

New Judge Tries His First Patent Case

Harold R. Medina

Follow this and additional works at: <http://scholarship.law.cornell.edu/clr>

 Part of the [Law Commons](#)

Recommended Citation

Harold R. Medina, *New Judge Tries His First Patent Case*, 34 Cornell L. Rev. 220 (1948)

Available at: <http://scholarship.law.cornell.edu/clr/vol34/iss2/4>

This Article is brought to you for free and open access by the Journals at Scholarship@Cornell Law: A Digital Repository. It has been accepted for inclusion in Cornell Law Review by an authorized administrator of Scholarship@Cornell Law: A Digital Repository. For more information, please contact jmp8@cornell.edu.

A NEW JUDGE TRIES HIS FIRST PATENT CASE*

HAROLD R. MEDINA

As I look back, I cannot quite understand how I agreed to relate this story. As I expect to tell the truth, the whole truth, and nothing but the truth—with perhaps a little exaggeration here and there—I am sure to place myself in a very sorry light. But confession is good for the soul, and it may be that my experiences can afford some pleasure and profit.

When I was sworn in, I had a vague horror that some day I would have to try a patent case. I had heard stories of how good particular judges were at the trial of patent cases and I had a feeling that a patent case was ushered in with considerable ceremony. But as I went through a month of admiralty in October and a criminal term in November, I forgot all about the bugaboo of a patent case and looked forward with some pleasure to the December Term when I was to try equity cases. "Well," I said to myself, "at least then I shall have a chance to work on familiar ground. Perhaps I shall be fortunate enough to get some interesting case with actors and actresses in it, or involving an allegedly obscene book or some other juicy subject, the decision of which will depend upon principles at least slightly familiar to me."

So, one day, as I was finishing my last admiralty case, I was told that my first equity case was being sent up to me. When I left the bench that afternoon what was my amazement and dismay to find in my chambers a nice little patent case with voluminous briefs submitted by each side. My first impulse was to reject it with scorn. But then I said to myself, "I shall have to make the fatal plunge some day, why not now?" I began studying the papers. The pleadings looked innocent enough, although not very informative. So I began wading into the briefs. When I was at the bar, I always used to make it a point to make a trial brief a detailed factual affair with just enough law to cover the vital spots. Incidentally, I never had any sympathy for the contention that lawyers should exchange trial briefs. As a very young man I had done that once only to find that my detailed revelation of our version of the facts had served no other purpose than to permit our adversary to patch up the weak spots in his armor.

But here were two briefs that did not discuss the facts at all. "Well," I thought, "perhaps the facts are so simple that no discussion is necessary. Anyway, I see plenty of law here and I had better get busy with it."

*From a speech delivered at the 25th Annual Dinner of the New York Patent Law Association, March 1948, New York City.

As I look back, I don't see how it was possible for the lawyers to cite so many cases. The first couple of nights before the trial, books were strewn all over my chambers—hundreds of them. All the principles relied upon were new to me, but the worst was that every patent case has some detailed factual background which has a perfectly bewildering effect on the uninitiate like myself. I had put in fifteen or twenty hours of the most unremitting toil before it dawned on me that each side was citing ten cases for each proposition, and that I was just wasting my time reading nine out of every ten of them. Of course, I had been foolish enough to think that there was some sense in these masses of decisions and that each one had some little point in it that had particular bearing on the case before me. This was sheer illusion, and my feverish reading left nothing but chaos. Perhaps my sub-conscious mind was picking up a little here and there, but my conscious mind was a complete blank.

The trial started. Evidently the lawyers had expected to open for five or ten minutes, just touching the high spots. If so, they were sadly disappointed. I had made up my mind that even if it killed the lawyers and me, I was going to understand everything that went on from the bell in the first round. Accordingly, the plaintiff's lawyer had not gone far when I said that I should like to know exactly what the issues were. This came as a distinct shock, and a prolonged discussion ensued. The defendant's lawyer had interposed a counterclaim praying for a declaratory judgment, and the more we talked about issues, the the more the issues piled up. I suggested that it might be enough for me to pass upon the question of infringement, as that looked comparatively easy, and not bother about the question of validity. Oh no, nothing like that! I was informed that the Circuit Court of Appeals had been most explicit that judges were not to resort to such lazy tactics, but must decide all the issues. Then it seemed as though the principal issues of validity concerned certain method claims, but the defendant's lawyer insisted that the apparatus claims of the particular patent in question were in issue and that there was also before me the validity of a number of prior patents and so on and so forth. It did not take me long to recognize my error. I changed the subject and bided my time. A few days later the plaintiff's attorney was urging some proposition, and the defendant's attorney objected on the ground that it was not presented by the pleadings. This gave me my chance and so I said, "Well, you asserted that all these claims, not only in this patent but in the earlier patents, were involved. Perhaps it would be fair to permit the plaintiff to amend so that all of the defendant's patents may

be in issue too." This had an immediate effect—a stipulation which limited the issues to the method claims. All the big talk that the case involved everything since the beginning of the world to the time of these presents disappeared in thin air.

There was another point that I expressed on the opening day of the trial. As the patent had issued, it seemed to me that there must be some kind of presumption of validity—that I should start the case with the notion that the patent was valid until somebody showed me it was invalid. Here again I was told that this was old-fashioned; that there was something which some old cases had spoken of as a presumption of validity, but that the Supreme Court had pretty well knocked that into a cocked hat. Furthermore, I was told, if a person wanted to be realistic, he really ought to start with the presumption that the patent was invalid. So we didn't get very far with that. I have never taken much comfort from rules which helped judges evade issues, and I was just as pleased to try first to understand what the plaintiff had invented and whether it was something really new, leaving technicalities of presumption to play their parts later when I knew more about the case.

After a couple of days of this jockeying around, we began to hear some testimony. It soon became apparent to me that the case involved a number of scientific principles of hydraulics and hydrodynamics and fluid mechanics, about which my ignorance was utterly complete. As a matter of fact, one day I made the statement that my ignorance was abysmal and this so shocked the reporter that when the minutes were typed up and sent to my chambers, they read my "knowledge" was abysmal. I suppose he thought that abysmal knowledge was profound knowledge and that it was much better to have the judge say he knew it all than to have him say he knew nothing. But nothing was right.

As I had developed a good many rather intimate contacts over a period of years at Columbia and Princeton, it occurred to me that perhaps I should get hold of some physics professor at either university and have him explain the whole matter to me from an utterly disinterested angle. But then I thought, suppose I were one of these lawyers—how would I feel if the judge got outside information about which I knew nothing and which was not subject to my cross-examination, and I wound up taking a licking because of some source that remained completely hidden and mysterious? That was the end of idea number one, for I could not see how it would be proper to fill my mind with data and information from a source not of record in the case. Besides, I knew that a little knowledge is a very dangerous

thing and it seemed highly probable that, after a few conferences with some university professor, I might think I knew all about the subject when I only knew just enough to make it a certainty that I would be wrong on every point.

Next I thought that at least I could study the text books and instruct myself in this way. A little reflection, however, brought me back to the same conclusion I had reached on the first proposition. So I left the text books alone, although I was dying to learn about the characteristics of a vortex, and particularly a hollow core vortex, together with a large number of other most interesting matters which I could scarcely refrain from studying on the side. But I didn't. Instead I bedeviled the witnesses with all kinds of absurd questions and I imagine the lawyers felt each day as though they were going into a torture chamber.

Then, one morning, someone produced the File Wrapper and tossed that in evidence. As everyone seemed to recognize the fact that this massive document was admissible, I could hardly wait for the first recess to take possession of the File Wrapper to familiarize myself with its contents. Accordingly, after spending half the night on the File Wrapper, I returned to court the next morning full of questions. I had hardly started when the very man who had put the File Wrapper in evidence protested loudly that it had practically nothing to do with the case, and that nothing could be more obnoxious than to fill my mind with erroneous notions based upon the progress of the application through the various proceedings in the Patent Office. I was told in a most positive way that the File Wrapper only came into the case when there was some question of estoppel, and that there did not seem to be any question of estoppel in this case. After hearing argument pro and con for some little time, I finally decided that I had better lay the File Wrapper aside.

Then I got another bright idea. It seemed to me that I might be in a better position to understand the evidence if I went and looked at the various machines in operation. This seemed to strike both sides as a most amazing proposition, but they all agreed. So one day we made a long trip by automobile. The first place we visited was a paper mill where a huge machine was ready for operation. The workmen took me just opposite the place they would work, where I could get an excellent view. First they put a few tons of so-called water into the receptacle and then one of the men heaved a huge bale of waste paper into the tank. I was spattered with paper stock from head to foot. The resultant excitement somewhat impaired the validity of the experiment. I was told that all those paper spots would come off with a

little brushing when they dried. That night I went to work with the brush, but when it became apparent that there would be nothing left but the lining of my suit, I sent it to the cleaners. I really think the trip was a good idea, but I don't think I shall try it again. My education was proceeding very rapidly.

By this time I was enjoying myself. Every day there were a number of experiments in the court room which were really fun. Also, I had taken charge of the exhibits and this is something I always like to do. I am one of those methodical individuals who never throws anything away and who takes great joy in collecting, tabulating, indexing and preserving all sorts of useless things. It is surprising to what extent such character traits are affected by little occurrences in our youth. Shortly after I started in as a law clerk, the office had a long complicated case involving four or five hundred exhibits which were put in my charge. I had a folder for each exhibit and two huge packing cases. For the first week of the trial I was getting exhibits out and putting them back and keeping track of them, having a wonderful time. One day in the mid-morning recess Julien T. Davies, who was our chief counsel in the case and the head of the office where I was employed, was standing in the middle of the court room with four or five of the older leaders of the bar of a generation ago, including Delancey Nicoll. To my surprise, he called me over, turned to the other men and said, "Mr. Nicoll, I want you to know young Medina. He is the man who has been doing such a grand job with these exhibits." And so he introduced me to the other lawyers. For a couple of weeks after that I was floating on air. So you can see how it was that in my first patent case I soon took charge of the exhibits, and had them placed on either side of the judge's bench, arranged so that when anyone wanted an exhibit, I could get it out and see that it was returned to its proper place right away.

With continually asking questions and handling the exhibits during the day, and sitting up half the night reading opinions, I was beginning to catch on a little bit. So I got the lawyers together and said, "Now, I think we had better decide just how we are going to proceed." Then I laid down a *modus operandi* which must have come as a distinct shock, but I still think it was the best procedure to follow. This was the arrangement. On the date the evidence was to be closed, each side was to have ready its final brief. At this suggestion there was a tremendous howl. That just wasn't done. Ordinarily counsel had three or four months to put in the briefs, and then another month or so for reply briefs and so on. But I was adamant. It was finally agreed that on the

day of closing the evidence the briefs should be in. Then we were to have a full day to study the briefs in preparation for the final argument. "Now," I said, "this final argument is really going to be decisive; we will take all the time we need, but when the last lawyer sits down at the end of the final argument, somebody is going to take it in the solar plexus." "What," said one of the lawyers, "your Honor doesn't mean to say that you are going to decide the case immediately?" "Yes," I said, "that is precisely what I am going to do." And it is precisely what I did do.

The final argument went on for two or three days. I let each of the lawyers have twenty books which could be referred to and discussed in the final arguments, but I would not allow three or four hundred of them and again suffer the endless repetition I had endured at the outset.

To show how foolish I was, it was my intention, when the final arguments had been concluded, to lean back and dictate the opinion. As it turned out, so many details were explained for the first time in the final arguments that I just did not feel equal to the dictation of the opinion on the spot. But I did the next best thing. I decided the case immediately, and then set up the procedure to be followed in connection with the findings. First I was to prepare the opinion in draft form, a copy to be given to each side. Only the successful party would prepare proposed findings. These were to be served on the other side. Then we were to have a further hearing at which the losing party might criticize the proposed findings and offer suggestions of his own. Both sides were to have the privilege of attacking any of the statements of fact in the draft opinion. By dealing with everything in the open and checking and double checking against the testimony and exhibits, I thought I could come as near as was humanly possible for a person of my equipment and limitations to decide the case right.

I wrote my draft opinion on schedule. That was way back last January. The minute the pressure was off, other matters turned up to demand attention. The result is that we haven't had that hearing on the findings yet; but we will and when those findings are made you can bet your bottom dollar that they are going to be findings that represent precisely what I desire to find and absolutely nothing else. I have been beaten so often at the bar by phony findings that while my strength lasts you may be sure that no finding ever signed by me will represent anything other than my own considered judgment.

That's the story. I haven't any idea that I am right in the case and I have enough sense to realize that my enthusiasm and efforts to con-

centration will probably all wear off in time. But, so far, I have done just what I always thought I should do. It ought to be a simple matter for a judge, particularly when he sits in an equity case, to go step by step through the trial with complete concentration. But it is turning out to be an infinitely more difficult task than I ever thought. Each one of us has only a certain amount of physical energy, and it is hard it is to do a one hundred percent job when completely fagged out.

And so I hope no one will be surprised if three or four years from now I am found solemnly listening to the evidence without comment, letting the lawyers explain as much or as little of the case as they choose, allowing three or four or even five months for briefs and reply briefs and then sitting on the case for a year or two. I know I shall not be surprised—or resentful—if as time goes on the proper lesson is drawn from this narrative, and attorneys see to it that their patent cases go to someone else.