THE COLUMBIA
SCIENCE & TECHNOLOGY
LAW REVIEW

VOL. XIX STLR.ORG SPRING 2018

ARTICLE

# COMPLEXITY AND IDIOSYNCRASY AT THE FEDERAL CIRCUIT[†]

Daniel R. Cahoy* and Lynda J. Oswald**

*As a specialized intermediate appellate court with exclusive jurisdiction over all U.S. patent appeals, the Federal Circuit wields extraordinary power over the development of the language of patent law. Scholars theorize that the Federal Circuit's isolation causes it to speak to a narrow audience (the specialized patent bar and sophisticated members of the inventive industries). In particular, the court may intentionally or subconsciously employ "jargon" to obscure difficult legal or policy issues. This Article uses recent case examples to illustrate that Federal Circuit patent doctrine does indeed suffer from two forms of obscurity related to vocabulary: complexity and idiosyncrasy. Patent system policy and goals suggest that obscurity is problematic and should be reduced. The optimal forum for concentrating on change is the Federal Circuit, but reducing obscurity while preserving the advantages of a specialized court is an enduring challenge.*

---



* Professor of Business Law and Dean's Faculty Fellow, Smeal College of Business, Pennsylvania State University. We are grateful for helpful comments and suggestions from participants at the Dark Sides of the Law in Common Law Countries Conference, Pantheon-Assas University, Paris, France (June 2017); the Annual Meeting of the Academy of Legal Studies in Business, Savannah, Georgia (Aug. 2017); and the Society of Legal Scholars Annual Conference, Dublin, Ireland (Sept. 2017). 

** Louis and Myrtle Moskowitz Research Professor of Business and Law, Stephen M. Ross School of Business at the University of Michigan.

## I. INTRODUCTION

The language of patent law matters. Inventors and competitors need to understand the parameters of both general patent doctrine and issued patents themselves in order to continue to innovate without risking infringement and costly legal liability. This imperative is best served by patent vocabulary that is clear, simple, and direct. However, two particular characteristics of patents and U.S. patent doctrine mitigate against such clarity. The first, related to language-based property rights, is shared by patent systems worldwide; the second, related to a specialized appellate court, is unique to the U.S. legal system and is amplified by our common law tradition. Both, however, lead to the creation of specialized vocabulary that increasingly restricts accessibility to U.S. patent doctrine to learned intermediaries.

As intangible rights defined by words rather than fences or landmarks, patents inherently require precise, detailed vocabulary

to adequately delineate and protect the property interests at stake. The United States's reliance on the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") as a highly specialized appellate court with exclusive, nationwide jurisdiction over patent appeals means that we have necessarily delegated considerable latitude and scope to shape and direct legal doctrine in the patent field to a single decision-making body. In no other area of U.S. law is so much law-creating power concentrated in a single intermediate appellate court, and, as a result, in no other area does a single court have so much influence over the vocabulary by which legal doctrine is formed and conveyed. The power and relative isolation of the Federal Circuit has fostered a patent vocabulary that is unnecessarily obscure.

The obscurity fostered by the Federal Circuit takes two forms. Perhaps the most obvious is *complexity*. The court has validated a myriad of opaque rules and unique procedures and policies that prevent inventors, competitors, and other interested parties from accessing and understanding the nature of inventions. A second form of obscurity derives from the unusual and unintuitive language choices embraced by the Federal Circuit. The *idiosyncrasy* of patent vocabulary itself is a barrier in that terms are often defined in a very patent-centric way that inhibits the understanding and participation of "outsiders." As a result of linguistic obscurity, full access to the patent system is effectively limited to a small group of experts.

This Article is the first to consider in depth the barrier erected by the Federal Circuit's linguistic complexity and idiosyncrasy. Part II explains the overall nature of patents, noting that vocabulary plays a particularly important role in the law at two critical junctures: (1) the initial creation of the patent right, and (2) its subsequent interpretation and enforcement by the courts. The Article argues that the Federal Circuit's unusual position as a specialized appellate court means that it has an outsized impact, consciously or subconsciously, on the accessibility of the law at both junctures. Part III demonstrates the effect of specialized vocabulary in patent law using case examples. These recent and important fact patterns illustrate the extent to which complexity and idiosyncrasy limit access. Finally, in Part IV, the Article shows that only a special class of expert intermediaries can effectively translate patent doctrine for the masses, slowing innovation and generating inefficiency. The Article then identifies the relatively painless solutions that are available to begin restoring access to patent law.

## II. THE VOCABULARY OF INVENTION: CREATION AND ENFORCEMENT

Patent practice is replete with colorful and arcane terms—e.g., "swearing behind," "evergreening," "submarine patents," "read on," "teach toward," "teach away," "patent trolls," and even "persons of ordinary skill in the art"—that may be baffling to non-experts and that can signal their outsider status.[1] In addition, and likely even more difficult to overcome, is substantive patent-centric vocabulary—e.g., claiming and litigation vocabulary—that affects property rights and case outcomes. The precision of language demanded in the patent system erects barriers to understanding and participation. These barriers are exacerbated by the unique appellate structure in the United States, which concentrates patent doctrine in a single court. Thus, full access to the patent system often requires the intercession of learned intermediaries, such as expert lawyers, commentators, or scholars, to translate and convey the meaning of issued patents and patent doctrine to inventors, competitors, and the public at large. The impact of this restricted access is the imposition of additional costs and a potential reduction in innovation.

### *A. Vocabulary in Patent Creation*

Under U.S. law, a patent conveys to an inventor of a "process, machine, manufacture, or composition of matter"[2] the right to exclude others from making, using, selling, offering to sell, or importing the invention for a limited period of time.[3] Similar definitions are found in other patent acts around the world.[4]

---

1. Previous commentators have noted the existence of patent-centric language that limits access to outsiders in this critical area. *See, e.g.*, Ted L. Field, *Write Like a Patent Litigator: Avoid Common Mistakes Made by Non-Patent Lawyers*, 17 J. MARSHALL REV. INTELL. PROP. L. 141, 144–46 (2017); Veronica Lawson, *The Terms and Arts of Patentese: Wolves in Sheep's Clothing*, *in* HANDBOOK OF TERMINOLOGY MANAGEMENT VOL. 1: BASIC ASPECTS OF TECHNOLOGY MANAGEMENT 171, 171–83 (Sue Ellen Wright & Gerhard Budin eds., 1997); Jed S. Rakoff, *Down with Patentese*, 21 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 839 (2011); Arnold B. Silverman & George K. Stacey, *Understanding "Patentese" – A Patent Glossary*, JOM, Sept. 1996, at 77, 77; T.E.R. Singer & Julian F. Smith, *Patentese: A Dialect of English?*, 44 J. CHEM. EDUC. 111, 111–12 (1967).

2. 35 U.S.C. § 101 (2018).

3. *Id.* § 271 (2018).

4. International agreement on the nature of patents extends back to the Paris Convention for the Protection of Industrial Property in 1883. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 21 U.S.T.

The difficulty comes in defining the contours and boundaries of a particular patent grant. The task of defining property interests is straightforward in the context of physical property. For example, land can be cordoned off with a fence and delimited with visual landmarks and geographic coordinates; personal property such as a vehicle or machinery can be identified with a unique number or descriptor and physical possession. However, intangible rights such as patents are more difficult to identify and describe. An invention is more of an idea than a physical item (although the idea could be embodied in something physical), and capturing that idea requires more than bricks or barbed wire. Capturing patentable ideas requires words, and the failure of language to provide adequate notice of what is owned harms not only the inventor, but also any member of society who has an interest in understanding where lines of ownership and public domain are drawn.

The words that define an invention are found in a patent's "claims." Claims are the legal description of what is covered by the patent. They are initially drafted by the patent applicant (or, more likely, the expert patent agent or patent attorney hired by the applicant) and presented to the United States Patent and Trademark Office (USPTO) for evaluation. When patentees seek to enforce their rights in court (e.g., against alleged infringers or in the face of a competitor's validity challenges), the claims determine the scope of the patentee's rights.[5]

A single patent may contain one or several claims, each of which sets forth the components or limitations that define the essential elements of the invention. Claims drawn too narrowly will grant insufficient patent rights to the inventor and allow excessive freedom to competitors; claims drawn too broadly will either not survive a competitor's validity challenge and result in the inventor losing the patent rights or will grant an overly broad monopoly that harms the public good by hamstringing innovation. Claims that are obscure or difficult to understand generate uncertainty that can increase search costs, stifle inventive activity, and result in expensive litigation.

---

1583 (amended Sept. 28, 1979). The current agreement on Trade-Related Aspects of Intellectual Property (TRIPS), which binds all members of the World Trade Organization, has mandated a standardized form of patent protection since 1994. *See* Marrakesh Agreement Establishing the World Trade Organization, Annex 1C Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299 [hereinafter TRIPS Agreement].

5. *See* Peter S. Menell et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 714 (2010).

### B. Vocabulary in Patent Enforcement and Litigation

Although obscurity in patent vocabulary is generally bad, it is difficult to eliminate. In fact, some obscurity is to be expected in an area of law defined by advances in technology as the increasingly complex and technical nature of patent subject matter poses real barriers for those not schooled in the particular fields of science and technology at issue.[6] Not much can be done to bridge this particular gap in understanding. However, obscurity added as a consequence of institutional design rather than technical complexity is unnecessary. From this perspective, the Federal Circuit is an attractive target for reform.

Congress established the Federal Circuit in 1982 as a specialized appellate court, spurred by unusually broad support from a wide variety of constituencies, including the inventive industries.[7] Congress's stated goals for this unusual experiment in court reform[8] were to "increase doctrinal stability in the field of patent law"[9] and to "fill a void in the judicial system by creating an appellate forum capable of exercising nationwide jurisdiction over appeals in areas of the law where . . . there is a special need for nationwide uniformity."[10] To ensure that the court did not become overly specialized and to avoid the problem of any special interest

---

6. *See, e.g.*, Peter Lee, *Patent Law and the Two Cultures*, 120 YALE L.J. 2, 10 (2010) (describing how difficult it is for generalist judges to understand the technology involved in many patent cases).

7. FRANK P. CIHLAR, THE COURT AMERICAN BUSINESS WANTED AND GOT: THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, at iii, iii n.4 (1982).

8. The legislative history of the Act creating the Federal Circuit referenced just two earlier specialty courts: the Temporary Emergency Court of Appeals, created by the Economic Stabilization Act Amendments of 1971, Pub. L. No. 92-210, 85 Stat. 743 (1971), and the U.S. Foreign Intelligence Surveillance Court, created by the Foreign Intelligence Surveillance Act of 1978, Pub. L. No. 95-511, § 103(a), 92 Stat. 1783 (1978). *See* S. REP. NO. 97-275, at 4 n.4 (1981).

In addition, federal courts are divided into two basic categories: (1) those formed under Article III of the Constitution (whose judges enjoy life tenure and salary protection, benefits intended to ensure independence and impartiality) and (2) those formed under Article I (the so-called "legislative courts," whose judges do not have life tenure or salary protection). Most specialized courts, such as the bankruptcy courts, the U.S. Tax Court, the Court of Appeals for Veterans Claims, and the U.S. Court of Federal Claims are Article I courts, reflecting their more limited role in the federal judicial system. The Federal Circuit, by contrast, is an Article III court, just like the regional circuit courts. *See* LAWRENCE BAUM, SPECIALIZING THE COURTS 14–16 tbl.1.2 (2011).

9. S. REP. NO. 97-275, at 5.

10. *Id.* at 2. *See also* H.R. REP. NO. 97-312, at 16–27 (1981) (discussing the purpose, background, and need for the legislation).

group dominating the court,[11] Congress deliberately expanded the court's subject matter jurisdiction to include, in addition to patents, certain trademark issues, international trade, veterans' benefits, federal personnel matters, government contracts, certain money claims against the federal government, and public safety officers' benefits claims.[12]

Over time, however, patents have taken over the lion's share of the Federal Circuit's caseload. While patent cases formed less than one-third of the court's caseload a decade ago,[13] they comprised almost two-thirds of the court's caseload in fiscal year 2017.[14] Patent law dominates the Federal Circuit's caseload and jurisprudence, and it is not surprising that we often, albeit imprecisely, think of the Federal Circuit as a "patent court."

Two aspects of institutional design confer on the Federal Circuit an oversized influence on patent vocabulary and, hence, doctrine. First is the court's role as the de facto final decision maker on most contested issues of patent creation and enforcement. The initial determination of whether to grant a patent is made by the USPTO. Appeals of that agency's decisions are taken to the Patent Trial and Appeals Board (PTAB).[15] In turn, decisions of the PTAB are appealable to the Federal Circuit.[16] Patent infringement cases, by contrast, begin in the United States District Courts; appeals of those decisions also go to the Federal Circuit.[17] Although further appeal to the United States Supreme Court is possible in both instances, in practical terms, the Federal

11. S. REP. NO. 97-275, at 6.

12. *Court Jurisdiction*, FED. CIR., http://www.cafc.uscourts.gov/the-court/court-jurisdiction (last visited Mar. 7, 2018).

13. *Appeals Filed, by Category, FY 2007*, FED. CIR., http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/ChartFilings07.pdf (last visited Mar. 7, 2018) (indicating that patent cases were 28% of Federal Circuit filings in fiscal year 2007).

14. *Appeals Filed by Category, FY 2017*, FED. CIR., http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/FY_17_Filings_by_Category.pdf (last visited Mar. 7, 2018) (indicating that patent cases were 63% of Federal Circuit filings in fiscal year 2017). By contrast, the second largest category of cases, federal personnel cases, comprised only 13% of the total caseload in fiscal year 2017. *Id.*

15. 35 U.S.C. § 134 (2018).

16. Decisions of the PTAB can be taken a District Court, *see* 35 U.S.C. § 145 (2018), and then appealed to the Federal Circuit, or appealed directly to the Federal Circuit (bypassing the District Court). *Id.* at § 141.

17. 28 U.S.C. § 1295 (2018).

Circuit is the final stop for the vast majority of patent appeals.[18] As a result, the Federal Circuit's influence on the development of patent vocabulary and doctrine is far-reaching and undeniable.

Second, the Federal Circuit, like all other common law courts in the United States, has the power to create broad doctrine. Although the hierarchy of legal authorities permits Congress to have the last word in any non-constitutional matter through its ability to enact statutes,[19] it often declines to use its statute-creating authority to its full extent, either failing to enact statutory provisions or enacting provisions that are vague or incomplete. As a result, courts play a significant role in creating law and doctrine through their case law, both in terms of statutory interpretation and in terms of filling in statutory interstices.[20] The Patent Act, in particular, fails to address many fundamental principles of patent doctrine, leaving to the courts the formidable task of interpreting the statutory language and its application in scenarios perhaps not contemplated by the legislature when drafting the legislation.[21]

---

18. The Supreme Court agrees to hear only about eighty of the 7,000–8,000 cases presented to it each year, so the likelihood of any given case coming before the Court is extremely small. *See Frequently Asked Questions - General Information*, SUP. CT., www.supremecourt.gov/about/faq_general.aspx (last visited Apr. 23, 2018). Over the past decade, the Supreme Court has heard, on average, four Federal Circuit cases a year. Timothy B. Dyk, *Thoughts on the Relationship Between the Supreme Court and the Federal Circuit*, 16 CHI.-KENT J. INTELL. PROP. 67, 67 (2016). However, not all of these involved cases arising from the Federal Circuit's patent caseload. *See, e.g.*, Matal v. Tam, 137 S. Ct. 1744 (2017) (holding that the Lanham Act's disparagement clause, prohibiting the registration of disparaging trademarks, is invalid under the First Amendment). In practical terms, then, the Federal Circuit has the final say in the vast majority of patent cases, whether those cases emanate from the PTAB or the district courts.

19. WILLIAM BURNHAM, INTRODUCTION TO THE LAW AND LEGAL SYSTEM OF THE UNITED STATES 41 (4th ed. 2006).

20. *See, e.g.*, City of Milwaukee v. Illinois, 451 U.S. 304, 313–14 (1981) (noting that where "Congress has not spoken to a particular issue," the courts must create federal common law as "a 'necessary expedient'") (citations omitted); United States v. Kimbell Foods, Inc., 440 U.S. 717, 727 (1979) (noting that where Congress has not spoken, the "federal courts [must] fill the interstices of federal legislation") (citations omitted). *See generally* BURNHAM, *supra* note 19, at 52 ("Because common law developed first and statutes dealt with relatively narrow subjects, the common-law mind views statutes as being enacted against the comprehensive backdrop of the common law. As a result, there is no need to fill any statutory gaps by extending the reach of the statute. Any gaps have already been filled by the common law.").

21. *See* DAN L. BURK & MARK A. LEMLEY, THE PATENT CRISIS AND HOW THE COURTS CAN SOLVE IT 103 (2009) (citing GRANT GILMORE, THE AGES OF AMERICAN LAW 96 (1977)).

Professor Nard noted that "a significant portion of U.S. patent law, including some of the most important and controversial patent law doctrines, is either built upon judicial interpretation of elliptical statutory phrases, or is devoid of any statutory basis whatsoever."[22] Judges, he concluded, not Congress, are the "principal architects" of patent law,[23] to such an extent that the Patent Act could be deemed "a common law enabling statute."[24]

Despite the potential for obscurity that flows from the nature of patents and the unique structure of the Federal Circuit, this specialized court poses significant advantages as well. The literature identifies three major theoretical advantages to specialized courts. First, the expertise that judges on specialized courts are able to develop may lead to more efficient resolutions of cases as these judges become highly proficient in the narrow range of cases they hear. This proficiency may reduce the effort that litigants must put into educating the court on the legal issues before them,[25] better protect parties with less skilled or experienced counsel, and reduce the workload of the generalist courts, thus increasing *efficiency* not only in the specialized court's subject matter field, but also across the federal judicial system.[26] Second, specialized courts may foster increased *accuracy* in the formulation and implementation of legal rules because of the judges' increased exposure to and expertise in their particular field or fields of law.[27] Third, specialized courts may enhance *uniformity*.[28] In addition to

---

22. Craig Allen Nard, *Legal Forms and the Common Law of Patents*, 90 B.U. L. REV. 51, 54 (2010) (footnotes omitted).

23. *Id.*

24. *Id.* at 53 (citing Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 801 (2008)).

25. *See, e.g.*, Rochelle Cooper Dreyfuss, *Specialized Adjudication*, 1990 BYU L. REV. 377, 377–79; Paul R. Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 GEO. L.J. 1437, 1447 (2012); Ellen R. Jordan, *Specialized Courts: A Choice?*, 76 NW. U. L. REV. 745, 747–48 (1981); Jeffrey W. Stempel, *Two Cheers for Specialization*, 61 BROOK. L. REV. 67, 87–88 (1995).

26. *See* Dreyfuss, *supra* note 25, at 377–79; Gugliuzza, *supra* note 25, at 1447; Jordan, *supra* note 25, at 747–48; Lynda J. Oswald, *Improving Federal Circuit Doctrine Through Increased Cross-Pollination*, 54 AM. BUS. L.J. 247, 251–52 (2017).

27. *See* Oswald, *supra* note 26, at 252 (discussing BAUM, *supra* note 8, at 33; Gugliuzza, *supra* note 25, at 1447; Dreyfuss, *supra* note 24, at 796).

28. "Uniformity" and "accuracy" refer to different legal objectives. Uniform results, even if inaccurate, can promote predictability and stability in the law. The outcome reached may be incorrect, but if the outcome is predictable and consistent, actors will be able to plan their activities accordingly. Dreyfuss, *supra* note 24, at 796.

reducing the incentive for forum-shopping,[29] uniform outcomes also foster predictability, thus enabling businesses and other actors to plan their activities so as to potentially avoid disputes and litigation in the future.[30]

In theory, another advantage that should exist for a specialized court is *clarity.* Clarity is most important when it involves the very vocabulary of the law. In no context is this more apparent than patent law, which depends on language to define essential property rights and identify areas open for innovation for inventors (those of ordinary skill in the art) and the public.[31] An efficient patent system requires a shared understanding of law to ensure predictable future outcomes. When that understanding is short-circuited by communication barriers—e.g., the inability of those most impacted by the law to understand what it is—costs necessarily increase. Moreover, courts depend on communication and broad understanding to contribute to efficiency and act as delineators of property rights with a veneer of legitimacy.

The concentration of so much doctrinal interpretation and generation of new vocabulary in a single specialized court, the Federal Circuit, may enhance the doctrinal nuances of the complicated area of patent law. On the other hand, if that one court uses its concentrated power, even inadvertently, to sow confusion through overly complex or idiosyncratic language that ignores the practical impact of terminology on stakeholders, the specialized court may foster obscurity and create barriers to accessibility.

### *C. The Emergence of Complexity and Idiosyncrasy in Patent Vocabulary*

Given the institutional design of patent law in the United States, how might obscurity take hold? Specialized courts with specialized bars—of which the Federal Circuit and the patent bar are the

29. Dreyfuss, *supra* note 25, at 378.

30. Gugliuzza, *supra* note 25, at 1448 (citing Richard L. Revesz, *Specialized Courts and the Administrative Lawmaking System*, 138 U. PA. L. REV. 1111, 1116–17 (1990)). *See also* PAUL D. CARRINGTON ET AL., JUSTICE ON APPEAL 171–72 (1976); John F. Duffy, *Harmony and Diversity in Global Patent Law*, 17 BERKELEY TECH. L.J. 685, 686 (2002); Michael E. Solimine, *Rethinking Exclusive Federal Jurisdiction*, 52 U. PITT. L. REV. 383, 406 (1991).

31. This idea is supported by the Patent Act, for example, in 35 U.S.C. § 112(a) (2018), as well as pronouncements from the U.S. Supreme Court. *See, e.g.*, Nautilus Inc., v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2129 (2014) ("[A] patent must be precise enough to afford clear notice of what is claimed . . . .").

paradigmatic example[32]—have the potential to develop an insular viewpoint that causes them to lose sight of the impact that their rulings may have on non-litigants. However, these parties, which include "consumers, suppliers, competitors, employees, investors, and the environment,"[33] are nonetheless impacted by a litigation's outcomes. Without peer courts issuing opinions in the same area, the specialized court may not feel pressure to generate detailed or persuasive opinions and may fall back on arcane or dense vocabulary, complex and overly refined rule systems, or excessive "formalism."[34] A specialized court might use jargon to either

---

32. Judge Rifkind emphasized the dangers of linking a specialized patent bar with a specialized patent court:

> Once you complete the circle of specialization by having a specialized court as well as a specialized Bar, then you have set aside a body of wisdom that is the exclusive possession of a very small group of men who take their purposes for granted. Very soon their internal language becomes so highly stylized as to be unintelligible to the uninitiated. That in turn intensifies the seclusiveness of that branch of the law and that further immunizes it against the refreshment of new ideas, suggestions, adjustments and compromises which constitute the very tissue of any living system of law. In time, like a primitive priestcraft, content with its vested privileges, it ceases to proselytize, to win converts to its cause, to persuade laymen of the social values that it defends. Such a development is invariably a cause of decadence and decay.

Simon Rifkind, *A Special Court for Patent Litigation? The Danger of a Specialized Judiciary*, 37 A.B.A.J. 425, 425–26 (1951).

33. Rochelle C. Dreyfuss, *Forums of the Future: The Role of Specialized Courts in Resolving Business Disputes*, 61 BROOK. L. REV. 1, 4 (1995). *See also* Gugliuzza, *supra* note 25, at 1449; Paul R. Gugliuzza, *The New Federal Circuit Mandamus*, 45 IND. L. REV. 343, 402 (2012); Paul M. Secunda, *Cognitive Illiberalism and Institutional Debiasing Strategies*, 49 SAN DIEGO L. REV. 373, 408 (2012). Other objections are also put forth by commentators, although with less frequency. *See, e.g.*, Gugliuzza, *supra* note 25, at 1449 (citing Jordan, *supra* note 25, at 748; Daniel J. Meador, *An Appellate Court Dilemma and a Solution Through Subject Matter Organization*, 16 U. MICH. J.L. REFORM 471, 483–84 (1983) (discussing the "debatable" concern that the most capable individuals may not be attracted to specialized judgeships)); Richard A. Posner, *Will the Federal Courts Survive Until 1984?: An Essay on Delegation and Specialization of the Judicial Function*, 56 S. CAL. L. REV. 761, 787 (1989) (asserting that there can be "boundary problems" arising from cases that span the jurisdictions of the specialist and generalist courts); Stempel, *supra* note 25, at 91–111 (listing, and largely refuting, arguments such as public acceptance and perceptions of fairness, geographic diversity, and flexibility in shaping future judiciaries).

34. *See* COMM'N ON REVISION OF THE FED. COURT APPELLATE SYS., STRUCTURE AND INTERNAL PROCEDURES: RECOMMENDATIONS FOR CHANGE 28–30 (1975); Gugliuzza, *supra* note 25, at 1440–41 (citing CARRINGTON ET AL., *supra* note 30, at 168; David Charny, *The New Formalism in Contract*, 66 U.

intentionally or subconsciously obscure the difficult legal or policy issues underlying its ruling.[35] By contrast, Judge Wood of the United States Court of Appeals for the Seventh Circuit argued that generalist courts avoid this potential pitfall: "Generalist judges cannot become technocrats; they cannot hide behind specialized vocabulary and 'insider' concerns. The need to explain even the most complex area to the generalist judge (and often to a jury as well) forces the bar to demystify legal doctrine and to make the law comprehensible."[36]

The Federal Circuit's institutional isolation has fostered two forms of obscurity related to vocabulary that have rendered patent law inaccessible to its intended users and beneficiaries. The first is *complexity*. The court has validated a myriad of murky rules and unique procedures and policies that may prevent a person having ordinary skill in the art—the touchstone for most patent doctrines[37]—from being able to access the nature of the invention at issue. The handicap is even greater for the general public, including business leaders, who theoretically must be able to rely on patents for strategic decision making, yet practically cannot decipher the highly technical jargon of patent claims without expert intermediaries.

The second is *idiosyncrasy.* The patent vocabulary embraced by the Federal Circuit is often unusual and unintuitive. That vocabulary itself is a barrier in that terms are often defined in a very patent-centric way that excludes outsiders. Traditional

---

CHI. L. REV. 842, 848 (1999)). Cognitive psychology literature refers to the "curse of expertise," i.e., the danger that experts may underestimate the difficulty encountered by non-experts. *See* Jeremy W. Bock, *Restructuring the Federal Circuit*, 3 N.Y.U. J. INTELL. PROP. & ENT. L. 197, 214–19 (2014) (summarizing literature).

35. *See* Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 3 (1989); Gugliuzza, *supra* note 25, at 1449; Rifkind, *supra* note 32, at 426. Justice Oliver Wendell Holmes, Jr., writing in 1923 about his experiences on the U.S. Supreme Court, noted that while "[e]very group . . . gets a more or less special terminology which it takes time for an outsider to live into," once a judge has gotten "hold of the language there was no such thing as a difficult case," just questions of law. Posner, *supra* note 33, at 787 (quoting *Letter to John C.H. Wu (May 14, 1923)*, *in* O.W. HOLMES, JUSTICE OLIVER WENDELL HOLMES: HIS BOOK NOTICES AND UNCOLLECTED LETTERS AND PAPERS 163–64 (H. Shriver ed. 1936)).

36. Diane P. Wood, *Generalist Judges in a Specialized World*, 50 SMU L. REV. 1755, 1767 (1997).

37. *See, e.g.*, KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 420 (2007) ("The question is not whether the combination was obvious to the patentee, but whether the combination was obvious to a person with ordinary skill in the art.").

meanings are ignored, and words that would otherwise import doctrine established in other areas are cabined to patent law.

Today, only a special class of expert intermediaries can effectively translate patent law for the masses. The examples that follow in Part III suggest not only that idiosyncrasy and complexity are eroding the legitimacy of patent rights, but also that change is necessary to provide inventors and the public with better access to patent law.

## III. EXAMPLES OF OBSCURE VOCABULARY IN PATENT LAW

The case law of the Federal Circuit exhibits a pattern of complexity and idiosyncrasy. The complexity cases relate to the steps for determining the boundaries and clarity of patent claims, a process called "construction." The process of revealing the correct vocabulary for claim construction has become so inscrutable and complex that those of ordinary skill effectively lack access. The idiosyncrasy cases highlight the Federal Circuit's surprisingly convoluted definitions for seemingly common words such as "exceptional," "comprising," and "consisting." Such redefinitions place patent law outside the grasp of the non-expert inventor or competitor. The examples below highlight the insider/outsider dichotomy that has come to characterize the patent law system.

### *A. Complexity in Claims Construction*

Patent claims are intended to serve a notice function that is fundamental to the societal bargain inherent in the grant of intellectual property rights.[38] In exchange for disclosing to the world a new invention, the patent owner is granted limited rights of exclusion. However, it has become increasingly difficult for non-specialists to understand the nature and legal extent of patented inventions.[39] Patent claim boundaries are drawn by specific words and phrases with technical legal impact that are difficult, if not impossible, to fully decode without substantial legal training. Even

38. Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2129 (2014) (stating that a patent must "afford clear notice of what is claimed" in order to permit the public to determine what remains open for use); Jason Rantanen, *Patent Law's Disclosure Requirement*, 45 LOY. U. CHI. L.J. 369, 371–73 (2013) (describing the history of the disclosure requirement).

39. *See* Sean B. Seymore, *The Teaching Function of Patents*, 85 NOTRE DAME L. REV. 621, 633–34 (2010) (referring to "patentese" as a language form used to craft vague or overly broad claims to the detriment of the public's understanding).

the concept of patentable subject matter itself is often beyond the reach of the very scientists and engineers who actually invent.[40]

The barrier to claim accessibility is largely a function of complexity in the process of interpreting the meaning of the claim language. This process is controlled by the courts through the decisions of the Federal Circuit. Unfortunately, the Federal Circuit has sometimes applied terms and words in unintuitive ways, triggering a narrow understanding of an otherwise general concept and imposing a somewhat arbitrary scope on claim language. Ultimately, the patent applicant has the legal responsibility of (and vested interest in) ensuring that claims are sufficiently definite in their boundaries to avoid such later reinterpretation. But even here, the Federal Circuit has introduced variability and unpredictability into the processes of even deciding whether the claim language is properly definite. Faced with such intractable obscurity, even those skilled in the art would be understandably reluctant to rely on patent documents in developing business strategy.

### 1. The Federal Circuit's Embrace of Claim Ambiguity

Patent claims have an inherent tendency to be complex. As the mechanism for describing an invention that, by definition, is new to the world, they require a level of detail and peculiar language choices that can be difficult for non-experts to understand. But even considering the highly-refined language related to invention technology (e.g., technical terms, terms of art, or scientific concepts such as DNA or protein sequences), claims still have layers of complexity that preclude a straightforward reading.

Some of this claim complexity is related to the shorthand phrases or codes that claim drafters necessarily use to ensure predictable interpretations. For example, claims expressed with a

---

40. The U.S. Supreme Court has issued several recent decisions on patentable subject matter under 35 U.S.C. § 101 that have cast uncertainty into the law. *See* Alice Corp. Pty. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014); Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 2107 (2013); Mayo Collaborative Servs. v. Prometheus Labs, Inc. 132 S. Ct. 1289 (2012). However, because the decisions are negative assertions of what is *not* patentable, there is considerable ambiguity about what *is* patentable in certain areas such as biotechnology. *See, e.g.*, Hallie Wimberly, Comment, *The Changing Landscape of Patent Subject Matter Eligibility and Its Impact on Biotechnological Innovation*, 54 HOUS. L. REV. 995, 1009 (2017) ("This lack of clarity harms those seeking patent protection for inventions that involve a natural law, physical phenomenon, or abstract idea.").

functional "means or step" term are limited by statute to the embodiment described in the supporting patent specification.[41] Thus, if a claim describes a "floatation means," but only a life jacket is mentioned in the specification, the claim is limited to a life jacket. The courts decide whether a word is functional (as opposed to defining an actual object).[42]

However, in modern claiming practice, the use of technical terms, formulaic phrases, and established sentence structure does not solve every interpretational problem. A court is still called upon to determine what the patentee's words mean in a process known as "claim construction." This exercise is a necessary component of infringement and validity analysis because it is the ultimate resolution of what a claim covers. The process itself has a deep layer of complexity.[43] Importantly, claim construction is reserved to the courts; established case law states that construing the meaning of a claim is a question of law, which cannot be undertaken by a jury,[44] not unlike contract interpretation. Unfortunately, this means that a lower court's or administrative agency's interpretation is always subject to overruling by the next level of appeal. The consequence is that one never fully knows the

---

41. 35 U.S.C. § 112(f) (2018). In contrast, the European Patent Office presumes that a claim covers the breadth of possible embodiments that perform the function. European Patent Office [EPO], *Guidelines for Examination*, at pt. F, ch. IV, § 6.5 (2016), https://www.epo.org/law-practice/legal-texts/html/guidelines/e/f_iv_6_5.htm.

42. Drawing this line has been an iterative process. The Federal Circuit initially stated that use of the word "means" created a presumption that claims should be limited to the embodiment described in the specification. Watts v. XL Sys., Inc., 232 F.3d 877 (Fed. Cir. 2000). And later the court stated that it is a nearly irrefutable presumption that the use of "means" compels the finding that the function articulated in the claims is limited to what is in the specification. Flo Healthcare Sols., LLC v. Kappos, 697 F.3d 1367 (Fed. Cir. 2012). More recently, the Federal Circuit reversed this trend and articulated a less rigid standard, stating that the standard is now whether the claim language would be understood by one skilled in the art to name a specific structure. Williamson v. Citrix Online, LLC, 792 F.3d 1339 (Fed. Cir. 2015). Some scholars have argued that the courts should go further and find "means" limitations in the many iterations of broad software claim language. *See* Mark A. Lemley, *Software Patents and the Return of Functional Claiming*, 2013 WIS. L. REV. 905, 962–63 (2013). All this flexibility in defining "means" exists for claims written long before the courts' decisions. The probability that a competitor or consumer could read a patent and predict these outcomes is nearly zero.

43. Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. PA. L. REV. 1743, 1753–56 (2009) (describing the legal rules that complicate claim construction as a problem apart from technological complexity).

44. Markman v. Westview Instruments, Inc., 517 U.S. 370, 388 (1996).

meaning of a claim until the highest court rules—and, as noted earlier, the de facto highest court in most patent cases is the Federal Circuit.[45]

A safeguard against post-patenting reinterpretation of claims is that a patentee must include sufficient definiteness in the claim language, utilizing "such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the [invention]."[46] As with a contract, ambiguity breeds unpredictability that may be used to one party's advantage in the future. Therefore, it is critical that a patentee be forced to articulate boundaries with clarity. The failure to do so results in an invalid patent.[47] Unfortunately, it is here that the Federal Circuit allowed a kind of ambiguity creep that threatened the very notice function of claiming practice.

The problem is illustrated by the recent case of *Biosig Instruments, Inc. v. Nautilus, Inc.*[48] Biosig had a patent directed to an invention of a heart rate monitor that was better than existing monitors at detecting the rate during exercise.[49] According to Biosig, Nautilus sold exercise machines with an infringing heart monitor. After a period of several years, during which Biosig's patent was subject to reexamination in the USPTO and there was much negotiation between the two companies, the dispute landed in a federal district court. The district court issued summary judgment that Biosig's asserted claims were invalid due to indefiniteness.[50] The court held that the claims' description of electrodes in a "spaced relationship" with each other was insufficient to instruct one of ordinary skill in the art as to what amount the space should be and thus failed to meet the required level of notice.

On appeal, the Federal Circuit reversed, finding that the parameters of the electrodes' spaced relationship could be inferred from patent's illustrations and were inherent in the nature of the

45. *See supra* notes 7–18 and accompanying text.

46. 35 U.S.C. § 112(a) (2018).

47. *See* Enzo Biochem, Inc. v. Applera Corp., 599 F.3d 1325, 1331 (Fed. Cir. 2010).

48. Biosig Instruments, Inc. v. Nautilus, Inc., 715 F.3d 891 (Fed. Cir. 2013).

49. U.S. Patent No. 5,337,753 (issued Aug. 16, 1994). To envision the invention, think about the heart rate monitor on a treadmill or exercise bike. The monitor's improvement was its ability to eliminate signal noise from skeletal muscles. *Biosig Instruments*, 715 F.3d at 894.

50. Summary Judgment Hearing Transcript, Biosig Instruments, Inc. v. Nautilus, Inc., No. 10-CV-7722 (S.D.N.Y. Mar. 5, 2012).

invention.[51] More importantly, the court emphasized its indefiniteness standard in which a claim cannot be rejected as indefinite unless it is "insolubly ambiguous."[52] This standard meant that, so long as a claim is "amenable to construction," a court could find that it was sufficiently clear to satisfy the patent bargain of disclosure in exchange for exclusivity.[53] To make such a determination, a district court engages in an after-the-fact review of the patent document and general knowledge of those of ordinary skill to determine whether an understanding is theoretically possible.[54] Again, this *ex post* consideration is entirely in the hands of the court as a question of law and can be appealed and revised with no additional testimony or evidence permitted from the parties.

The Federal Circuit's "insolubly ambiguous" standard injects uncertainty through complexity into the claims interpretation process. One cannot read a claim and definitively determine if it is *insolubly* ambiguous until the Federal Circuit attempts to solve the problem. Such uncertainty inherently leads to gamesmanship.[55] A rational patentee will attempt to maintain the maximum level of indefiniteness, which yields flexibility in covering later inventions but ultimately precludes access by making it difficult for others to comprehend accurately the scope of the invention.

The issue of the proper indefiniteness test was appealed to the Supreme Court in *Nautilus, Inc. v. Biosig Instruments, Inc.*[56] The Court weighed the competing interests and established the proper audience for the patent disclosure:

> On the one hand, the definiteness requirement must take into account the inherent limitations of language. Some modicum of uncertainty, the Court has recognized, is the "price of ensuring the appropriate incentives for innovation." One must bear in mind, moreover, that

51. *Biosig Instruments*, 715 F.3d at 899.

52. *Id.* at 898 (quoting Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed. Cir. 2005)).

53. *Id.*

54. *Id.*

55. FED. TRADE COMM'N, THE EVOLVING IP MARKETPLACE: ALIGNING PATENT NOTICE AND REMEDIES WITH COMPETITION 85 (2011) ("According to one panelist, applicants try to be 'as vague as possible, avoid any expression of meaning with the hope that when they get to litigation, they can broaden the meaning beyond what the Patent Office assumed it was.'" (footnote omitted)).

56. Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2129 (2014).

> patents are "not addressed to lawyers, or even to the public generally," but rather to those skilled in the relevant art.
>
> At the same time, a patent must be precise enough to afford clear notice of what is claimed, thereby "appris[ing] the public of what is still open to them."[57]

In view of these concerns, the Court found that the Federal Circuit's standard was impermissibly "amorphous."[58] Although as applied, the Federal Circuit seemed to home in on the proper indefiniteness result, the Supreme Court believed that "insolubly ambiguous" was not designed to help lower courts resolve the essential inquiry. Instead, the Supreme Court decreed that "a patent must be precise enough to afford clear notice of what is claimed."[59] The Court stated that the correct standard of definiteness requires that "a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty."[60]

The Court specifically called out the difficulty posed by the vocabulary adopted by the Federal Circuit. Biosig itself had acknowledged, and the Court appeared to agree, that "'terms like 'insolubly ambiguous' may not be felicitous.'"[61] While the Court declined to "'micromanag[e] the Federal Circuit's particular word choice' in applying patent-law doctrine,"[62] the Court also noted that the Federal Circuit's adoption of terms such as "insolubly ambiguous" and "amenable to construction" renders doctrine sufficiently unclear as to "leave courts and the patent bar at sea without a reliable compass."[63]

2. The Perseverance of Complex Construction Methodology

Another claim interpretation issue that frequently arises in patent cases is how to identify the correct definition for a term that has more than one meaning. For example, the word "substantially" in a patent claim could mean "essentially,"[64] "largely, but not

57. *Id.* at 2128–29 (alteration in original; citations omitted).
58. *Id.* at 2131.
59. *Id.* at 2129.
60. *Id.*
61. *Id.* at 2130 (quoting Brief for Respondent at 34).
62. *Id.* (citations omitted).
63. *Id.* (citations omitted).
64. Apple Inc. v. Samsung Elecs. Co., Ltd., 786 F.3d 983, 1003 (Fed. Cir. 2015).

wholly,"[65] or "not strictly."[66] Commentators have speculated that clever patent drafters may choose such ambiguous terms on purpose in order create definitional wiggle room that can be resolved after the most valuable meaning becomes clear.[67] Of course, such a maneuver is not optimal; the system ideally requires a level of certainty that allows competitors and the public to understand what technology is captured by the patent right. For this reason, the idealized scheme starts with a plain reading and expands definitional resources as necessary.

Initially, one simply reads the claims as written. It is well-accepted that patent claims should be construed according to their "ordinary and customary meaning."[68] However, patentees are permitted to substitute their own definitions (i.e., be their own lexicographer).[69] To assess the patentee's intent in this regard, a court must consider available "intrinsic evidence," such as the explanatory information in the patent as well as all of the documents exchanged with the USPTO during prosecution (the file wrapper).[70]

To further aid in the understanding of claim language, a court may turn to "extrinsic evidence" such as outside experts, industry manuals, or even dictionaries.[71] But when is all of this additional evidence appropriate? How can one know for certain when to cut off the inquiry? Surprisingly, that is an unclear proposition *ex ante* to litigation.

In 2005, the Federal Circuit decided *Phillips v. AWH Corp.*[72] in an attempt to settle whether extrinsic evidence can ever be consulted before or contemporaneously with intrinsic evidence.

---

65. LNP Eng'g Plastics, Inc. v. Miller Waste Mills, Inc., 275 F.3d 1347, 1355 (Fed. Cir. 2001).

66. Crocs, Inc. v. Effervescent, Inc., No. 16-CV-02004, 2017 WL 2787589, at *9 (D. Colo. June 27, 2017).

67. *See, e.g.*, Stephen J. Stark, Note, *Key Words and Tricky Phrases: An Analysis of Patent Drafters' Attempts to Circumvent the Language of 35 U.S.C. § 112*, 5 J. INTELL. PROP. L. 365, 375 (1997).

68. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).

69. Thorner v. Sony Comp. Ent. Am. LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

70. *Vitronics*, 90 F.3d at 1582.

71. Markman v. Westview Instruments, Inc., 52 F.3d 967, 980 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). This process is similar in some ways to interpretation of a contract, but only if contracts typically had thousands of pages of communications and papers that were automatically presumed to be accessible to the public.

72. Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Although the court stated that extrinsic evidence is generally "less reliable than the patent and its prosecution history in determining how to read claim terms," a court could "in its sound discretion . . . admit and use such evidence."[73] Ultimately, one will not fully appreciate the sources necessary to understand the meaning of claims until a court makes a determination. And, according to the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, patent interpretation is a question of law that can be reviewed *de novo* by an appellate court.[74] Such *de novo* review is often undertaken by the Federal Circuit, further delaying access to the "correct" vocabulary.

The Federal Circuit's ability to reweigh the evidence underlying an interpretation was undercut somewhat by the recent Supreme Court decision in *Teva Pharmaceuticals v. Sandoz*.[75] In that case, the Court held that the Federal Circuit must apply the "clear error" standard in reviewing fact-finding related to claim construction.[76] For example, if a district court determined that one expert supplying extrinsic evidence of claim meaning was more credible than another, the appellate court must give the trial court deference.[77] However, the determination of whether a fact dispute exists in the first place remains a legal issue that the Federal Circuit can determine on its own.[78]

The arduous process of understanding the meaning of claim vocabulary can exclude inventors and other skilled artisans from full participation in the patent system. It could be argued that complexity makes patent law more formulaic and thus more predictable for a certain expert class,[79] but that is neither the intended nor the optimal goal of the patent system.

### *B. Idiosyncrasy in Highly-Refined, Patent-Centric Definitions*

The use of specialized vocabulary or jargon can have the effect of making rules and procedures incomprehensible to an outsider.

---

73. *Id.* at 1318–19.

74. Markman v. Westview Instruments, Inc., 517 U.S. 370, 385 (1996).

75. Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831 (2015).

76. *Id.* at 840.

77. *See id.* at 841.

78. *See* Cardsoft, LLC v. Verifone, Inc., 807 F.3d 1346, 1350 (Fed. Cir. 2015) ("[W]e may nevertheless review the district court's constructions de novo if the intrinsic record fully determines the proper scope of the disputed claim terms.").

79. *See* Mark D. Janis & Timothy R. Holbrook, *Patent Law's Audience*, 97 MINN. L. REV. 72, 80–81 (2012).

As with complexity, some degree of idiosyncrasy naturally accompanies highly technical areas of law. However, it is likely that pitfalls are exacerbated in the specialized court setting simply because of the lack of the "laboratory of federalism," which former Chief Judge of the Federal Circuit Rader noted as being one of the major downsides of a specialized court.[80] If multiple intermediate appellate courts examine an issue and vet the language used, it is likely that the vocabulary will eventually coalesce around well-drafted, carefully considered, and commonly understood terms—or that when the Supreme Court steps in to resolve any lingering confusion or conflict in terms, it will do so against a backdrop of vocabulary thoroughly debated and considered by several intermediate appellate courts. When the terminology is developed within a single court, however, that opportunity for reflection, revision, and refinement is diminished, and the court risks excluding "outsiders."

### 1. The Federal Circuit's Unintuitive Definition of "Exceptional" in the Context of Bad Litigation Behavior

A recent case addressing fee shifting (in which the loser pays the winner's costs) provides an excellent example of the effect of the Federal Circuit's specialization on the development of doctrinal vocabulary. Parallel sections of the Patent Act (addressing patent infringement) and the Lanham Act (addressing trademark infringement) use identical language in granting the district courts discretion in awarding attorney fees in patent litigation: "The court in exceptional cases may award reasonable attorney fees to the prevailing party."[81] Patent infringement cases, of course, fall under the specialized jurisdiction of the Federal Circuit; trademark infringement cases, by contrast, are heard in the twelve generalist regional circuits.[82] As a result, the fee-shifting language of these two acts provides a unique opportunity to evaluate the effects of

---

80. *See* Randall R. Rader, *The United States Court of Appeals for the Federal Circuit: The Promise and Perils of a Court of Limited Jurisdiction*, 5 MARQ. INTELL. PROP. L. REV. 1, 4 (2001).

81. 35 U.S.C. § 285 (2018); 15 U.S.C. § 1117(a) (2018).

82. By statute, all cases arising under the Patent Act are appealed exclusively to the Federal Circuit. 28 U.S.C. § 1295(a)(1) (2018). Most other cases arising from the federal district courts, including trademark infringement under the Lanham Act, are appealed to the relevant regional circuit. *Id.* at § 1291 (2018). The Federal Circuit hears trademark cases arising from the USPTO and the Trademark Trial and Appeal Board, addressing issues such as registration, cancellation, and renewal. *Id.* at § 1295(a)(4) (2018).

specialization on the development of court-created legal vocabulary.

Generally, litigation procedure in the United States follows the "American Rule,"[83] under which each litigant pays his or her own attorney fees, regardless of success or failure in the litigation. In 1946, however, Congress amended the Patent Act to give the district courts discretionary authority to award reasonable attorney fees to the prevailing party in "any" patent case,[84] although with the expectation that recovery of attorney fees would not become the norm.[85] And, in practice, the regional circuit courts, who still had jurisdiction over patent appeals at that time, did limit the application of the award to "extraordinary circumstances."[86]

When Congress enacted the Patent Act of 1952, it adopted Section 285, which allows fee-shifting in "exceptional" cases. Although this change in terminology would appear to have limited the broader fee recovery under the 1946 amendment, the Supreme Court viewed this new language as being "for purposes of clarification only" and not as a change in doctrine.[87] The regional circuits continued to instruct the district courts to consider the totality of the circumstances in deciding whether to exercise their discretion to make attorney fee awards.

Jurisdiction over patent appeals shifted to the Federal Circuit in 1982.[88] For over two decades, the Federal Circuit adhered to the existing interpretation of Section 285.[89] Then, in 2005, in *Brooks Furniture Manufacturing, Inc. v. Dutailier International, Inc.*,[90] the Federal Circuit adopted a new rule that interpreted Section 285 fee shifting as being restricted to only those instances in which there is material inappropriate conduct related to the litigation. The court set forth a detailed and rigid formula in which it stated that "exceptional" under Section 285 encompassed "misconduct in

83. *See* Marx v. Gen. Revenue Corp., 568 U.S. 371, 382 (2013).

84. 35 U.S.C. § 70 (1946) (current version at 35 U.S.C. § 284 (2018)).

85. *See* S. REP. NO. 79-1503, at 2 (1946); *see generally* Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749, 1753–54 (2014) (summarizing history and development of 35 U.S.C. § 285).

86. *See, e.g.*, Park-In-Theatres, Inc. v. Perkins, 190 F.2d 137, 142 (9th Cir. 1951).

87. Gen. Motors Corp. v. Devex Corp., 461 U.S. 648, 653 n.8 (1983).

88. *See, e.g.*, Rohm & Haas Co. v. Crystal Chem. Co., 736 F.2d 688, 691 (Fed. Cir. 1984).

89. *See, e.g.*, Yamanouchi Pharm. Co. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1347 (Fed. Cir. 2000).

90. Brooks Furniture Mfg., Inc. v. Dutailier Int'l, Inc., 393 F.3d 1378 (Fed. Cir. 2005).

conduct of the litigation"[91] and "misconduct . . . in securing the patent."[92] Absent these settings, the *Brooks Furniture* court stated, attorney fees could be awarded against the patentee "only if both (1) the litigation is brought in substantive bad faith, and (2) the litigation is objectively baseless."[93]

The Federal Circuit's interest in narrowly construing "exceptional" seemed to have been based in part on a policy-based belief among many of its judges that patent owners have an inherent right to assert their patents in the absence of wrongful behavior that rises to the level of a tort. For example, in *Brooks Furniture*, the court found a "presumption that the assertion of infringement of a duly granted patent is made in good faith."[94] This patent-positive notion of ruling in favor of a patentee's ability to litigate effectively prejudged potential cases and removed them from the discretion of the district court. The net result of the Federal Circuit's narrow definition of "exceptional" in *Brooks Furniture* was that cases in which fee shifting was authorized under Section 285 were rare and difficult to prove.[95] An overly rigid and narrow context became an outcome-determinative definition that satisfied only the Federal Circuit's apparent normative desire to foster litigation opportunities and embrace the American Rule.

Outside forces conspired to pierce the Federal Circuit's isolation, however, including a U.S. litigation environment that many considered to be broken due to the emergence of "patent trolls."[96] Trolls, or in more neutral parlance, "non-practicing entities" (NPEs), are owners of patent rights who generally do not produce products or services and sue only to extract a settlement

---

91. *Id.* at 1381. The court described such behavior as including "vexatious or unjustified litigation, conduct that violates Fed. R. Civ. P. 11, or like infractions." *Id.*

92. *Id.* The court described this as "fraud or inequitable conduct in procuring the patent." *Id.*

93. *Id.* Later cases fleshed out these two elements. *See, e.g.*, iLOR, LLC v. Google, Inc., 631 F.3d 1372, 1377–78 (Fed. Cir. 2011) (stating that objectively baseless litigation is "so unreasonable no reasonable litigant could believe it would succeed" and subjective bad faith litigation arises when the plaintiff "actually know[s]" that the litigation is objectively baseless). Moreover, the *Brooks Furniture* court stated these determinations "must be established by clear and convincing evidence." 393 F.3d at 1382.

94. *Brooks Furniture*, 393 F.3d at 1382.

95. *See*, *e.g.*, Roger Allan Ford, *The Patent Spiral*, 164 U. PA. L. REV. 827, 846 (2016) (describing fee shifting powers before 2014 as "toothless").

96. EXEC. OFFICE OF THE PRESIDENT, PATENT ASSERTION AND U.S. INNOVATION 3–4 (2013).

payment.[97] In many cases, the patents asserted by trolls are weak and would not hold up in litigation if the defendant could afford to test the merits. In the wake of such behavior, fee shifting gained attention as a possible weapon to make trolling less attractive,[98] and the stage was set for a confrontation on the Federal Circuit's "exceptional" framework.

The case that provided the context for review was *ICON Health & Fitness, Inc. v. Octane Fitness, LLC*.[99] It involved Octane's alleged infringement of ICON's patent on an elliptical (exercise) machine that allowed for adjustable stride length.[100] ICON's allegations were weak from the outset. They included an overly broad construction by ICON of its claims to encompass Octane's machine that would have also rendered ICON's patent invalid.[101] In other words, it was a case that ICON should have known it could not win. And ICON did not in fact win. However, when Octane requested fee shifting under Section 285, both the district court and Federal Circuit concluded that the case was not "exceptional" because there was no wrongful behavior.[102]

The U.S. Supreme Court overruled the Federal Circuit in 2014 in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*[103] The Court determined that the rule laid out by the Federal Circuit in *Brooks Furniture* was "unduly rigid."[104] The Federal Circuit's requirement that the litigation had to be both "brought in subjective bad faith" and "objectively baseless"[105] impermissibly "superimpose[d] an inflexible framework onto statutory text that is inherently flexible."[106] The narrow patent-centric definition of "exceptional" had to give way to a more broadly understandable, common sense meaning.[107]

---

97. *Id.*

98. *See generally* Emily H. Chen, *Making Abusers Pay: Deterring Patent Litigation by Shifting Attorneys' Fees*, 28 BERKELEY TECH. L.J. 351 (2013).

99. ICON Health & Fitness, Inc. v. Octane Fitness, LLC, 496 F. App'x 57 (Fed. Cir. 2012).

100. *Id.* at 58.

101. *Id.* at 64–65.

102. *Id.* at 65.

103. Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749 (2014).

104. *Id.* at 1775.

105. Brooks Furniture Mfg., Inc. v. Dutailier Int'l, Inc., 393 F.3d 1378, 1381 (Fed. Cir. 2005).

106. *Octane Fitness*, 134 S. Ct. at 1756.

107. The Court also rejected the Federal Circuit's attempt to impose the more demanding "clear and convincing evidence" standard, stating the district courts "may determine whether a case is 'exceptional' in the case-by-case

In reinterpreting the term, the Supreme Court drew upon standard canons of statutory construction[108] in ruling that "exceptional" should be read according to its ordinary meaning: a case "that stands out from others" with respect to the strength of the argument or unreasonable manner of litigation.[109] The Supreme Court also noted, almost as an aside, that the Lanham Act contains fee shifting language identical to that found in the Patent Act.[110] The Court cited *Noxell Corp. v. Firehouse No. 1 Bar-B-Que Restaurant*,[111] a 1985 decision from the D.C. Circuit written by then-Judge Ruth Bader Ginsburg, joined by then-Judge Antonin Scalia; both of them of course had been elevated to the Supreme Court by the time of the *Octane Fitness* decision. The *Octane Fitness* Court noted that *Noxell* had interpreted the term "exceptional" in the context of Lanham Act fee shifting as meaning "uncommon" or "not run-of-the-mill."[112] There is no reason for the definition of the term to differ in the patent and trademark contexts, especially when used in identical statutory provisions.

The Supreme Court was able to draw upon its broad, generalist perspective on common sense and plain-meaning statutory interpretations to define the fee-shifting statute in a less rigid and more commonly understood way. In many respects, the Court's ruling transferred some power away from the Federal Circuit. More importantly, it made the trigger for fee-shifting behavior more understandable to the public or ordinary skilled artisan by reducing the level of patent-centric doctrinal analysis required. Moreover, the broadening of rules and methodology available to a trial court judge essentially increased the possibility that a litigant could prove a common-sense case of exceptionally bad behavior.[113]

---

exercise of their discretion, considering the totality of the circumstances." *Id.* at 1757–58.

108. *See*, *e.g.*, Perrin v. United States, 444 U.S. 37, 42 (1979) ("A fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning.").

109. *Octane Fitness*, 134 S. Ct. at 1756.

110. *Id.* at 1757.

111. Noxell Corp. v. Firehouse No. 1 Bar-B-Que Rest., 771 F.2d 521, 526 (D.C. Cir. 1985).

112. *Octane Fitness*, 134. S. Ct. at 1757 (quoting *Noxell*, 771 F.2d at 526).

113. In the wake of *Octane Fitness*, the number of granted requests for fee shifting has more than doubled, as one might expect. *See* Ryan Davis, *Fee Awards Loom Large in Patent Law 3 Years After* Octane, LAW360 (Apr. 27, 2017), https://www.law360.com/articles/915516/fee-awards-loom-large-in-patent-law-3-years-after-octane (reporting that the number of granted fee-shifting

Whether the linguistic clarity imposed by the Supreme Court can be easily maintained long-term is an open question, however. In a recent decision, *Checkpoint Systems, Inc. v. All-Tag Security S.A.*,[114] the Federal Circuit reversed a trial court's award of attorney's fees to the defendant. In doing so, it gave little deference to the lower court's determination that Checkpoint had insufficient evidence to ground its case and brought suit to leverage the competitive power of its patent.[115] The Federal Circuit's tendency to adopt formalistic, highly refined patent-centric definitions may prove a formidable barrier to overcome.[116]

### 2. The Persistence of "Patentese"

As a more general matter, it can be said that the Federal Circuit enables and even encourages the use of idiosyncratic wordplay—sometimes referred to as "patentese"—in various aspects of patent law.[117] It does this by routinely approving deviance from common understandings of vocabulary and supporting conflicting meanings in different context. Such an approach gives rise to the perception that only a few have access to the special language skills necessary to understand patents.

---

motions in 2012 and 2013 were 19 and 15, respectively, and in 2014, 2015, and 2016, it was 39, 42, and 41 respectively). But motion practice overall has also increased by at least 50 percent, meaning that more litigants are making fee-shifting requests. *Id.* (reporting that the number of overall fee-shifting motions in 2012 and 2013 were 93 and 109, respectively, and in 2014, 2015, and 2016, it was 170, 187, and 158 respectively). This suggests that the district courts have opened up as a forum for addressing bad behavior, increasing access that was previously curtailed by a narrow reading of "exceptional."

114. Checkpoint Sys., Inc. v. All-Tag Sec. S.A., 858 F.3d 1371 (Fed. Cir. 2017).

115. *Id.* at 1376.

116. Moreover, the problem of idiosyncratic, patent-centric vocabulary addressed in *Octane Fitness* is not confined to fee shifting. There are instances in many other aspects of patent law. For example, the Federal Circuit had a longstanding rule that permanent injunctions should routinely issue when infringement is found, absent "exceptional circumstances." *See, e.g.*, MercExchange, LLC v. eBay, Inc., 401 F.3d 1323, 1339 (Fed. Cir. 2005); Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1246–47 (Fed. Cir. 1989) ("It is the general rule that an injunction will issue when infringement has been adjudged, absent a sound reason for denying it."). The Supreme Court overturned the Federal Circuit in *eBay Inc. v. MercExchange, LLC*, finding that a traditional four-part injunction test common to general federal doctrine applied rather than the narrowly defined "exceptional circumstances" limitation invoked by the Federal Circuit. eBay Inc. v. MercExchange, LLC, 547 U.S. 388, 391 (2006).

117. For a selection of references making this point, see *supra* note 1.

Consider, for example, the difference between the terms, "comprising" and "consisting of." One of ordinary skill in the art (and the lay person) would likely consider these phrases to be synonyms.[118] However, as Professors Burk and Lemley point out, Federal Circuit case law defines "comprising" as "the patented invention contains at least the elements listed, but may also contain others," whereas "consisting of" "means that the invention contains only those elements listed."[119] In a similar vein, Professor Feldman notes that the Federal Circuit has found that the words "a" or "an" can actually mean "one or more" unless there is clear evidence of a patentee's intent to limit the language.[120] Such departures from general language rules simply erect a barrier to non-expert users of the patent system.

Judge Rakoff of the Southern District of New York laments that patentese reflexively infects judicial opinions, further creating a divide between expert insiders and the rest of the business community.[121] He states "what makes the use of jargon in patent cases particularly pernicious is that it frequently involves the use of ostensibly everyday words to convey obscure meanings."[122] Rakoff cites examples of patent law vocabulary that is more difficult to explain to a jury than necessary, such as "teach toward," "teach away," "prosecution history," and "file wrapper."[123] As a result, juries are more likely to be confused,[124] their determinations less accurate, and the trial court's burden of instructing the jury considerably heightened.

In addition to basic comprehension, the use of specialized language indicates who is part of the knowledgeable group—in effect, who the "insiders" are.[125] It serves as code for discounting those who are not. Most concerning, this signaling may be obvious and significant to the Federal Circuit,[126] which has implications for the ability of those not skilled in the specialized vocabulary to fully participate in the patent system.

---

118. *See* Burk & Lemley, *supra* note 43, at 1755 n.48.

119. *Id.* (citing KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1356 (Fed. Cir. 2000)).

120. Robin Cooper Feldman, *Plain Language Patents*, 17 TEX. INTELL. PROP. L.J. 289, 293 (2009) (citing Baldwin Graphic Sys., Inc. v. Siebert, Inc., 512 F.3d 1338, 1343 (Fed. Cir. 2008)).

121. Rakoff, *supra* note 1, at 839–41.

122. *Id.* at 840.

123. *Id.* at 840–41.

124. *Id.*

125. Field, *supra* note 1, at 145–46.

126. *Id.* at 146 n.35.

Because it touches on acquisition, enforcement, and even third-party evaluation, the persistence of idiosyncrasy in patent law is a broad problem. It contributes to the overall obscurity in patent vocabulary that an isolated court is insufficiently incentivized to eliminate.

## IV. REDUCING OBSCURITY

One possible response to reducing the complexity and idiosyncrasy of patent law that leads to obscurity is to rely on expert intermediaries (e.g., patent lawyers, consultants, or legal scholars) to interpret and communicate the rules. So long as we facilitate the understanding of the experts, clarity will filter down to inventors and the public. Some would argue that this approach has been de facto incorporated into the system and is now the expected route to resolve obscurity. For example, Professors Janis and Holbrook recently argued that the patent bar and other expert lawyers, commentators, and academics represent the true audience for patent law.[127] They assert that patent rules are no longer directed to the "general public," or even to inventors, but rather are broadcast to multiple intermediaries, who then re-transmit the rules to the end users, with whatever explanation is required under the circumstances.[128] In essence, they suggest that it would be better to recognize and optimize the intermediary communication route rather than continue with the legal fiction that inventors have the ability to operate autonomously.

Janis and Holbrook's proposal could be viewed as problematic from a normative perspective. Focusing primarily on intermediaries is an abdication of the modern legal system's responsibility to inform and incentivize the public. Consider the Plain Language Movement of the 20th century.[129] It pushed lawyers, companies, and the government to explain the law in terms accessible to the average person (culminating in the federal Plain Writing Act[130] passed during the Obama administration). We should not backslide to an era in which the legal elite effectively act as the gatekeepers for a secret innovation code, particularly when such information is so important to the economic future of

127. *See* Janis & Holbrook, *supra* note 79, at 87–88.

128. *Id.*

129. *See* Rachel Stabler, *"What We've Got Here is Failure to Communicate": The Plain Writing Act of 2010*, 40 J. LEGIS. 280, 281–85 (2013) (describing the rise of plain language requirements, first in communications from firms to consumers, and later from government to the public).

130. Plain Writing Act of 2010, Pub. L. No. 111-274, 124 Stat. 2861 (2010).

the globe. Moreover, as modern innovation is democratized—pushed out of industry labs and into the hands of individuals—the cost of requiring expert intermediaries increases. More and more, as the tools of innovation become standardized and more widely available, inventors are found outside of the traditional corporate setting, and instead in incubators, 3-D printing facilities, and improvised labs.[131] In such settings, patent attorneys are not as readily available. An overdependence on intermediaries will risk the loss of an essential element of the innovation system.

Rather, a better path is to reorient the current system to more fully inform the intended inventor audience. And the key component of the current system that must be altered is the Federal Circuit. It appears that the bulk of the linguistic barriers are due to the procedural and doctrinal isolation of this appellate court. Thus, opening up the court to a broader set of views may be the solution.

Recent incursions by the U.S. Supreme Court provide some insight into the potential benefits of a more inclusive mindset. An increased effort to compel the Federal Circuit to consider viewpoints beyond patents is likely to be the strongest means of reducing complexity and idiosyncrasy. Of course, in broadening the Federal Circuit's perspective and experiences, it is important not to lose the advantages of a specialized court. The increased accuracy and consistency are real and important assets for the intellectual property community.

One possible mechanism that is already established and in use is "sitting by designation."[132] This is a practice in which the Chief Justice of the Supreme Court temporarily assigns a circuit judge to serve on another appellate court or district court.[133] Professor Oswald has previously outlined the advantages of expanding the use of sitting by designation to increase accuracy.[134] This solution would be similarly effective in eliminating language barriers to provide better access. Other methods of reducing the Federal Circuit's isolation have been proposed, but most would require a more substantial reorganization of the court's jurisdiction.[135]

---

131. *See* Andrew W. Torrance & Eric von Hippel, *The Right to Innovate*, 2015 MICH. ST. L. REV. 793, 816–17 (2015) (discussing legal impediments to "citizen innovators").

132. *See* Oswald, *supra* note 26, at 289–90.

133. 28 U.S.C. § 291 (2018).

134. Oswald, *supra* note 26, at 289–90.

135. *See*, *e.g.*, Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1664–67 (2007) (proposing a

Another currently available mechanism that could reduce the pressure on the Federal Circuit to serve as a specialized court is the so-called Patent Pilot Program.[136] Introduced in 2011, the program directs patent cases to interested district court judges in select districts.[137] The idea is to increase lower-court expertise in patent law.[138] Such a program has the potential to improve linguistic obscurity by channeling more substantive patent law to the district courts. Arguably, one of the main reasons for the Federal Circuit's isolation is the frequent need to correct weak or unfounded rulings from generalist trial courts with little experience in patent law. If the Federal Circuit gains more confidence that the district courts are providing informed adjudication, the appeals court may be less inclined to substitute its own perspective and vocabulary. In the grander scheme, an expanded Patent Pilot Program can work as a complement to any initiative that broadens the Federal Circuit's perspective. Of course, whether the Patent Pilot Program is a successful means of increasing district court expertise is still an open question. In 2016, the Federal Judicial Center conducted a mid-term assessment of the 10-year program and found that affirmation rates among pilot and non-pilot courts were essentially the same.[139]

However accomplished, an increased effort to reduce the Federal Circuit's isolation is likely to be the strongest means of reducing complexity and idiosyncrasy. Although fully understanding patent technology may require skill in the art, the law that draws boundaries and punishes infringers should be available to all. If we can reduce linguistic barriers, we can replace obscurity in the law with clarity and accessibility and expect a more efficient innovation system overall.

---

system in which an additional general appellate court or the D.C. Circuit would share cases with the Federal Circuit).

136. Act of Jan. 4, 2011, Pub. L. No. 111-349, 124 Stat. 3675 (2011).

137. Randall R. Rader, *Addressing the Elephant: The Potential Effects of the Patent Cases Pilot Program and Leahy-Smith America Invents Act*, 62 AM. U. L. REV. 1105, 1106–07 (2013) (describing the origins and intent of the program).

138. *Id.*

139. MARGARET S. WILLIAMS ET AL., FED. JUDICIAL CTR., PATENT PILOT PROGRAM: FIVE-YEAR REPORT 36 (2016), https://www.fjc.gov/sites/default/files/2016/Patent%20Pilot%20Program%20Five-Year%20Report%20(2016).pdf (finding that patent adjudication affirmation rates among pilot and non-pilot courts were both about 72%).

## V. CONCLUSION

As the most significant source of patent jurisprudence, the Federal Circuit wields extraordinary power over the development of the language in the field. Unfortunately, its relative isolation as a specialized appellate court leads to a tunneled avenue of communication with a narrow audience of experienced practitioners. As a result, the court intentionally or subconsciously employs obscure language to resolve difficult legal or policy issues. Recent cases in particular highlight complexity and idiosyncrasy in the court's vocabulary. Such language barriers reduce access to patent law that is important to a wide range of businesspersons and technicians. To improve the current state without reducing the overwhelming benefits of the Federal Circuit, policymakers should take readily available steps to expose the court to a broader set of views.