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Down With Patentese

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Judicial opinions are directed at many audiences. Most immediately, they are directed to the parties, explaining the reasons for the court's decision. Judicial decisions are also written with one eye cocked on anticipated review by an appellate court. Further, if the decision deals with a novel or uncertain issue, the opinion will likely contain enough background information, both factual and legal, to make it of use to lawyers and judges in future cases. Beyond all this, however, judicial opinions are, in many cases, intended to be read by interested members of the lay public. This is not only because the controversies with which law deals are often of interest and importance to the lay public, but also, more fundamentally, because judges, as wielders of power in a democratic society, owe it to that society to explain their rulings.

Judicial opinions, then, should be written in language that a reasonably educated lay person may understand. Technical terms should be eschewed if possible, and, if unavoidable, should be explained. For example, Latin phrases—a carryover from medieval times—are inherently suspect, since they frequently serve to camouflage imprecise reasoning. Would any sensible judge ever instruct a jury hearing a criminal case that they were required to find that the defendant possessed "mens rea"? No, the judge would use everyday language like "knowing he was doing wrong" or "intending to cause harm" to denote the specific state of mind required. Yet, by using "mens rea" in a judicial opinion, a court may gloss over distinctions that are crucial to the case.

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These observations are prompted by this writer's belief that the use of misleading jargon is particularly prevalent in patent cases. Why this should be so, I am not sure; but what makes the use of jargon in patent cases particularly pernicious is that it frequently involves the use of ostensibly everyday words to convey obscure meanings. Take the phrase "reads on." To the everyday English reader, "read" is a transitive verb, as in "I'm going to read this silly article," and "on" is a preposition that would only follow "read" in unusual circumstances, such as "If you insist on reading aloud, please go read on the balcony." But to patent lawyers, "read on" is a verbal phrase that has no precise meaning but generally relates to the relationship between a patent claim and prior art. Thus, Black's Law Dictionary defines "read on" as "(Of a patent claim) to contain all the same features of (a prior art reference),"[1] a definition that would surely leave even an ordinary law student who had not had patent law scratching her head. And the use of the term in judicial decisions is, if anything, more imprecise.[2] But, let us not stop there—please read on:

Another example of obscure patentese is "teach," particularly when modified as in "teach toward" and "teach away." In ordinary English, "teach" is a transitive verb meaning to instruct. It is hard to think of any ordinary sentence in which it could be sensibly coupled to "toward" or "away." But in patent law, according to Black's Law Dictionary, "prior art that discourages an inventor from pursuing an invention 'teaches away from' that invention"[3] (and, conversely, prior art that encourages an inventor to pursue an invention "teaches toward" that invention). Moreover, according to the Federal Circuit, "What the prior art teaches and whether it teaches toward or away from the claimed invention also is a determination of fact."[4]

This means that a jury has to be instructed as to what is meant by "teach toward" and "teach away." Good luck. Although one

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1 BLACK'S LAW DICTIONARY 1378 (9th ed. 2009).

2 *See, e.g.*, Bid for Position, LLC v. AOL, LLC, 601 F.3d 1311, 1316 (Fed. Cir. 2010) ("[W]e agree with the court that the '151 patent does not read on a system that simply selects the highest ranking position of priority that is available for the offered bid . . . .").

3 BLACK'S LAW DICTIONARY 1601 (9th ed. 2009).

4 Para-Ordnance Mfg., Inc. v. SGS Imps. Int'l, Inc., 73 F.3d 1085, 1088 (Fed. Cir. 1966).

could multiply these examples without difficulty, let us limit ourselves to just one more: "prosecution," as in "prosecution history." In everyday English, "prosecution" is a noun meaning the conducting of a criminal proceeding. But in patent law, it is an adjective that, when coupled with the word "history," is, according to Black's Law Dictionary, a synonym for "file wrapper."[5] Wow, that's helpful.

And what is a "file wrapper?" It is, according to Black's Law Dictionary, "the complete record of proceedings in the Patent and Trademark Office"[6] regarding a given patent. Would it be so hard for patent lawyers and judges to simply refer to "the history of proceedings in the Patent and Trademark Office?" What does calling this a "file wrapper" (which sounds like something you might buy at Staples) or, worst yet, a "prosecution history" (which sounds like something used to deny bail) add except obscurity?

In these and other examples typical of patent law, one may infer that the original intent of the person who coined each of these obscure uses of everyday words was to try to find a shorthand way to express a difficult concept. But the result is that the use of the word renders the sentence unintelligible to the person unfamiliar with its obscure meaning, and imprecise to the person who is so familiar.

Although I haven't checked, I feel sure I have sinned in the past and used all the above terms, and others like them, in my own decisions in patent cases. For this, I should be prosecuted, or at least given a good wrap. But I hereby resolve in the future to write decisions in patent cases that anyone may understand: and I hope, dear reader, that you will do likewise.

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5 BLACK'S LAW DICTIONARY 1341 (9th ed. 2009).

6 *Id.* at 704.