REMEMBRANCES AND MEMORIAL: JUDGE GILES S. RICH, 1904 - 1999

By Neil A. Smith †

Twenty-eight years ago, when I was beginning my career in patent law, I applied for a job as a law clerk to Judge Giles S. Rich of the United States Court of Customs and Patent Appeals. Now, when I could be retiring, I have the opportunity and pleasure to share with others some of my remembrances in tribute to Judge Giles S. Rich.

My memories of Judge Rich begin with my interview. I was inspired by the Judge, even then an elder statesman of the judiciary and patent law, and I knew immediately that I wanted the law clerk position, despite the cut in pay I would take to get it.

At my interview, Judge Rich gave me copies of the brief in a pending CCPA case, and asked me to write a "draft" opinion as a writing sample. Apparently I qualified, since I shortly received a letter from Judge Rich in July of 1971, offering me the job. He wrote that he "found [my] draft opinion quite acceptable, except for a few little technicalities and reserving the right to disagree with the result."[1] Darn right! The case was *In re* Oda.[2] I wrote a draft opinion, affirming. Judge Rich authored the opinion for the court, reversing.[3] This was the man for whom I was going to help draft opinions?

Judge Rich went on to state:

> I have concluded that I would like to have you for a law clerk, commencing in the late summer of 1972, but, speaking as an older to a younger man, I feel obliged to mention some of life's uncertainties.... Appointment would, of course, depend on my continuing existence and sufficiently good health to work full time.[4]

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1. Letter from Giles S. Rich, Associate Judge, Court of Customs and Patent Appeals, to Neil Smith (July 1971) (on file with the author).
2. *In re* Oda, 443 F.2d. 1200 (CCPA 1971).
3. *See id.* at 1207.
4. Rich, *supra* note 2.

At the end of my clerkship, two years later, when I headed out to California, Judge Rich had already left Washington for his summer home in Connecticut where he pounded out opinions on his Smith Corona. He wrote again to say, "I am sorry not to be on hand as you leave my chambers for an entirely new way of life in San Francisco to commute across the Bay and worry about billable hours."[5] Complimenting me on my insights in the law and innovations, he said, "I hope you will feel the experience on the [c]ourt has been worth the financial sacrifice. My only advice to you is to urge on you the necessity, in private practice, of replacing me in becoming the critic of your own work and to see to it that it is in the best possible shape before it leaves your hands."[6] That was Judge Rich's legacy. In the opinions he wrote, the articles he authored, he was, as he taught me to be, the critic of his own work, and made sure each was in the best possible shape before publication.

As I set out for California, Judge Rich wished me and my then young family well, ending his letter with the words "While there is life, there is never a goodbye...."[7] Now at the end of his long and fruitful life it is my honor and privilege to say "goodbye" to my friend and colleague through this Memorial.

Judge Rich's Sense of Humor

Judge Rich's wit and humor distinguished him on the court. He was a tough cross-examiner, not only of his own work, but of winning and losing litigators before him; you had to be prepared—whether your case was good or bad—for tough questioning about the law and the facts of your case. In my thirty years of practice, few of the judges I have appeared before knew their law and facts as well as Judge Rich.

Interestingly, you could rarely tell from Judge Rich's questions from the bench which side he would determine would prevail. It was Judge Rich's opinion expressed at the First Court of Customs and Patent Appeals Judicial Conference in '74, when I served as his law clerk, that "[t]he most obvious thing to me as a Judge for 18 years on the CCPA is that if you expect to win in this court you had better be on the right side of the case. If you are not, about all you can do is make the best and most honest presentation you can and learn to live with the idea, as my first employer taught me, that losing cases is all part of the job, albeit a somewhat un-

5. Letter from Giles S. Rich, Associate Circuit Judge, Court of Appeals for the Federal Circuit, to Neil Smith (August 1974) (on file with the author).

6. *Id.*

7. *Id.*

pleasant way of making a living."[8] Twenty-five years later at this year's Federal Circuit Judicial Conference, Judge Rich's final Judicial Conference, the same comment to a packed audience drew laughs from the crowd.[9]

As a product of the Sixties, having been at Columbia Law School (forty years after Judge Rich) during the riots over the Vietnam War, my long hair (Yes, I had hair in those days) may have been a source of embarrassment and displeasure to Judge Rich and the closely cropped court. But while I clerked for Judge Rich, he never said a word about it, and of course, I did not cut it. Only years later, when looking at some old pictures of his law clerks in the "rogues gallery" where he kept pictures he had taken of his law clerks over the years, did he comment on my long hair. He never commented on my liberal thinking either.

By the way, as another illustration of his wonderful sense of humor: in that gallery of pictures of former law clerks, he put one of himself at age thirty, under the heading, "The First Law Clerk!"

Columbia Law School in the late 1920s had no course in patent law. Judge Rich learned patent law there anyway. Knowing that he would practice patent law, student Rich asked Professor Maggs, who taught administrative law, whether the course included patent law. He said that it did not. When Rich then said he would not take the course, Prof. Maggs proposed that if he would write an extensive paper on patent law, he would grade it, and if it was worthy, he would give him credit for the course.

He wrote the paper. A few years ago, Judge Rich gave a copy of it to a fellow judge on the bench, who suggested that he publish it. Judge Rich responded, "Not in my lifetime." Judge Lourie asked him if he would allow its publication after his death, and Judge Rich agreed.

I hope it will be published shortly. The paper was written in 1929, the year of Judge Rich's graduation, and includes a reference to the new Court of Customs and Patent Appeals, created that same year, on which Judge Rich was destined to sit.

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8. Giles S. Rich, *Address at the First Judicial Conference of the U.S. C.C.P.A.*, 65 F.R.D. 171, 194 (1974).

9. *See Federal Circuit Judicial Conference Looks at Court Procedures and Markman Issues*, 57 PTCJ 495 (1999).

Judge Rich's Insight into the History of the Patent Act

When the New Jersey Patent Law Association presented him with the Jefferson Medal of Honor in 1957, Judge Rich modestly accepted the medal, reminiscing on his and his father's patent careers. He said of the medal,

> It will be a vicarious reward for my mother. She endured forty-five years of marriage to a patent lawyer who worked nights and weekends and could never settle on a vacation. (How well I have come to understand my father's behavior!) [Speaking of the medal Judge Rich continued] My wife will like it. (Before we were married, she heard so much about section 271, that she used to call herself 'Misuse of 1953').[10]

In accepting the Jefferson Medal, Judge Rich explained how the Patent Act, which he and Pat Federico had drafted in 1952, came into being. The Codification Counsel to the Coordination Subcommittee of the Judiciary Committee of the House, Charlie Zinn, "had worked on several codifications for the Judiciary Committee."[11] As Judge Rich said of the Committee: "When it got a law all written up and approved, it liked to see it enacted, and Charlie knew how you got it done. You got it on a Consent Calendar at the appropriate moment, and that meant no floor debate. It was because of this little technique that you got a new patent statute when you did."[12]

As Judge Rich put it: "And that is the way you got a lot of your laws. It is a great way of conserving hot air. Can you imagine what debates on the floor of the House or Senate about most of the cardinal points of patent law would sound like?"[13]

Judge Rich continued, "[t]he New Patent Act went through both houses on consent calendars, and those houses relied on the unanimous recommendations of their respective committees, and when Truman signed the bill, we got the new law."[14]

Legislative intent was supplied later, as Judge Rich explained, in the form of the Reviser's Notes,[15] included with the Bill, which were written by Pat Federico in consultation with Giles Rich. Years later Judge Rich

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10. Giles S. Rich, Speech to the New Jersey Patent Law Association, Jefferson Medal Dinner (May 18, 1955).

11. *Id.*

12. *Id.*

13. *Id.*

14. *Id.*

15. P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (West 1954).

wrote a memorial article to Pat Federico after his death in 1982, just as I write this memorial today.[16]

Judge Rich and the Standard of Invention in the Patent Law

In illustrating the definition of the standard of invention, Judge Rich noted in his Jefferson Medal Speech: "If you look long enough in the patent law, you can find a case to support any kind of proposition, like the one recently put forth that a patent is not in effect until the day *after* it is granted, because by law it runs for only 17 years, and in computing the time you don't count the first day!"[17]

By far Judge Rich's greatest accomplishment, and there were many, in which he took the most pride, was drafting Section 103 of the new Patent Act,[18] which defined the standard of non-obviousness in the patent law. In the past, the law and language had always been confused by the use of multiple meanings of the word "invention." The new Patent Act acknowledged a difference between "inventions" and "patentable inventions." The old cases, which, as Judge Rich said, could support any proposition, looked at the "invention" made by the inventor to see if it was "an invention" since the law required "invention for patentability." As Judge Rich explained, "By completely eliminating the term 'invention' the drafters [of the Patent Act] hoped to release the courts from all the metaphysical law of the cases about this concept of 'invention' and to make it clear that not all inventions, only *unobvious* inventions, are patentable."[19]

Judge Rich's Sense of History

Judge Rich loved history, particularly reminiscing about growing up in the teens (both his and the century's "teens") in Rochester, New York. The first U.S. patentee, Samuel Hopkins, who received his patent July 31, 1790, is allegedly buried in Rochester. In my folder of the things Judge Rich gave me is a picture of Samuel Hopkins's grave he took—and developed and printed himself in his darkroom—when he gave a speech in Rochester during the early 70's when I clerked for him.

16. Giles S. Rich, *P.J. (Pat) Federico and His Works*, 64 J. PAT. OFF. SOC'Y. 1 (1982).

17. Rich, *supra* note 11.

18. 35 U.S.C. § 103 (1994).

19. Rich, *supra* note 11.

For his speech, entitled "Change,"[20] given in Rochester in 1974, Judge Rich reminisced about all the "changes" that took place in his then lifetime—twenty-five years ago, when I clerked for him. Speaking of his heritage, he noted that his father, who was a patent attorney there, was one of the draftsmen of the patent applications and/or patent drawings for the first "Brownie Camera" of the company which came to be known as Kodak. Judge Rich loved to tell the story of his father doing patent work for George Eastman, the founder of Eastman Kodak's little company, and not wanting to be paid in stock because he felt the company was too risky!

Giles Rich and Science

Perhaps one could say that Judge Rich's acceptance of new technologies and inventions as being patentable subject matter, and his constant battle to permit the patenting of newly-developed technologies resulted from his having seen so many technological changes in his lifetime. From having lived through a century with so many technological revolutions and changes in our society and economy, he knew that the patent system must evolve to protect the new technologies of computers, biological modifications, plants, and now, with Judge Rich's decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*[21], financial and business methods. Judge Rich understood, perhaps better than most of us who are here on this Earth for such a short period of its cosmic time, that if the patent system is to survive and fulfill its Constitutional purpose, it has to keep up with and allow for protection for all the new types of inventions made as society changes.

Judge Rich was always the first to embrace and enjoy new technological change. He is reported to be the first judge on the court to have e-mail. While the other judges were concerned about technology security, at age 92 Judge Rich ordered his own electronic mail account and began corresponding with his law clerks and others around the world.

When technology moved to the development of computers and computer programs, where scientists and inventors were putting their energy, Judge Rich argued for the patentability of computer programs.[22] His opinion for the court in *In re Benson* in 1971 reversed the decision of the then Patent Office Board of Appeals that the invention, "a method for

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20. Giles S. Rich, Speech to the Rochester Patent Law Ass'n (Oct 15, 1974). *See also* Giles S. Rich, *Change*, 2 APLA Q. J., 214 (1974) (an article by Judge Rich based upon this speech).

21. 149 F.3d 1368 (Fed. Cir. 1998), *cert denied*, 119 S. Ct. 851 (1999).

22. *See In re* Benson, 441 F.2d 682, 688 (C.C.P.A. 1971).

converting binary coded decimal number representations into binary number representations," was not patentable because it constituted "mental processes" and "mathematic steps," neither of which was "an art" in the Board's view.[23] Judge Rich explained the history he knew so well of 35 U.S.C. § 101: That "art" was the term used prior to his drafting the Patent Act in 1951; the term now being "process", which is defined to include an "art or method."[24]

Judge Rich wrote:

> It seems beyond question that the machines—the computers—are in the technological field, are a part of one of out best-known technologies, and are in the "useful arts" rather than the "liberal arts," as are all other types of "business machines," regardless of the uses to which their users may put them. How can it be said that a process having no practical value other than enhancing the internal operation of those machines is not likewise in the technological or useful arts?[25]

In 1972, just after I began my clerkship, the Supreme Court decided *Gottschalk v. Benson*,[26] reversing the CCPA. The decision by Mr. Justice Douglas, never a fan of the patent system, angered Judge Rich because he knew that computers were where the technological "action" was. He knew that for the patent system to continue to encourage invention and the investment of resources in technological innovation, it must keep up with protecting inventions in all the new fields in which they were being made.

Two days after the Supreme Court opinion by Justice Douglas, Judge Rich quietly circulated to his fellow Judges and law clerks on the court a quotation from a then-current book,[27] which quoted Justice Fortas describing Justice Douglas. Speaking of Douglas, Fortas said:

> His mind is a cutting instrument of fabulous sharpness. His intellect is a well-ordered, highly organized machine. For this man of intense sentiment, sentiment which cannot be sharply and effectively deployed is slop. To himself, to friend and foe alike, Mr. Justice Douglas is a harsh critic who lies in wait for the slothful, the untidy, the drooling, the soft and sappy. The unerr-

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23. *Id.* at 685.
24. *Id.* at 685 n.4.
25. *Id.* at 688.
26. Gottschalk v. Benson, 409 U.S. 63 (1972).
27. ROBERT SHOGAN, A QUESTION OF JUDGEMENT, THE FORTAS CASE AND THE STRUGGLE FOR THE SUPREME COURT (1972).

> ing leap to the jugular, the fantastic speed, the cleanliness of the kill—these are the marks of Douglas's mind.[28]

Although Judge Rich was personally stung by the Douglas opinion in *Benson*, the courts eventually adopted his position. Computer hardware, software, and even business methods may be patentable as long as they are useful and nonobvious.[29]

Much later in *In re Alappat*,[30] Judge Rich, writing for the majority, was able to limit Justice Douglas' *Benson* opinion to its proper scope, as he wrote"[i]n this way, the door remains open to the advancement of technologies by the incorporation of digital electronics."[31]

Judge Rich and the Trademark Law

As a practitioner in trademark as well as patent law, I would be neglectful if I did not mention some of Judge Rich's many contributions to trademark law. When I clerked for Judge Rich, the court considered *In re Honeywell*,[32] which dealt with the protectability of the shape and appearance of an article, as a trademark, in this case a "round" thermostat. What I began to appreciate at the time was the importance of this law, and Judge Rich's mammoth contribution to it, through a concurring opinion he authored in *In re Mogen David Wines Corp.*,[33] and his prior opinion in *In re Deister Concentrator Co.*[34] While another judge authored the opinion of the court in *Honeywell*, Judge Rich wrote another concurring opinion, as he had done in *Mogen David*, averting to his opinion in *Deister*, and noting the important distinction between "de facto secondary meaning" and not giving protection to functional designs under the law.[35] I commend you to this wonderful line of concurring opinions, and particularly Judge Rich's later 1982 opinion for the court in *In re Morton Norwich Products, Inc.*,[36] which outlined in simple terms the way to distinguish and analyze functionality under the law.[37] I venture to say that this line of cases may well be responsible for the development of trade dress law today that recognizes protection for product configurations.

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28. *Id.* at 131.
29. *See State Street Bank*, 149 F.3d at 1373-75.
30. 33 F.3d 1526 (Fed. Cir. 1994).
31. *Id.* at 1557.
32. 497 F.2d 1344 (C.C.P.A. 1974).
33. 328 F.2d 925 (C.C.P.A. 1964).
34. 289 F.2d 496 (C.C.P.A. 1961).
35. *See Honeywell*, 497 F.2d at 1350.
36. 671 F.2d 1332 (C.C.P.A. 1982).
37. *See id.* at 1337-40.

Years later in my practice, when I was litigating in the California District Court, and then in the Ninth Circuit, I came to appreciate the valuable and important contribution of Judge Rich and his "thinking outside the box" regarding the protectability of the shape and appearance of articles as trademarks. He believed they could be protected as trademarks if recognized by the public, just as traditional trademarked words and designs, as long as they were non-functional and identified source or product origin. The principles of law for words and logo trademarks applied equally to product designs and configurations.[38]

Early in my career, when I went to San Francisco, as Judge Rich put it in the language quoted above, to "commute across the Bay and worry about billable hours," I represented Levi Strauss, in an attempt to protect that little folded cloth ribbon "tab" which sticks out of the side of Levi's' patch pocket on the rear of its jeans. I used much of Judge Rich's writing and philosophy regarding the protectability of the shape and appearance of articles and things that function as trademarks to identify products in the real world marketplace, just like that small "tab" on Levi's jeans.

The "wheel came full circle" when, after winning in the district court, I appeared as a young lawyer before the bench in the Ninth Circuit, only to find Chief Judge Markey, from the CCPA, "sitting by designation" on the Ninth Circuit! Howard Markey was appointed to the CCPA as its Chief Judge just at the time that I had begun my clerkship. As luck (or fate) would have it, Judge Markey wrote the decision of the Ninth Circuit affirming the district court,[39] relying on all those principles of protecting product trade dress as trademarks I had learned from Judge Rich.

Memories

It is difficult for me to draw to a close this rambling memorial of my thoughts and appreciation of Giles Sutherland Rich, my tutor, teacher, mentor, critic, and supporter. Perhaps I have written so much, not because I have so much to say, but because as long as the article doesn't end, neither does the memory; as Judge Rich wrote me in 1974, "While there is life, there is never a goodbye ...."

Goodbye Judge Rich. With your foresight, intellect, and ability to draft statutes and opinions so clearly, you have been able, better than anyone else, to guide and direct the law governing the protection of inventions and

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38. The Supreme Court has granted certiorari recently in a product configuration case. *See* Samara Bros., Inc. v. Wal-Mart Stores, Inc. 165 F.3d 120 (2nd Cir. 1998), *cert. granted in part*, 120 S.Ct. 308 (1999).

39. *See* Levi Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817 (9th Cir. 1980).

discoveries embodied in our Constitution. I was fortunate to have had the privilege to work for and with you. But more fortunately for all, your work is written in our patent laws and in your opinions, which, under our system of laws and stare decisis, will live on forever. For this we thank you.