Donald Chisum – on patents

Professor Donald Chisum is the author of *Chisum on Patents*, a text first published in 1978 and regularly updated since then to incorporate changes in US patent law and practice. Chisum was professor of law at several universities before co-founding the Chisum Patent Academy in 2009. In 1989 he received the Jefferson Medal Award for an outstanding contribution to the constitutional goals of the patent and copyright systems.

What inspired you to embark on a career in patents?

After law school, I spent a year as a law clerk to a brilliant federal appellate judge, Shirley M Hufstedler. That experience, together with my previous law studies at Stanford University, convinced me that the most fascinating feature of law in the United States was its federal system and the interplay between the substantive law of individual states and the central law.

After clerking, I embarked on an academic career and continued my exploration of the federal-state interface. Charles Black of Yale, a distinguished scholar of constitutional law, gave me a critical piece of guidance: if one really wished to understand the workings of the federal constitutional system, one should not simply study jurisdiction and procedure. Rather, one should plumb in depth some area of substantive law. Black had done that with maritime and admiralty law, writing a well-regarded text. I determined to do the same for some area of law, preferably intellectual property. The choice there was clear: good treatises already existed on copyright and trademark law. But the last major treatise on patent law had been published in 1890 by Professor William C Robinson, also of Yale. And patent law was ideal as a field for studying the role of the federal judiciary.

In 1974, I began work without even having a contract with a publisher. One publisher rejected my proposal. But in 1975, Matthew Bender reviewed the initial chapters and outline I had prepared and offered a contract. My patent law treatise was published in October 1978 as five volumes. Over 33 years, it has grown to 26 volumes, reflecting the grand rejuvenation of patent law over that period of time.

What would you say has been the most significant development in patent law since the first edition of your treatise?

The most significant development would have to be the creation of the Court of Appeals for the Federal Circuit in 1982. The Federal Circuit was given jurisdiction of appeals that previously went to 12 different appeals courts. Concentrating all appeals in patent cases in one intermediate appellate court had a major impact on the patent system.

Whether the influence of the Federal

> "What was and is needed: a comprehensive simplification of patent law, which is industry and technology neutral and reflects the broad public interest"

Circuit has been universally positive for the patent system is subject to debate. One thing is clear: the creation of that court presented a treatise writer with a new and possibly unique challenge in updating a legal text. It magnified the importance of each reported court decision. There are now well over 2,000 precedential decisions by the Federal Circuit, virtually all involving some point of law that might be dispositive of a real-life problem. It has not helped that some judges of that court have been prone to writing lengthy opinions, sometimes not well-organised, and too often taking inconsistent positions.

Have any of the changes you have witnessed been detrimental to the patent system?

Three major changes come to mind that, arguably, have been detrimental to the patent system as a whole.

One was the development of the pre-trial *Markman* hearing procedure in patent litigation. It has multiplied the expense of litigation for both patent owners and accused infringers. It has encouraged an excessively technical focus on the precise language of patent claims. None of this has increased the interest in certainty about the scope of patent rights, which *Markman* sought to foster.

A second change was the relaxation of venue rules in patent infringement suits after the Federal Circuit's 1990 *VE Holdings* decision. That decision enabled patent owners to sue in any district in which an accused infringer had distributed allegedly infringing products. That has led to a concentration of patent cases in certain plaintiff-favoured districts such as the Eastern District of Texas even though neither party has any substantial presence in the district.

A third change was the enactment in 1984 of the Hatch-Waxman Act. The act's provisions on US Food and Drug Administration (FDA) approval of generic equivalents to patented drugs and on patent owner suits created incentives for both brand name and generic manufacturers to misuse the patent system. Brand name manufacturers are encouraged to obtain minor patents of questionable validity in order to stall FDA approval of generics via the act's automatic 30-month stay. Generic manufacturers are encouraged to take cheap shots at the validity of good and valuable patents.

More detrimental than any of these changes to the patent system are the changes that did not occur over the 33 years following the publication of my treatise. Despite the vast increase in patenting activity and importance of intellectual property rights since the mid-1970s, there has been little fundamental change in how the US Patent and Trademark Office operates or in how patent disputes are resolved. Over almost that entire period, there have been proposals for patent law reform. But proposals have inevitably been burdened by the efforts of particular industry groups to obtain special advantages. What was and is needed: a comprehensive simplification of patent law, which is industry and technology neutral and reflects the broad public interest. Likely, it will never happen.

You have lectured in patent law extensively and, in 2009, co-founded the Chisum Patent Academy. What motivated you to open the Academy?

Through my entire career, I have been a teacher as well as scholar. I came to realise that the treatise is a form of teaching and its most important students are not law students, but law graduates and other professionals working in patent departments and firms who are confronted with the complexities of the patent system, which can be so intimidating and unforgiving of mistakes.

I and my spouse, Professor Janice Mueller – also an author on patent law – realised that, for this group of working patent professionals, quality legal texts are important, but not enough. There is a huge and continuing need to provide quality education and training in both patent basics and ongoing important developments in patent law. To respond to that need, we established the Chisum Patent Academy.

What do you think are the biggest challenges facing the IP world today and how do you think they could best be overcome?

The three biggest challenges are costs, costs and costs. Intellectual property operates in three major arenas: procurement of IP; evaluation of what IP rights exist and who owns them; and enforcement of IP rights. All three arenas are too costly and uncertain (which is another form of cost). Cost causes all kinds of distortions. The costs weigh both on original creators of IP (and those who own their rights) and on subsequent creators and users.

The excessive cost problem could best be overcome by a major simplification of both substantive standards and enforcement procedures. But that's unlikely to happen any time soon. Substantive simplification is theoretically possible, but would be opposed by interests seeking special treatment.

Procedural reform also faces obstacles, not least of which is that cutting costs in IP means, in effect, reducing professional employment.

In the United States, a primary source of cost is the general legal structure, which promotes litigation and makes available onerous procedures, such as pre-trial discovery. The general structure is unlikely to see major reform, and giving IP rights special and favoured treatment would be difficult to sell.

Finally, who are your own IP heroes?

There are four giants in the history of United States patent law: Judges Joseph Story, Learned Hand and Giles Rich, and Professor William Robinson.

I admire the three judges, in part, because their careers extended for such long periods. From Professor Robinson's career, I learned two lessons – one positive and one negative. The positive one was about treatise writing. His 1890 three-volume work was and still is amazing, with its logical structure and copiously complete footnoting. The negative lesson was about staying focused on real work. Professor Robinson was lured into administration, becoming the founding dean of Catholic University Law School in Washington, DC. Unfortunately, the result was that he never prepared a second edition of his great treatise. It is a fate I have tried to avoid, keeping my professional focus on the treatise and making it responsive to the sweeping changes that patent law has witnessed since the 1970s and into the 21st century. ■