MEETING RECAP
THE PAULINE NEWMAN
IP AMERICAN INN OF COURT
TUESDAY, MARCH 19, 2013

The third meeting in 2013 of the Pauline Newman IP American Inn of Court took place in the Madison Building of the U.S. Patent & Trademark Office. It began at 6:00 p.m. with a reception in a first room of the Auditorium. The program began at 7:05 p.m., and was held in a second room of the Auditorium. President Al Tramposch announced elections to be held at the May meeting. Donald Dunner of Finnegan introduced the featured speaker, who was Professor Donald S. Chisum, author of *Chisum on Patents*. His presentation was entitled *Patent Law Yesterday, Today and Tomorrow: Confessions of a Treatise Author*.

He wrote the first edition of *Chisum on Patents* during 1974-1977. It was first published in 1978 in five volumes; it now has 33 volumes (including the 20 volume *Federal Circuit Guide*.)

He has also written many law journal articles. Professor Chisum recommends that legal practitioners and judges, not just academics and treatise writers, should write journal articles. When he began his career, most law schools did not offer courses on patent law. His "tenure" article was *The Allocation o f Jurisdiction Between State and Federal Courts in Patent Litigation*. Professor Charles Black advised, "To understand, truly, the Constitution and the federal system, pick for intensive study some area of substantive or procedural law that has repeatedly occupied the attention of the federal judges." Black wrote a treatise on admiralty and maritime law. Colliers wrote a treatise on bankruptcy. Nimmer wrote a treatise on copyrights. McCarthy wrote a treatise on trademarks. Patents were the only area of intellectual property left for Chisum to write a treatise on.

In determining under what law a case arises, the creation test (§1338) is contrasted with the substantial issue test (§1331). State courts are competent to apply federal law in cases in which it is applicable. In 1982, the Court of Claims and the Court of Customs and Patent Appeals were merged to create the Federal Circuit. The *Christiansen* case became the subject of appellate "ping pong", as the Federal and Seventh Circuits disagreed as to whether is was a patent case. Chief Justice Roberts has described the contours of arising under jurisdiction as not "a blank canvas. Unfortunately, the canvas looks like one that Jackson Pollock got to first."

Gunn v. Minton, decided by the U.S. Supreme Court in 2013, dealt with patent attorney malpractice. Experimental use was not raised in time as an exception to the on sale bar. (The America Invents Act ("AIA") may have increased the scope of patentable subject matter.) Patent attorney malpractice may be one of the few areas in which a party can seek to overturn a judgment based on the party's own mistake (filing in wrong court). The Texas Supreme Court held that the state courts had no jurisdiction, because the case arose under patent law. The U.S. Supreme Court unanimously reversed, on the grounds that the federal issue was not substantial. The federal courts do not have exclusive jurisdiction "of all questions in which a patent may be the subject-matter of the controversy." The states have a high interest in their ability to regulate the conduct of lawyers. It is not clear how far the holding in *Gunn* will extend in future cases.
The AIA makes it easier to remove patent and copyright cases from state to federal court.

The doctrine of "inequitable conduct" also stimulated Chisum to write his treatise. There was no good, up-to-date treatise on patent law. (*Walker on Patents* was one hundred years out of date.) *Chisum on Patents* has been cited by the U.S. Supreme Court. Under *Therasense*, omissions must be material. The judge in *Monolith* said, "the use of wilfully false testimony cannot be rinsed away with a solution composed primarily of legal semantics." Doctrines focusing on the conduct of attorneys were distracting from a focus on the scope and validity of a patent. The Supreme Court has praised Judge Rich his decision on the burden of proof for invalidity in *American Hoist*.

The Supreme Court's *Benson* decision was fundamentally wrong. Today there is chaos in the law of patent eligible subject matter. Chisum has written articles both praising and condemning *Bilski*.

The AIA has created a whole new set of intricacies and ambiguities in the definition of prior art. There will be two laws (old 102 and new 102) for decades. Chisum's final slides suggested topics for future articles on patent law.

Judge Pauline Newman made concluding remarks. The authors of the 1952 patent act brought together the wisdom that had evolved in the past. She discussed prominent cases and legislation since 1952, and the AIA. She endorsed Chisum's exhortation to think and to write.

The meeting adjourned at 7:21 p.m.

Photographs by Michael Lew.

Respectfully submitted,

Stephen Christopher Swift
Secretary-Treasurer