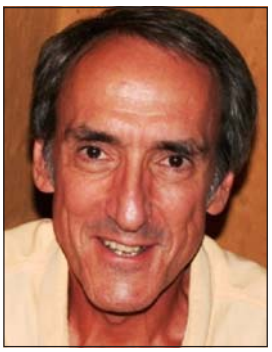
On judging intellectual property judgments

"judge : verb \jYj\: to form an opinion about (something or someone) after careful thought"



Bert Bester SC, Member, Johannesburg Society of Advocates,
Barrister, Solicitor & Notary Public, British Columbia

In theory, the adjudication of intellectual property law disputes, particularly about infringement, demands a clinically exact, analytical and deductive cognitive exercise. Successive generations of courts have therefore attempted, with greater or lesser success, to formulate general guidelines to prevent what ought to be a disciplined, rational, logical exercise from degenerating into purely intuitive callisthenics.

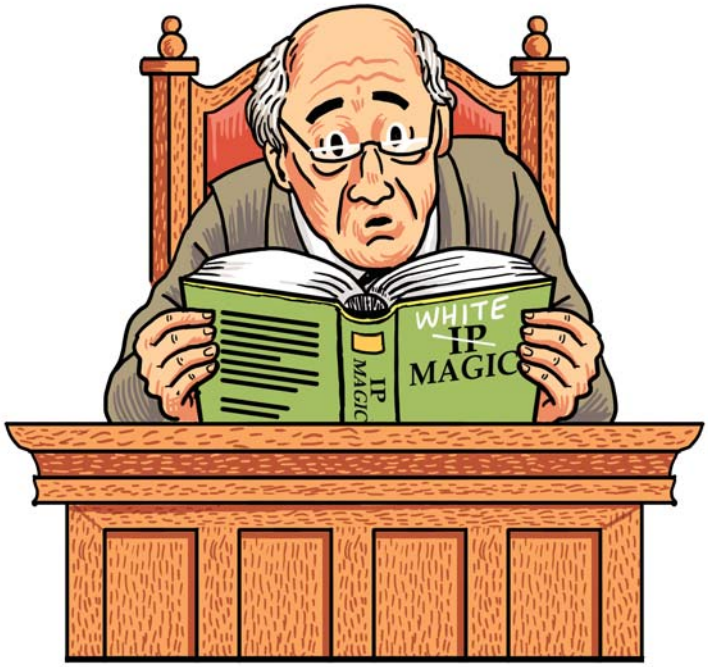
TRADE MARK INFRINGEMENT, for example, requires a comparison between a registered and an infringing mark for deceptive or confusing similarity by the application of quaint doctrines such as "imperfect recollection", the "notional purchaser", the "dominant feature or idea" of the mark, visual, aural and conceptual similarity, and so on. In copyright law substantial similarity between the copyrighted and the alleged infringing work is not enough; originality and qualitatively substantial similarity are the central measures. Patent law requires a multifactor, "purposive" construction of patent claims in order to divine the essential features of an invention as a prerequisite to the determination of an alleged infringement.

In the case of design law, that step-child of the intellectual property statutes quartet, the determination of infringing similarity requires an initial mapping of the scope of the protection afforded by the design registration, which in turn requires a construction of the definitive statement of the design and the drawings (or photographs) depicting it, all of which would supposedly identify the novel features of the registered design. But where the definitive statement is of the omnibus type (i.e., it does not isolate any feature of the design as novel or original) and the drawings (or photographs) depict the whole of the object incorporating the design, all attempts to determine that scope far too often degenerate into a rudderless exercise in which scientific, cognitive reasoning is surrendered to highly subjective ruminations that toll a tuneless, disconnected chime.

In fairness, the guidelines for the analytical and comparative exercise furnished by case law are often not only indefinite, esoteric and murky; their application requires, in addition to intellectual property law fluency, the ability comfortably to function in broad, multidisciplinary scientific, and even (marketing) communications and visual arts settings. It also requires a liberal dash of that Edward de Bono type lateral and creative cognitive skills; but most of all, a willingness and a resolute effort to be informed. No wonder John Marshall cautioned as long ago as in the Virginia Constitutional Convention Debates in 1829 "*that the greatest scourge an angry Heaven ever inflicted upon an ungrateful and a sinning people, was an obstinately ignorant … judiciary*". And not to be forgotten, William Howard Taft, said in 1908 that "*(i)t is well that judges should be clothed in robes, … in order to impress the judge himself with the constant consciousness that he is a high priest in the temple of justice and is surrounded with obligations of a sacred character that he cannot escape, and that requires his utmost care, attention and self-suppression*". Indeed.

But then, a wise old bird who sat as a puisne judge in Oban, Scotland, reminisced at his retirement that sitting on the Bench was a rotten and ungrateful job at best but, "*ach tae hell!, judges are paid to make decisions, not to make the right decisions; only appeal court judges are paid to make the right decisions and they aren't worth a damn anyway.*" And in the UK, some years ago that superb judge, Sir Hugh Laddie, announced, to indignant outcry, his resignation after far too few years on the High Court Bench. He complained bitterly of the strain of having to try cases that were beyond his ken and expertise: "*it was challenging – like high-wire walking – but I didn't think it was fair to litigants to be learning at their expense.*" That, from an internationally acclaimed expert on intellectual property law, celebrated as a judge of unparalleled acumen, with remarkable perceptive abilities and an uncanny judicial foresight. (He once demonstrated exactly such foresight when, in a 1997 patent case involving a dispute about the softness of two rival brands of bog rolls, he ordered samples of both to be lined up on the edge of the witness box in anticipation of expert testimony.) Of course, most judges make the occasional mistake and some are even prepared to admit to such human frailties. Even our own now deceased Judge Human, when on occasion asked for, and granting leave to appeal, remarked rather laconically, "*to err is human*".

Nevertheless, the public quite unreasonably expects of the judiciary to be omniscient and unfailing. Carefully considered and beautifully prosed judgments are expected – nay, demanded – and with expedition. Failing that, judges (even appeal court judges) are subjected to the occasional editorial sneering by the likes of Prof De Vos, Prof Owen Dean, Carmel Rickard and the Serjeant at the Bar.



After Bester SC

Such critics, whose harsh and at a times unwarranted words undoubtedly have a disquieting effect on judicial morale, apparently assume that all judges have the same leisure, support structure and ready resources as our Constitutional Court judges have to examine subjects deeply and to resolve debates wisely (*ach tae hell!*). Compounding these onerous burdens that weigh down on often frail judicial shoulders, intellectual property rights are ring-fenced by words, and words are plastic. As put in his inimitable way, Oliver Wendell Holmes, Jr. in *Towne v Eisner*, 245 U.S. 418, 425 (1918) said, "*a word is not a crystal, transparent and unchanging; it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used.*" And, one should add, it might also vary greatly "*according to the wisdom and peculiar philosophies of the reader*".

Not surprisingly, therefore, the impressive array of intricate legal tools conceived by the courts to attempt to determine the content and extent of intellectual property rights, and to resolve the relevant disputes, seldom prove to be reliable, exact or even scientific, and in practice often lead to vastly divergent results, not only among successive layers of court in an appeal process, but at times even among judges sitting in the same appeal.

Adjudication of disputes at the epicentre of the confluence of law and science is, therefore, fraught with anxiety. It challenges the ability to assimilate and digest intricate legal doctrines, complex scientific principles and esoteric marketing dogma, and to deal with these in an informed and effective way. In the result, the adjudicative exercise is per force effortful and slow; it requires motivation, concentration and patience, and therefore voraciously consumes time and resources – judicial commodities in very short supply, especially at the puisne level. Thus, fertile ground is fashioned for shortcuts, inadvertent or deliberate, to deliver speedier, easier and less effortful judgements.

Such shortcuts are mental strategies employed specifically because they do not require broad or deep legal knowledge, experience, computational capacity and mental effort. They provide an easy alternative to hard thinking and a simple procedure by means of which to find ready, easy answers to often difficult questions. Shortcuts, therefore, economise the selection and processing of information and enable automatic, intuitive and quick decision making, thus conserving scarce judicial time and resources. But shortcuts are per force taken in the context of information coloured and driven by a judge's peculiar values, beliefs, memories, perceptions, attitudes, stereotypes and, above all, understanding of the applicable legal and scientific dogma. Shortcuts, therefore, inevitably lead to systematic deviations from logic.

Philosophers as far back as René Descartes have distinguished between inductive, adductive and deductive reasoning as cognitive gate-ways to understanding and knowledge, and therefore to decision making. However, even then it was appreciated that deductive thinking is controlled, deliberative, reflective, considered, rational, dispassionate and rules-governed, whereas inductive and adductive thinking is essentially intuitive and therefore spontaneous, fast, effortless and undemanding of energy, computational capacity, time and resources. Decision making that follows on deductive reasoning is in the result more accurate and reliable. Decision making that flows from intuitive thinking more often than not results in conclusions that are notoriously inaccurate and unreliable.

How do judges decide intellectual property disputes in practice? Do they find the law and the facts and then apply the law to those facts in a mechanical and deliberative way; do they rely on mental shortcuts such as intuition, impressions, "hunches", "gut feelings", etc.; or is it a mixed bag of both? There are essentially two primary schools of thought.

THE FORMALISTS argue that the judicial system is a "giant syllogism machine" in which a judge acts like "highly skilled mechanic" and where decisions are made by ratiocination; an exercise in strict, logical reasoning that progresses from the general to the specific, and with a deductive justification of the latter. An exercise, therefore, comprising a major, normative premise (the applicable legal norm); a minor descriptive premise (the facts found proven); a deductive argument (the application of the legal norm to the proven facts) and a normative conclusion (the judgment) – an exercise in which the deductive argument is valid only if the premises logically imply the conclusion. And one in which the premises can only be said logically to imply the conclusion if *all* interpretations that make the premises true, also make the conclusion true. Formalistic judicial decision making, it has therefore

been said, is a process that begins in conflict (where some arguments seem to support one conclusion and other arguments another); then evolves through a reasoning process where the legal norms, the facts and the propositions undergo coherence shifts; and then achieves a state of coherence, thus transforming the way in which the dispute is represented in the judge's mind. The process therefore ends in closure with a tightly consistent justification of the final conclusion.

For their part, the realists argue that, advertently or inadvertently, judges decide cases purely by intuition, impression and "gut feel". They employ a process that allows the inferring of *y* from *x* because *x* presents a very good reason to accept *y* even though *y* does not necessarily follow from *x* and where *x* does not necessarily ensure *y*. Or one that allows the precondition *x* to be abduced from the consequence *y* and whereby *x* is inferred as an explanation of *y*. (Which is the equivalent of the fallacy of affirming the consequent because of multiple possible explanations for the precondition – something akin to the so-called "*prosecutor's fallacy/folly*" which results from a misunderstanding of *conditional* probability, which posits the probability of *y*, given that *x* has occurred).

Realistically, however, judgements are seldom the product of pure intuition or strict deduction; they are generally the product of both. But, as underscored by Kahneman in his seminal work, "*Thinking, fast and slow*", the interplay between intuitive and deliberative decision making is complicated and it happens without conscious awareness. When a judge is called upon to make a judgment that is computationally complex, that difficult problem is dealt with by answering a simpler problem – the difficult problem is substituted with a readily available cognitive bias, or then a heuristic attribute, but that substitution is subliminal and is thought of as taking place in the automatic intuitive judgment system, rather than in the more self-aware reflective system, which explains why judges can be unaware of their own cognitive biases, and why such biases can persist even when judges are made aware of them.

A heuristic attribute is a decision-making tool developed to function something like a "rule of thumb", and is invoked to reduce the amount of time and effort necessary to accomplish an assessment of probabilities on evidence that is often limited in quantity and quality, to simplify the difficult and time-consuming decision-making process, and thereby to cope with the multiple decisions that judges are required to make on a daily basis.

But are such judicial shortcuts the exception or the norm? On a first reading, most intellectual property judgments in various jurisdictions have the outward appearance of a legal technocratic exercise comprising a process of the application of articulate legal doctrine and deductive reasoning to proven facts.

But that is not the case. Empirical evidence gathered in various international studies suggests that when called upon to adjudicate cases outside of their comfort zone, or when called upon to decide cases and deliver judgments under time and other on-the-job constraints, even the most talented, dedicated and experienced judge routinely relies on cognitive shortcuts. Not many an overburdened puisne judge has the energy, the time, the inclination or even the resources to search dated, disorganised court libraries or a snail-paced Government supplied Internet before, and then to articulate intricate legal doctrine after, "careful thought". For all practical purposes, recourse to heuristics then becomes inevitable, particularly in *ex tempore* judgements.

One does not have to dig very deep into even our *written* judgements for examples of such intuitive shortcuts, which are often unwittingly announced by expressions such as, "*one's instinctive reaction*"; "*while evidence of deception in a passing off has value, it is, in the final analysis, the first impression that the product makes upon the court which is of overriding importance*"; "*when dealing with cases of alleged infringement of trade marks, the question of the likelihood of confusion or deception is a matter of first impression*"; "*primarily, the comparison is a matter of impression and in particular the first impression created is of prime importance*"; "*the interpreter … cannot avoid the often decisive first impression*" ; "*my first impression upon reading the affidavits …. having listened to, and weighed, the arguments … addressed to me, that remains my impression … indeed, it has grown into a conviction*".

MANY A GRIZZLED VETERAN of the Bench has shown, such intuitive shortcuts can on occasion lead to surprisingly accurate conclusions, but because intuitive judging is quick and easy, the temptation created by such past successes is so enormous that they eventually supplant and dominate all deliberation. And potentially majestic errors in judgment are then delivered. A careful deductive thinking process therefore requires a deliberate effort to purge the deliberative process of the influence of intuition and to escape the involuntary inclination to judge intuitively.

And a good judgement is *not* one where a shortcut taken, i.e. rationalized with pseudo-deliberative reasoning – the process of reasoning backwards from a final, intuitive conclusion to the evidence in order to justify the result. This stratagem, so-called "*motivated cognition*" has the advantage that a judgment is made to appear as if fully reasoned and the product of an intellectual struggle when it is not. It is an iniquitous process in which evidence supporting a particular conclusion is highlighted and information that speaks against it is simply disregarded. (It is also known as the "*Texas Sniper*" approach – a couple of shots are fired into a barn door and the target is then painted around the bullet holes.)

An example of another intuitive mental shortcut is the "*Halo effect*"; a shortcut that intuitively shapes conclusions. The experience by a judge of past perceived behavioural patterns and traits allows him, in a parallel situation in a next matter before him, intuitively to draw on those past experiences to reach a conclusion. For example, because of the past, personal experiences of a judge, he or she will have a positive or a negative predisposition towards counsel's argument or a witness' testimony based on, for example, one or more perceived characteristics, qualities or personality traits. Then, as a learned scholar once noted, lacking the time, knowledge, experience or inclination to make a cogent, independent, deductive judgment, the judge would tend to draw positive or negative conclusions in the case before him based on such perceptions in order to short-circuit or avoid difficult decisions and the effort of a detailed analysis and consideration of a given problem.

Examples of judicial utterances that point to an intuitive invocation of a "Halo" shortcut are, for example, "*Counsel for*

the applicant is a prominent and respected member of the Bar and an expert in this field of the law"; "*The applicant is represented by an established and reputable law firm*"; "*The plaintiff's witness is a respected scientist known to this court*"; "*The defendant's expert witness was well-groomed, courteous and articulate whereas the plaintiff's expert witness was nervous, temperamental and impolite*"; "*The witness had shifty eyes*"; "*The witness' entire demeanour and appearance did not inspire confidence in his testimony*"; "*I have carefully observed the demeanour of the witnesses and based on his demeanour I have no hesitation in finding …*".

A SUPERB EXAMPLE of the Halo effect is found in a survey that showed that attractive female barristers are perceived, but without any concurrent, focal awareness of that perception, to be more intelligent than homely female barristers. In the result attractive female barristers not only receive more courteous and polite hearings; they also have a better success rate! Small wonder the Halo Effect is referred to as "*the Devil Effect*"…

It is said that "*a thousand considerations*" could cumulatively contribute to, and influence the shaping of, such perceptions in the eyes of a judge. But, as the Constitutional Court in *President of the RSA and Others v SARFU* 2000 (1) SA 1 (CC) at 79 was quick to point out, it is dangerous to assume that all (and, one should add, perhaps any) triers of fact have that singular talent to judge on the basis of mere (subjective) observations, perceptions and past experiences.

Personally, I would go further and say that such unabashed judicial excursions into a territory upon which even experts in the humanities would tremble to tread, involuntarily reminds me of the theory advocated, and received with great public acclaim, in the Benedicts' treatise, *How to Analyze People on Sight*, (Roycrofters, NY, 1926). The thesis there was that accurate conclusions on the characteristics and qualities of humans can be drawn purely on the basis of a visual observation or appearance and traits. However, what might have been revolutionary human sciences a century ago is today nothing more than comedic clairvoyance and quackery that is best avoided.

But one ought not to wallow in despair. Many judges do pen analytical and deductive academic masterpieces that live on for generations as glittering monuments to judicial craftsmanship (think of *Roamer Watch*; *Atlas Organic Fertilizers; Plascon Evans*, *Gentiruco*, *Catnic Components*; *Burrow-Giles Lithographic Co.* and *Astrazeneca Canada* to name but a few of the many). To plagiarise Roger J. Traynor in *Some Open Questions on the Work of State Appellate Courts*, 24 U. CHI. L. REV. 211, 218 (1957) those judges must have wrestled with the devil more than once to set forth a sound opinion that would be sufficient unto more than simply the day of the case. A