REMARKS OF JOHN WITHERSPOON DELIVERED AT JANUARY 18, 2017 MEETING OF THE GILES SUTHERLAND RICH AMERICAN INN OF COURT

One summer night in 1926, while staying at the Willard Hotel, Giles Sutherland Rich made a decision that set in motion a chain of events that account for our being here tonight.

As a young man, he wanted to be a pilot, because, he said, he thought commercial aviation "might have a future." But he failed his eye exam. And so he had to look for a different career.

His father was a patent lawyer in New York. When he was growing up, Giles often visited his father's office and was intrigued by what he saw.

In the summer of 1926, he drove his father to Washington to interview some examiners. On the trip, he learned more about what his father did and why he liked it.

They stayed at the Willard Hotel, which was just across the street from the Patent Office in those days. It was there**,** he told a dinner audience celebrating his 90th birthday one evening in that very same hotel, that he decided to become a patent lawyer himself.

And so he got his law degree and embarked on what turned out to be a 27-year career in private practice. During that time, he came to greatly admire the work of Judge Learned Hand, and he sometimes visited his courtroom just to observe.

Then, in the summer of 1956, thirty years after that trip to Washington with his father, and three and a half years after passage of a new Patent Act that he had helped write, this technology-loving, photographer-extraordinaire, Harvard College and Columbia Law School educated, 52-year old New York patent lawyer moved to Washington, took the oath as an Associate Judge of the United States Court of Customs and Patent Appeals, began deciding cases and writing landmark opinions, and continued doing so until shortly before he died from lymphoma at age 95.

Early in the morning of June 10, 1999, Judge Raymond Clevenger sent this message to his law clerks:

"Judge Rich slipped away peacefully and quickly around 8 p.m. last night. We have lost one of the truly great jurists, and a genuinely wonderful man, but his time had come, which he knew and accepted with the grace that typified his every move."

Judge Rich never took senior status, and at the time of his death he was the oldest active federal judge in our nation's history. He never missed a day of hearings, which included 26 years of attending oral arguments at the CCPA, a five-judge Court that heard all of its cases sitting en banc.

For decades, Judge Rich was widely regarded as the foremost authority on United States patent law. Without question, he and Judge Learned Hand wrote more influential opinions in patent cases than any other judges in the 20th century.

He was the first patent lawyer appointed to the CCPA and, according to one writer, he was the first patent lawyer appointed to any court in the federal judiciary.

He authored 892 published opinions. They are all listed at the end of Volume 9, Number 1 (1999) of The Federal Circuit Bar Journal (subtitled "Tribute to the Life and Work of the Honorable Giles Sutherland Rich").

Also in that volume is an interview conducted by Professor Janice Mueller, one of his former law clerks. In the interview, Judge Rich explained why the "patent exhaustion doctrine" based on a "first sale" of a patented article by a patentee is "nonsensical."

His reasoning is very straight forward. The patent grant does not include a right to sell. A sale, then, cannot exhaust a patent right. There is no right to exhaust.

The results in the so-called "exhaustion" cases may be correct, he says, but the reasoning is wrong. The rights of the buyer are governed by principles of property law, or the law of sales, or both, and perhaps the antitrust law, but the patent law has nothing to do with those rights.

He concludes: "Let's clean up the thinking about this law." I hope one of you will accept that challenge. Now is a very good time.

During his 43 years on the bench, Judge Rich had one secretary and 39 law clerks. I was the sixth and served during the years 1964-1966. In February of 1966, the famous Graham v. John Deere case was decided by the Supreme Court.

Graham was the first case in which the Supreme Court considered section 103 of the 1952 Patent Act. Judge Rich was a principal author of section 103. He and a few others, including a highly respected member of the Patent Office Board of Appeals named Pat Federico, worked for years to get it enacted.

It was intended to put an end to the old case law "requirement for invention" that had grown up over the years. According to those cases, to be patentable, an invention had to "amount to invention." I'm not making this up! It was a vague and subjective standard. Judge Rich called it a judge's "plaything."

So, section 103 was enacted. And in 1964, Judge Rich titled his famous Kettering Award acceptance speech: "The Vague Concept of 'Invention' as Replaced by Section 103 of the 1952 Patent Act." In 1972, he titled another important speech: "Laying the Ghost of the 'Invention' Requirement." Both of these papers are found in Volume 14, Number 1 (2004) of The Federal Circuit Bar Journal (subtitled "Judge Rich Commemorative Issue").

But were the "vague concept of invention" and the "invention requirement" really laid to rest? For 60 years they were. But not now -- the judge's "plaything" is back. The Supreme Court has injected the notion of an "inventive concept" into section 101 jurisprudence. That phrase is just as vague, just as subjective, and just as mischievous today as it was in 1952.

Judge Rich must be turning in his grave!

Around the middle of the 20th century, there was another troubling development in the patent law. The patent misuse doctrine had been expanded to the point of essentially eviscerating the law of contributory infringement. Judge Rich once compared what was left of it to the smile that remained on the Cheshire cat in Alice in Wonderland.

And so, when he came into prominence, the patent system was very sick. Patent owners couldn't tell whether their patents were valid. And patents that were valid could only be asserted against direct infringers, lest their owners be held to have engaged in misuse. Both of these developments were the result of Supreme Court decisions.

Though it is not widely known, Judge Rich was the principal author of section 271 of the ’52 Act, which addressed the contributory infringement/patent misuse problem in its subsections (c) and (d).

This subject was of great interest to him early in his career. In 1942, at the age of 38, he published a series of articles, entitled “The Relation between Patent Practices and the Anti-Monopoly Laws.” They comprise the first five chapters of Volume 14 of The Federal Circuit Bar Journal that I just mentioned.

After the ‘52 Patent Act came to be, Judge Rich labored for more than a decade -- writing opinions, writing articles, and giving speeches -- painstakingly trying to educate the courts, including his own, patent examiners, and the bar of section 103’s very existence, first of all, and, secondly, of its significance.

It was a long, uphill fight. The Patent Office was especially resistant. Examiners continued their old ways of rejecting claims for “lack of invention.” I personally received such rejections ten years after the statute was enacted.

But the CCPA, led by Judge Rich, kept insisting that rejections be based on the statute. This was new for examiners, and required a different way of thinking. One career examiner and member of the Board of Appeals went so far as to say that Judge Rich was the “most hated man” in the Patent Office, and that I, as one of his former clerks, should not be on the Board.

My coming to the Board directly from the private sector was also disqualifying in the minds of some. It had not been done before.

Over time, attitudes changed and new thinking evolved. Twenty years later, Judge Rich had become one of the most admired and most respected men in the Patent Office. Watching that transition unfold over the years was truly a thing of beauty.

Watching his reaction to the Supreme Court’s decision in Graham on the day it was handed down was also a thing of beauty. To digress briefly, Judge Rich was fond of chocolate covered raisins. He kept a box of them in the top drawer of a file cabinet that sat in the room where I worked. From time to time, he would come in and take one, or perhaps two, little clusters of raisins, and then go back to work.

On the morning that Graham came down, George Hutchinson, the then Clerk of the Court, brought him a copy of the opinion. He took it into his chambers and closed the door.

He had reason to be concerned. The Court could have done a number of things not to his liking, such as finding the statute unconstitutional, or finding it to be a mere codification of the existing law.

After about an hour, he came out of his chambers and with a little smile on his face said: "Well, John, I think we've turned the corner." He then strolled over to the file cabinet and took not one, not two, but what appeared to be a handful of chocolate covered raisins!

Five months after his death, in November 1999, this Inn devoted its entire meeting to Judge Rich's life. I was invited to speak.

But rather than deliver a speech, I read a hypothetical letter that I had composed to Judge Rich's mother, Sara Sutherland Rich.

It went like this:

Washington, D.C.
November 16, 1999

Dear Mrs. Rich:

Tonight I will be talking to some fellow members of the Giles Sutherland Rich American Inn of Court about our namesake—your son—and I am writing to tell you what I plan to say.

He was a Master teacher—by which I mean he didn't teach at all. Those around him simply learned—as though by osmosis and by observation.

Working in his chambers was the lawyer's equivalent to a young engineer working in Edison's lab.

We observed a slow, deliberate reader—no speed reading courses for him—and always with a writing instrument in hand to make numerous marginal notations—including some with a bite!

We saw how he wrote—with utmost precision, conciseness and punch. He talked about making one's writing "march".

We observed a very analytical mind—one leery of so-called "doctrines" in the law, and one ever alert to "embroidering", a term used by him to describe the process of a first court paraphrasing a case holding—or worse yet a statute—followed by a second court paraphrasing the paraphrase, and so on, until the original holding becomes completely lost.

He fit the textbook description of a judge—intelligent, well-educated, possessing an in-depth working knowledge of the law, extremely dedicated and hard-working.

He looked like a judge. I shall always picture in my mind that tallish, erect, white-haired, stately figure, in his early '60s, walking down the marble corridor outside his then chambers.

He displayed a wonderful blend of the theoretical and the pragmatic—but with a strong tilt toward the latter.

He had a remarkable ability to clear his mind once a case had been decided, and to move on to the next with no lingering afterthoughts.

But there was much more to this man than his work. He loved science and he loved the law. But his greatest love of all, by far, was his love of his fellow man.

Through his example and encouragement, many of us were inspired to participate in bar associations, to teach, and to otherwise give back to the profession.

He especially enjoyed young people, and to learn about their lives. As was the case with his nearly 40 other clerks, our family became part of his.

When asked about the things she remembers, my wife said she will never forget "that photographer", who showed up at Sibley Hospital, and took about a dozen pictures of our only child when he was just a few days old.

I interviewed for my clerkship in June 1964—35 years almost to the day before his death. He asked me a number of questions about my wife, which I found

rather puzzling. The puzzle was ultimately solved, but not until years later—in 1991.

On October 1st of that year, our Inn held its inaugural meeting. He had been asked to speak about his life. It was a beautiful speech.

He spoke about many things. One—"an important subject" he called it—was about the three women in his life.

He said you were the first, and that you were a very strong influence on him. He described you as a calm, collected person who subtly influenced her "little boy" (his words) to be a thoughtful person.

One thing he said you taught him early in the game (as he put it) was this little verse, which he recited from memory:

> The wise old owl, lived in an oak
> The more he saw, the less he spoke;
> The less he spoke, the more he heard.
> Why can't we be like that old bird?

Well, Mother Rich, your "little boy" turned out to be exactly like that "old bird."

The other two women in his life, he said, were the two he had been married to—the first for 22 years before she died—and the second for 38 years at the time of his talk. He said they both "filled gaps in my education, making me into whatever I now am." This from a graduate of two of our finest schools! I thought it spoke volumes about the character of the man. It also solved my puzzle.

I must stop now to allow others to speak. I don't know quite what they will say. But I do know this: After all have spoken, everyone tonight will agree that the likes of your son bring to mind these words from Romeo and Juliet:

> When he shall die,
> Take him and cut him out in little stars,
> And he will make the face of heaven so fine
> That all the world will be in love with night.

Thank you, Mrs. Rich, for sharing him with us.

Sincerely,

John Witherspoon

So what is his legacy?

As I indicated, when he came on the scene around the middle of the last century, the patent system was on life support. And it had been that way for quite a few years.

The system was not respected and had little support from decision-makers in this town. Some would have been pleased to see it die.

A federal judge opined that the patent system had outlived its usefulness when, according to him, large corporations were getting all the patents. Another federal judge called the Patent Office the "sickest institution our Government has ever invented." A Supreme Court justice described patent examiners as "minor bureaucrats" who sit at desks and dole out monopolies in secret proceedings.

Many people did not consider patent lawyers to be lawyers at all. They were considered "nerds" who practiced science, not law. Almost all of them practiced in small boutique firms. Patent law was taught in only one or two of the country's law schools. The few patent law associations that existed had little influence on Capitol Hill.

But today things are quite different.

The patent system is widely considered to be a strong economic engine. It is supported by politicians in this town at the highest levels. Patents are sought in greater and greater numbers, because they have value. Patents are enforced and licensed more than before.

Many patent lawyers now practice in general practice law firms. Intellectual property law associations have sprung up all over the country. Patent law is now taught in a great many law schools.

What brought these changes about?

Many things contributed, not the least of which was the creation of the Federal Circuit.

But in my mind three things stand out above all else: (1) the enactment of section 103, (2) the enactment of section 271, and (3) the decision of the CCPA in In re Chakrabarty, which was affirmed by the Supreme Court in 1980 and which was critical to the development of the modern biotech industry.

These are foundation stones.

They are foundation stones that the Federal Circuit had the good fortune to inherit at its inception. They are foundation stones that, with the aid of sound decisions by the Federal Circuit, enabled the patent system to come back to life and to flourish. And they are foundation stones – all three of them -- that are the work product of Giles Sutherland Rich.

So if you want to find his legacy, just open your eyes and look around.

And don't forget. It all started with a failed eye exam!