

The Patent Law Issue

PATENT LAW AND litigation affects every person reading this magazine—and their friends and families too. Do you use the Internet? Within the last two years, a patent litigation directed at the routers used as the “backbone” of the Internet was tried before a jury in San Francisco, with the plaintiff seeking a permanent injunction against the further manufacture, sale, and use of those routers. In an article celebrating the defense’s win at that jury trial, the legal press wrote that “it’s hard to imagine what would happen if a plaintiff was about to secure an injunction on [those] routers. Would it bring civilization, as we know it, to a screeching halt? Because of the [defense’s win], we won’t have to answer that question.”

Are you an investor in pharmaceutical companies? Then perhaps you have felt the pain from stock drops that sometimes accompany a blockbuster product going “off patent”—that is, losing patent protection because the patent(s) that cover the product have expired. Do you own a BlackBerry® wireless e-mail device? Then perhaps you remember the district court litigation in which a plaintiff, having won a jury trial that found that the device had infringed the right, was seeking a permanent injunction against the further manufacture, use, or sale of the device. Depending on whom you believed, you were weeks or days or even hours away from the entry of that order—and from having your device turned off. In jurisdictions across the country, there are almost always patent litigations being fought in which the rights to make, use, and sell products and services on which millions of consumers depend are at risk. With roots stretching back to the Constitution (Article I, § 8), patent law and litigation continues to play an important role in the U.S. economy.

The Federal Lawyer is pleased to present this issue devoted to patent law. And we are privileged to present articles written by or about representatives of four

of the major participants in patent law and litigation as it exists today: Congress, the judiciary, academia, and litigators.

In Congress, the subject of patent reform has been the subject of much legislative assessment and scrutiny. As this issue goes to press, patent reform bills are pending in Congress. One of the legislative and thought leaders in the patent reform debates is Congressman Darrell Issa (R-Calif.). As a patent holder (see, for example, U.S. Patent No. 5,646,591), former business executive, and former patent litigant, the congressman is able to bring a broad and deep perspective—both theoretical and practical—to the difficult issues of patent reform. As you follow the ongoing patent reform debates and discussions, the points that he makes in his article—that the sky isn’t falling, for the most part—are good to keep in mind.

On the subject of broad and deep perspectives, *The Federal Lawyer* is privileged to present a profile of the Federal Circuit’s chief judge, Hon. Paul R. Michel. Created with the express goal of bringing more predictability to what was then a highly uncertain and circuit-specific body of law, the Federal Circuit celebrated its 25th anniversary this year. The circuit occupies a unique position in our federal appellate system. Unlike its sister circuit courts, the Federal Circuit’s jurisdiction is based on subject matter, not geography. Patent litigation is one of those subjects. Like other litigation that is based on rights established in a federal statute, patent litigation is waged initially in the federal district courts. On appeal, however, patent litigation is different: it generally goes to the Federal Circuit, not to the regional court of appeals for that district court.

Chief Judge Michel is the Federal Circuit’s fifth chief judge. Perhaps it will surprise many readers of this publication to learn that the current chief judge of the circuit that hears patent appeals was neither trained in technology while in college (he steeped himself in political science) nor trained in patent law in law school (his first job out of law school was as a state prosecutor in Philadelphia).

Or, perhaps, that fact will surprise very few: our patent litigation system is premised on the notion that lay people are appropriate decision-makers. Lay jurors serve as the triers of fact in patent cases, no matter how complex. Lay district judges preside over patent cases and decide what the disputed terms of the patent claims mean; decide summary judgment motions; and, under the Supreme Court’s recent *KSR*

decision, decide whether the asserted patent claims were obvious. Our patent system, in short, embraces the notion that, in addition to benefiting from the participation of people who have deep technical expertise in the subject matter, the system benefits from the participation of people who can bring to bear the perspectives from legal disciplines outside of patent law. Chief Judge Michel is one such person. His career has involved him in many of the important legal and political events of the last 30 years. The chief judge's perspectives on a variety of issues, including public service and the mentoring of young lawyers, serve to remind us that, long before the practice of law was seen as a business, it was highly regarded as a profession, and that, modern-day pressures aside, it can continue to be held in that regard.

One of the fascinating and rewarding aspects of patent law is that, despite its historical roots that stretch back to this country's founding, core patent law doctrines continue to evolve. That evolution, particularly in so rich and complex a subject as patent law, affords scholars an unusual opportunity to help shape the contours of emerging legal doctrine. Two of the leading patent law scholars in the United States have contributed articles to this issue. From the University of Pennsylvania Law School, Professor R. Polk Wagner advances an interesting thesis: that a series of major shifts has rocked the patent system in recent years, including a growth in patent-related activity and the emergence of the technology industry (on the West Coast) as a major player in the political economy of the patent system. Professor Wagner argues that these "plate tectonics," as he terms them, both explain the recent interest in the patent system and suggest important features of its future—including, in his view, that meaningful patent reform will increasingly fall to the courts.

Taking perhaps a different view, Clarisa Long, Max Mendel Shaye Professor of Intellectual Property Law at Columbia Law School and a visiting professor of law at the University of Chicago Law School, thoughtfully assesses some of the current legislative efforts at reform and urges that Congress take the time to make sure patent reform does not create more problems than it solves.

Finally, the high-stakes patent litigations that we now read or hear about can often carry practical lessons for those involved—the decision-makers in the companies that wage the battles and the lawyers litigating and trying those cases. One such recent high-profile litigation (*Fortune* magazine, among others, followed it) was the *Yeda/Imclone* patent dispute, in which the inventorship of the patent that protected a blockbuster drug was at issue. Nicholas Groombridge, at partner at Weil, Gotshal & Manges LLP in New York and the co-chair of the firm's Patent Litigation Group, conveys some useful lessons in his piece, "Practical Lessons from a 'Made-for-TV' Patent Litigation." (Disclosure: Groombridge is a law partner—and

friend—of mine.) Lawyers in the early phases of their careers may find some of these lessons particularly applicable.

At conversations at bar or other social functions, the first question people often ask is, "What do you do for a living?" The question is designed to reveal a range of subjects of mutual interest. It can be a nice icebreaker, except that it does not work that way for patent litigators. Tell someone that "I litigate and try patent cases," and (unless you are attending a patent law conference) you will almost invariably get a tepid "Oh" as a reaction, followed quickly by a change of subject. It's a bit distressing for those of us in the field, because we think of patents and patent litigation as meaningful and fascinating. Perhaps after reading the pieces in this issue, you will too.

We are pleased to bring you this special issue of *The Federal Lawyer* on the subject of patent law. **TFL**

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