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The Federal Circuit in the Shadow of the Solicitor General

John F. Duffy*

The Federal Circuit is an innovation. Created by Congress in 1982¹ as a way to centralize intermediate appellate jurisdiction in patent cases, the court was expected to create a unified body of patent precedents that would be developed by judges having some substantial degree of experience and expertise in the field.² That goal has largely been achieved,³ though there remains a lively debate as to whether Congress should have aimed for a somewhat different goal.⁴ Yet even where innovations are successful in achieving their original

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1 See Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25.

2 Thus, Daniel Meador, one of the architects of the legislation creating the Federal Circuit, praised the limitations on the Federal Circuit's subject-matter jurisdiction as a way to breed expertise, reasoning that the limited jurisdiction "improves decision making because each judge can achieve a higher level of expertise on the subjects with which he is regularly dealing." Daniel J. Meador, *Reducing Court Costs and Delay: An Appellate Court Dilemma and a Solution Through Subject Matter Organization*, 16 U. MICH. J.L. REFORM 471, 482 (1983); see also Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 7-8 (1989) [hereinafter Dreyfuss, *The Federal Circuit*] (noting that the proponents of the legislation creating the Federal Circuit had wanted to achieve "precision and accuracy" in patent law to a degree that had not been achieved through adjudication in the regional circuits); *id.* at 7 n.47 (quoting congressional testimony of Chief Judge Markey, who explained the benefits of expertise by hypothesizing "[i]f I am doing brain surgery every day, day in and day out, chances are very good that I will do your brain surgery much quicker, or a number of them, than someone who does brain surgery once every couple of years"); Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 788 (2008) (noting that at the time of the Federal Circuit's creation "[i]t was thought that if patent appeals were channeled to a single court, the federal docket would be more manageable and the quality of decisions in patent disputes would improve").

3 See Dreyfuss, *The Federal Circuit*, *supra* note 2, at 66.

4 See generally John M. Golden, *The Supreme Court as "Prime Percolator": A Prescription for Appellate Review of Questions in Patent Law*, 56 UCLA L. REV. 657 (2009); Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1623-25 (2007) (arguing that, rather than seeking to centralize patent appellate jurisdiction in a single court, Congress should have tried to achieve an optimal amount of centralization, which likely would require a small number of courts to hear patent appeals); S. Jay Plager & Lynne E. Pettigrew, *Rethinking Patent Law's Uniformity Principle: A Response to Nard and Duffy*, 101 NW. U. L. REV. 1735 (2007); Arti K. Rai, *Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH. L.J. 877 (2002) (arguing that much of the difficulty in resolving patent disputes is due not to complex law, but to the complex evidentiary and factual issues and that a specialized trial-level court may be a more effective solution than a centralized appellate court).

goals, they often produce unintended consequences. So too for the Federal Circuit. The innovative jurisdictional structure of the new appellate court has fostered a unique relationship between the Federal Circuit and the Solicitor General's Office and has, in a subtle but meaningful way, shifted power over the development of patent law from the judicial to the executive branch of government. This Article will document that transfer of power and will consider whether that shift in power should be welcomed or feared.

I. *The Solicitor General and the Patent System*

Although the Office of the Solicitor General has other duties—notably, it controls the ability of most other components of the government to file appeals in the courts of appeals—the Office's most important duty is to represent the United States before the Supreme Court. The composition of the Supreme Court's docket thus shapes and controls much of the Office's power and influence.⁵ At least in the last few decades, the United States has frequently appeared as an amicus in the Supreme Court even when the government is not directly involved in the litigation.⁶ The Office's ability to influence the path of the law in a particular area is therefore related to the *total* number of Supreme Court cases in the area, without regard to whether the government is a party, and to the level of attention that the Court affords those cases.⁷

⁵ See Rex E. Lee, *Lawyering for the Government: Politics, Polemics & Principle*, 47 OHIO ST. L.J. 595, 597–99 (1986); Wade H. McCree, Jr., *The Solicitor General and His Client*, 59 WASH. U. L.Q. 337, 338 (1981) (stating that the “Solicitor General . . . is responsible for conducting and supervising all aspects of government litigation in the Supreme Court of the United States”).

⁶ See Thomas Brennan, Lee Epstein & Nancy Staudt, *The Political Economy of Judging*, 93 MINN. L. REV. 1503, 1510–11 (2009) (describing how the Justices have “such a high level of faith in the Solicitor General's ability to present informed and balanced legal arguments that they sometimes invite him to present views in cases in which the United States is not even involved”); Richard J. Lazarus, *Advocacy Matters Before and Within the Supreme Court: Transforming the Court by Transforming the Bar*, 96 GEO. L.J. 1487, 1493–97 (2008) (noting that the Court has “almost always grant[ed] the Solicitor General permission to participate in oral argument as amicus curiae, yet rarely grant[ed] similar permission to any other amicus”); Lee, *supra* note 5, at 596–97 (noting that the Solicitor General's Office is regularly involved, either as a party or as an amicus, in more than fifty percent of the Supreme Court's docket).

⁷ See McCree, *supra* note 5, at 339–41 (relating the Solicitor General's role in handling a wide range of substantive areas of the law, as well as making determinations as to which cases require additional appellate review); Kristen A. Norman-Major, *The Solicitor General: Executive Policy Agendas and the Court*, 57 ALB. L. REV. 1081, 1083 (1994) (noting that the Solicitor General's responsibility to the Supreme Court includes serving as a filter to “screen out underserving litigation”); Seth Waxman, *Foreword: Does the Solicitor General Matter?*, 53 STAN. L.

In the area of patent law, the correlation between the Court's docket and the Solicitor General's influence meant that, as discussed in Part I.A below, the Solicitor General had little or no role to play in developing the field through the first dozen years of the Federal Circuit's existence. Since about 1994, however, the Court's interest in patent law has risen substantially, with the Court granting certiorari in several important cases and affording significant attention to petitions for certiorari in many other cases. The Court's heightened interest in patent law is documented in Parts I.B and I.C below.

With the Court's increased attention, the Solicitor General's Office has begun to wield enormous influence in the long-term development of the field. Indeed, as the Federal Circuit closes out the final years of its third decade, the interesting question is not whether the Solicitor General's Office now has significant power to control the developing path of patent law, but rather whether the Office holds more power over the long-term trends in the field than does the specialized appellate court that Congress created to govern the area.

A. *The Waning Interest of the Supreme Court: 1950–1994*

Prior to the middle of the twentieth century, the Supreme Court maintained a very active degree of supervision over the patent system.⁸ In the nineteenth century, the Court had mandatory appellate jurisdiction over all patent cases in the federal system, and it decided hundreds of cases.⁹ Indeed, in the last quarter of the nineteenth century, the Court often rendered more than a dozen patent decisions per Term.¹⁰ The Court's interest in patent cases continued even after Congress's decision in 1892 to give the Court discretion over its patent cases, with the Court averaging between two and six patent decisions per Term through the first half of the twentieth century.¹¹

If the Court had maintained that level of interest in the patent system, then the Solicitor General would have gradually assumed an important role in the patent system in the last quarter of the twentieth century, as the Solicitor General began to appear more frequently as an amicus, both at the certiorari and merits stages, in otherwise pri-

REV. 1115, 1117–18 (2001) (relating the ability of the Solicitor General's Office to influence the development of the Supreme Court's jurisprudence).

⁸ John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 286–93 (2002).

⁹ *Id.* at 286–91 (noting that the Supreme Court “was the national appellate court for all patent cases” due to a desire to establish national uniformity in patent law).

¹⁰ See Figure 1 (showing Supreme Court patent cases per Term from 1810 to 2008).

¹¹ Duffy, *supra* note 8, at 293.

Figure 1. Number of Supreme Court Patent Cases per Term Through the Supreme Court's 2008 Term (Five-Term Running Average)

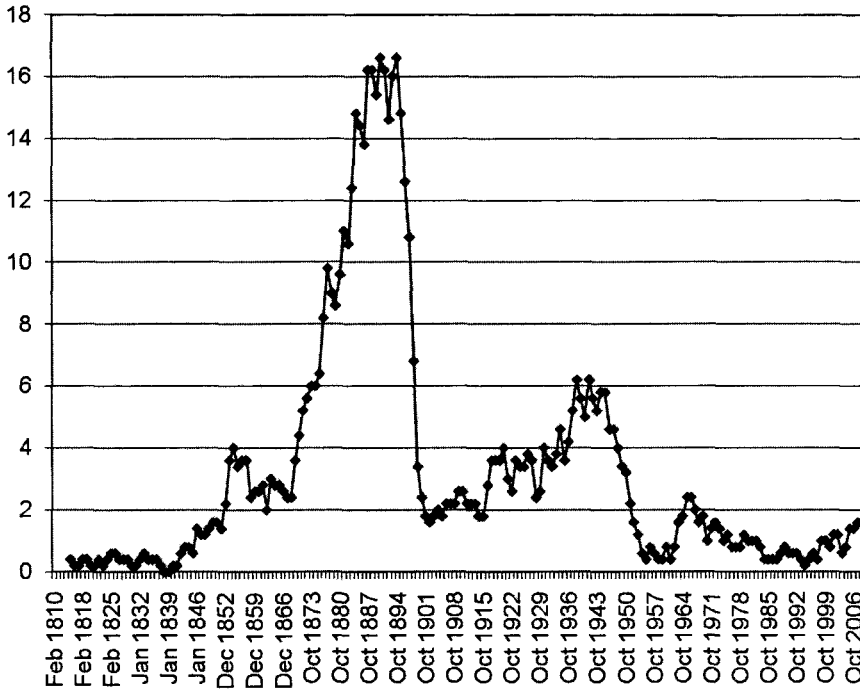
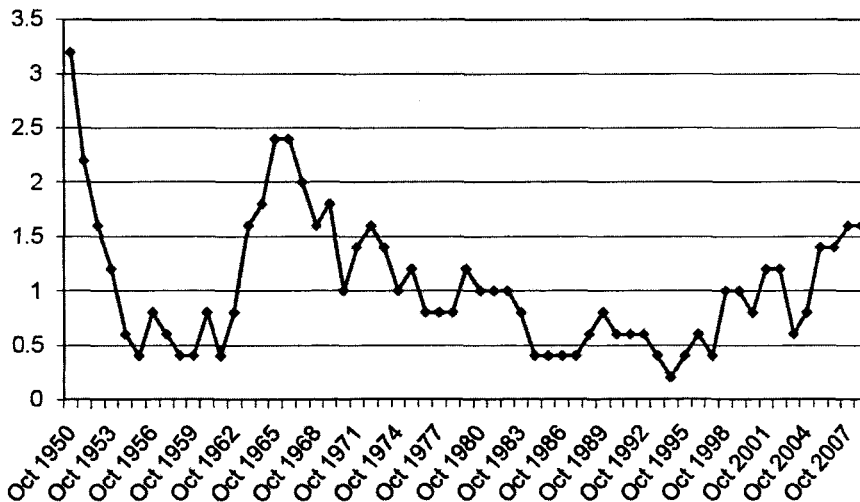


Figure 2. Number of Supreme Court Patent Cases per Term, 1950 to 2008 Terms (Five-Term Running Average)



vate cases. That did not occur, however, because the Supreme Court's interest in the patent system suffered a precipitous drop in the middle of the twentieth century.¹² From the beginning of the Supreme Court's 1950 Term through its 1982 Term (the year in which the Federal Circuit was created and the last year in which the Court ruled on a patent case from a regional circuit), the Court decided little more than one patent case, on average, per Term (thirty-six cases in thirty-three Terms).¹³

The Court's level of interest in the patent system dropped even further immediately after the creation of the Federal Circuit. In the first twelve complete Terms after the creation of the Federal Circuit (1983–1994, inclusive), the Court decided only five patent cases, less than one every two years.¹⁴ Moreover, those five cases seemed to underscore the Court's lack of interest in substantive patent law doctrines. One case was decided per curiam, without the benefit of oral argument.¹⁵ One case involved the interplay between the Patent Act and a statute outside of the special competence of the Federal Circuit.¹⁶ The other three cases involved jurisdictional or procedural issues, not core issues of substantive patent law.¹⁷

¹² See Figure 1; Duffy, *supra* note 8, at 294–96 (discussing reasons for the abrupt decrease in the number of patent cases heard by the Supreme Court in the latter half of the twentieth century).

¹³ See Duffy, *supra* note 8, at 294; Figure 2 (graph of Supreme Court patent cases per Term since 1950).

¹⁴ These cases were: *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809 (1986) (per curiam); *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800 (1988); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989); *Eli Lilly & Co. v. Medtronic, Inc.*, 496 U.S. 661 (1990); and *Cardinal Chemical Co. v. Morton International Inc.*, 508 U.S. 83 (1993). See Figure 8, *infra* p. 539 (providing a list of Supreme Court patent cases since the creation of the Federal Circuit).

¹⁵ See *Dennison*, 475 U.S. 809.

¹⁶ As described by the Supreme Court, the issue in the case was whether [§ 202 of the Drug Price and Patent Term Restoration Act of 1984, 35 U.S.C. § 271(e)(1) (1982 & Supp. V 1988)] renders activities that would otherwise constitute patent infringement noninfringing if they are undertaken for the purpose of developing and submitting to the Food and Drug Administration (FDA) information necessary to obtain marketing approval for a medical device under § 515 of the Federal Food, Drug, and Cosmetic Act[, 21 U.S.C. § 360e (1982)].

Eli Lilly & Co., 496 U.S. at 663–64.

¹⁷ In *Christianson*, the Supreme Court resolved the question of whether the Federal Circuit had jurisdiction to hear the petitioner's antitrust claims against his former employer where the case involved patent law issues only "obliquely." *Christianson*, 486 U.S. at 806. As the antitrust claims in the case did not "aris[e] under" a federal patent statute, the Supreme Court held that the regional circuits, not the Federal Circuit, held jurisdiction over the case. *Id.* at 809, 819. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* dealt with whether the U.S. Constitution's Supremacy Clause required that federal patent laws preempt Florida state statutes prohibiting

B. *The Beginning of the Court's Return, and the Increasing Role of the Solicitor General: 1994–1999*

In the 1994 Term, the Court began a slow return to the patent field.¹⁸ At first, its return was hard to notice. The Court in its 1994 Term granted only one petition for certiorari in a patent case, *American Airlines v. Lockwood*.¹⁹ The issue in that case—whether a patentee has the right to a jury trial in an action for a declaratory judgment of patent invalidity—was rendered moot after the patentee withdrew his demand for a jury trial.²⁰ Thus, the Court did not hold oral argument in the case, but instead merely vacated the Federal Circuit's opinion and remanded the case for further proceedings.²¹

Even in hindsight, the Court's grant of certiorari in *Lockwood* might be easy to overlook, but there are three additional reasons to consider the 1994 Term a significant turning point. First, the 1994 Term was the beginning of a long-term trend.²² While the Court had decided only five patent cases in the first dozen Terms in which the Federal Circuit was in existence, its next five patent cases were decided in the four Terms after 1994 (1995–1998, inclusive).²³ With one

the use of direct-molding processes to duplicate unpatented boat hulls. 489 U.S. at 144, 167–68. Finally, in *Cardinal Chemical Co. v. Morton International Inc.*, the Supreme Court held that the Federal Circuit should ordinarily not vacate a district court's holding of patent invalidity even though the circuit court determines that the patent was not infringed in that particular case. See 508 U.S. at 85. Rather, the court should normally review the district court's judgment of invalidity. While the Court's holding involved considerations of patent policy, it was ultimately directed to the proper appellate procedure to be followed by the Federal Circuit, not to an issue of substantive patent law.

¹⁸ See Gregory A. Castanias, Lawrence D. Rosenberg, Michael S. Fried & Todd R. Gernima, *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, 802–07 (2007) (recognizing that, for the Supreme Court's interest in patent cases, “[t]he tide began to turn in 1995”); Hon. Timothy B. Dyk, *Foreword: Does the Supreme Court Still Matter?*, 57 AM. U. L. REV. 763, 764–65 (2008) (noting that the Court increased its pace in reviewing patent-related matters “a bit” during the second decade of the Federal Circuit's existence but asserting that the pace “substantially accelerated in the past five years and particularly in the last three”).

¹⁹ *American Airlines, Inc. v. Lockwood*, 515 U.S. 1121 (1995) (No. 94-1660) (order granting certiorari).

²⁰ See *In re Lockwood*, 50 F.3d 966, 980 (Fed. Cir. 1995) (discussing whether the patentee has a right to a jury trial in a determination of patent validity).

²¹ *American Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995) (No. 94-1660) (vacating Federal Circuit opinion and remanding the case for trial).

²² Duffy, *supra* note 8, at 297–99; Dyk, *supra* note 18, at 764–65; see also ROBERT P. MERGES & JOHN F. DUFFY, *PATENT LAW AND POLICY* 1050–51 (4th ed. 2007) (noting the Supreme Court's continuing interest in patent cases and listing the nine cases decided 2002–2007).

²³ The cases in the Supreme Court's 1995–1998 Terms included *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997); *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998); *Dickinson v. Zurko*, 527 U.S.

exception, these cases also focused on issues involving matters of important patent policy such as the scope of the doctrine of equivalents,²⁴ the proper allocation of decisional power between judge and jury in interpreting patent claims,²⁵ the test for applying patent law's statutory "on sale" bar to patenting,²⁶ and the level of deference to be afforded to the Patent & Trademark Office ("PTO").²⁷ In its next ten Terms (1999–2008, inclusive), the Justices would hear argument and issue opinions in eleven more Federal Circuit patent cases.²⁸ Thus, unlike its anemic average of deciding less than one patent case every two years during the 1983–1994 Terms, the Court in the years since 1994 has averaged more than one patent case per Term, all of which have come from the Federal Circuit.

A second significant event in the 1994 Term was the beginning of Justice Breyer's tenure on the Court. Breyer began his career as a young law professor writing about intellectual property law, and his article *The Uneasy Case for Copyright*²⁹ remains a classic work of intellectual property skepticism.³⁰ Throughout his academic career, his work in government, and his tenure as a court of appeals judge, Breyer built a reputation as one of the leading scholars of antitrust, administrative law, and regulatory theory.³¹ Patent law, which com-

150 (1999); *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627 (1999).

²⁴ See *Warner-Jenkinson Co.*, 520 U.S. at 21.

²⁵ See *Markman*, 517 U.S. at 372 ("The question here is whether the interpretation of a so-called patent claim, the portion of the patent document that defines the scope of the patentee's rights, is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered.").

²⁶ See *Pfaff*, 525 U.S. at 57 (noting that the question on appeal was "whether the commercial marketing of a newly invented product may mark the beginning of the 1-year period [triggering the 'on sale' bar under § 102(b)] even though the invention has not yet been reduced to practice").

²⁷ See *Dickinson*, 527 U.S. at 153–54.

²⁸ *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124 (2001); *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826 (2002); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002); *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193 (2005); *Ill. Tool Works Inc. v. Indep. Ink, Inc.*, 547 U.S. 28 (2006); *Lab. Corp. of Am. Holdings v. Metabolite Lab.*, 548 U.S. 124 (2006); *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006); *MedImmune v. Genentech, Inc.*, 549 U.S. 118 (2007); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007); *Quanta Computer, Inc. v. LG Electronics, Inc.*, 128 S. Ct. 2109 (2008).

²⁹ Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

³⁰ See generally *id.* (arguing that the revisions in the later-enacted Copyright Act of 1976 would provide for unnecessary overprotections in a number of substantive areas).

³¹ For example, prior to becoming a Justice of the Supreme Court, Breyer authored the

bines intellectual property with issues of antitrust, regulatory theory, and administrative law, seems like a natural area for Justice Breyer, and his subsequent record in writing majority and dissenting opinions in patent cases suggests a strong level of interest in the area.³² Justice Breyer's appointment in 1994 appears to be at least partly responsible for the Court's increased number of certiorari grants in patent cases.

Finally, the most significant event for purposes of this Article was that the Court in its 1994 Term issued its first ever invitation for the Solicitor General to file an amicus brief setting forth the government's views as to whether the Court should grant certiorari in a patent case.³³ Such invitations, which Supreme Court practitioners refer to as "Calls for Views of the Solicitor General" or "CVSG" orders, have been an accepted part of Supreme Court practice for about a half century. Figure 3 below shows the number of such CVSG orders issued by the Court in all cases per Term.³⁴ As that Figure shows, the Court began routinely issuing such orders in the 1960s and '70s, and by 1980, it was not unusual for the Court to issue a dozen or more (sometimes many more) CVSGs per Term.³⁵ Yet prior to 1994, the Court had never issued a CVSG in a patent case.³⁶

following law review articles on federal economic regulation: *The Problem of the Honest Monopolist*, 44 ANTITRUST L.J. 194 (1975); *Afterword—Legacy of the New Deal: Problems and Possibilities in the Administrative State*, 92 YALE L.J. 1614 (1983); *Reforming Regulation*, 59 TUL. L. REV. 4 (1984); *Essay: Economists and Economic Regulation*, 47 U. PITT. L. REV. 205 (1985); *Antitrust, Deregulation, and the Newly Liberated Marketplace*, 75 CAL. L. REV. 1005 (1987). He also wrote important books on regulatory reform: *BREAKING THE VICIOUS CIRCLE: TOWARD EFFECTIVE RISK REGULATION* (1993) and *REGULATION AND ITS REFORM* (1982).

³² For instance, Justice Breyer authored the majority opinion in the following intellectual property-focused cases: *Dickinson*, 527 U.S. at 152, and *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 160 (1995). Additionally, he has authored a concurring opinion in *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 949 (2005), and dissenting opinions in *Laboratory Corp. of America Holdings*, 548 U.S. at 125; *Eldred v. Ashcroft*, 537 U.S. 186, 242 (2003); *J.E.M. Ag Supply, Inc.*, 534 U.S. at 147; and *College Savings Bank v. Florida Prepaid Post Secondary Education Expense Board*, 527 U.S. 666, 693 (1999).

³³ See *Barr Labs. v. Burroughs Wellcome Co.*, 515 U.S. 1130 (1995) (No. 94-1527) (inviting CVSG). Ultimately, the Court denied the petitioner's writ of certiorari. *Barr Labs. v. Burroughs Wellcome Co.*, 516 U.S. 1070 (1996) (No. 94-1527).

³⁴ See Figure 3 (showing the number of pre-certiorari CVSGs per Supreme Court Term in all case types).

³⁵ See *id.*

³⁶ See Figure 4 (showing the number of pre-certiorari CVSGs in patent cases per Term from 1990–2008). In its 1993 Term, the Court had issued a CVSG in a Federal Circuit case involving the Plant Variety Protection Act, 7 U.S.C. §§ 2321–2582 (2006), a statute that grants patent-like rights in plant varieties but that is administered by the Department of Agriculture. See *Asgrow Seed Co. v. Winterboer*, 510 U.S. 806, 806 (1993) (No. 92-2038) (issuing CVSG order); 511 U.S. 1029, 1029 (1994) (No. 92-2038) (granting certiorari); 513 U.S. 179, 193 (1995) (reversing the Federal Circuit).

Figure 3. Number of Pre-Cert CVSGs per Term Through the Supreme Court's 2008 Term

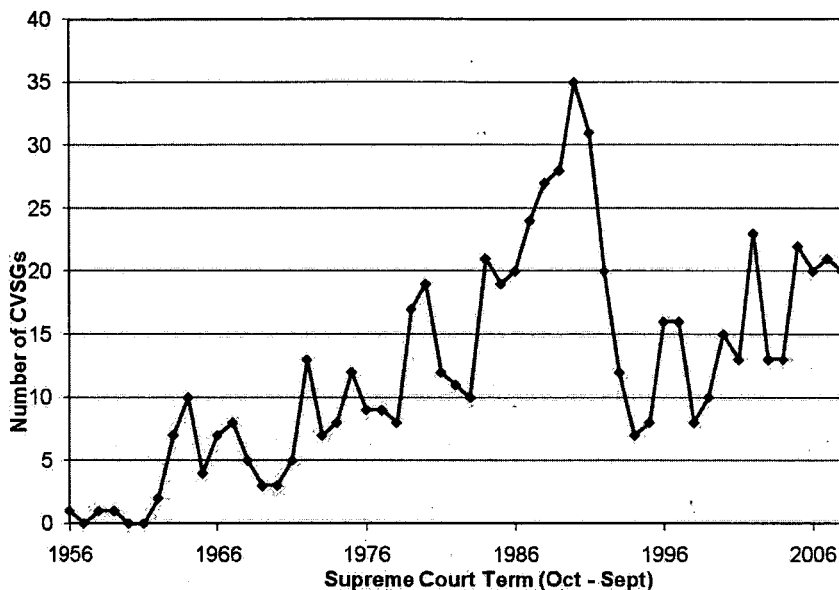
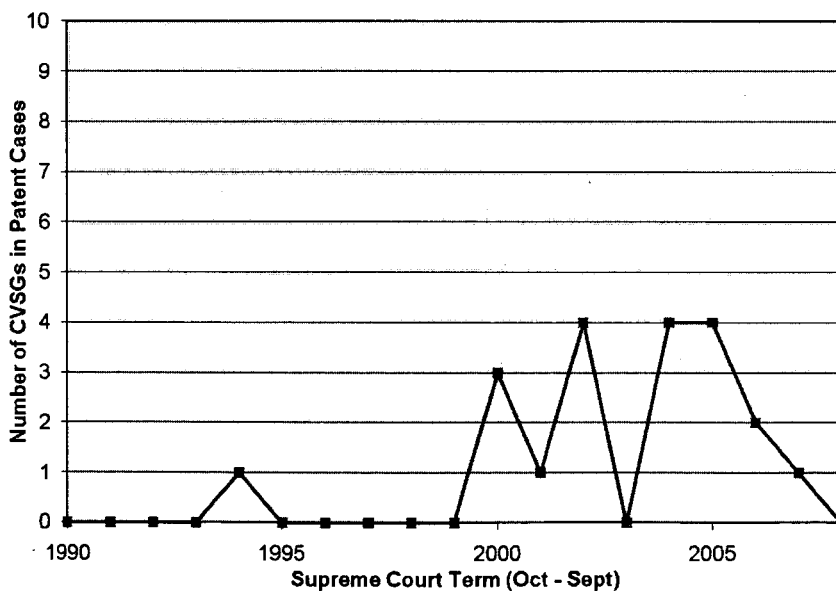


Figure 4. Number of Pre-Cert CVSGs per Term in Patent Cases Through the Supreme Court's 2008 Term



The absence of CVSG orders in patent cases is especially telling because CVSGs are thought to be issued where the Court believes the case for granting certiorari is close, the case is complex, and a component of the government may have some relevant expertise or interest

in the issue.³⁷ Patent cases are typically complex, and the PTO (a component of the government represented by the Solicitor General at the Court) has both great expertise in the patent system and a significant interest in assuring the system's proper functioning.³⁸ Thus, the absence of CVSGs prior to 1994 suggests that not only was the Court granting very few petitions for certiorari in patent cases, but it also was not seriously considering granting many such petitions.

In response to that first patent CVSG—the case was *Barr Laboratories v. Burroughs Wellcome Co.*³⁹—the Solicitor General recommended that certiorari be denied,⁴⁰ and the Court followed that recommendation.⁴¹ The case involved a high-stakes fight over whether Burroughs Wellcome held a valid patent on the use of azidothymidine (AZT) in the treatment of AIDS.⁴² The Federal Circuit sustained the validity of the Burroughs Wellcome patent, and the issue presented in the certiorari petition was whether an inventor may establish conception of an invention (and thereby establish priority to patent rights) even before the inventor has a reasonable expectation that an invention will succeed.⁴³ The Solicitor General's brief agreed with the Federal Circuit's view that such a reasonable expectation was not required, and it also demonstrated that the Federal Circuit's view was consistent with a long line of precedents, including the Court's own decision to sustain Alexander Graham Bell's priority right in *The Telephone Cases*.⁴⁴

³⁷ See Golden, *supra* note 4, at 710 (stating that “the Court can call for the views of the solicitor general when it believes it needs help in gathering the information necessary to apply the relevant criteria”); David C. Thompson & Melanie F. Wachtell, *An Empirical Analysis of Supreme Court Certiorari Petition Procedures: The Call for Response and the Call for the Views of the Solicitor General*, 16 GEO. MASON L. REV. 237, 245 (2009) (noting that the “Court calls for the views of the Solicitor General most often in intellectual property cases, antitrust cases, ERISA cases, and other matters involving complex regulatory regimes”).

³⁸ See Clarisa Long, *The PTO and the Market for Influence in Patent Law*, 157 U. PA. L. REV. 1965, 1971–72 (2009) (noting the increased influence of the PTO in matters before the Supreme Court); Arti K. Rai, *Growing Pains in the Administrative State: The Patent Office's Troubled Quest for Managerial Control*, 157 U. PA. L. REV. 2051, 2053–55 (2009) (discussing the institutional capabilities of the PTO).

³⁹ *Barr Labs. v. Burroughs Wellcome Co.*, 515 U.S. 1130 (1995) (No. 94-1527) (inviting CVSG).

⁴⁰ See Brief for the United States as Amicus Curiae at 34, *Barr Labs.*, 515 U.S. 1130 (1995) (Nos. 94-1527 & 94-1531), available at <http://www.justice.gov/osg/briefs/1994/w941527w.txt>.

⁴¹ *Barr Labs. v. Burroughs Wellcome Co.*, 516 U.S. 1070 (1996) (No. 94-1527) (denying certiorari).

⁴² See *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1225–26 (Fed. Cir. 1994).

⁴³ See Brief for the United States as Amicus Curiae, *supra* note 40, at 1.

⁴⁴ *Id.* at 16–17; see also *The Telephone Cases*, 126 U.S. 1 (1888).

After *Barr*, the Court did not issue another CVSG order in a patent case for the next five years. Still, the Court was increasing its level of activity in patent cases, and so too was the Solicitor General. The Court heard five patent cases during this period (1995–1999 Terms, inclusive).⁴⁵ In the first—the highly important case of *Markman v. Westview Instruments*⁴⁶—the Solicitor General did not bother to participate as an amicus in the case. But in the next four cases, the Solicitor General argued as an amicus or as a party.⁴⁷

Even during this early period, the Solicitor General's Office was in the process of building a record of success at the Supreme Court that would eventually be far better than the Federal Circuit's record. Although in one case—*Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*—the Court disagreed with the position endorsed by both the Court of Appeals and the Solicitor General,⁴⁸ the Solicitor General fared much better in each of the other cases. Where the Solicitor General represented the government as petitioner—in *Dickinson v. Zurko*⁴⁹—the Court reversed a unanimous en banc decision of the Federal Circuit in favor of the government's position (which afforded a higher level of deference to the PTO).⁵⁰ In another case, *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*,⁵¹ the Solicitor General agreed with most of the analysis of the en banc Federal Circuit, but on the one point that the Solicitor General disagreed with the Court of Appeals, the Supreme Court sided with the Solicitor General, vacated the decision below, and remanded the case—precisely the result sought by the Solicitor General.⁵²

⁴⁵ These cases were: *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997); *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998); *Dickinson v. Zurko*, 527 U.S. 150 (1999); and *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627 (1999).

⁴⁶ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

⁴⁷ The Solicitor General participated as amicus curiae in *Warner-Jenkinson*, 520 U.S. at 20, and *Pfaff*, 525 U.S. at 56, and as a party in *Dickinson*, 527 U.S. at 151, and *Florida Prepaid*, 527 U.S. at 629.

⁴⁸ *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999). Both the Federal Circuit and the Solicitor General agreed that Congress had abrogated the ability of states to claim a privilege of state sovereign immunity in patent infringement suits brought in federal court. See *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 148 F.3d 1343, 1355 (Fed. Cir. 1998); Brief for Respondent at 9–12, *Fla. Prepaid*, 527 U.S. 627 (1999) (No. 98-531). On appeal, the Supreme Court disagreed, holding that Congress's efforts were outside the authority granted under Article I. See *Fla. Prepaid*, 527 U.S. at 647–48.

⁴⁹ *Dickinson v. Zurko*, 527 U.S. 150, 151 (1999).

⁵⁰ *Id.* at 153–54, 165.

⁵¹ *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997).

⁵² *Id.* at 31–32, 40–41.

Finally, in *Pfaff v. Wells Electronics Inc.*,⁵³ the Solicitor General recommended affirming the judgment below, but rejecting the Federal Circuit's test for applying the Patent Act's "on sale" bar.⁵⁴ The Federal Circuit had held that a determination whether an invention was "on sale" required weighing the totality of the circumstances in each case,⁵⁵ but the Solicitor General argued that the test should be "more straightforward and direct."⁵⁶ The Court followed the general thrust of the Solicitor General's recommendation, criticized the Federal Circuit's totality-of-the-circumstances approach as "seriously undermin[ing] the interest in certainty," and set forth a more bright-line test similar to, albeit not identical to, the Solicitor General's proposed test.⁵⁷

At the end of the 1999 Term, the Solicitor General's role in the patent system was still minimal. The Solicitor General had largely supported the positions adopted by the Federal Circuit in every case except the one in which the government had been the petitioner seeking to overturn the ruling below. In the cases where the Solicitor General participated as an amicus, the Court's favoring of the Solicitor General over the Federal Circuit was subtle and easy to overlook. Moreover, in the 1999 Term, the Court heard no patent cases. It was entirely possible that the minor increase in Supreme Court patent cases over those five years had been a smallish aberration; that the Court's level of interest would fade once again; and that the Solicitor General would have little involvement in patents. But that is not what happened.

C. *The Solicitor General's Expanded Role: 2000–2009*

On the first day of the its October 2000 Term, the Supreme Court issued its second ever CVSG order in a patent case, requesting the Solicitor General's views on whether to grant certiorari in *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc.*⁵⁸ By the end of that

⁵³ *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55 (1998).

⁵⁴ *Id.* at 68 n.14.

⁵⁵ *Pfaff v. Wells Elecs., Inc.*, 124 F.3d 1429, 1433 (Fed. Cir. 1997) (holding that "in making the determination as to whether the invention was 'on sale,' 'all of the circumstances surrounding the sale or offer to sell, including the stage of development of the invention and the nature of the invention, must be considered and weighed against the policies underlying section 102(b).'" (citation omitted)).

⁵⁶ See Brief for the United States as Amicus Curiae Supporting Respondent at 28, *Pfaff*, 525 U.S. 55 (No. 97-1130).

⁵⁷ *Pfaff*, 525 U.S. at 65–66 n.11, 67–68.

⁵⁸ *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 531 U.S. 807 (2000) (No. 99-1996) (inviting CVSG).

month, the Court had issued two other CVSG orders in Federal Circuit patent cases,⁵⁹ bringing the number of patent CVSGs for the 2000 Term to triple the number that had been issued in the first eighteen years of the Federal Circuit's existence. That sudden surge of CVSG orders would mark the beginning of a significant trend. In the nine Terms from 2000 to 2008 (inclusive), the Court would issue nineteen CVSG orders in patent or patent-antitrust cases, with sixteen of those cases coming from the Federal Circuit.⁶⁰ During those Terms, patent cases would come to occupy more than 10% of the Court's total CVSG orders—an extraordinary figure given that, prior to 2000, the Court had issued only one CVSG in a patent case *ever* and that patent cases have not occupied more than 2.25% of the Court's docket (averaging over five years) for more than a half century.⁶¹

The surge in CVSGs can be viewed as the Supreme Court's solution to a problem created by the specialized jurisdiction of the Federal Circuit.⁶² In most federal statutory cases, the Supreme Court follows a rather simple rule in deciding whether to grant certiorari in the case: the Court waits until the courts of appeals have reached inconsistent results in the interpretation and application of the federal law.⁶³ If the Court followed that approach in reviewing certiorari petitions from Federal Circuit patent cases, it would end up hearing very few patent cases. In effect, the Court would lose a substantial portion of its authority to shape the course of federal patent law, and power over patent law would shift to the more expert intermediate appellate court.⁶⁴

⁵⁹ See *CSU, L.L.C. v. Xerox Corp.*, 531 U.S. 922 (2000) (No. 00-62) (inviting CVSG), *cert. denied*, 531 U.S. 1143 (2001); *Atlantic Richfield Co. v. Union Oil Co. of Cal.*, 531 U.S. 942 (2000) (No. 00-249) (inviting CVSG), *cert. denied*, 531 U.S. 1183 (2001).

⁶⁰ See Figure 5 (listing all instances of Supreme Court CVSGs in patent-related matters through the end of the 2008 Term).

⁶¹ See Figures 6 and 7 (graphs showing Supreme Court patent cases per Term as a percentage of total Supreme Court cases from the 1810 through the 2008 Terms and from the 1950 through the 2008 Terms).

⁶² See Hon. Randall R. Rader, *Introduction—Specialized Courts: The Legislative Response*, 40 AM. U. L. REV. 1003, 1004–06 (1991) (summarizing the concerns of lawmakers over the creation of the Federal Circuit, and noting particularly that the new court would eliminate the ability of regional courts to opine on patent matters).

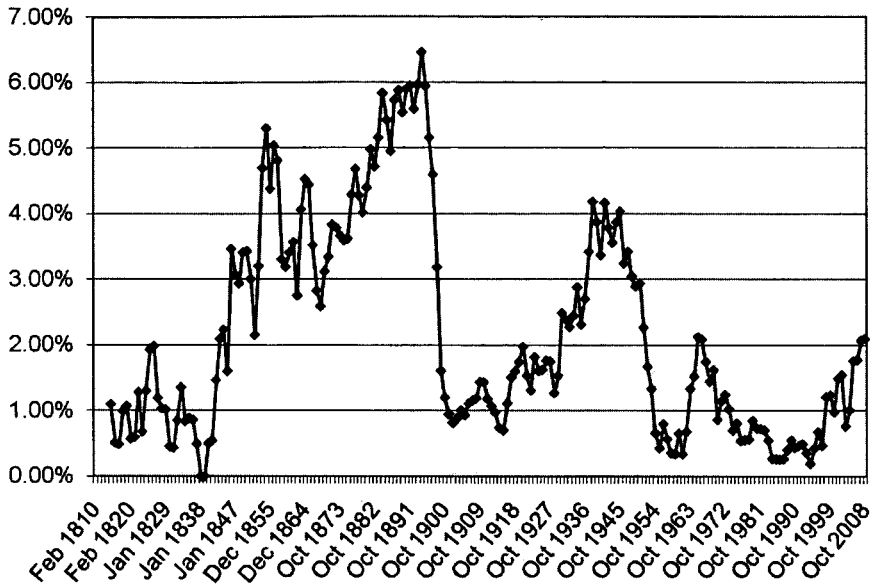
⁶³ See H.W. PERRY, JR., *DECIDING TO DECIDE: AGENDA SETTING IN THE UNITED STATES SUPREME COURT* 246–52, 277–79 (1991) (noting that circuit splits are a strong factor in granting certiorari in all cases); DORIS MARIE PROVINE, *CASE SELECTION IN THE UNITED STATES SUPREME COURT* 37–40 (1980); S. Sidney Ulmer, *The Supreme Court's Certiorari Decisions: Conflict as a Predictive Variable*, 78 AM. POL. SCI. REV. 901, 910 (1984) (relating the results of an empirical study indicating that the Supreme Court was “significantly responsive” to issues of legal conflict in the determination of whether to grant certiorari).

⁶⁴ See Hon. S. Jay Plager, *The United States Courts of Appeals, The Federal Circuit, and the Non-Regional Subject Matter Concept: Reflections on the Search for a Model*, 39 AM. U. L. REV.

Figure 5. Patent Cases and Patent-Antitrust Cases Involving Supreme Court CVSG Orders Through the 2007 Term

Case Name	Term Order Issued	Lower Court	SG Cert. Rec.	Cert?	SG merits rec.	Merits Disp.
Barr Lab. v. Burroughs Wellcome Co.	1994	CAFC	Deny	Denied		
J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.	2000	CAFC	Deny	Granted	Affirm	Affirmed
CSU, L.L.C. v. Xerox Corp.	2000	CAFC	Deny	Denied		
Atlantic Richfield Co. v. Union Oil Co.	2000	CAFC	Deny	Denied		
Fin Control Sys. Pty. v. Surfco Haw.	2001	CAFC	Deny	Denied		
Monsanto Co. v. Bayer Cropscience	2002	CAFC	Deny	Denied		
Dethmers Mfg. Co. v. Automatic Equip. Mfg. Co.	2002	CAFC	Deny	Denied		
Duke Univ. v. Madey	2002	CAFC	Deny	Denied		
Andrx Pharms., Inc. v. Kroger Co.	2003	6th Cir.	Deny	Denied		
Merck KGaA v. Integra Lifesciences I, Ltd.	2004	CAFC	Grant	Granted	Vacate and Remand	Vacated and Remanded
McFarling v. Monsanto Co.	2004	CAFC	Deny	Denied		
Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.	2004	CAFC	Deny	Granted only on question 3	Affirm, Dismiss, or Vacate and remand	Writ of Cert Dismissed
KSR Int'l Co. v. Teleflex, Inc.	2005	CAFC	Grant	Granted	Reverse	Reversed and Remanded
FTC v. Schering-Plough Corp.	2005	11th Cir.	Deny	Denied		
SmithKline Beecham Corp. v. Apotex Corp.	2005	CAFC	Deny	Denied		
Microsoft Corp. v. AT&T Corp.	2005	CAFC	Grant	Granted	Reverse	Reversed
Apotex Inc. v. Pfizer, Inc.	2005	CAFC	Settled before SG response	Denied		
Joblove v. Barr Labs, Inc.	2006	2nd Cir.	Deny	Denied		
Quanta Computer, Inc. v. LG Elecs., Inc.	2006	CAFC	Grant	Granted	Vacate and Remand	Reversed
Biomedical Patent Mgmt. Corp. v. Cal. Dep't of Health Servs.	2007	CAFC	Deny	Denied		

Figure 6. Supreme Court Patent Cases as a Percentage of Total Supreme Court Cases, 1810–2008 Terms (Five-Term Running Average)⁶⁵



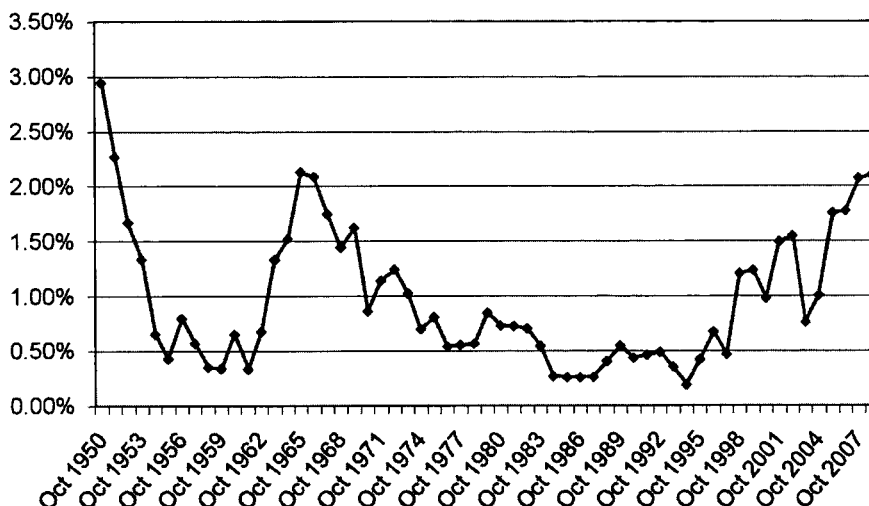
853, 855 (1990) (noting that one of the benefits of the Federal Circuit's creation was that it "reliev[ed] some of the pressure on the Supreme Court caused by the need to monitor inter-circuit differences" and that "[b]y making one appellate court responsible for the development of the law in particular areas, Congress, in a single stroke, eliminated inter-circuit conflicts and achieved uniformity").

⁶⁵ The percentage of the Supreme Court's docket occupied by patent cases, averaged over a five-year period, was determined by dividing the average number of patent cases per Term by the average number of Supreme Court cases per Term. The number of patent cases in each Term was determined by the method described in Duffy, *supra* note 8, at 287–88 n.50. The number of Supreme Court cases per Term was obtained from three sources.

For the Supreme Court Terms of 2002–2008, the source of the data was *The Harvard Law Review*, which annually publishes statistics on the Supreme Court's activity. See *The Supreme Court, 2008 Term—The Statistics*, 123 HARV. L. REV. 382, 393 (2009); *The Supreme Court, 2007 Term—The Statistics*, 122 HARV. L. REV. 516, 527 (2008); *The Supreme Court, 2006 Term—The Statistics*, 121 HARV. L. REV. 436, 447 (2007); *The Supreme Court, 2005 Term—The Statistics*, 120 HARV. L. REV. 372, 382 (2006); *The Supreme Court, 2004 Term—The Statistics*, 119 HARV. L. REV. 415, 428 (2005); *The Supreme Court, 2003 Term—The Statistics*, 118 HARV. L. REV. 497, 507 (2004); *The Supreme Court, 2002 Term—The Statistics*, 117 HARV. L. REV. 480, 489 (2003).

For the Supreme Court Terms of 1810–2001, the primary source was *The Supreme Court Compendium*. LEE EPSTEIN ET AL., *THE SUPREME COURT COMPENDIUM: DATA, DECISIONS, AND DEVELOPMENTS* 216–20 tbl.3-3 (3d ed. 2003). However, in 1850, the Supreme Court held both a January Term and a December Term. Professor Epstein and her co-authors combine these terms into one and report a single figure. To determine the number of cases in each of the 1850 Terms, Lexis searches were performed in the Lexis Supreme Court file, with the search limited only by date (1/1/1850 to 11/30/1850, and 12/1/1850 to 11/30/1851). Those searches yielded 78 and 85 cases, respectively. Limiting the search results to cases that included some substantive ruling by the Court produced 77 and 79 opinions. Those results were consistent with those of Professor Epstein and her co-authors, who report 156 cases for the two 1850 Terms. *Id.*

Figure 7. Supreme Court Patent Cases as a Percentage of Total Supreme Court Cases, 1950–2008 Terms (Five-Term Running Average)



Of course, shifting power over patent law from the Supreme Court to the Federal Circuit might be defended as good public policy. The Supreme Court decided very few patent cases in the first dozen years after the creation of the Federal Circuit,⁶⁶ and it could have chosen to continue that approach indefinitely, perhaps hearing Federal Circuit patent cases only where institutional issues with broader implications were at stake.⁶⁷ Congress created the Federal Circuit in part because the Supreme Court was not supervising circuit splits that were arising in patent law and in part because Congress wanted to have a more expert appellate court supervising the law of patents.⁶⁸ In the years following the creation of the Federal Circuit, many patent practitioners believed that the new court would become the nation’s “de facto supreme court of patents.”⁶⁹

The number of cases per Supreme Court Term varies slightly depending upon the definition employed to define a case (and thus Professor Epstein’s numbers sometimes differ from those reported in *The Harvard Law Review*). Those discrepancies are, however, typically less than 10% and would not greatly affect the general results reported in the graphs.

⁶⁶ See *supra* notes 14–17 and accompanying text.

⁶⁷ See Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 408, 417–19 (arguing that the Court should limit its review of federal patent cases to ensure the proper “allocation of power among institutional actors”).

⁶⁸ See Dreyfuss, *The Federal Circuit*, *supra* note 2, at 6–7.

⁶⁹ Donald S. Chisum, *The Supreme Court and Patent Law: Does Shallow Reasoning Lead to Thin Law?*, 3 MARQ. INTELL. PROP. L. REV. 1, 2 (1999) (“Since the creation of the Federal Circuit in 1982, we have all said that the Federal Circuit is the Supreme Court of patent law because they have virtually exclusive appellate jurisdiction over patent matters. Consequently,

The Supreme Court was, however, almost certainly destined to resist relinquishing its authority, for it would have set a precedent that might lead to much broader inroads on the Court's power. The U.S. Constitution vests the judicial power of the United States "in *one* supreme Court, and in such *inferior* Courts as the Congress may from time to time ordain and establish."⁷⁰ The references to "one" Supreme Court and to the other courts being "inferior" supports an interpretation of the Constitution that forbids Congress from establishing other courts having final appellate jurisdiction over any field of federal law. True, the Constitution also provides that the Supreme Court's appellate jurisdiction is subject to "such Exceptions . . . as the Congress shall make."⁷¹ The so-called "Exceptions Clause" supports a constitutional interpretation under which Congress could eliminate the Supreme Court's appellate jurisdiction over a category of federal cases and allow some other federal court to have the final word in that area of law. That interpretation of the Exceptions Clause has, however, remained highly controversial through history,⁷² and the extent to which the Exceptions Clause gives Congress the power to limit the appellate jurisdiction of the Supreme Court remains one of the great unresolved issues in the study of federal courts.⁷³

there is no point in thinking about the Supreme Court."); Janis, *supra* note 67, at 387; Harold C. Petrowitz, *Federal Court Reform: The Federal Courts Improvement Act of 1982—And Beyond*, 32 AM. U. L. REV. 543, 557 (1983) (asserting that "[i]t seems safe to predict that few of the new court's decisions will reach the Supreme Court because of the consistency that *should* result from decisions of the Federal Circuit").

⁷⁰ U.S. CONST. art. III, § 1, cl. 1 (emphasis added).

⁷¹ *Id.* § 2, cl. 2.

⁷² See Peter J. Smith, *Textualism and Jurisdiction*, 108 COLUM. L. REV. 1883, 1893–94 (2008) (summarizing the historical debate over the scope of the Exceptions Clause and the power of Congress to limit Supreme Court appellate jurisdiction).

⁷³ See, e.g., Gerald Gunther, *Congressional Power to Curtail Federal Court Jurisdiction: An Opinionated Guide to the Ongoing Debate*, 36 STAN. L. REV. 895, 901–910 (1984) (discussing the long-running academic debate on the Exceptions Clause and agreeing with the advocates of broad congressional power to limit Supreme Court appellate jurisdiction); John Harrison, *The Power of Congress to Limit the Jurisdiction of Federal Courts and the Text of Article III*, 64 U. CHI. L. REV. 203 (1997) (discussing the more general constitutional debate on the scope of congressional power over federal jurisdiction and reading the Exceptions Clause as being, "in itself, limited only insofar as some limitations might be so large as no longer to constitute exceptions"); Henry M. Hart, Jr., *The Power of Congress to Limit the Jurisdiction of Federal Courts: An Exercise in Dialectic*, 66 HARV. L. REV. 1362, 1365, 1364 (1953) (arguing that Congress could not rely on the Exceptions Clause to "destroy the essential role of the Supreme Court in the constitutional plan" and considering, as one example, the elimination of Supreme Court appellate jurisdiction over all cases *except patent cases(!)*); Lawrence Gene Sager, *The Supreme Court, 1980 Term—Foreword: Constitutional Limitations on Congress' Authority to Regulate the Jurisdiction of the Federal Courts*, 95 HARV. L. REV. 17, 44 (1981) (arguing for a narrow interpretation of the Exceptions Clause because "[a]n 'exception' implies a minor deviation from a surviving norm; it

Given the constitutional implications that would arise with any attempt to place final appellate jurisdiction in another federal court, the Supreme Court itself seems unlikely to encourage such a shift in power from itself to a lower court. Yet if the Court were to maintain its ultimate authority over patent law by continuing to grant certiorari in Federal Circuit patent cases, the Court needed to develop metrics other than circuit splits for deciding which petitions for certiorari it should grant.

Developing such new metrics did not occur immediately. Even when the Court was showing revived interest in patent law during its 1994–1999 Terms—with grants of certiorari in six cases in six Terms—the Court still seemed to be using its standard method for deciding whether to grant certiorari in patent cases. Two of those six certiorari grants could be explained on the basis of splits between the Federal Circuit and other circuit decisions that had been rendered prior to the creation of the Federal Circuit.⁷⁴ Another case involved what was essentially a circuit split between the Federal Circuit and the Third Circuit on the constitutionality of federal statutes that were designed to limit the Eleventh Amendment immunity of States in intellectual property cases.⁷⁵ The fourth case involved a petition for certiorari filed by the Solicitor General on behalf of the PTO,⁷⁶ and petitions

is a nibble, not a bite”); Herbert Wechsler, *The Courts and the Constitution*, 65 COLUM. L. REV. 1001, 1005 (1965) (concluding that there is “no basis” for a narrow interpretation of the Exceptions Clause). Apart from the Exceptions Clause, vesting all federal appellate jurisdiction in a “Supreme Patent Court” would also raise a question whether the scheme would violate the Vesting Clause of Article III, which requires federal judicial power to be located in “one supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish.” U.S. CONST. art. III, § 1, cl. 1 (emphasis added).

⁷⁴ As to *American Airlines, Inc. v. Lockwood*, 515 U.S. 1121 (1995) (No. 94-1660) (order granting certiorari), Judge Nies’s dissenting opinion from the Federal Circuit ruling expressly argued that the majority opinion “creates the type of conflict with other circuits that warrants Supreme Court review.” *In re Lockwood*, 50 F.3d 966, 987 (Fed. Cir. 1995) (Nies, J., dissenting). Not surprisingly, one of American Airlines’ main arguments in seeking certiorari was that the Federal Circuit’s decision had “create[d] a conflict among the circuits.” Petition for a Writ of Certiorari at 16–20, *American Airlines, Inc.*, 515 U.S. 1182 (No. 94-1660) (arguing that, prior to the creation of the Federal Circuit, every circuit court to address the relevant issue had rejected the argument adopted by the Federal Circuit). As to *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 60 (1998), the Supreme Court justified its grant of certiorari by referring to a conflict between the Federal Circuit and the decisions of other circuits rendered prior to the creation of the Federal Circuit.

⁷⁵ Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 630–31 n.1 (1999); see also Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 148 F.3d 1343, 1351 (Fed. Cir. 1998) (explaining the divergence between the circuits).

⁷⁶ Petition for Writ of Certiorari at 1, *Dickinson v. Zurko*, 527 U.S. 150 (1998) (No. 98-377).

filed by the Solicitor General typically enjoy a high likelihood of being granted by the Court.⁷⁷

One apparent innovation in the Court's certiorari practice during the 1994–1999 Terms could be seen in two cases arising out of fractured en banc rulings by the Federal Circuit.⁷⁸ Those cases suggest one possible approach by which the Supreme Court could decide certiorari petitions from Federal Circuit patent decisions. If the Federal Circuit thought a case important enough to decide en banc and the Federal Circuit judges themselves split on the outcome of the case, then the case becomes a good candidate for Supreme Court review. That approach to deciding certiorari in patent cases has the advantage of being a close approximation to the approach taken by the Supreme Court in other areas, for it makes certiorari decisions turn on the importance of the case and the degree of splits among judges. Of course, those splits are not true splits in binding legal authority. The Federal Circuit's nationwide jurisdiction precludes different appellate courts reaching differing results in different parts of the country (which is the consequence of true circuit splits in other areas of federal law). But the approach is broadly similar to the Court's general approach in deciding certiorari because the Court looks inside the federal judiciary for signals that a grant of certiorari is needed. Looking for splits within the Federal Circuit does, however, have one obvious drawback: the Supreme Court must rely on the Federal Circuit *itself* to identify the patent cases that the Supreme Court should review.

If the Supreme Court wanted some metric by which it could gauge whether the Federal Circuit as a whole had erred, it needed to find some novel way to evaluate certiorari petitions in patent cases. The CVSG mechanism appears to have filled that need. Since the 2000 Term, the Court has referred to the Solicitor General many more certiorari petitions in patent cases than would be expected based on either (i) historical practice, or (ii) the percentage of patent cases on the Court's merits docket. The Supreme Court seems to have hit

⁷⁷ See Lazarus, *supra* note 6, at 1493 (“The Court grants the Solicitor General’s petitions for writ of certiorari at a rate of several orders of magnitude higher than anyone else’s—about 70% of the time compared to less than 3–4% for others.”).

⁷⁸ These two cases were *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1995), and *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). In *Markman*, the Federal Circuit split 8–1, with Judge Newman dissenting from the majority. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 999 (Fed. Cir. 1995) (Newman, J., dissenting). In *Warner-Jenkinson*, three separate dissenting opinions were filed, encompassing the views of five different circuit judges. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1536 (Fed. Cir. 1995) (Plager, J., dissenting); *id.* at 1545 (Lourie, J., dissenting); *id.* at 1550 (Nies, J., dissenting).

upon the idea of relying more on the Solicitor General to select the patent cases that should be heard from the Federal Circuit. In one way, the Court's reliance on CVSGs to decide certiorari in patent cases is not radically dissimilar to its standard approach to deciding certiorari in federal statutory cases: in both, the Court is looking for splits in *authority*. For most federal cases, the Court relies on splits in judicial authority, but for the patent system, the Court also looks for splits between the executive and judicial branches of the government.

Yet in another way, the Supreme Court's shift toward reliance on CVSGs could be seen as a very significant change, as compared to its practice in other areas of federal law. By placing greater reliance on the Solicitor General's recommendations rather than on judicial splits in deciding certiorari petitions, the Supreme Court has afforded the executive branch a subtle but significant increase in power over patent cases. Although the Solicitor General often opines on certiorari petitions in other areas of federal law, the Court usually requests the Solicitor General's assistance with a certiorari petition only in "close" cases, where the right decision on the petition is not clear.⁷⁹ CVSGs are unlikely where the lower courts are in complete agreement; those petitions will be denied. And CVSGs are also unlikely where the lower courts have been deeply and persistently split; those cases will be granted. In patent cases, by contrast, the Supreme Court appears to be calling for the Solicitor General's views more frequently precisely because it lacks such judicial signals concerning certiorari.⁸⁰

The Solicitor General's discretion to recommend either granting or denying certiorari may also be greater in a patent case. If the executive branch agrees with the Federal Circuit's ruling, the Solicitor General can emphasize the correctness of the decision and the absence of any actual conflicts in appellate authority. If the executive branch disagrees with the Federal Circuit's ruling, the Solicitor General can attack the reasoning of the decision below and argue that the impossibility of any true circuit conflict militates in favor of reviewing

⁷⁹ See Thompson & Wachtell, *supra* note 37, at 279 ("Given the Solicitor General's unmatched experience with the Court and its standards for certiorari, and the quality of legal reasoning produced by the office, it is understandable that the Court would seek his opinion on close questions of certiorari.").

⁸⁰ Thompson and Wachtell's study indicated that intellectual property matters formed the most common subject area of Supreme Court cases where CVSGs were issued, *id.* at 281, but their conclusion was based on the time period covered by their data, Supreme Court Terms 1992–2004. During that period, the Court issued CVSGs in eleven patent cases and four copyright cases. Prior to that period, the Court had never issued a CVSG in a patent case and had issued only four CVSGs in copyright cases.

the decision sooner rather than waiting for further percolation of the issue. Finally, more CVSGs in patent cases also give the Solicitor General more opportunities to select cases having good factual bases for supporting the results favored by the executive branch.

Since 2000, the Solicitor General has enjoyed not only an expanded ability to help in selecting patent cases for Supreme Court review but also an incredible winning streak in getting the Supreme Court to adopt its legal positions in patent cases. In the past ten years, the Solicitor General is batting as close to a thousand as could be. In only one case—*eBay, Inc. v. MercExchange, L.L.C.*⁸¹—did the party supported by the Solicitor General lose.⁸² Yet even in that case, the Court adopted the legal analysis applied by the Solicitor General;⁸³ the Court reversed and remanded the case only because the Court did not believe the Federal Circuit had actually applied the legal test articulated by the Solicitor General.⁸⁴ In all the other cases, the Court

⁸¹ *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

⁸² In the *eBay* decision, the Court sided with the petitioner when it vacated the Federal Circuit's judgment and held that the lower court's application of the test for injunctive relief was incorrect. *Id.* at 394. The Solicitor General's Office had filed a brief in support of the respondent in this matter. See Brief for United States as Amicus Curiae Supporting Respondents, *eBay, Inc.*, 547 U.S. 388 (No. 05-130).

⁸³ The legal analysis in the Court's opinion begins:

According to well-established principles of equity, a plaintiff seeking a permanent injunction must satisfy a four-factor test before a court may grant such relief. A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction. See, e.g., *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311–13 (1982).

eBay, 547 U.S. at 391.

Similarly, the Solicitor General's brief set forth the same four factors and relied on the same Supreme Court precedent: "[T]he four factors that traditionally govern equitable relief [are]: (1) the likelihood of irreparable injury; (2) the inadequacy of legal remedies; (3) the balance of hardship between the parties; and (4) and the public interest" Brief for United States as Amicus Curiae Supporting Respondents, *supra* note 82, at 5 (citing *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 312–13 (1982)). The Solicitor General's brief then endorsed that four-factor test: "The Patent Act's provision that injunctions shall issue 'in accordance with the principles of equity,' 35 U.S.C. [§] 283, directs the district courts to issue injunctions in accordance with the familiar four-factor test set out in *Weinberger v. Romero-Barcelo*, 456 U.S. 305 (1982)." Brief for United States as Amicus Curiae Supporting Respondents, *supra* note 82, at 9.

⁸⁴ A comparison of the Solicitor General's brief and the Supreme Court's opinion shows the small difference between the two. After endorsing the "traditional four-factor test" for granting an injunction, the Solicitor General acknowledged that the Federal Circuit's opinion is flawed because it did not "explicitly recite[]" that test:

The Federal Circuit, in this case as well as others, has not explicitly recited the traditional four-factor test when reviewing a district court's grant or denial of per-

Figure 8. Supreme Court Patent Cases Since the Creation of the Federal Circuit

Case Name	Term	SG Participates on Merits	SG - CAFC Split	Position Adopted	CVSG
Dennison Mfg. Co. v. Panduit	1985	No (per curiam opinion; no merits argument)			No
Christianson v. Colt Indus. Operating Corp.	1987	No			No
Bonito Boats Inc. v. Thunder Craft Boats, Inc.	1988	No			No
Eli Lilly & Co. v. Medtronic Inc.	1989	No.			No
Cardinal Chem. Co. v. Morton Int'l. Inc.	1992	No.			No
American Airlines, Inc. v. Lockwood	1994	N/A (dismissed as moot prior to argument)			No
Markman v. Westview Instruments, Inc.	1995	No.			No
Warner-Jenkinson Co. v. Hilton Davis Chem. Co.	1996	Yes	Y	SG	No
Pfaff v. Wells Elecs., Inc.	1998	Yes	N	Closer to SG	No
Dickinson v. Zurko	1998	Party	Y	SG	N/A (Pet'r)
Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank	1998	Yes (defending constitutionality of congressional statute)	N	Neither	No
J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.	2001	Yes	N	S. Ct. agrees w/ both	Yes
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.	2001	Yes	Y	SG	No
Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.	2001	No			No
Merck KGaA v. Integra Lifesciences I, Inc.	2004	Yes	Y	SG	Yes
Ill. Tool Works Inc. v. Indep. Ink, Inc.	2005	Yes	Y	SG	No
eBay Inc. v. MercExchange, L.L.C.	2005	Yes	N	Closer to SG	No
Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.	2005	Yes	N/A	Cert. dismissed	Yes
MedImmune, Inc. v. Genentech, Inc.	2006	Yes	Y	SG	No
KSR Int'l Co. v. Teleflex Inc.	2006	Yes	Y	SG	Yes
Microsoft Corp. v. AT & T Corp.	2006	Yes	Y	SG	Yes
Quanta Computer, Inc. v. LG Elects., Inc.	2007	Yes	Y	SG	Yes
Bilski v. Kappos	2009	Party	N/A	Pending	N/A (Resp.)

reached the result sought by the government. As with cases prior to 2000, the Court often used analysis and language that was highly similar to that proposed by the Solicitor General.

The success of the Solicitor General's Office in patent cases can only be fully appreciated by comparison to the Federal Circuit's record in the same cases. As shown in Figure 8, the Solicitor General's Office has participated as a party or an amicus in thirteen patent cases decided by the Supreme Court since 1996.⁸⁵ In nine of those cases, the Solicitor General has supported a different result than that reached by the Federal Circuit, and *in every case* the Supreme Court has agreed with the Solicitor General's position over the Federal Circuit's.⁸⁶ Furthermore, in two additional cases where the Solicitor General agreed with the Federal Circuit's result but not its reasoning (*Pfaff* and *eBay*), the Supreme Court's reasoning is much closer to that proposed by the Solicitor General's Office.⁸⁷ Thus, in cases in which the Solicitor General and the Federal Circuit differ, the Solicitor General is on a 9–0, and perhaps even an 11–0, winning streak.⁸⁸ In the history of its exis-

manent injunctive relief. . . . Nevertheless, the court of appeals' analysis would proceed in a more disciplined fashion if the court expressly applied the abuse-of-discretion standard with explicit reference to the traditional four-factor test, which provides the requisite framework for evaluating the distinct considerations that apply to patent claims.

Brief for United States as Amicus Curiae Supporting Respondents, *supra* note 82, at 15 (footnotes omitted). The Supreme Court merely decided that the Federal Circuit had failed not only to recite but also to apply the correct test:

In reversing the District Court, the Court of Appeals departed in the opposite direction [as compared to the District Court] from the four-factor test. The court articulated a "general rule," unique to patent disputes, "that a permanent injunction will issue once infringement and validity have been adjudged." . . .

Because we conclude that neither [the Federal Circuit nor the district court] correctly applied the traditional four-factor framework that governs the award of injunctive relief, we vacate the judgment of the Court of Appeals

eBay, 547 U.S. at 393–94 (citation omitted).

⁸⁵ Figure 8. The count of thirteen cases here includes only cases in which the Court has rendered a decision. This measure excluded *Laboratory Corp. of America Holdings v. Metabolite* because the Court never rendered a decision on the merits but instead dismissed the certiorari petition there as improvidently granted. 548 U.S. 124 (2006) (No. 04-607). The *Bilski* case is also excluded here because it was not decided prior to the publication of this article. See *Bilski v. Doll*, 129 S. Ct. 2735 (June 1, 2009) (No. 08-964) (order granting certiorari).

⁸⁶ Figure 8.

⁸⁷ *Id.*

⁸⁸ By contrast, the Solicitor General's overall success rate as an amicus curiae during the Supreme Court Terms from 1980 to 1999 was approximately 72%. See EPSTEIN ET AL., *supra* note 65, 675 tbl.7-16 (showing success rates of 72.8%, 78.2%, and 68.2%, respectively, over 239 cases during the Reagan Administration, 110 cases during the Bush Administration and 148 cases during the Clinton Administration). Similarly, the Solicitor General's success rate as an advocate for a federal agency during the period between the Court's 1948 and 2001 Terms is

tence, the Federal Circuit has still never seen the Supreme Court agree with its position where the Solicitor General has opposed that position.

Impressive as the Solicitor General's record is, sterile statistics do not do full justice to the depth of influence that the Solicitor General appears to wield in Supreme Court patent cases. Not only is the Court agreeing with the Solicitor General's preferred result, the Court is also embracing legal tests and holdings that bear remarkable resemblance to the tests articulated by the Solicitor General. For example, in *Quanta Computer, Inc. v. LG Electronics, Inc.*,⁸⁹ after agreeing with the Solicitor General's position that Federal Circuit doctrine on patent exhaustion was inconsistent with Supreme Court precedent, the Court addressed the standard for determining whether the sale of particular licensed products exhausts the licensor's patent rights. The Solicitor General articulated a two-part test that the product should trigger exhaustion if the product "[1] constitutes a material part of the invention, and [2] has no substantial noninfringing use."⁹⁰ The Supreme Court articulated a highly similar two-part test, albeit with the parts reordered: The sale of licensed products triggers patent exhaustion if the products "[1] had no reasonable noninfringing use and [2] included all the inventive aspects of the patented methods."⁹¹

The pattern in *Quanta Computer* is readily seen in other cases.⁹² In fact, the Court often gives the Solicitor General explicit credit. Thus, in the concluding paragraphs of its opinion in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,⁹³ the Court summarized its holding and immediately acknowledged that "[t]his is the approach advocated by the United States, see Brief for United States as *Amicus Curiae* 22–28, and we regard it to be sound."⁹⁴ Similarly, in *Merck*

69.4%. *Id.* at 678 tbl.7-18. If we assume the higher of these two success rates (72%), the odds of the Solicitor General compiling a perfect winning record is only 5.2% for 9 consecutive victories, and is only 2.7% for 11 victories.

⁸⁹ *Quanta Computer, Inc. v. LG Elecs., Inc.*, 128 S. Ct. 2109 (2008).

⁹⁰ Brief for the United States as *Amicus Curiae* Supporting Petitioners at 31, *Quanta Computer*, 128 S. Ct. 2109 (2006) (No. 06-937).

⁹¹ *Quanta Computer*, 128 S. Ct. at 2122.

⁹² As previously mentioned, the Supreme Court in the *eBay* case also adopted the four-factor test endorsed by the Solicitor General. *See supra* note 84.

⁹³ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

⁹⁴ *Festo*, 535 U.S. at 740. The *Festo* Court held that amendments to patent claims give rise to a presumption of prosecution history estoppel barring the patentee from reliance on the doctrine of equivalents but that the presumption could be overcome by the patentee in certain circumstances. The Court then listed three potential circumstances in which the patentee could overcome the presumption, and two of those three were "cribbed from the Solicitor General's Brief." Duffy, *supra* note 8, at 328–29.

KGaA v. Integra Lifesciences I, Ltd.,⁹⁵ the Court concluded its legal analysis by giving appropriate recognition to the source for its holding:

We thus agree with the Government that the use of patented compounds in preclinical studies is protected under § 271(e)(1) as long as there is a reasonable basis for believing that the experiments will produce “the types of information that are relevant to an IND or NDA.” Brief of United States as *Amicus Curiae* 23.⁹⁶

So great has the Solicitor General’s influence been in recent cases that the Court has not only agreed with the outcome urged by the government but also expressly endorsed the specific argumentation advanced in the Solicitor General’s brief. A good example is *Microsoft Corp. v. AT&T Corp.*,⁹⁷ where the majority opinion references arguments advanced by the Solicitor General four times, and each time the Court agrees entirely with the government’s position.⁹⁸ Indeed, even when it was not citing to the Solicitor General’s brief, the Court seemed to be very heavily influenced by the arguments in the brief. In the penultimate paragraph of its opinion, the *Microsoft* Court (1) noted that “Congress is doubtless aware of the ease with which software (and other electronic media) can be copied, and has not left the matter untouched”; (2) cited to the Digital Millennium Copyright Act as an example where Congress has legislated to address problems caused by the ease of copying; and (3) concluded that any change in patent law to account for such problems “should be made after focused legislative consideration, and not by the Judiciary forecasting Congress’ likely disposition.”⁹⁹ That paragraph follows quite

⁹⁵ Merck KGaA v. Integra Lifesciences I, Ltd., 545 U.S. 193 (2005).

⁹⁶ *Id.* at 208.

⁹⁷ Microsoft Corp. v. AT&T Corp., 550 U.S. 437 (2007). The issue in the case was whether, for purposes of 35 U.S.C. § 271(f), copies of Microsoft’s software could be considered “components” supplied from the United States where the specific copies of the software were produced overseas but the master copy of the software was created in this country. *See id.* at 441.

⁹⁸ *Id.* at 448 (setting forth the position of the United States that “only a copy of software, not software in the abstract, can be a component” for purposes of § 271(f)); *id.* at 451–52 (concluding, in agreement with the government’s position, that “a copy of Windows, not Windows in the abstract, qualifies as a ‘component’ under § 271(f)"); *id.* at 454 (quoting and expressly endorsing the Solicitor General’s argument that the ease of producing copies overseas does not alter the legal analysis of which components should be viewed as being supplied from the United States); *id.* at 455 (quoting and expressly endorsing the Solicitor General’s arguments that the presumption against extraterritoriality supports a narrow reading of § 271(f)); *id.* at 456 (quoting and expressly endorsing the Solicitor General’s arguments to reject a broader reading of § 271(f)).

⁹⁹ *Id.* at 458–59.

closely a paragraph in the Solicitor General's brief which (1) noted that "Congress is fully aware of the ease with which software can be copied, and at times it has adopted special rules to modify intellectual property rights for computer software and other new technologies"; (2) cited to the Digital Millennium Copyright Act; and (3) concluded that the Federal Circuit had "erred by arrogating the authority to expand the statute's coverage beyond the limits of its text in order to ensure that Section 271(f) will 'remain effective' for new technologies."¹⁰⁰

In sum, the creation of the Federal Circuit may have had the unintended consequence of shifting power from the judiciary to the executive branch of government. The centralization of intermediate appellate jurisdiction in patent cases has made it extremely difficult for the Supreme Court to exercise its certiorari jurisdiction in patent cases using the traditional approach of waiting for splits in judicial authority to arise. In response, the Court has increased its reliance on the executive branch for assistance in selecting patent cases in which Supreme Court review should be granted. Increased reliance by the Court translates into increased power for the executive branch.

But the shift in power may be even greater. The Solicitor General both helps in selecting cases and also performs a function that is generally performed by the lower courts in other areas of federal law: outside the patent area, the Supreme Court typically hears cases in which the lower courts have already created a diversity of authoritative opinions on the relevant legal issue. The Court then can choose between the competing authoritative opinions, each of which has been thoroughly considered and applied by sophisticated appellate courts. In the patent area, the Court lacks that sort of diversity of authoritative opinions, so it appears to be looking to the executive branch to provide it with competing positions to weigh against the doctrines constructed by the Federal Circuit. By playing that role, the Solicitor General also realizes a certain increase in power to shape the development of patent law.

Shifting power to the executive branch does not appear to be something Congress considered when the Federal Circuit was created in 1982. Instead, Congress was interested in concentrating intermediate appellate jurisdiction in a single court. But as Congress centralized judicial power in the Federal Circuit, the Supreme Court's need

¹⁰⁰ Brief for the United States as Amicus Curiae Supporting Petitioner at 37-38, *Microsoft Corp.*, 550 U.S. 437 (2007) (No. 05-1056).

to maintain its jurisdiction and power over the field has caused some of what was previously judicial power and influence to leak away into the executive branch. That shift is an especially significant development in patent law because the entire field has traditionally had a common law feel to it, as throughout history the courts themselves have fashioned patent law with only a modicum of guidance from the statutory sources.¹⁰¹ A pressing issue now is whether that migration of power is a positive development for the patent system.

II. Executive Branch Influence Over Federal Property Rights

For most administrative schemes, an incremental shift in power from the judiciary to the executive branch would be greeted with little more than a yawn. Most administrative agencies already have enormous power in their respective fields of regulation, including broad rulemaking powers¹⁰² that, pursuant to *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*¹⁰³ and *National Cable & Telecommunications Ass'n v. Brand X Internet Services*,¹⁰⁴ the agencies may use even to overturn prior judicial interpretations of statutes, provided that the statute is ambiguous.¹⁰⁵ An incremental addition to such broad powers could hardly be seen as remarkable, and indeed, the

¹⁰¹ For example, the nonobviousness requirement of patent law was originally developed in judicial decisions and was not codified until the courts had issued a century of precedents on the subject. See John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 41–43 (2007) (tracing the development of the obviousness doctrine). Another good example is patent law's "inequitable conduct" doctrine, which the Federal Circuit has correctly recognized as "a judicially created doctrine." *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006). A third example is the law governing patentable subject matter, which the courts frequently treat as an area "of federal common law." John F. Duffy, *Rules and Standards on the Forefront of Patentability*, 51 WM. & MARY L. REV. 609, 621 (2009).

¹⁰² For instance, the Securities and Exchange Commission has significant authority to promulgate rules if in the interest of the public and protection of investors. See generally 15 U.S.C. § 78w (2006) (conferring on the Commission broad power to make "such rules and regulations as may be necessary or appropriate to implement" the statutory provisions that the Commission administers). Similarly, the Food and Drug Administration has wide "authority to promulgate regulations for the efficient enforcement" of federal statutes governing food and drug safety. See 21 U.S.C. § 371(a) (2006).

¹⁰³ *Chevron U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

¹⁰⁴ *Nat'l Cable & Telecomms. Ass'n v. Brand X Internet Servs.*, 545 U.S. 967 (2005).

¹⁰⁵ See *Brand X Internet Servs.*, 545 U.S. at 982–83; see also CHARLES H. KOCH, JR., WILLIAM S. JORDAN III & RICHARD W. MURPHY, *ADMINISTRATIVE LAW: CASES AND MATERIALS* 696–701 (5th ed. 2006) (discussing whether *Chevron* abrogates the traditional ability of the judicial branch under *Marbury v. Madison*, 5 U.S. (1 Cranch) 137 (1803), to interpret and review the laws); Cass R. Sunstein, *Law and Administration After Chevron*, 90 COLUM. L. REV. 2071, 2074–75 (1990) (remarking that the *Chevron* decision could be seen as "a kind of . . . counter-*Marbury* for the administrative state"); John F. Duffy, *Administrative Common Law in Judicial Review*, 77 TEX. L. REV. 113, 201–02 (1998) (arguing that the basis for the broad authority agen-

level of deference afforded by the courts to the agency might be so great that subtle shifts in deference to the Solicitor General's litigating positions may not even be detectable.

The patent system, however, is different. The PTO has no substantive rulemaking powers,¹⁰⁶ and the courts in general, and the Supreme Court in particular, have never afforded the agency *Chevron* deference on its views about the reach of substantive patent law.¹⁰⁷ Indeed, the Supreme Court has never explicitly afforded the agency *any form* of deference—including the more modest form of deference articulated in *Skidmore v. Swift & Co.*¹⁰⁸—on substantive patent law issues.¹⁰⁹ Thus, the incremental shift in power from the courts to the executive branch is much more significant than it would be in most other administrative fields.

The desirability of the shift in power toward the executive branch must be considered in comparison to other alternatives. One alternative to consider is the situation as it existed prior to 1982. Patent issues were then decided by thirteen different intermediate appellate

cies possess under *Chevron* is not a “counter-*Marbury*” principle but instead “just a corollary of the delegated lawmaking theory”).

¹⁰⁶ See, e.g., *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996) (“As we have previously held, the broadest of the PTO’s rulemaking powers—35 U.S.C. § 6(a)—authorizes the Commissioner to promulgate regulations directed only to ‘the conduct of proceedings in the [PTO]’; it does *not* grant the Commissioner the authority to issue substantive rules.” (emphasis added) (citations omitted)); *Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 930 (Fed. Cir. 1991) (“A substantive declaration with regard to the Commissioner’s interpretation of the patent statutes, whether it be section 101, 102, 103, 112 or other section, does not fall within the usual interpretation of [the PTO’s limited rule making authority].”).

¹⁰⁷ See *Kessler*, 80 F.3d at 1550 (holding that, because it lacks a substantive rulemaking power, the PTO is not entitled to *Chevron* deference for its interpretations of substantive patent statutes). The Federal Circuit recently addressed a corollary to this issue in *Tafas v. Doll*, and held that *Chevron* deference could be applied to the extent that the PTO’s proposed rules were procedural in nature—a position that is consistent with the agency’s limited rulemaking authority. *Tafas v. Doll*, 559 F.3d 1345, 1353–54 (Fed. Cir. 2009). The Federal Circuit later granted en banc review in that case and vacated the panel decision. See *Tafas v. Doll*, 328 F. App’x 658 (Fed. Cir. 2009) (en banc). Although that case would have provided an opportunity for the full Federal Circuit (and perhaps later, the Supreme Court) to examine the extent of the PTO’s rulemaking power, the agency ultimately ended the litigation by rescinding its rules. See Press Release, U.S. Patent & Trademark Office, USPTO Rescinds Controversial Patent Regulations Package Proposed by Previous Administration (Oct. 8, 2009), available at http://uspto.gov/news/09_21.jsp. Thereafter the Federal Circuit vacated its order granting en banc rehearing and dismissed the appeal. See *Tafas v. Kappos*, 586 F.3d 1369, 1371 (Fed. Cir. 2009).

¹⁰⁸ *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

¹⁰⁹ Even in the cases catalogued in Figure 8, *supra*, where the Supreme Court agreed with the government’s position on patent law, the Supreme Court did not expressly afford the government the lesser form of deference described in *Skidmore*. A Lexis search of all Supreme Court cases (using the search “skidmore and patent”) yields no patent case in which the Court has ever cited the *Skidmore* case.

courts and by the Supreme Court. The Court did not need executive branch participation to select cases because it was still possible to have circuit splits, which help identify the cases in which the Court should grant certiorari, and which also present to the Court competing authoritative opinions.¹¹⁰ That alternative has its own serious drawback: although the intermediate appellate courts held more power in shaping patent law, those courts adjudicated patent cases so infrequently that the judges on the courts often lacked a certain baseline degree of experience in the field that is helpful in generating coherent and carefully reasoned patent doctrine.

Prior to 1982, a judge on a circuit court could probably go a whole career without ever hearing more than a case or two involving some core issues of patent law—e.g., issues such as enablement, utility, or the statutory bars to patenting.¹¹¹ Thus, although the system of thirteen circuits did provide signals to the Supreme Court as to which cases to grant certiorari and did provide competing opinions for the Supreme Court to consider, those signals and opinions may not have been especially helpful to the Court because the diverse judges lacked experience in the area.

By contrast, the Solicitor General's Office does not suffer from such a handicap. The Supreme Court's frequent CVSGs and grants of certiorari in patent cases are likely to give the Solicitor General's Office the opportunity to develop substantial experience with the patent system. Moreover, the Solicitor General's Office can also draw on the expertise found elsewhere in the executive branch; it may draw on the PTO's experience. Viewed in this light, the slight shift in power from the courts to the executive branch may very well be desirable because, as compared to the pre-1982 structure, the change provides more experienced and expert opinions to assist the Supreme Court in crafting patent law.

The shift in power to the Solicitor General's Office could also be compared to the alternative of granting a substantive rulemaking power to the PTO—a statutory change that Congress considered in

¹¹⁰ See *supra* notes 63–64 and accompanying text (discussing the importance of circuit splits in the Supreme Court's decisions to grant certiorari petitions).

¹¹¹ For example, a Westlaw search of patent cases in the Sixth Circuit between the years 1970 and 1980 yields only four decided cases that include any variant of "enable!" within 100 words of the statutory citation to section 112 of the Patent Act. (The search was: patent /100 enable! /100 "112" & co(sixth) & da(aft 1970 & bef 1980).) Since such a search should almost certainly identify any enablement cases, it seems reasonable to assume that the judges on that circuit heard only four cases on patent enablement in the entire decade.

2007 and that the Obama administration requested in 2009.¹¹² If the agency had such a rulemaking power, it could make binding rules about substantive patent law issues such as obviousness, utility, or patentable subject matter. That alternative would have the benefit of ensuring that the entity formulating the law in the area had expertise and experience in the field, and it raises the question whether a much greater shift in power to the executive branch would be more desirable than the shift of power that has already occurred through the influence of the Solicitor General's Office.

Vesting the PTO with a rulemaking power would, however, have one overarching and unavoidable problem: rulemaking powers give executive agencies the power to *change* the rules when political forces change.¹¹³ In most areas of federal regulation, that ability to change with political forces is a positive, not a negative.¹¹⁴ Indeed, the Supreme Court's watershed *Chevron* decision cites two reasons for granting deference to administrative positions established through a rulemaking: (1) administrative expertise; and (2) administrative responsiveness and accountability to political forces.¹¹⁵ Thus, although *Chevron* allows one administration to adopt one vision of a statute, the successor administration may adopt another interpretation of the statute, and a third administration is still free to return to the interpretation that the first administration had adopted years earlier.¹¹⁶ The

¹¹² See Patent Reform Act of 2007, H.R. 1908, 110th Cong. § 11 (2007) (as introduced) ("In addition to the authority conferred by other provisions of this title, the Director may promulgate such rules, regulations, and orders that the Director determines appropriate to carry out the provisions of this title or any other law applicable to the United States Patent and Trademark Office or that the Director determines necessary to govern the operation and organization of the Office."); Letter from Gary Locke, Sec'y of Commerce, to Patrick J. Leahy, Chairman, S. Judiciary Comm., at 2 (Oct. 5, 2009) (on file with author) (endorsing the "granting of USPTO substantive rulemaking authority").

¹¹³ See, e.g., *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 34–38 (1983) (tracing the changing treatment of a proposed safety regulation by Secretaries of Transportation in different presidential administrations).

¹¹⁴ See *Chevron U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 865–66 (1984) (holding that an agency's political responsiveness provides a reason for courts to grant the agency deference in interpreting ambiguous statutes); see also *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 188–89 (2000) (Breyer, J., dissenting) (arguing that a new administration's policy is a permissible reason for changing agency regulations); *Motor Vehicle Mfrs.*, 463 U.S. at 59 (Rehnquist, J., concurring in part and dissenting in part) (noting that a "change in administration . . . is a perfectly reasonable basis for an executive agency's reappraisal of the costs and benefits of its programs and regulations [and as] long as the agency remains within the bounds established by Congress, it is entitled to assess administrative records and evaluate priorities in light of the philosophy of the administration").

¹¹⁵ See *Chevron*, 467 U.S. at 865–66.

¹¹⁶ See, e.g., Kenneth W. Starr, *Judicial Review in the Post-Chevron Era*, 3 YALE J. ON REG.

ability of administrations to change is not an unintended consequence of *Chevron*.¹¹⁷ Rather, it is the heart and soul of *Chevron*, and it is clearly part of the power that would be conveyed to the PTO through an administrative rulemaking power.

That sort of change, however, may well be anathema to stable property rights, especially property rights designed to encourage research investments that are supposed to yield returns over the course of the approximately two-decade period during which patents grant exclusive rights.¹¹⁸ Consider, for example, the issue of patentable subject matter. If the administrative agency had the power to issue binding rules under the statute, then whole fields of endeavor could be unpatentable, patentable, and then unpatentable again, all within a dozen years as three different administrations come and go. Such a regime would seem to be too uncertain to foster the kinds of investments that patent property rights are intended to foster,¹¹⁹ and the shifts in regime could also lead to a great deal of litigation. Rapid changes in patent policy could thus create the worst of all possible worlds from the standpoint of public policy, with little encouragement of real innovation and much litigation.

283, 312 (1986) (“After *Chevron*, agencies may depart more easily from their predecessors’ interpretations. By orchestrating a number of changes in statutory interpretations by different agencies, an incoming administration will be better able to recast the regulatory system in its own image.”); Matthew C. Stephenson, *Legislative Allocation of Delegated Power: Uncertainty, Risk, and the Choice Between Agencies and Courts*, 119 HARV. L. REV. 1035, 1047 (2006) (noting that while “courts are obliged in most circumstances to adhere to precedents established in earlier cases . . . [t]his constraint . . . does not apply to administrative agencies, which can and do change their interpretations in response not only to new information but also to changes in the administration’s political and regulatory priorities”).

¹¹⁷ *Chevron*, 467 U.S. at 863–64 (“An initial agency interpretation is not instantly carved in stone. On the contrary, the agency . . . must consider varying interpretations and the wisdom of its policy on a continuing basis.”).

¹¹⁸ See, e.g., Abraham Bell & Gideon Parchomovsky, *A Theory of Property*, 90 CORNELL L. REV. 531, 552 (2005) (“The conclusion is that a property system with stable rights increases the value of assets to users (now owners) and decreases the costs of obtaining and defending those assets[.] . . . [G]enerally, the benefits provided by property systems increase with the stability of the property rights they create.”); Craig Allen Nard, *Certainty, Fence Building, and the Useful Arts*, 74 IND. L.J. 759, 785–95 (1999) (discussing the need for certainty in patent rights as an incentive for innovation and invention); Todd J. Zywicki, *The Rule of Law, Freedom, and Prosperity*, 10 SUP. CT. ECON. REV. 1, 22 (2002) (“The documented effect of increasing rule of law values on economic growth is robust. Individuals are more willing to invest in economic growth where property rights are stable.”).

¹¹⁹ See F. Scott Kieff, *Coordination, Property and Intellectual Property: An Unconventional Approach to Anticompetitive Effects and Downstream Access*, 56 EMORY L.J. 327, 386–87 (2006) (arguing that “if individuals perceive that property rights and contracts are not being enforced, they may have less faith in property rights and contracts being enforced in the future” and may therefore “shift investments towards other activities”).

In contrast to the alternative of giving the agency a rulemaking power, the subtle expansion of the executive branch's influence injects into the patent law a more modest and more *stable* amount of political influence. The Solicitor General gains some power to control the cases heard by the Court, and has the ability to articulate opinions that represent alternatives to the positions established in the Court of Appeals. The Solicitor General becomes the most prominent "competitor" to the Federal Circuit, but that competition still plays out in the marketplace of ideas at the Supreme Court. The ultimate course of the law remains controlled by judicial decisions, which are constrained by principles of *stare decisis* and are therefore presumed to be more stable than executive branch rules. That approach seems superior to giving the executive branch the much greater powers associated with substantive rulemaking powers, which invite doctrinal vacillation to be based on political shifts. The result is a compromise, allowing some, but not too much, political influence. Viewed in this light, the Solicitor General's expanded role may not be something to fear, at least if the degree of executive branch influence remains checked by other forces.

That last caveat suggests that the Supreme Court should remain wary of relying overmuch on the Solicitor General's Office not only in adjudicating the merits of cases but also in deciding whether to grant certiorari. In the past decade, the Court has been very liberal in issuing CVSGs in the patent area, and it may not even realize the extent to which the Solicitor General is coming to dominate the certiorari process in the patent area. In future cases, the Court (and, of course, the attorneys who practice before it) should experiment with other ways of selecting patent cases for review by the Court. Perhaps the Court could be more attentive to claims that the Federal Circuit has deviated from prior precedents. The Court could also place more weight on the presence of private amicus briefs as a way to determine importance without relying on the Solicitor General's views. Finally, for those certiorari petitions where the Court does call for the views of the Solicitor General, the Court might afford the Solicitor General's views about certiorari somewhat less deference than would be given in another area of law.

With respect to the patent cases that the Court does hear on the merits, the Court should worry that the position advocated by the current administration's Solicitor General could shift with new administrations. In evaluating the weight to be given to the Solicitor General's position, the Court should be especially attentive to the *du-*

rability of the position through different administrations and should, in crafting judicial doctrine, try to avoid relying excessively on positions adopted by a particular Solicitor General's Office. That approach might very well push the Court toward the approach advocated by John Golden, who has argued that, where the Supreme Court finds itself in disagreement with the Federal Circuit, the Court should rule narrowly, perhaps even limiting its holding to a rejection of the Federal Circuit doctrine without much more.¹²⁰ That approach seems wise not only because it allows the Federal Circuit, with its greater expertise in patent law, to develop the doctrine in the first instance.¹²¹ The approach also prevents the Supreme Court from crystallizing a doctrine that might seem appealing based on the current administration's representations, but might seem unattractive in future years when a different Solicitor General from a different administration endorses a different position.

Conclusion

In the last decade and a half, the Supreme Court has returned its attention to the field of patent law. Yet in this new era, the nationwide jurisdiction of the Federal Circuit has posed problems for the Court in exercising its jurisdiction. The Court lacks the strong signals generated by peer intermediate appellate courts—i.e., circuit splits—that the Court typically uses in deciding whether to grant certiorari. The Court also lacks the competing lower court opinions that in other areas of federal law serve as a tableau of options that the Court can consider in crafting its own doctrine. In response to those problems, the Supreme Court has migrated toward relying heavily on the Solicitor General's Office to serve as the de facto “competitor” to the Federal Circuit in patent cases. Thus, certiorari decisions in patent cases are decided increasingly not by “circuit splits” but by “branch splits”—a split between the judicial branch (in the form of the Federal Circuit) and the executive branch (in the form of the Solicitor General).

¹²⁰ See generally Golden, *supra* note 4, at 709–16.

¹²¹ See *id.* at 700–05; Duffy, *supra* note 8, at 342 (analyzing the relationship between the Federal Circuit and the Supreme Court and expressing the hope that “each institution will be mindful not only of its strengths, but of its weaknesses too,” and that “[f]or the Supreme Court, this means recognizing the limitations of its expertise and refraining from trying to lead the development of the law”); Janis, *supra* note 67, at 408–09 (arguing that the Supreme Court should adopt a “managerial model” in determining when to grant certiorari to hear patent cases from the Federal Circuit, intervening only when necessary to correct a persistent conflict).

Once it grants certiorari, the Court often finds itself faced with a choice between an approach fashioned by the judiciary and one developed within the executive branch. Since the creation of the Federal Circuit, the Court has confronted such a choice in nine cases, and in every case, the Court has sided with the executive branch. In two other cases where the Federal Circuit and the Solicitor General agreed on the result in the case but relied on different legal reasoning to reach the result, the Supreme Court also seemed to side with the Solicitor General. The Solicitor General's extraordinary winning streak in such cases provides one of the best barometers of the respective influence that the Federal Circuit and the Solicitor General have in Supreme Court patent cases.

The Court's greater reliance on the Solicitor General's views in patent cases appears to be a very recent innovation, dating back at most to just a few years before the turn of the century. In large measure, it is not an innovation that need be feared. The executive branch may provide an effective source of competing views that the Supreme Court can weigh against the positions developed by the Federal Circuit. The Court can also be assured that those views will be informed by an expertise similar to that possessed by the Federal Circuit. Yet if the innovation need not be feared, it perhaps should be moderated. The Supreme Court can look to signals by other actors—including district court decisions, separate opinions from the judges within the Federal Circuit, decisions rendered by appellate courts prior to the creation of the Federal Circuit, amicus briefs, and perhaps even articles by lowly academics—to provide both the indications of the importance and the competing positions that are helpful for a thorough and reasoned adjudication at the Court.

Finally, there is the matter of the Solicitor General's shadow over the Federal Circuit—the extraordinary winning streak that the Solicitor General's Office has enjoyed in modifying or overturning Federal Circuit decisions at the Supreme Court. In some respects, the Solicitor General's success at the Court is not surprising. The generalist Supreme Court is more often persuaded by the generalist advocate than by the specialist court. Still, the success of the Solicitor General calls into question a central part of the theoretical justification for an expert appellate court in the field of patents. If the most important contours of the field are to be shaped by a generalist advocate before a generalist Court, the need for the expert intermediate court might fairly be doubted.

Yet attributing the Solicitor General's success to generalist advocacy may be too superficial. The Supreme Court's apparent attraction to the patent positions of the Solicitor General's Office may also be attributed to the wellspring of executive branch expertise that the Office can tap, for the Solicitor General's briefs on patent law are also briefs of the PTO. The true success of the Solicitor General's Office lies in mediating between the expert administrative agency and the generalist Court. The Office's positions become attractive to the Court because the Office can take the insights of the expert agency and package them to be persuasive to generalists. That tactic, however, need not be and should not be the exclusive domain of the executive branch.

The Federal Circuit also has the opportunity to develop positions informed by expertise. For the Federal Circuit, the source of expertise is its own thoroughgoing experience with, and daily supervision of, the entirety of the country's patent appeals. But the court's doctrine must also be crafted to be persuasive to a generalist audience or it will not be enduring. For many years after its creation, the Federal Circuit did not have to worry about such a generalist audience, for it was not there. With the return of the Supreme Court to the bar of patents, the expert intermediate court has a new role that, despite all the differences between court and advocate, is highly similar to the role that the Solicitor General's Office has apparently mastered in its mediation between the expert and the generalist.

For the Federal Circuit, the role undoubtedly presents a challenge. The patent attorneys typically arguing before the Federal Circuit are specialists, and they present their cases with arguments that seem sensible within the specialty. In deciding those cases, however, the Federal Circuit must fashion opinions that are persuasive to the generalists who hold final authority to review all patent appeals. In an era when the Supreme Court has resumed its traditional practice of reviewing a significant number of federal patent cases, attention to the ultimate generalist audience—the Justices—is essential to the long-term success of any actor in the patent system. And for the Federal Circuit, it is the path out of the Solicitor General's shadow.