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Gone Judge – Judge Randall Rader To Resign

Article By:

Before stepping down as Chief Judge of the Fed. Cir. on May 30th, Judge Rader had sent a letter to his colleagues on the court apologizing for sending an email to an attorney who had appeared before the court a number of times, praising his work and encouraging him to circulate the email to his associates. (A copy of the letter is available at the end of this post.) The letter was dated May 23, 2014, and was clear about the error of his ways:

> "I realize in retrospect that the email constituted a breach of the ethical obligation not to lend the prestige of the judicial office to advance the private interests of others. I apologize for that error, which may have led to the perception that the attorney in question was in a position to influence me in my performance of judicial duties….Working with the court, I have taken steps to remedy the breaches for which I was responsible by recusing in cases as to which a question might be raised as to my impartiality. I am committed to adhering carefully to the requirements of the Code of Conduct for United States judges in making any necessary recusal decisions. I am truly sorry for the lapse and will work diligently to ensure that it does not recur…."

Sadly, Judge Rader kept that promise and announced that he will retire from the court effective on June 30, 2014. I considered him to be one of the best "IP minds" on the court and enjoyed the straightforward and outgoing persona that he projected. However, I also remember noting during the AMP v. Myriad appeal, that AMP's attorneys (the ACLU) requested that he recuse himself due to public comments he made about the merits of AMP's arguments. This flap did not fly, but perhaps it presaged the one that did.

As the Patent Office's misguided s. 101 Guidelines begins to impede patenting a wide range of subject matter—the PSA assay would not be patent eligible today—Judge Rader's dissent In re Bilski stands out as a plea for sensible analyses of s. 101 questions:

> "This court's willingness to venture away from [s. 101] follows on the heels of an oft-discussed dissent from the Supreme Court's dismissal of its grant of certiorari in Lab. Corp. of Am. Holding v. Metabolite Labs., Inc., 548 U.S. 124 (2006). That dissent is premised on a fundamental misapprehension of the distinction between a natural phenomenon and a

> patentable process. The distinction between ‘phenomena of nature,’ ‘mental processes,’ and ‘abstract intellectual concepts’ is not difficult to draw. The fundamental error in the Lab Corp. dissent is its failure to recognize the difference between a patent eligible relationship—i.e., that between high homocysteine levels and folate and cobalamin deficiencies—and a patent eligible process for applying that relationship to achieve a useful tangible, and concrete results—i.e., diagnosis of potentially fatal conditions in patients. Nothing abstract there. Moreover, testing blood for a dangerous condition is not a natural phenomenon, but a human invention.”

Substitute “Patent Office Guidelines” for “Lab. Corp. dissent” and this analysis could have –indeed, should have –been read into the record at the Public Forum on the Guidelines held on May 9th. Anyone concerned with patenting diagnostic assays should pause a minute to mourn the loss of an ally who might well have taken a role in reversing the hostility of the Office to such a broad sector of technology. After all, Judges Bryson, O’Malley and Wallach held that the Intema assay combination was not patent-eligible. (Judge Rader authored the opinion that vacated and remanded the district court’s decision in Ariosa v Sequenom granting a preliminary injunction to patentee Sequenom, but that was due to errors in claim interpretation. Judge Rader, joined by Judges Dyk and Reyna, specifically stated that they were not opining on whether or not the patent-eligibility of the claimed assays was controlled by Mayo.)

In any case, Judge Rader’s resignation comes at a bad time for the patent system and we don’t need the forecast to be any worse than it already is.

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