

1. **Judicial Hyperactivity: The Federal Circuit’s Discomfort with its Appellate Role**

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Abstract

The authors identify a phenomenon in Federal Circuit decision-making that might fairly be termed “judicial hyperactivity.” Judicial hyperactivity describes what happens when the court from time to time loses track of the important distinction between trial and appellate roles and engages in a form of decision-making at odds with traditional notions of appellate review. The authors explain how to recognize judicial hyperactivity and discuss several recent examples of the practice, including instances where Federal Circuit panels have apparently taken up the roles normally assigned to patent examiners, to advocates and to judicial fact-finders. The authors argue that, although the court may view judicial hyperactivity as efficient or expedient in a particular case, the practice should be avoided because it will ultimately have a pernicious effect, undermining confidence in the judiciary and the predictability of the judicial process.

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1. Introduction

The United States Court of Appeals for the Federal Circuit is an intermediate federal appellate court, not a trial court.¹ Charged by statute with reviewing decisions of lower courts and administrative agencies,² it has no original jurisdiction. Unfortunately, the court from time to time appears to lose track of the important distinction between trial and appellate roles and engages in what might be termed “judicial hyperactivity”—a form of decision-making at odds with traditional notions of appellate review. In this article, we explain how to recognize judicial hyperactivity and discuss several recent examples of the practice. We argue that, although the court may view judicial hyperactivity as efficient or expedient in a particular case, the practice will ultimately have a pernicious effect, undermining confidence in the judiciary and the predictability of the judicial process.

As an initial matter, we should hasten to distinguish “judicial hyperactivity” from its better known sibling, “judicial activism.” The latter term refers to a tribunal going beyond the substantive statutory or common law to reach ideologically-motivated outcomes (whether to engage in a bit of social engineering or to give shape to a radical new jurisprudence). Readers familiar with this more traditional usage will recognize that the very term “judicial activism” is

drenched in political overtones. The New Dealers reviled the conservative majority of the Supreme Court for its judicial activism in striking down liberal New Deal legislation in the 1930s.³ Today, the phrase is likely to be used both by conservatives in attacking liberal judges⁴ and—more and more—by liberals attacking conservative judges.⁵ These pejorative uses of the term often carry an implied disagreement with the outcome of the allegedly judicial activist decisions. Critics of a more purist bent, however, may employ the term to criticize the court’s policy focus itself, decrying the court’s “activism” in usurping the legislature’s role in setting policy without regard to the particular policy outcomes.⁶

While judicial hyperactivity does not necessarily aim to reshape the substantive law in ways some view as improper, it does share with its more politicized sibling a fundamental focus on the proper role of the judiciary. In identifying judicial hyperactivity, however, our focus is not on the rules that govern society, but on those that direct the decision-making process itself. Unlike critics who level the charge of “judicial activism” when they believe that a court has improperly usurped the policy-making role of the legislature, we are concerned with what happens when an intermediate appellate court usurps elements of the decision-making process that are supposed to be the province of the lower courts, administrative bodies, or even litigants.

The line between “statutory interpretation” or common law legal evolution and policy-driven judicial activism may at times be a hard one to draw. Thus, the charge of “judicial activism” is often a highly subjective one. The line between proper appellate review and improper judicial hyperactivity, by contrast, is considerably clearer and more easily administered. The proper role of an appellate court is to decide appeals from other tribunals, either lower courts or administrative agencies.⁷ In deciding those appeals, the appellate court usually should consider only the evidence before the lower court or administrative agency.⁸ The appellate court should not find facts; instead, it should review the fact-finding of the lower tribunal.⁹ The appellate court should decide the appeal based on the decision below and on the arguments presented by the parties. It is usually easy enough to see when a court has gone beyond the factual record presented to the trier of fact below and the issues briefed by the litigants before it to engage in fact-finding, evidentiary weighing, and advocacy of its own.

Judicial hyperactivity is not as rare as it is unfortunate. The Federal Circuit is a court of specialized and limited jurisdiction.¹⁰ Not surprisingly, obvious opportunities for judicial *activism* present themselves comparatively rarely on the docket of Federal Circuit patent cases.¹¹ But the same specialized jurisdiction that helps insulate the judges of the Federal Circuit from the temptation to engage in judicial activism may motivate them to indulge in judicial hyperactivity. The familiarity and expertise of the Federal Circuit judges with issues common to the court’s specialized jurisdiction may lead them more readily to usurp the fact-finding role.¹² Almost since its inception, the Federal Circuit has been dogged with criticism for straying from the path carefully delineated for appellate tribunals.¹³ Disappointed litigants and commentators alike have

criticized the court for fact-finding and other forms of hyperactive judging.¹⁴ Increasingly, the bar is expressing concern over the court's decision-making procedures and its apparent willingness to take over the roles of patent examiner, advocate and trier of fact.¹⁵ As we will show, from time to time the Federal Circuit has, with legitimate cause, expanded the scope of its jurisdiction consciously and explicitly. The expansion we discuss in this article, however, is of a far less overt (if perhaps not less deliberate) sort. Bearing in mind that not all expansion of Federal Circuit jurisdiction is necessarily judicial hyperactivity, we turn now to examine each of the concerns noted above.

1. The Federal Circuit As Patent Examiner

The Federal Circuit's recent opinion in *In re Cortright*¹⁶ has fueled anew the bar's concern over the Federal Circuit's penchant for stepping out of its appellate role. The case came to the court as a garden-variety appeal by a patent applicant from the decision of the Board of Patent Appeals and Interferences ("Board"). The Board had affirmed a patent examiner's rejection of patent claims directed to a method of treating baldness by rubbing the scalp with "Bag Balm," a product used by dairy farmers to soften cow udders.¹⁷ The Board had concluded that the patent application did not enable the claimed invention because the treatment was not shown to "restore hair growth," as specified in the claims.¹⁸ On appeal, the Federal Circuit reversed the Board's decision, holding that the Board had incorrectly interpreted the claim limitation "restore hair growth" to require that the treatment return the user's hair to its original state.¹⁹ The court ruled that the Board had erred in failing to interpret the claim limitation as one of ordinary skill in the art would have done.²⁰

But here's the rub: to establish how one of ordinary skill in the art would interpret the "restore hair growth" limitation, the court looked to the use of that term in three patents that were not cited or considered by the patent examiner, Board, Patent and Trademark Office ("PTO") Solicitor, or patent applicant.²¹ Apparently, the court conducted its own patent and literature search in order to identify publications that supported its interpretation of the claim limitation.²² Patent and literature searching, needless to say, is usually the province of the applicant or the patent examiner, not an appellate court.

The reaction to *Cortright* was a mix of bemusement and concern. One publication, in a wry understatement, labeled the *Cortright* opinion a "surprising appellate court approach to claim construction."²³ The less sanguine—among whom, no doubt, one could find much of the PTO's staff and the patent bar—were slack-jawed over the obvious implication of the *Cortright* opinion: "that a court is as free to examine previous patents in construing claims as it is to examine court opinions in construing statutes."²⁴

In response to the panel decision in *Cortright*, the PTO Solicitor filed a petition for panel

rehearing. The Solicitor offered a number of grounds for reconsideration. First, noting that the panel had considered a total of thirteen patents and two newspaper articles that were not before the Board, he argued that the panel decision violated the statute requiring the court to review the Board's decisions "on the record before the Patent and Trademark Office."²⁵ Second, in a related argument, the Solicitor noted that the panel decision was contrary to numerous cases in which the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, had refused to consider patents not considered by the Board, even when urged to do so by one of the parties.²⁶ Third, and more fundamentally, the Solicitor relied upon "the well-established general rule prohibiting an appellate court's reliance on materials outside the record."²⁷ "Simply put," the Solicitor argued, "an appellate tribunal cannot so fundamentally change the record on appeal to reverse an administrative agency."²⁸

The Solicitor's brief acknowledged that the rule against going outside of the record made in the lower court or other tribunal is not absolute, but argued that neither of the two recognized exceptions to the general rule applied in this case. The first exception allows an appellate court to take judicial notice of materials outside the record under Federal Rule of Evidence 201.²⁹ "Judicial notice is an evidentiary procedure for recognizing without proof the existence and truth of certain *facts* which are regarded as a matter of common knowledge or which could be instantly and unquestionably demonstrated."³⁰ The Federal Circuit has often taken judicial notice of law,³¹ publicly available documents,³² dictionary and other reference work definitions,³³ and facts.³⁴ But, the Solicitor argued, the judicial notice exception did not apply in *Cortright* for several reasons: the panel nowhere said that it was taking judicial notice of the extra-record patents and articles;³⁵ the court has in the past refused to take judicial notice of patents raised for the first time on appeal;³⁶ judicial notice would extend only to undisputed information about the patents and articles, not to the disputed meaning of a claim term;³⁷ and the PTO was not given an opportunity "to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed" as required by Rule 201(e).³⁸

The second exception allows an appellate court to rely on extra-record materials "in the interests of justice."³⁹ But, as the Solicitor argued in *Cortright*, this exception applies only in extraordinary cases that involve misrepresentation, wrongdoing or omission, facts not involved in *Cortright*.⁴⁰ Although the patent applicant argued that the "interests of justice" were implicated,⁴¹ it was undisputed that the applicant had not cited or argued these patents or articles to the examiner, Board or Federal Circuit. Nor did the applicant suggest the existence of misrepresentation, wrongdoing or omission, or any other reason why the extra-record materials should be considered "in the interests of justice."⁴²

This is not to say that no argument could be made for the Federal court's hyperactivity in *Cortright*. The court reached out to the extra-record materials in order to arrive at a patent claim construction. Because the public will rely on the court's claim construction, there is arguably a

public interest in ensuring that the construction be correct. The defect in this argument is that if the Federal Circuit had allowed the rejection of the claims to stand, the applicant would have been forced to return to the PTO to negotiate claim language on which he and the PTO could agree.⁴³

In any event, the *Cortright* panel denied rehearing without issuing an opinion.⁴⁴ Consequently, the PTO and bar are left to wonder why the court did what it did, and to what extent the Federal Circuit now feels free, sua sponte, to consider not only new issues arising out of facts in the record of the proceedings below (but never briefed by either side), but also materials outside the record altogether, as it did in *Cortright*.⁴⁵ Given the large number of sources to which the court could in theory turn for new evidence, only one thing is now certain: to find out whether the Federal Circuit will undertake the effort to create a new record on appeal in any specific case, one must pursue an appeal.

1. The Federal Circuit As Advocate

As a general rule, an appellate court will not consider an argument for the first time on appeal.⁴⁶ The Federal Circuit has been as eloquent as any court in articulating the rule and describing its basis:

A party's argument should not be a moving target. The argument at the trial and appellate level should be consistent, thereby ensuring a clear presentation of the issue to be resolved, an adequate opportunity for response and evidentiary development by the opposing party, and a record reviewable by the appellate court that is properly crystallized around and responsive to the asserted argument.⁴⁷

This rule arises from concerns for fundamental fairness long recognized by the United States Supreme Court.⁴⁸ Refusing to consider new arguments on appeal ensures that ““parties may have the opportunity to offer all the evidence they believe relevant to the issues . . . [and] in order that litigants may not be surprised on appeal by final decision there of issues upon which they have had no opportunity to introduce evidence.””⁴⁹

The Federal Circuit has also emphasized that appellate courts normally limit themselves to issues that the parties have preserved below and raised on appeal.⁵⁰ Application of this rule “frees trial courts to focus on the factual and legal issues the parties identify as being in dispute, without having to worry that a misstep on an issue not disputed or objected to by the parties will result in a reversal.”⁵¹ This rule also lets “appellate courts focus on issues that the trial courts have expressly ruled on and that the parties have briefed on appeal, rather than having to venture opinions regarding issues that have never been briefed, argued, or even adverted to in the course of the proceedings.”⁵²

The Federal Circuit, however, has recently given short shrift to the general rule against considering arguments for the first time on appeal, instead grounding an increasing number of its dispositions on arguments raised by a party for the first time on appeal or, sometimes, arguments not made on appeal by either party. For example, in one recent case, *Rodime PLC v. Seagate Technology, Inc.*,⁵³ the Federal Circuit reversed a grant of summary judgment of patent noninfringement because the district court had erred in concluding that the patent claim limitation at issue was a “means-plus-function” limitation governed by 35 U.S.C. § 112 ¶ 6.⁵⁴ Significantly, neither the patentee nor the accused infringer argued to the Federal Circuit that the subject limitation was anything other than a means plus function limitation. Sua sponte, the Federal Circuit reversed the district court on an issue that no one raised on appeal.⁵⁵

The Federal Circuit explained its action by noting that:

Before the district court, Rodime argued that the “positioning means” element did not invoke § 112, ¶ 6. . . . On appeal, however, Rodime appears to have conceded this threshold issue. . . . That conversion, however, does not relieve this court of its responsibility to interpret the claims as a matter of law.

To be sure, the Federal Circuit is not bound by the parties’ stipulations of law.⁵⁶ And, of course, the court does have the power to consider new arguments on appeal.⁵⁷ But it has stated repeatedly that it is reluctant to do so, and that it will do so only in certain narrowly defined circumstances, such as “when necessary to avoid manifest injustice,”⁵⁸ when the issue is one of pure law⁵⁹ (as contrasted with claim construction, for example, which is a question of law based on underlying factual findings), or when the argument goes to jurisdiction.⁶⁰

As with *Cortright*, the Federal Circuit’s hyperactivity in *Rodime* could arguably find justification in the importance of claim construction—an issue of law—to the public at large. The Federal Circuit’s claim construction would likely follow the patent and be relied on by the public. The importance of this public notice function indubitably gave rise to the Federal Circuit’s sense of “responsibility to interpret the claims as a matter of law.”⁶¹

This “responsibility,” however, is apparently not absolute. In a similar case that pre-dated *Rodime*, the Federal Circuit noted that neither party had raised a particular claim construction issue but refrained from addressing that issue other than to note: “Because that question was not presented, and because the claimed invention as argued would have been obvious at the time it was made to those skilled in the art, we need not and do not decide the question here.”⁶² In another pre-*Rodime* opinion, this one *per curiam*, the court noted that “where, as here, the parties agree to a particular construction of the claims which is adopted by the district court, and neither party disputes that construction on appeal, this court declines to raise an issue sua sponte which the parties have not presented on appeal.”⁶³ In a concurrence, however, one panel member opined

that because claim construction is an issue of law the court has an obligation to review it.⁶⁴ In another concurrence to the same opinion, the other two panel members rejected this assertion.⁶⁵ Likewise, in a similar case that *post*-dated *Rodime*,⁶⁶ the court noted its concern with the claim construction but stated that “where, as here, the parties agree to a claim construction that is adopted by the district court, and neither party disputes that construction on appeal, we decline to raise an issue *sua sponte* that the parties have not presented.”⁶⁷

Now the bar is left to wonder why and when the court will consider arguments raised for the first time on appeal and arguments not made by either party but concocted by the court itself. Once again, the only way to find out is to take an appeal.⁶⁸

1. The Federal Circuit As Fact-Finder

As an appellate court, the Federal Circuit’s role is not to hear evidence *de novo*.⁶⁹ Fairness to the litigants weighs against reconsideration of the facts at the appellate level.⁷⁰ Appellate fact-finding would undermine the lower tribunal’s legitimacy, increase the number of appeals by encouraging litigants to retry cases at the appellate level, and needlessly reallocate judicial authority.⁷¹

Not long after it was first constituted, the Federal Circuit was criticized for fact-finding. That criticism came both from the bar⁷² and from within the court itself.⁷³ In response to these complaints, the Supreme Court sent a case back to the Federal Circuit, publicly questioning whether the panel had engaged in impermissible fact-finding:⁷⁴

Petitioner contends that the Federal Circuit ignored Federal Rule of Civil Procedure 52(a) in substituting its view of factual issues for that of the District Court. . . . Petitioner’s claims are not insubstantial. . . . The Federal Circuit . . . did not mention Rule 52(a), did not explicitly apply the clearly-erroneous standard to any of the District Court’s findings on obviousness, and did not explain why, if it was of that view, Rule 52(a) had no applicability to this issue.⁷⁵

Chastened by this public rebuke, the Federal Circuit studiously avoided at least overt fact-finding for years. It would appear, however, that the court might now be backsliding,⁷⁶ most often by reaching out to make factual findings as an alternative to remanding a case to be considered anew in the district court. As we will discuss, this is problematic enough when the court engages in fact-finding on the basis of arguments presented and considered below and urged again by one of the parties on appeal. We shall also explore a particularly troubling case in which the Federal Circuit not only engaged in fact-finding but did so pursuant to a claim construction never urged by either party to the appeal.

1. The Temptation to Find Facts Rather than Remand

While this article does not purport to offer a comprehensive review of all instances of judicial hyperactivity in the Federal Circuit, the cases we have reviewed suggest that the Federal Circuit is particularly tempted to engage in appellate fact-finding when deciding whether to remand after a reversal of a trial court's decision, and when reviewing a grant of summary judgment where there was no cross motion for summary judgment. We shall consider these two situations in turn.

1. *Remand for new findings*

While the occasional dissent charges the panel majority with appellate fact-finding in other contexts,⁷⁷ fact-finding is particularly dangerous when the court relies on its own findings of fact to avoid remand. If an appellate court determines that the lower tribunal failed to make a necessary finding or sets aside the lower tribunal's fact-findings, then the appellate court generally should remand to the lower tribunal to make the necessary findings.⁷⁸ It is not the role of the appellate court to make factual findings on its own.⁷⁹

There is one exception—or, more precisely, one refinement—to the general rule favoring remand: remand is not necessary in cases where “the record permits only one resolution of the factual issue.”⁸⁰ Strictly speaking, this determination is not fact-finding at all. Courts may decide cases as a matter of law where the undisputed facts admit of only one conclusion.⁸¹ In arriving at such a conclusion, the court—be it a trial court or an appellate court—is not engaged in fact-finding.⁸²

Picking up on this “exception,” the Federal Circuit has suggested on several occasions that it is free to decide a case, instead of remanding, where the record is clear and the facts uncontradicted.⁸³ Even where the evidence is disputed, the Federal Circuit feels free to decide the case when “the court could only make one finding of fact or decide the fact in only one way.”⁸⁴ But whether the record is clear and whether a fact could be decided in only one way are often subjects of dispute, and the “clear record” exception to remand “leaves much room for abuse.”⁸⁵ The Federal Circuit's interpretation of what findings are clear on the record, some fear, could expand and contract at the court's whim.⁸⁶

The Federal Circuit is particularly tempted to avoid remand in cases where it rejects the lower tribunal's foundational decision on claim interpretation or literal infringement. For example, in *Pall Corp. v. Hemasure, Inc.*,⁸⁷ the court reversed the district court's grant of summary judgment of literal infringement and, even though the district court had not reached the issue, went on to enter judgment of noninfringement, in effect granting the defendant's cross-motion for summary judgment.⁸⁸ Because there was no dispute as to the structure of the accused device, and because the parties argued infringement under the doctrine of equivalents on summary judgment, the Federal Circuit resolved the issue, finding no infringement under the doctrine of equivalents.⁸⁹ This resolution was not unreasonable under these limited circumstances. This willingness to

address issues on which the lower tribunal has not passed, however, can quickly go too far.

For example, in one early case the Federal Circuit avoided remand because “the record is relatively short and the legal and factual issues are uncomplicated and not difficult to resolve.”⁹⁰ Clearly, this goes too far and reeks of impermissible fact-finding. That a factual issue is uncomplicated or not difficult to resolve does not mean that that issue could be decided in only one way.

In a more recent case,⁹¹ which the court remanded for a finding on infringement after reversing the district court’s claim interpretation, Judge Lourie dissented, arguing that under the proper claim interpretation, the accused device “clearly” did *not* meet the disputed claim limitation, either literally or under the doctrine of equivalents.⁹² But even if the technical subject matter were, as Judge Lourie stated, “readily understandable,”⁹³ the factual finding of infringement is best made in the first instance by the trial court because at least one of the litigants might well disagree with the appellate court’s “understanding” of the facts, regardless of how “readily understandable” the technical subject matter.⁹⁴

1. ***Sua sponte grant of summary judgment***

Appellate courts are also tempted to exhibit judicial hyperactivity when reviewing a grant of summary judgment where there was no cross motion for summary judgment. Reversal of the grant of summary judgment should be accompanied by a remand for the district court to proceed with the case. Sometimes, however, an appellate court comes to believe that its reversal of the grant of summary judgment warrants more than a mere remand. Judicial hyperactivity results when that belief is translated into action.

The Federal Circuit has engaged in such hyperactivity. For instance, in *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*,⁹⁵ the Federal Circuit considered a district court’s grant of summary judgment of literal infringement, along with the patentee’s argument that even if the Federal Circuit disagreed with the grant of summary judgment of literal infringement, it could still affirm the judgment on the ground of infringement under the doctrine of equivalents.⁹⁶ The Federal Circuit did disagree with the district court on literal infringement and was willing to consider the doctrine of equivalents even though the district court had not reached it, but the court did not agree that the evidence on summary judgment showed infringement under the doctrine of equivalents.⁹⁷ Rather than simply reversing the district court’s grant of summary judgment, however, the Federal Circuit went on to direct the district court to enter summary judgment of noninfringement.⁹⁸ This result was surprising for several reasons, not the least of which was that the accused infringer had never even moved for summary judgment of noninfringement.

The *Chiuminatta* opinion justified the Federal Circuit’s *sua sponte* grant of summary judgment by

citing a Ninth Circuit case for the proposition that “a court may sua sponte grant summary judgment to the nonmoving party where the moving party cannot prove its case on the undisputed facts.”⁹⁹ The problem with the Federal Circuit’s reliance on this precedent is two-fold. First, the Ninth Circuit was addressing a sua sponte grant of summary judgment by a trial court, not an appellate court. The Ninth Circuit authority does not support an appellate court’s sua sponte grant of summary judgment.

Second, even as to the trial court’s ability to grant summary judgment sua sponte, the Federal Circuit grossly mischaracterized Ninth Circuit law. Under Ninth Circuit law, a trial court may grant summary judgment sua sponte against a nonmoving party only if that party was “given reasonable notice that the sufficiency of his or her claim will be in issue.”¹⁰⁰ “Reasonable notice implies adequate time to develop the facts on which the litigant will depend to oppose summary judgment.”¹⁰¹ On appeal, however, the record is—or should be—fixed by the record that was before the district court.¹⁰² Unless the appellate court is willing to take on the entirely improper role of receiving from the moving party additional evidence to oppose summary judgment, the moving party cannot be afforded the required notice. A court should grant summary judgment sua sponte only if it has given the moving party reasonable notice and an opportunity to submit evidence to oppose the grant. An appellate court simply cannot do that.

It is easy to understand the Federal Circuit’s motivation to grant summary judgment sua sponte in *Chiuminatta*. By explaining that the determination of no literal infringement precluded a finding of infringement under the doctrine of equivalents, the Federal Circuit saved the trial court the effort of determining that result for itself.¹⁰³ The *Chiuminatta* patentee had argued for summary judgment of infringement under the doctrine of equivalents and, the Federal Circuit decided, failed to present evidence on which a reasonable jury could find for it on that issue. The patentee had its one bite at the apple; fairness—it might be said—dictates that it not be given another.

Appealing as this argument may be, however, the Federal Circuit should not be able to grant summary judgment sua sponte where the trial court could not. Because the Federal Circuit cannot to give meaningful notice to the movant, its sua sponte grant of summary judgment will strike the movant as at least unfair and possibly as a denial of due process.¹⁰⁴ The availability of that outcome will spur disappointed nonmovants to appeal, seeking the grant of a summary judgment for which they never asked. As a result, appeals will increase while confidence in the court decreases.

1. ***Exxon v. Lubrizol*: the Federal Circuit Succumbs to a Double Temptation**

The damage of appellate fact-finding increases as the Federal Circuit, appearing increasingly comfortable with its de facto role as the final arbiter of patent law and procedure, becomes more willing to adopt claim constructions that were not advocated by the parties or adopted by the trial

court. An example of this form of judicial hyperactivity is *Exxon Chemical Patents v. Lubrizol Corp.*,¹⁰⁵ where the Federal Circuit rejected the trial court's interpretation of the patent claims, as well as those of both parties.¹⁰⁶ Accordingly, the Federal Circuit vacated the trial court's judgment in favor of the patentee. The court went on to state that "[w]hen we determine on appeal, as a matter of law, that a trial judge has misinterpreted a patent claim, we independently construe the claim to determine its correct meaning, and then determine if the facts presented at trial can support the appealed judgment."¹⁰⁷

The Federal Circuit explained that if the facts presented at trial cannot support the judgment under the Federal Circuit's claim construction, "we reverse the judgment below without remand for a second trial on the correct law."¹⁰⁸ That is what the court did, relying on *Boyle v. United Technologies Corp.*,¹⁰⁹ a case in which the Supreme Court held that a circuit court could reverse without remand if the evidence presented at trial would not support the jury verdict for the plaintiff under the properly formulated defense.¹¹⁰ The *Boyle* Court considered it irrelevant that the defendant had not objected to a jury instruction that supported the verdict and that the circuit court had adopted the formulation of the defense for the first time in that very case.¹¹¹ The Court remanded to ensure that the circuit court had not improperly assessed on its own whether the defense had been established but had properly decided that no reasonable jury could, under the properly formulated defense and the facts presented, have found for the plaintiff.¹¹² The *Boyle* holding, therefore, supports the Federal Circuit's reversal without remand in *Exxon*.

The troubling aspect of the Federal Circuit's opinion is the threshold determination to adopt a claim construction advanced by neither of the parties at trial.¹¹³ As the dissent in *Exxon* argued, "[b]y advocating a different interpretation of the claim sua sponte, the majority required *Exxon* to litigate during trial not only its opponent's position but also the unknowable position of the appellate court."¹¹⁴ Consequently, argued the dissent, the defendant won on a claim interpretation that it could never have raised on appeal because that interpretation was not argued in the motions for judgment as a matter of law.¹¹⁵ Further, by applying its own interpretation to the facts, the Federal Circuit intruded on the role of the jury. As one commentator suggests, "[I]f the [Federal Circuit] persists in applying its own interpretation of the claims to the facts without a new trial, there truly is no remaining purpose for a jury in this process."¹¹⁶

Of course, the extent to which the *Exxon* court's claim construction differed from those of the parties was the subject of disagreement, with the panel majority asserting that its interpretation was "but a slight variance from that urged" by one of the parties.¹¹⁷ The further the position adopted by the Federal Circuit from those advanced by the parties at trial, the more incongruous reversal without remand seems.¹¹⁸ The more willing the Federal Circuit is to hold that no reasonable jury could find facts to support the Federal Circuit's claim construction—without ever giving a jury (reasonable or not) a chance to do so—the more the court appears to assume the jury's fact-finding role. Indeed, some Federal Circuit opinions read almost like trial court

opinions, weighing conflicting evidence as if the court were a “super-juror,” with only a nod to the standard that no reasonable jury could find one way or the other.¹¹⁹

The Federal Circuit’s temptation to resolve cases instead of sending them back to the trial court for factual findings is understandable. Resolution by the appellate court avoids “unnecessary remand, for the perfunctory task of making fact-findings that are clear on the record.”¹²⁰ Otherwise, “protracted litigation and unnecessary delay and expense would occur.”¹²¹

Although judicial economy is both a laudable goal and a powerful argument, appellate fact-finding will lead to more protracted litigation, not less. If the Federal Circuit were free to find its own facts in considering arguments not raised or resolved below, the appellant would be encouraged to “shotgun” its appeal—that is, to raise as many issues as it possibly can in the space allowed, hoping that at least one will appeal to a hyperactivist panel. Encouraging this “scattershot” approach would reward belated legal creativity at the expense of the appellee, whose job should be nothing more than defending the decision reached below. Opening the door to new arguments on appeal ensures that neither party would be able to predict the facts, arguments or issues that would form the basis for the appellate court’s decision. Inevitably, this uncertainty would result in an increase in appeals, an effect directly opposite to the judicial economy that motivates Federal Circuit fact-finding.¹²²

1. The Expanding Role of the Federal Circuit

As we have shown, the Federal Circuit is exhibiting symptoms of judicial hyperactivity. Nevertheless, it would be unfair (and incorrect) to suggest that the Federal Circuit alone is responsible for its judicial hyperactivity, or that every case in which the court’s jurisdiction is expanded necessarily presents a case of judicial hyperactivity.

Part of the responsibility rests on the Supreme Court. For example, by confirming that claim construction is an issue of law for the court to decide, the Supreme Court’s ruling in *Markman v. Westview Instruments*¹²³ plainly hastened the Federal Circuit’s move toward greater involvement as an appellate tribunal in the sorts of de novo review that have tempted the court to take on the role of advocate. In the first year or so after the *Markman* decision, it appeared that the Federal Circuit was reversing and remanding to the lower courts over a third of the claim constructions it reviewed.¹²⁴ While some observers have attributed this high rate of reversals to district court judges’ unfamiliarity with complex technical issues and their apparent unwillingness to properly construe patent claims,¹²⁵ others have criticized the Federal Circuit’s close review under the de novo standard as a “constitutionally troubling” effort to limit the role of juries in patent cases.¹²⁶

To be sure, “[c]haracterization of an issue of law application as fact or law for purposes of identifying a formalized standard of review depends on the perceived need for review, not on the

actual status of the issue.”¹²⁷ In other words:

findings of fact may be defined as the class of decisions we choose to leave to the trier of fact subject only to limited review, while conclusions of law are the class of decisions which reviewers chose [sic] to make for themselves without deference to the judgment of the trial forum.¹²⁸

Because the Federal Circuit’s labeling of issues as fact or law is the exercise of its appellate judicial power, albeit in a way that some would criticize, these decisions do not raise concerns of judicial hyperactivity unless the Federal Circuit declares something a question of fact, then resolves the factual dispute instead of remanding for fact-finding below. Judicial expansion involving only the labeling of issues is therefore beyond the scope of this article.

Also beyond the scope of this article is the extent of review of fact-finding that the court engages in under the Rule 52(a) clearly erroneous standard of review,¹²⁹ which by its nature is subject to adaptation “to the shifting needs of different cases, different laws, and different times.”¹³⁰ We pause only to note that the Federal Circuit’s expertise in patent law weighs heavily on the level of review of factual findings under Rule 52(a). We are certainly not the first to recognize that “[d]ifferent kinds of fact-finding choices give rise to more or less penetrating review according to the relative capacities of district courts and appellate courts in many dimensions.”¹³¹ It is beyond dispute that the judges of the Federal Circuit often can bring to bear special technical expertise that makes their review of factual findings “more” rather than “less penetrating.” Indeed, the notion that Rule 52(a) actually forces appellate courts to defer to the district court’s fact-finding, or that the Seventh Amendment forces appellate courts to defer to jury fact-finding, may be considerably inflated.¹³²

Moreover, while we might agree with those who have seen a creeping tendency in Federal Circuit cases to expand the scope of the court’s substantive and procedural jurisdiction,¹³³ that too is not the sort of activism that fits neatly within the rubric of cases we have discussed here. The precise contours of the substantive and procedural laws to be applied by the court will depend upon the circuit out of which the appeal arises, and the line between issues that “arise under the patent laws” and those that do not can be hard to administer.¹³⁴ This urge to expand the scope of subject matter areas to which the court applies its own law, rather than regional law, is not an example of judicial hyperactivity as we perceive it. Formal reallocation of the decision-making authority from the regional circuit courts to the Federal Circuit, although of concern to many, is more akin to traditional judicial activism.

1. Conclusion

The United States Court of Appeals for the Federal Circuit is an intermediate appellate court, not a trial court or an administrative agency. It has no business conducting patent searches or

otherwise examining patent applications. Its judges are not appointed to create new arguments raised by neither of the parties in order to justify reversing a lower court or an administrative agency. It is not the Federal Circuit's job to find facts. To the extent it engages in these activities, the Federal Circuit dramatically reduces certainty and predictability in patent appeals.¹³⁵ This in turn will cause the number of appeals to continue to increase as disappointed litigants are encouraged to roll the dice¹³⁶ in hope that the Federal Circuit will conduct its own patent search or examine the patent application afresh, think up some new arguments that had not occurred to counsel, or find facts not found by the lower tribunal.

In connection with its patent jurisprudence, the Federal Circuit is—most deservedly—a highly respected court, performing a difficult task in a very important arena of the law. The unique and specialized jurisdiction and expertise of the Federal Circuit, however, may be one of the factors contributing to the court's hyperactivist tendencies. Other contributing factors may include the public interest in claim construction and the desire for judicial economy. Understandable though the temptation in particular cases may be, fact-finding, creating new records on appeal, and raising new arguments increase unpredictability and uncertainty, erode confidence in the courts, and ultimately encourage more unmeritorious appeals. It is for this reason that the Federal Circuit, like any other appellate court, should strive to confine its decision-making procedures to those traditionally associated with an appellate court, and leave patent searching, innovative advocacy and fact-finding to others.

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1 . The Federal Circuit is an intermediate appellate court in that it reviews decisions of trial courts and administrative agencies, and its decisions are subject to review by the United States Supreme Court. *See* 28 U.S.C. §§ 1254, 1295 (1994).

2 . The Federal Circuit's jurisdiction is defined by statute. *See* 28 U.S.C. § 1295 (1994).

3 . *See, e.g.*, Henry J. Abraham, *Justices and Presidents* 208-11 (3d ed. 1992).

4 . See, e.g., Robert H. Bork, *Slouching Towards Gomorrah: Modern Liberalism and American Decline* 115 (1996) (“[T]he Court is certain to be activist on the cultural left well into the next century.”).

5 . See, e.g., David F. Pike, *Court Redefined Judicial Activism Again This Term*, L.A. Daily J., July 1, 1999, at 1; David G. Savage, *New Conservative Activism Sweeps the Federal Courts Law: GOP-appointed Jurists Back States’ Power; Strike Rules on Clean Air, Youth Smoking, Rape Victims’ Right to Sue*, L.A. Times, June 22, 1999, at A1.

6 . Such criticism can come from within the court itself. “It is policy choices that lead to departure from precedent, into the judicial activism that weighs against legal stability,” observed Federal Circuit Judge Pauline Newman, warning against “policy-driven activism whereby the application of the law will not be known until the Federal Circuit hears the case.” Pauline Newman, *The Federal Circuit, Judicial Stability or Judicial Activism?*, 42 Am. U. L. Rev. 683, 688 (1993).

Nor, certainly, is the charge of judicial hyperactivity saved for the Federal Circuit alone. Professor Erwin Chemerinsky has observed a similar sort of procedural overreaching—what he calls “the new judicial activism”—in recent decisions of the United States Supreme Court. See Erwin Chemerinsky, *The New Judicial Activism*, Cal. Law., February 2000, at 25, 26. Professor Chemerinsky points to the recent decisions in *Kolstad v. American Dental Association*, 527 U.S. 526 (1999), and *Reno v. Arab-American Anti-Discrimination Committee*, 525 U.S. 471 (1999), as examples of the Supreme Court stepping out of its traditional appellate role to decide questions as to which certiorari had not been granted, and which had neither been addressed by the lower courts in deciding the case, nor briefed or argued by the parties. This, according to Professor Chemerinsky, amounts to “flouting the basic elements of the appellate process for no apparent good reason by reaching out to decide major legal issues that have not been ruled upon by the lower courts.” Chemerinsky, *supra*, at 25. Professor Chemerinsky’s observations underscore the fact that the Federal Circuit is by no means alone in the practice of judicial hyperactivity.

7 . “[T]he function of an appellate court is to correct errors committed at trial.” *Key Pharm. v. Hercon Lab. Corp.*, 161 F.3d 709, 715 (Fed. Cir. 1999). A second function is “to articulate and interpret legal rules that the lower courts must apply.” Maureen McGirr, Note, *Panduit Corp. v. Dennison Mfg. Co.: De Novo Review and the Federal Circuit’s Application of the Clearly Erroneous Standard*, 36 Am. U. L. Rev. 963, 963 n.3 (1987); see also Edward H. Cooper, *Civil Rule 52(a): Rationing and Rationalizing the Resources of Appellate Review*, 63 Notre Dame L. Rev. 645, 649 (1988) (“[T]he federal courts of appeals serve two functions: the correction of error in individual cases and the development of the law in ways that will guide future conduct and future litigation.”). These functions are not independent. “The declarative, legislative function of appellate courts can only be rightly exercised as a by-product of their more mundane corrective function.” J. Dickson Phillips, Jr., *The Appellate Review Function: Scope of Review*, Law & Contemp. Probs., Spring 1984, at 1, 6.

8 . “As the statute requires, our court decides on the record.” Howard T. Markey, *Trademarks on Appeal—A View From the Bench*, 66 Trademark Rep. 279, 282 (1976).

9 . See Cooper, *supra* note 7, at 657 (“[T]rial courts are primarily responsible for sifting the evidence and finding the facts, while appellate courts are primarily responsible for developing the law.”).

10 . The Federal Circuit was established in 1982, in part in an effort by Congress to foster uniformity in the application of the law of patents. See S. Rep. No. 97-275, at 5 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 15. Congress created the United States Court of Appeals for the Federal Circuit by enacting the Federal Courts

Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982). The Act effectively merged two existing Article III courts, the Court of Claims and the Court of Customs and Patent Appeals, expanding their mandate to give the new court exclusive appellate jurisdiction over most cases involving patent issues, as well as a host of other subjects. *See* 4 Donald S. Chisum, *Patents: A Treatise on the Law of Patentability, Validity, and Infringement* §11.06[3][e] (1999). The record of the time reflects three reasons motivating the creation of the new court: (1) relief of the regional circuit courts' appellate workload; (2) the hope that the new court would bring about greater uniformity in the development and application of the patent law; and (3) more effective use of existing federal judicial resources. *See id.* § 11.06[3][e][i].

11 . Until recently the court has not had a body of decisions large enough to provide a basis for a statistically significant analysis of its rulings. We would expect in the not too distant future to see empirical studies that will be able to assess the court's rulings and either confirm or deny the rather pervasive impression that the court is ideologically disposed to be "pro-patentee." For one interesting view of how "the numbers" play out, see Robert L. Harmon, *Patents and the Federal Circuit* app. 973-81 (4th ed. 1998). Mr. Harmon has collected some raw data on the reversal rate for patent cases in the Federal Circuit. For the period he analyzed, he found that an accused infringer who loses in the trial court had a one in seven chance of prevailing on appeal. By contrast, the patent holder had a nearly one in four chance of winning in the Federal Circuit what it could not win in the trial court. As Mr. Harmon observes: "an accused infringer had better win below [in the trial court]. And even then, it is not out of the woods." *Id.* at 980.

12 . In *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997), the Supreme Court noted the Federal Circuit's "special expertise" in patent law when it left to the Federal Circuit's "sound judgment in this area" the task of refining the formulation of the test for applying the doctrine of equivalents. In *Dickinson v. Zurko*, 527 U.S. 150, 155 (1999), the Supreme Court recognized that the Federal Circuit's experience extended beyond pure questions of patent law and procedure, and explicitly recognized the "import[ant] . . . fact that, when a Federal Circuit judge reviews PTO fact-finding, he or she often will examine that finding through the lens of patent-related experience—and properly so, for the Federal Circuit is a specialized court." According to the Supreme Court, in reviewing PTO determinations, this "comparative expertise" allows the Federal Circuit "better to understand the basis for the PTO's finding of fact" and "may play a more important role in assuring proper review" of those determinations. *Id.*

13 . *See, e.g.*, Douglas A. Strawbridge et al., *A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Area Summary: Patent Law Developments in the United States Court of Appeals for the Federal Circuit 1986*, 36 Am. U. L. Rev. 861, 875 (1987); McGirr, *supra* note 7, at 967, 980-81; Edward V. Filardi & Robert C. Scheinfeld, *Appellate Review of Patent Bench Trials: Is the CAFC Following Rule 52(a)?*, in *Current Developments in Patent Law 1985*, at 9, 14 & n.3 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 213, 1985). *See also infra*, notes 7273 -, and accompanying text.

14 . *See, e.g.*, Strawbridge et al., *supra* note 13, at 875 ("The Federal Circuit has had considerable difficulty adjusting to its role as a court of appeals under Rule 52(a).").

15 . The evidence for this assertion is largely anecdotal. Practitioners, being mindful of the fact that, in any given case, judicial hyperactivity will likely benefit one side or the other, are understandably reticent to voice strong criticisms of the court. Commentators have noted, however, the general tendency on the part of the Federal Circuit to take for itself the role of final arbiter of issues that, at least at one time, were fairly considered the province of the trial court and jury. For example, Ted D. Lee and Michelle Evans observe that, in applying the substantial evidence

standard:

when the Federal Circuit believes the jury verdict was correct, it simply holds that the substantial evidence test was met. On the other hand, when the Federal Circuit believes the jury verdict was wrong, it substitutes its opinion for that of the jury and simply states that the substantial evidence test was not met.

Ted D. Lee & Michelle Evans, *The Charade: Trying a Patent Case to All “Three” Juries*, 8 Tex. Intell. Prop. L.J. 1, 14 (1999).

16 . 165 F.3d 1353 (Fed. Cir. 1999).

17 . *See id.* at 1355. The Federal Circuit’s opinion noted seven other patents identifying “more mundane materials” used for the same purpose, including Dead Sea mud; emu oil; potato peelings and lantana leaves; vitamin D3 and aloe; a salve of garlic powder, brewer’s yeast, grapefruit juice, acetic acid, and kelp; salves of sage, nettles, and aloe; and a salve of pine extract and bamboo extract or Japanese apricot. *See id.* at 1357 & n.1.

18 . *See id.* at 1355.

19 . *See id.* at 1359.

20 . *See id.*

21 . Petition for Rehearing for Appellee Commissioner of Patents and Trademarks at 2-3, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh’g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999).

22 . The court’s opinion does not mention whether the court conducted its own search, but the “prior art” on which the court relied, some of which was apparently not prior art, is not identified in the Board’s opinion or the briefs of the parties.

23 . *PTCJ Comment*, 57 Pat. Trademark & Copyright J. (BNA) 286 (1999).

24 . *Id.*

25 . Petition for Rehearing at 3-4 (citing 35 U.S.C. § 144 (1994)).

26 . *See id.* at 4-5 (citing *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) (dictum); *In re Nielson*, 816 F.2d 1567, 1571 (Fed. Cir. 1987) (dictum); *In re Margolis*, 785 F.2d 1029, 1031 (Fed. Cir. 1986) (dictum); *In re Moore*, 409 F.2d 585, 589 n.7 (CCPA 1969); *In re Land*, 402 F.2d 801, 804-05 & n.3 (CCPA 1968); *In re Phillips*, 315 F.2d 943, 945 (CCPA 1963)). The Federal Circuit’s adherence to stare decisis is considered in Matthew F. Weil & William C. Rooklidge, *Stare Un-Decisis: The Sometimes Rough Treatment of Precedent in Federal Circuit Decision-Making*, 80 J. Pat. & Trademark Off. Soc’y 791 (1998).

- 27 . Petition for Rehearing at 6 (citing *Boone v. Chiles*, 35 U.S. (10 Pet.) 177, 208 (1836); *Coplin v. United States*, 761 F.2d 688, 691 (Fed. Cir. 1985)).
- 28 . *Id.* at 5.
- 29 . Rule 201 allows a court to take judicial notice of adjudicative facts that are not subject to reasonable dispute because they are either generally known or “capable of accurate and ready resort to sources whose accuracy cannot be reasonably questioned.” Fed. R. Evid. 201(a)-(b). *See, e.g.*, *Massachusetts v. Westcott*, 431 U.S. 322, 323 n.2 (1977) (taking judicial notice of a fact not subject to reasonable dispute and readily verifiable after giving the parties an opportunity to comment and agree that such notice was proper). Judicial notice may be taken at any stage of the proceeding, including during appeal. *See* Fed. R. Evid. 201(f). Most often, facts are judicially noticed for the first time on appeal in order to avoid reversal. *See* 21 Charles Alan Wright & Kenneth W. Graham, Jr., *Federal Practice & Procedure* § 5110 (1977). Noticing facts for the first time on appeal to support reversal occurs in cases that “doubtless involve factors such as those that move courts to label a ruling below as ‘plain error’ so that it can be considered on appeal even though no objection was made at trial.” *Id.*
- 30 . *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1339 (C.C.P.A. 1981).
- 31 . *See, e.g.*, *Bronson v. United States*, 46 F.3d 1573, 1581 (Fed. Cir. 1995) (change in the bankruptcy law).
- 32 . *See, e.g.*, *Genentech, Inc. v. United States Int’l Trade Comm’n*, 122 F.3d 1409, 1417 n.7 (Fed. Cir. 1997) (court orders); *Ginsberg v. Austin*, 968 F.2d 1198, 1201 (Fed. Cir. 1992) (General Services Administration handbook); *Dodd v. Tennessee Valley Auth.*, 770 F.2d 1038, 1039 n.1 (Fed. Cir. 1985) (TVA report filed with President and Congress).
- 33 . *See, e.g.*, *Marquardt Co. v. United States*, 822 F.2d 1573, 1578 (Fed. Cir. 1987) (accounting text’s distinction between acquiring and acquired corporations); *Stewart-Warner Corp. v. United States*, 748 F.2d 663, 669 & n.17 (Fed. Cir. 1984) (dictionary definition of “bicycle”); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1447 & n.3 (Fed. Cir. 1984) (dictionary definition of “pressure sensitive adhesive”).
- 34 . *See, e.g.*, *Pyles v. Merit Sys. Protection Bd.*, 45 F.3d 411, 415 (Fed. Cir. 1995) (noting that loss of intellectual faculties denominated “dementia” is due to progressive organic brain diseases); *Sears Roebuck & Co. v. United States*, 22 F.3d 1082, 1087 n.8 (Fed. Cir. 1994) (noting that television cameras existed before broadcasting systems); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 897 F.2d 511, 514 n.3 (Fed. Cir. 1990) (noting the “adjudicative fact” of a first office action); *Beardmore v. Department of Agric.*, 761 F.2d 677, 679 (Fed. Cir. 1985) (noting distances between cities from an American Automobile Association map).
- 35 . Petition for Rehearing for Appellee Commissioner of Patents and Trademarks at 7, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh’g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999). Although Rule 201 does not require courts to state expressly when they take judicial notice of the extra-record facts, it is plainly preferable that a court do so. *See* Fed. R. Evid. 201(e) advisory committee’s note (“No formal scheme of giving notice is provided. An adversely affected party may . . . have no . . . notice at all. The likelihood of [such a failure of notice] is enhanced by the frequent failure to recognize judicial notice as such.”). A statement by the court in this case that it was taking judicial notice would have lent at least a modicum of procedural decorum to

what appears, without it, to be unconstrained fact-finding.

36 . See Petition for Rehearing at 7-8 (citing *Holmes v. Kelly*, 586 F.2d 234, 237 n.6 (C.C.P.A. 1978) (refusing to take judicial notice of a patent submitted by a party for the first time on appeal because Court charged by 35 U.S.C. § 144 with reviewing Board decisions on the evidence before the PTO); *Gellert v. Wanberg*, 495 F.2d 779, 782 (C.C.P.A. 1974) (refusing to take judicial notice of a patent because it was not of record and not considered by the Board); *In re Patrick*, 189 F.2d 614, 616 (C.C.P.A. 1951) (refusing to take judicial notice of a patent even though it was listed in a petition for reconsideration of a Board decision because it was not supplied to the Board)).

37 . See *id.* at 8 (citing *Hoganas AB v. Dresser Indus.*, 9 F.3d 948, 954 n.27 (Fed. Cir. 1993) (taking judicial notice of a related patent and, in particular, of the references cited on the face page of the patent, in order to establish that a particular reference was before the examiner who examined the patent)).

38 . *Id.* at 8 (quoting Fed. R. Evid. 201(e)). The most powerful of these arguments seems to be this last argument, to which appellant did not respond. See Answer for Appellant Cortright to Appellee Petition for Rehearing at 7-9, *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999) (No. 98-1258), *reh'g denied*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999). The PTO was, however, given an opportunity to be heard when the panel denied its petition for rehearing.

39 . See, e.g., *Dakota Indus. Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61, 63 (8th Cir. 1993); *United States v. Hope*, 906 F.2d 254, 260 n.1 (7th Cir. 1990). See also *Colonial Penn Ins. Co. v. Coil*, 887 F.2d 1236, 1239 (4th Cir. 1989) (taking judicial notice of extra-record information that was “relevant to a just and fair decision”).

40 . See Petition for Rehearing at 8-9 (citing *Dakota Indus., Inc. v. Dakota Sportswear, Inc.*, 988 F.2d 61, 63-64 (8th Cir. 1993); *Dickerson v. Alabama*, 667 F.2d 1364, 1367-68 (11th Cir. 1982); *Erkins v. Bryan*, 663 F.2d 1048, 1052 n.1 (11th Cir. 1981)).

41 . See Answer for Appellant at 9-10.

42 . The appellant provided no specific analysis of her claim that the action of the court fell within the “interests of justice” exception. Rather, citing a number of cases for the general proposition that an appellate court may take judicial notice, the appellant merely stated, in a conclusory fashion, “[w]hat the Panel did with respect to the interpretation of the word ‘restore’ here, clearly was within the exception of the ‘interests of justice’.” *Id.* at 9.

43 . Between the date of the Federal Circuit’s decision and its mandate, the applicant can file a continuing application under 35 U.S.C. § 120 and then prosecute that application. See 35 U.S.C. § 120 (1994); 37 C.F.R. § 1.197 (1999). In addition, she may make certain limited amendments, but not as of right. See 37 C.F.R. § 1.116(c) (1999).

44 . See *In re Cortright*, No. 98-1258, 1999 U.S. App. LEXIS 9001 (Fed. Cir. Apr. 20, 1999) (nonprecedential).

45 . The court’s pointed silence on the point raises the hope that this particular foray into judicial hyperactivity is an anomaly and not the beginning of a new trend.

46 . See *Finnigan Corp. v. United States Int’l Trade Comm’n*, 180 F.3d 1354, 1363 (Fed. Cir. 1999).

47 . *Id.* (citing *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997)).

48 . *See* *Hormel v. Helvering*, 312 U.S. 552, 556 (1941).

49 . *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1362 (Fed. Cir. 1998) (quoting *Hormel v. Helvering*, 312 U.S. 552, 556 (1941)) (alteration in original).

50 . *See* *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 852 (Fed. Cir. 1999) (Bryson & Newman, JJ., concurring).

51 . *Id.*

52 . *Id.*

53 . 174 F.3d 1294 (Fed. Cir. 1999), *cert. denied*, 120 S.Ct. 933 (2000). The Federal Circuit denied Seagate's petition for rehearing and declined Seagate's suggestion for rehearing en banc. *See* *Rodime PLC v. Seagate Tech., Inc.*, No. 98-1076, 1999 U.S. App. LEXIS 14193 (Fed. Cir. June 3, 1999). Seagate filed a petition for certiorari arguing, *inter alia*, that the Federal Circuit erred in reviewing the district court's claim construction de novo, without deference to the district court's findings. Seagate's criticism of the Federal Circuit's de novo review is bolstered by the fact that the parties did not argue the issue on appeal, and the court presumably did not have before it the expert testimony on which the district court based its claim construction. Without that testimony the Federal Circuit may have had difficulty in viewing the claim terms as one of ordinary skill in the art would view them.

54 . *See* *Rodime*, 174 F.3d at 1303.

55 . For the court to rely on an argument not raised by either party to support a reversal (such as in *Rodime*) or a dissent from an affirmance (*see, e.g.,* *Ritchie v. Simpson*, 170 F.3d 1092, 1099-1100 (Fed. Cir. 1999) (Newman, J., dissenting)) makes less sense than doing so to support affirmance. *See* *Wright & Graham, Jr.*, *supra* note 29 (arguing that “[w]here the issue of judicial notice is raised for the first time on appeal, the appellate court is faced with a conflict This dilemma disappears . . . when judicial notice is raised for the purpose of affirming the decision below.”) .

56 . *See* *Technicon Instr. Corp. v. Alpkem Corp.*, 866 F.2d 417, 421-22 (Fed. Cir. 1989).

57 . The Supreme Court has recognized that “[t]here may be exceptional cases or particular circumstances which will prompt a reviewing or appellate court, where injustice might otherwise result, to consider questions of law which were neither pressed nor passed upon by the court or administrative agency below.” *Hormel v. Helvering*, 312 U.S. 552, 557 (1941). The Supreme Court has announced no general rule, stating instead that “[t]he matter of what questions may be taken up and resolved for the first time on appeal is one left primarily to the discretion of the courts of appeals, to be exercised on the facts of individual cases.” *Singleton v. Wulff*, 428 U.S. 106, 121 (1976). Last term, the Supreme Court twice decided issues that had not been briefed by the parties or argued before the Court. *Pike*, *supra* note 5, at 5, and *Chemerinsky*, *supra* note 6, at 25-26, describe how in *Reno v. American-Arab Anti-Discrimination Committee*, 525 U.S. 471 (1999), the Court decided an issue that it announced it would not consider

when it took the case, and in *Kolstad v. American Dental Association*, 527 U.S. 526 (1999), the Court decided an issue that was not among the questions presented in the case and was neither briefed nor argued.

58 . *Braun, Inc. v. Dynamics Corp.*, 975 F.2d 815, 821 n.12 (Fed. Cir. 1992) (dictum).

59 . *See Bellotti v. Baird*, 428 U.S. 132, 143-44 n.10 (1976).

60 . *See Minnesota Chippewa Tribe v. United States*, 768 F.2d 338, 341 (Fed. Cir. 1985).

61 . As to such apparent importance, however, courts have at their disposal special procedures for requesting additional briefing and even expediting consideration of important and pressing matters. *See Chemerinsky, supra* note 6, at 26. The Federal Circuit is no exception to this rule.

62 . *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582 (Fed. Cir. 1983). *Accord Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1015 n.2 (Fed. Cir. 1998) (“[B]ecause neither party addresses the point, we shall assume that it is legally proper to apply the doctrine of equivalents to a claim drafted in means-plus-function form.”).

63 . *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999) (per curiam).

64 . *See id.* at 847 (Rader, J., concurring).

65 . *See id.* at 851-52 (Bryson & Newman, JJ., concurring) (“We have no duty, with respect to claim construction or any other nonjurisdictional legal issue, to address questions the parties have not preserved for appeal and have not presented as grounds for challenging or supporting the judgment of the trial court.”).

66 . *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999).

67 . *Id.* at 1348 n.2. In *WMS Gaming*, the district court had accepted a stipulation by the parties regarding the claim construction. *See id.* The Federal Circuit, however, is not bound by such stipulations. *See Technicon Instr. Corp. v. Alpkem Corp.*, 866 F.2d 417, 421-22 (Fed. Cir. 1989).

68 . Ironically, Judge Rader, the author of the *Rodime* opinion and *Seal-Flex* concurrence, has argued that the Federal Circuit’s lack of deference to trial courts will increase litigation, discourage settlement, and promote uncertainty. *See Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting).

69 . *See Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969) (“[A]ppellate courts must constantly have in mind that their function is not to decide factual issues *de novo*.”).

70 . *See Anderson v. City of Bessemer City*, 470 U.S. 564, 575 (1985).

71 . *See Fed. R. Civ. P. 52(a)* advisory committee’s note on 1985 Amendment.

- 72 . *See, e.g.*, Strawbridge et al., *supra* note 13, at 875 (“The Federal Circuit has had considerable difficulty adjusting to its role as a court of appeals under Rule 52(a.)”); McGirr, *supra* note 7, at 967, 980-81; Filardi & Scheinfeld, *supra* note 13e, at 14 n.3.
- 73 . *See, e.g.*, RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1449 (Fed. Cir. 1984) (Kashiwa, J., dissenting); Jones v. Hardy, 727 F.2d 1524, 1534-35 (Fed. Cir. 1984) (Kashiwa, J., dissenting).
- 74 . Dennison Mfg. Co. v. Panduit Corp., 475 U.S. 809, 811 (1986).
- 75 . *Id.* at 810-11.
- 76 . Even the federal government has recently accused the Federal Circuit of appellate fact-finding. *See, e.g.*, Hughes Aircraft Co. v. United States, 140 F.3d 1470, 1474 n.3 (Fed. Cir. 1998) (refusing to consider government’s allegations of appellate fact-finding because Supreme Court’s remand was limited).
- 77 . *See, e.g.*, K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1371 (Fed. Cir. 1999) (Rader, J., dissenting) (majority affirmed the decision below); Metric Constructors, Inc. v. Goldin, No. 95-1078, 1995 U.S. App. LEXIS 30300, at *23 (Fed. Cir. Oct. 20, 1995) (nonprecedential) (Nies, J., dissenting) (majority reversed and remanded); Malta v. Schulmerich Carillons, Inc., 952 F.2d 1320, 1343 (Fed. Cir. 1991) (Newman, J., dissenting) (majority affirmed the decision below).
- 78 . *See* *Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709, 713-14 (1986) (“If the Court of Appeals believed that the District Court failed to make findings of fact essential to a proper resolution of the legal question, it should have remanded to the District Court to make those findings.”); *Pullman-Standard v. Swint*, 456 U.S. 273, 291 (“When an appellate court discerns that a district court has failed to make a finding because of an erroneous view of the law, the usual rule is that there should be a remand for further proceedings to permit the trial court to make the missing findings.”); *DeMarco v. United States*, 415 U.S. 449, 450 n.1 (1974) (“[Fact-finding] is the basic responsibility of district courts, rather than appellate courts, and . . . the Court of Appeals should not have resolved in the first instance this factual dispute which had not been considered by the District Court.”). If, on the other hand, the lower tribunal’s fact-findings were unassailable but the proper rule of law was misapplied to those findings, the appellate court may reverse. *See Icicle Seafoods*, 475 U.S. at 714.
- 79 . *See Icicle Seafoods*, 475 U.S. at 714. As a consequence, in a case where the Federal Circuit rejected the district court’s basis for dismissing a declaratory judgment action seeking a declaration of patent noninfringement, the court remanded for findings on the plaintiff’s objectively “reasonable apprehension” of suit, even though the declarations on that issue were before the Federal Circuit. *International Med. Prosthetics Research Assoc., Inc. v. Gore Enter. Holdings, Inc.*, 787 F.2d 572, 577 (Fed. Cir. 1986).
- 80 . *Pullman-Standard*, 456 U.S. at 292 (dictum); *Ralls v. United States*, 52 F.3d 223, 1226 (9th Cir. 1995). *But see* Stuart Minor Benjamin, *Stepping into the Same River Twice: Rapidly Changing Facts and the Appellate Process*, 78 Tex. L. Rev. 269, 334 (1999) (arguing that rapidly changing facts can justify appellate fact-finding).
- 81 . Examples include summary judgment pursuant to Federal Rule of Civil Procedure 56 and judgment as a matter of law pursuant to Federal Rule of Civil Procedure 50. The assessment of the sufficiency of the evidence to support a

jury verdict or bench judgment is labeled a question of law, although it is necessarily a fact-based task. *See* Eric Schnapper, *Judges Against Juries—Appellate Review of Federal Civil Jury Verdicts*, 1989 Wis. L. Rev. 237, 299 (1989).

82 . *See* Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1020 (Fed. Cir. 1985) (“To engage in fact finding [in connection with a summary judgment motion] would be not only inappropriate, but would per se imply the impropriety of the grant.”). As the Court has observed:

[t]o affirm a grant of summary judgment, an appellate court must accordingly determine that the record demonstrates an absence of any actual dispute as to factual inferences which would have a material impact on the entitlement of the summary judgment movant to judgment as a matter of law For summary judgment, fact-finding is an inappropriate exercise, at either the appellate or the district court level.

Lemelson v. TRW, Inc., 760 F.2d 1254, 1260 (Fed. Cir. 1985).

83 . *See, e.g.*, Jones v. Hardy, 727 F.2d 1524, 1531-32 (Fed. Cir. 1984).

84 . SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 886 n.4 (Fed Cir. 1988).

85 . McGirr, *supra* note 7, at 980.

86 . *See id.*

87 . 181 F.3d 1305 (Fed. Cir. 1999).

88 . *See id.* at 1306.

89 . *See id.* at 1312. This was not a case like *MEHL/Biophile International Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999), where the Federal Circuit rejected the district court’s basis for grant of summary judgment but nevertheless *affirmed* the judgment on another ground that was briefed by the parties on summary judgment below but not decided by the district court.

90 . Baginsky v. United States, 697 F.2d 1070, 1074 (Fed. Cir.), *cert. denied*, 464 U.S. 981 (1983).

91 . Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc., 183 F.3d 1347 (Fed. Cir. 1999).

92 . *Id.* at 1360 (Lourie, J., dissenting).

93 . *Id.* at 1359.

94 . The potential for disagreement looms large because “left to their own devices, a large number of appellate judges

simply cannot resist acting like super-jurors, reviewing and revising civil verdicts to assure that the result is precisely the verdict they would have returned had they been in the jury box.” Schnapper, *supra* note 81, at 354. Fortunately, the notion that the Federal Circuit can decide the infringement issue for itself where the subject matter is “readily understandable” has so far remained confined to a dissenting opinion.

95 . 145 F.3d 1303 (Fed. Cir. 1998).

96 . The patentee was correct in its assertion that the Federal Circuit may affirm a judgment by relying on grounds briefed on summary judgment but not reached by the district court. *See* MEHL/Biophile Int’l Corp. v. Milgraum, 192 F.3d 1362, 1366 (Fed. Cir. 1999).

97 . *See Chiuminatta*, 145 F.3d at 1310-11.

98 . *See id.* at 1311.

99 . *Id.* (citing *Cool Fuel, Inc. v. Connett*, 685 F.2d 309, 311 (9th Cir. 1982)).

100 . *O’Keefe v. Van Boening*, 82 F.3d 322, 324 (9th Cir. 1996) (holding that consideration of a supplemental submission on a motion for reconsideration afforded the moving party fair notice of sua sponte summary judgment); *see also* *Buckingham v. United States*, 998 F.2d 735, 742 (9th Cir. 1982) (reversing sua sponte grant of summary judgment and remanding for further proceedings where adversely affected party was not given adequate notice).

101 . *O’Keefe*, 82 F.3d at 324; *see also* *Portsmouth Square, Inc. v. Shareholders Protective Comm.*, 770 F.2d 866, 869 (9th Cir. 1985) (holding that plaintiff had full opportunity to develop the facts in support of its case because its discovery was complete at the time of the pretrial proceedings).

102 . *See generally supra* Part I.

103 . The *Chiuminatta* panel declined to decide whether equivalence under 35 U.S.C. § 112 ¶ 6, is a question of fact or law. *See Chiuminatta*, 145 F.3d at 1309 (noting that the issue had been left open in *Markman v. Westview Instruments*, 52 F.3d 967, 977 n.8 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996)).

104 . In this regard, the appellate posture is entirely different from review of a trial court’s decision to grant or deny a motion for judgment as a matter of law after a jury trial, as in *Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1014-18 (Fed. Cir. 1998). In that situation, the appellee has been afforded every opportunity to submit its evidence on the issue. Nevertheless, one commentator suggests that “[w]here an appellate court identifies a defect in the evidence which was not perceived by the trial judge, it should leave to the trial court the choice between judgment n.o.v. and a new trial, unless special circumstances make such a remand clearly inappropriate.” Schnapper, *supra* note 81, at 310.

105 . 64 F.3d 1553 (Fed. Cir. 1995).

106 . *See id.* at 1556. Interpretation of patent claims is an issue of law. *See* *Markman v. Westview Instruments*, 52

F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

107 . *Exxon Chem. Patents*, 64 F.3d at 1560.

108 . *Id.*

109 . 487 U.S. 500 (1988).

110 . *See id.* at 513.

111 . *See id.* at 513-14.

112 . *See id.* at 514.

113 . *See generally supra* Part II.

114 . *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1569 (Fed. Cir. 1995) (Nies, J., dissenting).

115 . *See id.* at 1568. The majority held the appellant's motion for judgment as a matter of law adequate. *See id.* at 1561 n.6.

116 . Gregory D. Leibold, *In Juries We Do Not Trust: Appellate Review of Patent Infringement Litigation*, 67 U. Colo. L. Rev. 623, 670 (1996). Nor, one might add, is there much need for JMOL motions.

117 . *Exxon Chem. Patents*, 64 F.3d at 1560. The defendant interpreted the claim at issue to read only on "end product compositions." *Id.* at 1558. The Federal Circuit held that the claimed recipe ingredients must be present in the accused products "at some time," but not necessarily in the end product. *Id.*

118 . Likewise, when the Federal Circuit adopts a new procedural rule not applied by the trial court, remand would seem appropriate. *But see* *Lear Siegler v. Sealy Mattress Co.*, 873 F.2d 1422 (Fed. Cir. 1989) (reversing without remand after adopting a rule restricting the way in which patentees must prove infringement under the doctrine of equivalents in jury cases); *Malta v. Schulmerich Carillons, Inc.* 952 F.2d 1320 (Fed. Cir. 1991) (applying the *Lear-Siegler* rule to a pre-*Lear-Siegler* jury verdict and reversing without remanding).

119 . *See, e.g., Dawn Equip. Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1014-17 (Fed. Cir. 1998).

120 . McGirr, *supra* note 7, at 981.

121 . *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886 n.4 (Fed. Cir. 1988).

122 . *See Malta*, 952 F.2d at 1332 (Newman, J., dissenting) ("[B]roadening appellate review . . . impairs the confidence of litigants and the public in the decisions of the trial courts, and it multiplies the number of appeals.")

(citing Charles Alan Wright, *The Doubtful Omniscience of Appellate Courts*, 41 Minn. L. Rev. 751, 779 (1957))).

123 . 517 U.S. 370, 372 (1996).

124 . *See* Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1476 n.4 (Fed. Cir. 1998) (en banc) (Rader, J., dissenting) (noting that 47 of 126, or 37.3%, of Federal Circuit decisions reviewing the issue of claim construction were reversed between the date *Markman* was decided (April 5, 1995) and November 24, 1997).

125 . *See* Robert N. Young, *Judge Versus Jury On The Scales Of Justice: 35 U.S.C. § 112, ¶ 6 “Equivalents” In The Balance*, 32 J. Marshall L. Rev. 833, 857 (1999), and sources cited therein, including Margaret Cronin Fisk, *Confusion Follows ‘96 Landmark Patent Case: “Markman” Decision Didn’t Turn Out As Most Predicted*, Nat’l L.J., June 15, 1998, at A1 (noting that some district court judges construe patent claims narrowly to make summary judgment proper, effectively dumping the problem of claim construction on the Federal Circuit through appellate review); Philip J. McCabe & P. McCoy Smith, *Courts Order “Markman” Hearings Early In Cases: Such Hearings Often Precipitate A Party’s Request For Summary Judgment or a Settlement Order*, Nat’l L.J., Oct. 19, 1998, at C42 (noting that judges are pushing claim construction to an earlier time in the case to achieve quicker disposition).

126 . Leibold, *supra* note 116, at 625. *See generally id.* On the other hand, the Court’s labeling the obviousness issue as a question of law has been applauded as an appropriate way to achieve national uniformity in patent cases. *See* Cooper, *supra* note 7, at 668. Needless to say, the bar is not of one mind regarding the Federal Circuit’s treatment of jury verdicts in patent cases.

127 . Cooper, *supra* note 7, at 660.

128 . Carrington, *The Power of District Judges and the Responsibility of Courts of Appeals*, 3 Ga. L. Rev. 507, 518 (1969).

129 . *See* Fed. R. Civ. Proc. 52(a) (“Findings of fact . . . shall not be set aside unless clearly erroneous.”).

130 . Cooper, *supra* note 7, at 670.

131 . *Id.* at 646.

132 . *See generally* Schnapper, *supra* note 81.

133 . The Federal Circuit derives its special jurisdiction from 28 U.S.C. § 1295, which reads, in part, “The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction . . . of an appeal from a final decision of a district court . . . if the jurisdiction of the court was based, in whole or in part, on section 1338 of this title.” 28 U.S.C. § 1295 (1994). Section 1338, in turn, gives the district courts original jurisdiction of actions “arising under any Act of Congress relating to patents.” 28 U.S.C. § 1338 (1994). Thus, in deciding the cases before it, the Federal Circuit applies a hybrid of Federal Circuit and regional circuit law. On substantive questions “arising under the patent laws,” the Federal Circuit follows its own law; on procedural matters and substantive questions not central to its own patent jurisprudence, it is supposed to follow the law of the circuit of the district court from which the appeal was taken. *See* Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574 (Fed. Cir. 1984) (ruling as a matter of

law that procedural issues not unique to patent claims shall be decided according to law of regional circuit). *See, e.g.,* Manildra Milling Corp. v. Ogilvie Mills, Inc. 76 F.3d 1178, 1181 (Fed. Cir. 1996) (Federal Circuit law governs determination of when party is “prevailing” for purposes of cost award, but regional circuit law governs the district court’s exercise of discretion).

134 . *See* John Donofrio & Edward Donovan, Christianson v. Colt Industries Operating Corp.: *The Application Of Federal Question Precedent To Federal Circuit Jurisdiction Decisions*, 45 Am. U. L. Rev. 1835, 1837 (1996) (“It is not always clear whether a district court’s jurisdiction is based on an ‘Act of Congress relating to patents,’ and consequently the issue of whether an action should be appealed to the Federal Circuit or the regional circuit court is often murky.”). From time to time, Federal Circuit opinions will announce the addition of new issues to the list of those “arising under” the patent law, as the Federal Circuit sweeps more and more issues within the scope of its own jurisdiction. These can be issues as diverse as antitrust liability for conduct in procuring or enforcing a patent, *see* Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059 (Fed. Cir. 1998); preemption of state contract law by federal patent law, *see* Power Lift, Inc. v. Weatherford Nipple-up Sys., Inc., 871 F.2d 1082 (Fed. Cir. 1989); the reviewability on appeal of jury findings in a patent trial, *see* Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850 (Fed. Cir. 1991); and the burdens and standards of proof on laches and estoppel, *see* A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020 (Fed Cir. 1992) (en banc).

135 . The need for “a tolerable degree of confidence and certainty,” particularly in view of the perpetually high cost of patent litigation has long been recognized. *See* H. & C. Howson, *American Patent System* 43 (1872). And the cost of patent litigation has skyrocketed recently, with the *median* patent case costing up to \$2.5 million through appeal. *See* American Intell. Prop. L. Ass’n, *Report of Economic Survey* 72 (1999).

136 . In *The Devil’s Dictionary*, Ambrose Bierce defines “appeal” as: “In law, to put the dice into the box for another throw.” Ambrose Bierce, *The Devil’s Dictionary* 14 (1911).