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Academics and the Federal Circuit: Is There a Gulf and How Do We Bridge it?

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John R. Thomas*

Many of the great research universities of the United States enjoy a close relationship with innovators. Names like Carnegie, Cornell, Hopkins, Stanford, and Vanderbilt bring to mind not so much these men, but the academic institutions that they founded. The mention of other research institutions, such as the Universities of Chicago and Virginia, allows us to recall entrepreneurial founders such as Rockefeller and Jefferson. It is appropriate then, to consider how university research—and in particular, the work product of the law schools—is faring before that court whose rulings most directly impact American innovation policy.

There can be no question that the individual members of this court have endeavored mightily to assist the universities in their missions of research, teaching, and service. For example, one of the court’s jurists served for over three decades as a full-time member of a law school faculty; another has endowed a chair in her name at one of the country’s leading law schools; one sits on his law school’s Board of Visitors; yet another holds positions upon both the Board of Regents and the Board of Trustees of two of our most highly regarded universities.

Several members of the court serve as beloved instructors in the area law schools; others have tirelessly given of their own time to visit our classrooms; three of them are co-authors of leading patent law casebooks. The court has even gone so far as to convene formally in our lecture halls. It would be difficult to overstate, through each of these vehicles, the ways in which these jurists inspire our students, and encourage them to aspire to the highest values of our profession. When one considers the other demands upon them, the commitment of Federal Circuit jurists towards America’s universities is nothing short of extraordinary. Each of us on this panel, I’m sure, along with our institutions, is tremendously grateful for their efforts.

We can quickly conclude that this court, both collectively and through its individual members, is an institution that values the academy. One might be inclined to believe, then, that there would be a similar interest in scholarly research. Here, however, we find a disconnect. In fact, empirical research has show that the Federal Circuit is less likely than other courts to cite scholarship in its opinions. For example, a study by Professor Craig Nard revealed that

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* Professor of Law, Georgetown University. Remarks at The Giles Sutherland Rich American Inn of Court, Washington, D.C., September 13, 2005.
the copyright and trademark opinions of the Second and Ninth Circuit are four times more likely to cite a law review article than the Federal Circuit is in patent cases. The raw numbers of citations are even more telling looking at the last two years of Professor Nard's study. For the calendar year 1999, the Federal Circuit cited a grand total of two articles; in 2000, seven articles were cited—five of them in the Festo case. These annual statistics are consonant with others over the court's nearly twenty-three year history.

Another consideration is: What are the articles being cited? One lengthy decision that likely every person in the room has reviewed is Phillips v. AWH Corp. In the three opinions associated with that decision, a total of two articles were cited. One of the articles was titled The Law of the Word: Dictionary Shopping in the Supreme Court; the other was Judicial Discretion of the Trial Court, Viewed From Above. Most of us are well aware that there is a substantial body of literature addressing claim construction in the post-Markman era, both by full-time members of law faculties and by scholarly practitioners. Needless to say, none of that work was cited in the lengthy Phillips opinions.

I am by no means suggesting that the scholarly literatures deserves citation merely by reason of its existence; or indeed that it is worthy of any notice whatsoever, beyond the weight of its own words. No one advocates the citation of literature for its own sake, as some sort of prop. Yet we suspect a positive correlation exists between the rate of scholarly citation and the extent of its influence. A review of the recent studies by the National Academies, Federal Trade Commission, and National Academy of Public Administration, as well as testimony received by Congress in connection with patent reform legislation, reveals that academic research plays an important role within the patent law. Yet for matters more directly within the province of this court, it seems that law professors in the patent field are primarily writing for a limited audience—each other. It is worth exploring how it can be that the jurisprudence

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3 Nard, supra note 1, at 680 tbl.3, 681 n.53.
4 See generally id. at 680 tbl.3.
5 415 F.3d 1303 (Fed. Cir. 2005).
6 See id. at 1308–09, 1322, 1333.
8 Maurice Rosenberg, Judicial Discretion of the Trial Court, Viewed from Above, 22 SYRACUSE L. REV. 635 (1971).
of the one court most bound up with our country's R&D establishment in large measure fails to reflect the fruits of university research. I suspect there are numerous explanations; let me speak to two of them.

A first factor is the lack of established academic tradition in our field. Just a decade ago, several schools boasted that U.S. News & World Report ranked them as having preeminent intellectual property faculties; they also cheerfully awarded LL.M. degrees in Patent and Intellectual Property Law. In fact their full-time faculties did not include a single tenured faculty member who taught patent law. This was no mere oversight: Many academics believed that good people didn't do intellectual property, particularly patents.

This statement is by no means meant to denigrate the dedicated adjunct professors who can bring perspectives to future practitioners that no full-time academic can. Indeed, the teaching of seasoned, articulate lawyers forms an integral part of any robust intellectual property program. Yet the demanding schedule of professionals often limits their ability to conduct ambitious programs of scholarly research. No wonder then, that patent scholarship was generated quite slowly, and within the academy the field remained something of a backwater.

A second factor is the nature of this court. It was created to be an expert body in patent law and, for the most part, is assigned with hearing patent appeals from across the United States. Further, the court aspires to the practice of panel adherence to the holdings of their predecessors. Reference to other authorities may be seen as pointless at best, and at worst disruptive. As two of the court's jurists have explained: "Critical articles may be written by those who have lost a case, or those who are skilled in a particular technology or not, or those who have little practical experience or who are seasoned experts."10 They further stressed that "we decide cases as they come to us, based on the arguments raised, the decisions below, the law, the facts, and our best efforts, not based on occasional journal articles."11

In an era in which patent litigation has been heavily influenced by the Daubert12 and Markman cases, the view has a certain resonance. It suggests that documents not generated within the usual course of litigation should be eyed warily, as potentially constituting junk law, or perhaps corrupted by the taint of advocacy. Under this view, law journal off-prints should not be bound in the tan of Harvard, the white of Yale, or the maroon of Chicago, but rather the minty green of an amicus brief, complete with a statement of interest at the start.

11 Id. at 974.
Can we predict that the role of the academy change? Today, of course, the situation regarding patent scholarship is much different than it was in 1982. Increasing numbers of former Federal Circuit clerks have found a place in the academy, more law schools are hiring associate professors with research interests in patents, and the scholarly literature in patent law has exploded in recent years. Something of a circularity problem persists, however. Perhaps out of a sense that the Federal Circuit primarily relies upon its own opinions, lawyers may be reluctant to devote much of their limited word counts to citation of scholarly authority, not to mention discussion of it—even where such authority is persuasive and supportive of their position in a particular dispute. In turn, the Court may simply not have ready access to the scholarly literature.

Yet there is reason to believe this situation is changing. As the actual students of the new cohort of academics themselves advance, they are predisposed to embrace the literature of their instructors more freely. Further, the nature of patent practice is changing. As we observe patent law firms dissolving, or merging into general practice firms, we realize that the patent bar is much less self-contained that it was. As patent lawyers increase their professional interactions with colleagues practicing in other disciplines—for example, with members of the antitrust bar, where judicial citation to scholarly viewpoints is well-entrenched—we suspect that traditions concerning the use of scholarship will also change.

Does the jurisdictional grounding of the Federal Circuit necessarily imply a restrictive view of scholarship? In my opinion, this is a reason for this institution not to shy from academic research, but rather to embrace it. The jurisprudence of this Court has at times been described as isolated. In my view, this view is unfair and unwarranted—yet there can be no stronger response to this charge than through broader resort to scholarship. Further, nobody reads scholarly writings in order to learn substantive law; the treatises and commentaries fulfill that need. Scholarship instead allows its reader to benefit from the insights that a period of sustained study, isolated from the pressures of time and the necessity for persuasion, can bring. Academics provide important perspectives from disciplines that are remote or inaccessible to the typical patent practitioner; they place the patent law within its larger legal and social context; and yes, they sometimes take positions that are unpopular among the patent bar. For these reasons, the scholarly literature at times merits consideration. The fact that we are gathered here today to address this important topic provides at least some acknowledgment of these principles; and it suggests greater dialogue between the bench and the academy in the future.

Allow me to close by observing that schools of thought, intellectual movements, and cultures rarely prosper when they are entirely self-referential. In the United States, the role of the university has been a dynamic one; but at
its best the academy has served as the conscience of the community; as an honest arbiter of debate; and ultimately as a contributor to the establishment of just laws. In days yet to come, so it may be within the patent bar, and before this court. Thank you.