Does *i4i* Foretell Increased Respect for Judge Rich?

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Professor Field regards that as a noteworthy possibility.

In *KSR*, the 35 U.S.C.§ 282 presumption of validity seemed to get short shrift. The Court relied heavily on the uncited Asano patent to invalidate the patent in question. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007). Indeed, the Court said that when previously uncited art is offered in litigation, "the rationale underlying the presumption — that the PTO, in its expertise, has approved the claim — seems much diminished." *Id.* at 426. It is not surprising, then, that Microsoft had some confidence in arguing in *i4i* that a mere preponderance of evidence overcomes the burden, if not otherwise, when previously uncited prior art is brought to courts' attention. Microsoft Corp. v. i4i Ltd. Partnership, 131 S.Ct. 2238, 2249 (2011).

Justice Sotomayor, however, writing for the Court, found no support for that proposition, either in earlier cases or in the legislative history of the statute. Regarding competing policy arguments as best made to Congress, she points out that the Federal Circuit's view, i.e., that the presumption can be overcome only with clear and convincing evidence, has been left intact despite numerous opportunities to amend § 282 and "ongoing criticism, both from within the Federal Government and without." 131 S.Ct. at 2252.

Yet that the burden is unchanged does not mean that new art applies with the same force as prior art considered in the PTO. Regarding that, Justice Sotomayor notes

Judge Rich's observation, "When new evidence… is relied on, the tribunal considering it is not faced with having to disagree with the PTO or with deferring to its judgment or with taking its expertise into account. The evidence may, therefore, carry more weight and go further toward sustaining the attacker's unchanging burden." *Id.* at 2251 (quoting American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1360 (Fed. Cir. 1984)).

Judge Rich sat on the CCPA and Federal Circuit from 1955 until his death forty-four years later, and Westlaw credits him with nearly 700 patent opinions. Moreover, Justice Stevens, concurring in *Bilski,* acknowledges that he was "one of the main drafters of the 1952 Act," Bilski v. Kappos, 130 S.Ct. 3218, 3247 (2010).

Yet it seemed that the Court's crediting Judge Rich's views, much less quoting him, was unusual. The Westlaw search, "Judge /3 Rich," confirmed my impression. The Court has reviewed patent opinions drafted by him, but I found only three instances otherwise taking note of his views: Diamond v. Diehr, 450 U.S. 175, 202 (1981), reviewed his opinion for the CCPA, but Justice Stevens, dissenting, also referenced views expressed in earlier, related cases. The only other mentions were in Blonder-Tongue Labs., Inc. v. Univ. Ill. Fndn., 402 U.S. 313, 337 n. 28. (1971), and Aro Mfg. Co. v. Convertible Top Replacement Co., 377 U.S. 476, 486 n. 6 (1964).

I therefore undertook to compare the number of citations to Judge Learned Hand, also well regarded for his patent opinions. A Westlaw search for "'Learned Hand' /p patent" identified Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 67 (1998); Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 149, 157 (1989), Graham v. John Deere Co.

of Kansas City, 383 U.S. 1, 55 (1966); Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U.S. 364,375 (1942), and two others that warrant brief discussion.

Judge Hand's dissent from an opinion affirmed in Jungersen v. Ostby & Barton Co., 335 U.S. 560 (1949), was endorsed by dissenting Justices Frankfurter, Barton and Jackson. Justice Jackson not only agreed but also famously observed, "[T]he only patent that is valid is one which this Court has not been able to get its hands on." *Id.* at 572. But, in terms of endorsement, Justice Frankfurter's opinion, joined by Justice Burton, stands out. He wrote, "Since this Court's opinion has not, to my mind, met the questions which he raised, and since I cannot improve upon what Judge Learned Hand wrote, I adopt his opinion as mine." *Id*. at 568.

Finally, as would many today, Justice Frankfurter seems to endorse Hand's criticism of "the extraordinary condition of the law which makes it possible for a man without any knowledge of even the rudiments of chemistry to pass upon [facts in issue]." Marconi Wireless T. Co., Am. v. U.S., 320 U.S. 1, 61 n.1 (1943) (dissenting in part and quoting Parke-Davis & Co. v. H. K. Mulford Co., 189 F. 95, 115 n.1 (2d. Cir. 1911)).

A search for "au(Learned Hand" & infring! valid! /s patent" identified 62 district court opinions, and a further search that substituted "L" for "Learned" identified 136, including those written for the Second Circuit, for a total of 198 patent opinions. An equivalent search for "au(Rich) & claim /s patent," however, identified 686 opinions. Thus, ignoring concurring and dissenting opinions apparently not identified by such searches, Judge Rich, for whom patent law was a constant focus, wrote far more patent opinions expressing views also worthy of Supreme Court consideration.

Learned Hand, an exceptionally well-regarded judge who authored nearly 200 patent opinions, certainly deserves continued respect with regard to issues addressed there. Yet that he is cited twice as often as Rich seems unfortunate. I leave others to speculate about causation but hope that Justice Sotomayor in *i4i* signals more forthcoming respect for Judge Rich. If so, that seems potentially more significant than the outcome in that particular case.