

Use of Treatises in Intellectual Property Cases

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A public perception exists that legal scholarship in the form of secondary authorities, such as law review articles, has been demonstrated as not worthy of citation by courts.¹ However, recent empirical law review articles have demonstrated that courts, including the United States Supreme Court, frequently cite to sources beyond primary sources, such as cases, statutes, and regulations.² Some of these articles have focused on the use of specific secondary sources, such law review articles within intellectual property cases.³ Additionally, at least one legal scholar has critiqued the reliance on treatises within copyright cases.⁴ While the reliance of patent law on legal scholarship has been mentioned previously, research regarding treatise use in patent law has not been developed further in the past ten years.⁵ Generally, intellectual property as a field is perceived to be highly reliant upon treatises – is this actually true? As of yet, there is no empirical research on the overall reliance on treatises in intellectual property cases – therefore, this study aims to determine whether the perceptions regarding treatise use are accurate.

What treatises are important enough to be looked for in this study?⁶ Following the search parameters of law review studies is not possible to catch **all** possible treatises because of the way treatises are cited.⁷ The preliminary searches regarding what are generally considered to be the major treatises did find that some treatises are indeed cited much more, by searching in all cases in

¹ Adam Liptak, *The Lackluster Reviews That Lawyers Love to Hate*, N.Y. TIMES, October 21, 2013, <http://www.nytimes.com/2013/10/22/us/law-scholarships-lackluster-reviews.html>

² David L. Schwartz & Lee Petherbridge, *Use of Legal Scholarship by the Federal Courts of Appeals: An Empirical Study*, 96 CORNELL L. REV. 1345 (2011); David L. Schwartz & Lee Petherbridge, *Legal Scholarship and the United States Court of Appeals for the Federal Circuit: An Empirical Study of a National Circuit*, 26 BERKELEY TECH. L.J. 1561 (2011); David L. Schwartz & Lee Petherbridge, *The End of an Epithet? An Exploration of the Use of Legal Scholarship in Intellectual Property Decisions*, 50 HOUS. L. REV. 523 (2012); Raizel Liebler & June Liebert, *Something Rotten in the State of Legal Citation: The Life Span of a United States Supreme Court Citation Containing an Internet Link (1996-2010)*, 15 YALE J.L. & TECH. 273 (2013)

³ David L. Schwartz & Lee Petherbridge, *The End of an Epithet? An Exploration of the Use of Legal Scholarship in Intellectual Property Decisions*, 50 HOUS. L. REV. 523 (2012)

⁴ Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CINN. L. REV. 1 (2004).

⁵ Craig Allen Nard, *Toward A Cautious Approach to Obeisance: The Role of Scholarship in Federal Circuit Patent Law Jurisprudence*, 39 HOUS. L. REV. 667, 681 (2002)

⁶ Brent E. Newton, *Law Review Scholarship in the Eyes of the Twenty-First Century Supreme Court Justices: An Empirical Analysis*, 4 DREXEL L. REV. 399, 402 n10 (2012) (“My review of the Justices' opinions revealed a large number of citations ... to legal scholarship that appeared in treatises or other legal books.”)

⁷ One suggestion has been to follow a Lemley principle – if a treatise is important enough to be cited in the over one hundred law review articles published by Mark Lemley since 1988 then it is worthy of being included in a list of important IP treatises. For example, this principle would include studying citations to at least Nimmer on Copyright and Goldstein on Copyright, but as of the most recent search, **not** Patry on Copyright or Abrams on Copyright. Another suggestion is to poll IP professors – or to look in a random sample of cases and look for only the treatises cited there.

the last three years, cited #: copyright treatises: Nimmer – 341; Patry – 41; Goldstein – 14; Abrams – 2; patent treatises: Chisum – 89; Walker on Patents (any edition) – 17; trademark treatises: McCarthy on Trademarks – 424; Gilson – 18; Kane – 2; Callman – 10.⁸

In the vast majority of the previous research in citation analysis, any “use” was considered to be sufficient, without specificity regarding the type of use.⁹ This study could potentially delve deeper into how specific sources are used. Do the treatises actually support the proposition for which they are cited? And how often are they changed due to the whims or interests of the authors, as claimed by Ann Bartow for at least the Nimmer Copyright treatise? This type of content analysis is more time consuming, but may be more valuable than raw count comparisons. Citation analysis is starting to face critique, such as Frank Pasquale’s statement that while “Citation patterns may help us discern truly important work” a “citation can be driven by many motives other than the excellence of work.”¹⁰

Because there are many ways for this work in progress to proceed, I am seeking input from others on what potential aspects will be the most important for intellectual property scholarship. Is it more important to look to raw numbers or how treatises are cited? Should this research focus on specific courts? Other types of limitation of scope? Or how often do cases cite to different types of secondary sources, including treatises and law review articles, compared to primary sources?

⁸ These numbers are similar to the percentages of citations within law review articles (JLR): Nimmer’s 629 to Patry’s 159; McCarthy’s 407 to Gilson’s 58; Chisum’s 241 to Walker’s 71.

⁹ Fred R. Shapiro & Michelle Pearse, *The Most-Cited Law Review Articles of All Time*, 110 MICH. L. REV. 1483, 1514 (2012) (“One of the most popular and respected measurements of impact is reference in court opinions. Both KeyCite on Westlaw and Shepard’s on Lexis cover citations to law review articles made in judicial opinions. ... Unlike some traditional citation studies, these metrics give some indication of the extent to which an article was referenced.”); Brent E. Newton, *Law Review Scholarship in the Eyes of the Twenty-First Century Supreme Court Justices: An Empirical Analysis*, 4 DREXEL L. REV. 399, 402 (2012) (“The study sought to identify opinions that directly cited a law review article”); David L. Schwartz & Lee Petherbridge, *The Use of Legal Scholarship by the Federal Courts of Appeals: An Empirical Study*, 96 CORNELL L. REV. 1345, 1353-54 (2011) (“for the purposes of this study judges ‘use’ scholarship when they cite to it in reported opinions”).

¹⁰ Frank Pasquale, *Glass Houses: Liptak on Legal Scholarship*, BALKANIZATION, October 22, 2013, <http://balkin.blogspot.com/2013/10/glass-houses-liptak-on-legal-scholarship.html>