Exclusive Interview: Superstar CAFC Advocate Don Dunner

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On two different occasions I had the privilege of interviewing the Honorable Paul Michel, the most recent former Chief Judge of the United States Court of Appeals for the Federal Circuit. In the final segment of my second interview with Chief Judge Michel we talked about appellate advocacy in general. The conversation turned to the type of appellate advocate parties should be looking to retain when in front of the Federal Circuit. Near the end of that conversation Chief Judge Michel said: "Don Dunner is a good example of somebody like that. Chemical engineer, lifetime patent lawyer, appellate specialist, wrote a treatise about the Federal Circuit. Covers all the bases. Argues in the court very, very, very frequently, and has for decades. He's an example of a superstar advocate in my opinion." With such lofty praise I had to interview Don Dunner.

Don Dunner is a partner with Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, and he has argued over 150 cases before the Federal Circuit. I contacted Don Dunner in mid-January 2011 and our interview took place shortly thereafter. Dunner was enormously candid, although many of the things I would have liked to ask him had to be off the table due to ongoing litigation. In fact, Dunner is involved in three exceptionally important cases: *TiVo v. EchoStar*, *Microsoft v. i4i* and *Uniloc v. Microsoft*. Thankfully, Dunner did agree to return to talk to us further once these important cases finally resolve without further opportunity for appeal. We did, however, go in depth discussing *eBay v. MercExchange*, the dynamic between the Supreme Court and the Federal Circuit, how he approaches appeals generally and specifically blow-by-blow and which Federal Circuit Judges ask the toughest questions.

Without further ado, my interview with Don Dunner.

QUINN: First off I just want to thank you very much for taking the time to chat with me today. I appreciate that.

DUNNER: I'm happy to do it.

QUINN: The genesis of my interest in talking to you started when I talked with Chief Judge Michel in September. I interviewed him and we talked about appellate advocacy for quite a while. And he named you specifically as an example of an excellent appellate advocate at the Federal Circuit. So I thought it would be interesting to talk to you. Maybe we could start off with — how do you become an appellate advocate with such a great reputation?

DUNNER: Well, I think the short answer is that it didn't happen overnight. It was a combination of events that led me to the point where I spend a lot of time and take great pride in my Federal Circuit practice. And it really started with the fact that I was a law clerk at the predecessor of the Federal Circuit, the Court of Customs and Patent Appeals. I was a law clerk for the then Chief Judge of the Court of Customs and Patent Appeals, Noble Johnson. And that goes back almost to the beginning of time, I guess, 1956 through 1958. I spent two years there and got a very liberal education in appellate practice. And when I left that court and went into private

practice, I naturally got pulled into cases which were then before the Court of Customs and Patent Appeals, brief writing at the very beginning; it didn't really evolve into oral advocacy until some point at a later time.

And then I remember distinctly in 1964, which was six years after I left the court, I was asked to give a speech at the John Marshall Law School. And I chose as my topic notable patent cases that had been decided by the Court of Customs and Patent Appeals. And one of the co-lecturers at that conference was a professor whose name is Jim Gambrell, who became a life-long friend and who unfortunately just recently passed away. But through my participation in that conference, I got to know Professor Gambrell pretty well. At that time, he was collaborating with another professor, Irving Kayton, who was very well known and who was head of the patent law program at GW Law School. And shortly thereafter, Professor Kayton got me involved in putting on a two full day course at the GW Law School on practice before the Court of Customs and Patent Appeals. As a condition of my giving that course, he asked me to write what essentially was a book. I then wrote a book on the Court of Customs and Patent Appeals, not on substantive practice before that court, but on the procedural practice before that court. And the goal of this book and of this course was basically to spoon-feed students about appellate advocacy.

The greatest lesson I had ever had on the subject was my very first trial, not as an appellate lawyer but as a trial lawyer in the Supreme Court in New York, which is New York's lowest trial court. My first case put me in a situation where I didn't know what table to sit at; I didn't really know anything about trial practice. I tried to attend a trial before mine started, but my trial was the first trial of the year in October and New York State had just changed its rules. So I decided that if I was ever going to write a book or give a course it would teach people all the basics they needed to know about practice before a court. So I wrote what became a two volume text, which ultimately was published by Matthew Bender, on spoon-feeding practitioners as to how to try an appellate case before the CCPA from the beginning of the case to the end. It was filled with forms. It was filled with detailed text. I reviewed every procedural case that was published in the BNA patent quarterly from 1929 on, which is when the CCPA started. And that became a full-blown course at the GW Law School, which I taught for about 12 years until the CCPA was replaced by the Federal Circuit. Then there was a two or three year lapse and I finally converted that to a Federal Circuit text.

Well, during the course of all this teaching and writing and speaking, my name became known to various and sundry people. I started out with a case here and a case there and, before you knew it, I had argued over 150 cases before the Federal Circuit, which is about where the number is right now, supplemented with arguments before the 1st, 2nd, 3rd, and 6th Circuits, and the Delaware Supreme Court. So it was a long, slow process, and for anybody who thinks that it happens overnight, my experience is to the contrary. It happens over a long, long period of time. And you have to live a long, long period of time to achieve that kind of background in appellate practice. So that was a long answer to your very short question.

QUINN: No, I think that that's great. Because what comes through whenever I talk to folks like you is the harder you work the luckier you get, as that old saying goes. It's always, always true.

DUNNER: (Laughs) Yeah, that's exactly right.

QUINN: And now, let me just ask you this. As you were setting out at the beginning, though, did you really have a sense that you were laying the foundation? Or were you maybe, I guess what I'm trying to say is were you intentionally laying this foundation, or were you just taking opportunities and then at some point you saw where it was all going and then you started to capitalize?

DUNNER: No, I certainly was not. I did not have this exact career path in mind. Although Professor Kayton always used to say that he would make me the world's most famous appellate patent attorney, I took that with a grain of salt. I took the cases as they came, but I certainly enjoyed the appellate work. I enjoyed teaching, I enjoyed writing and lecturing. And so it just naturally led to that. But I certainly did not know in 1956 that I would ever become what you might characterize as an appellate lawyer.

QUINN: Well, that's interesting. It's always interesting to hear how people set out and achieve success in a niche that they carve out for themselves. And you have carved out quite a niche. I was looking at a lot of the cases that you have argued and it's impressive the number of very important Federal Circuit decisions that you've been involved in. One of the ones that caught my particular attention, because it's something that I've been writing on a lot lately myself, is the *eBay v. MercExchange* case. And I was wondering if maybe you could talk to us a little bit about that and maybe how you got involved in that and procedurally a little bit about the case.

DUNNER: Well, my involvement in the *eBay* case was actually in a way a peripheral involvement. eBay approached me and asked me if I would collaborate with it and its appellate counsel in presenting its case to the Federal Circuit. I was not the principal lawyer in the case, but they asked me to argue half of the case. But it was the half that dealt with the issue that went to the Supreme Court, and that was the injunction issue in the case. So I actually participated at the very tail end of the oral argument and restricted myself to the injunction issue and perhaps another small part of the case.

Unfortunately, at the time, eBay was fighting the very routine response that the Federal Circuit had to the issuance of injunctions. At the time, the Federal Circuit had an almost reflexive reaction to injunction issues in patent cases. Stated differently, the Federal Circuit felt that if you won, if you're a patent owner and were victorious at the trial level, an injunction should follow almost as a matter of right. There were a few cases where the Federal Circuit did not have that reflexive reaction, and that was in cases with a public interest. Unless you were a pharmaceutical patent owner, or had a patent involving a healthcare product, if the patent owner was not ready, willing, and able to fill the public need for the product or the process involved, the court would almost routinely support the granting of an injunction. And the *eBay* case was not that kind of a case. And so I knew at the time that I was climbing a tall mountain and trying to swim upstream because *eBay* was fighting the grant of an injunction which basically did not involve one of these strong public interest issues. And so nobody could have been very surprised when the Federal Circuit sustained the grant of an injunction.

I was not involved in the oral argument at the Supreme Court level, but the fact that the Supreme Court issued its opinion as it did should also not have been a surprise to anybody, that is the ruling in favor of *eBay*. The Supreme Court in recent years has come out strongly against bright line tests in the patent and other fields. It has done that in the *KSR* case, it's done that in the *Bilski* case. And so *eBay* was one of those types of cases which at the time fortunately resulted in the vindication of eBay's position on the injunction issue. I've been involved in a couple of other cases which have gone up to the Supreme Court. Unfortunately, I've not ended up arguing any of them. And one of my cases is now before the Supreme Court, the *i4i* case.

QUINN: Yes, and I would love to talk to you about that, but I know that that's probably got to be off limits for now. And I won't put you in a difficult position. But maybe after that whole thing gets resolved, if we could chat briefly that would be wonderful.

DUNNER: I would love to, particularly if the Federal Circuit decision is sustained.

QUINN: Yes. Now, one of the things you were just talking about is this idea of the Supreme Court and bright line rules and that is a hot button issue at the moment. And maybe you don't want to go there because I think it's a hot button issue because of *Microsoft v. i4i*. And people are looking at trying to guess what the Supreme Court might do. And for me, I think I have a pretty good idea what they're going to do. But I think what they are likely to do is causing a number of folks in the industry to question whether this aversion to bright line rules is really the right approach? And I'll give you a for instance, and then maybe just let you comment and go wherever you want to go with it. In the situation where you have with the *eBay* case and you're saying no to an injunction as a matter of right even though the patent grant is an exclusive grant, and then in *KSR* you're talking about a case-by-case "common sense" approach to obviousness, it makes it much easier to invalidate

patents. It seems as if we're in an era where there is pulling back, retreating on the strength of the patent. And I personally wonder whether that's a good thing at the end of the day.

DUNNER: Well, I'm certainly a great believer in the patent system. What you may or may not know is that I was very much involved in the early days in the formation of the Federal Circuit. Just before the Federal Circuit was formed; I was president of the American Patent Law Association, which is now the American Intellectual Property Law Association. And in that role I ended up being a member of various presidential commissions which ultimately led to the formation of the Federal Circuit, and I testified before Congress in support of the court. One of the reasons for the formation of the Federal Circuit was the problem with the lack of uniformity in the application of patent law, because the responsibility for interpreting the law was spread among the then 12 different circuits before the Federal Circuit was formed. The whole purpose of forming the Federal Circuit was to eliminate the scatter-shot approach by the various circuit courts to the application and interpretation of the patent law. So having the law develop to a point where you have less uniformity, less certainty, is a problem. And while it is clear that the Supreme Court does not like bright line tests, and that the Federal Circuit has got to follow the Supreme Court's guidelines, there are certain areas, not all areas, but certain areas, where there's a tension between having something other than a bright line test and having uniformity in the law.

The *KSR* case is a perfect example. The Federal Circuit had a test which was designed to provide predictability to companies in research and development or who were investing in patent technologies and innovation, and the Supreme Court basically said you can't have that bright line test. I don't think that's a good idea. In the injunction area one can argue that maybe that goal is not as critical because after all, you're talking about when an injunction should issue and when an injunction shouldn't issue, and that kind of issue comes up not only in patent cases but in many other cases. So there's a tension between the Supreme Court's aversion to bright line rules and uniformity in the patent law. And in those areas where that tension is great, I think the need for a bright line rule may not be as important. So you constantly have to look at what is the issue involved. Is a bright line rule really critically important, or is a bright line not critically important. So I agree with you that in areas like *KSR*, I think the tension should resolve in favor of uniformity. But there are other areas where maybe the tension should resolve in favor of not having bright line tests. And I'm not sure the Supreme Court is cognizant of the importance of resolving that tension in the right direction.

QUINN: Yes. And sometimes I would say, and I may go one step further and say, sometimes I'm not sure that the Federal Circuit is cognizant either, along the same lines with respect to the impact it has on patent prosecution. Because when dealing with matters of patentability and matters routinely adjudicated by patent examiners and the board, bright line rules are very important. There are 6,300 plus patent examiners, many, or you could say most of who are not patent attorneys; they're science experts. And I wonder how much the Supreme Court factors that in. And in some cases I wonder how much the Federal Circuit considers what really goes on at the Patent Office. And I know that maybe it isn't so much a question, but maybe I'll throw it to you to just get thoughts, if you have any.

DUNNER: Well, I think there's something to be said for the point you're making. The Federal Circuit, for example, often talks about, well, you can eliminate this problem, that problem with proper claim drafting. And that is not always possible. If it is possible, it's not always feasible. And if it is feasible, it does not always take into account the realities of patent prosecution, of drafting claims and what have you. So I do agree with you to some meaningful extent. So, again, that sort of fits into the point I made, that it depends on the issue involved. There are some times when bright line tests work, there are some times when bright line tests don't work. But it is quite clear that the Supreme Court is inclined towards feeling, let's not have bright line tests at all, which also may not work all the time. So the answer is somewhere in the middle. It depends what the issue is. It depends what the goal is. It depends how well does a bright line test work, it depends how well does a bright line test not work.

QUINN: Well, it strikes me that one of the things that makes it difficult for the Supreme Court, or even district courts, is they don't have a lot of experience with this area of law, and the same law is going to apply in the patent procurement context at the Patent Office and not just in litigation. When you say something in one context it may seem to make sense, but then it may fall apart if you try and apply it in the other context that it needs to work in. I wonder as an appellate advocate, how do you get that point across? How do you get the court to think about the broader ramifications of what they may otherwise be predisposed to do?

DUNNER: Well, it's hard really to generalize. But I will say this, that in every appellate case, if there is a broad potential impact of what the court is doing on the application of the law in litigation or in research or anything, we try to bring that out in the brief writing, in the appellate argument. Not every appellate case has some broad application. There are some appellate cases which just impact on the particular case at hand. But certainly that is true. To the extent there's some broad policy issue, we try to bring it out. And obviously, there are issues in the damages area and other areas which do have broad application, and one side or the other is trying to let the Federal Circuit know that a particular issue at hand may have a broad application. And both sides are doing that. But certainly we try to do that whenever we can.

QUINN: Right. Now, you just brought up damages. And I was wondering, are you comfortable talking about the recent case, the 25% rule? Or is that still–

DUNNER: Well, no, and I will tell you why. I am counsel in a case, *Uniloc*, in which that rule was enunciated. And that case may well be the subject of a petition for en banc rehearing, and so I think it probably is inappropriate for me to talk in any depth about that rule.

QUINN: That's perfectly fine.

DUNNER: You will be reading something that I will be writing about that rule in the near future.

QUINN: Okay. Well, good enough, I certainly look forward to that. I know you've been involved in the *TiVo v. EchoStar* case, so I won't get into that. But it seems like at the moment you have a blockbuster slate of cases you're working on. Perhaps we can chat from a perspective of how do you manage that? How do you manage your time? Are you working a hundred hours a week doing all this? Could you speak to that sort of time management, attorney management skill set?

DUNNER: Well, I can answer that. I am involved in a lot of major cases right now. *TiVo v. EchoStar* is one of them, and *Uniloc* is one of them, and *i4i* is one of them, and there are others. And what I do is I do work a lot. While I take time off for skiing with grandchildren and what have you, I do work a lot of my waking hours. And the key is that I have a lot of resources at my disposal. My law firm has 400 professionals with a lot of very talented young people, and people who are not so young, many of whom have clerked at the Federal Circuit and many of whom have clerked at district courts. And so whenever I get involved in one of these cases, my first order of priority is to put together a team to work with. And obviously, I can't have the same team working on all the cases or they'd have the same problem that I have. And so each of these cases has a core team which typically consists of one or two, usually two younger lawyers, and then we have access to a lot of other lawyers to do legal research and the like. But two core lawyers who are doing the basic core strategy work, core drafting work and what have you. And we also work with paralegals. We have one paralegal, we call them legal assistants, and maybe even two who specialize in Federal Circuit practice so they know inside and out what the court's rules are and how to put a case together. And what we do is we put together this team and we sit down and we strategize.

We have one person, usually not me, who goes through the entire record usually in conjunction with trial counsel, but trial counsel play a primary role only at the district court level, and at the Federal Circuit level they usually play a secondary role. And we go through and we put together an outline of what the case is going to be about. I'm involved at every stage of that process, but I typically don't go through the entire record. That

usually is assigned to the person who's going to put together a first draft. I usually don't do the first draft of the brief. I used to, but I'm involved in too many cases to do that. And as long as I'm working with some really bright people who are very good brief writers, the system works very well. The key is that the people I'm working with have got to be not only imaginative and good lawyers but good brief writers. And we have a lot of those. I've worked with a lot of people over the years who have been really superb backups for me. At some point I will ultimately get a draft of the brief. Sometimes we will have a full fleshed outline before we do the drafting, sometimes we won't. It depends on who the person is that I'm working with. But at some point I will get a draft of the brief and I will read it and will basically cross-examine the brief, in effect. I will read it carefully; I will mark it up. There will be many, many interlineations that I add to the brief. And then at some point we will have a package that will be sent to the client and to trial counsel for them to cross-examine it. By the time we are through, we'll have a brief that's really been vetted, that's been cross-examined before it is ever filed with the court. In those cases where I am the appellant, we get to write two briefs.

But in those cases where I am representing the appellee, the last brief will be a brief filed by the opposing counsel. And in those cases I always have my team draft what I call a stream-of consciousness response to that last brief. So I will always have in my possession a last brief or its equivalent to help me prepare for oral argument. And so that's the process. It takes a lot of time. But because I'm not the person who's going through every last piece of the record, I am able to spread myself over a large number of cases. And then when it comes to preparing for oral argument, that's a wholly different process. There it's primarily me rather than working in collaboration with other people. It's mostly me. And I spend at least 50 hours in every appeal preparing for oral argument, often more than a hundred hours. And often there are mock arguments. I just had an argument recently where we had four mock arguments in one case, and two law firms involved working together on the appeal. So there's a lot of work involved. Preparing briefs and preparing for oral argument is a very long, detailed almost tedious process, but it's a labor of love in the last analysis.

QUINN: That's interesting. That was one of the questions I wanted to ask you about whether you still do mock oral arguments to prepare. Or whether you felt like you by that point in time you had all the issues in and you were familiar enough with the court having argued so much that it wasn't quite as necessary?

DUNNER: Okay. Well, I did mention it in part. But let me just amplify on that. Each appeal is a different appeal. And while I've had a lot of cases and I'm comfortable arguing before the court, that doesn't mean I'm ready for the next case. I've got to get ready for the next case. And the goal is to try to anticipate questions that are going to be asked by the court. I read your interview with Chief Judge Michel, and there was some discussion about getting ready for oral argument. I think that mock arguments are helpful. I don't always do them. If the client wants them, I always do them. It's hard to increase your energy level in a mock argument to the point at which it must be for the oral argument. In each of the four mock arguments I had recently, I never quite was energized during those mock arguments as much as I am in fact during the oral argument. At the oral argument my energy level is as high as it could possibly be. I am not nervous. I don't get nervous any more. Before every oral argument my wife as I leave my home always says to me, "Oh, you'll do fine." But on my way to work, I always wonder how I am going to remember all the details I have to remember. And somehow, some way, I do remember them.

When I have these mock arguments they help me anticipate questions from the bench. And even when I don't have mock arguments, I have co-counsel write out questions and answers for me. And I tell them to be as diabolical as they possibly can be. I always read them before the oral argument. The goal is to try to figure out what questions I am going to be asked and how am I going to answer those questions. And if you do what I'm describing and you spend enough hours reading the materials, it works well. I told you I don't read every part of the record. But I read the briefs thoroughly, and every time I come to any point other than motherhood and fatherhood points, I go to what we call the appendix, which is the record that goes to the Federal Circuit, and I check testimony and I check documents and I check exhibits and what have you, looking to be ready for any possible question the court might ask me. And I would say that 98-99% of the time, I anticipate questions that I'm going to be asked. Not always, but most of the time. And I'm typically ready with an answer that is helpful rather than hurtful. And so that's the goal, and it's doable if you spend enough time.

QUINN: I have a question that maybe you won't want to answer. Which of the CAFC judges ask the most difficult questions? And it doesn't have to be somebody who's sitting currently, it can be somebody who's been on the court in the past. Or you can just say that they all ask equally brilliant and equally difficult questions.

DUNNER: No, they don't all ask the same number of the same kind or the same quality of questions. There are some judges that don't ask very many questions at all. But I would say that there are a lot of judges who ask good questions. One of the very effective questioners of late has been Judge Kimberly Moore, who's one of the newer judges on the court. Judge Moore asked some really tough questions in the *i4i* case. She was a tough questioner in the *Uniloc* case. And she is certainly well prepared. When Judge Michel was on the court, some felt he was an aggressive questioner. But I always found his questioning very reasonable. Judge Clevenger is now a senior judge, but often asks some very difficult questions. Judge Dyk is probably one of the toughest questioners on the court. He clerked for three Supreme Court justices and was a very effective appellate advocate in private practice. He often asks questions going well beyond issues that were briefed. In one en banc argument before the court he asked questions about the content of briefs at the district court level in a precedential case that ultimately went to the Supreme Court. And there are other judges who also do as well. Chief Judge Rader is always well informed about the cases before him, and is a very aggressive questioner. Judge Bryson is a very reflective judge and often asks questions testing the edges of the argument you're making, much as a Supreme Court Justice might question you: Where is your argument going to take us? How would your argument impact on A rather than B or rather than C? And so a lot of the judges ask good, difficult questions. I've mentioned some of those who are tougher than others. I'm not saying tough in a negative way, but tough in the sense that they test you and your knowledge of the case.

QUINN: Now, you were just talking about Judge Dyk maybe asking questions that were not necessarily directly briefed. And that brought to my mind in looking at your roster I notice you were involved in the *Nobelpharma* case back, oh, now, that's 12 or 15 years ago regarding–

DUNNER: I remember it well.

QUINN: Regarding the antitrust issue. And it was always my understanding, and maybe this is not correct, and I've been dying to ask somebody this question who would know for many years. What actually happened with the original panel withdrawing that decision? Was that sua sponte or was that provoked by a motion?

DUNNER: Well, I remember that case very well. And I will tell you an interesting anecdote about that case. The case is now no longer in the system so I can talk about it. Two of the judges issued a panel decision in my favor on the antitrust issue; with one dissent. Shortly after the opinion came down, I received a phone call from a friend of mine, who suggested that if I hadn't had any Supreme Court cases, I probably would have one soon. A petition for en banc rehearing was filed, and we filed a response. The case, however, never went en banc because the panel issued an opinion changing its decision vacating the antitrust part of the decision in my favor and going the other way. So I don't know what happened in the Federal Circuit, but I can guess.

QUINN: Okay, I have another question for you that hopefully is not too off the wall. With the Federal Circuit having so many judges that are capable of taking senior status and the court makeup having an opportunity to really significantly change over the next several years, I and others have kind of been looking at the appointments a little bit more carefully than you might otherwise for the Court. And I think there's a couple of folks, Jimmie Reyna has been nominated and Edward DuMont has been nominated. I think that they're excellent attorneys. But in looking at the biographical information of the judges that are still there, we're going to come to a point in time where we don't have very many judges, if any, that are patent attorneys. Judge Newman, Judge Lourie, Judge Linn, but Judge Newman and Judge Lourie could take senior status at any time, or just simply retire. And Judge Linn is only a few years away from that point. So do you think it's important that the Federal Circuit continue to have some representation from the patent bar?

DUNNER: The answer is yes. But the whole scheme of the Federal Circuit was to prevent it from becoming a specialized court. I believe there are statements in the congressional hearings suggesting that maybe four, maybe five at most of the 12 circuit judges should have patent backgrounds. And right now, aside from those who have learned patent law on the bench, you've actually got four. You've got Judge Moore in addition to Judges Lourie, Newman, and Linn. And a little known fact is that Judge Gajarsa started out with a patent firm, Cushman, Darby, and Cushman. He was only there for a year, I believe, and I don't think he himself considers himself to have a patent background. So basically you've got four judges with patent backgrounds. Judge Lourie and Judge Newman both could go senior if they wanted to, but I think that neither is likely to do so short of having health problems. I think they're going to stay around for a good long while because they not only love their jobs, but when they go senior, they no longer can participate in en banc hearings unless they've been on the panel. So both are likely to stay. Judge Linn was appointed in 1999. Whether he will go senior, I don't know. Judge Moore is going to be around for a long time, since she was very young when she was appointed, and she will ultimately at some point be Chief Judge. But, yes, I think that there should be always a compliment of at least four judges, maybe five, with prior patent experience. And there are a lot of very bright people out there who I think would make superb judges. It would be very nice for a private practitioner with a lot of litigating experience to be appointed. And there are some super bright people who I know would take it if they were offered the job.

QUINN: Would you care to suggest a few or–?

DUNNER: Yeah, well, I can think of one who would be superb, a super bright lawyer named Bill Rooklidge, who is on the West Coast, who's a former president of the American Intellectual Property Law Association and who clerked at the Federal Circuit for Chief Judge Nies. Somebody like John Whealan, who used to be the Patent and Trademark Office Solicitor for many years that is now an Associate Dean at GW Law School, would be excellent. And there are others who would be very good. So there are a lot of people out there. There are academics who I know would be interested, who might also be very good. I've heard Todd Dickinson mentioned as a possibility. He's a former Director of the PTO, who's now Executive Director of the AIPLA, and who I suspect might take it if he were offered the job. So there are a lot of people out there who are very good prospects.

QUINN: Now, let me just take a step back a little bit. You had said that you're pretty sure that in the legislative history there was this discussion of not having a specialized court. Now, the way I always understood it was that this idea of a specialized appellate court was just so foreign to U.S. jurisprudence that those types of things were said to calm fears and explain that isn't going to be what's happening. Today, if you look at the docket of the Federal Circuit over the last year or two, it's 40 to 45% patent cases. And I wonder whether it makes sense to continue to have only four or five of the judges that have a patent background given that any and all of them can and randomly do get assigned to patent cases.

DUNNER: Well, I'd like to comment about that. The hostility to a specialized appellate court in the patent field was so great that unless the court was formed with a pledge that it would not became solely a patent court, the court never would have been formed. The only reason the court was formed was there was an innovation crisis during President Carter's term, and there was concern about innovation slowing down in the United States and going overseas, and what have you. And then Professor Meador of the University of Virginia came along and said, I'll solve the problem, let's combine two existing courts, the CCPA and the Court of Claims, and we have judges who are not specialized patent judges but who have patent experience, and we'll give them jurisdiction over areas that aren't just patents so they'll be exposed to other areas of the law. The general bar was against having a specialized patent court. The ABA came out, in fact, against it even though it's Intellectual Property Law Section at the time came out in favor of it. There was just so much hostility to a specialized court that Congress pledged that it wouldn't contain only patent people, it would contain other people who would bring other disciplines to bear on patent cases. English majors, history majors, political science majors, economics majors and what have you which would provide the court with insights that are not strictly in the patent field. That's why you have three former Supreme Court law clerks, Judges Clevenger, Dyk, and Bryson. Unless you have that, even though there are lots of patent cases, there will be this continued

hostility toward what was regarded as the Rifkin rule named after Judge Simon Rifkin, who was a former district court judge in the Southern District of New York and who was one of the co-chairs, I believe, of the Lyndon Johnson Commission on the Patent System. He talked about his view that when you have specialized courts, the judges start to talk their own language that nobody else understands and they develop biases towards or against specific points of view. The Federal Circuit, even though it has lots of patent cases, is hardly a pro patent court. They've rendered a lot of decisions which a lot of people think are not pro patent decisions, so they go both ways. They've had pro patent decisions, they've had anti patent decisions, and I think there is something in the legislative history — I'm not sure, I can't quote it to you — suggesting that there shouldn't be any more than four or five judges with prior patent experience. And I think that's a good rule.

QUINN: Okay. You mentioned a couple of things I'd like to circle back to. One, do you think that this hostility toward a specialized patent court, or maybe a specialized court in general, or appellate court particularly, may subside given Congressman Issa's patent district court project.

DUNNER: Well, I think the Issa concept is an interesting concept. It comes very close to the line of specialization that the general bar has traditionally been hostile to. On the other hand, it has within it some safeguards that push in the other direction. For example, the judges who will be participating in this process are not patent lawyers. They are generalist judges. They're just generalist judges who are in courts that have had a lot of patent cases, and the judges can opt in or opt out as they please. So you're ending up with generalist judges who will be getting more patent cases than they otherwise would get, such as a number of district courts now have. For example, in Delaware you've got judges, because so many corporations are incorporated in Delaware, who get more than their share of patent cases. And those judges have developed patent expertise. In Massachusetts you've got Judge Saris and other judges such as Judge Young who had had a lot of patent cases. In the Eastern District of Texas you have a lot of judges who have handled a lot of patent cases. And the same is true in Alexandria, Virginia and the Northern District of California. So you have judges who have a lot of patent cases and develop patent expertise, but who are generalist judges who have other cases, who have criminal cases, who have bankruptcy cases, who have whatever kind of cases you might think of. So you have at the district court level something paralleling what happened at the Federal Circuit in that you have judges who are not patent specialists but who become knowledgeable about patent law. So it's an interesting experiment. I think if you try to go further and say let's have a special patent court, let's convert the Court of International Trade to a special patent court — I've heard people mention that — I think there would be tremendous hostility to that. So it does come closer to the line, but I don't think it crosses the line.

QUINN: And then the other thing that you had mentioned was that there was an innovation crisis, as you called it, during the Carter Administration. There are a lot of people, and myself included, that wonder whether we are also experiencing another point in time when there is an innovation crisis. And I wonder if you might just comment on that, if you have any thoughts on that.

DUNNER: Yes. Well, I don't know that we have an innovation crisis of the kind that was perceived to exist during President Carter's administration. But I am concerned with attempts to dilute the patent law. I'm concerned with attempts to dilute it in the damages area. I might be accused of being biased because the *i4i* case is presently before the Supreme Court, but that represents another attempt to dilute the effectiveness of patents, and I know there's enormous concern with those efforts. So I don't know that there's an innovation crisis, but there is significant concern that there are a lot of efforts to pare back the effectiveness of the patent grant, and that does concern me. And I'm concerned with the efforts of the Business Software Alliance, backed by high tech firms, to get Congress to legislate and pare back significantly the ability of patent owners to achieve their return on their patents. So that does concern me. Whether you call that an innovation crisis or not, I don't know.

QUINN: There's an old saying, and I'm sure you've heard it, bad people or bad actors make bad laws. And one of the things that I fear is happening right now, and particularly in the patent space, is that it's not just a

bad person or bad actor within a case, but the belief that so-called patent trolls are the bad actors in the industry. Whenever a case comes up to the district courts or the Federal Circuit or the Supreme Court, they seem to have in the back of the mind — how is this going to play out for the problem which is maybe not at all in front of them, which is the non practicing or patent troll problem. And I wonder how much of that is really causing the patent laws to take a turn. Do you have a thought on that?

DUNNER: Well, you know, I've been involved in and seen litigation where a patent litigant will try to paint his adversary as a patent troll, or a non-practicing entity. There are lots of non-practicing entities which actually are beneficial to the patent system, universities and what have you. So, yes, you read references in opinions to patent trolls. There have been a reference or two in Supreme Court opinions to that effect. But there have been other cases in which the district court chastised trial counsel for characterizing his adversary as a banker, suggesting that it was not really innovating itself but was just looking to the patent system to generate money. So there is that attempt by litigators to paint the system black, and that's picked up in some court cases. To what extent that has influenced some of the dominant themes by the Supreme Court is hard to tell. It certainly is something that you see. And I think district court judges are acting properly when they tell counsel not to go there, to stay away from that. Because after all, if somebody owns a patent, he's entitled to enforce his patent, and he shouldn't be damned because he's a non-practicing entity. Many of them are good outfits, good companies, good industries.

QUINN: Yeah. Today Thomas Edison would be considered by some to be a patent troll.

DUNNER: Oh, yes, that's an interesting point.

QUINN: Which by any fair definition that can't be what it means.

DUNNER: Yes.

QUINN: All right, now, if you're game, usually I end interviews by trying to ask some questions, akin to James Lipton of the Inside The Actor's Studio, just some random questions to kind of get to know you personally a little bit better.

DUNNER: Sure.

QUINN: Favorite hobby or pastime?

DUNNER: Well, of late I have been using whatever spare time I have driving, working out on the elliptical trainer, listening to books on tape. Over the years I've mostly been reading U.S. Patent Quarterlies and BNA Journals and what have you. Of late I've been reading through books on tape . . . history, books about great people, Einstein, presidents, what have you. I love to do that. At times I can't wait to get in my car to listen to the next episode. Also, as old as I am, I've managed to remain a skier, which is one opportunity to get to know your grandchildren. And we have a place on the Eastern Shore and I have a boat and I tinker around in it and use it to go for hard shell crabs in nearby restaurants that are on the water. And I also play a little tennis. So that basically is what I do. But I mostly work. I mostly work.

QUINN: Yeah, I hear you. Well, favorite author? Do you have a favorite author?

DUNNER: Oh, I love historians. I love to read books by Doris Kearns Goodwin. I've read David McCullough's book on John Adams and others, and so I like authors who write historical books.

QUINN: Okay. How about a favorite movie?

DUNNER: Favorite movie. Well, I've watched My Cousin Vinny so many times. If I had to select my favorites, I would mention two favorite movies. One is My Cousin Vinny and one is To Kill a Mockingbird, both of which have to do with the practice of law.

QUINN: Do you care to elaborate on My Cousin Vinny? I think that's a great movie, it's a funny movie, but not one I would necessarily expect you to pick.

DUNNER: I think the acting in it is just absolutely superb. I think the movie has a funny storyline. The ABA has a poll of great legal movies . . . they came out with it last year, and To Kill a Mockingbird is always number one, in a field of its own. My Cousin Vinny is right near the top, so there are a lot of people who like it. I guess there are other movies that I've loved over the years. Just two or three nights ago I saw Twelve Angry Men; I never tire of seeing that movie. And there are other great movies. I like war movies, such as The Longest Day. I never tire of seeing Patton, which was on TV last night, which I saw a piece of. So there are a lot of really very good movies.

QUINN: Okay.

DUNNER: One of my very favorite movies which nobody would probably include on his list is Limelight, a movie which you've probably never heard of which was written by Charlie Chaplin, produced by Charlie Chaplin, directed by Charlie Chaplin, the music of which was written by him, and he was the lead actor in it. So there are a lot of very great movies.

QUINN: Okay, very good. Do you have a favorite sport?

DUNNER: Favorite sport. Well, I love watching football. My daughter was a professional tennis player, so I do like tennis. And I play tennis myself. I'm not very good at it. But the sport I like to view the most is football. It would be a little better if the Redskins had a better team, but—

QUINN: Who would you most like to meet? And the theme here is famous American inventors, Benjamin Franklin, Thomas Edison, the Wright Brothers, or you can insert somebody and go off the board.

DUNNER: Well, Thomas Edison would be a good starter, I would guess. I haven't really thought about that, but certainly Thomas Edison is in everybody's book as the most prolific inventor of the greatest number of really significant developments. So Thomas Edison would be a good choice.

QUINN: Okay. How about the coolest invention of all time?

DUNNER: The coolest invention: what if I told you the refrigerator, would you laugh?

QUINN: (Laughs) Yes, I would.

DUNNER: (Laughs) Oh, gosh, there are so many great inventions, I wouldn't even know where to start.

QUINN: Okay. Well, the refrigerator is not a bad one, I mean, that was a very important invention that we take for granted today.

DUNNER: You're talking about the refrigerator?

QUINN: Yes.

DUNNER: Yes, but I said it to be cute.

QUINN: No, I know, I know. All right. How about favorite sci-fi visionary, Jules Verne, Gene Roddenberry, George Lucas, or H.G. Wells?

DUNNER: George Lucas certainly is right up there.

QUINN: Okay. Star Trek or Star Wars?

DUNNER: Since I'm not a Star Trekkie, or whatever they call themselves, I'll have to pick Star Wars.

QUINN: And that's all I have. I really appreciate you taking the time to chat with me.

DUNNER: Oh, it's been a lot of fun. I like talking about the things I talked about, and you certainly asked a lot of good questions. So I appreciate the opportunity to answer them.