

IF YOU CAN'T BEAT THEM, JOIN THEM? THE IMPACT OF “SITTING BY DESIGNATION” ON CLAIM CONSTRUCTION REVERSAL

Shawn P. Miller*
(smiller@law.stanford.edu)

ABSTRACT

On January 4, 2011, Congress created the Patent Pilot Program under the theory that with greater experience participating district court judges will do a better job adjudicating patent disputes. But whether this program is a success depends on the type of experience, if any, that leads judges to make better decisions, often measured as Federal Circuit agreement. For example, Schwartz (2008) found that district judges with prior claim constructions reviewed on appeal are not more likely to have their claim constructions affirmed on appeal in subsequent cases. At least by this measure, experience through Federal Circuit teaching and district judge learning does not appear effective. In this paper, I investigate the impact of a novel measure of experience, whether a district court judge has sat by designation on a Federal Circuit panel in a claim construction appeal, on the likelihood a district judge's claim constructions are reversed. While this is not the type of experience Patent Pilot Program judges will obtain, it is statistically effective. Before sitting by designation, judges who later do so actually have a slightly higher claim construction reversal rate than judges who never do so. After sitting by designation, the reversal rate of district court judges on subsequent claim construction appeals decreases by 50 percent. This decrease is not fully explained by other measures of experience, including the number of prior patent cases or years on the bench. Nor is it fully explained by the timing of the appeal, the particular district court judge or various other characteristics of the patents, the parties and the litigation. Thus, these results suggest an alternate way to increase district judge and Federal Circuit agreement beyond the mechanisms the Patent Pilot Program facilitates.

* Olin-Searle Fellow in the Stanford Program in Law, Science and Technology and Adjunct Professor, University of San Diego. Ph.D., George Mason University; J.D., Notre Dame Law School; B.S., University of Notre Dame.