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How to Choose the Next Federal Circuit Judge: Stick with Experience

By **Judge Paul Michel (Ret.)**
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Print Article

"Patent law was a mess when the court was legislated into existence four decades ago….Have we now come full circle?"

The Court of Appeals for the Federal Circuit, the nation's patent court, is at a crossroad. Today, unlike in earlier decades, nearly all its cases are patent-related, yet, to my eye, barely half its members can be considered lifetime patent lawyers. And although any diligent lawyer can learn "black letter" patent law on the job (as I myself did), that is no longer sufficient, because judges also need a deep understanding of how inventors and investors, including corporate CEOs, rely on patents in making difficult and fateful decisions about whether to fund new R&D and manufacture new products, or not. Such decision-makers crave predictability of outcome and stability of legal requirements. Because uncertainty generates excess risk, when in doubt, they usually opt against going forward.

The Court is Productive, but Increasingly Paralyzed

Therefore, recent trends in case law are worrisome as impeding progress "in science and the useful arts." Why? Because predictability and stability have been systematically downgraded. Instead, the court seems determined to keep evolving legal frontiers in pursuit of a more perfect patent system than contained in the Patent Act and settled precedent, each following personalized assumptions of optimal patent policy. Consequently, results often seem a function of the composition of the randomly-drawn panel, a fact unknowable when critical

decisions are made years before any appeal. Moreover, the court seems consistently unwilling to go *en banc* to resolve numerous and disturbing conflicts and thus speak clearly, with one voice. It has been years since the last re-hearing by the full court in a major patent case. Many votes whether to go *en banc* are close, sometimes 6-6. Such paralysis is unhelpful, to say the least.

But in creating the court in 1982, Congress was explicit that the court's mission was to clarify and unify patent law, increasing predictability and reliability. And strengthen its power to drive technology advances, which for decades the court did—until recent years.

Everyone can agree that all the present judges are extremely intelligent, learned and industrious. In fact, it is most impressive how the same staffing of 12 active judges the court was accorded at its creation have shouldered the flood of appeals from the Patent Trial and Appeal Board (PTAB), on top of the continuing river from the district courts and the international Trade Commission. And the cases are more complex than ever, not only technologically but economically.

But productivity is not the only measure of success. Coherent patent doctrine is just as important. So are stability of rules and predictability of results. There, the court has been less successful. Consider the confusion surrounding such basic and common patent issues as the bounds of eligibility, availability of injunctions after judgement of infringement, nexus requirements for damages and injunctions, proper claim construction methods, obviousness analysis, especially regarding Objective Indicia of Non-Obviousness and, again, nexus requirements, all of which seem to shift constantly.

Full Circle

Patent law was a mess when the court was legislated into existence four decades ago. Its first chief judge had a "Phoenix List" of major problem areas, which the court resolved in its first decade and beyond. Have we now come full circle with patent law's lines being badly blurred? Even worse, continually shifting and difficult for examiners and judges to apply consistently.

Patents that were valid when issued are often later invalidated under subsequent case law developments. So, the patentee is effectively punished—divested of its personal property right (see 35 U.S.C. § 261)—for having failed to predict later extensions of the precedents as much as a decade earlier. Section 101's and 112's growing requirements are just two examples.

Chief Judge Markey often opined in early years that the court's complement of patent lawyers should reflect the proportion of its patent cases. In early decades, patent cases made up about a third of the docket, so, logically, it should have had about four lifetime patent lawyers, which it did. Now, over three-quarters of its docket consists of patent-related appeals, but only half of the 12 active judges were, pre-appointment, patent lawyers by any definition. Even then, none had extensive personal experience both trying patent cases and prosecuting appeals.

Choose Wisely

To me, this all suggests that the nominee to fill the vacancy on the CAFC expected in May should be a seasoned patent litigator. And ideally one who has represented both patent owners and accused infringers. And preferably one with exposure to the PTAB as well as trial and appellate courts. But most importantly, a patent lawyer who believes in patents! Such a litigator should be able to resist the gravitational pull of ever-expanding extensions of Supreme Court decisions such as *Mayo/Alice*, *e-Bay*, *KSR*, *Lexmark*, *Helsinn*, etc.

Of course, experience as a district judge active with patent cases is roughly equivalent. Experience in industry can also inform deep understanding how the patent system applies in practice, including in deals, licensing and portfolio building. Academics and Capitol Hill policy lawyers seem less informed on such matters and hence less appropriate.

Because so much patent litigation today is global, reflecting global commerce, international experience, including with licensing and Standard Essential Patents and FRAND disputes and foreign courts and patent laws, would be very useful.

Finally, the lawyer selected must not only believe in the utility of patents as drivers of progress, but also in the mission of the court itself. So, service as a law clerk, although not a requirement, is also desirable.

Under all these criteria, the Administration, fortunately, will have many suitable candidates from which to choose. Let's hope the criteria are kept in mind.

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THE AUTHOR

Judge Paul Michel (Ret.) became a private citizen on June 1, 2010 for the first time since he graduated from law school at the University of Virginia in 1966. Upon graduating from law school he became an Assistant District Attorney in Philadelphia, thus embarking upon the career of a public servant from 1966 to his retirement from the United States Court of Appeals for the Federal Circuit in 2010. Michel served on the Federal Circuit, which is the main patent appeals court in the United States, from 1988 to 2010, serving as Chief Judge from 2004 to 2010.