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Article

*787 EN BANC REVIEW, HORROR PLENI, AND THE RESOLUTION OF PATENT LAW CONFLICTS

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I. Introduction

In late 1998, the authors published an article and gave several speeches explaining how the United States Court of Appeals for the Federal Circuit's failure to accord stare decisis effect to its own patent law precedent created a number of intra-circuit conflicts. [FN1] The purpose of the article and speeches was to identify ways in which the Federal Circuit's treatment of its own precedent threatened the very uniformity of patent law that Congress sought to foster by creating the circuit. [FN2] The article and speeches stimulated discussion among the bench and bar about ways to resolve those conflicts and, thereby, increase uniformity and predictability inpatent*788 law. Many members of the bar shared examples of, and concerns about, conflicts in the Federal Circuit's patent law precedent. Indeed, one member of the Federal Circuit itself addressed the concerns over the conflicts. In a series of frank and thoughtful speeches to California patent law organizations during January of 1999, Judge Arthur J. Gajarsa, Circuit Judge of the United States Court of Appeals for the Federal Circuit, addressed the issue of conflicts at the Federal Circuit. [FN3]

In his speeches, Judge Gajarsa conceded that conflicts exist in the Federal Circuit's patent law, [FN4] recognized the difficulty those conflicts cause the patent bar and its clients, and suggested that the court and the bar work together in a partnership to resolve those conflicts. [FN5] Judge Gajarsa devoted *789 particular attention to explaining the process for seeking en banc [FN6] review of panel opinions, suggesting the bar could improve the chances of obtaining such review by focusing petitions for en banc review on intra-circuit conflicts created or perpetuated by the panel opinion. [FN7] By identifying and focusing *790 on the specific conflict, Judge Gajarsa explained, the bar could bring the conflict to the attention of the full court, increasing the chance of an en banc resolution of the conflict. [FN8]

Judge Gajarsa is certainly correct that a partnership between the bench and bar is necessary to resolve the intra-circuit conflicts plaguing patent law. Further, a petition for en banc review is greatly strengthened when it focuses the court's attention on a conflict created or perpetuated by a

particular panel's decision. En banc review, however, is not the only, or even the best, method of addressing conflicts within the Federal Circuit, in part, because there is such a heavy cost associated with the en banc procedure. This article explains why en banc review is perhaps the least efficient way to avoid or resolve conflicts. Due to this inefficiency, the resolution of patent law conflicts requires a much more comprehensive partnership between the bench and bar. [FN9]

The bench and bar partnership proposed by this article requires consistency, candor, and care from lawyers and judges at all stages of appellate proceedings. Initially, the advocate bears the burden of this partnership. In rendering advice on whether to appeal lower court decisions, the advocate must carefully consider the precedent established by prior cases. In briefs addressed to three-judge panels, the advocate must both identify perceived conflicts already existing in the law and directly confront precedent contrary to his or her client's position. During oral argument, the advocate must acknowledge contrary precedent and existing conflicts in the law. Finally, the advocate must offer reasoned grounds for distinguishing or favoring one line of precedent over another.

*791 Thus, particularly in the initial stages of the appellate process, the burden of resolving the existing conflicts and avoiding future conflicts rests as much on the bar as it does on the bench. [FN10] The advocate's candor regarding conflicts and dicta not only assists the Federal Circuit in identifying, avoiding, and resolving conflicts, but enhances that advocate's credibility with the court.

After written briefs and oral arguments, the court takes over. At that point, the authoring judge must treat precedent with respect, avoiding unnecessary dicta. Further, the other judges on the panel must be alert to conflicts missed by the authoring judge. Finally, all the judges on the panel must heed the warnings of the circuit's Senior Technical Assistant and other judges on the court about conflicts identified during the pre-publication circulation of opinions.

Once an opinion is issued, the responsibility shifts back to the advocate to focus petitions for rehearing and en banc review, as Judge Gajarsa suggests, on any conflicts created or perpetuated by the panel opinion. At this point, conflicts in the law assume paramount importance in the decision-making process. The panel should carefully consider any conflict identified in a petition for rehearing to avoid involving the entire court. If the panel does not act, the full Federal Circuit should consider granting en banc review to resolve clear conflicts in precedent. Even the denial of en banc review can be salutary. If the apparent conflict in precedent is not real, the court can explain that fact in the denial of en banc review. If the court is deadlocked on an issue, separate opinions identifying the basis of the split serve both as a warning to the bar and a signal to the Supreme Court that the Federal Circuit cannot resolve the disagreement without assistance.

Finally, and as the last resort, where Federal Circuit precedent is in irreconcilable conflict, the advocate should seek a grant of certiorari from the Supreme Court. Just as inter-circuit conflicts necessitate Supreme Court review, an intra-circuit conflict in an area--like patent law--where the Federal Circuit has exclusive jurisdiction, likewise justifies *792 Supreme Court review.

Following this Introduction, Part II of this article examines Judge Gajarsa's proposed solution to the problem of intra-circuit conflicts: a bench and bar partnership in the en banc review process. Part II explains why en banc review is costly and inefficient, and suggests that en banc review may not be appropriate for resolving every intra-circuit conflict (let alone preventing future conflicts). Part III considers a more extensive

bench and bar partnership than the one proposed by Judge Gajarsa. It identifies the responsibilities of both judges and attorneys at each step of the appellate process. Furthermore, Part III stresses that each step of the process requires both bench and bar effort to resolve prior conflicts with precedent in the Federal Circuit and to minimize new conflicts in the future.

The authors of this article advance their suggestions with some trepidation and more than a little humility. Conflicts can be, and often are, created unintentionally. Despite any court's best efforts, conflicts will continue to be a fact of life. Further, the proposed partnership between bench and bar requires much work on the part of both groups--and clients may initially view it with some trepidation as well. The partnership imposes a considerable burden on the judges of the Federal Circuit to read all of the patent cases that the Federal Circuit publishes each year (as well as a good number of the unpublished dispositions and the many more non-patent cases the court issues). Advocates shoulder a similar burden, keeping abreast of recent developments in patent law and faithfully scouring the circuit's precedent for rulings relevant to their cases.

These burdens notwithstanding, the efforts urged by this article will benefit clients, not only in the long run, but in the short run as well. Moreover, only through this partnership can the bench and bar efficiently and effectively resolve the burgeoning conflicts in Federal Circuit patent law. This resolution ultimately serves the clients' interests by avoiding unnecessary litigation. [FN11]

*793 II. Horror Pleni: The Aversion to En Banc Review

In his speeches on the subject of conflicts in the Federal Circuit, Judge Gajarsa suggested that the bar could influence the conflict-resolving efforts of the court by focusing on conflicts presented by panel opinions when submitting petitions for en banc review. This suggestion assumes that once a conflict is identified, the Federal Circuit will resolve that conflict en banc. Courts generally are reluctant, however, to undertake en banc review. This reluctance--termed by one observer "horror pleni" [FN12]--has several valid bases.

A. En Banc Review Is Inefficient

En banc review can be very costly from an institutional point of view. [FN13] En banc review of appeals by a twelve-judge court like the Federal Circuit "normally take[s] an inordinate time to schedule, let alone decide. Almost invariably, . . . they produce multiple opinions and postpone disposition of the case for months, sometimes years." [FN14] For twelve judges to rehear a case en banc consumes resources that might be more fruitfully spent on three or four other dispositions by three-*794 judge panels. [FN15] In addition, there are other factors adding to the overall "transaction cost" associated with en banc procedures. For example, the grant of a petition for rehearing en banc often provides parties the possibility (and perhaps incentive) to settle before resolution of the case (but after expending considerable judicial resources on the case). [FN16] Moreover, if the en banc court simply agrees with the panel opinion, all are left to wonder whether a more efficient manner of resolving the alleged conflict existed. [FN17] Factoring in these "risks" for a given year of en banc decision-making on the District of Columbia Circuit, Judge Douglas Ginsburg and his co-author, Donald Falk, estimated the overall cost of en banc review at approximately the cost of five and one-half normal panel dispositions. [FN18] Critics of en banc review have concluded that the advantage of uniformity attained by en banc review is outweighed by the institutional costs incurred. [FN19]

*795 B. En Banc Review Can Create Friction on the Federal Circuit

Judges being human, en banc cases can cause friction between the judges on the Federal Circuit. No judge wants his or her opinions subjected to en banc review, and some regard a colleague's vote for en banc review of one of their cases "as tantamount to betrayal." [FN20] While judges' regard for their colleagues may survive differences on individual cases, the potential for friction--occasioned when proceedings within the court itself take an adversarial turn--cannot be ignored. Critics of en banc review have decried the erosion of collegiality among judges participating in such review, and have raised it as a reason against such review. [FN21]

C. En Banc Review Will Not Solve All Problems

Both the authors' previous article and Judge Gajarsa's speeches highlighted a number of issues that now appear ripe for en banc review. It may be a mistake, however, to assume that making some or all of these issues subject to en banc review at the earliest opportunity will cure the problem.

By taking a case en banc, the court does not guarantee a resolution of all conflicts with precedent. The Supreme Court always sits en banc, yet its patent law decisions often create as many conflicts as they resolve. [FN22] Likewise, the Federal Circuit's predecessor, the Court of Customs and Patent Appeals ("C.C.P.A."), always sat en banc, and its precedent was not free from conflict. [FN23] Potential conflict always looms, even for an en banc court.

Furthermore, the limitations with the en banc procedure are systemic and will not change. En banc review will always be inefficient and carry the potential for friction. For these reasons, the Federal Circuit cannot overcome its horror pleni merely by a more eager embrace of the en banc procedure. *796 Similarly, quick resolution of all conflicts in patent law precedent through en banc review is unrealistic. Instead, if both the bench and bar embrace the partnership proposed by Judge Gajarsa throughout the appellate process, the resolution of many conflicts in patent law becomes possible.

III. The Rest of the Partnership: Duties of the Bench and Bar

Stare decisis is, simply put, the policy of the courts "[t]o abide by, or adhere to, decided cases." [FN24] Stare decisis applies only to the holding of a given case, that is, to "legal issues that were actually decided." [FN25] Courts legitimately refuse to be bound by dicta. [FN26] "[A] dictum is not authoritative. It is the part of an opinion that a later court, even if it is an inferior court, is free to reject." [FN27] And, of course, stare decisis "deals only with law, as the facts of each successive case must be determined by the evidence adduced at trial." [FN28]

The doctrine of stare decisis holds considerable sway over the thinking of most American-educated lawyers. As Justice Cardozo observed: "Stare decisis is at least the everyday working rule of our law." [FN29] It is not, however, an immutable *797 commandment of lawmaking. Indeed, stare decisis is a concept foreign to many other legal systems. [FN30] Even the courts of the American common law tradition apply the concept with varying degrees of fidelity (or rigidity). [FN31] In the United States Supreme Court, for example, the countervailing consideration of the need for a court (particularly a court of last resort) to correct errors or injustices in the law constrains the concept of stare decisis. [FN32] As Justice Cardozo explained, reconciliation of the "tendency to subordinate precedent to justice . . . with the need [for] uniformity and certainty, is one of the great problems confronting the lawyers and judges of our day." [FN33]

The Federal Circuit has a relatively simple rule of stare decisis to govern how the court treats its own precedent. Under the Federal Circuit's version of this rule, prior decisions are binding unless and until overturned by the court en banc. [FN34] Where precedential decisions of the court conflict, the *798 earlier decision controls. [FN35] Stare decisis is not self-executing; its application requires diligent effort on the parts of the both bench and bar.

A. The Advocate's Obligation to Present Authority Accurately and Fairly

To persuade a Federal Circuit panel to decide a case differently from an earlier, apparently controlling, decision, the advocate must confront and distinguish that earlier decision. [FN36] The advocate must analyze the earlier decision, identify precisely what was decided (as opposed to information merely discussed or considered), and then persuade the panel that the earlier case decided an issue different from the issue presented by the pending one. [FN37] In some instances, this analysis requires the advocate to argue to the Federal Circuit panel that the question decided by an arguably precedential case was materially different from what the opinion itself claims it decided, or that the earlier case was postured in a way materially different from the present case. [FN38]

This exercise requires that the advocate distinguish carefully between the holding of the prior case and mere dicta. [FN39] *799 The court that decided the earlier question often provides unexpected help in this task. For example, by articulating alternate grounds for an opinion, a court may render both grounds "dicta," inasmuch as neither is essential to the outcome of the case. [FN40] Thus, regardless of how emphatically a court states the holding of its case (or what it perceives to be the holding of its case), another panel or court may label that "holding" merely dicta at some point in the future. [FN41]

A careful reading of opinions allows the advocate to parse out real holdings from dicta. Careful reading of this sort serves the court by giving it an opportunity to advance precision and clarity in the law. This, in turn, improves the chances of the court accepting the advocate's argument. Writing in a recent issue of Litigation magazine, Federal Circuit Judge Paul Michel outlined his personal views on appellate advocacy, touching in part on this very issue. [FN42] Judge Michel observed that it is important not to confuse dicta and holdings, and counseled, "[d]on't separate legal propositions from supporting authority and rulings from legal context . . . . Dicta are not binding; only holdings are." [FN43]

By the same token, however, advocates ought not to encourage one panel of the Federal Circuit to transmute into "dicta" the plain holding of a previous panel in the earlier case. Such mischief undermines certainty in the law and invites en banc reconsideration.

An advocate should also confront authority contrary to that on which she relies. [FN44] Pointing out conflicting precedent interests an appellant more than an appellee, whose interest *800 lies in "lying low" and obtaining an affirmance. Both sides, however, should recognize that relying on dicta, or on only one line of cases to the exclusion of a conflicting line of cases, is dangerous. The court may well dismiss an argument based on dicta or on a single line of cases in favor of authority presented by the other side. By not addressing the contrary authority early on, the advocate may lose the opportunity to do so, together with the appeal.

Judge Michel articulates what he calls the "Ten Commandments of Appellate Advocacy," the first of which is to "honor precedent." [FN45] Judge Michel explains the primacy of this "commandment" by pointing out that if an advocate "cannot articulate a theory of reversible error based on precedent," he or she "probably should not appeal." [FN46] By honoring precedent, the

advocate advances the partnership between the bench and bar by bringing only meritorious appeals, while at the same time increasing the chances of succeeding on appeal.

B. The Authoring Judge's Obligation to Treat Precedent Fairly

Fair treatment of precedent requires identifying the extent to which the precedent is relevant to the case at bar. [FN47] If the holding of the earlier case is not distinguishable in a relevant manner from the case before the court, the precedent controls. [FN48] More frequently, however, the earlier case is not squarely on point, but rather involves a particular approach to certain issues, an acceptance of certain premises, or a mode of analysis that logically applies by extension to the case at bar. [FN49]

*801 With this type of suggestive, but not directly controlling precedent, appellate judges select the opinions they agree with and disregard those they do not agree with. As a result, precedent may be ignored or distinguished. Over time, this process results in a sorting or culling of the court's precedent. [FN50] This sorting process favors more current precedent, while distinguishing, or limiting to its facts, unpopular precedent. [FN51]

Precedent that is truly controlling should be followed or overruled. [FN52] The latter can be done only by the court sitting en banc, something the Federal Circuit undertakes reluctantly. Following precedent, however, requires the discipline to toe the line on prior opinions that clearly dictate the outcome of the present case.

Former Chief Judge Wald of the District of Columbia Circuit asserts that "[w] hen a judge finds precedent dead set against the way she thinks the case should go, she usually accedes to it, albeit reluctantly." [FN53] Experience, however, shows Judge Wald may be too idealistic. As one commentator noted, "[c]onsiderable anecdotal evidence suggests that when judges care deeply about a particular legal issue but disagree with existing precedent, they often attempt to subvert the doctrine [of stare decisis] and free [themselves] from its fetters by stretching to distinguish [the precedential authority]." [FN54] Moreover, as Justice O'Connor frankly observed, judges "know how to mouth the correct legal rules with ironic solemnity while avoiding those rules' logical consequences." [FN55] The proposed bench and bar partnership requires judges to follow directly or acknowledge the controlling authority of earlier decisions, despite any personal disagreement. [FN56]

*802 C. The Authoring Judge's Obligation to Limit Dicta

Justice Holmes cautioned that "the proper derivation of general principles in both common and constitutional law . . . arise gradually, in the emergence of a consensus from a multitude of particularized prior decisions." [FN57] That is, "[t]he common law does not work from pre-established truths of universal and inflexible validity to conclusions derived from them deductively [,]" rather, "[i]ts method is inductive, and it draws its generalizations from particulars." [FN58] Unfortunately, the Federal Circuit is less than ardent in practicing restraint in pronouncing new principles of patent law. [FN59]

Shortly after Congress created the Federal Circuit, Chief Judge Howard Markey recognized that the new court "ha[d] its work cut out for it in achieving that part of its mission which entails removal from the field of patent law . . . 'the high costs of ifs." ' [FN60] "Not only the opportunity, but the duty of clarifying the law of patents itself," he explained, "will require the resolution of numerous apparent conflicts lurking in past decisions and decisional approaches of various courts." [FN61]

The Federal Circuit quickly acted to resolve the dozen patent law conflicts that Chief Judge Markey identified. [FN62] In doing so, however, some members of the court developed the unfortunate habit of writing broadly, expounding on matters far beyond the facts of the case. [FN63] In the short term, this *803 "maximalist" [FN64] approach fulfilled what Chief Judge Markey believed was the Federal Circuit's obligation to "illuminate a clear and consistent course capable of being followed with ease and assurance by its trial tribunals and its bar." [FN65] In the long term, however, this approach made it much more difficult for the court to satisfy the need that Chief Judge Markey recognized "for maintenance of stare decisis wherever possible." [FN66]

The Federal Circuit does not enjoy the advantage of the Supreme Court, which allows issues to percolate through the various circuits, each serving as a proving ground for different ideas and approaches to the law. Because cases come to the Federal Circuit straight from the harried and overworked district courts, many of which lack particularized expertise in patent law, they seldom include the comprehensive statements of fact and law usually available to the Supreme Court. [FN67] For this reason, it is perilous for the Federal Circuit to announce bright line rules or offer sweeping statements intended for general application. [FN68] Opinions that stray far from the particular facts presented are vulnerable to contradiction by cases involving a set of facts, not foreseen by the panel authoring the earlier opinion, that demand a contrary out *804 come.

This vulnerability of decisions suggests the need to turn away from the "maximalist" approach to opinion writing. In addition to reducing the opportunities for judicial errors and the need to override precedent, decisional "minimalism" likely reduces the burdens of judicial decisions. [FN69] The court that realizes that changes in the law occur, to quote Justice Cardozo, "inch by inch," [FN70] may take comfort that it discharges its obligation by "nudging the law slightly in one direction or another," [FN71] but only as far as is necessary to decide the case at bar. Although these changes may not seem "momentous in the making," [FN72] a court deciding cases in this incremental manner may find that the effect of such decisions "has been not merely to supplement or modify; it has been to revolutionize and transform." [FN73]

Clearly, the use of dicta is the enemy of minimalism. In some cases, it may also be "against the rules." The "rules" in this case are the Federal Circuit's own internal operating procedures, and one of these rules specifically instructs that "all opinions and orders shall be as short and as limited to the dispositive issue as the nature of the cases or motions will allow." [FN74] By minimizing dicta, which is by definition unnecessary to the given issue, the bench aids in achieving the aims of the bench and bar partnership. [FN75]

*805 D. The Other Panel Judges' Obligation to Review the Draft Panel Opinion

The internal operating procedures of the Federal Circuit reveal additional opportunities for judges to exercise care in shepherding an opinion through the decision-making process, thereby ensuring that the opinion adds to the overall reliability and predictability of the law. [FN76] First, it is important to note that the two non-authoring judges on a panel must vote on the decision before it becomes the decision of the panel. To advance the ends of consistency in the law, the two non-authoring judges should not confine their review to the outcome, but rather should also review the reasoning of the opinion. This review of the draft panel opinion should pay particular attention to Federal Circuit precedent.

The non-authoring panel judges' opportunity to review the draft opinion is important.

The enlistment of more memories, of more individuals' recalled experience, cannot help but produce more lines of guidance as well as more threads to be tied in: the enlistment of more imaginations and more individuals' projections of possibility and likelihood cannot help but call forth a more serviceable advance exploration of the prospective bearings of the announced reason and rule. [FN77] Despite its advantages, multi-judge reviews are not always fully effective. Because of "pride of opinion, or bother about offending such pride, or weird views about manners or delicacy, [panel judges may be reluctant to make] any suggested change of wording, thought, or even of citation." [FN78] While by no means universal, [FN79] such reluctance to suggest *806 changes to the opinions of another judge "raises tremendously the likelihood of discontinuity among a court's results over the years." [FN80] For this reason, the non-authoring panel judges' opportunity to review and comment upon the author's draft opinion is not only an obligation, but it is essential for producing clear, consistent opinions.

If a non-authoring panel member identifies a conflict, he or she should informally attempt to persuade the authoring judge to revise the opinion to avoid the conflict. [FN81] There are times, however, when the panel members simply disagree, and the authoring judge will refuse to revise his or her opinion to avoid the conflict perceived by a non-authoring judge. If the non- authoring judge cannot dissuade the third panel member from joining the draft opinion, the stage is set for an invitational dissent. [FN82] Instead of making law, the invitational dissent makes the case for a change in the law. [FN83] This form of dissent is an invitation to change the law or to resolve a conflict created or perpetuated by the panel opinion. The invitational dissenter writes not to the panel or to the bar, but to the non-panel judges of the Federal Circuit, the Supreme Court, and Congress. [FN84] Invitational dissents play a legitimate, and oft-times effective, role in identifying conflicts in precedent that are capable of resolution only by the Federal Circuit en banc, the Supreme Court, or Congress. [FN85]

*807 E. The Non-Panel Judges' and Senior Technical Assistant's Obligation to Review Circulating Opinions

The structure of the Federal Circuit, with its twelve active judges, senior judges, and visiting judges sitting in panels of three, can result in what Karl Llewellyn called "appallingly different courts." [FN86] Structurally, the Federal Circuit has taken two steps to insure respect for both its rules concerning precedent and its integrity as a single court. First, the Federal Circuit instituted the practice of circulating the decisions of each panel to each judge on the court before publishing the decisions. [FN87] For the same reasons that the non-authoring judges' input to the authoring judge is important, the non-panel judges' suggestions to the panel are vital. [FN88] Unlike the panel judges, however, non-panel judges must request the decision below, briefs, and appendixes. [FN89]

Second, and perhaps as important, the Federal Circuit created the post of Senior Technical Assistant. [FN90] The duties of *808 the Senior Technical Assistant include reviewing draft opinions for conflict with Federal Circuit precedent and calling such conflicts to the court's attention before the cases are published. [FN91]

These procedural and structural mechanisms should ensure that new decisions by three-judge panels follow precedent and recognize those decisions that would conflict with the court's stare decisis principles. The Federal Circuit may then modify or consider en banc those decisions identified as conflicting with precedent. [FN92] In other words, these procedures should allow the court to "speak convincingly and with one voice on those issues of law within its exclusive jurisdiction." [FN93]

F. The Authoring Judge's Obligation to Heed Concerns Expressed Before Publication

With each step forward in the process of rendering a final decision on appeal, the stakes rise: authoring judges, in particular, become more identified with the position they support. After the panel has drafted its opinion, the rest of the court becomes a group of potential critics of the opinion. Although the remainder of the court is greater in number than the panel, it is probably proceeding with less information, and certainly with less familiarity with the details of the case, than the authoring judge. While the inertia is high by this *809 step in the process, the cost of failing to correct a mistake, failing to adhere to stare decisis principles, or taking the question en banc for decision by the entire court, can be even greater. For this reason, the authoring judge must view herself as being under an obligation to consider the views of other judges before releasing an opinion for publication. Further, the Senior Technical Assistant should have a particularly strong voice at this stage in the review process. If the court provides the Senior Technical Assistant with the necessary resources to perform his job and trusts him to accurately perform that job, then the Senior Technical Assistant's identification of a potential conflict should call the entire court to reexamine the opinion.

G. The Advocate's Obligation to Focus on the Conflict Created or Perpetuated by a Panel Opinion in the Petition for Rehearing

In his series of California speeches, [FN94] Judge Gajarsa explained that a Federal Circuit panel is unlikely to grant a petition for rehearing based on the argument that the panel erred in view of the facts of the specific case. In a petition for rehearing before the panel, the panel judges view such an argument as asking the panel to grind the same corn a second time. If an advocate points out that the panel opinion creates or perpetuates a conflict, however, the panel is more likely to grant the rehearing.

H. The Panel Judges' Obligation to Consider Conflicts Identified in the Petition for Rehearing

Given the considerable lengths to which the court must go in order to consider a suggestion for hearing en banc, [FN95] the panel should carefully consider the points made in a petition for panel rehearing. [FN96]

A petition for rehearing that identifies a conflict created by the decision should spur the panel judges to find another avenue so as to avoid the conflict. The relatively few petitions for rehearing that are granted should not dissuade the panel *810 members from considering such petitions carefully. "The reason so few petitions are granted is not because we do not pay close attention to them," the judges say, but "because we exhausted all avenues to decision the first time around." [FN97] By clarifying its opinion, or otherwise assuaging legitimate concerns raised in the petition for panel rehearing, the panel saves the entire court a lot of work.

The panel judges not authoring the opinion have a particular obligation to carefully consider the conflicts identified in petitions for rehearing. Even judges that dissent from the original panel opinion should consider these conflicts. Most judges dissenting from a panel opinion are "content to reinforce their original panel dissent with a symbolic vote for rehearing by the panel, and to ration their [en banc] votes carefully." [FN98] Recognizing that a denial of en banc rehearing only strengthens the authority of the majority opinion, some judges accompany their vote for panel rehearing with statements of their reasons. [FN99] Although these statements have no more precedential effect than a dissent or concurrence, they address an audience perhaps more receptive than the Federal Circuit, such as the Supreme Court or Congress. [FN100] These statements also contribute to the ongoing dialogue

in secondary literature, a dialog that may bring additional pressure on the circuit to resolve the conflict created or perpetuated by the majority opinion. [FN101]

The statements of dissenting panel members can, however, be costly. "Broadside attacks on existing precedents . . . tend to highlight doctrinal and ideological splits in the court and invite cynical observations from litigants and commentators about different law emanating from different panels." [FN102] For this reason, attempting to obtain en banc review is preferred over merely criticizing the majority opinion in a dissenting opinion or a dissent from the denial of rehearing. [FN103]

*811 The grant of a petition for rehearing does not necessarily portend a reversal of the original outcome. Past Federal Circuit cases demonstrate that the court may grant a petition "to the extent of considering and disposing of the arguments there presented," thereby adhering to its original result. [FN104] The Federal Circuit has also granted rehearing, heard oral argument, and then adhered to the original outcome. [FN105] These efforts by the panel to ensure consideration of all the arguments cannot be anything but salutary.

I. The Advocate's Obligation to Focus on the Conflict Created or Perpetuated by a Panel Opinion in the Petition for En Banc Review

The court considers as valid bases for seeking en banc consideration "a demonstrated conflict with Supreme Court or Federal Circuit precedent, or the case must be of exceptional importance." [FN106] Conflicts with Supreme Court precedent and cases of exceptional importance are few and far between. The advocate should, therefore, focus a petition for en banc review on the intra-circuit conflict created or perpetuated by the panel opinion. By doing so, the advocate maximizes the potential for achieving the desired outcome for the client and serves the court by giving it one final opportunity to address real conflicts of law en banc. [FN107]

J. The Court's Obligation to Address Real Conflicts En Banc

As Judge Gajarsa explains, arguing in a petition for rehearing en banc that the original panel was incorrect carries little weight with the full circuit. At this stage of the proceedings, the court is looking for opportunities to clarify the *812 law and make it more uniform, rather than ensuring that it decided a particular case correctly. [FN108] The Federal Circuit's internal operating procedures emphasize this role of en banc review, considering it appropriate for

> (1) [the] necessity of securing or maintaining uniformity of decisions; (2) involvement of a question of exceptional importance; (3) [the] necessity of overruling a prior holding of this or a predecessor court expressed in an opinion having precedential status; or (4) the initiation, continuation, or resolution of a conflict with another circuit. [FN109]

Due to the Federal Circuit's heavy patent caseload, intra-circuit conflicts loom large on this list.

As a result of the inordinate resources consumed by the en banc review of a case, such review "is not undertaken lightly; the initiating judge must feel deeply that circuit jurisprudence is significantly threatened to call for [en banc review]." [FN110] The Federal Circuit provides en banc review relatively infrequently, publishing only twenty-five en banc opinions in patent cases in its history: one in 1982, [FN111] none in 1983, two in 1984, [FN112] four in 1985, [FN113] none in 1986, two in 1987, [FN114] two in 1988, [FN115] one in 1989, [FN116] three in 1990, [FN117] none in *813 1991, one in 1992, [FN118] none in 1993, two in 1994, [FN119] three in 1995, [FN120] none in 1996 or 1997, three in 1998, [FN121] and one in 1999. [FN122]

Notwithstanding the relative infrequency of en banc review, the Federal Circuit judges realize that they have the last word in many instances, thus they "take a very hard look" at en banc petitions. [FN123] "[T]he man or judge who is stirred out of being a sleeping dog comes awake with a growl and a mission." [FN124] Judge Gajarsa indicated that there might be a new resolve in the Federal Circuit to be more aggressive in averting (or defusing) threats to the circuit's jurisprudence. [FN125] The court may be moving toward a greater appreciation that en banc review "is a sign of a healthy court," and *814 demonstrates that the court "will respond to difficult legal issues, including reexamining precedent, where appropriate, to correct possible deviations." [FN126]

With this new appreciation of en banc review, the advocate should not shrink from seeking it in proper cases. Where a conflict clearly exists, neither the statistics concerning how few en banc petitions are granted, nor the court's traditional horror pleni should dissuade the advocate from seeking en banc review. Seeking review strengthens the hand of the judges on the Federal Circuit who share a common view of the conflict in precedent and are committed to addressing and resolving such conflicts.

K. The Advocate's Obligation to Focus on Intra-Circuit Conflicts in the Petition for Certiorari

If the advocate is unsuccessful in persuading the Federal Circuit to resolve the conflict created or perpetuated by the decision, he or she may turn to the Supreme Court. At this juncture, the Federal Circuit's opinion itself may affect the potential for the grant of certiorari. The Supreme Court relies heavily on lower court judges to "frame vital issues, document the need for their resolution or clarification, and develop rationales to justify one solution or reform over another." [FN127] The opinions in the courts below set the terms of debate for the Supreme Court, as well as the structure of arguments for counsel. [FN128] For this reason, it is important for the Federal Circuit to address the conflict in precedent.

Supreme Court review is the exception rather than the rule. [FN129] The Court grants petitions for certiorari "only for compelling reasons," and rarely "when the asserted error consists of erroneous factual findings or the misapplication of a *815 properly stated rule of law." [FN130] Indeed, the Court limits its reasons for granting certiorari on appeals from the Federal Circuit in patent cases to: (1) decisions in conflict with a decision of another federal circuit court on the same important matter; (2) decisions where the court departed so far from the accepted and usual course of judicial proceedings as to require an exercise of the Supreme Court's supervisory power; (3) decisions on an important question of federal law that has not been, but should be, decided by the Supreme Court; and (4) decisions resolving an important federal question in a way that conflicts with relevant decisions of the Supreme Court. [FN131] None of these reasons provides a basis for the Court to review a decision merely because of a split in the Federal Circuit's case law, even though the Federal Circuit has exclusive jurisdiction over appeals in patent cases. [FN132] This is so because the Supreme Court views it as "primarily the task of a court of appeals to reconcile its internal difficulties." [FN133]

There is another reason that the Federal Circuit serves as the "court of last resort" in most patent cases. [FN134] Congress gave the Federal Circuit the task of ironing out the inconsistencies in patent law, and during the first dozen or so years of the Federal Circuit's existence, the Supreme Court was very deferential to the new court's substantive patent law decisions. [FN135] While the Supreme Court has reviewed Federal Circuit decisions in a number of patent cases, [FN136] only three dealt *816 with substantive patent law issues. [FN137] Further, in none of the substantive patent law cases did

the Supreme Court base its review on a conflict in the precedent of the Federal Circuit or its predecessor courts. In only one of these three cases was the Federal Circuit badly and publicly split over the issue. [FN138] With patent law conflicts becoming more apparent and numerous, and as advocates focus more on those conflicts in their petitions for certiorari, expect the Supreme Court to be less deferential to the Federal Circuit and its patent-lawmaking role.

Both advocates and judges agree that the Supreme Court is not particularly well suited to resolve thorny issues of substantive patent law. [FN139] The threat of expanded Supreme Court intervention in development of the patent law may be *817 the keenest incentive for the Federal Circuit, and advocates before it, to work to minimize intra-circuit conflicts. The result leaves patent law in an unenviable position, caught between the Scylla of a fractious and conflict-riddled Federal Circuit Court of Appeals and the Charybdis of a Supreme Court lacking sophistication in the nuances of patent law. This consideration underscores the longer-range importance of the bench and bar partnership proposed by Judge Gajarsa and elaborated on by this article.

IV. Conclusion

Judge Gajarsa's assertion that the bench and bar need to work together to resolve conflicts in the Federal Circuit's patent law is doubtlessly correct. But that partnership cannot be limited to the en banc review process. If only because of the Federal Circuit's legitimate reluctance to grant en banc review--its "horror pleni"--the partnership needs to start at the beginning of the appellate process and continue to the very end. Both the bench and bar need to confront the court's patent precedent and treat it with respect. At the same time, slavish adherence to past decisions does not serve the bench, the bar, or the public. [FN140] The challenge is to identify cases that require a departure from precedent and overrule them in a straightforward and proper manner. Only through the careful application of the principles of stare decisis can the bench and bar resolve the conflicts in the Federal Circuit's patent case law.

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[FN1]. See 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); William C. Rooklidge, Stare Un-Decisis: The Decline of Stare Decisis at the United States Court of Appeals for the Federal Circuit, Address Delivered at the Northwestern School of Law of Lewis & Clark College Second Annual Conference on Intellectual Property in the Global Marketplace (Oct. 23, 1998), and at the National Inventors Hall of Fame Continuing Legal Education Program on Intellectual Property Law Practice (Sept. 19, 1998); Matthew F. Weil, Stare Un-Decisis: The Sometimes Rough Treatment of Precedent by the United States Court of Appeals for the Federal Circuit, Address Delivered at the Meeting of the Orange County Patent Law Association in Costa Mesa, California (Oct. 21, 1998).

[FN2]. See Weil & Rooklidge, supra note 1, at 791-94 (citing S. Rep. No. 97-275, at 5 (1981), reprinted in 1982 U.S.C.C.A.N. 11, ¤ 15).

[FN3]. See Arthur J. Gajarsa, Conflicts at the Federal Circuit, Address to the San Diego Intellectual Property Law Association (Jan. 14, 1999), to the Orange County Patent Law Association (Jan. 15, 1999), and to the Los Angeles Intellectual Property Law Association (Jan. 16, 1999).

[FN4]. See id. The examples that Judge Gajarsa cited relate to several matters not touched upon in this article. First, Judge Gajarsa addressed the standard of review for factual determinations in preliminary injunctions against patent infringement. Compare Smith Int'l, Inc. v. Hughes Tool Co., 718 F.2d 1573, 1579 (Fed. Cir. 1983) (seriously misjudged the evidence), with New Eng. Braiding Co. v. A.W. Chesterton Co., 970 F.2d 878, 882 (Fed. Cir. 1992) (clearly erroneous). Second, Gajarsa discussed the nature of the issue of equivalence under 35 U.S.C. ¤ 112, P 6. Compare Intel v. United States Int'l Trade Comm'n, 946 F.2d 821, 841 (Fed. Cir. 1991) (factual issue), with Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1457 n.7 (Fed. Cir. 1998) (en banc) (declining to decide whether it was an issue of law or of fact). Third, Gajarsa addressed the circuit's interpretation of apparently unambiguous statutory terms. Compare In re Alappat, 33 F.3d 1526, 1584 n.3 (Fed. Cir. 1994) (Schall, J., dissenting) ("We assume that the legislative purpose is expressed by the ordinary meaning of the words used.") (quoting United States v. James, 478 U.S. 597, 604 (1986)), with Nike, Inc. v. Wal-Mart Stores, 138 F.3d 1437, 1440 (Fed. Cir. 1998) (court can consider extrinsic evidence "to determine whether ambiguity has invaded an apparently clear text"). Fourth, Judge Gajarsa discussed the perspective from which prosecution history estoppel is analyzed. Compare Litton Sys. v. Honeywell, Inc., 140 F.3d 1449, 1462 (Fed. Cir. 1998) (perspective of person of ordinary skill in the art), with Cybor, 138 F.3d at 1457 (perspective of competitor). Finally, Gajarsa addressed the level of identity required to establish statutory or "same invention" -type double patenting. Compare Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355 (Fed. Cir. 1986) ("By 'same invention' we mean identical subject matter.") (quoting In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970)), with In re Lonardo, 119 F.3d 960, 965 (Fed. Cir. 1997) ("[T]he phrase 'same invention' refers to an invention drawn to substantially identical subject matter.").

[FN5]. See Gajarsa, supra note 3. Judge Gajarsa is not the first jurist to call for a partnership between the bench and bar. See Edward D. Re, The Partnership of Bench and Bar, 16 Cath. Law. 194 (1970) [hereinafter Re, Partnership of Bench and Bar].

[FN6]. Careful readers may have noted that this spells "en banc" with an "e" rather than an "i," which the authors used in their prior article. The term is spelled differently by different courts. The Federal Rules used "in banc" until they were revised in December of 1998 after long consideration. See United States v. Edmonds, 80 F.3d 810, 812 (3d Cir. 1996) (citing Fed. R. App. P. 35 (Preliminary Draft of Proposed Amendment, Sept. 1995)); Fed. R. App. P. 35 (using "en" rather than "in" for the spelling of "en banc"). Before 1999, the Federal Circuit had more or less doggedly adhered to the formal "in banc" spelling. Now, like many other courts, it has begun to use the spellings interchangeably. Compare Fed. R. App. P. 35 ("En Banc Determination"), and Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 n.1 (Fed. Cir. 1999) (discussing the court's "en banc" action),

with Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 1068 n.5 (Fed. Cir. 1998) (discussing the court's "in banc" action). As "en banc" is now the statutorily correct spelling, that is the spelling used in this article.

[FN7]. See Gajarsa, supra note 3. 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. No. 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. The Act effectively merged two existing Article III courts, the Court of Claims, and the Court of Customs and Patent Appeals. Congress expanded 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 ¤ 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 4 id. ¤11.06[3][i]. To maintain uniformity in the court's jurisprudence, a majority of active judges may vote to take a case en banc. See Fed. Cir. Internal Operating P. 13(a).

Upon concurrence of the majority of active judges, the court will, for any appropriate reason, conduct an en banc hearing, rehearing, or reconsideration. Among the reasons for en banc actions are: (1) necessity of securing or maintaining uniformity of decisions; (2) involvement of a question of exceptional importance; (3) necessity of overruling a prior holding of this or a predecessor court expressed in an opinion having precedential status; or (4) the initiation, continuation, or resolution of a conflict with another circuit.

Id. at 13(b). Because of the Federal Circuit's special jurisdiction, it is unlikely, though not impossible, that the court's opinions would ever be the source of conflicts other than intra-circuit conflicts. Conflicts with another circuit can arise, however, over questions outside the exclusive jurisdiction of the Federal Circuit (as to which the Federal Circuit either follows its own law or follows the law of the circuit of the district court from which the appeal was taken). See, e.g., Manildra Milling Corp. v. Ogilvie Mills, Inc., 76 F.3d 1178, 1181 (Fed. Cir. 1996) (declaring that Federal Circuit law governs determination of when party is "prevailing" for purposes of cost award, but regional circuit law governs district court's exercise of discretion).

[FN8]. See Gajarsa, supra note 3. Judge Gajarsa is not the first to call for more en banc action. See Michael Ashley Stein, Uniformity in Federal Courts: A Proposal for Increasing the Use of En Banc Appellate Review, 54 U. Pitt. L. Rev. 805 (1993); Roger Andewelt et al., Remarks at the Tenth Annual Federal Circuit Judicial Conference, in 146 F.R.D. 205, 376 (1992).

[FN9]. See Re, Partnership of Bench and Bar, supra note 5, at 204. Judge Re pointed out that the partnership of the bench and bar should extend throughout the trial and appellate process. See id.

[FN10]. See id. at 205. Judge Re explained that thinking of "the decisional process as the sole responsibility of the judge ... falls far short of the fact, and does violence to the cooperative effort that must prevail if the system is to succeed." Id.

[FN11]. Intra-circuit patent law conflicts generate what Karl Llewellyn identified as a "shift in reckonability of outcome," which "produces appeals based not on sound judgment but on wild speculation, therefore vastly too many appeals." Karl N. Llewellyn, The Common Law Tradition: Deciding Appeals 43 (1960). These conflicts hamper the law's ability to serve as "prophecies of what courts will do." Oliver W. Holmes, The Path of the Law, 10 Harv. L. Rev. 457, 461 (1897).

[FN12]. Horror pleni is, literally, "horror of the Plenum," which Llewellyn defined as "a strong aversion of the members of the German Supreme Court (at that time consisting of about seventy-five judges) en banc, to settle a conflict between a prior decision of one Supreme Court panel and the pending case of another." Karl N. Llewellyn, The Case Law System in America 12 n.1 (Paul Gerwitz, ed. 1989).

[FN13]. Other courts have adopted ways of overruling precedent without considering the issue en banc. For example, in the District of Columbia Circuit, a panel can escape the effect of precedent by circulating its draft opinion to the full court calling particular attention to the proposed departure from precedent and, if the full court approves, the panel may publish the opinion (inserting a so-called "Irons footnote" to inform those who read the opinion that the court was aware of the apparent conflict). See Douglas Ginsburg & Donald Falk, The D.C. Circuit Review September 1989-August 1990: The Court En Banc: 1981-1990, 59 Geo. Wash. L. Rev. 1008, 1015 (citing Irons v. Diamond, 670 F.2d 265, 268 n.11 (D.C. Cir. 1981)). "In contrast, a panel of the Seventh Circuit may overrule a circuit precedent if, upon circulation of the proposal, a majority of the active judges does not object." Id. at 1016. This article does not consider whether the Federal Circuit should adopt any of these methods, but instead confines itself to identifying ways to work within the current system. The indispensable first step towards identifying those ways, however, is to recognize that en banc review is not a panacea for all the conflicts in Federal Circuit patent law precedent.

[FN14]. Patricia M. Wald, Changing Course: The Use of Precedent in the District of Columbia Circuit, 34 Clev. St. L. Rev. 477, 482-83 (1986).

[FN15]. See Ginsburg & Falk, supra note 13, at 1019.

[FN16]. A study of en banc cases in the District of Columbia Circuit identified at least one high-profile case in which the parties settled after the circuit court granted a motion for rehearing en banc. See id. at 1065-66. Litigants certainly appreciate the risk, so clearly documented by those authors, that en banc review can result in reversal. In the period reviewed by Ginsburg and Falk, the reversal rate was over 80%. See id. at 1034 n.131. Indeed, Ginsburg and Falk even document a case in which the mere grant of a petition for en banc review prompted the original three-judge panel to preempt en banc review by reversing its own opinion. See id. at 1012 n.32.

[FN17]. In fact, in cases where a panel wishes to overrule existing precedent and the court is demonstrably of one mind on the question, there is a more efficient way. For those occasions when the court recognizes that en banc review is simply a practical necessity to change an obsolete or unworkable rule of law or procedure set down by an earlier case or cases, the "partial en banc" is an option. As the authors discussed in their previous article, this is a more efficient way of conducting en banc review. See Weil &

Rooklidge, supra note 1, at 794. In that article, the authors predicted the partial en banc procedure would be a little-used mechanism. See id. Two recent Federal Circuit opinions, however, force a revision of that prediction. It appears that the court is particularly willing to employ the partial en banc in instances where all or nearly all of the judges see the need to alter a largely procedural rule and will, therefore, simply join in the portion of the opinion announcing that change. See, e.g., Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 n.1 (Fed. Cir. 1999); Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 1068 n.5 (Fed. Cir. 1998).

[FN18]. See Ginsburg & Falk, supra note 13, at 1020. These concerns are by no means exclusive to the District of Columbia Circuit. See, e.g., Lang's Estate v. Commissioner, 97 F.2d 867, 869 (9th Cir. 1938) (expressing concern over the administrative burdens of en banc hearings).

[FN19]. See Stein, supra note 8, at 820, 829-37 nn.73-74 (concluding that the inefficiency argument is exaggerated).

[FN20]. Wald, supra note 14, at 488. Of course, not all en banc reviews are necessarily contentious or even controversial.

[FN21]. See Stein, supra note 8, at 840-45.

[FN22]. A recent example is Pfaff v. Wells Elecs., Inc., 525 U.S. 55 (1998), where the Supreme Court created a new standard for the stage of development required for application of the on sale bar, but in formulating its test appeared to shift the initial burdens of going forward with evidence related to experimental use.

[FN23]. Because the C.C.P.A. always sat en banc, its latest decision was, and is, binding. See In re Gosteli, 872 F.2d 1008, 1011 (Fed. Cir. 1989).

[FN24]. Black's Law Dictionary 978 (6th ed. 1991). "Stare decisis" is short for "stare decisis et non quieta movere" or "stand by the decision and do not disturb what is settled." Edward D. Re, Stare Decisis, 79 F.R.D. 509, 509 (1975) [hereinafter Re, Stare Decisis]. "The principle of stare decisis is integral to our jurisprudence 'because it promotes the evenhanded, predictable, and consistent development of legal principles, fosters reliance on judicial decisions, and contributes to the actual and perceived integrity of the judicial process." ' In re Zurko, 142 F.3d 1447, 1457 (Fed. Cir. 1998) (en banc) (quoting Payne v. Tennessee, 501 U.S. 808, 827 (1991)). "[A]ny departure from the doctrine of stare decisis demands special justification." Arizona v. Rumsey, 467 U.S. 203, 212 (1984).

[FN25]. Beacon Oil Co. v. O'Leary, 71 F.3d 391, 395 (Fed. Cir. 1995). In other words, "the only part of a previous case that is binding is the ratio decidendi (reason for deciding)." Rupert Cross & J.W. Harris, Precedent in English Law 39 (4th ed. 1991).

[FN26]. See, e.g., U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership, 513 U.S. 18, 24 (1994) ("This seems to us a prime occasion for invoking our customary refusal to be bound by dicta."). See also Cross & Harris, supra note 25, at 41 ("Dicta in earlier cases are, of course, frequently followed or applied, but dicta are never more than persuasive authority. There is no question of any judge being bound to follow them.").

[FN27]. In re McGrew, 120 F.3d 1236, 1238 (Fed. Cir. 1997) (quoting United States v. Crawley, 837 F.2d 291, 292 (7th Cir. 1988)).

[FN28]. Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1570 (Fed. Cir. 1993); see also Cross & Harris, supra note 25, at 222-24.

[FN29]. Benjamin N. Cardozo, The Nature of the Judicial Process 20 (1921).

[FN30]. See Linda Karr O'Connor, International and Foreign Legal Research: Tips, Tricks, and Sources, 28 Cornell Int'l L.J. 417, 419 (1995).
Fundamental differences in approach and philosophy exist between civil law and common law jurisdictions. For example, in many civil jurisdictions there is no principle of stare decisis. The law flows primarily from civil codes rather than from case law. Consequently, respected commentaries and doctrinal writings about the codes may be given more weight by practitioners and judges than are cases, even if on point.
Id.

[FN31]. Stare decisis is a "principle of policy," not an "inexorable command," and courts are not necessarily constrained to follow "unworkable" or "badly reasoned" precedent. Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 63 (1996). While stare decisis in general should be viewed as "policy" and not a "command," there are contexts in which the policy takes on considerably more weight. The Supreme Court has observed of its own sometimes sporadic adherence to principles of stare decisis that "[c]onsiderations in favor of stare decisis are at their acme in cases involving property and contract rights, where reliance interests are involved." Payne v. United States, 501 U.S. 808, 828 (1991). The Court has also frequently observed that, in questions of statutory interpretation, where errors can be remedied by legislative action, there is even less reason to disregard the "policy" of respecting previous decisions. See, e.g., Smith v. Allwright, 321 U.S. 649, 665 (1944). In the jurisprudence of patents, both of these considerations weigh in favor of the consistent application of stare decisis principles.

[FN32]. Indeed, a recent study suggests that the behavior of Supreme Court justices is rarely influenced by precedent. See Harold J. Spaeth & Jeffrey A. Segal, Majority Rule or Minority Will 287-315 (1999).

[FN33]. Cardozo, supra note 29, at 160.

[FN34]. See Newell Co. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); UMC Elec. Co. v. United States, 816 F.2d 647, 652 n.6 (Fed. Cir. 1987), cert. denied, 484 U.S. 1025 (1988); Kimberly-Clark Corp. v. Fort Howard Paper Co., 772 F.2d 860, 863 (Fed. Cir. 1985); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 1573 (Fed. Cir. 1983).

[FN35]. See Newell, 864 F.2d at 765; UMC Elec., 816 F.2d at 652 n.6; Kimberly-Clark, 772 F.2d at 863; Mother's Restaurant, 723 F.2d at 1573; see also Albert G. Tramposch, The Dilemma of Conflicting Precedent: Three Options in the Federal Circuit, 17 Am. Intell. Prop. L. Ass'n Q.J. 323, 326-27 (1989). This rule has an exception for the precedent of the Court of Customs and Patent Appeals, which always sat en banc. The latest C.C.P.A. decision is binding precedent. See supra note 23. And, of course, conflict assumes that the holdings of the cases conflict, not just dicta, that is, "statements

in judicial opinion upon a point or points not necessary to the decision of the case." In re McGrew, 120 F.3d 1236, 1238 (Fed. Cir. 1997).

[FN36]. See Paul Michel, Remarks at the Eleventh Annual Federal Circuit Judicial Conference, in 153 F.R.D. 177, 198 (1993).

[FN37]. See generally Cross & Harris, supra note 25, at 39-96 (considering thoroughly the holding/dicta distinction); Re, Stare Decisis, supra note 24, at 510-14. Given the reluctance of a court to overturn a precedent unnecessarily, litigants realize that they need not ask the court to do so when they can win if an objectionable precedent is held inapplicable. See Spaeth & Segal, supra note 32, at 40-41.

[FN38]. See Llewellyn, supra note 12, at 12-13; see also Michel, supra note 36, at 199.

[FN39]. "There is a fundamental difference between a 'decision' and an 'opinion.' The decision is the egg. The opinion is crowing about it." Howard T. Markey, Trademarks on Appeal--A View from the Bench, 66 Trademark Rep. 279 (1976) [hereinafter Markey, Trademarks on Appeal].

[FN40]. See Weil & Rooklidge, supra note 1, at 794-95.

[FN41]. See, e.g., In re McGrew, 120 F.3d 1236 (Fed. Cir. 1997). The court in McGrew considered the emphatic statement in In re Sasse, 629 F.2d 675 (C.C.P.A. 1980), that 35 U.S.C. ¤ 135(b) applies only to interference proceedings and not to ex parte prosecution. See McGrew, 120 F.3d at 1238. The McGrew court seized on two sentences in the Sasse opinion addressing the facts of that case as providing an alternative basis. See id. It then labeled the statement summarizing almost the entire thrust of the opinion as "dicta." See id. Thus, by adding additional reasons for its decision, the court effectively undermined what precedential value the opinion may have had.

[FN42]. See Paul R. Michel, Effective Appellate Advocacy, 24 Litigation 19 (1998) [hereinafter Michel, Effective Appellate Advocacy].

[FN43]. Id. at 21-22.

[FN44]. Of course, there is an ethical responsibility to directly confront contrary precedent, a topic that is beyond the scope of this paper. See Re, Partnership of Bench and Bar, supra note 5, at 202-04.

[FN45]. Michel, Effective Appellate Advocacy, supra note 42, at 23. See also Paul R. Michel, Appellate Advocacy--One Judge's Point of View, 1 Fed. Cir. B.J. 1, 9 (1991).

[FN46]. Michel, Effective Appellate Advocacy, supra note 42, at 23.

[FN47]. See generally Re, Stare Decisis, supra note 24, at 510-11.

[FN48]. See id. ("If [the precedent] is binding, the principle established in the prior case must be applied, and determines the disposition of the subsequent case.").

[FN49]. See Wald, supra note 14, at 490. As then Chief Judge Nies explained, "the language in some opinions may have been overstated and there is

frustration if you're faced with that and you can't reach the result, reasonably or intellectually honestly, that the judges have agreed on." Helen W. Nies, Remarks at the Tenth Annual Federal Circuit Judicial Conference, in 146 F.R.D. 205, 216 (1993).

[FN50]. See Wald, supra note 14, at 490-91.

[FN51]. See id.

[FN52]. There is at least one, narrow exception to this rule. A lower court may have reason to depart from precedent when the failure to do so would mean, as a practical matter, that an issue of importance would evade high court review. See Jerome B. Falk Jr., Honest Dissent, Los Angeles Daily J., August 13, 1998, at 6; see also Cross & Harris, supra note 25, at 125-64 (cataloging other exceptions).

[FN53]. Wald, supra note 14, at 481.

[FN54]. Evan H. Caminker, Why Must Inferior Courts Obey Superior Court Precedents?, 46 Stan. L. Rev. 817, 819 (1994).

[FN55]. Id. (quoting TXO Prod. Corp. v. Alliance Resources Corp., 509 U.S. 443, 500 (1993)).

[FN56]. Critics of en banc review have identified self-disciplined adherence to circuit precedent as an alternative to en banc review. See Stein, supra note 8, at 857 n.256.

[FN57]. Frederic R. Kellogg, Law, Morals and Justice Holmes, 69 Judicature 214 (1986). "The law moves brick by brick and broader legal policies evolve when a large number of bricks are viewed together." Andewelt et al., supra note 8, at 381.

[FN58]. Cardozo, supra note 29, at 22-23.

[FN59]. At the extreme end of the spectrum is the patent opinion that reads like a law clerk thesis. Cf. Bernard Schwartz, Decision: How The Supreme Court Decides Cases 260 (1996) (criticizing the Supreme Court Justices' "virtual abdication of what many consider the Justices' most important function--that of explaining their decisions to the profession and the public").

[FN60]. Howard T. Markey, The Phoenix Court, 10 Am. Pat. L. Ass'n Q.J. 227, 231 (1982).

[FN61]. Id. at 232.

[FN62]. See Melvin Halpern, The Office of the Senior Technical Assistant, in The United States Court of Appeals for the Federal Circuit: A History (1982-1990), at 181 (United States Judicial Conference 1991).

[FN63]. To be fair, there were and are members of the court that avoid dicta scrupulously. The late Circuit Judge Jean Galloway Bissell is an example.

[FN64]. Professor Cass Sunstein defines a "maximalist" as one who seeks "to decide cases in a way that sets broad rules for the future and that also gives ambitious theoretical justifications for outcomes." Cass R. Sunstein,

One Case at a Time: Judicial Minimalism on the Supreme Court 9-10 (1999). While many Federal Circuit patent opinions smack of maximalism in that they are "wide"-- they decide more than the case at hand--they may also be viewed as "shallow" in that they reach incompletely theorized agreements, a hallmark of minimalism. See id. at 10-11.

[FN65]. Markey, Trademarks on Appeal, supra note 39, at 235.

[FN66]. Id.

[FN67]. See Laura M. Burson, A.C. Aukerman and the Federal Circuit: What is the Standard of Review for a Summary Judgment Ruling on Laches or Equitable Estoppel?, 32 Loy. L.A. L. Rev. 799, 830 (1999).

[FN68]. Judge Roger Andewelt of the Court of Federal Claims cautioned the Federal Circuit early on regarding "the thirst for principles and certainty and bright lines":

> When Federal Circuit judges take a look at lower court decisions, they have the briefs of each of the parties before them. This gives the court a very, very narrow focus on the policy issues impacted. It's true as a court and as an individual sitting on the court, you develop some expertise over a period of time. But how confident can you really be that you understand what's going on out there in the economic community? Do you really understand the ramifications of the bright lines that you create, what's left inside and what's left outside of those lines?

Andewelt et al., supra note 8, at 381.

[FN69]. Sunstein, supra note 64, at 4. Professor Sunstein defines "decisional minimalism" as "saying no more than necessary to justify an outcome, and leaving as much as possible undecided." Id. at 3.

[FN70]. Cardozo, supra note 29, at 25.

[FN71]. JamesC. Schroeder & RobertM. Dow,Jr., Arguing for Changes in the Law, 25 Litigation 37, 37 (1999).

[FN72]. Cardozo, supra note 29, at 27.

[FN73]. Id. at 27-28.

[FN74]. Fed. Cir. Internal Operating P. 9(4). Accord Howard T. Markey, Remarks at the Second Annual Federal Circuit Judicial Conference, in 104 F.R.D. 207, 243 (1984) ("Opinions must distill the facts to their operative minimum and limit discussion of the law to that necessary for resolving the issues presented.") [hereinafter Markey, Remarks].

[FN75]. "The nature of the beast is that courts decide the issues before them and shouldn't reach out to resolve uncertainties which needn't be resolved to the case." Andewelt et al., supra note 8, at 382. By this proposal, this article urges the court to adopt new rules with great care, not to resort as a matter of course to a "totality of the circumstances" analysis, an approach for which the court has been criticized by commentators. See, e.g., Thomas K. Landry, Certainty and Discretion in Patent Law: The On Sale Bar, the Doctrine of Equivalents, and Judicial Power in the Federal Circuit, 67 S. Cal. L. Rev. 1151 (1994). Additionally, at least one judge of the court itself has criticized the court's approach. See An Interview With Circuit Judge Randall R. Rader, 7 J. Proprietary Rts. 2 (1995). Indeed, the Supreme

Court rejected the Federal Circuit's "totality of the circumstances" test for application of the on sale bar because it "seriously undermines the interest in certainty." Pfaff v. Wells Elec., Inc., 525 U.S. 55, 65-66 (1998).

[FN76]. An electronic copy of the court's Internal Operating Procedures is available on the Internet at <http://www.fedcir.gov>.

[FN77]. Llewellyn, supra note 11, at 314.

[FN78]. Id.

[FN79]. It may sometimes be easier to convince a full appeals court to take a case en banc than it is to win a motion for reconsideration before the panel that handed down the objectionable opinion in the first instance. See David Giles & Bruce Brown, Rehearing Motions: The Switch of Minds That Saved The Times, 25 Litigation 50, 65 (1999). To win reconsideration, Giles and Brown observed, "you have to persuade a panel of three that it was wrong," whereas to have a case taken en banc, "you have to persuade other judges on the court only that their colleagues were wrong." Id. Indeed, Giles and Brown point out that in some courts, ideological divisions may make one faction eager to overturn particular panels' opinions. See id.

[FN80]. Id.

[FN81]. Withholding a vote or threatening a dissent may pressure the authoring judge to revise the draft opinion, if only to avoid the "enormous amount of time [that] may be consumed as draft panel opinions and dissents shuttle back and forth among the panelists." Wald, supra note 14, at 503.

[FN82]. See id. at 493-95.

[FN83]. The separate opinion "guarantees a new perspective and lends, as it were, a depth dimension to decisions," and "paves the way for new developments in the law." Llewellyn, supra note 12, at 52, 56. The dissent has the added value of guaranteeing "the public that any bending of the law will see the light of day" and "that judges are on the job, that in the chambers where a judge's deliberations take place, judges join battle over the law, each judge feeling individually responsible for the panel's decisions." Id. at 59.

[FN84]. See Wald, supra note 14, at 493.

[FN85]. Of course, this type of dissent must not be abused, so that the dissent serves merely to weaken the majority opinion and confuse future readers. "[I]t's extremely important that the judges at the Federal Circuit understand the need for harmony. Split decisions, inconsistent decisions create real problems." Avern Cohn, Remarks at the Tenth Annual Federal Circuit Judicial Conference, in 146 F.R.D. 205, 372 (1992).

[FN86]. Llewellyn, supra note 11, at 251.

[FN87]. See Halpern, supra note 62, at 182. See also Glenn L. Archer, Jr., Conflicts and the Federal Circuit, 29 J. Marshall L. Rev. 835, 836 (1996). Then-Chief Judge Archer stated, "We take this circulation period very seriously. A substantial number of opinions bring about comments, both technical and substantive, from one, or more often, several judges." Id.

[FN88]. If non-authoring judges' input is ignored, rehearing may result. Any time an advocate files a petition for rehearing en banc, that petition is circulated to each of the active judges, any of whom may ask for a response from the opposing party. See Fed. Cir. Internal Operating P. 14(2). Responses, when sought and received, are likewise circulated and any active judge may, at that time, ask that the court be polled to determine whether a majority of the active judges wish to rehear the case en banc. See id. Judges who disagree with a panel opinion may even seek to have the court rehear the matter en banc sua sponte, without a petition for rehearing en banc. See id. 14(3).

[FN89]. Litigants are required to file only twelve copies of their briefs and supporting materials. See Fed. Cir. Rule 31. Of these, two copies of the "briefs, records and other case related materials" are circulated to each judge of the merits panel (that is, the panel hearing the merits of a case). Fed. Cir. Internal Operating P. 3. The fact that a non-merits-panel judge must make the effort to contact the clerk's office and request one of the remaining six sets of briefs exemplifies the practical obstacles that face a judge who wishes to grapple in any depth with the issues raised by a case before another panel.

[FN90]. See Halpern, supra note 62, at 182. Writing in a 1991 history of the Federal Circuit, Senior Technical Assistant ("STA") Halpern opined:

> Probably the most important aspect of the STA's office has been its participation in the court's process of trying to avoid conflict and confusion in published opinion. After a panel approves the author's opinion, but before it is published, the opinion is circulated for comments by the remaining judges and the STA's office on any arguable inconsistencies or confusion with prior published opinions. The author and panel can then consider those comments to see if they agree with them and if a change in the opinion is needed.

Id. While the Federal Circuit may be unique in charging a particular court staff member with the task of monitoring for possible conflicts in precedent, at least some of the other circuit courts of appeals (the District of Columbia, Third, Fourth, and Sixth Circuits) follow the practice of circulating all of their opinions to the full court before issuing them. See Ginsburg & Falk, supra note 13, at 1012 n.29. This has also been the practice among the judges of the Ninth Circuit, at least in 1991-1992, when one of the authors clerked for a judge of that court. See supra note *.

[FN91]. See Halpern, supra note 62, at 182.

[FN92]. One theory is that if these procedures cannot keep the law uniform, "nothing can." Giles S. Rich, My Favorite Things, 35 IDEA 1, 11 (1994). The authors recent article pointed out a number of instances in which practice has fallen well short of theory and suggested reasons why this might be so. See generally Weil & Rooklidge, supra note 1. It seems likely that these conflicts can arise when judges ignore the efforts of the Senior Technical Assistant.

[FN93]. William Rehnquist, Remarks at the Eleventh Annual Federal Circuit Judicial Conference, in 153 F.R.D. 177, 182 (1993).

[FN94]. See supra note 3 and accompanying text.

[FN95]. See supra notes 13-18 and accompanying text.

[FN96]. See Markey, Trademarks on Appeal, supra note 39, at 281 ("[W]e give just as thorough consideration to a petition for rehearing as we do the original briefs.").

[FN97]. Id.

[FN98]. Wald, supra note 14, at 483.

[FN99]. See id. at 483.

[FN100]. See id. at 484.

[FN101]. See id. at 485. While the relative paucity of citations to secondary literature in Federal Circuit patent opinions suggests that this pressure may not amount to much, several Federal Circuit judges have commented publicly that they appreciate and read secondary literature.

[FN102]. Id. See also Cohn, supra note 85.

[FN103]. See Wald, supra note 14, at 485 . If the attempt to obtain en banc review is successful, "the circuit jurisprudence is cleared of the underbrush of discredited precedents," and if the attempt is unsuccessful, "the precedent will have been rehabilitated at least for the moment." Id.

[FN104]. United States v. Grumman Aerospace Corp., 927 F.2d 575, 577 (Fed. Cir.), cert. denied, 502 U.S. 919 (1991).

[FN105]. See Bosco v. United States, 976 F.2d 710, 711 (Fed. Cir. 1992).

[FN106]. Glenn L. Archer, Remarks at the Fourteenth Annual Federal Circuit Judicial Conference, in 170 F.R.D. 534, 541 (1996). The en banc procedure is spelled out in detail in Fed. Cir. Internal Operating P. 14.

[FN107]. Rearguing the merits in a petition for en banc consideration is "quite wasteful of the court's time" because the petitions "get circulated to all the Judges, and each Judge must take time to read the request." Archer, supra note 106, at 541.

[FN108]. See Gajarsa, supra note 3.

[FN109]. Fed. Cir. Internal Operating P. 13(2).

[FN110]. Wald, supra note 14, at 483.

[FN111]. See South Corp. v. United States, 690 F.2d 1368 (Fed. Cir. 1982) (Federal Circuit adopted Court of Claims and C.C.P.A. precedents).

[FN112]. See Atari Inc. v. JS & A Group, Inc., 747 F.2d 1422 (Fed. Cir. 1984) (holding that the Federal Circuit retains jurisdiction on non-patent issues); Gardner v. TEC Sys., Inc., 725 F.2d 1338 (Fed. Cir. 1984) (establishing standard of review for obviousness finding).

[FN113]. See In re Bennett, 766 F.2d 524 (Fed. Cir. 1985) (broadening reissue application requirements); In re Etter, 756 F.2d 852 (Fed. Cir. 1985) (finding that claims in reexamination do not enjoy presumption of validity); Paulik v. Rizkalla, 760 F.2d 1270 (Fed. Cir. 1985) (clarifying rules for determining priority of invention); SRI Int'l v. Matsushita Elec. Corp., 775

F.2d 1107 (Fed. Cir. 1985) (holding that a factual issue concerning reverse doctrine of equivalents precludes summary judgment).

[FN114]. See Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931 (Fed. Cir. 1987) (clarifying rules governing doctrine of equivalents); Woodard v. Sage Prod., Inc., 818 F.2d 841 (Fed. Cir. 1987) (discussing appeal of interlocutory orders under section 1292(a)(1)).

[FN115]. See Kingsdown Med. Consultants, Ltd. v. Hollister, Inc., 863 F.2d 867 (Fed. Cir. 1988) (addressing the standard of review for an inequitable conduct issue); In re Roberts, 846 F.2d 1360 (Fed. Cir. 1988) (concluding that the Federal Circuit will not issue mandate in conflict with that of another circuit in the same case).

[FN116]. See Racing Strollers Inc. v. TRI Indus., Inc., 878 F.2d 1418 (Fed. Cir. 1989) (holding that a design patent application receives filing date of utility application).

[FN117]. See In re Dillon, 919 F.2d 688 (Fed. Cir. 1990) (discussing rules governing obviousness determination in case of chemical compounds and compositions); Beatrice Foods Co. v. New England Printing & Lithographing Co., 899 F.2d 1171 (Fed. Cir. 1990) (clarifying damages for patent infringement); Aerojet-General Corp. v. Machine Tool Works, 895 F.2d 736 (Fed. Cir. 1990) (clarifying damages for patent infringement).

[FN118]. See A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020 (Fed. Cir. 1992) (discussing laches and equitable estoppel in infringement actions).

[FN119]. See In re Alappat, 33 F.3d 1526 (Fed. Cir. 1994) (clarifying rules of patentability under section 101); In re Donaldson Co., 16 F.3d 1189 (Fed. Cir. 1994) (interpreting means-plus-function language in patent claim).

[FN120]. See Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512 (Fed. Cir. 1995), rev'd, 520 U.S. 17 (1997) (clarifying rules governing doctrine of equivalents and prosecution history estoppel); Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996) (ruling claim construction to be a question of law); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538 (Fed. Cir. 1995) (clarifying damages for patent infringement).

[FN121]. See In re Zurko, 142 F.3d 1447 (Fed. Cir. 1998) (applying clearly erroneous standard in review of fact-finding by Patent Office); Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448 (Fed. Cir. 1998) (holding that the Federal Circuit reviews claim construction de novo); Nobelpharma AB v. Implant Innovations, Inc., 129 F.3d 1463 (Fed. Cir. 1998) (concluding that Federal Circuit law governs patent misconduct under antitrust laws).

[FN122]. See Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356 (Fed. Cir. 1999) (holding that the Federal Circuit will apply Federal Circuit law in determining whether patent law conflicts with other federal statutes or preempts state law causes of action). In Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 187 F.3d 1381 (Fed. Cir. 1999), the court en banc identified five issues on the doctrine of prosecution history estoppel for further briefing, presaging a likely future en banc decision.

[FN123]. Markey, Remarks, supra note 74, at 211.

[FN124]. Llewellyn, supra note 11, at 252.

[FN125]. The court's recent order in Festo suggests that Judge Gajarsa's may, in fact, be correct. See Festo, 187 F.3d at 1381.

[FN126]. Glenn L. Archer, Introduction, 44 Am. U. L. Rev. 2109, 2111 (1995).

[FN127]. Wald, supra note 14, at 505.

[FN128]. See id.

[FN129]. During the early years of the Federal Circuit's patent jurisdiction, the Supreme Court granted certiorari on issues of substantive patent law only very rarely. However, the Supreme Court has taken at least one patent case in each of the last three years of the 1990s, "[a]nd increasingly the cases are on matters of core significance to patent law, not simply jurisdictional questions or cases interpreting special statutory exemptions." Donald S. Chisum, Nies Memorial Lecture: The Supreme Court and Patent Law: Does Shallow Reasoning Lead To Thin Law?, 3 Marq. Intell. Prop. L. Rev. 1, 3 (1999).

[FN130]. Sup. Ct. R. 10.

[FN131]. See id.

[FN132]. See 28 U.S.C. ¤1295(a)(1) (1999).

[FN133]. Wisniewski v. United States, 353 U.S. 901, 902 (1957).

[FN134]. Howard T. Markey, The Federal Circuit and Congressional Intent, 41 Am. U. L. Rev. 577 (1992); see also Michael Paul Chu, Note, An Antitrust Solution to the New Wave of Predatory Patent Infringement Litigation, 33 Wm. & Mary L. Rev. 1341, 1351 (1992) ("[The Federal Circuit is effectively the court of last resort for patent appeals because very few patent cases reach the Supreme Court.").

[FN135]. See Dickinson v. Zurko, 119 S. Ct. 1816, 1823 (1999) ("[W]hen a Federal Circuit judge reviews PTO factfinding; he or she often will examine that finding through a lens of patent-related experience--and properly so, for the Federal Circuit is a specialized court."); Rehnquist, supra note 93, at 184 ("[T]he Federal Circuit ... has made good progress in its aspiration to combine careful decisionmaking with a willingness to correct its own error in order to produce a substantial and consistent body of jurisprudence, which should rarely require Supreme Court review."); see also Allan N. Litman, Restoring the Balance of Our Patent System, 37 IDEA 545, 565 (1997).

[FN136]. See Dickinson, 119 S. Ct. 1816; Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996); Cardinal Chem. Co. v. Morton Int'l, Inc., 508 U.S. 83 (1993); Christianson v. Colt Indus. Operating Corp., 486 U.S. 800 (1988); Dennison Mfg. Co. v. Panduit Corp., 475 U.S. 809 (1986).

[FN137]. See Pfaff v. Wells Elec., Inc., 525 U.S. 55 (1998); Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997); Eli Lilly Co. v. Medronic, Inc., 496 U.S. 661 (1990). Arguably, Asgrow Seed Co. v. Winterboer, 513 U.S. 179 (1995), a Plant Variety Protection Act case, is a fourth such case.

[FN138]. In Hilton Davis Chemical Co. v. Warner-Jenkinson Co., 62 F.3d 1512 (Fed. Cir. 1995), rev'd, 520 U.S. 17 (1997), Judges Plager, Archer, Rich, Lourie, and Nies dissented, while Judge Newman added a concurring opinion. Pfaff v. Wells Electronics, Inc., 124 F.3d 1429 (Fed. Cir. 1997), aff'd, 525 U.S. 55 (1998), bore no panel dissents, and the dissents and concurrences in other on sale bar cases involving the required extent of development were largely confined to how the Federal Circuit's "substantially complete" standard was to be applied, rather than a challenge to that standard itself. See also Continental Plastic Containers v. Owens Brockway Plastic Prods ., 141 F.3d 1073, 1081 (Fed. Cir. 1998) (Newman, J., dissenting).

[FN139]. See William C. Conner, Speech at the Seventy Fifth Annual Dinner of the New York Intellectual Property Law Association, in 6 Fed. Cir. B.J. 363, 363 (1997) ("A number of federal judges, with an endearing excess of modesty, have professed to me that they know little or nothing of patent law. Actually the only difference between them and the Justices of the U.S. Supreme Court is that the Justices don't admit it."); see also Paul E. Schaafsma, High Court Displaying Patent Mistrust, Nat'l L.J., May 24, 1999, at C13 ("[T]he Supreme Court's emerging lack of trust of the Federal Circuit could inject new uncertainty into issues the patent bar believes are settled."). One commentator, however, implores the Supreme Court "to wake from its slumber and realize that patent law deserves its attention." Landry, supra note 75, at 1214. He does so out of his belief that the Federal Circuit is usurping power from the district courts by eschewing rules in favor of a "totality of the circumstances" approach. See id. One speculation, with the benefit of hindsight, is that the Court granted certiorari in Pfaff, 525 U.S. at 55, for that very reason. However, the Court stated that it granted certiorari in that case to resolve a split of authority involving 20-year old decisions of the Second and Seventh Circuits, a representation that has raised more than a few eyebrows in the patent bar. See Schaafsma, supra, at C15.

[FN140]. As Justice Frankfurter observed over half a century ago, "[w]isdom too often never comes, and so one ought not to reject it merely because it comes late." Henslee v. Union Planters Nat'l Bank& Trust Co., 335 U.S. 595, 600 (1949) (Frankfurter,J., dissenting).
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