

Fall 2012

Newman, J., Dissenting: Another Vision of the Federal Circuit

Blake R. Hartz

Woodard, Emhardt, Moriarty, McNett & Henry LLP, Indianapolis, IN, brhartz@gmail.com

Follow this and additional works at: <https://www.repository.law.indiana.edu/ipt>



Part of the Intellectual Property Law Commons, Judges Commons, Jurisdiction Commons, Jurisprudence Commons, Legal Education Commons, Legal History Commons, Legal Profession Commons, Legal Writing and Research Commons, Legislation Commons, Litigation Commons, and the Science and Technology Law Commons

Recommended Citation

Hartz, Blake R. (2012) "Newman, J., Dissenting: Another Vision of the Federal Circuit," *IP Theory*. Vol. 3 : Iss. 1 , Article 5.

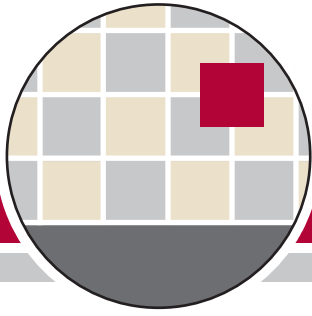
Available at: <https://www.repository.law.indiana.edu/ipt/vol3/iss1/5>

This Article is brought to you for free and open access by the Law School Journals at Digital Repository @ Maurer Law. It has been accepted for inclusion in IP Theory by an authorized editor of Digital Repository @ Maurer Law. For more information, please contact rvaughan@indiana.edu.



JEROME HALL LAW LIBRARY

INDIANA UNIVERSITY
Maurer School of Law
Bloomington



Newman, J., Dissenting: Another Vision of the Federal Circuit

Blake Hartz*

INTRODUCTION

This Essay examines how, to some, the Court of Appeals for the Federal Circuit has gone astray. While the wisdom of various aspects of the Federal Circuit has been questioned in recent years by commentators,¹ relatively little attention has been paid to some of the most common and constant criticism: the dissenting opinions of Judge Pauline Newman.² Examining the dissenting opinions of Judge Newman provides an alternative viewpoint of the Federal Circuit and how it has (at least according to one) erred. Part I discusses the reasons for selecting Judge Newman for the leading role. Part II examines the role of dissenting opinions in general and in particular at the Federal Circuit. Part III provides an empirical overview of Judge Newman's prodigious collection of dissents before addressing some doctrinal areas where her view of the law departs from that of the larger body of Federal Circuit judges. Part IV describes how Judge Newman's dissenting jurisprudence may be reinvoked in the future at the Federal Circuit.

I. A CENTRAL FIGURE IN FEDERAL CIRCUIT DIALOGUES

Before joining the court, Judge Newman had thirty years of experience as a chemist and patent lawyer at FMC Corporation.³ Her involvement in the American Chemical Society included committee work on patents and related legislation.⁴ She served on a domestic

* J.D., Indiana University Maurer School of Law. Thanks to Mark Janis for many opportunities.

1. See, e.g., Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 Nw. U. L. REV. 1619 (2007).

2. But see W. Stanfield Johnson, *The Federal Circuit's Great Dissenter and Her "National Policy of Fairness to Contractors"*, 40 PUB. CONT. L.J. 275 (2011) (analyzing two decades of Judge Newman's dissents in government contracts cases). Judge Newman's disagreements with particular judges have also been examined. E.g., Dennis Crouch, *Dissents: Judges Newman and Dyk*, PATENTLY-O (Sept. 23, 2011, 4:42 PM), <http://www.patentlyo.com/patent/2011/09/dissents-judges-newman-and-dyk.html> (reporting Judges Newman and Dyk disagreed on over 75% of precedential patent cases in an eighteen-month period in which they were both involved).

3. See MARION T. BENNETT, *THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY 1990-2002*, at 25-26 (2004).

4. *Id.* at 26.

policy review committee convened by President Carter starting in 1978,⁵ and continued to be an influential industry voice in the creation of the Federal Circuit.⁶

Not only is Judge Newman one of the central figures in the creation of the Federal Circuit, but she also frequently disagrees with her colleagues.⁷ As the first judge appointed directly to the Federal Circuit, and now entering her twenty-ninth year on the court,⁸ she is associated with some 369 dissenting opinions.⁹ Compare this with the 892 opinions for the court she has written in the same time.¹⁰ Judge Newman dissents more than anyone else on the court.¹¹

Judge Newman is unreserved about expressing her departures from the majority of the court. Additionally, she admits that her opinions are influenced by her experience with the patent system before the Federal Circuit: “Although I’ve occasionally criticized our treatment of the law, I never forget why we were formed, or the state of the patent law

5. Pauline Newman, *Origins of the Federal Circuit: The Role of Industry*, 11 FED. CIR. B.J. 541, 541-42 (2002).

6. See FRANK P. CIHLAR, *THE COURT AMERICAN BUSINESS WANTED AND GOT: THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT* 9-10 (1982) (“What is clear, however, is that the CAFC *would* have suffered such a fate [died in committee like previous proposals] without the efforts of a handful of people, including . . . Pauline Newman of FMC Corporation . . .”); Newman, *supra* note 5, at 543 (noting that in Congressional testimony Newman represented over 107 industry groups, businesses, and universities);

7. See Gregory A. Castanias et al., *2010 Patent Law Decisions of the Federal Circuit: The Advent of “The Rader Court”*, 60 AM. U. L. REV. 845, 1052 Table 1 (2011) (reporting Newman wrote greatest number of separate opinions in patent cases in 2010, and that nearly half of the patent opinions she authored generated separate opinions by other judges); Dennis Crouch, *Dissenting Opinions at the Federal Circuit*, PATENTLY-O (Sept. 2, 2012, 11:44 AM), <http://www.patentlyo.com/patent/2012/09/dissenting-opinions-at-the-federal-circuit.html>.

8. Judge Newman was appointed to the court in 1984. *Pauline Newman, Circuit Judge*, U.S. CT. APP. FOR THE FED. CIR., <http://www.cafc.uscourts.gov/judges/pauline-newman-circuit-judge.html>.

9. As of April 13, 2012. Using the CTAF database on Westlaw, I searched for “DIS(newman)”. The “DIS(NAME)” query actually reports any occurrence of NAME anywhere in the dissent, so it picks up the names of judges joining in the dissent written by another, as well as case citations including “(NAME, J., [dissenting/concurring])”. While this limits the accuracy of some of the empirical results in this Essay, it provides some metric of dissension.

10. As of April 13, 2012. Using the CTAF database on Westlaw, I searched for “JU(newman)”.

11. I performed searches for the other active judges similar to that described above. See *supra* notes 9 and 10. These results are summarized in Table 3 *infra*. Judge Newman is certainly an outlier with respect to the total number of dissents produced, but less so given her length of service. The most recent group of appointees appears to be writing a greater number of dissents as a percentage of their overall opinion writing. However, these results are skewed by several recent denials of petitions for rehearing en banc, which confuses the way Westlaw tags who the opinion authors are. See *supra* note 9. For example, Judge Wallach is counted as having two dissents and no majority opinions. But his two “dissents” are actually recorded for cases where he joins the opinion of another judge dissenting from the denial of rehearing en banc, *Byrne v. Wood, Herron & Evans, LLP*, 676 F.3d 1024 (Fed. Cir. 2012), and *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350 (Fed. Cir. 2012). See also, e.g., Gregory A. Castanias et al., *Survey of the Federal Circuit’s Patent Law Decisions in 2006: A New Chapter in the Ongoing Dialogue with the Supreme Court*, 56 AM. U. L. REV. 793, 978 tbl.2 (2007) (reporting Newman wrote half of all dissents in patent cases in 2006).

before we arrived.”¹² If there is a “dialogue” about, among, or between the Federal Circuit and anyone else, Judge Newman is one of the discernible voices.

II. DISSENTING OPINIONS AND THE FEDERAL CIRCUIT

A. Functions of Dissent

Some judges criticize the proliferation of dissents. Judge Posner claims “[m]ost judges do not like to dissent” for a variety of reasons, including the perception that writing a dissent increases the significance of the majority opinion.¹³ Moreover, writing dissents frays the collegiality that is central to small-group appellate decision-making.¹⁴ Commentators have long recognized that dissents undermine public confidence in the judicial system because they “reveal[] the amateurish uncertainty of the judicial mind.”¹⁵ Even Justice Holmes, himself a great dissenter, called dissents “useless” and “undesirable” (in a dissenting opinion, of course).¹⁶

But dissenting opinions serve important purposes. They can be prophetic, “point[ing] the way to our future, showing us what we and our government can and should become.”¹⁷ Dissents can be specifically written to trigger further review by the Supreme Court,¹⁸ the en banc court,¹⁹ or the legislature.²⁰ They can improve the majority opinion and keep the majority’s characterization of the record honest.²¹ Dissents also communicate to the losing party that their arguments were heard,²² alleviating some of the public confidence problems that might otherwise be created by appearing to undermine the majority.

12. Newman, *supra* note 5, at 541; *see also* Judge Pauline Newman, *After Twenty-Five Years*, 17 FED. CIR. B.J. 123, 123 (2007) (“It is time, again, to think creatively, to assure that the law and the policy it implements are optimum for today’s and tomorrow’s science and its technologic applications.”).

13. RICHARD A. POSNER, *HOW JUDGES THINK* 32 (2008).

14. *See id.* at 32-34. The theory of “dissent aversion” has been documented in some academic studies. *E.g.*, Stefanie A. Lindquist, *Bureaucratization and Balkanization: The Origins and Effects of Decision-Making Norms in the Federal Appellate Courts*, 41 U. RICH. L. REV. 659, 694-96 & tbl.5 (2007). Judge Posner says this result is expected, because on a larger court, the dissenting judge will not be on the same panel with the majority as often, and therefore have less incentive to be nice. *See* POSNER, *supra* note 13, at 32 n.30; *see also* Alex Kozinski & James Burnham, *I Say Dissent, You Say Concurral*, 121 YALE L.J. ONLINE 601, 609-10 (2012) (noting growth of en banc activity as courts have grown and generated more “outlier panels”).

15. William A. Bowen, *Dissenting Opinions*, 17 GREEN BAG 690, 693 (1905).

16. *N. Sec. Co. v. United States*, 193 U.S. 197, 400 (1904) (Holmes, J., dissenting).

17. William A. Fletcher, *Dissent*, 39 GOLDEN GATE U. L. REV. 291, 295 (2009). Justice Brennan described these “prophetic” dissents as those that “soar with passion and ring with rhetoric” and “at their best, straddle the worlds of literature and law.” William J. Brennan, Jr., *In Defense of Dissents*, 37 HASTINGS L.J. 427, 431 (1986).

18. *E.g.*, Evan A. Evans, *The Dissenting Opinion—Its Use and Abuse*, 3 MO. L. REV. 120, 131 (1938).

19. Fletcher, *supra* note 17, at 296, 299-300.

20. *Id.* at 299.

21. *Id.* at 297-98.

22. *Id.* at 298-99.

B. Dissenting Opinions in the Federal Circuit

The Federal Circuit has jurisdictional peculiarities that raise the stakes for dissenting opinions. For its subject matter jurisdiction, the Federal Circuit is the exclusive appellate forum.²³ Among other things, this prevents the creation of “circuit splits” that form the basis of many petitions for *certiorari* and trigger the involvement of the Supreme Court.²⁴ While there has been a recent uptick in the number of Federal Circuit cases decided by the Supreme Court, the lack of a jurisprudential “conversation” between the Federal Circuit and both the sister Courts of Appeals and the Supreme Court has been noted throughout the Federal Circuit’s history.²⁵ The ABA’s opposition to the creation of the Federal Circuit originally was due, in part, to this lack of a “percolation” of issues with the other circuits.²⁶ Indeed, some judges of the Federal Circuit have complained about a lack of competing voices.²⁷ Judge Newman, however, maintains that “because the Federal Circuit itself airs divergent viewpoints in important cases,” issues “that may warrant further judicial or legislative consideration” receive sufficient attention.²⁸ In the words of one commentator, “[o]ne thing the Federal Circuit has learned to do is to write dissents that attract Supreme Court review.”²⁹

Like the other federal appellate courts, panel opinions of the Federal Circuit are binding on future panels unless an en banc ruling (or a Supreme Court decision) intervenes and changes the law.³⁰ Although the court has a practice of circulating opinions to the

23. 28 U.S.C. §§ 1292(c), (d), 1295 (2006) (referring to “exclusive” jurisdiction). Determining whether something falls within the “arising under” jurisdiction of the statutes listed in § 1295 is governed by the well-pleaded complaint rule. *Christianson v. Colt Indus.*, 486 U.S. 800 (1988). For certain administrative actions, parties can seek review or redetermination, depending on the context, at the district court level before that same subject would be appealable to the Federal Circuit. *See, e.g.*, 35 U.S.C. § 145.

24. Nard & Duffy, *supra* note 1, at 1623-24.

25. *See, e.g.*, Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 389.

26. Pauline Newman, *The Federal Circuit—A Reminiscence*, 14 GEO. MASON L. REV. 513, 516-17 (1992).

27. *See* Randall R. Rader, *The United States Court of Appeals for the Federal Circuit: The Promise and Perils of a Court of Limited Jurisdiction*, 5 MARQ. INTELL. PROP. L. REV. 1, 4 (2001); *see also* Nard & Duffy, *supra* note 1, at 1622-24 (describing statements by Judges Michel and Rader).

28. Judge Pauline Newman, *The Federal Circuit in Perspective*, 54 AM. U. L. REV. 821, 823 (2005) (responding to arguments raised by the ABA litigation section in opposition to the creation of the Federal Circuit); *see also id.* at 826 (“With close questions, diversity of judicial viewpoint is more frequent. Such diversity produces the ‘percolation’ that scholars feared would be lost to the Federal Circuit, and indeed can lead to consensus strengthened by the deliberations in reaching it.”); Pauline Newman, *The Sixth Abraham L. Pomerantz Lecture: Commentary on the Paper by Professor Dreyfuss*, 61 BROOK. L. REV. 53, 62 (1995) (claiming the concern over lack of Supreme Court attention due to insufficient intercircuit conflict “has not been borne out in practice”).

29. Rochelle Cooper Dreyfuss, *The Federal Circuit as an Institution: What Ought We to Expect?*, 43 LOY. L.A. L. REV. 827, 840 (2010) (collecting cases).

30. *E.g.*, Federal Circuit Internal Operating Procedure 13 ¶1. Problems of relative youth (and lack of precedent) of the Federal Circuit are at least partially ameliorated by the incorporation of Court of Customs and Patent Appeals and Court of Claims cases as binding precedent. *See S. Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982).

chambers of all active judges before publication,³¹ this rarely results in hearing issues en banc.³² The rate at which cases are decided en banc at the Federal Circuit is among the lowest of the Courts of Appeals.³³ Despite this, dissent from denial of rehearing en banc can be important to changing the law³⁴ and its practice³⁵ at the Federal Circuit.

III. NEWMAN, J., DISSENTING

A. *By the Numbers*

1. Statistical Overview of Judge Newman's Dissent Writing

Table 2 in the Appendix shows how Judge Newman's dissent and majority opinion writing has varied over time. Although there is quite a bit of variation, Judge Newman's rate of dissent, as measured against the number of majority opinions she has authored in a given year and illustrated in Figure 1, below, has generally increased with her length of service on the court.³⁶ Figure 2 presents the same information, but calculated against the total of majority, dissenting, and concurring opinions.³⁷ The dissent rate, when simply compared to the number of opinions authored (calculated as either majority plus dissent or majority, concurrence, and dissent), increases by about 1% each year. However, if we account for the growing caseload of the court, including the growing number of panels Judge Newman has sat on, trends are less pronounced, as illustrated in Figure 3.³⁸ That rate of increase is less than 0.3% per year.

31. Federal Circuit Internal Operating Procedure 10 ¶5.

32. Christopher A. Cotropia, *Determining Uniformity Within the Federal Circuit by Measuring Dissent and En Banc Review*, 43 LOY. L.A. L. REV. 801, 817 (2010) (reporting en banc rate of the Federal Circuit as 0.18% of all cases over period of study).

33. *Id.*

34. *See, e.g.*, Kozinski & Burnham, *supra* note 14, at 607-08. Kozinski and Burnham call a dissent from denial of rehearing en banc a "dissent". *Id.* at 601. Among other redeeming functions of dissents, they identify use of dissents in later cases by the Supreme Court. *Id.* at 608 (citing *Chickasaw Nation v. United States*, 534 U.S. 84, 91 (2001) (citing *Little Six, Inc. v. United States*, 229 F.3d 1383, 1385 (Fed. Cir. 2000) (Dyk, J., dissent))).

35. *Id.* at 608 (citing the use of Judge Newman's dissent in *Atlantic Thermoplastics Co. v. Faytex Corp.*, 974 F.2d 1279 (Fed. Cir. 1992), in a reference book to explain why patent prosecutors should avoid product-by-process claims).

36. *See infra* fig.1. The slope of the best-fit line is 0.0107, meaning the rate increases over 1% per year. I have omitted concurrences from this figure. The tendency to increase the frequency of dissent with time on a court is not unique to Judge Newman. *See* Brennan, *supra* note 17, at 427 (noting that Justice Brennan dissented zero times in sixteen opinions his first term, but dissented forty-two times out of fifty-six in the October 1984 term).

37. Westlaw counts a concurrence-in-part, dissent-in-part as both a concurrence and a dissent. Thus, D/(D+M+C) may undercount because the denominator contains multiples. However, simply counting dissents may overcount, since dis(JUDGE) will pick up things like "(JUDGE, J., dissenting)" in a citation and "with whom JUDGE, Circuit Judge, concurs" in the dissenting opinion. Concurrences are potentially overcounted in this way, too. I've tried to provide a mixture of different counting/trending techniques to ensure that the overall conclusions are sound.

38. *See infra* fig.3. The slope of the best-fit line is 0.0027.

Figure 1: Percentage of Opinions Dissenting Over Time

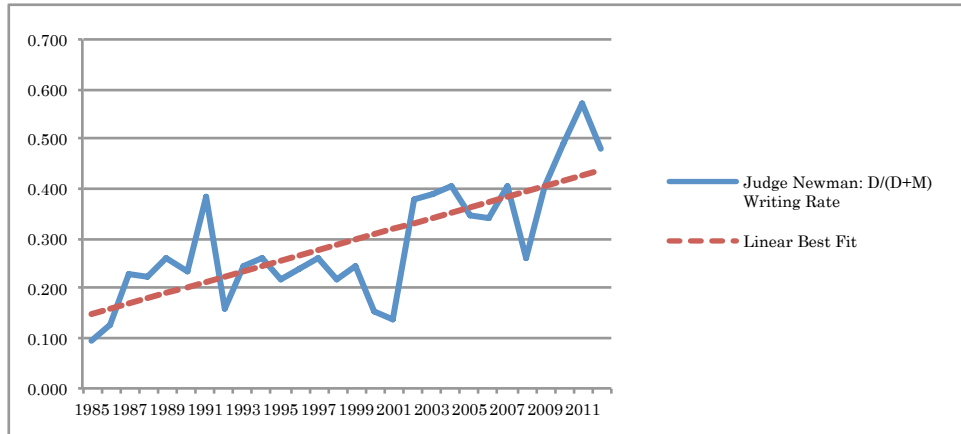


Figure 2: Percentage of Opinions Dissenting Over Time (including Concurrences)

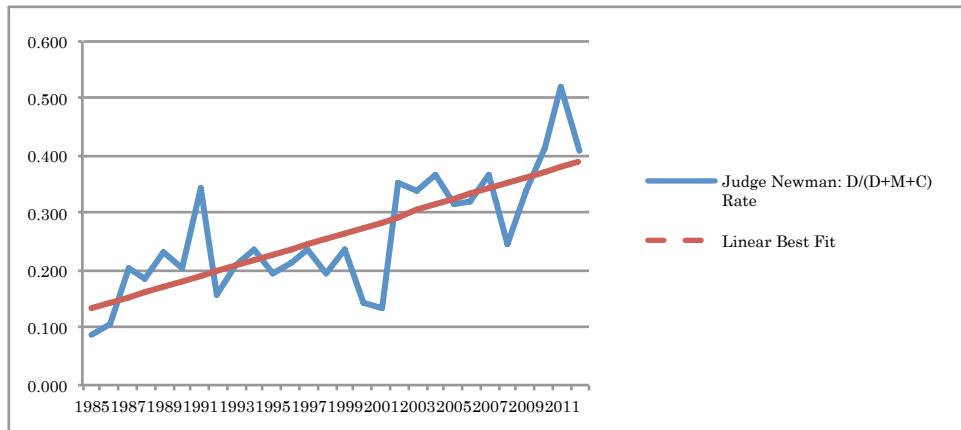
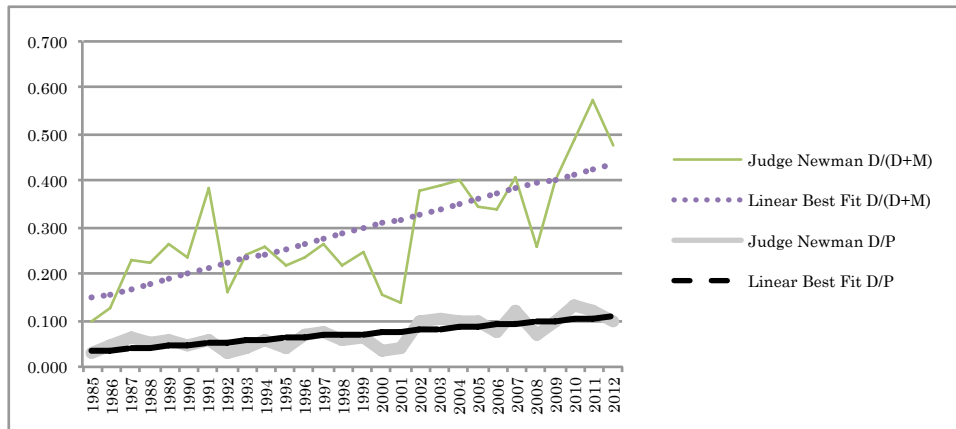


Figure 3: Dissent Rate Per Panel Compared to Per Opinion



The overall numbers reinforce the perception that Judge Newman dissents frequently. She has dissented in more than 7% of the cases she has been involved in while writing majority opinions in only 17% of them.³⁹ Comparing Judge Newman to (most of) the other members of the court is also illustrative of her prodigious dissenting rates. Table 3 in the Appendix compiles these results. Of the current court, she has one of the lowest writing rates for majority opinions (discounting the three most recent appointees), and simultaneously the highest writing rate for dissenting opinions. Of the former judges, only Judge Davis, dissenting in 5.6% of the cases he appeared in, is comparable to Judge Newman’s 7.1% dissent rate. By comparison, some of the other former active judges of the court have extremely low dissent rates: Rich, less than 0.6%; Markey, 1.1%; Clevenger, 1%; Archer, 1%; Michel, 1.1%.

However measured, Judge Newman is responsible for much of the dissent on the court, past and present. Christopher Cotropia reports 538 dissenting opinions in Federal Circuit cases in fiscal years 1998-2009.⁴⁰ By my count, about 35% of those dissents (191) are from Judge Newman.⁴¹ Cotropia also notes that 325 of the dissents in his study are patent cases, and the rate of dissent (compared to total number of opinions) is almost three times greater in patent cases.⁴² Applying the same methodology as Cotropia, Judge Newman is

39. See *infra* tbl.2.

40. Cotropia, *supra* note 32, at 815 tbl.1. Cotropia’s numbers include all opinions and orders, regardless of publication or precedential status. See *id.* at 811.

41. See *infra* tbl.2. However, the search technique is imperfect, and captures things like “with whom NEWMAN, Circuit Judge, joins, dissenting from denial of rehearing en banc” and citations including “Newman, J.” in dissenting opinions. Nonetheless, it provides some proxy.

42. Cotropia, *supra* note 32, at 816 tbl.2. Cotropia defined “patent case” broadly to include “any case involving a patent law issue, no matter how tangential that issue was to the main issues.” *Id.* at 813. He achieved this by simply structuring the Westlaw query like this: op(patent!) dis(patent!) & da(aft 9/30/1997 & bef 10/1/2009). See *id.* at 813 n.70. This method labels any case that includes the word “patent” as a “patent case”.

involved in 112 (34%) of the dissents in patent cases over the relevant period.⁴³ Over her entire career, Judge Newman has dissented in over 15% of the patent cases in which she appeared on the panel, more than twice her overall rate, while writing majority opinions in 29% of patent cases she hears, which is also substantially more than her overall writing rate.⁴⁴

2. Recent Trends in Judge Newman’s Dissents

Examining the most recent dissents in depth provides additional insights into current differences in opinion. Seventy-four opinions, starting in fiscal year 2009 to April 2012, were categorized based on subject matter jurisdiction and the type of issue dissented from. The study included all opinions in which Judge Newman authored or joined in a dissent. Applications of the broad labels of “jurisdictional,” “procedural,” and “substantive” to the type of issue the dissent focuses on is imperfect and somewhat subjective, but nonetheless provides some insight into the variety of decisions involved. Table 1 below summarizes the results from the study.

Subject Matter	Jurisdictional	Procedural	Substantive	Total of Row
Antidumping	0	0	2	2
Claim ⁴⁵	1	1	6	8
Contract	2	1	5	8
Customs	0	0	2	2
Employee Benefits	1	1	5	7
Patent	3	11	23	37
Taking	0	0	2	2
Trademark	1	0	3	4
Vaccine	0	0	1	1
Veterans	0	3	0	3
Total of Column	8	17	49	74

A few points about Table 1 stand out. First, in accordance with the overall trend of higher dissent rates in patent cases described in the previous section, Judge Newman’s

43. My query: dis(newman) & da(aft 9/30/1997 & bef 10/1/2009) & (op(patent!) dis(patent!)).

44. Using the query techniques described *supra* notes 42-43, Judge Newman has, in patent cases over her entire career, 1324 panels, 207 dissents, 393 majority opinions, 103 concurrences, and 58 opinions concurring-in-part and dissenting-in-part.

45. This includes all claims that weren’t a government contract or a taking, such as tax refunds, judicial compensation, and various other claims against administrative agencies.

dissents over the past three years are weighted heavily towards patent cases. Notably, half of her dissents over the period are in patent cases; issues of claim construction, obviousness, contract interpretation accounted for twelve of these, while no other specific issue garnered more than two. Second, disagreements about jurisdiction, which would ideally be a well-defined area, are relatively frequent.

B. By the Words

Although Judge Newman's dissents are too numerous to comprehensively discuss, a few highlights of common themes show differences of opinion about the role of the Federal Circuit and the law it produces.

1. Fact/Law Distinction and Appellate Review

Judge Newman has repeatedly criticized the rest of the court for turning questions that appear to be factual into legal issues that can be decided by the court. Her dissent in *Markman I* is perhaps the most prominent example. There, she examines many definitions of what it means for an issue to be “fact” and finds that defining “inventory” is a “fact” under all of them.⁴⁶ She argues claim construction as a matter of law “distorts the trial/appellate relationship” and “manifests a heady misperception of our assignment as a national appellate court.”⁴⁷ Even if the legal effect of a claim is a legal issue, it is premised on underlying facts that should not be reclassified as “law.”⁴⁸ Furthermore, she notes, that labeling factual inquiries as legal inquiries may conflict with Seventh Amendment jury trial rights.⁴⁹ Obviously, the Supreme Court disagreed with some of these conclusions in *Markman II*.⁵⁰ Nonetheless, Judge Newman had raised many of the same issues well before *Markman*,⁵¹ and the debate over the claim construction fact/law matters and how to review the “mongrel” practice rages on.⁵² Surprisingly, in one of the more recent cases to approach the claim construction review standard issue, Judge Newman did not write separately from the denial of rehearing en banc.⁵³

46. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1008-10 (Fed. Cir. 1995) (Newman, J., dissenting).

47. *Id.* at 1008.

48. *See id.* at 1000.

49. *E.g., id.* at 1000, 1010-17.

50. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

51. *See Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 821-26 (Fed. Cir. 1989) (Newman, J., dissenting).

52. *E.g., Amgen Inc. v. Hoescht Marion Roussel, Inc.*, 469 F.3d 1039 (Fed. Cir. 2006) (generating six separate opinions regarding the denial of rehearing en banc); *see also id.* at 1043 (Newman, J., dissenting from denial of rehearing en banc) (urging all scientific and technological facts be reviewed under the same standards and calling for the standard of review in claim construction to be reopened).

53. *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369 (Fed. Cir. 2011). *cert. denied*, ___ S. Ct. ___, 2013 WL 57105 (2013).

But the broader issue of fact/law classification and the role of appellate courts remains a lingering issue. One example is the *Festo* case. On the final remand from the Supreme Court, Judge Newman criticizes the majority for “converting two of the Court’s three rebuttal criteria into questions of law and then deciding them, sua sponte, without trial or record.”⁵⁴ She also dissented in *Lough v. Brunswick Corp.*, stating that experimental use should remain classified as a question of fact.⁵⁵ Similarly, in a recent contracts case, she dissents because “[t]he panel majority now redesignates some critical findings of fact as rulings of law. . .”⁵⁶ Judge Newman’s dissents also continue to criticize the court for finding new facts on appeal.⁵⁷ She has also recently dissented on the grounds that a panel majority opinion was a new rejection that a patent applicant had had no opportunity to respond to.⁵⁸ Additionally, Judge Newman has expressed concerns about different standards of review and the relationship of the court to Patent & Trademark Office.⁵⁹ Together, these opinions show a lasting disagreement about the role of the Federal Circuit as an appellate court.

2. Takings

Judge Newman’s view of the Fifth Amendment Takings Clause is more expansive than those of some of her colleagues. Just last year, in *Arkansas Game & Fish Commission*, she dissented from the panel and denial of rehearing en banc decisions, criticizing the majority for finding that a repeated temporary flooding could not be a taking.⁶⁰ The Supreme Court reversed in late 2012.⁶¹ Similarly, the *Zoltek Corp.* case illustrates a division at the Federal Circuit over whether patent infringement is cognizable as a taking or merely as

54. *Festo Corp. v. Shoketsu Kinzoku Kogyu Kabushiki Co.*, 344 F.3d 1359, 1378 (Fed. Cir. 2003) (Newman, J., concurring in part and dissenting in part).

55. 103 F.3d 1517, 1519 (Fed. Cir. 1997) (Newman, J., dissenting).

56. *Mabus v. Gen. Dynamics C4 Sys., Inc.*, 633 F.3d 1356, 1365 (Fed. Cir. 2011) (Newman, J., dissenting).

57. *See Gen. Protecht Grp., Inc. v. Int’l Trade Comm’n*, 619 F.3d 1303, 1314 (Fed. Cir. 2010) (Newman, J., dissenting) (“This court now finds its own facts, applies theories that were not raised by any party, uses incorrect standards of review, and creates its own electrical technology contrary to the uniform and unchallenged expert testimony.”); *id.* at 1319 (“[T]he court’s contrary finding is totally devoid of support.”); *see also Shum v. Intel Corp.*, 633 F.3d 1067 (Fed. Cir. 2011) (Newman, J., dissenting) (“That a jury is deadlocked does not convert fact into law, and the constitutional right is not negated when the jury is deadlocked.”); *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 77 F.3d 450, 456 (Fed. Cir. 1996) (Newman, J., dissenting) (“It is inappropriate for the appellate court to make its own scientific finding that such proof is not possible on the court’s new criterion.”).

58. *In re Aoyama*, 656 F.3d 1293, 1301 (Fed. Cir. 2011) (Newman, J., dissenting).

59. *In re Baxter Int’l, Inc.*, 698 F.3d 1349, 1351-55 (Fed. Cir. 2012) (Newman, J., dissenting from denial of rehearing en banc); *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, (Fed. Cir. 2012) (Newman, J., additional views).

60. *Ark. Game & Fish Comm’n v. United States*, 648 F.3d 1377, 1383 (Fed. Cir. 2011) (Newman, J., dissenting from denial of rehearing en banc); *Ark. Game & Fish Comm’n v. United States*, 637 F.3d 1366, 1379 (Fed. Cir. 2011) (Newman, J., dissenting).

61. *Ark. Game & Fish Comm’n v. United States*, No. 11-597, 568 U.S. ____ (U.S. Dec. 4, 2012).

a tort that cannot be brought in the Court of Federal Claims.⁶² Judge Newman has also disputed the timing of when a taking occurs,⁶³ as well as the possessory rights of Native Americans that would give rise to a takings claim.⁶⁴

IV. JUDGE NEWMAN'S DISSENTS AND FEDERAL CIRCUIT ADVOCACY

What do Judge Newman's dissents tell us about the Federal Circuit? Even if there is significant conflict at the court, the likelihood of invoking the en banc court is small.⁶⁵ To the extent that Federal Circuit en banc practice can be analogized to Supreme Court petitions for certiorari, the framing and presentation of the case similarly takes on paramount importance.⁶⁶ This may be especially important because of the recent generational turnover at the Federal Circuit: with three judges with less than two years of experience (and three additional seats currently vacant), it is possible that the newest crop of judges is less set in their ways and more open to the minority viewpoints expressed in the past. If the statistics for Judges O'Malley and Reyna indicate that these judges are willing to depart from their current colleagues,⁶⁷ they may be more willing to depart from precedent and consider dissents of the past. The importance of dissents in changing the law at the Federal Circuit may be even greater than in other circuits given the Federal Circuit's tendency to rely on its own cases and develop a specialized law that is "substantially out of the mainstream."⁶⁸

62. *Zoltek Corp. v. United States*, 464 F.3d 1335 (Fed. Cir. 1996); *see also Zoltek Corp. v. United States*, 442 F.3d 1345 (Fed. Cir. 2006) (per curiam) (containing two differently reasoned concurrences and a dissent), *vacated*, 672 F.3d 1309, 1317-18 (Fed. Cir. 2012) (en banc in part).

63. *Barclay v. United States*, 443 F.3d 1368, 1378 (Fed. Cir. 2006) (Newman, J., dissenting) (insisting that a notice of intent to convert a railway into a trail did not constitute a taking (and set a statute of limitations running) because the reversionary interest was not yet terminated, while her colleagues disagreed); *Caldwell v. United States*, 391 F.3d 1226, 1236 (Fed. Cir. 2004) (Newman, J., dissenting) (same); *see also John R. Sand & Gravel Co. v. United States*, 457 F.3d 1345, 1361 (Fed. Cir. 2006) (similar, involving restrictions on gravel pit based on nearby landfill).

64. *Bay View, Inc. v. United States*, 278 F.3d 1259, 1266-68 (Fed. Cir. 2001) (Newman, J., dissenting) (finding interest in full amount of proceeds of timber sales); *Karuk Tribe of Cal. v. Ammon*, 209 F.3d 1366, 1380 (Fed. Cir. 2000) (Newman, J., dissenting) (finding sufficient interest to support a takings claim, contrary to the majority).

65. *Cotropia*, *supra* note 32.

66. *Dreyfuss*, *supra* note 29, at 834 ("[T]he large number of debates among the Federal Circuit judges, coupled with the low rate of en banc review, suggests that the judges are continually in conflict but fail to frame their disagreements in ways that make en banc review fruitful enough to identify optimal rules on which to converge.").

67. *See infra* tbl.3 (reporting Judges O'Malley and Reyna dissent in 35% and 57% of their filed opinions so far, respectively); *see also* Harold C. Wegner, *New Judges on the Federal Circuit*, IP FRONTLINE, (Apr. 21, 2012), <http://www.ipfrontline.com/depts/article.aspx?id=26834&deptid=7> (collecting citations for Judge Reyna).

68. *See* Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 804 & n.84 (2008); *see also, e.g., Abraxis Bioscience, Inc. v. Navinta LLC*, 625 F.3d 1359, 1368 (Fed. Cir. 2012) (Newman, J., dissenting) (criticizing majority for creating special standing rule when subject of a commercial sale is a patent).

Judge Newman's dissents may be instructive on particular doctrinal problems as well. Takings cases may be a particularly interesting doctrine to watch. The recent *Arkansas Game & Fish Commission* case at the Supreme Court is notable. While the Federal Circuit has had several affirmances in recent years, odds favor reversal once certiorari has been granted.⁶⁹ Judge Newman's opinion in *Arkansas Game & Fish Commission* relied heavily on Supreme Court cases, and is structurally similar to her opinion in *Bilski*⁷⁰ that was in some ways vindicated.⁷¹ *Arkansas Game & Fish Commission* had a similar outcome. While the Supreme Court did not rule that a taking occurred, instead deciding the case on the narrower grounds that the Federal Circuit erred in providing an automatic exemption from normal takings doctrine for temporary floods,⁷² the decision supports Judge Newman's approach.⁷³ It seems plausible that Judge Newman's other disagreements about the proper application of takings law, including the existence of sufficient property interests and timing and accrual of takings claims, will be more influential in the range of takings cases that come before the Federal Circuit.

CONCLUSION

Judge Newman's dissents provide an alternative vision of the Federal Circuit, both structurally⁷⁴ and doctrinally.⁷⁵ While the influence of any one dissenting opinion at the court is unknown, Judge Newman's dissents provide divergent, reasoned viewpoints on a broad range of topics. As society, law, and court personnel shift over time, Judge Newman's contrapuntal collection remains (and grows!), waiting to be discovered by a more appreciative audience. ■

69. See, e.g., *Circuit Scorecard*, SCOTUSBLOG, http://sblog.s3.amazonaws.com/wp-content/uploads/2012/06/SB_scorecard_OT11_final.pdf (last visited Nov. 12, 2012) (reporting reversals in 63% of October Term 2011 cases).

70. *In re Bilski*, 545 F.3d 943, 976 (Fed. Cir. 2008) (Newman, J., dissenting) (arguing the machine-or-transformation test is inconsistent with Supreme Court precedent).

71. *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010) (rejecting machine-or-transformation as sole test).

72. *Ark. Game & Fish Comm'n v. United States*, No. 11-597, 568 U.S. ___, slip op. at 13 (U.S. Dec. 4, 2012).

73. Compare *id.* at 7-8, with *Ark. Game & Fish Comm'n v. United States*, 637 F.3d 1366, 1381-82 (Fed. Cir. 2011) (Newman, J., dissenting from denial of rehearing en banc).

74. E.g., Johnson, *supra* note 2, at 276, 346 (concluding that Judge Newman's dissents "declare a responsible, nonpartisan view that the Federal Circuit has inappropriately moved the balance of its government contract jurisprudence toward protecting the sovereign and the public fisc" and "speak for a frustrated national conscience").

75. See Mark Rambler, *The Faces of the Federal Circuit; A Look at the Judges that Make U.S. Patent Law*, RECORDER (S.F.), Mar. 22, 1999, at 5 (quoting Professor Rochelle Dreyfuss describing Judge Newman as "the most broad-minded" and "willing to think more about interdisciplinary ideas").

APPENDIX

Table 2: Dissent Rates of Judge Newman⁷⁶

Fiscal Year ⁷⁷	D ⁷⁸	M ⁷⁹	C ⁸⁰	P ⁸¹	D/(D+M)	D/(D+M+C)	(D/P)	(D+M)/P	M/P
1985	2	19	2	67	0.095	0.087	0.030	0.313	0.284
1986	4	28	6	84	0.125	0.105	0.048	0.381	0.333
1987	8	27	4	128	0.229	0.205	0.063	0.273	0.211
1988	9	31	9	173	0.225	0.184	0.052	0.231	0.179
1989	11	31	5	195	0.262	0.234	0.056	0.215	0.159
1990	7	23	4	145	0.233	0.206	0.048	0.207	0.159
1991	10	16	3	177	0.385	0.345	0.056	0.147	0.090
1992	6	31	1	199	0.162	0.158	0.030	0.186	0.156
1993	9	28	6	213	0.243	0.209	0.042	0.174	0.131
1994	12	34	5	211	0.261	0.235	0.057	0.218	0.161
1995	11	39	6	260	0.220	0.196	0.042	0.192	0.150
1996	14	45	6	201	0.237	0.215	0.070	0.294	0.224
1997	16	45	6	210	0.262	0.239	0.076	0.290	0.214
1998	12	43	6	212	0.218	0.197	0.057	0.259	0.203
1999	13	40	2	200	0.245	0.236	0.065	0.265	0.200
2000	8	43	4	224	0.157	0.145	0.036	0.228	0.192
2001	9	57	2	222	0.136	0.132	0.041	0.297	0.257
2002	19	31	4	196	0.380	0.352	0.097	0.255	0.158

76. This table includes all opinions and orders, regardless of publication and precedential status. The dates are based on *fiscal* years (October 1 to September 30), in order to compare against the results reported in Cotropia, *supra* note 32.

77. 1984 is omitted because Judge Newman authored no majority and no dissenting opinions in her first few months on the bench. She did sit on four panels for opinions issued in 1984; that fact is accounted for in total results for the per panel statistics.

78. Number of dissenting opinions, sample Westlaw query for the 2011 results: dis(newman) & da(aft 9/30/2010 & bef 10/1/2011).

79. Number of majority opinions, sample Westlaw query for the 2011 results: ju(newman) & da(aft 9/30/2010 & bef 10/1/2011).

80. Number of concurring opinions, sample Westlaw query for the 2011 results: con(newman) & da(aft 9/30/2010 & bef 10/1/2011).

81. Number of panels sat on, sample Westlaw query for the 2011 results: pa(newman) & da(aft 9/30/2010 & bef 10/1/2011).

2003	20	31	8	198	0.392	0.339	0.101	0.258	0.157
2004	19	28	5	194	0.404	0.365	0.098	0.242	0.144
2005	20	38	5	201	0.345	0.317	0.100	0.289	0.189
2006	18	35	3	235	0.340	0.321	0.077	0.226	0.149
2007	22	32	6	184	0.407	0.367	0.120	0.293	0.174
2008	12	34	3	175	0.261	0.245	0.069	0.263	0.194
2009	19	28	9	196	0.404	0.339	0.097	0.240	0.143
2010	24	25	9	183	0.490	0.414	0.131	0.268	0.137
2011	24	18	4	201	0.571	0.522	0.119	0.209	0.090
2012 ⁸²	11	12	4	115	0.478	0.407	0.096	0.200	0.104
TOTAL	369	892	137	5203	0.293	0.264	0.071	0.242	0.171

Table 3: Dissent Rates at the Federal Circuit⁸³

Judge ⁸⁴	D ⁸⁵	M ⁸⁶	P ⁸⁷	Years Active ⁸⁸	D/Y	D/(D+M)	D/P	(D+M)/P	M/P
Active Judges									
Newman	369	892	5203	28.12	13.12	0.293	0.071	0.242	0.171
Lourie	70	981	4881	22.02	3.18	0.067	0.014	0.215	0.201
Rader	87	1079	5188	21.68	4.01	0.075	0.017	0.225	0.208
Bryson	52	720	3752	17.54	2.96	0.067	0.014	0.206	0.192
Linn	44	452	2658	12.40	3.55	0.089	0.017	0.187	0.170
Dyk	108	474	2300	11.89	9.09	0.186	0.047	0.253	0.206
Prost	39	411	2558	10.55	3.70	0.087	0.015	0.176	0.161
Moore	24	149	1144	5.60	4.29	0.139	0.021	0.151	0.130

82. Ending 4/13/2012, the day the searches were conducted.

83. I followed the methodology of Cotropia, *supra* note 32, using simple Westlaw searches similar to those laid out *supra* notes 76-79.

84. I'm only including (A) active judges; and (B) senior and past judges with at least five years of active *Federal Circuit* service. The search dates for the senior and past judges eliminate any Court of Claims or Court of Customs and Patent Appeals cases and any decisions while on senior status.

85. Number of dissenting opinions, based on Westlaw query: dis(NAME)&da(aft START & bef END).

86. Number of majority opinions, based on Westlaw query: ju(NAME)&da(aft START & bef END).

87. Number of panels sat on, based on Westlaw query: pa(NAME)&da(aft START & bef END).

88. This is calculated based on the difference between date the searches were conducted (4/13/2012) or the date the judge retired, died, or took senior status, whichever is earlier, and the date on which each judge joined the Federal Circuit.

O'Malley	14	26	225	1.30	10.81	0.350	0.062	0.178	0.116
Reyna	12	9	196	1.02	11.72	0.571	0.061	0.107	0.046
Wallach	2	0	33	0.40	4.97	1.000	0.061	0.061	0.000
Senior and Past Judges									
Mayer	139	604	4646	23.04	6.03	0.187	0.030	0.160	0.130
Plager	54	443	2845	21.05	2.57	0.109	0.019	0.175	0.156
Clevenger	32	622	3216	15.76	2.03	0.049	0.010	0.203	0.193
Schall	42	765	3619	17.13	2.45	0.052	0.012	0.223	0.211
Gajarsa	70	509	2942	13.88	5.04	0.121	0.024	0.197	0.173
Rich	16	563	2659	16.79	0.95	0.028	0.006	0.218	0.212
Davis	33	168	593	5.80	5.69	0.164	0.056	0.339	0.283
Markey	13	264	1223	8.66	1.50	0.047	0.011	0.226	0.216
Miller	18	203	790	7.17	2.51	0.081	0.023	0.280	0.257
Friedman	28	131	694	6.75	4.15	0.176	0.040	0.229	0.189
Nies	68	360	1775	13.17	5.16	0.159	0.038	0.241	0.203
Bissell	20	179	724	5.65	3.54	0.101	0.028	0.275	0.247
Archer	24	544	2332	12.02	2.00	0.042	0.010	0.244	0.233
Michel	50	878	4505	22.24	2.25	0.054	0.011	0.206	0.195