

Elite Patent Law

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I. INTRODUCTION

Patent law, the conventional wisdom goes, isn’t for everyone. It’s the legal domain of scientists. Engineers. Chemists. Molecular biologists. Your J.D. won’t even let you practice law at the Patent Office unless you also have a bachelor’s degree (or an “equivalent” amount of academic credit) in certain science or engineering fields.¹ Judge Learned Hand, in a famous opinion

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1. OFFICE OF ENROLLMENT & DISCIPLINE, U.S. PATENT & TRADEMARK OFFICE, GENERAL REQUIREMENTS BULLETIN FOR ADMISSION TO THE EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE 4–8 (2018), https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf; see also William

assessing the patentability of purified adrenaline, eloquently lamented “the extraordinary condition of the law which makes it possible for a man without any knowledge of even the rudiments of chemistry to pass upon such questions as these.”² Judge Samuel Kent—who was later impeached and imprisoned for lying to federal investigators about sexual harassment allegations³—put it somewhat less eloquently when he derided the judges of the patent-focused Federal Circuit as “people wearing propeller hats.”⁴

But perceptions of patent law as a specialized, esoteric area of practice—and of patent lawyers as pocket protector-sporting aficionados of geeky headwear—are increasingly wrong.⁵ Over the past two decades, the country’s most prominent attorneys have begun to gravitate toward patent cases. In the Supreme Court’s 2016 Term, for example, former Solicitor General Seth Waxman argued a remarkable four of the six patent cases heard by the Court. Other lawyers arguing patent cases that Term included four former Assistants to the Solicitor General (William Jay, Deanne Maynard, Carter Phillips, and Andrew Pincus) and the former dean of Stanford Law School (Kathleen Sullivan). Combined, those six lawyers have presented oral argument to the Justices over 200 times. Patent specialists, they are not.

That the Supreme Court would even *hear* six patent cases in a single Term is noteworthy, too. As Figure 1 below indicates, from 1982 (the year the Federal Circuit began operation) through 2000, the Supreme Court heard more than one patent case in a single Term only once (in 1998), and it often didn’t hear any.

Hubbard, *Razing the Patent Bar*, 59 ARIZ. L. REV. 383, 391–93, 400–19 (2017) (criticizing the Patent Office’s technical education requirement).

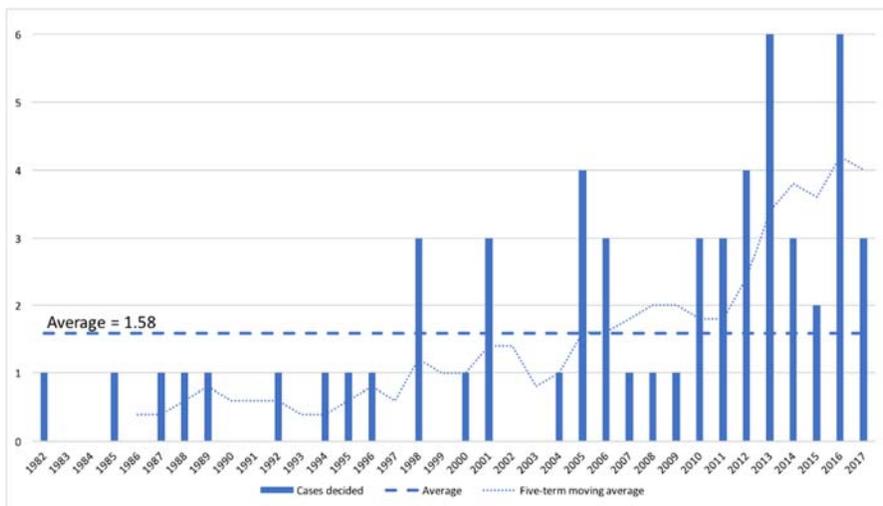
2. *Parke-Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 115 (C.C.S.D.N.Y. 1911), *aff’d in part, rev’d in part*, 196 F. 496 (2d Cir. 1912).

3. *House Impeaches Texas Judge Accused of Sex Crimes*, CNN, <http://edition.cnn.com/2009/POLITICS/06/19/U.S.impeachment.judge/index.html> (last updated June 19, 2009, 1:53 AM).

4. Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 396 (2000) (quoting *O.I. Corp. v. Tekmar Co.*, No. 95-CV-113 (S.D. Tex. June 17, 1996), *aff’d*, 115 F.3d 1576 (Fed. Cir. 1997)).

5. See Lee Petherbridge & David L. Schwartz, *The End of an Epithet? An Exploration of the Use of Legal Scholarship in Intellectual Property Decisions*, 50 HOUS. L. REV. 523, 552–53 (2012) (“Those who teach patent law are aware that to this day there exist the remnants of a culture that preferred attorneys with technical backgrounds to other attorneys. . . . Today that view seems archaic. . . .”).

Figure 1. Patent Cases Decided by the Supreme Court,
OT1982 through OT2017



In a recent article, I linked the Supreme Court's increased interest in patent law to the increased participation of elite Supreme Court lawyers in patent cases, particularly at the cert. stage, when the Court is weighing whether to grant review.⁶ (As explained in more detail in that article, I define an elite Supreme Court lawyer as someone who has presented oral argument at the Court in five or more cases in the current and ten preceding Terms, combined.⁷ All of the lawyers mentioned a couple paragraphs ago easily qualify as elite.) In patent cases, the proportion of cert. petitions filed by elite Supreme Court lawyers has increased more than fivefold since the early 2000s and has more than doubled since 2010. Over precisely the same time period (2002 through 2017), the rate at which the Supreme Court granted cert. in patent cases more than doubled. And those granted petitions are disproportionately filed by elite advocates. In a patent case, the Court is over three times more likely to grant one of their petitions as compared to a petition filed by a lawyer outside that group. There is thus reason to think that the Supreme Court's increased interest in patent law is due at least in part to the presence of a small group of high-profile lawyers—no more than 30 strong—increasingly appearing in patent cases.⁸

6. See Paul R. Gugliuzza, *The Supreme Court Bar at the Bar of Patents*, 95 NOTRE DAME L. REV. (forthcoming 2019) (manuscript at 4–5), <https://ssrn.com/abstract=3347935>.

7. See *id.* (manuscript at 6–7).

8. There are, of course, other factors that are also likely driving the Supreme Court to grant cert. more frequently in patent cases; I discuss them in more detail in the article. See *id.* (manuscript at 3–4).

This Essay builds on my prior work in two ways. First, it shows that elite Supreme Court litigators are not only handling more patent cases at the Court itself, they are also increasingly arguing patent cases at the Federal Circuit. As recently as 2009, fewer than 1 in 100 Federal Circuit oral arguments were delivered by an elite Supreme Court advocate. Today, that figure is about 1 in 20. In a similar vein, from 2008 through 2010, fewer than 10% of all elite Supreme Court advocates also presented oral argument at the Federal Circuit in a given year. Today, that figure has tripled, with about one-quarter of elite Supreme Court advocates also delivering at least one argument at the Federal Circuit annually.

Second, this Essay confronts the normative implications of having a small, relatively homogeneous group of lawyers play such a significant role in shaping patent law in the United States. The presence of elite advocates—who know well enough to deemphasize the technological aspects of patent cases when litigating before the Justices—could help explain why the Supreme Court has generally shied away from disputes involving the core requirements of patentability, such as nonobviousness, even though, as I explain in more detail below, doctrinal disruption in those areas would be particularly useful. Ultimately, however, elite advocates' involvement in patent cases may be beneficial: As non-specialists in patent law, they can help alleviate problems that have arisen due to the centralization of patent appeals in the semi-specialized Federal Circuit.

II. THE SUPREME COURT BAR IN PATENT LITIGATION

The past few decades have seen the emergence of a tiny cadre of lawyers specializing not in any substantive area of law but in litigation at the U.S. Supreme Court.⁹ This Part provides empirical evidence of the emergence of an elite Supreme Court bar and of its increasing involvement in patent litigation at both the Supreme Court and the Federal Circuit.

A. THE ELITE SUPREME COURT BAR

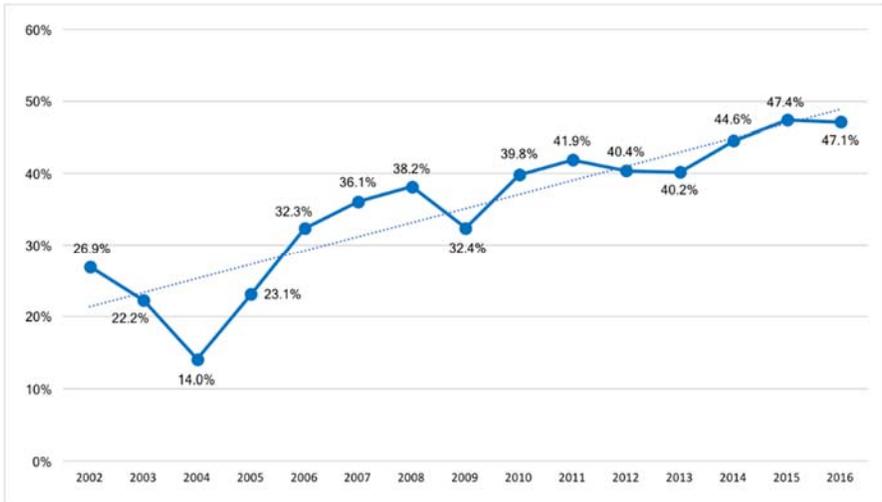
Figure 2 below illustrates how a small group of lawyers, working in the private sector, have come to dominate advocacy before the U.S. Supreme Court. (My other recent paper on the Supreme Court bar in patent cases describes in detail the data and methodology underlying the analysis presented in Sections II.A and II.B of this Article.)¹⁰ Figure 2 shows the percentage of all Supreme Court oral arguments that were delivered by elite advocates on a Term-by-Term basis, excluding arguments presented by

9. For detailed accounts of this development, see Richard J. Lazarus, *Advocacy Matters Before and Within the Supreme Court: Transforming the Court by Transforming the Bar*, 96 GEO. L.J. 1487, 1497–1502 (2008); Joan Biskupic et al., *The Echo Chamber*, REUTERS (Dec. 8, 2014, 10:30 AM), <https://www.reuters.com/investigates/special-report/scotus>.

10. Gugliuzza, *supra* note 6 (manuscript at 6–13).

attorneys employed by the government.¹¹ As that figure illustrates, as recently as 2005, less than a quarter of the private-sector lawyers presenting oral argument at the Supreme Court met my definition of elite. A decade later, that proportion had doubled. In both the 2015 and 2016 Terms, 47% of all private-sector lawyers presenting oral argument at the Supreme Court qualified as elite.¹²

Figure 2. Percentage of Non-Government Lawyers Presenting Oral Argument Who Qualified as Elite, OT2002 through OT2016



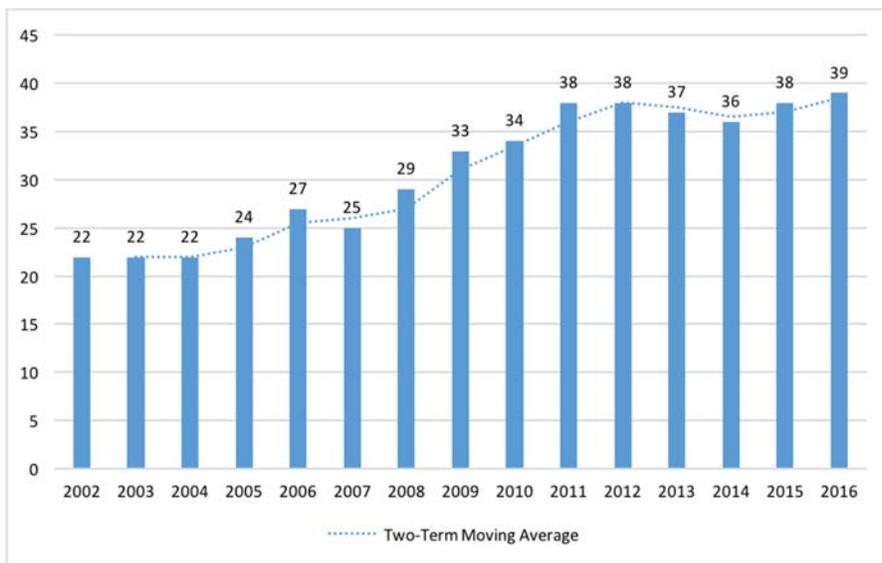
How many lawyers comprise that elite group? Not many. In the 2016 Term, a mere 39 private-sector lawyers met my definition of elite, as Figure 3 below illustrates.¹³

11. For example, lawyers in the Office of the Solicitor General, lawyers working in a state attorney general's office, city and county prosecutors, and state and federal public defenders.

12. A linear regression of the data underlying Figure 2 shows statistical significance ($p < .001$) and a positive slope ($B = .020$).

13. In order to accurately capture the emergence of an elite *private sector* Supreme Court bar, Figure 3 excludes arguments that a lawyer conducted while employed by the government in determining whether that lawyer qualified as elite. Throughout the remainder of the Essay, I include *all* oral arguments in determining whether a lawyer qualifies as elite, on the rationale that a Supreme Court argument in *any* capacity helps the lawyer develop expertise and the reputation among the Justices and their law clerks that could influence the Court's decision-making.

Figure 3. Number of Lawyers with Five or More Oral Arguments in the Current and Ten Preceding Terms, Excluding Cases Argued as a Government Employee, OT2002 through OT2016



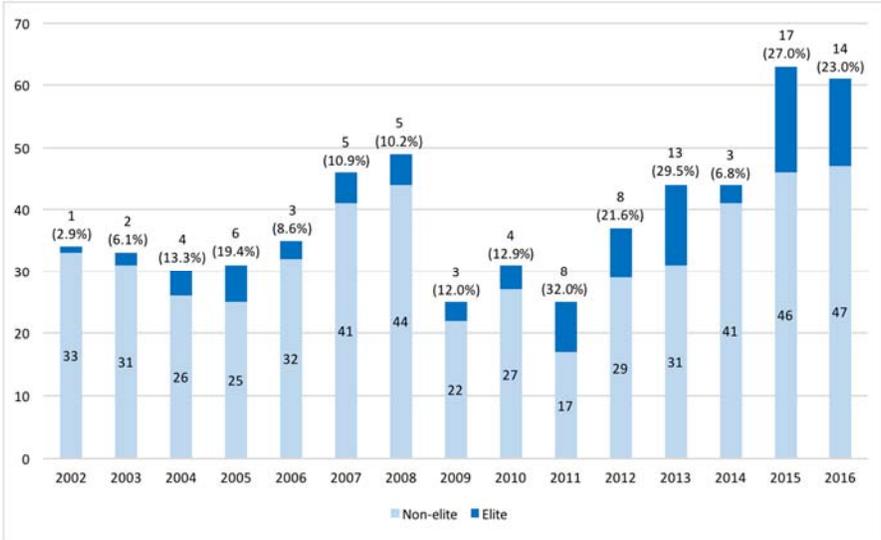
Putting things slightly differently: Of the roughly 230,000 American lawyers who are formally members of the Supreme Court bar, about 0.03% of them handled half of the Court's oral arguments in 2016.

B. ELITE LAWYERS IN SUPREME COURT PATENT CASES

Not only is a small group of lawyers increasingly dominating oral argument before the Supreme Court, those same lawyers are increasingly involved in patent litigation, both at the Court itself and in the Federal Circuit. The most interesting development at the Supreme Court has occurred at the cert. stage. As Figure 4 below illustrates, from 2002 through 2009, elite advocates filed barely 10% of cert. petitions in Federal Circuit patent cases (29 of 283). From 2010 through 2016, however, elite lawyers filed 22% of cert. petitions in Federal Circuit patent cases (67 of 305). That difference is statistically significant at the 1% level ($p < .001$).¹⁴

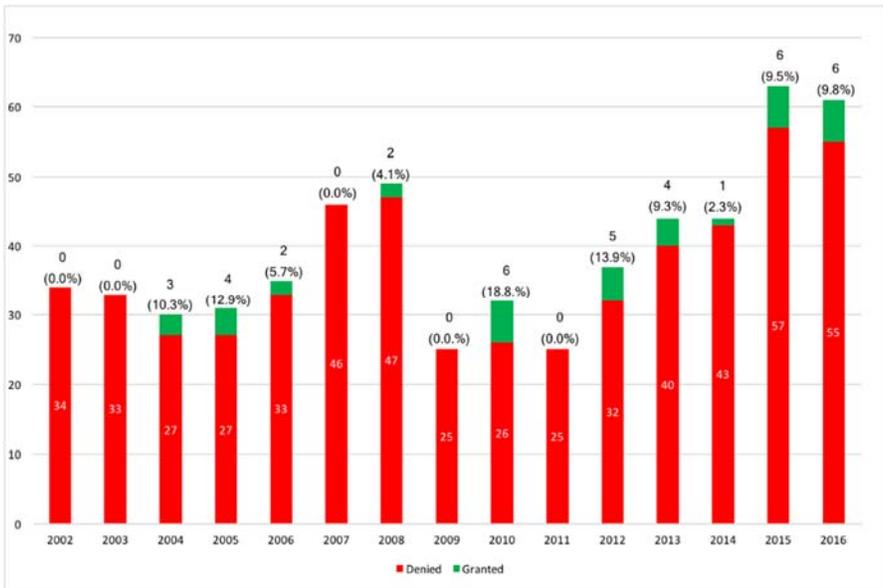
14. Because the data presented throughout this Essay includes the entire population of relevant cases during the time periods of interest, the results are arguably statistically significant by definition. Nevertheless, to provide a sense of the importance of observed differences, I report p -values at several points, based on the assumption that my data is a sample of a larger population. Unless otherwise indicated, to calculate p -values, I used Microsoft Excel to perform a two-tail t -test.

Figure 4. Paid Cert. Petitions in Federal Circuit Patent Cases Filed by Elite/Non-Elite Advocates, OT2002 through OT2016



The increase in the proportion of cert. petitions filed by elite advocates neatly corresponds to the Supreme Court's increased tendency to grant cert. in patent cases. As Figure 5 below demonstrates, from 2002 through 2009, the Supreme Court's grant rate in Federal Circuit patent cases was only 3.9% (11 of 283). From 2010 through 2016, however, the grant rate more than doubled to 9.2% (28 of 306), a difference that is again statistically significant at the 1% level ($p = .009$).

Figure 5. Paid Cert. Petitions Granted or Denied in Federal Circuit Patent Cases, OT2002 through OT2016



The correlation between the increasing involvement of elite lawyers in patent cases and the growth of the Supreme Court's patent docket does not, of course, prove causation. Yet aspects of my data suggest that elite advocates have played at least some role in influencing the Court to hear more patent cases. As Table 1 below shows, from 2002 through 2016, the Supreme Court granted 15.6% of cert. petitions filed by elite advocates in Federal Circuit patent cases as compared to only 4.7% of petitions filed by non-elites in Federal Circuit patent cases, another difference that is statistically significant at the 1% level ($p = .005$).¹⁵ Put slightly differently: The Supreme Court is 3.3 times more likely to grant cert. when a petition in a Federal Circuit patent case is filed by an elite advocate as compared to a non-elite.

15. The overall grant rate for Federal Circuit patent cases was 6.6%.

Table 1. Grant Rates on Cert. Petitions in Federal Circuit Patent Cases, OT2002 through OT2016

	Elite	Non-elite
Granted	15	23
Denied	81	469
% Granted	15.6%	4.7%

Another way of quantifying the remarkable success that elite lawyers appear to have had in shaping the Supreme Court's patent docket: From 2002 through 2016, petitions filed by elite lawyers accounted for 16.3% of the cert. petitions filed in Federal Circuit patent cases, as illustrated by Figure 6 below. Yet, as Figure 7 indicates, petitions filed by elite lawyers accounted for nearly 40% of the petitions *granted* by the Supreme Court in Federal Circuit patent cases (15 of 38). That difference is, again, statistically significant at the 1% level ($p = .007$).

Figure 6. Cert. Petitions *Filed* in Federal Circuit Patent Cases, OT2002 through OT2016

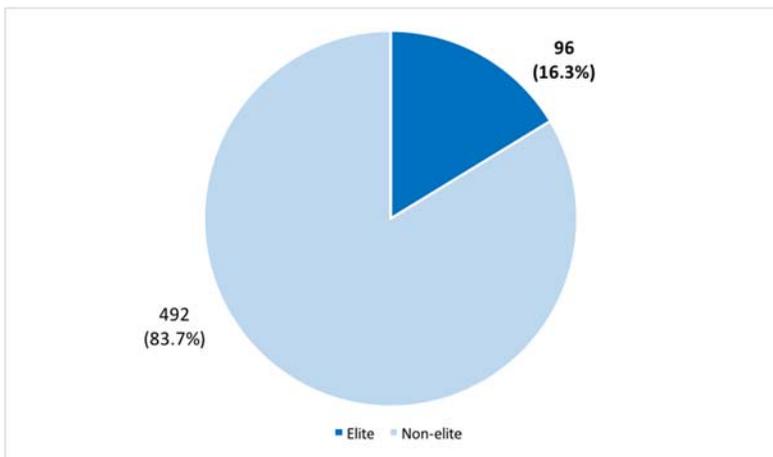
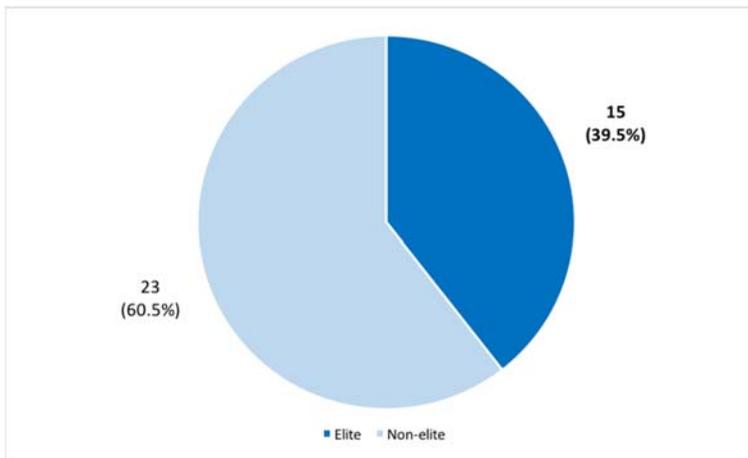


Figure 7. Cert. Petitions *Granted* in Federal Circuit Patent Cases, OT2002 through OT2016

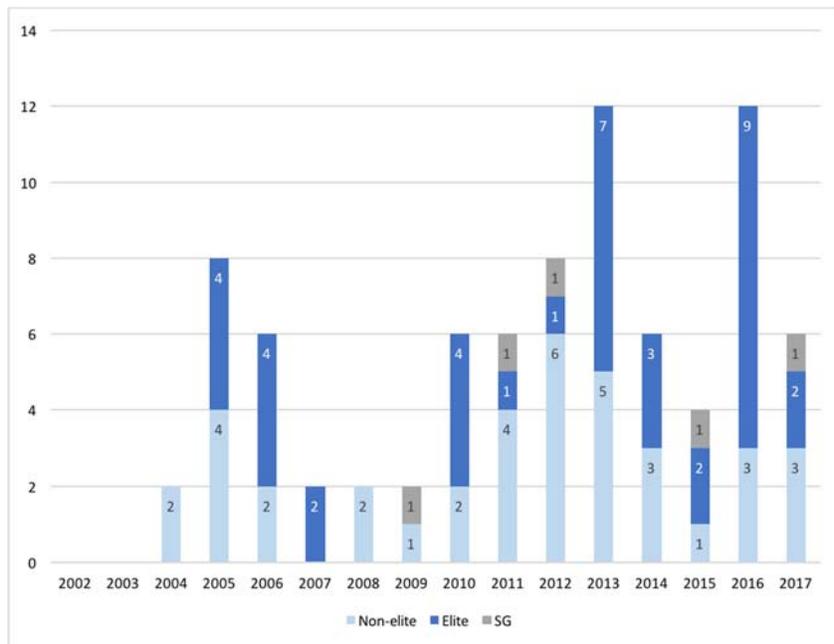


Though elite lawyers' participation in patent cases has grown significantly at the cert. stage, elite lawyers have historically handled a sizeable proportion of Supreme Court patent cases decided on the merits. Figure 8 below indicates the classification of each lawyer who presented oral argument on behalf of a party in a Supreme Court patent case from the 2002 Term through the 2017 Term. Out of a total of 82 non-amicus argument presentations in 41 cases,¹⁶ 39 presentations were made by elite lawyers (47.6%), 38 by lawyers who did not meet the definition of elite (46.3%), and five by lawyers from the Office of the Solicitor General (6.1%).

Though the numbers are relatively small, Figure 8 indicates that those proportions have held relatively steady over time. From 2002 through 2010, for instance, elite lawyers handled 50.0% of arguments (14 of 28) and non-elites handled 46.4% (13 of 28), with one argument handled by the Solicitor General's office (3.6%). From 2011 through 2017, the proportion of merits arguments conducted by elite lawyers actually decreased slightly. Over that period, elite lawyers handled 46.3% of arguments (25 of 54)—precisely the same proportion as handled by non-elites. The Solicitor General's office handled four arguments over that period (7.4%).

16. The Court often permits the Solicitor General to present oral argument in patent disputes that are otherwise entirely between private parties. *See, e.g., Sandoz Inc. v. Amgen Inc.*, 137 S. Ct. 1664, 1668 (2017). I disregard those amicus presentations for the purpose of Figure 8.

Figure 8. Supreme Court Oral Arguments in Patent Cases, OT2002 through OT2017



But even though it is status quo at the merits stage in patent cases, the change in elite representation at the cert. stage is significant. Elite lawyers' remarkable success in obtaining certiorari may help explain why the number of patent cases heard by the Supreme Court has increased so substantially over the past decade.

C. ELITE LAWYERS AT THE FEDERAL CIRCUIT

Not only are elite Supreme Court advocates increasingly seeking certiorari in patent cases, they are also increasingly litigating patent cases at the Federal Circuit. This Section of the Essay reports the results of a novel empirical study of the lawyers presenting oral argument in Federal Circuit patent cases.

1. Background and Methodology

Because this is the first Essay to describe results from that study, some background on data and methodology is in order. As a starting source, I used *The Compendium of Federal Circuit Decisions*,¹⁷ developed by Jason Rantanen, to

¹⁷. *The Compendium of Federal Circuit Decisions*, FED. CIR. DATA PROJECT, UNIV. OF IOWA, <https://empirical.law.uiowa.edu/compendium-federal-circuit-decisions> (last visited April 21, 2019) [hereinafter the *Compendium*].

create a list of all Federal Circuit decisions in that database from 2008 through 2017.¹⁸ Though the *Compendium* includes all decisions posted on the Federal Circuit's website going back to 2004, I began in 2008 because, prior to that year, the court did not post its orders affirming the lower tribunal's judgment without an opinion under Federal Circuit Rule 36.¹⁹ From the list of decisions I exported from the *Compendium*—which included all Federal Circuit decisions in appeals from the district courts and the U.S. Patent and Trademark Office ("PTO")—I eliminated trademark cases²⁰ and, to the best of my ability, the small number of appeals from district court cases that did not involve patent claims.²¹ I then added to that dataset all Federal Circuit decisions in appeals from patent cases at the U.S. International Trade Commission ("ITC") from 2008 to 2017.²²

With a list of all patent cases decided by the Federal Circuit in hand, I used the slip opinions on the Federal Circuit's website to determine the

18. For a description of the *Compendium* and its contents, see Jason Rantanen, *The Landscape of Modern Patent Appeals*, 67 AM. U. L. REV. 985, 997–1007 (2018).

19. For background on Rule 36 and the controversy surrounding its use, see Paul R. Gugliuzza & Mark A. Lemley, *Can a Court Change the Law By Saying Nothing?*, 71 VAND. L. REV. 765, 778–80, 804–05 (2018). Any empirical study of the Federal Circuit that does not include those opinionless affirmances raises a significant risk of reporting inaccurate results. See John R. Allison, Mark A. Lemley & David L. Schwartz, *Understanding the Realities of Modern Patent Litigation*, 92 TEX. L. REV. 1769, 1771 (2014) (noting that many empirical studies of patent litigation omit unreported decisions, such as Rule 36 affirmances).

20. These were easy to identify because the *Compendium* coded the tribunal below as the Trademark Trial and Appeal Board.

21. The main source of Federal Circuit jurisdiction over non-patent district court cases is the so-called Little Tucker Act, which grants the district courts and Court of Federal Claims concurrent jurisdiction over breach of contract claims against the federal government seeking \$10,000 or less in damages. See 28 U.S.C. §§ 1295(a)(2), 1346(a)(2) (2012). I located these cases by searching for instances in which a lawyer employed by the federal government—but not the PTO Solicitor's Office—argued the case before the Federal Circuit. I then reviewed the Federal Circuit's decision (or, in the case of a Rule 36 affirmance, the parties' briefs) to determine whether the case involved a patent-related issue. It bears emphasizing that the total number of Federal Circuit decisions in non-patent district court appeals (at least those that are orally argued) is vanishingly small—no more than two or three per year. I also removed from the list of cases exported from the *Compendium* a small number of duplicate entries, as well as cases that had multiple opinions in the *Compendium* even though it seemed clear that the case had been argued only once (for example, if the court had revised its original opinion in the case, see, e.g., *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271 (Fed. Cir. 2015), *opinion withdrawn and superseded on reh'g*, 793 F.3d 1268 (Fed. Cir. 2015), or the case had both panel and en banc proceedings but only one oral argument, see, e.g., *Apple Inc. v. Samsung Elecs. Co. Ltd.*, 816 F.3d 788, *aff'd in part and remanded in part on reh'g en banc*, 839 F.3d 1034 (Fed. Cir. 2016)). Though it's possible a few erroneous entries remain, the total number of oral arguments in my dataset is quite large—nearly 6,000 over a ten-year period—meaning that minor oversights are unlikely to significantly affect my results.

22. To compile the list of decisions in ITC patent appeals, I used the Federal Circuit's website to search for all decisions in appeals from the ITC, then reviewed the decisions themselves to determine if it was a patent case. For an overview of the ITC's jurisdiction over patent disputes, see Sapna Kumar, *Expert Court, Expert Agency*, 44 U.C. DAVIS L. REV. 1547, 1553–62 (2011).

identity and organizational affiliation of the lawyers who presented oral argument in each case.²³ In calculating the number of arguments presented by any given lawyer, my unit of measurement was one opinion. So, for example, if the Federal Circuit consolidated several appeals into one case and issued one opinion resolving all of those appeals, the attorneys were credited with having presented one argument. Conversely, if the court decided two or more related cases in separate opinions, the attorneys were credited with having presented multiple arguments, even if those arguments were heard by the same panel on the same day.

The final step was to compare my list of Federal Circuit arguments with the list of elite Supreme Court lawyers that I prepared for my other recent article on this topic. Because I determined elite status on a rolling, Term-by-Term basis,²⁴ but the only date information that is readily available for Federal Circuit cases is the date the case was *decided*,²⁵ I employed a brief time lag. For example, to determine the number of elite Supreme Court lawyers who presented oral argument at the Federal Circuit in cases decided in 2017, I looked to my list of elite Supreme Court lawyers for October Term 2016, which encompassed parts of both 2016 and 2017.²⁶

2. Results

On to the results. As Figure 9 below shows, the number of Federal Circuit arguments presented by elite Supreme Court advocates has increased substantially since 2008. As recently as 2009, the number of Federal Circuit oral arguments presented by elite Supreme Court advocates was in the single digits. Over the past three years, however, elite advocates have presented an average of 34 oral arguments to the Federal Circuit annually.

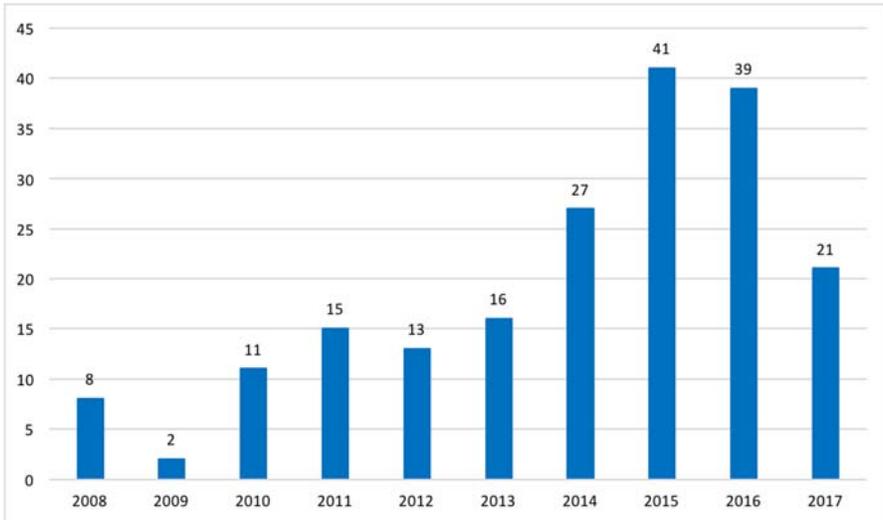
23. The slip opinion itself indicates whether a case was orally argued. Cases that were argued include a notation along the lines of “[Lawyer], [Firm], [City, State], *argued for* [Party].” *See, e.g.*, *Haemonetics Corp. v. Baxter Healthcare Corp.*, No. 2009-1557, slip op. at 1 (Fed. Cir. June 2, 2010), <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/09-1557.pdf> (emphasis added). Cases that were not argued say merely “[Lawyer], [Firm], [City, State], *for* [Party].” *See, e.g.*, *Wallace v. Ideavillage Prods. Corp.*, No. 2015-1077, slip op. at 1 (Fed. Cir. Mar. 3, 2016), <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1077.Opinion.2-26-2016.1.PDF> (emphasis added).

24. Specifically, a lawyer qualified as elite if he or she had presented oral argument five or more times in the current and ten preceding Terms combined. *See* Gugliuzza, *supra* note 6 (manuscript at 6).

25. The date of decision is clearly indicated on the slip opinion. *See, e.g.*, *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, No. 2008-1333, slip op. at 1 (Fed. Cir. Feb. 9, 2009), <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/08-1333.pdf>.

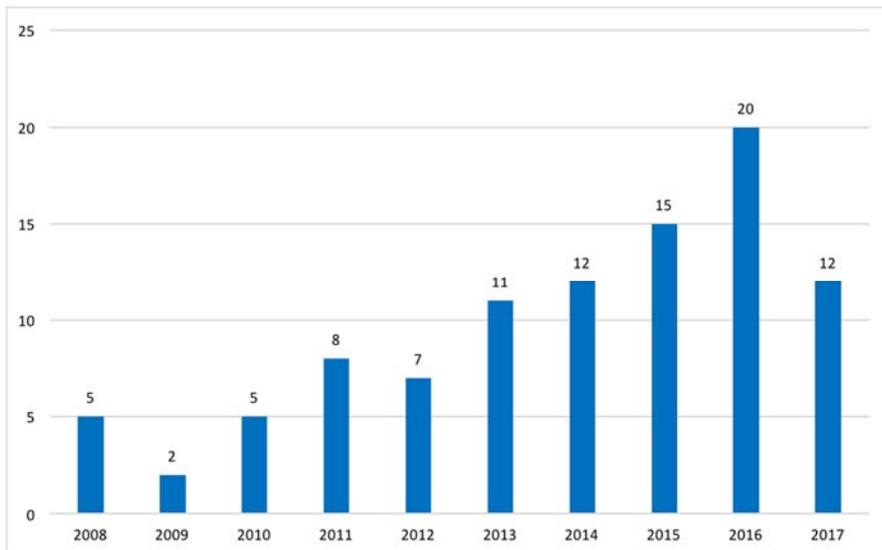
26. Supreme Court terms begin and end on the first Monday of October. 28 U.S.C. § 2 (2012).

Figure 9. Federal Circuit Oral Arguments Presented by Elite Supreme Advocates, 2008 through 2017



Another way of understanding the increased presence of elite Supreme Court advocates at the Federal Circuit is to count not the *number of arguments* they have presented, but to simply count how many of those *individual lawyers* presented at least one oral argument at the Federal Circuit. As Figure 10 below indicates, from 2008 through 2010, an average of only four elite Supreme Court advocates appeared before the Federal Circuit annually. From 2015 through 2017, by contrast, an average of 16 elite Supreme Court advocates presented oral argument at the Federal Circuit in a given year.

Figure 10. Elite Supreme Court Advocates Presenting One or More Oral Arguments at the Federal Circuit, 2008 through 2017



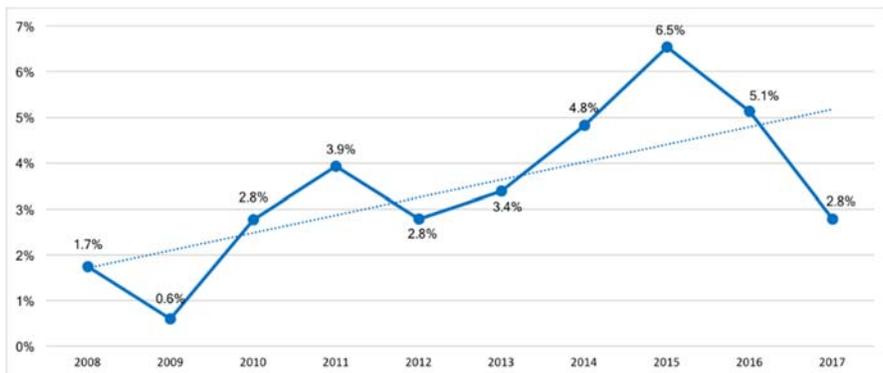
Of course, over the time period of my study (2008 through 2017), the Federal Circuit's caseload increased, due mostly to the large number of appeals from the new post-issuance review proceedings at the Patent Office that began operating in 2012.²⁷ Yet, despite that overall increase in caseload, the *proportion* of Federal Circuit oral arguments presented by elite Supreme Court advocates has also grown significantly since 2008, as Figure 11 below illustrates. Over the three-year period from 2008 through 2010, elite lawyers presented only 1.8% of oral arguments at the Federal Circuit (21 of 1199).²⁸ Five years later, however, that proportion had increased 2.5 times. From 2015 through 2017, elite Supreme Court advocates presented 4.7% of oral arguments in Federal Circuit patent cases (101 of 2140).²⁹

27. See Gugliuzza & Lemley, *supra* note 19, at 780 (reporting, based on data from the *Compendium of Federal Circuit Decisions*, that the number of Federal Circuit rulings in appeals from district courts and the PTO (the two primary sources of Federal Circuit patent cases) increased from 216 in 2011 to 449 in 2016).

28. The denominator here excludes arguments presented by government lawyers, as the government lawyers who typically present oral argument at the Federal Circuit in patent cases (most frequently, lawyers in the PTO Solicitor's Office and staff attorneys at the ITC) could not possibly qualify as elite Supreme Court advocates because Supreme Court litigation on behalf of the federal government is the exclusive domain of the Solicitor General's office. See generally *Fed. Election Comm'n v. NRA Political Victory Fund*, 513 U.S. 88 (1994) (holding that the FEC could not file a petition for a writ of certiorari without the Solicitor General's permission (citing 28 U.S.C. § 518(a) and 28 C.F.R. § 0.20(a))).

29. A linear regression of the data underlying Figure 11 shows statistical significance ($p < .03$) and a positive slope ($\beta = .004$).

Figure 11. Percentage of Federal Circuit Oral Arguments Presented by Elite Supreme Court Advocates, 2008 through 2017



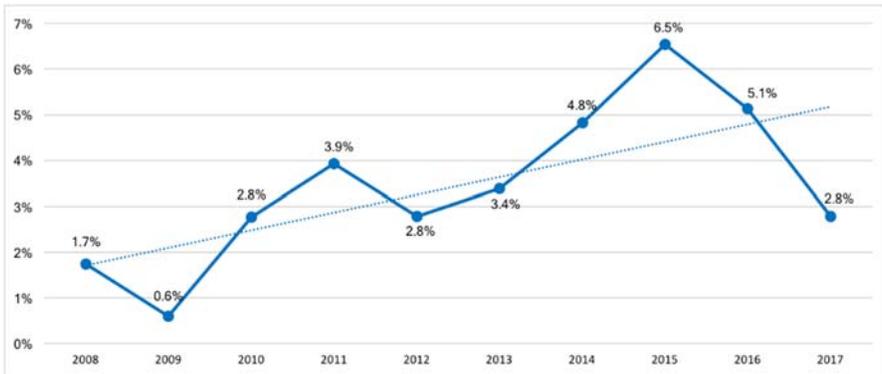
Of course, the number of lawyers who qualify as elite Supreme Court advocates has also increased over the past decade, as discussed above and at greater length in my other paper on this topic.³⁰ Nevertheless, the *proportion* of elite Supreme Court advocates who have also presented oral argument at the Federal Circuit has continued to increase apace. As Figure 12 below illustrates, as recently as 2010, fewer than 10% of elite Supreme Court advocates in private practice presented oral argument at the Federal Circuit.³¹ Today, that figure has more than doubled, with roughly one-quarter of all elite Supreme Court advocates also presenting at least one oral argument at the Federal Circuit in a given year. Like the increase in number of elite arguments, this increase in the proportion of elite advocates presenting arguments at the Federal Circuit is statistically significant.³²

30. See Gugliuzza, *supra* note 6 (manuscript at 29–32).

31. So that Figure 12 would focus on elite advocates in private practice, I excluded from the population of elites any lawyer who presented argument on behalf of the government in a given Term—mostly lawyers from the Office of the Solicitor General.

32. In a linear regression, $p = .002$ and $\beta = .023$.

Figure 12. Percentage of Elite Supreme Court Advocates in Private Practice Presenting One or More Oral Arguments at the Federal Circuit, 2008 through 2017



* * *

Today, the practice of patent law is not reserved to specialists with backgrounds in the hard sciences. Rather, patent law—particularly at the appellate level—is being shaped by the most notable generalist litigators at the country’s most prestigious law firms. Is that good for the patent system and society? Bad? A little of both? The next Part discusses the normative implications of the elite Supreme Court bar’s growing presence in patent appeals.

III. ELITE PATENT LAW

The changes in the appellate patent bar described above could be highly beneficial. Most significantly, elite Supreme Court litigators—whose practices span almost every conceivable area of substantive law—could help counteract the shortcomings of the relatively specialized Federal Circuit. But there are also risks from the rise of “elite patent law.” Most notably, the presence of elite advocates—who know well enough to deemphasize the technological aspects of patent cases—could help explain why the Court has often shied away from disputes about the core requirements of patentability, even though doctrinal disruption in those areas would be helpful. Ultimately, the Supreme Court specialists in the Office of the Solicitor General might be best positioned to capitalize on the upsides and mitigate the downsides of the elite private bar’s increasing involvement in patent appeals.

A. BENEFITS OF ELITE LAWYERING IN PATENT APPEALS

Elite lawyers’ lack of specific expertise in patent law taps into a longstanding debate on the institutional structure of the American system for resolving patent disputes. For nearly a century, judges, lawyers, and scholars

clamored for a specialized court to hear patent cases.³³ Those cries culminated in the creation of the Federal Circuit, which began operating in 1982.³⁴ But now that we have judicial specialization in patent litigation, the critiques have started to pile up. One objection is that Congress created specialization at the wrong level: It's the facts of patent cases that are complicated, not the law, so we'd be better served with a specialized *trial* court.³⁵ Others have argued that the Federal Circuit has embodied the shortcomings often associated with specialized courts: tunnel vision³⁶ and capture.³⁷ A shortcoming of modern patent law, this line of thinking goes, is the lack of peer-level dialogue among intermediate appellate courts about the content of legal doctrine.³⁸

Elite, generalist appellate lawyers could provide a helpful substitute for the missing conversation about patent law among peer-level appellate courts. In an important article on the Federal Circuit as an institution, John Golden conceptualized the Supreme Court's role in patent law as the "prime percolator"—"act[ing] as a catalyst for new or renewed judicial examination

33. See, e.g., *Marconi Wireless Tel. Co. v. United States*, 320 U.S. 1, 60–61 (1943) (Frankfurter, J., dissenting in part) ("It is an old observation that the training of Anglo-American judges ill fits them to discharge the duties cast upon them by patent legislation."); *Parke-Davis & Co. v. H. K. Mulford Co.*, 189 F. 95, 115 (C.C.S.D.N.Y. 1911) (Hand, J.) ("How long we shall continue to blunder along without the aid of unpartisan and authoritative scientific assistance in the administration of justice, no one knows; but all fair persons not conventionalized by provincial legal habits of mind ought, I should think, unite to effect some such advance."), *aff'd in part, rev'd in part*, 196 F. 496 (2d Cir. 1912); HENRY J. FRIENDLY, *FEDERAL JURISDICTION: A GENERAL VIEW* 157 (1973) ("I am unable to perceive why we should not insist on the same level of scientific understanding on the patent bench that clients demand of the patent bar . . .").

34. See Paul R. Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 GEO. L.J. 1437, 1453–64 (2012) (providing a historical summary of the Federal Circuit's creation).

35. See, e.g., Michael Goodman, *What's So Special About Patent Law?*, 26 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 797, 829–30 (2016). Congress, for its part, has lightly experimented with judicial specialization at the trial level. See Patent Cases Pilot Program, Pub. L. No. 111-349, 124 Stat. 3674 (2011) (permitting judges in certain districts to, in essence, volunteer to hear patent cases when their colleagues do not want to); see also Amy Semet, *Specialized Trial Courts in Patent Litigation: A Review of the Patent Pilot Program's Impact on Appellate Reversal Rates at the Five-Year Mark*, 60 B.C. L. REV. 519, 522 (2019) (empirical study finding, among other things, that "the pilot program has not resulted in pilot judges being reversed less often on appeal" but that pilot judges "are somewhat better at encouraging settlement" than non-pilot judges).

36. See, e.g., Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035, 1110 (2003); see also Rochelle Cooper Dreyfuss, *The Federal Circuit: A Continuing Experiment in Specialization*, 54 CASE W. RES. L. REV. 769, 787–88 (2004) (noting that the Federal Circuit's patent-focused jurisdiction creates "a danger that [the court] will act as though . . . technological progress requires greater emphasis on patents, leading it more often to hold patents valid and infringing").

37. See, e.g., WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 336–38 (2003) (finding that the creation of the Federal Circuit increased the number of patents issued and the amount of patent litigation).

38. See, e.g., Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1623 (2007); Diane P. Wood, *Is It Time to Abolish the Federal Circuit's Exclusive Jurisdiction in Patent Cases?*, 13 CHI.-KENT J. INTELL. PROP. 1, 4 (2013).

of issues that the Federal Circuit has settled with excessive speed or, given new understandings or circumstances, excessive finality.”³⁹ The elite bar could play an important role in facilitating that percolation.

Most simply, elite lawyers’ cert. petitions in patent cases are unusually successful, as discussed above, meaning that, as a purely quantitative matter, the elite bar’s mere presence in patent cases may be producing more percolation of patent law than we would otherwise get. Moreover, elite advocates can pick and choose specific legal issues on which settled Federal Circuit law is particularly in need of reform and that the Supreme Court might be willing to disrupt. A good example is *eBay Inc. v. MercExchange, L.L.C.*⁴⁰ In a cert. petition filed by an elite Supreme Court advocate (Carter Phillips), eBay launched a broad challenge to established Federal Circuit precedent—which had been applied in hundreds if not thousands of cases over the years—that presumptively granted an injunction to a patentee upon any finding of infringement.⁴¹ That is not to say that the Court handled *eBay* flawlessly when it decided the case on the merits.⁴² Rather, the point is that well-known Supreme Court litigators have the credibility and know-how to effectively present an aggressive attack on circuit precedent that otherwise seems settled.⁴³

Of course, *eBay* might have been an easy sell to the Court because the case wasn’t really about patent law, it was about remedies, and it certainly didn’t require the Court to grapple with the technology underlying the parties’ dispute. When a case *is* about patent doctrine or requires understanding the relevant technology, it might be harder to convince the Court to perform its percolating function. Justice Scalia, for example, was once asked what his hardest decision was.⁴⁴ His response? Not *Bush v. Gore*. Not *Citizens United*. Not even the Affordable Care Act or same-sex marriage

39. John M. Golden, *The Supreme Court as “Prime Percolator”: A Prescription for Appellate Review of Questions in Patent Law*, 56 UCLA L. REV. 657, 663 (2009).

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

41. Petition for a Writ of Certiorari, *eBay*, 547 U.S. 388 (No. 05-130), 2005 WL 1801263, at *1 (question presented: “Whether the Federal Circuit erred in setting forth a general rule in patent cases that a district court must, absent exceptional circumstances, issue a permanent injunction after a finding of infringement.”).

42. For a cogent critique, see Mark P. Gergen, John M. Golden & Henry E. Smith, *The Supreme Court’s Accidental Revolution? The Test for Permanent Injunctions*, 112 COLUM. L. REV. 203, 213–14 (2012) (suggesting that the “traditional” test for injunctive relief adopted in the *eBay* opinion was anything but).

43. Another good example of an experienced (though not quite elite) Supreme Court litigator successfully challenging long-settled Federal Circuit precedent is James Dabney in *TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514, 1519–20 (2017), in which the Court ultimately overturned a nearly 30-year-old Federal Circuit precedent on venue law in patent cases. Dabney also argued *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 404 (2007), as counsel of record on the cert. petition.

44. Interview by Piers Morgan with Antonin Scalia, CNN (July 18, 2012), <http://transcripts.cnn.com/TRANSCRIPTS/120718/pmt.01.html>.

cases. “It would probably be a patent case,” he said. Which one? He wouldn’t say, only offering that “it’s the dullerest case imaginable.”⁴⁵

Elite lawyers can potentially help the Court overcome any aversion to complex patent cases because the Court can trust those advocates to present the issues well.⁴⁶ A good example is *Sandoz Inc. v. Amgen Inc.*⁴⁷ The cross-petitions in that case raised difficult, highly technical questions about the process of resolving patent disputes involving “biosimilar” products under the Biologics Price Competition and Innovation Act.⁴⁸ The Court granted both petitions—which were each filed by elite advocates—and, in its decision, provided important guidance to a burgeoning industry.⁴⁹

In fact, the Justices themselves have explicitly praised the quality of advocacy provided by elite lawyers in patent cases. At oral argument in *Helsinn v. Teva*, a recent case presenting the question of whether the America Invents Act changed what it means for a product to be “on sale” and hence potentially disqualified from patentability,⁵⁰ Justice Breyer commended the (elite)

45. *Id.* Given the timing of the interview, my money’s on *Bilski v. Kappos*, 561 U.S. 593, 611–13 (2010), in which the Court, though unanimous in result, splintered 5-4 on the question of whether business methods could ever be patented. The Court issued its decision on the last day of the 2009 Term, and Justice Stevens’s lengthy concurrence reads suspiciously like a lost majority opinion. See ROBERT PATRICK MERGES & JOHN FITZGERALD DUFFY, *PATENT LAW AND POLICY: CASES AND MATERIALS* 103 (7th ed. 2017). Justice Kennedy’s opinion for the Court, by contrast, is a slapdash exercise in textualist interpretation of the notoriously sparse Patent Act. See Peter S. Menell, *Forty Years of Wondering in the Wilderness and No Closer to the Promised Land: Bilski’s Superficial Textualism and the Missed Opportunity to Return Patent Law to Its Technology Mooring*, 63 STAN. L. REV. 1289, 1291 (2011); see also Craig Allen Nard, *Legal Forms and the Common Law of Patents*, 90 B.U. L. REV. 51, 53 (2010) (“[T]he patent code . . . is a common law enabling statute, leaving ample room for courts to fill in the interstices.” (footnote omitted)).

46. See generally Katherine Shaw, *Friends of the Court: Evaluating the Supreme Court’s Amicus Invitations*, 101 CORNELL L. REV. 1533, 1542 (2016) (describing the Justices’ appreciation of the high-quality advocacy provided by the elite Supreme Court bar).

47. *Sandoz Inc. v. Amgen Inc.*, 137 S. Ct. 1664 (2017).

48. *Id.* at 1669.

49. See John Duffy, *Opinion Analysis: The Supreme Court Reverses Another Federal Circuit Patent Case*, SCOTUSBLOG (June 13, 2017, 10:18 AM), <http://www.scotusblog.com/2017/06/opinion-analysis-supreme-court-reverses-another-federal-circuit-patent-case> (“Sandoz emerged as the clear victor in the case, winning the right to bring ‘biosimilar’ versions of complex biologic drugs to market sooner and also gaining a small but potentially important procedural right for future litigations.”). A runner-up as an example here would be *Caraco Pharmaceutical Laboratories, Ltd. v. Novo Nordisk A/S*, which addressed the extremely technical question of whether a generic pharmaceutical manufacturer can use a counterclaim in a patent infringement lawsuit to challenge the description of patent scope that the brand manufacturer submits to the Food and Drug Administration. *Caraco Pharm. Labs., Ltd. v. Novo Nordisk A/S*, 566 U.S. 399, 403 (2012). Though Justice Kagan’s opinion for the Court has been held up as an exemplar of good legal writing, Ross E. Davies, *Recommended Reading*, in GREEN BAG ALMANAC & READER 15, 15 (Ross E. Davies ed., 2013)—among other things, it muses on the odds of the New York Mets winning the World Series (“no chance whatsoever”)—the case isn’t the best example of the elite bar’s impact because the petitioner’s counsel of record, Steffen Johnson, didn’t qualify as elite—though he had previously argued before the Court. See *Holmes v. South Carolina*, 547 U.S. 319, 320 (2006).

50. *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628, 630 (2019).

lawyers' briefs as "excellent" and registered his view that "the bar really earned its pay on both sides."⁵¹ Justice Breyer's comments then led Justice Kagan (as well as the lawyers themselves), to similarly praise the "excellent" quality of advocacy in the case.⁵² All of this fawning led Chief Justice Roberts, after indicating the conclusion of argument with his usual statement that "[t]he case is submitted," to quip: "I am sure we'll come up with an excellent opinion."⁵³ At least some of the praise at the *Helsinn* argument was, to be sure, made with tongues planted firmly in cheek.⁵⁴ Still, it's hard to imagine an oral argument—in a relatively dry patent case, no less—devolving into such jocularity without two elite lawyers (both of whom are alums of the Solicitor General's office) standing at the podium.⁵⁵

But even if elite lawyers can help the Court overcome aversion to the legal complexity of some patent cases—and maybe even make the Justices laugh about them⁵⁶—what about *technological* complexity? At least some Justices do not appear wild about digging into the facts surrounding patent cases either. Justice Scalia again provides one example. In the *Myriad* case involving patents on human DNA, he refused to join portions of the majority opinion "going into fine details of molecular biology" because, he explained, "I am unable to affirm those details on my own knowledge or even my own belief."⁵⁷ (Some observers have suggested that Justice Scalia was right to be skeptical of majority's recitation of the relevant science.)⁵⁸ Moreover, as I have chronicled

51. Transcript of Oral Argument at 42, *Helsinn*, 139 S. Ct. 628 (No. 17-1229), https://www.supremecourt.gov/oral_arguments/argument_transcripts/2018/17-1229_p702.pdf (Justice Breyer: "So it's possible among these excellent briefs—I thought the bar really earned its pay on both sides—but, I mean, the—the—the—I—I couldn't come up with a good . . . example . . .").

52. See *id.* at 44 (Justice Kagan: "Because[] in Mr. Shanmugam's excellent brief . . ."); *id.* at 45 (William M. Jay: "[B]ut . . . in both of [Mr. Shanmugam's] excellent briefs . . . you won't find any dictionary definition anywhere of 'on sale' . . ."); *id.* at 59–60 (Kannon K. Shanmugam: "Mr. Jay today, as in his excellent brief, suggests that 'otherwise' could be read to cover situations in which there is some overlap.").

53. *Id.* at 63.

54. Indeed, given the cavalcade of mockery his initial remark spurred, Justice Breyer might think twice before again commenting on the quality of advocacy before the Court. See *id.* at 60 (Justice Breyer: "You have a whole brief, I mean, you know, you have a brief—I mean, everybody's is excellent. Okay? But the point is . . .").

55. But cf. Tonja Jacobi & Matthew Sag, *Taking Laughter Seriously at the Supreme Court*, 73 VAND. L. REV. (forthcoming) (manuscript at 52), <https://ssrn.com/abstract=3345077> (empirical study finding that the Justices "are significantly more likely to make . . . comments that provoke the courtroom gallery into laughter while a [n]ovice [advocate] is speaking, and significantly less likely to do so during the" arguments of experienced Supreme Court advocates).

56. See generally Jay Wexler (@SCOTUSHUMOR), TWITTER, <https://twitter.com/SCOTUSHUMOR> (last visited April 21, 2019) ("Tracking SCOTUS [laughs] is my life's work.").

57. Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 569 U.S. 576, 596 (2013) (Scalia, J., concurring in part and concurring in the judgment).

58. See Noam Prywes, *The Supreme Court's Sketchy Science*, SLATE (June 14, 2013, 12:15 PM), http://www.slate.com/articles/health_and_science/science/2013/06/supreme_court_patent_case_science_the_justices_misunderstand_molecular_biology.html.

in prior work, the Court routinely declines to apply the law to the facts of the case when it decides patent disputes, even in cases in which the Court is well-positioned to do so.⁵⁹ Surveying the Supreme Court's case law more generally, Linda Greenhouse recently observed that "[w]hen it comes to science and technology, Supreme Court [J]ustices resemble lay people in robes, often ill-equipped to grasp fully the implications of the important cases they are asked to decide on scientific subjects."⁶⁰ The Court's hesitation to get into the technological weeds could be, as I explain next, one of the downsides of elite lawyers' increasing dominance of patent cases.

B. POTENTIAL PITFALLS

Elite Supreme Court lawyers are, in all likelihood, keenly aware that patent cases are not the Justices' favorite. That awareness could help explain why the Court's patent docket consists largely of cases that either (a) raise transsubstantive issues of procedure, jurisdiction, and remedies or (b) involve questions of statutory interpretation, and why the Court rarely decides cases involving the core, common law-like doctrines at the heart of patent law.

The Court's penchant for transsubstantive issues in patent cases has been detailed at length elsewhere,⁶¹ so I won't repeat examples here. As for statutory interpretation, consider that, in the past two years, the Court has granted and decided two cases involving patent infringement under 35 U.S.C. § 271(f)—a relatively obscure provision that makes it illegal to sell components of patented inventions for assembly outside the United States.⁶² Petitioner's counsel of record in both cases qualified as elite—indeed, they are part of what might be considered the uber-elite, having each argued over 75 Supreme Court cases in their careers.⁶³ Though § 271(f) is relevant in only a fraction of patent infringement disputes, it's not surprising that the Court granted cert. in those cases. They involved: (1) elite lawyers,⁶⁴ (2) the potential extraterritorial application of U.S. law (a topic the Supreme Court

59. Paul R. Gugliuzza, *How Much Has the Supreme Court Changed Patent Law?*, 16 CHI.-KENT J. INTELL. PROP. 330, 344–46 (2017).

60. Linda Greenhouse, *The Supreme Court & Science: A Case in Point*, 147 DAEDALUS 28, 28–29 (2018).

61. See, e.g., J. Jonas Anderson, *Reining in a "Renegade" Court: TC Heartland and the Eastern District of Texas*, 39 CARDOZO L. REV. 1569, 1603–09 (2018); Paul R. Gugliuzza & Megan M. La Belle, *The Patently Unexceptional Venue Statute*, 66 AM. U. L. REV. 1027, 1028–29 (2017); Peter Lee, *The Supreme Assimilation of Patent Law*, 114 MICH. L. REV. 1413, 1451 (2016).

62. *WesternGeco LLC v. ION Geophysical Corp.*, 138 S. Ct. 2129, 2134, 2137–39 (2018); *Life Techs. Corp. v. Promega Corp.*, 137 S. Ct. 734, 738–43 (2017).

63. See Petition for a Writ of Certiorari, *WesternGeco*, 138 S. Ct. 2129 (No. 16-1011), 2017 WL 678358 (Paul Clement); Petition for a Writ of Certiorari, *Life Techs.*, 137 S. Ct. 734 (No. 14-1538), 2015 WL 3941490 (Carter Phillips).

64. Whose cert. petitions are, to repeat, 3.3 times more likely to be granted than petitions filed by non-elites. See *supra* Figure 1.

frequently engages with and may feel a special responsibility for policing),⁶⁵ and (3) legal questions that could be resolved through commonplace tools of statutory interpretation.⁶⁶ Indeed, despite § 271(f)'s irrelevance to the miner of patent infringement disputes, the two recent cases were not the first time that provision had been litigated at the Supreme Court.⁶⁷ In fact, § 271(f) was enacted to overrule a Supreme Court decision holding that making a product outside the United States could never be an act of patent infringement.⁶⁸

One consequence of the Court's penchant for transsubstantive issues and questions of statutory interpretation—which the elite bar seems keenly aware of⁶⁹—is that the Supreme Court's patent docket neglects the core, common law-like requirements of patentability. Contrast the somewhat-esoteric provision of § 271(f) with § 103. Section 103 sets forth the nonobviousness requirement that has been called the “sine qua non of patentability.”⁷⁰ Yet the Supreme Court last decided an obviousness case in 2007, when it overruled Federal Circuit precedent that required courts and patent examiners to identify a specific “teaching, suggestion, or motivation” to make the claimed invention in order to justify a finding of obviousness.⁷¹ In that case, *KSR International Co. v. Teleflex, Inc.*, the Court instead called for a more flexible

65. See STEPHEN M. SHAPIRO ET AL., SUPREME COURT PRACTICE 270–71 (10th ed. 2013) (discussing the Court's proclivity to grant cert. on “[s]ignificant federal statutory questions implicating foreign affairs”).

66. Justice Thomas opened the Court's opinion in *WesternGeco* by describing the issue in the case:

Under the Patent Act, a company can be liable for patent infringement if it ships components of a patented invention overseas to be assembled there. See 35 U.S.C. § 271(f)(2). A patent owner who proves infringement under this provision is entitled to recover damages. § 284. The question in this case is whether these statutes allow the patent owner to recover for lost foreign profits.

WesternGeco, 138 S. Ct. at 2134. And the Court, in an opinion by Justice Sotomayor, framed the issue in *Life Technologies* as follows:

Section 271(f)(1) . . . prohibits the supply from the United States of “all or a substantial portion” of the components of a patented invention for combination abroad. We granted certiorari to determine whether a party that supplies a single component of a multicomponent invention for manufacture abroad can be held liable for infringement under § 271(f)(1).

Life Techs., 137 S. Ct. at 737 (citation omitted).

67. See *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 447 (2007) (deciding a § 271(f) case in which the cert. petition filed by another member of the uber-elite: former Solicitor General Ted Olson).

68. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 527 (1972), *superseded by statute*, 35 U.S.C. § 271(f) (2012), *as recognized in Life Techs.*, 137 S. Ct. at 742–43.

69. In a conversation a couple years ago, one elite Supreme Court advocate flatly told me (paraphrasing slightly): “The way to get the Court interested in a patent case is to raise an issue of jurisdiction or procedure, or to frame it as involving a question of statutory interpretation.”

70. *Roanwell Corp. v. Plantronics, Inc.*, 429 U.S. 1004, 1005 (1976) (White, J., dissenting from denial of certiorari).

71. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–21 (2007).

analysis accounting for market demands, design incentives, and the common sense of a person of ordinary skill in the art.⁷² In *KSR*'s immediate aftermath, the Federal Circuit seemed to abide by the Supreme Court's instructions, upholding more rulings of obviousness and deploying a more pliant legal test.⁷³ In the past few years, however, the Federal Circuit has issued several decisions that appear to conflict with *KSR*. Particularly questionable rulings limit the use of common sense,⁷⁴ demand specific evidence of a motivation to combine prior art references,⁷⁵ and turn the legal question of nonobviousness into a largely if not entirely factual one.⁷⁶ The Supreme Court has received cert. petitions on these issues—filed by elite lawyers, no less⁷⁷—but to date it has denied them. One possible explanation for why obviousness cases—though immensely important to the patent system—generally don't appeal to the Supreme Court is that obviousness is a case-specific question that requires deep engagement with the underlying technology.⁷⁸ Even elite lawyers, it seems, can't overcome the Court's aversion to those types of issues.

The proof might lie in an exception to what I've just written. The *Helsinn* case discussed above (excellently, I hope) involved the novelty provision of § 102—indisputably one of the core requirements of patentability.⁷⁹ But that case presented a pure issue of statutory interpretation: Did the America Invents Act (“AIA”), passed in 2011, change the definition of what it means

72. *Id.*

73. See Jason Rantanen, *The Federal Circuit's New Obviousness Jurisprudence: An Empirical Study*, 16 STAN. TECH. L. REV. 709, 713 (2013).

74. See *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361 (Fed. Cir. 2016) (“[C]ommon sense is typically invoked to provide a known *motivation to combine*, not to supply a missing claim limitation.”), *cert. denied sub nom. Google Inc. v. Arendi S.A.R.L.*, 137 S. Ct. 1329 (2017).

75. See *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1052 (Fed. Cir. 2016) (en banc) (upholding jury verdict of nonobviousness as supported by “implied fact finding” of no motivation to combine), *cert. denied*, *Samsung Elecs. Co. v. Apple Inc.*, 138 S. Ct. 420 (2017); see also *id.* at 1078 (Dyk, J., dissenting) (“Contrary to *KSR*, the majority now holds that a known problem is not sufficient [to support a finding of obviousness] and that there must be evidence of a specific motivation [to combine].”).

76. See, e.g., *Everlight Elecs. Co. v. Nichia Corp.*, 719 F. App'x 1008, 1012 (Fed. Cir. 2018) (“We agree with the district court that substantial evidence supports the jury verdict of [obviousness]. . . . A reasonable jury could have drawn a variety of conclusions regarding the strength and credibility of the evidence. We will not reweigh that evidence here.”), *cert. denied*, *Nichia Corp. v. Everlight Elecs. Co.*, 139 S. Ct. 183 (2018); see also *Apple Inc.*, 839 F.3d at 1075 (Dyk, J., dissenting) (“[T]he majority turns the legal question of obviousness into a factual issue for a jury to resolve, both as to the sufficiency of the motivation to combine and the significance to be given to secondary considerations.”).

77. Petition for a Writ of Certiorari, *Samsung*, 138 S. Ct. 420 (No. 16-1102), 2017 WL 957228 (Kathleen Sullivan); Petition for a Writ of Certiorari, *Google*, 137 S. Ct. 1329 (No. 16-626), 2016 WL 6648849 (Eric Miller); see also Petition for a Writ of Certiorari, *Nichia*, 139 S. Ct. 183 (No. 17-1707), 2018 WL 3141455. The petition in *Nichia* was filed by Mark Lemley, who is a well-known Federal Circuit advocate and legal scholar but not a member of the Supreme Court elite.

78. See, for example, the intricate description of automobile gas pedal technology in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407–09 (2007).

79. *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628, 630 (2019).

for a product to be “on sale” and hence potentially disqualified from patentability?⁸⁰

To be fair, there is one core issue of patentability that the Court *has* repeatedly engaged in recent years: the patent-eligible subject matter doctrine. Though § 101 of the Patent Act recites eligibility in broad terms (any “process, machine, manufacture, or composition of matter” is eligible for patenting),⁸¹ the Court has recently reinvigorated a judge-made exception to those broad eligibility categories. That exception prohibits patents on abstract ideas and natural phenomena unless the patent also contains an “inventive concept” that “transform[s]” the idea or phenomenon into a patent-eligible *application*.⁸² Remarkably, this string of recent decisions began with a case, *Lab. Corp. v. Metabolite*, in which the petition—filed by an elite lawyer—didn’t even raise the eligibility issue.⁸³ Perhaps realizing the case was a poor vehicle for addressing eligibility, the Court ultimately dismissed the petition as improvidently granted.⁸⁴

Since the dismissal of *Lab. Corp.*, the Supreme Court has evolved the eligibility requirement over four decisions in less than a decade, developing a test that focuses both on the patent’s scope (does it claim an abstract idea or natural phenomenon?) and on its originality as compared to prior technology (does the patent contain an inventive concept?).⁸⁵ Of course, that test implicates matters also addressed by other provisions of the Patent Act, namely, § 102’s novelty requirement, § 103’s nonobviousness requirement, and the disclosure doctrines of § 112. Accordingly, many critics have argued the Court would be better off leaving questions of scope and inventiveness to the statutory provisions that are expressly designed to govern those issues.⁸⁶

80. See *id.* at 633–34 (holding that the AIA did not change the rule that “secret” sales can be invalidating). For what it’s worth, the petition was filed by a member of the elite (Kannon Shanmugam), who flagged the statutory hook in the very first line of the question presented. See Petition for a Writ of Certiorari, *Helsinn*, 139 S. Ct. 628 (No. 17-1229), 2018 WL 1168243, at *1 (presenting the question: “Whether, under the Leahy–Smith America Invents Act, an inventor’s sale of an invention to a third party that is obligated to keep the invention confidential qualifies as prior art for purposes of determining the patentability of the invention.”). The other patent case argued in the Supreme Court’s current, 2018 Term similarly involves a pure issue of statutory interpretation: whether the federal government is a “person” who may file post-issuance proceedings to invalidate a patent at the Patent Office. See *Return Mail, Inc. v. U.S. Postal Serv.*, 868 F.3d 1350, 1365 (Fed. Cir. 2017) (holding that the government may request post-issuance review), *cert. granted*, 139 S. Ct. 397 (2018); see also 35 U.S.C. § 321(a) (2012) (“[A] person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent.” (emphasis added)).

81. 35 U.S.C. § 101.

82. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 221 (2014).

83. See Petition for a Writ of Certiorari, *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124 (2006) (No. 04-607), 2004 WL 2505526.

84. *Lab. Corp.*, 548 U.S. at 125–26.

85. See *Alice Corp.*, 573 U.S. at 217–18.

86. See, e.g., Timothy R. Holbrook & Mark D. Janis, *Patent-Eligible Processes: An Audience Perspective*, 17 VAND. J. ENT. & TECH. L. 349, 377 (2015); see also John M. Golden, *Redundancy*:

In prior work, I have argued that the eligibility requirement, even if it is *substantively* duplicative of other patentability doctrines, plays a useful *procedural* role by permitting quick disposition of patents that are clearly invalid.⁸⁷ Courts often consider eligibility to raise a question of law devoid of factual considerations, which allows the issue to be resolved earlier in the case than more fact-driven validity doctrines such as novelty and nonobviousness.⁸⁸ But that's just my own, post hoc rationalization of the Supreme Court's decisions reinvigorating the eligibility requirement. The Court itself seems blissfully unaware of the procedural consequences of its recent rulings.⁸⁹ So why, then, has the Court fixated on the judge-made exceptions to § 101 while almost entirely ignoring cases involving the patentability requirements that are actually written in the statute and that seem to address similar policy considerations? Since 2010, the Court has heard more cases on eligibility—four (plus the *Lab. Corp.* case dismissed as improvidently granted in 2006)—than it has decided on §§ 102, 103, and 112 combined—two.

For starters, it's worth noting that elite lawyers filed three of the five petitions the Court granted on eligibility issues. A savvy Supreme Court advocate might have been able to postulate at least a couple reasons why the Court would be attracted to cases raising eligibility issues, even if it usually shies away from questions of patentability. First, while doctrines such as nonobviousness seem hyper-technical—requiring a detailed understanding of the claimed invention, the prior art, and the problem to be solved⁹⁰—eligibility doctrine allows the Court to decide patentability without getting into the technological weeds and instead broadly characterizing inventions as reciting “fundamental economic practice[s]”⁹¹ or “conventional activity.”⁹² Second, eligibility—with its lofty concerns about patents that unduly “preempt the use of . . . natural law[s] . . . in the making of further discoveries”⁹³ or that “improperly [tie] up the future use of [the] building blocks of human ingenuity”⁹⁴—looks, as compared to other patentability doctrines, more like a topic the Court regularly grapples with: constitutional law. Indeed, Justice Breyer, in an opinion dissenting from the dismissal of certiorari in *Lab. Corp.* (joined by Justices Stevens and Souter), emphasized a

When Law Repeats Itself, 94 TEX. L. REV. 629, 695 (2016) (“[T]he Court’s [recent eligibility] opinions have overruen the apparently sharp distinction between questions of subject-matter eligibility and questions of novelty or nonobviousness . . .”).

87. See Paul R. Gugliuzza, *Quick Decisions in Patent Cases*, 106 GEO. L.J. 619, 655–57 (2018).

88. *Id.* at 636–37, 654.

89. See *id.* at 652–53.

90. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 405–07 (2007).

91. See, e.g., *Bilski v. Kappos*, 561 U.S. 593, 611 (2010).

92. See, e.g., *Mayo Collab. Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012).

93. *Id.* at 72–73.

94. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (quoting *Mayo*, 566 U.S. at 85).

view that eligibility has a quasi-constitutional dimension.⁹⁵ “[T]he reason for the exclusion” of laws of nature from patent eligibility, Justice Breyer explained, “is that sometimes *too much* patent protection can impede rather than ‘promote the Progress of Science and useful Arts,’ the constitutional objective of patent and copyright protection.”⁹⁶

A key reason to hire an elite Supreme Court advocate is that they know the Court exceptionally well, and they are certainly aware of the cert.-granting patterns I’ve described above.⁹⁷ That deep knowledge of the Court might help explain why the Court’s agenda in patent law doesn’t always focus on the core issues that are most salient to the day-to-day administration of the patent system. Indeed, it took more than a decade and numerous unsuccessful cert. petitions before the Court finally tackled (and overturned) perhaps the most important and controversial ruling the Federal Circuit ever made: that patent claim construction is a pure question of law subject to *de novo* review on appeal.⁹⁸

C. THE SOLICITOR GENERAL’S ROLE IN PATENT CASES

So, the elite Supreme Court bar’s increasing involvement in patent cases seems to have both positive and negative aspects. One thing that appears certain, however, is that the Court will continue to hear a significant number of patent cases in the near future. My data shows a clear trend toward more and more elite advocates filing more and more cert. petitions in patent cases that, as compared to cases in other areas of law, the Court is relatively likely

95. *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 126–27 (2006) (Breyer, J., dissenting from the dismissal of the writ of certiorari).

96. *Id.* (quoting U.S. CONST. art. I, § 8, cl. 8).

97. And so, they *all* file briefs that emphasize transsubstantive issues or matters of statutory interpretation and that deemphasize patent doctrine and the underlying technology. See generally Shaw, *supra* note 46, at 1584 (noting that elite Supreme Court lawyers “tend to present arguments in very similar styles and to adhere to very similar norms”).

98. For a sample of unsuccessful petitions on that topic, see *Petition for a Writ of Certiorari, Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 2012 WL 957505 (filed Mar. 20, 2012) (No. 11-1154), *cert. denied*, 568 U.S. 1084 (2013); *Petition for a Writ of Certiorari, SMC Corp. v. Norgren, Inc.*, 2009 WL 3199679 (filed Oct. 6, 2009) (No. 09-412), *cert. denied*, 558 U.S. 1148 (2010); *AWH Corp. v. Phillips*, 2005 WL 3038548 (filed Nov. 9, 2005) (No. 05-602), *cert. denied*, 546 U.S. 1170 (2006); *Petition for a Writ of Certiorari, Memorex Prods. Inc. v. SanDisk Corp.*, 2005 WL 2508049 (filed Oct. 6, 2005) (No. 05-546), *cert. denied*, 546 U.S. 1076 (2005); *Waner v. Ford Motor Co.*, 2003 WL 22429252 (filed Oct. 9, 2003) (No. 03-563), *cert. denied*, 540 U.S. 1105 (2004); *Tegal Corp. v. Tokyo Electron Am., Inc.*, 2002 WL 32135085 (filed Jan. 2, 2002) (No. 01-993), *cert. denied*, 535 U.S. 927 (2002). The Court finally resolved the issue in *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (overruling *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc)). The petition in *Teva*, it should be noted, was filed by a member of the elite. See *Petition for a Writ of Certiorari, Teva*, 135 S. Ct. 831 (No. 13-854), 2014 WL 230926 (William Jay). For a thorough history of the Federal Circuit’s precedent on the law/fact distinction in claim construction and the controversy surrounding it, see J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 NW. U. L. REV. 1, 21–35 (2013).

to grant. How, then, to maximize the benefits of elite lawyers' involvement in patent cases while minimizing the downsides?

One key player I haven't discussed much is the Solicitor General. In other work, I have shown that the Solicitor General—who normally has significant influence at the cert. stage—wields even greater influence in patent cases. From 2002 through 2016, the Court agreed with the Solicitor General's recommendation in 78.9% of cases in which the Court called for the Solicitor General's views (62 of 232).⁹⁹ In patent cases, however, the Court agreed with the Solicitor General's recommendation in a remarkable 93.3% of cases (28 of 30).¹⁰⁰ John Duffy has similarly documented the enormous influence the Solicitor General has when he or she files a brief on the merits of a patent case, reporting that, in every Supreme Court patent case from 2000 through 2010, the Court adopted the legal position the Solicitor General suggested in its brief on the merits (whether the government was participating as a party or, more frequently, an amicus).¹⁰¹

The deference the Solicitor General receives at the cert. stage arises, at least in part, because of its deep knowledge of the Court and of its sensitivity to the criteria the Court applies for granting review.¹⁰² Similarly, one oft-cited reason for the success the elite private Supreme Court bar has had in reshaping the Court's agenda more generally is that those lawyers—who are often alums of the Solicitor General's office—know how to exploit those same considerations.¹⁰³

Perhaps, then, in patent cases, the Solicitor General should apply different criteria when deciding whether to recommend the grant or denial of cert. After all, one of the most common bases for a cert. grant—a circuit split—almost never happens in patent cases because of the centralization of appeals in the Federal Circuit. By the Court's own rules, that leaves only two possible justifications for granting cert. in a patent case: the importance of the issue¹⁰⁴ and the plainly erroneous nature of the decision below.¹⁰⁵ While those

99. Gugliuzza, *supra* note 6 (manuscript at 22–23, 26).

100. *Id.* (manuscript at 25).

101. John F. Duffy, *The Federal Circuit in the Shadow of the Solicitor General*, 78 GEO. WASH. L. REV. 518, 538–40 (2010).

102. See Adam D. Chandler, Comment, *The Solicitor General of the United States: Tenth Justice or Zealous Advocate?*, 121 YALE L.J. 725, 727 (2011).

103. As Richard Lazarus puts it:

The[] expertise [of elite Supreme Court advocates] lies in determining how best to pitch a case, how to strike a theme of interest to particular Justices, and how to secure the filing of amicus briefs that will most effectively buttress their arguments and distinguish their petition from the mounds of others. They know how to frame a petition in order to best support a claim of a circuit conflict, the legal importance of an issue, or the pressing need for immediate Supreme Court review.

Lazarus, *supra* note 9, at 1525.

104. SUP. CT. R. 10(c).

105. *Id.* R. 10(a).

sorts of Federal Circuit decisions certainly warrant review, the Solicitor General could recommend that the Court grant cert. in cases where the decision below is not obviously wrong or high stakes, but that could have the potential to percolate core patent doctrine.

Of course, the Court sometimes doesn't call for the Solicitor General's views at all. Indeed, out of 589 paid cert. petitions in Federal Circuit patent cases from 2002 through 2016, the Court called for the Solicitor General's views only 31 times, or in 5.3% of cases.¹⁰⁶ Though that percentage might seem small, consider that, by my calculations, the Court calls for the Solicitor General's views in only about 1.3% of cases overall.¹⁰⁷ Similarly, the Solicitor General recommended a grant in 12 of the 30 patent cases in which it filed a brief at the invitation of the Court, or about 40%.¹⁰⁸ While that again might seem like a small fraction, the Solicitor General overall recommends that the Court grant cert. only about a quarter of the time (in 62 of 294 cases in my dataset).¹⁰⁹ Thus, suggesting that the Solicitor General should more liberally recommend granting cert. in patent cases would, to be sure, push an already high rate of grant recommendations even higher.

Still, there is precedent for the Solicitor General recommending grant in patent cases that are not obvious candidates for cert. *KSR* might be the best example.¹¹⁰ The "teaching, suggestion, or motivation" test applied by the Federal Circuit in that case was arguably in tension with Supreme Court precedent calling for a more flexible analysis, but the decision itself wasn't much different than scores of obviousness decisions the Federal Circuit had issued in the preceding two decades.¹¹¹ The Solicitor General could have—but didn't—take a similar step in the recent *Samsung v. Apple* case, in which it recommended denying cert. on the issue of the jury's role in deciding patent validity.¹¹² The Solicitor General's primary argument was that the Federal Circuit had reached the correct result,¹¹³ but, given the controversy

106. See Gugliuzza, *supra* note 6 (manuscript at 22, 38–39) (noting that there would be 32 CVSG orders if one were to count a case that was voluntarily dismissed before the Solicitor General filed its brief. *Maersk Drilling USA, Inc. v. Transocean Offshore Deepwater Drilling, Inc.*, 572 U.S. 1131 (2014) (mem.)).

107. Specifically, from 2002 through 2016, the Court issued 328 CVSG orders (according to data I have collected) and the Court disposed of 24,669 cert. petitions (according to data reported by the Court). See *Journal*, SUP. CT. U.S., <https://www.supremecourt.gov/orders/journal.aspx> (last visited April 21, 2019).

108. One of the 31 patent cases identified in the text as involving CVSG orders settled before the Solicitor General filed its brief. *Apotex Inc. v. Pfizer, Inc.*, 549 U.S. 970 (2006) (denying cert.); see Gugliuzza, *supra* note 6 (manuscript at 38–39).

109. See Gugliuzza, *supra* note 6 (manuscript at 26).

110. Brief for the United States as Amicus Curiae, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (No. 04-1350), 2006 WL 1455388.

111. See, e.g., *id.* at *14–16 (citing cases).

112. Brief for the United States as Amicus Curiae, *Samsung Elecs. Co. v. Apple Inc.*, 138 S. Ct. 420 (2017) (No. 16-1102), 2017 WL 4457613, at *9.

113. See *id.*

surrounding this issue,¹¹⁴ the Supreme Court's intervention might have been warranted to either settle the issue or at least disrupt the rule currently emerging in the Federal Circuit, which grants the jury *carte blanche* to decide the ultimate question of patent validity—which the Supreme Court itself has consistently held to be a question of law.¹¹⁵

Another method of injecting an additional voice at the cert. stage (which other commentators have discussed at greater length) would be to allow the PTO to dissent from briefs filed by the Solicitor General in the Supreme Court and file its own brief.¹¹⁶ Allowing that additional brief could usefully highlight for the Court areas of patent law where reasonable minds might differ about the correctness of Federal Circuit law or the desirability of Supreme Court review.

IV. CONCLUSION

The dramatic increase in the number of patent cases decided by the Supreme Court might be the most significant development in intellectual property law in the past two decades, and the growing involvement of elite Supreme Court litigators in patent cases seems to provide at least a partial explanation for that trend. Granting a small, homogenous group of lawyers such immense power over patent law has numerous implications. It might explain, for instance, why the Supreme Court rarely engages core patent doctrines such as the nonobviousness requirement: Elite lawyers know that those doctrines raise hard questions about technology that the Court prefers to avoid, so they focus their cert. petitions on other issues. But the Solicitor General, as a neutral actor, could be a useful counterweight.

114. See *supra* notes 74–76 and accompanying text (citing conflicting statements by Federal Circuit judges); see also Mark A. Lemley, *Why Do Juries Decide if Patents Are Valid?*, 99 VA. L. REV. 1673, 1675 (2013) (“Curiously, while the right to a jury trial on patent validity issues is widely assumed, there is in fact no solid support in modern case law for such a right.”).

115. See, e.g., *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17 (1966).

116. See Ben Picozzi, Note, *The Government's Fire Dispatcher: The Solicitor General in Patent Law*, 33 YALE L. & POL'Y REV. 427, 447 (2015).