HISTORIAN'S CORNER

"As Time Goes By - You be the Judge!"

by Dale Carlson

In our first two columns, we focused on the contributions to the patent profession of Judge Giles Rich and Paul Rose, respectively. As you may recall, they partnered in framing the 1952 Patent Act, working in concert with the PTO's Pat Federico.

Both Judge Rich and Mr. Rose were patent lawyers in the traditional sense of the word. Both were registered to practice before the PTO, practiced in the field, and eventually ended up teaching patent law to the next generation of would-be patent lawyers.

Long before Judge Rich became President of our Association, he wrote with the logical mind of someone destined to one day become a judge. In an article entitled "The Wrong Clue, Sherlock", appearing in the Journal of the Patent Office Society ("JPOS") in 1933, he critiqued another author's statements concerning the Constitutional mandate relating to inventions. The other author had commented that "an invention must promote progress in order to be patentable."

In dissecting Article 1, Section 8, Clause 8 of the Constitution, Judge Rich concluded that the Constitutional restrictions are but two: (a) the exclusive right is for inventors, and the right applies (b) only to their discoveries. He concluded that "we see no condition precedent to the granting of a patent requiring that the invention patented shall promote anything. Congress has the power to make laws which shall promote progress. The laws are to do the promoting...".

Judge Rich brought a practical mind to the bench borne of his years of practice as a patent lawyer. In preparing for this, he had a head-start. Judge Rich's father was a patent lawyer, first with the Rochester, NY firm of Church and Rich, and later, beginning in 1919, in Manhattan with the Western Electric Company.

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With his lineage in patent law and practice, it's easy to see why Judge Rich became what is tantamount to "a patent lawyer's patent lawyer". Other judges similarly situated include Federal Circuit Judge Pauline Newman, a past Director of our Association, and Judge William C. Conner, a past President of our Association.

What all three judges share as a common bond are their years of experience as practicing patent lawyers. Such experience doubtless provided, and continues to provide, a "real world" grounding to their judicial opinions.

Recently, President George Bush nominated Kimberly A. Moore to fill Judge Clevenger's open seat on the Federal Circuit. Ms. Moore brings impressive credentials to the bench. She clerked for Chief Judge Archer on the Federal Circuit, worked in private practice as an IP litigator, and co-authored a treatise on patent litigation.

Ms. Moore is not, however, a registered patent lawyer, and has not practiced before the PTO. This represents an important line of demarcation from the backgrounds of Judges Rich, Newman and Conner. We can hope that, if confirmed by the Senate, Ms. Moore will capitalize upon the practical experience in patents that her future colleagues, Judges Newman, Lourie and Gajarsa, bring to the bench.

To the extent that our Association's members believe that patent-experienced judges are an important component of the Federal Circuit's make-up, we should consider bringing forward qualified candidates when opportunity permits. If you spot a good candidate, or believe yourself to be one, please consider passing your thoughts on to Ed Bailey, Chair of the Committee on Public and Judicial Personnel.

Happy nominating!