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Food For Thought

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Are You Curious?

I was doing some background research recently regarding a medical technology, and happened upon an article from 2002[i] in which the author, J. Willis Hurst, MD, addressed the question "What is the single most important attribute for someone who wishes to learn medicine?" His answer: "curiosity."

Dr. Hurst recounted how residents often identify various physiologic or biochemical conditions that their patients exhibit without considering the underlying *cause* of the condition. "It often becomes obvious that the trainee does not have the curiosity to ask him or herself that question," he explained, cautioning that "[l]earning medicine requires that nascent trainees and seasoned physicians ask themselves questions about their patients and, if the answers to the questions are not known, to look them up or ask somebody." In his view, "[t]his sequence of thought and action cannot be achieved without curiosity."

Dr. Hurst could just as well have been talking about practicing law. Curiosity about both the facts and the law are essential to critical legal analysis and the provision of thoughtful legal advice. I wonder if lack of curiosity might be an underlying cause of superficial legal analysis, a problem that crops up both in-house and in law firms.[ii] A few typical examples of superficial intellectual property analysis include:

- Construing patent claims without analyzing the specification, especially where the specification contradicts or undermines the claim construction upon which a non-infringement defense is predicated and a product is cleared for launch.
- Prosecuting a patent application without knowing whether or how the claims relate to a current or planned product, much less whether the relevant product (if any) is commercially or strategically important.
- Dismissing as frivolous a patentee's concern that to preserve its rights it must file an infringement action against one's client because of "the six-year rule" (the lawyer not being aware of the six-year damages limitation of 35 USC §286).
- Unilaterally terminating patent license royalty payments on a subset of products on the grounds of a newly-developed argument that the contract does not require payment on that subset, despite having paid royalties on that subset of products for ten years since the inception of the license (the lawyer being unaware of how courts employ "course of performance" to construe contract language and further unaware that not paying the royalties also created a patent infringement cause of action).
- Advocating filing a trade secret misappropriation action before any of the allegedly misappropriated trade secrets has been identified sufficiently to be articulated cleanly (the advocate being unaware that courts require identification of trade secrets with reasonable particularity before discovery can proceed).

Like Dr. Hurst, I wonder why these lawyers did not ask themselves certain questions, like: What is the Federal Circuit's algorithm for construing claims, and what would the patent owner argue about claim construction? Why did we file this patent application? Why does the other side think it needs to file

suit on or soon after the sixth anniversary of their patent issuance, and what did they mean by the "six year rule"? Does it not seem risky to unilaterally change a contract interpretation to one's own benefit after ten years, and how might my client's conduct at the time of contracting and over the ensuing years affect how a court will interpret the contract's scope? What happens, and what is going to be required of my client, after this trade secret case is filed? Etc.

Superficial legal analysis is often accompanied by rationales like "good enough is good enough" for in-house law practice, "you need to understand that some matters only require a 'B' grade work product," "we needed to act quickly and there just wasn't time," "the client didn't want me to dig any deeper," etc. Regardless of the purported justification for setting the bar so low, it is a mystery to me how any intellectual property lawyer would not want to dig into the law and the facts sufficiently to develop their analysis and provide high-quality advice that reduces risk and increases the probability of a good result. There seems something at work in these situations, and in many situations, it may well be a lack of curiosity.

Dr. Hurst provides a useful metaphor for the lack of curiosity:

> Imagine that you are sitting in a chair in the living room of your home when you notice water dripping on your head. You observe too that the drops are falling more frequently every minute you sit there. You have 4 choices:
>
> 1. Leave the room and, by doing so, leave the problem for someone else to solve.
> 2. Continue to sit there and have no other thoughts about the dripping water.
> 3. Move your chair, but do nothing about the dripping water.
> 4. Ask yourself what could be causing the water to drop on your head.[iii]

In each of the examples of superficial analysis I provided above, a selection was made among choices 1, 2, and 3. But only choice 4 can get a good lawyer to where they want and need to be. I cannot imagine ever selecting choice 1, 2, or 3.

In closing, two questions to consider:

- *For intellectual property lawyers:* What choice do you make?
- *For scientists and business-people:* What choice is your intellectual property lawyer making?

[i] J. Willis Hurst, *A Metaphoric Equivalent for Curiosity.* Medscape (July 17, 2002)(herein "Hurst (2002)").

[ii] I have seen superficial legal analysis problems more often (but certainly not exclusively) among in-house lawyers, likely because one typically does not thrive in a good law firm without learning to dive into the details of fact and law. Some in-house legal departments do set the bar high and encourage excellence. For example, in my time at Life Technologies the IP Department actively discouraged superficial analysis, referring to it as derisively as "hitting the easy button." While many other companies also maintain high standards within their Legal and IP Departments, there are also many at which "hitting the easy button" is standard and routine.

[iii] Hurst (2002).