

2-8-2019

Administrative Oversight: Justice Gorsuch's Patent Opinions, the PTAB, and Antagonism Toward the Administrative State

Daniel D. Kim
Unified Patents

Jonathan Stroud
Unified Patents

Follow this and additional works at: <https://scholarship.kentlaw.iit.edu/ckjip>

 Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Daniel D. Kim & Jonathan Stroud, *Administrative Oversight: Justice Gorsuch's Patent Opinions, the PTAB, and Antagonism Toward the Administrative State*, 18 Chi. -Kent J. Intell. Prop. 53 (2019).

Available at: <https://scholarship.kentlaw.iit.edu/ckjip/vol18/iss2/6>

This Article is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Chicago-Kent Journal of Intellectual Property by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact dginsberg@kentlaw.iit.edu.

ADMINISTRATIVE OVERSIGHT:

JUSTICE GORSUCH’S PATENT OPINIONS, THE PTAB, AND ANTAGONISM TOWARD THE ADMINISTRATIVE STATE

DANIEL D. KIM AND JONATHAN STROUD*

ABSTRACT

In his first term, Justice Neil Gorsuch has made a surprisingly forceful impact on, of all things, patent law—and even more unlikely, the United States Patent and Trademark Office’s adjudicatory arm, the Patent Trial and Appeal Board. Was there any way to predict, from his 10th Circuit opinions below, that he would author opinions in all three patent cases in his first term? Was this attention the result of deeply submerged but long-felt opinions on patent law, or rather a result of his sharp distrust of administrative overreach? We analyze 10th Circuit and Supreme Court opinions authored by Justice Gorsuch, and conclude his unforeseen interest springs from his desire to limit agency power rather than from any particular concern with patents. Still, his opinions—intentionally or by happenstance—will reverberate through our patent law for years.

* Daniel Kim is a recent graduate from the American University Washington College of Law and an Associate at Unified Patents, who would like to thank Jonathan for all the opportunities, including co-authoring this paper. Jonathan Stroud is the Chief IP Counsel at Unified Patents and Adjunct Professor at American University Washington College of Law. Thank you to Daniel for his dedication, affability, and hard work on this and various other projects.

TABLE OF CONTENTS

I. INTRODUCTION	54
II. BIOGRAPHICAL BACKGROUND	56
III. 10TH CIRCUIT OPINIONS	59
A. <i>HYDRO RESOURCES INC. V. EPA</i>	61
B. <i>RUSSO V. BALLARD MEDICAL PRODUCTS</i>	63
C. <i>STORAGECRAFT TECHNOLOGY CORPORATION V. KIRBY</i>	63
D. <i>MESHWERKS, INC. V. TOYOTA MOTOR SALES U.S.A., INC.</i>	64
E. <i>SUREFOOT LC V. SURE FOOT CORP.</i>	66
IV. JUSTICE GORSUCH’S FIRST-TERM SUPREME COURT	
OPINIONS	67
A. <i>OIL STATES V. GREENE’S ENERGY (DISSSENT)</i>	68
B. <i>SAS INSTITUTE INC. V. IANCU (MAJORITY)</i>	70
C. <i>WESTERNGECO LLC V. ION GEOPHYSICAL CORP. (DISSSENT)</i>	71
D. <i>UPPER SKAGIT INDIAN TRIBE V LUNDGREN (MAJORITY)</i>	72
V. SUMMARY	73
VI. CONCLUSION	75

I. INTRODUCTION

“The real art of conversation is not only to say the right thing at the right place, but to leave unsaid the wrong thing at the tempting moment.”

Lady Dorothy Nevill

Justice Gorsuch cares deeply about patents. At least, that is the conclusion many would have you draw¹ from his penning of opinions in all three of the patent

1. See, e.g., Ronald Mann, *Opinion analysis: Justices reject Patent and Trademark Office’s rules for partial consideration of petitions for inter partes review*, SCOTUSBLOG (Apr. 25, 2017), <http://www.scotusblog.com/2018/04/opinion-analysis-justices-reject-patent-and-trademark-offices-rules-for-partial-consideration-of-petitions-for-inter-partes-review/>; Jenny B. Martin, *Justice Gorsuch Drives Home Patent Protection*, WASH. TIMES (Dec. 6, 2017), <https://www.washingtontimes.com/news/2017/dec/6/justice-neil-gorsuch-patent-protection/>.

cases before the high court his first term (2017–2018).² They would urge you to read the tea leaves, make some inferences, and come to understand that Justice Gorsuch has long harbored strong opinions on patents.³ But is there any evidence, hint, or suggestion in his life, work, or past opinions that Gorsuch the jurist was ever particularly interested in patents *per se*?⁴ Or is it rather that the patent disputes of the modern Court almost invariably contain Federal administrative law aspects—something he cares deeply about—and provide a convenient battleground from which to express his open and growing skepticism of the Federal Government's ability to handle legal disputes?⁵ Despite the many voices making the former claim, it does not appear that Justice Gorsuch cared (or even thought) much about patent law before his elevation to the high court.⁶

After reviewing Justice Gorsuch's IP-related opinions⁷—none of them squarely patent cases—a few subtle points emerge. The most prominent appears to be that Justice Gorsuch's opinions, in general, spring from deep desire to check the administrative state—in sum, it is not about patents, it is about administrative law and the balance of powers. On that point, the liberal justices—in particular, Justice Elena Kagan—sit on the opposite end of the spectrum.⁸ And his recent selection of

2. See *Oil States Energy Servs. LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1380 (2018) (Gorsuch, J., dissenting); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1352 (2018); *WesternGeco LLC v. ION Geophysical Corp.*, 138 S. Ct. 2129, 2139 (2018) (Gorsuch, J., dissenting).

3. See *infra* Section III.

4. We are not alone in asking. See, e.g., Dennis Crouch, *Justice Neil Gorsuch*, PATENTLY-O (Apr. 7, 2017), <https://patentlyo.com/patent/2017/04/justice-neil-gorsuch.html> (“I expect Justice Gorsuch to support strong patent rights, but primarily focus on statutory language and historic precedent. *I.e.*, do not expect Gorsuch to see patents as a fundamental right, but rather a policy tool that can be fully regulated by Congress.”); Howard S. Hogan & Lucas C. Townsend, *Where Does Judge Gorsuch Fall on IP?*, LAW J. NEWSL. (Mar. 1, 2017), <http://www.lawjournalnewsletters.com/sites/lawjournalnewsletters/2017/03/01/where-does-judge-gorsuch-fall-on-ip/?slreturn=20180726155851>; Scott Graham, *What to Expect From Neil Gorsuch on IP, Patents and Trade Secrets*, THE NAT'L L. J. (Feb. 13, 2017) <https://www.law.com/nationallawjournal/almID/1202779049527/What-to-Expect-From-Neil-Gorsuch-on-IP-Patents-and-Trade-Secrets/> (discussing many of the same few non-patent IP-related 10th Circuit cases discussed herein).

5. Or maybe it is just that, as the junior Justice on the Court, Justice Gorsuch is being given the least-desired or lowest-priority opinions to write.

6. In an irrelevant but colorful aside, the United States Patent and Trademark Rocky Mountain Regional Office in Denver, on the 10th floor of the GSA building, literally looks down on the 10th Circuit, Justice Gorsuch's onetime seat. It is fair to assume that he was at least familiar with the creation of the regional Office and its proximity to his Court in the years prior to his ascension. What he thought about that—if at all—is, of course, as enigmatic as his earlier views on patents, if any.

7. See *infra* Section III.

8. See, e.g., Elena Kagan, *Presidential Administration*, 114 HARV. L. REV. 2245 (2000) (advocating for a broader view of presidential executive and administrative power).

two patent-experienced law clerks only reinforces the observation that this interest is newfound, and seemingly provoked by his seat on the High Court.⁹

In sum, looking at Justice Gorsuch's opinions can help inform his reasoning, worldview, and goals as they relate to the state of U.S. patent law. We begin by introducing a short biographical background, continue by reviewing some key 10th Circuit cases, look to four important first-term Supreme Court cases, and briefly conclude.

II. BIOGRAPHICAL BACKGROUND

Nothing in Justice Gorsuch's lightly reported background and upbringing suggests he would have any particular interest or expertise in patent law. Nonetheless, context is important (and interesting) considering how little the average lawyer knows about his Honor.

Neil McGill Gorsuch was born in 1967 to two lawyers, Anne and David Gorsuch.¹⁰ His mother Anne was named the first female Environmental Protection Agency ("EPA") Administrator in 1981, though she resigned under pressure 22 months later after refusing to turn over subpoenaed documents.¹¹ Shortly thereafter, his parents divorced.¹²

9. He has hired Notre Dame Professor Stephen Yelderman, a professor of patent law and a former 10th Circuit Clerk, for the 2019–2020 season, as well as Jeff Quilici, a former K&L Gates LLP and Baker Botts LLP patent litigator and another 10th Circuit Clerk of then-Judge Gorsuch's. See Kevin Allen, *Professor Stephen Yelderman to clerk for Supreme Court Justice Neil Gorsuch*, NOTRE DAME LAW SCHOOL (Oct. 15, 2018), <https://law.nd.edu/news-events/news/professor-stephen-yelderman-to-clerk-for-supreme-court-justice-neil-gorsuch/>; IAM, *Amplified Patent Expertise Could Help SCOTUS Dispel Credibility Rumors*, (Oct. 26, 2018), <https://www.iam-media.com/law-policy/justice-gorsuch-makes-his-patent-voice-heard-he-has-unusual-amount-ip-expertise-call>. He has also hired what appears to be the first Native American Supreme Court Law Clerk, Tobi Young, who is currently serving in the 2018–2019 term. See Press Release, Chicksaw Nation Media Relations Office, Chicksaw Woman Selected To Clerk For Supreme Court Justice Neil Gorsuch (Apr. 13, 2018), <https://chickasaw.net/News/Press-Releases/Release/Chickasaw-woman-selected-to-clerk-for-Supreme-Cour-47329.aspx>. While her heritage does not reflect any special expertise in patent law or tribal sovereign immunity law, it is at least further evidence of his longstanding relationship and expertise in areas of tribal concern. See *id.* ("Justice Gorsuch is well respected by tribal leaders for his understanding of tribal sovereignty and Indian law. His decision to select a Native American to serve as clerk underscores his appreciation of the importance of the Native perspective on Indian law.").

10. *Neil Gorsuch*, BIOGRAPHY.COM, <https://www.biography.com/people/neil-gorsuch-020617> (last visited Aug. 25, 2018).

11. *Burford Resigns as Administrator of Embattled EPA*, TOLEDO BLADE, Mar. 10, 1983, at 1. It is unclear how many and how much of Gorsuch's opinions concerning the administrative state were formed during his "formative" years; however, it is difficult to imagine that this particular scandal helped improve the young Neil Gorsuch's early opinions of the propriety of the exercise of administrative power.

12. Patricia Sullivan, *Anne Gorsuch Burford, 62, Dies; Reagan EPA Director*, WASH. POST, July 22, 2004, <http://www.washingtonpost.com/wp-dyn/articles/A3418-2004Jul21.html>.

Justice Gorsuch attended Georgetown Preparatory School in Maryland, where he was voted class president.¹³ At Columbia University, he displayed conservative views as a writer for the *Columbia Daily Spectator* and co-founder of *The Federalist Paper*.¹⁴ He graduated Phi Beta Kappa in 1988. Gorsuch attended Harvard Law School, where he was classmate with Barack Obama, earning his J.D. in 1991.¹⁵

Neil Gorsuch first clerked for Judge David B. Sentelle of the United States Court of Appeals for the District of Columbia Circuit.¹⁶ He then spent another year clerking with two Supreme Court justices, the retired Anthony M. Kennedy and the retired Byron R. White.¹⁷

In 1995, Gorsuch joined the D.C. law firm formerly known as Kellogg, Huber, Hansen, Todd, Evans & Figel.¹⁸ Specializing in complex litigation across a wide range of fields, including antitrust, telecommunications, and securities fraud, he made partner in three years, in 1998.¹⁹ It is unclear if he handled or was exposed in his years in private practice to any patent-specific matters.

In 2004, Gorsuch received a doctorate in legal philosophy from the University of Oxford.²⁰ He then joined the U.S. Department of Justice in 2005 as principal deputy associate attorney general, helping to oversee areas related to constitutional law, civil rights, and environmental regulation.²¹ In his own words, “as Principal Deputy Associate Attorney General at the Department of Justice, I had a supervisory role over litigating components that were involved in various kinds of intellectual property litigation.”²² But nowhere does it suggest he managed or was exposed to patent law in particular—and the answer is likely no in any real respect, unless in regards to his antitrust background, which seems unlikely given his focus there.

In July 2006, the 39-year-old Gorsuch was confirmed without opposition to the U.S. Court of Appeals for the Tenth Circuit, in Denver.²³ That year he also

13. *Neil Gorsuch*, *supra* note 10.

14. *Id.* (showing his early tendency towards a more conservative interpretation of the law).

15. *Id.*

16. *Id.*

17. *Id.*

18. *Id.* (The firm is now known as Kellogg, Hansen, Todd, Figel & Frederick LLP).

19. *Id.*

20. *Id.*

21. *Id.*

22. SENATE JUDICIARY COMM., NOMINATION OF JUDGE NEIL M. GORSUCH TO BE ASSOCIATE JUSTICE OF THE UNITED STATES SUPREME COURT: QUESTIONS FOR THE RECORD (Mar. 24, 2017), <https://www.judiciary.senate.gov/imo/media/doc/Gorsuch%20QFR%20Responses.pdf> [hereinafter “NOMINATION OF JUDGE GORSUCH”].

23. *Neil Gorsuch*, *supra* note 10.

published a book version of his Doctoral Thesis, *The Future of Assisted Suicide and Euthanasia*, in which he argued against the legality of the practice.²⁴

He later established himself, through statements and his judicial opinions, as a sort of neo-originalist and a textualist,²⁵ adhering to a belief in the intent of the founders of the U.S. Constitution, though some have argued his “natural law” philosophy is more radical than Justice Scalia’s style of Constitutional originalism.²⁶ He has supported religious freedom in important and controversial cases—for example, ruling in favor of Hobby Lobby in 2013 during the store’s fight against mandated contraception coverage in the Affordable Care Act.²⁷

Gorsuch also made known his opposition to the power given to federal regulators over courts, invoking the controversial 1984 ruling that set the legal precedent in that matter during a 2016 immigration case.²⁸ He was nominated by President Donald J. Trump to fill the seat vacated by the death of Justice Antonin Scalia after a lengthy Congressional battle involving President Barak Obama’s attempt to appoint Merrick Garland for the same seat.²⁹ He was confirmed, 54–45,³⁰ and sat for the 2017–2018 term, the first and only justice to sit with his once-clerked-for Justice, Anthony Kennedy, before the latter’s retirement at the end of the term.³¹

24. NEIL M. GORSUCH, *THE FUTURE OF ASSISTED SUICIDE AND EUTHANASIA* (Princeton Univ. Press, 2006) (adapted from Neil Gorsuch, *The right to receive assistance in suicide and euthanasia, with particular reference to the law of the United States* (doctoral thesis, University of Oxford, 2004), https://ora.ox.ac.uk/catalog/uuid:688e5b8c-bb06-4d86-abe0-440a7666ffc1/download_file?file_format=pdf&safe_filename=MS.D.Phil.c.19040_ocr.pdf&type_of_work=Thesis).

25. See Rachel del Guidice, *Gorsuch Touts Originalism, Textualism in Address to Conservative Legal Society*, THE DAILY SIGNAL (Nov. 17, 2017), <https://www.dailysignal.com/2017/11/17/gorsuch-touts-originalism-textualism-in-address-to-conservative-legal-society/> (stating that “[a] person can be both a committed originalist and textualist and be confirmed to the Supreme Court of the United States”).

26. See J. Paul Kelleher, *Neil Gorsuch’s “natural law” philosophy is a long way from Justice Scalia’s originalism*, VOX (Mar. 20, 2017), <https://www.vox.com/the-big-idea/2017/3/20/14976926/gorsuch-natural-law-supreme-court-hearings>.

27. *Hobby Lobby Stores, Inc. v. Sebelius*, 723 F.3d 1114, 1121 (10th Cir. 2013) (en banc) (Gorsuch, J., concurring) (finding the Affordable Care Act’s contraceptive mandate on a private business violated the Religious Freedom Restoration Act), *aff’d sub nom* *Burwell v. Hobby Lobby Stores, Inc.*, 134 S. Ct. 2751 (2014).

28. *Gutierrez-Brizuela v. Lynch*, 834 F.3d 1142, 1152–53 (10th Cir. 2016).

29. Leigh Ann Caldwell, *Neil Gorsuch Confirmed to Supreme Court After Senate Uses ‘Nuclear Option’*, NBC NEWS (Apr. 7, 2017), <https://www.nbcnews.com/politics/congress/neil-gorsuch-confirmed-supreme-court-after-senate-uses-nuclear-option-n743766>.

30. *Id.*

31. Michael D. Shear, *Supreme Court Justice Anthony Kennedy Will Retire*, N.Y. TIMES, June 27, 2018), <https://www.nytimes.com/2018/06/27/us/politics/anthony-kennedy-retire-supreme-court.html>.

III. 10TH CIRCUIT OPINIONS

*“Our age is infected with a mania for shewing things only in the environment that properly belongs to them, thereby suppressing the essential thing, the act of the mind which isolated them from that environment.”*³²

In his ten years on the 10th Circuit, Justice Gorsuch authored few published IP-related opinions—likely due to a combination of geography and jurisdiction. According to Justice Gorsuch, the 10th Circuit, per statute,³³ did not hear any but the most tangential patent-related appeals,³⁴ unsurprising, given the statute and that the 10th Circuit covers an area of the country that does not include many large cities, innovative centers, or large universities with busy tech transfer offices. It is perhaps unsurprising then that diligent searching revealed only a handful of even IP-relevant, much less patent-centric, opinions.

Unfortunately, Judge Gorsuch’s 10th Circuit opinions, after research and review, do not reveal much about patent law in general or how he is likely to consider appeals from the Patent Trial and Appeal Board (“PTAB”), but they do reveal important things about his jurisprudence in general, as well as in areas of adjacent law sure to arise in the patent context in the coming years—Native American tribal sovereign immunity and Federal Article III standing to challenge administrative decision-making. We briefly review a representative sample of his 10th Circuit opinions, addressing issues particular to recent patent issues, like the sovereign immunity of Native American tribes.

For context, the sovereign immunity of Native American tribal patent owners came to a head recently in *Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc.*,³⁵ a case likely to result in a brief for certiorari—thus, understanding Justice Gorsuch’s approach to tribal immunity below could provide context for any future rulings from the bench, either on certiorari or in opinion.

Luckily for those seeking that context, the 10th Circuit (and Justice Gorsuch) is no stranger to Native American issues, including those of sovereign immunity. Indeed, you can trace a direct line from *Hydro Resources Inc. v. U.S. EPA*,³⁶ a 6–5 *en banc* decision over Native American land rights, to *Upper Skagit Indian Tribe*

32. MARCEL PROUST, *WITHIN A BUDDING GROVE* 328 (C.K. Scott Moncrieff trans., 1st. ed. 1919).

33. 28 U.S.C. § 1295 grants jurisdiction to all appeals from cases “arising under any Act of Congress relating to patents” *See* 28 U.S.C. § 1295 (2012).

34. *See* NOMINATION OF JUDGE GORSUCH, *supra* note 22 (“As a [Tenth Circuit] judge, I have participated in intellectual property cases, though of course not patent cases which, as you note, proceed to another circuit.”).

35. *St. Regis Mohawk Tribe v. Mylan Pharm. Inc.*, No. 2018-1638 (Fed. Cir. July 20, 2018).

36. *Hydro Resources Inc. v. U.S. EPA*, 608 F.3d 1131, 1135 (10th Cir. 2010) (*en banc*).

v. Lundgren,³⁷ a 7–2 late-term Supreme Court case in which he sided with the liberal Justices, and drew a disagreeable concurrence from Chief Justice Roberts, joined by Justice Kennedy, and a truly biting dissent from Justice Thomas, joined by Justice Alito. This will be discussed later.³⁸

After reading his handful of previous 10th Circuit opinions on IP disputes, such as copyrights, trade secrets, and patent-adjacent standing disputes, other nuances emerge.³⁹ Gorsuch can be pithy. He can be biting. He can be folksy (if sometimes forcedly so). He clearly knows the law, and seems to favor citing rules over records. He will summarily dismiss arguments he finds irrelevant or meritless as seemingly beneath notice. His gloss of facts—refreshing to one used to reading citation-heavy administrative proceedings—suffices only to inform the reader of their various truths, and are structured and stated to lead readers down his planned primrose path. His opinions read like a law professor’s dream in terms of clarity and structure. He is not often verbose. He is a smart, possibly impatient man who would like to get the point across neatly.

In his first term, Justice Gorsuch has taken a harder line than even some supporters would have likely supposed. He seems less concerned with consensus or majority-building than with statement-making, and has even raised the ire of other conservative justices, as can be seen in his 8–1 dissent in *Sveen v. Melin*⁴⁰ or in the dissent of Justice Thomas in *Upper Skagit Indian Tribe v. Lundgren*.⁴¹

For all of that, you can count us both admirers,⁴² if not of his judicial philosophy—and here we admit biases⁴³—then at least of his obvious ability as a writer and jurist.⁴⁴

37. *Upper Skagit Indian Tribe v. Lundgren*, 138 S. Ct. 1649, 1655–57 (2018).

38. See *infra* Section III.A.

39. There has been quite a bit of discussion about the stylistic differences between Judge Gorsuch of the 10th Circuit and Justice Gorsuch of the Supreme Court and the difference in quality between the two styles. See, e.g., Nina Varsava, *Elements of Judicial Style: A Quantitative Guide to Neil Gorsuch’s Opinion Writing*, 93 N.Y.U. L. REV. 76 (2018). As the vast majority of his writing stems from his 10th Circuit tenure, we have formed our opinions reviewing the entirety of his work as a jurist, and not just his limited tenure as a Justice. Thus, despite some recently noticed errors of redundancy and heavy-handed prose, we will continue to write in the present tense about Justice Gorsuch’s literary style.

40. *Sveen v. Melin*, 138 S. Ct. 1815, 1826–31 (2018) (Gorsuch, J., dissenting).

41. *Upper Skagit Indian Tribe*, 138 S. Ct. at 1656 (Thomas, J., dissenting).

42. We, the authors, do not admit to sharing a single hive-mind, nor do we completely mirror in our opinions in all things. However, we do believe in the importance of compromise, discussion, and debate. We understand that we can accomplish more as a unit than as individuals: to wit, “two heads are better than one.” Thus, for this article, we are we.

43. We identify with a more liberal judicial philosophy, though we strive to keep an open mind and to evolve. Both authors were educated at American University’s Washington College of Law—well-known for its liberal tendencies—but we seek to maintain a healthy respect and awareness of alternative views. (One of the authors is often better at this than the other.) We have found the recent debate over the scope of patent law’s administrative aspects both unexpected and fascinating, coming as

Justice Gorsuch greatly prefers to apply the filial “we” in his opinions, inviting the readers close with familiarity and witticism, as if welcoming the reader into the court’s mind—“[w]hile we do not imagine,” “we are able to limit our attention in this case,” “we thus understand,” or while, writing as the Court, “we have no difficulty” determining something, while “[p]laintiffs do not argue, and we do not remotely hold,” otherwise.⁴⁵ Give him credit—he endeavors to spice up the page. He might add that the “[d]efendants, unsurprisingly, disagree,” but that “[a]s it happens, we are able to avoid entering this thicket.”⁴⁶ Other courts may “remind us” or a party’s arguments may “not tell the whole story.”⁴⁷ A case may be “[i]nformative in its contrast,” or, of a certain dispute, “we have no need to pick sides today.”⁴⁸

Or this gem, from a determination of personal jurisdiction in a copyright case: “In this way, [the inquiry] is something like a bank shot in basketball. A player who shoots the ball off of the backboard intends to hit the backboard, but he does so in service of his further intention of putting the ball into the basket;” thus, a defendant’s “express aim” could “be said to have reached into [the court’s jurisdiction] in much the same way that a basketball player’s express aim in shooting off of the backboard is not simply to hit the backboard, but to make a basket.”⁴⁹

With that overview on style and background, we turn to the cases—the only notable published writings related to intellectual property we could identify for this article.

A. *Hydro Resources Inc. v. EPA*

Hydro is relevant and important on a few levels—those of standing, administrative skepticism, rules challenges, and Justice Gorsuch’s ability to gain a majority of his colleagues’ support. As an *en banc* decision he authored, it was likely the product of time and effort, and can provide an important window into his

it has recently from many some conservative parties who once saw the AIA and other patent reforms as an extension of the kinds of tort reform of the 90s as supporting American businesses.

44. See *supra* note 39 for further discussion.

45. *Dudnikov v. Chalk & Vermilion Fine Arts, Inc.*, 514 F.3d 1063, 1071–72 & 1074 (10th Cir. 2008).

46. *Id.* at 1072–73.

47. *Id.* at 1075.

48. *Id.* at 1076 & 1079 (ruling for the originally *pro se* small challenger against the corporate owner of copyrights on a personal jurisdiction).

49. *Id.*

approach to standing, which recently emerged as a hot-button issue in the context of appeals from the PTAB.⁵⁰

In *Hydro* and other cases, then-judge Gorsuch took a somewhat liberal view of standing, allowing a bare challenge to an EPA rule by a company who had not demonstrated more than that it would have to obtain a second permit and endure the additional expense of, in the future, complying with further regulatory fees.⁵¹ This has relevance to his view of potential future challengers to the United States Patent and Trademark Office (“USPTO”) administrative rules, in that it suggests he is likely to find standing is no great hurdle to such a challenge.

He unsurprisingly sided with the state regulatory body over the EPA’s expansive reading of its permitting jurisdiction, even though it was the EPA’s original choice to devolve some of its regulatory authority to state agents—and in doing so, sided with the regulated over the regulator.⁵² The complex issue earned him a majority, though a close one, of his 10th Circuit colleagues, and a biting dissent from the rest.⁵³

Judge Gorsuch also addressed, at some level, his wariness of agency deference in *Hydro*,⁵⁴ giving us a window into how he might treat deference arguments on appeal. Though his view on deference was not as obvious then as it has been,⁵⁵ Justice Gorsuch’s opinion follows the legacy of his Supreme Court predecessor, Justice Scalia.⁵⁶ Though the primary dissent argued that the EPA deserved at least *Skidmore* deference,⁵⁷ then-Judge Gorsuch reasoned that it is

50. See Matthew J. Dowd & Jonathan Stroud, *Standing to Appeal at the Federal Circuit: Appellants, Appellees, and Intervenors*, 74 CATH. U. L. REV. (forthcoming 2019) (discussing *Phigenix, Inc. v. ImmunoGen, Inc.*, 845 F.3d 1168 (Fed. Cir. 2017) (discussing recent standing cases.)).

51. *Hydro Resources Inc. v. U.S. EPA*, 608 F.3d 1131, 1144–45 (10th Cir. 2010) (en banc) (“As we have previously explained, ‘the out-of-pocket cost to a business of obeying a new rule of government[,] . . . (sic) whether or not [there may be] pecuniary loss’ associated with the new rule, suffices to establish an ‘injury in fact.’” (citing *Nat’l Collegiate Athletic Ass’n v. Califano*, 622 F.2d 1382, 1386 (10th Cir. 1980)).

52. See *Hydro*, 608 F.3d at 1144–45.

53. *Id.* at 1170 (Ebel, J., dissenting).

54. *Id.*

55. See *Gutierrez-Brizuela v. Lynch*, 834 F.3d 1142, 1149 (10th Cir. 2016) (Gorsuch, J. concurring) (“*Chevron* . . . permit[s] executive bureaucracies to swallow huge amounts of core judicial and legislative power and concentrate federal power in a way that seems more than a little difficult to square with the Constitution”) (citing *Chevron U.S.A. Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984)).

56. Judge Gorsuch cited two concurring opinions by Justice Scalia in his reasoning as to why the Court should not apply any deference to the EPA. See *Hydro*, 608 F.3d at 1146 (citing *Miss. Power & Light Co. v. Miss. ex rel. Moore*, 487 U.S. 354, 381 (1988) (Scalia, J., concurring); *Crandon v. U.S.*, 494 U.S. 152, 174 (1990) (Scalia, J., concurring)).

57. *Hydro*, 608 F.3d at 1170 n.2 (Ebel, J., dissenting) (citing *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944)).

“inappropriate” for the court to apply a legal theory not presented by one of the parties.⁵⁸ Thus, the EPA’s regulation was successfully challenged.

B. *Russo v. Ballard Medical Products*

In *Russo v. Ballard Medical Products*,⁵⁹ then-Judge Gorsuch demonstrated that he was at least familiar with patent law when he addressed a \$20 million trade secret award case and issues of federal preclusion of state law claims—an argument he dismissed handily. In 2008, he upheld the award against a medical device company despite the company’s protest that it had patented the device and thus patent law preempted the state law trade secret claim on which the claim was based. In doing so, Judge Gorsuch defended a small inventor against a larger company, and found no problem with a \$20 million award, effectively disregarding the defense counsel’s sophisticated ways of arguing the award should be limited.⁶⁰ However, in writing his opinion, Judge Gorsuch mainly ignored diving into questions of inventorship, ownership, and patentability.⁶¹ Instead, he spent the bulk of his opinion discussing the question of the Supremacy Clause’s relationship to state trade secret laws and federal patent laws. Ultimately, while he did concede that state protections can conflict with federal patent law,⁶² Judge Gorsuch felt no reason to involve federal law in a case involving only the two claims of misappropriation and breach of contract.⁶³

C. *StorageCraft Technology Corporation v. Kirby*

Another trade secret case is notable in its elevation of formal legal harm over actual economic loss. It suggests that Justice Gorsuch may likely draw lines in favor of strict infringement liability and be less tethered than other justices to considerations of actual harm or consequences. In *StorageCraft Technology*

58. *Hydro*, 608 F.3d at 1146 n.10. The dissent does note that the court should at least consider applying *Skidmore* deference despite the EPA’s oversight, as a “party’s concession on the standard of review does not bind the court, as such a determination remains for the court to make for itself.” *Id.* at 1170 n.2 (Ebel, J., dissenting) (internal citations omitted). The Majority was not convinced and does not address the issue above the line of the opinion.

59. *Russo v. Ballard Med. Prods.*, 550 F.3d 1004 (10th Cir. 2008).

60. *Id.* at 1021 (“While perhaps a plausible position as a policy matter, the problem with Ballard’s argument is that the Utah legislature has rejected it . . . [a]pparently, it was the Utah legislature’s desire to ensure that misappropriators are not allowed to keep ill-gotten gains from their unlawful acts of misappropriations.”).

61. *Id.* at 1014 (“[N]o question of federal patent law was raised by Mr. Russo’s trial. He did not seek to be proclaimed the inventor of Ballard’s patents, or seek of the rights associated with inventorship”).

62. *Id.* at 1013 (citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974)).

63. *See Russo*, 550 F.3d at 1008.

Corporation v. Kirby,⁶⁴ he upheld a \$3 million award to a Utah company for a trade secret disclosure based entirely on spite—one that did not result in any actual loss.⁶⁵ He found that “[w]hen someone steals a trade secret and discloses it to a competitor he effectively assumes for himself an unrestricted license in the trade secret. And that bears its costs.”⁶⁶

Judge Gorsuch apparently understands the questionable sensibility of such a strict interpretation of the law’s language.⁶⁷ But in the end, he did not seem much troubled by harmful or perverse results of written law, shifting any blame for poorly written or unjust laws “to those charged with writing” them rather than “those charged with applying” them.⁶⁸ This suggests to us he is unlikely to be swayed by parade-of-horrible arguments and likely prefers arguments couched in the text of the law before him divorced from much external context or consequence.

D. *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*

Justice Gorsuch has also shown no great fear in tackling technology head-on, and has shown fluency in some of the more arcane details of that technology—as evidenced by his opinion in the copyright case, *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*⁶⁹ There, Judge Gorsuch found the computer-generated wire-frame images of cars created for digital advertisements were not copyrightable, and expressed doubts as to the extent of what *is* copyrightable, finding that photographs, wire frames, and other artistic expressions “*can be*, but are not *per se*, copyrightable.”⁷⁰ This suggests he is unlikely to liberally apply the copyright doctrine to purely functional works and may look with skepticism on claims that products, without evidence of artistic expression, are copyrighted.

Like his future dissent in *Oil States*,⁷¹ Gorsuch spent quite some time discussing the history and purpose of intellectual property law. (It is perhaps not

64. *StorageCraft Tech. v. Kirby*, 744 F.3d 1183 (10th Cir. 2014).

65. *Id.* at 1185 (“The trouble is Utah’s law doesn’t distinguish between a misappropriator’s venial motives.”).

66. *Id.*

67. *Id.* at 1187 (“We can imagine arguments that might lead [to] . . . worries that hypothetical royalty negotiation exercises themselves might be difficult to administer in certain circumstances or might yield damages in excess of the plaintiff’s actual losses.”).

68. *Id.*

69. *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258 (10th Cir. 2008).

70. *Id.* at 1269 (“[T]he Court indicated, photographs are copyrightable, if only to the extent of their *original* depiction of the subject. Wilde’s image is not copyrightable; but to the extent a photograph reflects the photographer’s decisions”).

71. *See infra* Sec. IV.A.

surprising that the self-proclaimed originalist and textualist⁷² would first cite the Constitution⁷³ and then explore the plain and ordinary meaning of the statute⁷⁴ in support of his analysis.) Starting there, he approached copyright in general, but not before laying the Constitutional groundwork many courts gloss over.

In analyzing the opinion, Justice Gorsuch seems to recognize the particular difficulties in interpreting the nuances of intellectual property issues can be. Perhaps surprisingly, he shows some empathy towards *Meshwerks*, whose digital copies of Toyota's cars he nonetheless held "insufficiently original to warrant copyright protection,"⁷⁵ noting the "considerable amount of time, effort, and skill that went into making"⁷⁶ the models. If *Meshwerks*, *Russo*, and *StorageCraft* suggest anything to the patent lawyer consistent with what we will see from *SAS* and *Oil States* and his vision of the PTAB, it is that he seems to either side with, or at least recognize, the plight of the individual or the small plaintiff over the corporate, even when siding legally with the corporation. But with so few data points, that may be nothing more than idle speculation. Experience suggests the latter.

But one insight to take from *Meshwerks* is in comparing it to the notable Supreme Court case *Oil States*⁷⁷ discussed at length later. In *Meshwerks*, as in *Oil States*, Justice Gorsuch starts at the law's source, tracing a line from the Constitution to the case at hand. He similarly discusses the intent and purpose of intellectual property law generally—that is, according to him.⁷⁸ He then takes time to discuss briefly the opposing interpretation,⁷⁹—if not a bit sarcastically.⁸⁰ Reading either opinion as Gorsuch caring about the state of intellectual property law per se, however, misses the point. That approach is one he seems to adopt regardless of subject matter. Rather, Gorsuch the jurist seems occupied with two things—the law as it relates to the Constitution,⁸¹ and providing support for his opinions based on his reading of the statutory text. Interestingly, he seems to shy

72. *Meshwerks*, 528 F.3d at 1262 ("This constitutional and statutory principle seeks to strike a delicate balance-reward").

73. *Id.* at 1262 ("The Constitution authorizes Congress '[t]o promote the Progress of Science and useful Arts'").

74. *Id.* at 1263 ("What exactly does it mean for a work to qualify as 'original'?").

75. *Id.* at 1269.

76. *Id.* at 1268.

77. *Oil States Energy Servs., LLC., v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365 (2018).

78. *Id.* at 1382 ("The Constitution itself reflects this new thinking").

79. *Id.* at 1380 ("no doubt, dispensing with constitutionally prescribed procedures is often expedient").

80. It seems he likes setting up straw men almost as much as he relishes knocking them down. It is a persuasive (if, to a dissenter, provocative) tactic.

81. Whether that be the Constitutionality of a statute or the roles of the separate branches.

away from heavy citation of the facts of any case, seeming much more comfortable discussing the law *per se*.

E. Surefoot LC v. Sure Foot Corp.

He has, however, waded into areas of law that have been deeply debated by the patent community—a case about declaratory judgment standing after *MedImmune*, albeit in a trademark case. His approach there was to treat the issue—declaratory judgment standing—as he would treat any other standing issue, citing the founding statutes and the relevant case to synthesize clear rules devoid of overcomplexity.

In *Surefoot LC v. Sure Foot Corp.*,⁸² Judge Gorsuch found declaratory judgment jurisdiction after *MedImmune Inc. v. Genentech*,⁸³ where there was a broader business dispute between the two parties than what was before the court in the declaratory judgment action, including Trademark Trial and Appeal Board (“TTAB”) challenges.⁸⁴ Judge Gorsuch at least suggested that five TTAB oppositions and other administrative actions were enough to establish declaratory judgment jurisdiction to challenge their validity in Federal Court, which is all the more notable given the growth and interest in standing to appeal from the PTAB, of which one of us has written.⁸⁵ *Surefoot*, particularly coupled with *Hydro*, suggests that Justice Gorsuch may have a preference for finding court standing rather than using it as a means of exercising judicial restraint. The outcome in *Surefoot* also suggests he might find standing to appeal where there is a broader dispute between the two parties at bar not directly related to the potential harm before him.

To be sure, standing is a “squishy” doctrine, in the words of many practitioners.⁸⁶ This particular preference is not expressly mentioned in the text of the opinion, and does not necessarily suggest how he might rule in another standing case where the Court might have other reasons for wanting (or not) to hear a particular case. So while we could read in a willingness to acknowledge the usefulness of TTAB proceedings and their administrative merit, we could equally see the argument that by finding the federal district court had standing that would

82. *Surefoot LC v. Sure Foot Corp.*, 531 F.3d 1236 (10th Cir. 2008).

83. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007).

84. *Surefoot LC*, 531 F.3d at 1246–47.

85. See *supra* note 50 and accompanying text.

86. See, e.g., *Church Provides No Sanctuary: Sixth Circuit’s FDCA Decision May Breathe New Life into TCPA Spokeo Arguments*, CONSUMER FIN. SERVS. LEGAL UPDATE: BLOG (Feb. 20, 2018), <https://consumerfinancialserviceslaw.us/church-provides-no-sanctuary-sixth-circuits-fdca-decision-may-breathe-new-life-into-tcpa-spokeo-arguments/> (“The result has been languid opinions and squishy legal doctrine in the arena of standing, where only precision and intellectual rigor ought to prevail.”).

control the outcome of those proceedings, he was expressing a preference for Federal adjudication over administrative.⁸⁷ Perhaps the latter resonates more with his recent skepticism of the PTAB—and perhaps reflects early questioning as to why the Federal courts should defer to an administrative body in deciding what the law is or should be.

IV. JUSTICE GORSUCH'S FIRST-TERM SUPREME COURT OPINIONS

Some might view Justice Gorsuch penning three patent opinions in his first year as a Supreme Court Justice demonstrating a newfound interest in and attention to patent law,⁸⁸ an area in which he is (as demonstrated) not much experienced. Lobbyists and advocates hopeful for an ally on the bench have jumped to conclude Justice Gorsuch is everything from a patent protectionist⁸⁹ to “a patent attorney’s hero”⁹⁰ to a potential ally in the fight for 35 U.S.C. § 101 reform.⁹¹

Not so (at least, not yet). We see no change in his rhetoric or focus from his time as a 10th Circuit judge to his time as Supreme Court Justice. Rather, after reading many of his opinions in detail, both below and at the high court, it does not appear that Justice Gorsuch has concerned himself much with patent law *per se*—whether by choice or by chance. Instead, Justice Gorsuch appears most concerned about the administrative state, and what (we would imagine) he sees as the apparent weakening of judicial authority. It could be said, of course, that arguments tailored towards his strict constructionist and textualist views are more likely to hold sway; but any argument that expects him to come out on the side of one patent lobby or the other is unlikely to land, and misses the point—it is administrative law he is concerned with.

87. *Surefoot LC*, 531 F.3d at 1247 (“at least one commentator has suggested that the ‘real policy’ undergirding the case law cited by *Sure Foot ND* . . . has nothing to do with Article III but with a more practical concern ‘not to short-circuit the administrative tribunal that has already achieved jurisdiction over the issues’”).

88. *See supra* notes 2–3 and associated text.

89. Jenny Beth Martin, *Justice Gorsuch Drives Home Patent Protection*, WASH. TIMES (Dec. 6, 2017), <https://www.washingtontimes.com/news/2017/dec/6/justice-neil-gorsuch-patent-protection/>.

90. *Gorsuch—A Patent Attorney’s Hero*, MR. IP LAW: BLOG (Apr. 24, 2018), <https://www.mriplaw.com/blog/2018/4/24/gorsuch-a-patent-attorneys-hero>.

91. *See, e.g.*, Ben Brownlow, *Patent Owner Impact: Justice Gorsuch’s Strict Adherence to Textualism*, IP WIRE: BLOG (May 2, 2017), <http://ipwire.com/stories/patent-owner-impact-gorsuchs-adherence-strict-textualism/> (“The *Alice/Mayo* framework applied in the Supreme Court’s decision in *Alice Corp. Pty Ltd. v. CLS Bank Int’l* is exactly the type of judicially-manufactured law that textualists like Gorsuch warn against. In his view, the judiciary was never meant to interpret the law without a basis or support in the underlying statute”).

A. *Oil States v. Greene's Energy*⁹² (dissent)

In *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, the Supreme Court affirmed the U.S. Court of Appeals for the Federal Circuit in finding that *inter partes* review does not violate the separation of powers principles of Article III or the Seventh Amendment.⁹³ The dispute—whether issued patents are a “public right” or a “private right”—springs from a 2011 Chief Justice Roberts opinion that held that “Congress may not ‘withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law.’”⁹⁴ In that case, it held an administrative tribunal could not take from a common-law court a common-law counterclaim.

Here, the 7–2 opinion in which the Court noted that it had previously recognized that “the decision to grant a patent is a matter involving public rights—specifically, the grant of a public franchise.”⁹⁵ Thus, the Court held that as “*inter partes* review is simply a reconsideration of that grant, and Congress has permissibly reserved the PTO’s authority to conduct that reconsideration,” the PTO could reevaluate the patentability of claims without violating Article III.⁹⁶ The 7–2 majority opinion of the Court was written by Justice Thomas and joined by Justices Kennedy, Ginsburg, Breyer, Alito, Sotomayor and Kagan.

Oil States was Justice Gorsuch’s first direct judicial foray into patent law, and, joined by Chief Justice Roberts in dissent, he adopted a surprisingly hard line, 7–2, arguing that the Patent Offices’ longstanding use of post-grant proceedings (reissue, certificates of correction, and *ex parte* reexamination, among others) represented a retreat from judicial independence.⁹⁷ Largely ignoring the nuanced running dispute between a Justice Breyer-led coalition advocating for a liberal interpretation of *Stern v. Marshall*,⁹⁸ and a Chief Justice Roberts-led coalition calling for the opposite, Justice Gorsuch drew an surprisingly hard line, suggesting

92. *Oil States Energy Servs., LLC., v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1380–86 (2018) (Gorsuch, J., dissenting).

93. *Id.* at 1365.

94. *Stern v. Marshall*, 564 U.S. 462, 484 (2011).

95. *Oil States*, 138 S. Ct. at 1373.

96. *Id.*

97. It is worth noting that scholars Adam Mossoff and Jonathan Barnett, among others, have for years maintained a hard line on the, shall we say, “judicial nature” of granted patents. Here Professor Mossoff was rewarded for his long and stalwart line of argument with multiple citations to some of his many meticulously researched law review articles on the subject. See *Oil States*, 138 S. Ct. at 1382 (Gorsuch, J., dissenting) (citing Adam Mossoff, *Rethinking the Development of Patents: An Intellectual History 1550–1800*, 52 HASTINGS L.J. 1255 (2001)). Whether you agree or disagree with Mr. Mossoff, credit him with earning Justice Gorsuch’s ear and acknowledgement.

98. *Stern*, 564 U.S. at 494.

that the *McCormick* case,⁹⁹ coupled with the Constitution, means the administration cannot and should not revoke *any* granted patent rights.¹⁰⁰

The majority, authored by Justice Thomas, cited a long list of cases, law, and statutory schema.¹⁰¹ It took pains to distinguish *McCormick* and its ilk, noting that they “sought only to interpret statutes then in force,” namely, the 1870 Patent Act.¹⁰² Justice Gorsuch retorted: “this much is hard to see.”¹⁰³ Justice Gorsuch cited Justice Thomas’ words in a 2015 dissent against him, signaling that even those on the court he is most closely aligned with ideologically will not escape his hard line.

He notes that the “decision may not represent a rout,” but argued that “it at least signals a retreat from Article III’s guarantees,” and while it “may seem like an act of judicial restraint,” rather, “enforcing Article III isn’t about protecting judicial authority for its own sake.”¹⁰⁴ In this, we see his voice emerge—a Justice, in his opinion, must actively rule where they might otherwise demur to prevent what he sees as a broader erosion of judicial independence.

His approach is clear. For Justice Gorsuch, when it comes to threats of judicial erosion or what he sees as administrative overreach, it can be characterized superlatively as “damn the torpedoes, full speed ahead.”¹⁰⁵ While Gorsuch spends a few pages here discussing the purpose, history, and practice of patent law for the first time, it is not patents or patent law per se that he cares about—at least, up until now. Rather, it is his fear that the courts are giving up its judicial authority “in the name of efficient” governing.¹⁰⁶ His final line sums up the obvious inference: “Hamilton warned the judiciary to take ‘all possible care . . . to defend itself against’ intrusions by the other branches.”¹⁰⁷

99. *McCormick Harvesting Mach. Co. v. Aultman*, 169 U.S. 606 (1898).

100. One can sense, and could sense at oral argument, that the Chief Justice was disappointed in missing the opportunity to cement his *Stern* plurality here. *Stern*, 564 U.S. at 468–504. Indeed, the Breyer concurrence and the Thomas majority both note it, with the majority dodging it and the concurrence seeking to distinguish the case (and hence weaken it), and the dissent largely ignoring it. See generally *Oil States*, 138 S. Ct. at 1384 (Gorsuch, J., dissenting).

101. *Oil States*, 138 S. Ct. at 1370–75 (citing *United States v. Am. Bell Tel. Co.*, 128 U.S. 315, 370 (1888); *McCormick*, 169 U.S. at 609; and *Brown v. Duchesne*, 60 U.S. 183, 197 (1856)).

102. *Oil States*, 138 S. Ct. at 1384.

103. *Id.*

104. *Id.* at 1386.

105. To popularly (mis)paraphrase Admiral David Farragut at the Battle of Mobile Bay (“Damn the torpedoes! Four bells. Captain Drayton, go ahead! Jouett, full speed!”).

106. *Oil States*, 138 S. Ct. at 1386 (Gorsuch, J., dissenting).

107. *Id.* (citing THE FEDERALIST NO. 78, at 466 (Alexander Hamilton) (Clinton Rossiter ed., 1961)).

B. *SAS Institute Inc. v. Iancu*¹⁰⁸ (majority)

We might call *SAS* “Gorsuch’s revenge;” we might equally think of it a consolation prize, a 5–4 compromise opinion, or a plain-language statutory construction case; or we might see it as the moderating of tone that occurs when one goes from slim dissent to bare majority. The 5–4 opinion took a relatively straightforward statutory interpretation of the AIA and, disregarding the argued consequences thereof, adopted instead a plain facial reading of the statute, finding the agency’s interpretation contrary to that plain meaning.

In his opinion, Justice Gorsuch sidestepped *Chevron* deference as unnecessary to the analysis,¹⁰⁹ but nonetheless took some shots at it along the way. He also took some shots at the Justice Thomas-authored majority opinion in *Oil States*¹¹⁰—issued on the same day. Note that, in majority, Justice Gorsuch’s view of the IPR and the post-grant review process is much more balanced, nuanced, and even conciliatory. This shift suggests that either separate clerks wrote the opinions, or (much more likely), Justice Gorsuch had a freer hand in penning his dissent (nonbinding and joined by only one other) than he did in a bare majority opinion joined by fellow Justices Thomas, Alito, Roberts, and Kennedy.

He notes here that, despite the USPTO’s patent examination process:

Sometimes . . . bad patents slip through. Maybe the invention was not novel, or maybe it was obvious all along, and the patent owner should not enjoy the special privileges it has received. To remedy these sorts of problems, Congress has long permitted parties to challenge the validity of patent claims in federal court. More recently, Congress has supplemented litigation with various administrative remedies. The first of these was *ex parte* reexamination.¹¹¹

Justice Gorsuch adopted an interesting new taxonomy for post-grant challenges, calling *ex parte* review “inquisitorial,” comparing the IPR process to civil litigation, and suggesting the IPR process could be used to circumnavigate the courts, and dismissing some of the more complex arguments by the Government. In dismissing arguments otherwise, he notes, “We just don’t see it.”¹¹² In dicta he suggests *Chevron* may not have continued vitality, “[b]ut whether *Chevron* should

108. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

109. *Id.* at 1358 (citing *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984)).

110. *Oil States*, 138 S. Ct. at 1365.

111. *SAS*, 138 S. Ct. at 1353.

112. *Id.* at 1357 (citing *Chevron*, 467 U.S. at 837).

remain is a question we may leave for another day,” as it need not be invoked for this opinion.¹¹³

Other than the various practical consequences he ignores and the exegesis involved in his divining of the Congressional intent behind the statutory language,¹¹⁴ his reading is textual and straightforward. As his lower-court opinions reveal, he would rather the answer be straightforward than left to another's case-by-case discretion, particularly where the other does not wear robes. We would have preferred judicial restraint here, whether liberal or conservative. It will be fascinating to watch this Court develop.

The liberal justices, for their part, variously call his reading of the statute “wooden,” and conjure a parade of horrors. As to those horrors, color *us* skeptical—this is at most a somewhat obtuse procedural change, and should do little to affect outcomes, though it may make administration of some challenges more difficult. But as noted,¹¹⁵ the consequences of the Court's opinions are not the point for Gorsuch. His textualist views dominate his opinion. It is not that he is ignoring the complexity and nuance of the reasons behind certain laws, rather, he often seems unconvinced it should matter.

C. *WesternGeco LLC v. ION Geophysical Corp.*¹¹⁶ (dissent)

Extraterritoriality makes strange bedfellows. In *WesternGeco*, we see Justice Gorsuch join Justice Breyer in dissent, again against Justice Thomas.

In dissent, he finds that “A U.S. patent provides a lawful monopoly over the manufacture, use, and sale of an invention within this country only.”¹¹⁷ He finds that this reading presupposes that U.S. patent owners can charge rents for their patents that are infringed on foreign soil, and argues this conflicts with the plain language of 35 U.S.C. §§ 154(a)(1) and 271(a). He argues that, the “same acts outside the United States do not infringe a U.S. patent right.”¹¹⁸ Asking “[w]hat's the upshot for our case?,” he finds that “a U.S. patent does not protect its owner

113. *SAS*, 138 S. Ct. at 1358 (citing *Chevron*, 467 U.S. at 837).

114. One of the authors has spoken with many of those who participated in the debates and drafting of the bill, and they assure him that they simply did not think about whether institutions would be partial or otherwise. In our mind, both are possible interpretations to be implemented and neither is more or less inherently unfair. Both interpretations have their advantages and drawbacks. We think on some level Justice Gorsuch agrees, and this is more about the agency replacing its own judgment for what he sees is the statutes' judgment. In one respect, Justice Gorsuch is blending right in with his Supreme colleagues—his skepticism of patent specialists is likely to resonate with the rest of the Court.

115. *See supra* note 67 for further discussion on this point.

116. 138 S. Ct. 2129, 2139 (2018) (Gorsuch, J., dissenting).

117. *Id.*

118. *Id.*

from competition beyond our borders,”¹¹⁹ despite the harm from overseas competition. He engages in a parade of horribles, suggesting that our U.S. patent laws cannot extend beyond our border, for components or otherwise. The dissent can be summed up as endorsing a limited view of patent monopolies:

By failing to heed the plain text of the Patent Act and the lessons of our precedents, the Court ends up assuming that patent damages run (literally) to the ends of the earth. It allows U.S. patent owners to extend their patent monopolies far beyond anything Congress has authorized and shields them from foreign competition U.S. patents were never meant to reach.¹²⁰

*D. Upper Skagit Indian Tribe v Lundgren*¹²¹ (majority)

Finally, a largely unnoticed late-term Gorsuch majority opinion on tribal sovereign immunity, *Upper Skagit Indian Tribe* merits mention for its potential effect on recent PTAB decisions. In this case, a Native American tribe surveyed land purchased from the U.S. government (in attempting to, but having not yet reintegrated it into their reservation), and found an adjacent landowner’s fence included 1,300 feet of fence that was over their property line, and sought to remove the landowner; the landowner preemptively brought a quiet title action in U.S. court; the tribe invoked sovereign immunity to dismiss the suit.¹²² The case centered in part on whether *in rem* (versus *in personam*) suits are immune from sovereign immunity.

The case is important for both the PTAB and patent law, as Native American tribes and state universities have been claiming sovereign immunity exempts them from the IPR process, most notably and unsuccessfully in *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*¹²³ One of the arguments the Board judges made (albeit in concurrence) in finding that principles of Native American sovereign immunity did not apply was that because PTAB proceedings are *in rem*, sovereign immunity did not apply.¹²⁴

119. *Id.* at 2140.

120. *Id.* at 2143–44.

121. *Upper Skagit Indian Tribe v. Lundgren*, 138 S. Ct. 1649 (2018).

122. Nearly a century ago, one of the author’s (we’ll leave it to the reader to imagine which one) Arkansan great-grandfather initiated an action in trespass against an adjacent landowner for a similar offense, which seems to be a fairly common dispute in the American heartland.

123. *St. Regis Mohawk Tribe v. Mylan Pharms. Inc.*, No. IPR2016-01127, Papers 129, 130 (P.T.A.B. Feb. 23, 2018), *aff’d*, 896 F.3d 1322 (Fed. Cir. 2018) (request for en banc review pending as of this writing).

124. APJ Bisk and APJ Harlow wrote thus their identical concurrences at the PTAB in the University of Minnesota immunity Board decisions. *See LSI Corp. v. Regents of the Univ. of Minn.*, No. IPR2017-01068, Paper 18 at 11, Paper 19 at 11 (P.T.A.B. Dec. 19, 2017) (Harlow, APJ,

Justice Gorsuch, writing for the 7–2 majority and joined by the liberal justices, noted that the fee-patented lands of Native American land were *not* wholly exempt based in *in rem* jurisdiction, throwing into doubt what APJ Bisk and APJ Harlow argued.¹²⁵ In doing so, Justice Gorsuch ran afoul of what Justice Thomas called “hornbook law” on an alternative common-law exception—that immovable property is, and has been for centuries, immune from sovereign immunity.¹²⁶ That is, if the immovable property is on the land of the sovereign, the sovereign always has jurisdiction.

The case has obvious implications for PTAB tribal sovereign immunity. If Justice Gorsuch feels strongly that a more liberal application of sovereign immunity might be appropriately applied to patent law, the recent decision made by the Court of Appeals for the Federal Circuit could be under threat,¹²⁷ in that the inevitable petition for *certiorari* in *St. Regis* or one of the follow-on challenges related to sovereign immunity may catch his eye and receive a favorable vote to grant *certiorari* and an eventual hearing in conference; he certainly, after *Skagit*, will not be finding that the PTAB proceedings, as *in rem*, wholly avoid questions of sovereign immunity. That is all the more true after his recent hiring and installing of the first Supreme Court law clerk of Native American descent, Tobi Young, for the 2018–2019 term.¹²⁸

V. SUMMARY

*“Uncompromising men are easy to admire. He has courage, so does a dog. But it is exactly the ability to compromise that makes a man noble.”*¹²⁹

After a careful reading of Justice Gorsuch’s intellectual property opinions, we find no indication Justice Gorsuch had any strong interest in patents or patent law when he came to the Court. In his first year as a Supreme Court Justice, it

concurring); *Ericsson Inc. v. Regents of the Univ. of Minn.*, No. IPR2017-01186, Paper 14 at 13 (P.T.A.B. Dec. 19, 2017) (Bisk, APJ, concurring).

125. *Upper Skagit Indian Tribe*, 138 S. Ct. at 1653. APJ Bisk and APJ Harlow published identical concurring opinions in two separate IPR proceedings. See *LSI Corp. v. Regents of the Univ. of Minn.*, No. IPR2017-01068 (P.T.A.B. Dec. 19, 2017) (Harlow, APJ, concurring), *Ericsson Inc. v. Regents of the Univ. of Minn.*, No. IPR2017-01186 (P.T.A.B. Dec. 19, 2017) (Bisk, APJ, concurring); see also *St. Regis Mohawk Tribe v. Mylan Pharms. Inc.*, No. IPR2016-01127 (P.T.A.B. Feb. 23, 2018), *St. Regis Mohawk Tribe v. Mylan Pharms. Inc.*, No. 2018-1638 (Fed. Cir. July 20, 2018).

126. *Upper Skagit Indian Tribe*, 138 S. Ct. at 1657 (Thomas, J., dissenting).

127. *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322 (Fed. Cir. 2018).

128. See Press Release, Chicksaw Nation Media Relations Office, Chicksaw Woman Selected To Clerk For Supreme Court Justice Neil Gorsuch (Apr. 13, 2018), <https://chickasaw.net/News/Press-Releases/Release/Chickasaw-woman-selected-to-clerk-for-Supreme-Cour-47329.aspx>.

129. BRAVEHEART (20th Century Fox Home Entertainment 1995) (lines spoken by the leper Edward Bruce about the film’s Catholic hero, Sir William Wallace).

appears Justice Gorsuch penned his patent opinions in part because he found the patent cases some of the low-hanging fruit related to administrative law issues that have long concerned him. Rather, we find two consistent strains throughout his writings: one, a healthy skepticism for any Congressional or judicial interpretation beyond the plain language of the governing statute; and two, skepticism for any argument suggesting an administrative body may be better equipped to adjudicate a legal issue. In that respect, we admire his clarity of purpose.

We do worry, however, about any judge or justice who can so easily ignore the real-world consequences of their seemingly academic decisions.¹³⁰ But we suppose the inevitable tension between descriptivists and prescriptivists in English usage extends to judicial philosophy and, indeed, most fields—and boils down to a disagreement between hard rules versus adaptable standards, and—as a corollary—a disagreement between the respective metes and bounds between the Branches of Government.

In that way, Justice Gorsuch is consistent with Judge Gorsuch. During his tenure on the 10th Circuit, Judge Gorsuch did not have the opportunity to adjudicate many patent issues. This does not affect our opinion. Patents seem to have been, at least at first, a secondary concern for Justice Gorsuch. But it is a useful vehicle for him to address other concerns.¹³¹ We have already addressed how much his new opinions can mirror his old concerns. We have noted his wariness of administrative deference, in both *Chevron* and *Skidmore* we have noted his tendency towards simple interpretations of the law, consequences be damned; and we have noted his summarily dismissing arguments that might threaten judicial authority. Justice Gorsuch will form his own opinions about the language before him, sometimes despite the precedence, and he will make those opinions clear.

130. To be fair, it should be noted that Judge Gorsuch has cited policy discussions in some of his opinions discussed here. *See, e.g.*, *Russo v. Ballard Med. Prods.*, 550 F.3d 1004, 1021 (10th Cir. 2008). Such policy discussions, however, are most commonly used as a straw man to seemingly soften his rebuke of an interpretation or opinion he does not agree with. *See, e.g., id.* at 1021 (“We cannot agree”). Or to berate poorly written laws. *See, e.g., id.* at 1021 (“While perhaps a plausible position as a policy matter, the problem with Ballard’s argument is that the Utah legislature has rejected it.”).

131. *Compare Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA Inc.*, OYEZ, <https://www.oyez.org/cases/2018/17-1229> (last visited Dec 31, 2018) (deciding whether “on-sale” under AIA law includes secret sales) with *Oil States Energy Services LLC v. Greene’s Energy Group, LLC*, OYEZ, <https://www.oyez.org/cases/2017/16-712> (last visited Dec 31, 2018) (deciding whether an administrative law process can deprive patent holders of their property rights without providing them a jury and an Article III forum) and *SAS Institute Inc. v. Iancu*, OYEZ, <https://www.oyez.org/cases/2017/16-969> (last visited Dec 31, 2018). It should be noted that the case in *Helsinn Healthcare* rests solely on the statutory interpretation of the language in the AIA and is unlikely to have any effect on Administrative law, thus it did not surprise the Authors of this paper that J. Gorsuch chose to interject only once during the oral arguments, on a question regarding the Office’s interpretation of the language. This is in stark contrast to the forty-one and twenty-eight times he spoke up during the *Oil States* and *SAS* oral arguments respectively.

In that respect, we point readers to the 8–1 *Sveen v. Melin*,¹³² a seemingly easy Supreme Court case where Justice Gorsuch was the lone dissenter. In it, 100 years of precedent on the Contracts Clause seemingly controlled. Justice Gorsuch, for his part, was not swayed by the opinions of precedent, nor was he swayed by practicality or nuance. We leave it up to readers to decide if that is judicial activism, judicial restraint, radical originalism, or something new we have not yet seen in the Court.

However, after a year of opinions, we now know more about where Justice Gorsuch stands on that spectrum. We are largely hopeful that the Justice and his colleagues will continue to strive for the right decisions (on patents, at least) for our polity, while engaging in a healthy respect for our rule of law. After all, “shall not the judge of all the earth do right?”¹³³

VI. CONCLUSION

Thus, we return to and reform our initial thesis. Justice Gorsuch has, in fact, cared about patents in his first term, but only because patent law happens to be a useful springboard to addressing his greater concerns regarding administrative law and judicial authority. Put another way, any argument about patents, patent law, or the role of the Patent Office made before Justice Gorsuch not addressing the role of the judiciary versus the administrative state was unlikely to hold sway, and may have been summarily dismissed in his opinions. It was in appealing to his hostility to longstanding principles of administrative law that one could find a receptive ear, and pen. Now, with the hiring of clerks specializing in patent law and with a growing body of experience ruling on issues before him at the high Court, Justice Gorsuch seems to be betraying a desire to “learn fast” the issues undergirding some of the patent law disputes he confronted in his first term. So whether he *was* interested in patents might be a moot point today; but the fact that he is *now* seemingly concerned with patent law is best informed as being sparked by, rooted in, ongoing administrative law concerns.

132. *Sveen v. Melin*, 138 S. Ct. 1815 (2018).

133. *Genesis* 18:25 (King James); *see also* ALAN MOORE, *WATCHMEN* CHAPTER III: THE JUDGE OF ALL THE EARTH (1985).