure of his ignorance or of the unsoundness of his views. It may have happened that in some instances the allowance of patents has served to cloak incapacity and indifference to duty.<sup>147</sup>

Foote therefore made it a priority to “improve the qualifications of examiners and obtain a high order of ability in the examining corps.”<sup>148</sup> He appointed a three-man committee to examine the qualifications of the examiners.<sup>149</sup> He reported that “[t]he duty has been, so far, faithfully and judiciously performed, and several changes in the [Patent Office] have resulted therefrom.”<sup>150</sup> Things evidently had deteriorated to the point that *Scientific American* applauded this move. “Among other reforms introduced,” it wrote, “is that of examination of examiners, to see if they are qualified for their duties.”<sup>151</sup> In the future,

before any appointment can be made the candidate will be thoroughly examined as to his fitness for the place. He must possess at least some show of qualification or he cannot be appointed. All those now in the Office will have to submit to this examination, and if found unqualified will be discharged. . . . The Commissioner intends to raise the standard of principal examiners to that of the judges of our common courts, and

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143. ANNUAL REPORT OF THE COMMISSIONER OF PATENTS FOR 1877, at xiii (1878).

144. H.R. DOC. NO. 40-96, at 6 (1868).

145. H.R. DOC. NO. 40-52, at 5 (1869).

146. *Id.*

147. *Id.*

148. *Id.*

149. *Id.*

150. *Id.*

151. *Special Correspondence of the Scientific American—Affairs at the Patent Office*, SCI. AM., Sept. 16, 1868, at 180.

means to do away with the practice heretofore in vogue of appointing persons to positions simply because they happen to be related to some M.C. or Senator.<sup>152</sup>

Judges of course were not selected for scientific expertise, and political influence is not wholly unknown in judicial selection, so this aspiration is telling in and of itself.

The Patent Office introduced competitive examinations for patent examiners in 1869, thirteen years before the Pendleton Act began inching the civil service as a whole toward merit-based selection.<sup>153</sup> Commissioner Fisher explained that

it may be conceded that, by this method, in exceptional cases, a competent man may be kept out of office, but an incompetent one can very rarely come in. To lessen the chances of error, great care has been taken in adapting the examination to the work to be done, so that theory and practice must both be combined to achieve the highest measure of success[,] . . . the result upon the Office at large, and especially as shown in the character and capacity of new employees, has been most gratifying.<sup>154</sup>

In a famous article in the *North American Review*, Jacob D. Cox, an ardent civil service reformer, then recently departed as Secretary of the Interior, praised the Patent Office as “demonstrative proof” of the benefits of competitive examination designed to weed out incompetent aspirants for agency jobs.<sup>155</sup>

Lawyers continued to play their part in the problems of the Patent Office. A pension act providing for disability payments was adopted in 1862<sup>156</sup> and, owing to the carnage of the Civil War, pensions became big legal business in the post-war period.<sup>157</sup> Pension applications were made ex parte, without examination of the applicant, so the system resembled the patent-by-oath practice of the 1793 Act.<sup>158</sup> It was an invitation to fraud, which was acknowledged as inevitable.<sup>159</sup> Lawyers trolled for clients who might claim pensions, and the full range of supposedly modern abuses were

152. *Id.*

153. H.R. DOC. NO. 41-102, at 6–7 (1870); *Civil Service Reform*, N.Y. TIMES, Dec. 3, 1870.

154. H.R. DOC. NO. 41-102, at 7. One assessment states: “The result of Commissioner Fisher’s policy was shown in the character of the new members of the corps, who in all the requirements of the position readily demonstrated a superiority over those in Office who had come in under the old order.” William I. Wyman, *Samuel Sparks Fisher*, 2 J. PAT. OFF. SOC’Y 490, 494 (1919).

155. Jacob D. Cox, *The Civil-Service Reform*, 112 N. AM. REV. 81, 100 (1871). Cox was a Union general in the Civil War and thus knew President Grant, but the two parted ways on a variety of topics, abbreviating Cox’s tenure as Secretary of War. For a brief summary of the Patent Office’s practice relative to other branches of administration, see WHITE, *supra* note 140, at 214–15.

156. 12 Stat. 566 (1862). For an overview, see WHITE, *supra* note 140, at 209.

157. See WHITE, *supra* note 140, at 209.

158. *Id.*

159. *Id.* at 215–17.

on display.<sup>160</sup> In 1898, 60,000 lawyers were authorized to practice before the pension board.<sup>161</sup> One of them, George Lemon, had 125,000 matters (including pending and rejected claims) in his office.<sup>162</sup> An 1878 statute used price regulation to address the problem, limiting fees in pension cases to ten dollars.<sup>163</sup>

At this point, both the Pension Board and the Patent Office operated from within the Department of Interior and, from a certain very crude angle, both pension applications and patent applications involved getting things from the government. So, to some pension agents, it seemed natural to expand their practice to include patent applications as well. In his 1869 annual report, Commissioner Fisher summarized the problems patent agents posed for the Patent Office—pursuing contingent fees they sought patents on “mere technical combinations” and cared more “about the number than the quality of those which they obtain.”<sup>164</sup> The worst of them “adopt this business as an incident to a claim agency, and press for patents as they press for back pay and pensions.”<sup>165</sup> They took advantage of inventors who were often “poor, uneducated, and lacking any legal knowledge” and who wanted “a cheap solicitor, and do not know how to choose a good one.”<sup>166</sup> Solicitors who “care for nothing but to give [clients] something called a patent, that they may secure their own fee, have in too many instances proved a curse.”<sup>167</sup>

As noted above, dissatisfaction with the practices of patent agents predated the 1862 Pension Act. The 1861 amendment to the Patent Act gave the Commissioner power, “for gross misconduct,” to “refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and subject to the approval of the President of the United States.”<sup>168</sup> This provision echoed Burke’s call, as a private citizen, eleven years earlier. The provision was carried forward in the 1870 Act, though it

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160. Peter David Blanck & Michael Millender, *Before Disability Civil Rights: Civil War Pensions and the Politics of Disability in America*, 52 ALA. L. REV. 1, 22, 31 (2000) (“The most successful pension lawyers of the late nineteenth century hired agents who scoured the docks and alleyways of major cities in search of poor veterans who were unaware of their pension eligibility. . . . Pension lawyers were allowed to collect ten dollars for each claim they pursued. By the end of the nineteenth century, the Bureau’s critics denounced them as parasites who were responsible for defrauding both the government and their own clients.”).

161. *Id.* at 31.

162. *Id.*; see also Theda Skocpol, *America’s First Social Security System: The Expansion of Benefits for Civil War Veterans*, 108 POL. SCI. Q. 85, 103 (1993).

163. 20 Stat. 243, ch. 367 (1878).

164. H.R. DOC. NO. 41-102, at 9 (1870).

165. *Id.*

166. *Id.*

167. *Id.*

168. 12 Stat. 247 (1860); *Sperry v. Florida ex rel. Fla. Bar*, 373 U.S. 379 (1963) (noting statutory history). Commissioner Colfax’s annual report for 1863 hinted at dissatisfaction with aggressive agents: “It is the duty of patent agents, who now form so important a class of professional men in this country, not too earnestly to press doubtful applications, and not to demand of the office a liberality in granting patents, which, if carried too far, would destroy the system which is the foundation of their business.” ANNUAL REPORT OF THE COMMISSIONER OF PATENTS FOR 1863, at 17 (1864).

only required the consent of the Secretary of the Interior rather than the President.<sup>169</sup> In 1870, *Scientific American* reported that Foote had suspended McGill, Grant & Co., and George W. McGill from practice, the first suspensions the editors knew of, though the power had existed for nine years.<sup>170</sup>

The Patent Office's power was expanded in 1884, when Congress gave the Secretary of the Interior power to

prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing claimants before his department . . . [and] after notice and opportunity for hearing, suspend or exclude from further practice before his department any such person, agent or attorney shown to be incompetent, disreputable, or who refuses to comply with the said rules and regulations . . .<sup>171</sup>

The statute was aimed at pension agents but, as the Patent Office was in the Department of Interior as well, by its terms it also extended to patent agents. Consistent with the statutory text, *Wedderburn v. Bliss*<sup>172</sup> held that such discipline was administrative and not subject to judicial review. The Patent Office began registering attorneys in 1899 and, in 1922, it received the power to enact its own regulations of patent agents and attorneys.<sup>173</sup>

#### *F. The Rise and Decline of the Inequitable Conduct Doctrine*

The 1790 and 1793 Acts had a crude mechanism that theoretically might have helped compensate for the limited expertise possessed by the Board of Arts and the absence of expertise in the registration system. Each act carried forward a form of the English writ of *scire facias* by creating a right of action to cancel a patent.<sup>174</sup> Within a year of issuance, under the 1790 Act, or three years under the 1793 Act, a challenger could submit an oath showing that the patent had been obtained "surreptitiously, or upon false suggestion."<sup>175</sup> Courts receiving such oaths could issue orders to show cause why the patent should not be repealed.<sup>176</sup> This right of action provided means by which persons with expertise showing a patent invalid could bring that expertise to bear within the patent system broadly construed, though not the grant process itself. The right of action was not

169. Patent Act of 1870, ch. 230, § 17, 16 Stat. 198–217 (1870).

170. *The Commissioner Suspends a Patent Agent for Gross Misconduct*, SCI. AM., Aug. 27, 1870, at 136. Just before resigning in 1870, Fisher struck Otto Leissring from the rolls for pocketing client funds. *Another Patent Agent in Trouble*, SCI. AM., Dec. 3, 1870, at 356.

171. 23 Stat. 101 (1884).

172. 12 App. D.C. 485 (D.C. 1898).

173. 42 Stat. 390 (1921).

174. Patent Act of 1790, ch. 7, § 5, 1 Stat. 109–12; Patent Act of 1793, ch. 11, § 10, 1 Stat. 318–23; see *Ex parte Wood & Brundage*, 22 U.S. 603, 609 (1824) (section 10 of the 1793 Act was designed "to provide some means to repeal patents which have been obtained surreptitiously, or upon false suggestions; the very cases for which a *scire facias* issues at the common law").

175. *Wood & Brundage*, 22 U.S. at 605.

176. A more extensive version of this history may be found in David McGowan, *Inequitable Conduct*, 43 LOY. L.A. L. REV. 945 (2010).



carried forward in the 1836 Act.<sup>177</sup> “Only in the case of interference did the 1836 Act provide a private right that might lead to cancellation,”<sup>178</sup> though, as we have seen, Commissioner Mason’s legalism led him to recommend the revival of *scire facias* practice.<sup>179</sup>

*Providence Rubber Co. v. Goodyear*<sup>180</sup> and *Mowry v. Whitney*<sup>181</sup> noted the 1836 Act’s elimination of the private right of action for cancellation; *Mowry* conceived of the writ as asserting a right belonging to the defrauded party—the government.<sup>182</sup> *United States v. American Bell Telephone Co.*<sup>183</sup> held that the government could sue to repeal a fraudulently procured patent, though the 1836 Act contained no such provision.<sup>184</sup> The modern doctrine began to take shape with *Keystone Driller Co. v. General Excavator Co.*,<sup>185</sup> which held that fraud on the PTO compelled vacatur of a fraudulently obtained judgment.

*Hazel-Atlas Glass Co. v. Hartford Empire Co.*<sup>186</sup> extended *Keystone*. The patentee in *Hazel-Atlas* drafted an article to be used in support of a patent application and paid a well-known union official to sign it.<sup>187</sup> The patentee submitted the article to the PTO, passing it off as the official’s own work.<sup>188</sup> The patent issued, and Hartford sued *Hazel-Atlas* for infringement.<sup>189</sup> Hartford lost at the trial court and, on appeal, relied heavily on the article.<sup>190</sup> The appellate court entered a judgment of validity and infringement; its opinion quoted Hartford’s article.<sup>191</sup> *Hazel-Atlas* then tracked down the union president to question him about the article.<sup>192</sup> He

177. Section 6 of the 1793 Act also allowed a defendant sued for infringement to defend on the ground that the patent lacked novelty, recovering costs for a successful defense. *Id.* at 948–49.

178. McGowan, *supra* note 176, at 950.

179. *See supra* note 112 and accompanying text.

180. 76 U.S. 788 (1869).

181. 81 U.S. 434 (1871).

182. Courts applying *Mowry* read it to bar ordinary defendants from asserting inequitable conduct as a defense. *See Vortex Mfg. Co. v. Ply-Rite Contracting Co.*, 33 F.2d 302 (D. Md. 1929).

183. 128 U.S. 315 (1888).

184. *Corona Cord Tire Co. v. Dovan Chem. Corp.*, 276 U.S. 358, 374 (1928) (no fraud shown where patentee submitted declaration claiming to have used accelerant to vulcanize rubber but had only shown that the accelerant worked without vulcanizing anything: “Production of rubber goods for use or sale was not indispensable to the granting of the patent. Hence the affidavits, though perhaps reckless, were not the basis for it or essentially material to its issue. The reasonable presumption of validity furnished by the grant of the patent therefore would not seem to be destroyed”); *Burke Elec. Co. v. Indep. Pneumatic Tool Co.*, 232 F. 145 (2d Cir. 1916) (affirming holding of Judge Learned Hand, then a district judge, that defense would not lie where the description, though misleading, was not intentionally so and the misleading element concerned the operation of the invention rather than the elements of patentability).

185. 290 U.S. 240 (1933).

186. 322 U.S. 238 (1944).

187. *Id.* at 240.

188. *Id.*

189. *Id.* at 241.

190. *Id.*

191. *Id.*

192. *Id.*

would not talk to Hazel-Atlas, but he did give Hartford an affidavit and received eight thousand dollars shortly thereafter.<sup>193</sup> Holding that “[t]here are issues of great moment to the public in a patent suit,” the Court vacated the judgment.<sup>194</sup> The following year, the Court wrote that “[a] patent by its very nature is affected with a public interest,”<sup>195</sup> the language that begins Rule 56 to this day.

Dissenting in *Hazel-Atlas*, Justice Roberts noted that “[i]t is complained that members of the bar have knowingly participated in the fraud. Remedies are available to purge recreant officers from the tribunals on whom the fraud was practiced.”<sup>196</sup> The PTO took notice. It instituted disciplinary proceedings against three lawyers involved in the proceedings and disbarred them.<sup>197</sup> Prosecution counsel, Dorsey, appealed.<sup>198</sup> The D.C. Circuit reversed, in part chiding the PTO for lacking ordinary common sense, much less expertise:

It was the duty of the Patent Office under the law to investigate these matters for itself, to arrive at a determination on the facts and evidence presented and not to shift the burden of its own responsibilities to a blind reliance on some article presented from some trade journal, which with ordinary intelligence it might have known to be self-serving for the party offering it.<sup>199</sup>

The Supreme Court was not persuaded. It reversed, in a brief per curiam opinion.<sup>200</sup>

Rule 1.56 was adopted in 1977.<sup>201</sup> The PTO said it codified “the existing [Patent] Office policy on fraud and inequitable conduct, which is believed consistent with the prevailing case law in the federal courts.”<sup>202</sup> Some commentators disagreed that the rule reflected previous office practice,<sup>203</sup> but with the backing of the Supreme Court, the existence—if not the contours—of such a duty was secure. Like the rigor of examination and the

193. *Id.* at 242.

194. *Id.* at 246.

195. *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1945).

196. *Hazel-Atlas*, 322 U.S. at 252.

197. *See Hatch v. Ooms*, 69 F. Supp. 788 (1947).

198. *Dorsey v. Kingsland*, 173 F.2d 405, 407 (1949), *rev'd*, *Kingsland v. Dorsey*, 338 U.S. 318 (1949).

199. *Id.*

200. *Kingsland*, 338 U.S. 318.

201. 42 Fed. Reg. 5588, 5589 (1977).

202. *Id.* Some privilege-related objections were raised. The PTO was unimpressed: Several comments concerned whether attorneys and agents could represent their clients’ interests and at the same time comply with § 1.56. Similar comments were directed to §§ 1.97 to 1.99. It is of course in the interest of the client to have a valid patent and this cannot be obtained without disclosure of known material facts. It is not inconsistent for an attorney or agent to fulfill his duty of candor and good faith to the Office and to act as an advocate for his client. The submission of information under § 1.56 does not preclude the submission of arguments that such information does not render the subject matter of the application unpatentable.

*Id.* at 5590.

203. John T. Roberts, *The Disclosure Duty: Its Evolution, Scope, and Limitations*, 5 APLA Q. J. 154 (1977).

ideal of disinterested expertise, the inequitable conduct doctrine waxed and waned over the years. Some cases relied on Rule 1.56 in assessing materiality of alleged misstatement or omissions.<sup>204</sup> PTO practitioners decried a “plague” of allegations, however, and called for the doctrine to be narrowed.<sup>205</sup> As before, they proved to be an influential group. In *Therasense, Inc. v. Becton, Dickinson & Co.*,<sup>206</sup> the Federal Circuit held that inequitable conduct requires proof of intent to defraud the PTO and but-for materiality, meaning that a patent would not have issued but for deceit by a patentee or its agent.<sup>207</sup>

## II. LAWYERING WITHIN THE DOMAIN OF EXPERTISE

The history surveyed in Part I illustrates important aspects of the relationship between administration as a means of regulation and the practice of law. At all points in time, patentees had to sue infringers in court, so ordinary litigation practices were never absent from the picture. Under the 1793 Act, however, they were essentially all that stood between a purported inventor and his hoped-for riches. The picture became more complicated when the 1836 Act introduced the prospect of expert review. In theory, patents that issued after expert scrutiny deserved a greater presumption of validity than patents that issued upon oath under the registration system. Expert examination up front would tend to favor patentees in litigation, but if lawyers worked both sides of the street, there would be no net effect on their business over the general run of cases, except to the extent that fewer patents implied fewer cases.<sup>208</sup>

The picture looked different from an *ex ante* perspective. Greater confidence in issued patents would be no solace to a client whose application was rejected. Neither would it do much for counsel prosecuting the application on a contingent fee basis. Lawyers and agents who limited their practice to prosecution, therefore, might well favor the appearance of expert review without the substance. Litigators working both sides of the street might favor that approach as well, at least to the extent that more patents might imply more work. Lawyers who represent only infringers might hope for more stringent, gold-plated review to avoid a lemons-style problem, but even they would realize that a patent that does not issue cannot be asserted.

Patent lawyers thus straddle the fence of expert review. They want patents to carry the prestige of having passed examination while retaining as much of their own strategy space as possible. The antagonism to strict “illiberal” review seen in the 1840s and 1850s reflects a basic antagonism

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204. *Id.*

205. A small sample of this output is cited in *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1288 (Fed. Cir. 2011).

206. 649 F.3d 1276 (Fed. Cir. 2011).

207. *Id.* at 1292.

208. Which might not be the case: if patentees under the registration system were less likely to invest in litigation than patentees that already survived examination, then the number of infringement suits might be roughly the same.

between lawyers who seek maneuvering room to ply their trade and examiners who wanted to apply expertise.<sup>209</sup> To an expert examiner, an invention either was or was not novel in relation to the prior art, for example, and while the nature of the question of novelty might be specified by statute, the answer and the means of obtaining it posed technical questions. From this perspective, the lawyer's tradecraft—drawing distinctions, framing facts, inflating or deflating the significance of evidence, making tactical concessions, and so on—amounted to noise.

This ambivalence can be seen in the unsuccessful efforts of lawyers to use state licensing regulations to exclude nonlawyers from practice before the PTO. In the early 1960s, Florida sued Alexander Sperry, a nonlawyer admitted to practice before the PTO, to enjoin him from pursuing his practice while a resident in Florida.<sup>210</sup> Though conceding that patent prosecution is “the practice of law,” the Court held that federal regulation of practice before the PTO precluded Florida from asserting its laws against unlicensed practice to enjoin Sperry's PTO work.<sup>211</sup> A group of patent agents submitted a brief as amici curiae asking how mastery of bar subjects suited one to prosecute patents and whether Florida bar examiners felt qualified to assess a patent agent's application—good points, each.<sup>212</sup>

In *Sperry v. Florida Bar*,<sup>213</sup> the bar's protectionist impulses ran headlong into both science and history, and lawyerly self-interest proved too weak to overcome their combined force. The bar's effort is instructive, however, as providing a concrete example of a contested conceptual space between lawyers' work and “science,” or, more generally, between advocacy and expertise. I contend that we may extrapolate from the example of patent prosecution, and from its history, to draw more general insights regarding the relationship between lawyers and the administrative state. Though there are many justifications for regulation, an agency's *claim* of disinterested expertise will tend to produce stricter rules on lawyers' behavior than would be found absent that claim.

#### A. *Distinguishing Regulatory Justifications*

Roughly speaking, we can identify three genres of regulation; it is best to think of these genres of regulation as shading into one another on a continuum, rather than as distinct categories. In the first, a regulation is justified by specialized knowledge an agency claims to have. An invention either is or is not useful, novel, and nonobvious; a cancer drug either is or is not safe and effective, relative to a placebo.

The second genre adds administrative enforcement to things that are unlawful already; the SEC or FTC may punish false statements about a company or its products, for example. Such belt-and-suspenders regulation

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209. See *supra* Part I.

210. *Sperry v. Florida ex rel. Fla. Bar*, 373 U.S. 379 (1963).

211. *Id.* at 383.

212. Brief of Amicus Curiae Am. Ass'n of Registered Patent Attorneys & Agents at 4, *Sperry*, 373 U.S. 379, 1962 WL 115181.

213. 373 U.S. 379 (1963).

may target legitimate areas of underenforcement, but underenforcement itself implies only a need for more or better enforcers. Underenforcement does not entail the need for a new agency. A claim to specialized knowledge thus helps justify agency regulation as the form the extra layer of enforcement takes.

A third category combines the first two. Expertise may be employed to create new categories of wrongs not otherwise explicitly prohibited. Thus, the SEC may mandate particular forms of accounting and treat deviations as unlawful, the FDA may prohibit the sale of drugs that have not been shown to be safe and effective using specified methods, or the EPA may set limits on discharges.<sup>214</sup>

Before exploring the implications of the first category, I want to acknowledge some limitations on these distinctions. These categories exclude some important features of regulation. As a practical matter, regulation is often just cartelization with a government stamp. Much licensing—including licensing of lawyers—is like this. We should not lose sight of this fact, but for the moment we can focus on the claim of expertise as a justification for regulation, even if in fact the justification is just window dressing. The claim to possess expertise is a sideshow when protectionism is at work, but the claim still may be significant with respect to how the agency approaches lawyers who practice before it. These distinctions also do not talk about vertical integration of enforcement, or about how modes of regulation rulemaking is different from adjudication, which in turn is different from oversight by the late, unlamented Office of Thrift Supervision (OTS). And some tasks that are uniquely federal—immigration being an obvious example, as well as import-related regulation such as is practiced in the International Trade Commission—will tend toward the agency form because there is no ready alternative.

Finally, disinterested expertise is good, but it is not—and cannot be—everything.<sup>215</sup> Even assuming we can discern that mandatory vaccination will have debilitating side effects in ten cases while saving one hundred lives, we must decide whether the trade-off is worth it. We can construct equations expressing these trade-offs, but the values of the variables have to come from somewhere, and there is no reason to expect that disinterested expertise can answer what is essentially a question of values. Various flavors of Hume may be recited—even assuming we can get a handle on the “is” of the question, doing so does not get us to “ought.”<sup>216</sup>

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214. As this example shows, general laws—such as nuisance—may capture some conduct that agencies may target more specifically.

215. This idea is a persistent theme of Steven Goldberg’s work and the later work of Arthur Leff. STEVEN GOLDBERG, *CULTURE CLASH: LAW AND SCIENCE IN AMERICA* (1994); Arthur A. Leff, *Law and Technology: On Shoring Up a Void*, 8 *OTTAWA L. REV.* 536 (1976); see also Laurence H. Tribe, *Technology Assessment and the Fourth Discontinuity: The Limits of Instrumental Rationality*, 46 *S. CAL. L. REV.* 617 (1973) (exploring similar themes).

216. DAVID HUME, *A TREATISE OF HUMAN NATURE* (L.A. Selby-Bigge ed., Oxford Clarendon Press 1896), <http://oll.libertyfund.org/titles/342> [<https://perma.cc/D3CA-FA5V>].

The appeal of expertise cannot be realized in full. Even where it might succeed as a scientific matter, practical application drags expertise into the muddled mire of politics and ethics. From this angle, there is no such thing as “disinterested” expertise because expert procedures contest with alternatives such as faith, ideology, and custom. Lawyering in the regulatory state therefore may be viewed as part of a problem memorably described by Arthur Leff as the conflict between the desire for “findable rules that authoritatively and unambiguously direct us how to live” and desire to be free to choose what to do and how to live.<sup>217</sup>

Nevertheless, none of these limitations implies that distinguishing among regulatory justifications is pointless or that we can learn nothing by exploring the first category, in which administration is justified at least in part by the claim to possess expertise. Thus caveated, I contend that, in general, agencies claiming to wield expertise will want to reign in lawyers in rough proportion to the plausibility of that claim. The stronger the claim, the more an agency will try to reign in lawyers, and vice versa. The reason is simple: within the domain of expertise, lawyers have relatively little to do. Their stock in trade—framing and other rhetorical tricks, bluffing, crafty negotiation, cloaking evidence with the veils of privilege or work product—is of little value when the question is whether lead in gasoline is bad for people, whether Thalidomide crosses the placental barrier and disrupts the formation of a fetus, or whether Cetuximab is effective in patients with KRAS mutant cancers.

Within the domain of disinterested expertise, lawyers, as lawyers, are more likely to contribute noise than signal. They can serve as efficient information gatherers, and in some cases can enhance clarity through the arrangement of information in relation to specified purposes, but arrangement is a relatively thin increment of information, and lawyers are duty-bound to favor arrangements that favor their clients, which may or may not imply arrangements that increase the efficiency of administration.

### *B. Tension Between Truth and Competing Values*

This point may be sharpened further, though at the risk of caricature. Suppose there are two types of issues of possible interest to lawyers: truth and fairness. In the domain of truth, we presume a high degree of consensus on standards for assessing some subject; we denote that consensus by proclaiming that the standards are “objective.” In the domain of fairness, subjectivity counts. Even if there are some objective standards for some assessment, within the domain of fairness they do not exhaust all points relevant to a question. This division roughly corresponds to the way defamation law determines whether a statement is one of fact or one of opinion, though this division raises some distinct problems of its own.<sup>218</sup>

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217. Arthur A. Leff, *Unspeakable Ethics, Unnatural Law*, 1979 DUKE L.J. 1229, 1229 (emphasis omitted).

218. E.g., David McGowan, *Copyright and Convergence: A Pragmatic Perspective*, in INTELLECTUAL PROPERTY PROTECTION OF FACT-BASED WORKS: COPYRIGHT AND ITS ALTERNATIVES 233 (Robert Brauneis ed., 2009); Robert C. Post, *The Constitutional Concept*

This dichotomy has some tricky aspects. Many true propositions would gain lots of votes as being fair, but those votes are not essential to truth. Propositions that imply or entail horribly unfair things may nonetheless be true. Some might take issue with the second presumption necessary for this dichotomy to work: that there is no truth of the matter about fairness. I think that is right. There are (lawyerly) ways to tease truth out of fairness, though they tend to involve sociobiological explanations that are controversial and which try to lessen the subjectivity of fairness by grounding it in science.

This dichotomy does *not* entail that any given problem implicates only one domain. There may be a truth of the matter about whether the defendant killed the victim, as there is about whether a molecule starves cancerous cells, but it does not follow that truth is all that is at stake if we put the defendant on trial. If it did, all reliable methods of investigation would be acceptable, yet the law layers fairness concerns (thinly) on top of this goal. The right to counsel and prohibitions on beating confessions out of suspects come to mind.

The domains of fairness and truth coexist, but often they are in tension and the relative influence of the domains changes over time. Within the domain of expertise, as the administrative state grows it stakes greater claims to truth as a value and tries to expand the domain in which lawyers and clients must conform their behavior to the primacy of that value. Often that means strict disclosure obligations imposed by financial regulators and the PTO that would (for now) seem bizarre and unconstitutional in a criminal trial. The lure of expertise exerts a more subtle influence, as lawyers leverage scientific evidence or explain, apologetically, that convictions may be had even without the sort of forensic evidence jurors might see on television.

### III. WHAT WILL REMAIN?

Most readers of this Article have been wily enough to see what is coming, so let me repeat: claims to expertise may fail, expertise possessed may not be applied, and where regulation is justified on grounds other than expertise, my argument in this Article does not apply. Nevertheless, within the asserted domain of expertise, the argument in Part II gives lawyers peripheral roles. Lawyerly training may lead one to take center stage and proclaim, “I come not to answer the question, but to problematize it!”<sup>219</sup> But in the domain of expertise, that speech never takes center stage. It is whispered from the wings if heard at all.

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*of Public Discourse: Outrageous Opinion, Democratic Deliberation, and Hustler Magazine v. Falwell*, 103 HARV. L. REV. 601, 652 n.265 (1990).

219. Which actually sounds more like a professor. A lawyer would say, “I come not to answer the question, but to ask another, more to my liking.” See Jerry L. Mashaw, *Law and Engineering: In Search of the Law-Science Problem*, 66 L. & CONTEMP. PROBS. 135 (2003) (surveying the various ways in which lawyers and scientists diverge in their approaches to problem solving). I think he overstates the compatibility of engineering with litigation, but patent prosecution would be a good case for his thesis.

Some lawyers, particularly academic lawyers, dislike the suggestion that they might play Osric someday but never Hamlet. They insist that problematizing is valuable, that they still have something to bring to the table (and by implication that they still deserve a seat there), even if all they have to offer is various arguments of the form “is that fair/says who?” True enough. My point is comparative: within the domain of fairness, this sort of argument may say most of what can be said, and lawyer-sophists—philosophical or otherwise—may sit at the head of the table. Within the domain of expertise, they sit farther down the table if they get a seat at all. When a strong claim of expertise is made, they may find themselves relegated to the children’s table and be told to be seen but not heard.

Assuming expert means for finding it (a big assumption, to be sure), the aspiration to truth constrains rhetoric. When truth is the prime value and expertise is adopted as the means of finding it then, as a practical matter, lawyers either must conform to the narrow constraints of disinterested expertise or insist that some other game must be played. That is roughly what happened in the 1840s and 1850s, when patent agents and inventors complained that examinations were too strict. Unhappy with having to prove novelty, which at least in theory is an inquiry that takes the falsifiable form of the assertion that a claimed invention has not been used or disclosed before, advocates shifted the focus to inventors and their aspirations. Rhetorically they succeeded in shifting from logos to pathos as the primary mode of discourse. Logically the move had essentially nothing to commend it, but the move gave lawyers and their clients more strategy space. The resulting mess eventually provoked Commissioner Fisher’s reaction—competitive examinations and a renewed emphasis on precision and rigor—and a corresponding reduction in strategy space. As one might have guessed by now, this cycle recurs predictably in the history of patent law. It seems intrinsic to the process. To this day, patent prosecutors with law degrees earn more than patent agents, and the differential wage reflects incremental learning in legal rhetoric, not science. Indeed, the size of the wage disparity is evidence of the degree to which the patent system cannot be relied upon to allow applications based on scientific rather than legal grounds.

To the extent this generalization is accurate, it implies three things. First, within the domain of expertise, confidentiality will be a less important value than accuracy, and lawyers’ assertions of confidentiality will be more contested than they are in other domains. Rule 1.56 exemplifies this point, as does the OTS’s displeasure with Kaye Scholer’s alleged attempt to interpose itself between the OTS as regulator and Lincoln Savings as a regulated entity.<sup>220</sup> It is more common for disclosure obligations to target

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220. E.g., Geoffrey C. Hazard, *Lawyer Liability in Third Party Situations: The Meaning of the Kaye Scholer Case*, 26 AKRON L. REV. 395 (1993). The issues are surveyed in a symposium in 23 L. & SOC. INQUIRY (1998). Kaye Scholer pointed out that by the time it showed up, the relationship between the OTS and Lincoln Savings had become adversarial; Kaye Scholer was litigation counsel. Dennis E. Curtis, *Old Knights and New Champions: Kaye Scholer, the Office of Thrift Supervision, and the Pursuit of the Dollar*, 66 S. CAL. L.



clients rather than lawyers, but the relative point still holds. Where disinterested expertise justifies regulation, the experts need something to work with, which implies strong disclosure rules. It also implies that courts should be more willing to entertain claims of selective waiver, which would allow regulated companies to provide information to supposedly expert regulators without feeding the frenzy of decidedly nonexpert civil litigation.<sup>221</sup> Lawyers who cannot shift the rhetorical ground and change the game they have to play will be stuck with a relatively subservient role, at least compared to lawyers who deal with private disputes or regulation that is not justified by claims of expertise.

The second point might be called “Sperry’s revenge.” As we shift from the domain of fairness to the domain of truth, we invite entry by any and all truth producers, including programmers, economists, statisticians, and other nonlawyers. The engineer’s claim to be better able to prosecute patents has turned from a defensive protection of legacy rights to a tactical incursion into work that used to be performed by lawyers. Even within nonexpert domains, such as general litigation, much of the work may be expertised and therefore made competitive. There is no reason to expect that trend to change.

Finally, the prospect of disinterested expertise raises the question why rules governing advocacy before tribunals would ever be concerned with giving lawyers enough room to strut their stuff. Possibly there is no truth of the matter, though then one wonders why a tribunal should be convened. What is it supposed to do? Bizarre epistemologies may be espoused, and the “standard model” of lawyering may accommodate them, but often they are implausible on their face and they prove too much: if knowledge is so elusive the cumbersome apparatus of a trial is pointless. Possibly there is a truth, but no consensus exists on the means of ascertaining it. That happens often enough, but it does not justify efforts to skew results within any particular means, such as by sowing distrust of a truthful witness, or engaging in rhetoric detached from any plausible relationship to the truth.

Any difference in practice may be assessed from either of the contrasting perspectives. For most lawyers, it would be natural to ask why the PTO imposes affirmative disclosure obligations—but it is equally fair to ask why other tribunals do not. The administrative state has expanded over time, bringing more and more subjects within the domain of claimed expertise; there is no reason to expect that process to stop. This expansion invites arguments about what lawyers do and should be allowed to do and about how important truth is in comparison to other values. The process complements other, more market-oriented changes that tend to put pressure on traditional conceptions of what lawyers may and should do. As clients

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REV. 985, 989 (1993) (noting—though not endorsing—Kaye Scholer’s argument). The point in the text is that within the domain of disinterested expertise, that fact should not matter.

221. See, e.g., DAVID MCGOWAN, DEVELOPING JUDGMENT ABOUT PRACTICING LAW 251–52 (2d ed. 2013) (describing the rule against selective waiver); cf. Mila Sohoni, *The Power to Privilege*, 163 U. PA. L. REV. 487 (2015).

push from the market side, experts touting the primacy of truth over fairness will do so from the government side. These complementary forces will continue to exert pressure on lawyers to justify their methods in terms of results rather than tradition.