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Caroline M. Turner
Columbia Law School

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A PATH TOWARD AN INCREASED ROLE FOR THE UNITED STATES IN PATENT INFRINGEMENT LITIGATION

CAROLINE M. TURNER*

A number of major statutory schemes implicate federal interests but do not provide for explicit authority for the United States to bring lawsuits for damages or to obtain injunctive relief. The patent statutes provide that the patentee may sue in the case of infringement, and court decisions have extended that right to certain licensees. Accordingly, the United States has participated in cases in which it is not a co-patentee or licensee only as an amicus. Yet the government arguably has an interest in intervening in or instituting, as a co-plaintiff, infringement cases involving certain patents. Recent scholarship has renewed attention on whether, and to what extent, the United States may broadly assert a cause of action that is implied from a statute or is based on an inherent, non-statutory authority. The Supreme Court's current intolerance of rights implied from statutes in cases brought by private litigants means that the government must rely on a different theory in order to potentially succeed in asserting a cause of action. Because the United States has frequently argued that a unique standard for implying a right to sue from a statute should apply when the government is a plaintiff, this article focuses on the most-invoked decision, Wyandotte Transportation Company v. United States. It concludes that Wyandotte is a fragile cornerstone for actions beyond suits to recover pecuniary loss or remedy damage to government property. The article then turns to a little-understood but broad authority that is not dependent on implication from a statute but rather rests on sovereignty and the effectuation of important federal interests. It suggests that this power, which has been referenced in several Supreme Court decisions and argued in several contexts, should be examined anew as a basis for claims by the United States in cases involving patent infringement.

INTRODUCTION

“The United States has a strong interest, encompassing a variety of perspectives, in the scope of judicial remedies for patent infringe-

ment.”¹ The Solicitor General files amicus briefs in the Federal Circuit and the Supreme Court in patent cases, sometimes as a result of a request for views² and in others at the government’s own initiative.³ These briefs are submitted as a result of extensive coordination with the U.S. Patent and Trademark Office (PTO) and numerous other agencies⁴ and have often significantly influenced the courts⁵ on a variety of issues, including infringement standards.⁶ In addition, the Commercial Litigation Branch, Intellectual Property Section of the Civil Division of the U.S. Department of Justice (DOJ) represents the United States when the government is a patent holder or licensee, both offensively and defensively.⁷

But the government does not bring infringement actions as a co-plaintiff or intervenor in cases brought by owners of patents when the United States is not a co-owner or licensee (hereinafter, a “private patent”). Although there are apparently no reported instances in which the United States has sought to file or join such a lawsuit as a co-plaintiff in a district court when it was not an indispensable party, it did unsuccessfully seek to bring an action under an implied right theory to secure invalidation of a patent.⁸ The reason why such suits have not been brought or joined seems simple enough: the patent statutes specifically provide that the patentee may bring an action to redress an infringement.⁹ The sparse legislative history shows no indication that

* J.D. candidate 2016, Columbia Law School.

1. Brief for the United States as Amicus Curiae Supporting Respondent at 1, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (No. 05-130).

2. See, e.g., Brief for the United States as Amicus Curiae, *Sony Computer Entertainment America LLC v. 1st Media, LLC*, 134 S. Ct. 418 (2013) (No. 12-1086). For a discussion of the practice, see J. Jonas Anderson, *Patent Dialogue*, 92 N.C.L. REV. 1049, 1080 (2014).

3. See, e.g., Brief for the United States as Amicus Curiae Supporting Neither Party, *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, No. 13-854 (U.S. June 18, 2014), 2014 WL 2769084; Brief for the United States as Amicus Curiae Supporting Petitioner, *Octane Fitness, LLC v. Icon Health & Fitness, Inc.*, 134 S. Ct. 1749 (2013) (No. 12-1184).

4. See Paul R. Gugliuzza, *Saving the Federal Circuit*, 13 CHI.-KENT J. INTEL. PROP. 350, 358 (2014) (“[T]he Solicitor General does not act alone when formulating the position of the United States.”); Arti K. Rai, *Competing With the “Patent Court”: A Newly Robust Ecosystem*, 13 CHI.-KENT J. INTEL. PROP. 386, 390 (2014) (“[T]he Solicitor General represents not simply the PTO, but also a number of other agencies with interests in patent questions.”).

5. See, e.g., Paul R. Gugliuzza, *IP Injury and the Institutions of Patent Law*, 98 IOWA L. REV. 747, 766 (2013) (“enormous influence”); John F. Duffy, *The Federal Circuit in the Shadow of the Solicitor General*, 78 GEO. WASH. L. REV. 518, 540-44 (2010) (compiling statistics).

6. See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731-41 (2002) (adopting view advanced by Solicitor General).

7. Commercial Litigation Branch, Intellectual Property Section, U.S. Dep’t of Justice, <http://www.justice.gov/civil/intellectual-property-section> (last visited Mar. 17, 2015).

8. *United States v. FMC Corp.*, 717 F.2d 775, 786 (3d Cir. 1983).

9. 35 U.S.C. § 281 (2012). Accordingly, the patentee is, as a prudential requirement, an indispensable party in a lawsuit alleging infringement of the patent. See, e.g., *Indep. Wireless Tel. Co. v. Radio Corp. of Am.*, 269 U.S. 459, 461 (1926). A licensee may sue if it holds “all substantial

Congress, in any iteration of the statutes, considered whether the United States should have a right to bring actions as a co-plaintiff, much less endorsed such claims.¹⁰ Any such lawsuit would, then, be dependent upon an argument that the government has either an implied statutory or an inherent right.

The established orthodoxy, in the absence of any pronouncements on the desirability of such actions,¹¹ is undoubtedly that such claims are either not in furtherance of an important federal objective or would surely be unsuccessful, or both. This article argues that these assumptions are questionable and ought to be revisited. While the path to judicial recognition of a cause of action to address infringements of private party patents is not obstacle-free, the journey is relevant to the furtherance of strategic technological and innovation objectives.¹² This article does not seek to define with specificity the types or categories of patents that the United States, acting through the Civil Division,¹³

rights” to the patent. *Textile Prods., Inc. v. Mead Corp.*, 134 F.3d 1481, 1484 (Fed. Cir. 1998). When a federal agency patent owner grants either an exclusive or a non-exclusive license, it may under the Bayh-Dole Act, 35 U.S.C. § 207(a)(2) (2012), in its discretion authorize the licensee to bring an infringement action on its own behalf “without joining the United States as a party.” 35 C.F.R. § 404.5(b)(2). In such cases, courts refuse to require the United States to participate in the litigation as an involuntary plaintiff. *Nutrition 21 v. The United States*, 930 F.2d 862, 867 (Fed. Cir. 1991). This article addresses instances in which the United States is not a patent owner but contemplates either bringing an infringement action as a co-plaintiff with the owner or “all rights” licensee or joining an existing suit as an intervenor-plaintiff. Encompassed within its scope are infringements of patents resulting from federally funded research that, pursuant to the Bayh-Dole Act, are issued to nonprofit institutions, universities, and small businesses when the non-governmental entity has elected to retain title and otherwise complied with the Act’s requirements. This article does not, however, submit that federal research funding should be the sole, or even the predominant, factor that the Justice Department should consider in making discretionary determinations regarding participation in infringement litigation. *See infra* note 14.

10. *See, e.g.*, P.J. Federico, *Commentary on the New Patent Act*, 75 J. PAT. & TRADEMARK OFF. SOC’Y 161, 215 (1993) (only change in 1952 Act was to update language to refer to “civil action” rather than “action on the case” and to note that the change did not affect right to jury trial). The legislative history discussed in *United States v. FMC Corp.*, 717 F.2d 775, 776 (3d Cir. 1983), *see infra* note 85, is not applicable to this issue, and nothing in the history of any of the patent statutes addresses the role of the United States in private patent enforcement actions.

11. The DOJ Task Force on Intellectual Property, during the George W. Bush Administration, made no reference to such suits in a 2006 “Progress Report”, which was apparently the last of its kind. *See* USDOJ, PROGRESS REPORT OF THE DEPARTMENT OF JUSTICE’S TASK FORCE ON INTELLECTUAL PROPERTY (2006), available at <http://www.justice.gov/sites/default/files/opa/legacy/2006/06/22/ipreport61906.pdf>.

12. This article is agnostic about the value of patents in fostering innovation. *See, e.g.*, Tim Wu, *Intellectual Property, Innovation, and Decentralized Decisions*, 92 VA. L. REV. 123, 127–31 (2006) (questioning assumption). Most commentators agree that actions for infringement or to address the validity of issued patents are important components of a desirable system. *See generally* Michael J. Burstein, *Rules for Patents*, 52 WM. & MARY L. REV. 1747, 1747 (2011) (noting that most suggestions for policy reform assume “that patent policy is best made through case-by-case adjudication of the validity of individual patents.”).

13. The PTO does not have independent litigating authority. Accordingly, lawsuits would be brought by the Justice Department, most likely by the Civil Division. *See* notes 7, *supra*, and 114, *infra*. As to why “[c]entralized control of litigation in the DOJ creates political accountability” and

should contemplate seeking to protect in infringement litigation.¹⁴ It does, however, operate from the presumption that there is a sound argument that the government has a stake in the strength and durability of certain patents, including as an example “green technology” patents that result from initiatives such as the National Innovation Strategy.¹⁵ While administration and congressional priorities can change, a government that encouraged expedited processing of patent applications for green technologies¹⁶ and which otherwise acknowledged through subsidies and tax credits the value of supporting startups in internationally competitive clean energy sectors¹⁷ should likewise consider supporting a patentee in an infringement case.¹⁸ And participation as a co-plaintiff is, quite clearly, preferable to amicus or even so-called “litigating amicus” status.¹⁹

concerns about over enforcement are overstated, see Seth Davis, *Implied Public Rights of Action*, 114 COLUM. L. REV. 1, 55 (2014).

14. The case of a start-up green technology patentee, *infra*, is offered as an example, not as a limitation. It does suggest that there are instances, assumedly limited in number, in which the United States might consider active participation in infringement litigation, but this article purposefully does not attempt to identify categorically when the government should (or ought not) do so. The example concerns a situation in which the government has taken such an active role in promoting patent applications that it arguably also has an interest in the enforcement of the issued patent. Importantly, these are not the only kinds of patents that the United States might decide that it has an interest in enforcing, and it may properly determine in its discretion not to attempt to enforce certain private patents even if they result from federal funding or an expedited issuance process.

15. Nat'l Econ. Council, *A Strategy for American Innovation: Driving Towards Sustainable Growth and Quality Jobs* (2009), available at <http://www.whitehouse.gov/administration/eop/nec/StrategyforAmericanInnovation/>.

16. See Patrick Gattari, *The Role of Patent Law in Incentivizing Green Technology*, 11 NW. J. TECH. & INTELL. PROP. 41, 42 (2013) (describing PTO fast-track program, which is no longer accepting new applications but continues to examine previously filed submissions out of order).

17. See generally Eric L. Lane, *Building the Global Green Patent Highway: A Proposal for International Harmonization of Green Technology Fast Track Programs*, 27 BERKELEY TECH. L.J. 1119, 1136-45 (2012) (describing processes in numerous countries, including the United States, to promote green technologies through patents).

18. The high cost of patent litigation, see, e.g., Jon E. Wright, *Willful Patent Infringement and Enhanced Damages—Evolution and Analysis*, 10 GEO. MASON L. REV. 97, 97 (2001) (“enormously expensive and often swamp balance sheets”), suggests that many green technology companies, which are often start-ups with “negative cash flow,” Gattari, *supra* note 16 at 43, may hesitate to defend their patents, or seek settlements that devalue their worth. Yet “[f]or small firms... patent rights might be the only effective means to obtain a return on investments in research and development.” John M. Golden, *Principles for Patent Remedies*, 88 TEX. L. REV. 505, 545 (2010). When patent infringement is unaddressed, holders may have more difficulty obtaining private investment. See, e.g., Clarisa Long, *Patent Signals*, 69 U. CHI. L. REV. 625, 653 (2002) (“Among venture capitalists, both the quantity and quality of patents have long been factors that are taken into consideration when deciding whether to invest in a company, particularly in its early stages.”).

19. As Jeremy Bock has recognized, litigating amicus status has rarely been sought and has significant limitations. Jeremy W. Bock, *Neutral Litigants in Patent Cases*, 15 N.C. J. L. & TECH. 233, 285 (2014) (“Unlike an intervenor, however, a litigating amicus is unable to appeal from any judgments, and may be dismissed at any time if the court decides that the amicus is no longer necessary. As with a regular amicus, the decision to allow litigating amicus participation is committed to the discretion of the district court.”). It has traditionally been utilized only in civil rights

This article focuses hereafter on how the United States might argue that it has a cause of action in a private patent infringement case. Part I describes the Supreme Court's current intolerance of rights implied from statutes in cases brought by private litigants. It illustrates why the government must rely on a different theory in order to potentially succeed in a private patent case. Because the United States has frequently argued that a unique standard for implying a right to sue from a statute should apply when the government is a plaintiff, the Part focuses on the most-referenced decision, *Wyandotte Transportation Company v. United States*.²⁰ It concludes that *Wyandotte* is a fragile cornerstone for actions beyond suits to recover pecuniary loss or remedy damage to government property. Part II discusses a little-invoked but broad authority that is not dependent on implication from a statute but rather rests on sovereignty and the effectuation of important federal interests. It suggests that this power, which has been referenced in several Supreme Court decisions and argued in several contexts, should be examined as a basis for claims to enforce a private patent. The last Part identifies several jurisdictional and case management issues that are likely to arise if the United States seeks to file an action or becomes a co-plaintiff or intervenor as a matter of right.

I. IS THERE A DISTINCT PUBLIC RIGHT OF ACTION DOCTRINE? IF SO, DOES IT SUPPORT AN IMPLIED RIGHT CLAIM TO ENFORCE A PATENT?

A. *Alexander v. Sandoval* and its Effect on Private Implied Right Claims

In *Alexander v. Sandoval*,²¹ the Supreme Court, in a case involving Title VI of the Civil Rights Act of 1964, rejected the *Cort v. Ash*²² factors

cases. *See, e.g.,* *Hoptowitz v. Ray*, 682 F.2d 1237, 1260 (9th Cir. 1982) (prisoners rights). In gingerly introducing district courts to the presence of the United States as a party in private patent cases, the Civil Division might be tempted to seek only permissive intervention under Rule 24(b). Bock has suggested that the PTO might be able to intervene permissively for the specific purpose of addressing a patent validity issue, or the Justice Department to opine on an antitrust question. Bock, *supra*, at 283. But the observation did not contemplate the possibility of an implied or inherent cause of action, and therefore must have assumed that intervention as of right by the United States in a private patent case was impossible. Moreover, it animates a disadvantage of permissive intervention. "The district court's discretion . . . under Rule 24(b), to grant or deny an application for permissive intervention includes discretion to limit intervention to particular issues." *Dep't of Fair Employment & Hous. v. Lucent Technologies, Inc.*, 642 F.3d 728, 741 (9th Cir. 2011); *Van Hoomissen v. Xerox Corp.*, 497 F.2d 180, 181 (9th Cir. 1974). Depending on how courts respond, permissive intervention may not be preferable to amicus, or even "litigating" amicus, status. This article proposes that the Justice Department seek intervention as of right, or alternatively, permissive intervention if intervention of right is denied. *See* Part III, *infra*.

20. *Wyandotte Transportation Company v. United States*, 389 U.S. 191, 191 (1967).

21. *Alexander v. Sandoval*, 532 U.S. 275 (2001).

and looked only to whether Congress intended to create a private right of action. Justice Scalia announced that the “right must come, if at all, from the independent force of [the statute].”²³ *Sandoval* mandates that the only tools to use to determine the answer are the text and structure of the laws. Justice Scalia shunned legislative history, or speculation as to what Congress intended. The impact of *Sandoval* cannot be understated. Only the clearest expression of congressional intent will now suffice. Moreover, the Court essentially disregards inquiry into that intent. Subsequent opinions have, virtually without exception, rejected efforts to either acknowledge or expand private implied rights. Courts have refused to imply causes of action under ostensibly pro-consumer statutes and regulations such as the Protecting Tenants at Foreclosure Act,²⁴ the Home Affordable Mortgage Program,²⁵ the Video Privacy Protection Act,²⁶ the Air Carrier Access Act,²⁷ and other measures.²⁸

B. The Demise of the Private Right of Action has Significant Implications for Potential Claims by the United States Regarding the Infringement of a Private Patent

Unless courts are willing to accept the proposition that an implied right of action claim by the government should be examined in a different way, with a different standard applied, implied right suits by the United States to seek injunctive relief or damages for private patent infringement will not succeed. As noted, the patent legislation makes no mention of the United States as an enforcer of private patents, but rather specifies that the patent holder may bring an action. And there is no legislative history to support the position that Congress even en-

22. *Cort v. Ash*, 422 U.S. 66 (1975).

23. *Alexander*, 532 U.S. at 286. *See also Id.* at 288–89 (“It is immediately clear that the ‘rights-creating’ language so critical to the Court’s analysis in *Cannon* of § 601 is completely absent from § 602. False Far from displaying congressional intent to create new rights, § 602 limits agencies to ‘effectuating’ rights already created by § 601.”) (citations omitted).

24. *Mik v. Federal Home Loan Mortgage Corporation*, 743 F.3d 149, 166 (6th Cir. 2014).

25. *Miller v. Chase Home Finance, LLC*, 677 F.3d 1113, 1116 (11th Cir. 2012); *Wigod v. Wells Fargo Bank, N.A.*, 673 F.3d 547, 554 (7th Cir. 2012).

26. *Sterk v. Redbox Automated Retail, LLC*, 672 F.3d 535, 538–39 (7th Cir. 2012) (no right of action for retention claims pursuant to Act).

27. *Lopez v. Jet Blue Airways*, 662 F.3d 593, 597 (2d Cir. 2011); *Boswell v. Skywest Airlines, Inc.*, 361 F.3d 1263, 1270 (10th Cir. 2004); *Love v. Delta Air Lines*, 310 F.3d 1347, 1359 (11th Cir. 2002).

28. *See, e.g., Stew Farm, Ltd. v. Natural Resources Conservation Serv.*, 767 F.3d 554, 565 (6th Cir. 2014) (Food Security Act); *El Paso Natural Gas Co. v. U.S.*, 750 F.3d 863, 890 (D.C. Cir. 2014) (Indian Dump Cleanup Act); *Clear Sky Car Wash LLC v. City of Chesapeake, Va.*, 743 F.3d 438, 444 (4th Cir. 2014) (Uniform Relocation Assistance and Real Property Acquisition Policies Act).

visioned, much less endorsed, such actions. Whether such a different doctrine exists, and how it has been and might be applied, is discussed below. But the point is that it is now essential that public rights of action be viewed differently, both generally and for patent lawsuits. As Seth Davis notes, application of a *Sandoval* approach to public litigation would in most cases “bar a public right to sue even when a government seeks to vindicate a ‘private right’ against pecuniary loss.”²⁹ Even if courts historically have been willing, at least in some cases, to give a more liberal scope to public rights of action, the Court’s private right retrenchment signals an unwillingness to endorse “independent federal court lawmaking.”³⁰

The reluctance to embrace new rights of action and to limit remedies are both reflective of “the recent trend against private enforcement,”³¹ despite the notion in *Franklin v. Gwinnett County Public Schools*³² that the two are analytically distinct.³³ The United States has, on several occasions, pointed to *Wyandotte* as endorsing a separate, more liberal approach to public implied rights and as justifying a finding that an implied right exists in various contexts.³⁴ But, as we shall see, the background of the decision, the Court’s language, subsequent judicial interpretations, and limited application in practice by the government demonstrate its short reach.

C. Wyandotte as a Potential Basis for Public Implied Right Claims

If any modern Supreme Court decision supports the proposition that public implied rights of action are distinct from private, *Cort/Sandoval* rights, and may potentially have broad applicability, it is *Wyandotte*. *Wyandotte* has considerable initial appeal for potential suits by the United States to enforce a private patent, as it stands for the proposition that the United States has an implied right of action in the absence of clearly contrary congressional intent.³⁵

29. Davis, *supra* note 13, at 33.

30. Gillian E. Metzger, *Ordinary Administrative Law as Constitutional Common Law*, 110 COLUM. L. REV. 479, 506 (2010) (“the decline of implied rights of action” is symptomatic of “the Court’s increased resistance to independent federal court lawmaking”). See also Arthur R. Miller, *From Conley to Twombly to Iqbal: A Double Play on the Federal Rules of Civil Procedure*, 60 DUKE L.J. 1, 10 (2010).

31. Davis, *supra* note 13, at 12.

32. *Franklin v. Gwinnett County Public Schools*, 503 U.S. 60 (1992).

33. Davis, *supra* note 13, at 12 n.49 (“[j]udicial retrenchment from implied private rights of action is an example of the Court’s apparent ‘hostility’ to private enforcement.”).

34. See, e.g., Brief of United States as Defendant/Appellee, In re American River Transportation Company v. United States, No. 14-1867 (8th Cir. July 16, 2014), 2014 WL 3703299.

35. *Wyandotte Transportation Company v. United States*, 389 U.S. 191, 200 (1967).

Before *Wyandotte*, courts “had consistently held that owners of sunken vessels had an absolute right of abandonment, and that following abandonment, the government had no *in personam* rights against the owners of the vessel to recover expenses incurred in raising a sunken vessel which posed a threat to navigation.”³⁶ The Wreck Act was enacted as part of the Rivers and Harbors Act (RHA) of 1899. It was largely in response to *Willamette Iron Bridge Co. v. Hatch*,³⁷ which had held that the common law did not address the abandonment of vessels or the creation of obstructions in navigable waters.³⁸ The applicable provisions were Section 10, which prohibited “[t]he creation of any obstruction not affirmatively authorized by Congress to the navigable capacity of any of the waters of the United States”, Section 12, which made a violation of Section 10 a criminal offense, and Section 15, which provided, in pertinent part, that “it shall not be lawful to tie up or anchor vessels or other craft in navigable channels in such a manner as to prevent or obstruct the passage of other vessels or craft; or to voluntarily or carelessly sink, or permit to cause to be sunk, vessels or other craft in navigable channels.” The statute did not, however, expressly provide for the recovery by the United States of the costs incurred in raising or removing vessels.

The Court had previously interpreted Section 10 in two cases, *Sanitary District of Chicago v. United States*³⁹ and *United States v. Republic Steel Company*.⁴⁰ *Wyandotte* was a logical extension of the Court’s deci-

36. Frederic E. Cann, *Interaction of the Limitation of Liability Act and the Wreck Act: Who can Limit Liability for the Government’s Wreck Removal Expenses?*, 30 U. FLA. L. REV. 560, 560 (1978).

37. *Willamette Iron Bridge Co. v. Hatch*, 125 U.S. 1 (1888).

38. See Cann, *supra* note 36, at 563.

39. *Sanitary District of Chicago v. United States*, 266 U.S. 405, 425–26 (1925).

40. *United States v. Republic Steel Company*, 362 U.S. 482, 492 (1960). In *Sanitary District*, the Court ruled that the United States could obtain an injunction preventing the Sanitary District of Chicago from increasing its water intake from the Great Lakes by discharging sewage into the Mississippi River watershed. Because the activity was inconsistent with the statute’s prohibition of modifications to the capacity of a lake, and thereby affected navigable waters, an injunction was appropriate. The Court’s reasoning was, in part, based on the government’s obligation to comply with a treaty. *Sanitary*, 266 U.S. at 425. Significantly, the Court stressed that “[t]he Attorney General by virtue of his office may bring this proceeding and no statute is necessary to authorize the suit.” *Id.* at 426. In *Republic Steel*, the Court addressed a situation in which a polluter’s industrial wastes discharged into the Calumet River had reduced the depth of the navigable channel. On several occasions, the Army Corps of Engineers had dredged the channel. The Court concluded that the government could seek an injunction requiring that Republic maintain the channel depth to assure navigation. Placing emphasis on the statutory term “navigable capacity,” the Court reasoned that the United States had “an interest to protect or defend.” *Republic Steel*, 362 U.S. at 492. It noted that “Congress has legislated and made its purpose clear; it has provided enough federal law [through section 10] from which appropriate remedies may be fashioned even though they rest on inferences.” *Id.* The Court had also previously held that the United States could sue in tort in the event it sustained a pecuniary loss. *United States v. Standard Oil Co.*, 332 U.S. 301, 315 n.22 (1947) (“[i]t has not been necessary for Congress to pass statutes imposing civil liability in

sions in *Sanitary District* and *Republic Steel*. Most significantly for present purposes, the Court stated that “the general rule [is] that the United States may sue to protect its interests.”⁴¹ Moreover, the rule “is not necessarily inapplicable when the particular governmental interest sought to be protected is expressed in a statute carrying criminal penalties for its violation.”⁴² Concluding that “[t]he inadequacy of the criminal penalties explicitly provided for” is “beyond dispute”,⁴³ it found that prison terms are “hardly a satisfactory remedy for the pecuniary injury which the negligent shipowner may inflict upon the sovereign.”⁴⁴ Therefore, although unlike in *Republic Steel* the Court did not base its opinion on Section 10, it nonetheless concluded that “the principles of *Republic Steel* apply, by analogy, to the issues now before us.”⁴⁵ It gave no express indication that it intended to examine public and private rights of action under the same standard. Instead, it reasoned that the private rights cases lent support to the conclusion that the United States should have an implied right.⁴⁶

The contemporaneous response of many lower courts was to conflate public and private rights, and in some cases to either seek to diminish the scope of what was perceived to be a *Borak-Wyandotte* test for private rights or to ignore it completely. For example, in *Breitweiser v. KMS Industries, Inc.*,⁴⁷ the court determined that a private right should be implied only when the statute either does not provide for a remedy at all or the remedy is “grossly inadequate.”⁴⁸ Conflation continued in subsequent decisions such as *United States v. St. Bernard Par-*

those situations where it has been understood since the day of the common law that the sovereign is protected from tortious interference.”).

41. *Wyandotte Transportation Company v. United States*, 389 U.S. 191, 201 (1967).

42. *Id.* at 201–02.

43. *Id.* at 202.

44. *Id.*

45. *Id.* at 203.

46. On the other hand, the Court did not expressly say that the standards are different. There is a cogent argument that the only thing the Court was doing was to accept and incorporate the previously decided private right cases and thereby apply what was then a relatively lenient approach, under *J.I. Case Co. v. Borak*, 377 U.S. 426, 426 (1964), to both implied causes of action and remedies. It is perhaps significant that the Court did not describe *Sanitary District* or *Republic Steel* as establishing a standard unique to claims by the United States. Indeed, the opinion stressed the need for treating the United States in the same manner as private party. If the Court meant to incorporate and apply the private right standard, the present-day reach of *Wyandotte* is limited indeed. Because of the change in approach to private cases, it is arguable that *Wyandotte* is not only inconsistent with the Court’s current approach to implied rights, its liberal view as to implied remedies generally must now be rejected as well.

47. *Breitweiser v. KMS Industries, Inc.*, 467 F.2d 1391 (5th Cir. 1972), *cert. denied*, *Breitweiser v. KMS Industries, Inc.*, 410 U.S. 969 (1973).

48. *Id.* at 1392–93.

ish⁴⁹ and *United States v. Gilbert*.⁵⁰ A number of courts, while acknowledging *Wyandotte*, concluded that ordinary rules of statutory construction should nonetheless limit or deny implied remedies.⁵¹ And, not surprisingly, courts, again referencing *Wyandotte* as part of the private implied right canon, denied implied right claims by emphasizing legislative intent.⁵² Still others, also citing *Wyandotte*, denied implied right claims when the statute in question set forth an alternative remedy.⁵³

The Supreme Court itself has subsequently cited *Wyandotte* only once, in *Cannon v. University of Chicago*.⁵⁴ To the extent that *Wyandotte* has been specifically cited by lower courts as affirming or supporting a right of action by the United States, it has almost always been in the context of a restitution remedy or to protect the government's posses-

49. *United States v. St. Bernard Parish*, 756 F.2d 1116, 1122-23 (5th Cir. 1985) (using private right of action doctrine in examining whether United States had action under the National Flood Insurance Act to seek recovery for flood cleanup costs).

50. *United States v. Gilbert*, 244 F.3d 888, 913 (11th Cir. 2001) (examining whether the United States had an implied private right of action to seek an order requiring a defendant to file a third-party forfeiture claim in a RICO case).

51. See, e.g., *Hollaway v. Bristol-Meyers-Corp.*, 485 F.2d 986, 988-89, 1002 (D.C. Cir. 1973); *Chaves v. Freshplet Food, Inc.*, 456 F.2d 890, 893-95 (10th Cir.), cert. denied, 409 U.S. 1042 (1972); *Western Colo. Fruit Growers Ass'n v. Marshall*, 473 F. Supp. 693, 697 (D. Colo. 1979) (denying implied counterclaim for damages to recover costs incurred in the transport and housing of seasonal laborers).

52. See, e.g., *Acevedo v. Nassau County*, 500 F.2d 1078, 1083-84 (2d Cir. 1974); *Jordan v. Montgomery Ward & Co.*, 442 F.2d 78, 81 (8th Cir. 1971).

53. See, e.g., *Rogers v. Ray Gardner Flying Serv., Inc.* 435 F.2d 1389, 1393 (5th Cir. 1970).

54. *Cannon v. University of Chicago*, 441 U.S. 677 (1979). The majority opinion, in applying the *Cort* test, referenced *Wyandotte* and *Republic Steel* and noted that “[a]nalogously, the Court has implied causes of action in favor of the United States where the statute creates a duty in favor of the public at large.” *Id.* at 693. The language suggests that private implied rights may be subject to a different standard, but does not describe the breadth of a public implied right doctrine or even hint that *Wyandotte* has application beyond its recovery of costs context. A more extensive discussion occurred in Justice Powell’s dissent, which ironically was the pivot toward a highly restrictive view of implied rights, in which he declared his view that “[w]hen Congress chooses not to provide a private civil remedy, federal courts should not assume the legislative role of creating such a remedy and thereby enlarge their jurisdiction.” *Id.* at 730-31 (Powell, J., dissenting). The United States has, particularly in the RHA cost recovery context, referenced the dissent as supporting its argument that public implied rights of action should be viewed differently. See Brief of United States as Defendant/Appellee, In re American River Transp. Co. v. United States, No. 14-1867 (8th Cir. July 16, 2014), 2104 WL 3703299. The language relied upon is Justice Powell’s statement that “the implication of civil remedies in favor of the Government, see *Wyandotte Transp. Co. v. United States*, []; *United States v. Republic Steel Corp.*, [] [is] significantly different from the implication of a private remedy from a federal statute.” *Cannon*, 441 U.S. at 743 n.3 (Powell, J., dissenting). But that language, which appears in a footnote, is followed by a sentence that makes clear that the reference is to the extrapolation of a civil penalty from a criminal statute, rather than endorsement of a broad public right of action. In *Wyandotte* and *Republic Steel*, the Court was willing to find a right of action to seek a civil penalty under a statute that references criminal enforcement. *Id.* Thus, the “significant” difference referenced by Powell most likely was to civil penalties in a specific and narrow context. It is, indeed, significant that no court or commentator has specifically referenced the Powell dissent in support of the proposition that *Wyandotte* created or applied a broad public implied right.

sory interest in natural resources.⁵⁵ Another way in which *Wyandotte* is narrowly cited is for the proposition that an injunction may be sought in cases in which the statute in question addresses criminal violations.⁵⁶ On several occasions, courts have agreed that the United States may in an implied action seek recovery of costs or an injunction or damages to protect the government's proprietary interest but have neither cited nor relied upon *Wyandotte*.⁵⁷ Moreover, in some cases, courts have recognized, in cases involving unregistered agricultural products and illegal food stamp distribution, federal implied rights without reference to either *Wyandotte* or the private implied right cases.⁵⁸ In others, however, courts have refused to imply a federal right of action even for recovery of costs, either by applying private remedy case law or by finding that the statute did not provide for the remedy sought.⁵⁹

55. For example, the Fifth Circuit, in *United States v. Ray*, 423 F.2d 16, 21–22 (5th Cir. 1970), soon after *Wyandotte* endorsed a right of action to enjoin construction that would affect a coral reef. The court reasoned that the United States had an “overwhelming. . .vital interest” in ensuring that the coral remained healthy and that “protective action by the Government to protect despoliation of these unique natural resources is of tantamount importance.” *Id.* at 22–23. *See also* *University of Texas Medical Branch at Galveston v. United States*, 557 F.2d 438, 451 (5th Cir. 1977) (recovery of cost of removing sunken barge). An *in personam* remedy to recover the costs of repairing a river lock that was damaged by a barge was approved by the Sixth Circuit in *Hines, Inc. v. United States*, 551 F.2d 717, 727 (6th Cir. 1977). The Ninth Circuit likewise cited *Wyandotte* in upholding a claim by the United States for recovery of costs expended in removing piers pursuant to Section 10 of the RHA. *United States v. Alameda Gateway Ltd.*, 213 F.3d 1161, 1166 (9th Cir. 2000).

56. *See, e.g.*, *United States v. Seminole Tribe*, 45 F. Supp. 2d 1330, 1331 (M.D. Fla. 1999).

57. The Sixth Circuit, without reference to *Wyandotte*, held that the United States could, in furtherance of the Spending Clause and the government's interest in ensuring that conditions imposed on the recipients of federal funds are properly enforced, bring an action to enforce the Family Education Rights and Privacy Act. *United States v. Miami Univ.*, 294 F.3d 797, 808 (6th Cir. 2002). The Eleventh Circuit approved of “injunctive relief, declaratory judgment and money damages” associated with the removal of sunken barge. *United States v. Baycon Indus., Inc.*, 804 F.2d 630, 633 (11th Cir. 1986). It subsequently approved of a mandatory injunction to require a Florida state agency to comply with state statutory duties in order to protect the United States' proprietary interests in the Everglades National Park and in a national wildlife refuge. *United States v. South Florida Water Mgmt. Dist.*, 28 F.3d 1563, 1571 (11th Cir. 1994), *cert. denied*, 514 U.S. 1107 (1995). Similarly, the First Circuit approved, again without citing *Wyandotte*, of an implied right of action to recover improper Medicare payments, noting that “[i]n the context of recovery of overpayments, the government has broad power to recover monies wrongly paid from the Treasury, even absent any express statutory authorization to sue.” *United States v. Lahey Clinic Hosp.*, 399 F.3d 1, 15 (1st Cir. 2005) (citing *United States v. Wurts*, 303 U.S. 414, 415 (1938)).

58. *See, e.g.*, *United States v. Rx Depot, Inc.*, 438 F.3d 1052, 1057 (10th Cir. 2006) (disgorgement remedy sought against Canadian exporter of pharmaceuticals to the United States); *Woods v. United States*, 724 F.2d 1444, 1448 (9th Cir. 1984) (suit for reimbursement of food stamp funds allegedly improperly paid); *Impro Products, Inc. v. Block*, 722 F.2d 845, 852 (D.C. Cir. 1983) (agricultural products).

59. The Fifth Circuit, for example, rejected an implied strict liability claim under the Refuse Act because while the act included a strict liability provision, it did not apply to the costs at issue. *United States v. Dixie Carriers, Inc.*, 627 F.2d 736, 741 (5th Cir. 1980). It declined, in contrast with the Sixth Circuit in *Hines* in a virtually identical factual context, to endorse an implied *in personam*

Similarly, *Wyandotte*, for a decision with potentially broad ramifications, has engendered little academic curiosity, and what exists hardly supports a robust interpretation. The more recent, and sparse, commentary has concerned the relatively mundane question whether the Court's rationale in construing the Wreck Act, which as a part of the RHA "concern[s] wreck removal responsibilities and expressly contemplate[s] an in personam remedy"⁶⁰ extends to *in rem* remedies or to *in personam* remedies in other reimbursement contexts.⁶¹ Other analyses treat *Wyandotte* as simply another private right of action case,⁶² effectively cabin the decision solely to the RHA,⁶³ assume without discussion that it more particularly applies exclusively to the Wreck Act,⁶⁴ or, infrequently and most liberally, conclude that it simply effectuates the government's "recovery of public service expenditures."⁶⁵

The absence of academic curiosity is perhaps not surprising given that the United States has rarely advocated use of *Wyandotte* in non-cost recovery cases, despite its view that the decision has considerable scope.⁶⁶ And when the United States has sought to apply *Wyandotte*

remedy against a barge owner, citing private rights cases for the proposition that "a number of recent Supreme Court decisions [have held] that we should be reluctant to imply a remedy broader than Congress expressly provided." In re *Barnacle Marine Mgmt.*, 233 F.3d 865, 870 (5th Cir. 2000). See also *United States v. The Tug Sundial*, 861 F. Supp. 2d 1208, 1217 (D. Or. 2012) (the most notable of several district court opinions that endorse *Barnacle*). And it refused to apply, or even mention, *Wyandotte* in the seemingly clear-cut context of recovery of flood cleanup costs under the National Flood Insurance Act. *United States v. St. Bernard Parish*, 756 F.2d 1116, 1122-23 (5th Cir. 1985) (describing the United States as seeking an implied private right of action, and applying private right cases). The Third, Fourth, and Ninth Circuits, in significant decisions discussed hereinbelow, *United States v. Solomon*, 563 F.2d 1121 (4th Cir. 1977); *United States v. Mattson*, 600 F.2d 1295 (9th Cir. 1979); *United States v. FMC Corp.*, 717 F.2d 775 (3d Cir. 1983); *United States v. City of Philadelphia*, 644 F.2d 187 (3d Cir. 1981), specifically refused to apply *Wyandotte* in civil rights and patent cases.

60. David W. Robertson & Michael F. Sturley, Recent Development, *Recent Developments in Admiralty and Maritime Law at the National Level and in the Fifth and Eleventh Circuits*, 26 TUL. MAR. L.J. 193, 285 (2001).

61. See, e.g., Lee A. Handford, Comment, *Serious Snag in the Wreck Act: Non-Negligent Owners' Liability for Removal of a Wreck*, 15 TUL. MAR. L.J. 103, 114 (1990).

62. See, e.g., William L. Larson, Note, *Effective Enforcement of the Foreign Corrupt Practices Act*, 32 STAN. L. REV. 561, 571 (1980) (*Wyandotte* created a three-part test for private implied rights of action after *Borak* and preceding *Cort*).

63. See, e.g., Donald C. Greenman, *Limitation of Liability Unlimited*, 32 J. MAR. L. & COM. 279, 295 (2001); James Stephen O'Brien, Jr., Note, *Admiralty—Deviation in the Fifth Circuit: The New Interpretation of the Wreck Act*, 59 TUL. L. REV. 1089, 1093 (1985).

64. See, e.g., R. Michael Underhill, *The Sovereign as Plaintiff: Clean Seas and the Other Coin of the Realm*, 3 U.S.F. MAR. L.J. 37, 40 (1990/1991).

65. See Joel M. Gora, *The Pentagon Papers Case and the Path Not Taken: A Personal Memoir on the First Amendment and the Separation of Powers*, 19 CARDOZO L. REV. 1311, 1311 (1998) (*Wyandotte* has no application in cases involving First Amendment rights).

66. Indeed, the Solicitor General, in opposing certiorari in 2009 in a Fifth Circuit case involving a drydock that, as a result of Hurricane Katrina, broke away from its moorings and sank in the Industrial Canal in New Orleans, argued that *Wyandotte* has little or no modern-day application even in cases involving non-negligent sinkings, because of subsequent 1986 revisions to the

more expansively, including in a patent case, it has met with considerable opposition and judicial reluctance, as the next sections describe.

D. Rejection of a Broad Application of Wyandotte: United States v. City of Philadelphia

*City of Philadelphia*⁶⁷ arose in the context of widespread civil rights violations by then-mayor Frank Rizzo and Police Commissioner Joseph F. O'Neill. Prior federal prosecutions of police officers for extracting illegal confessions had not resulted in systemic change; in fact, in at least one instance a convicted officer had subsequently been promoted.⁶⁸ The government sought an injunction against Fourteenth Amendment violations through implication from criminal provisions found in the Civil Rights Acts of 1866 and 1870 and the Fourteenth Amendment itself. The Third Circuit, in a 5-4 decision denying a petition for rehearing, rejected "the government's suggestion that the comprehensive analysis developed in the later [private right of action] Supreme Court opinions must be discarded in favor its 1967 *Wyandotte* decision."⁶⁹

The United States' view, according to the court, was that "*Wyandotte* sets forth a different and more liberal test for recognition of implied rights of action in favor of the government"⁷⁰ and that the decision supported broad injunctive relief because there were no "other adequate means by which the United States can carry out its responsibility."⁷¹ The basis for the court's conclusion was that *Wyandotte*

Wreck Act. Brief of the United States in Opposition at 8, *Southern Scrap Material Co., L.L.C. v. United States*, No. 08-696 (U.S. Feb. 27, 2009), 2009 WL 526995. The United States has also argued on occasion that *Wyandotte* was an implied right decision that preceded *Sandoval* and should not be given current effect to endorse broad private implied rights. Brief of the Department of Transportation as Amicus Curiae, *Boswell v. Skywest Airlines, Inc.*, 361 F.3d 1263 (10th Cir. 2014) (No. 02-4188). Although the United States mentioned *Wyandotte* in an initial brief in one of the actions brought by the government to quash state-issued subpoenas to telephone companies, it relied instead largely upon preemption and national security grounds when the case was consolidated with others by a multidistrict litigation panel. In re National Sec. Agency Telecommunications Records Litigation, 633 F. Supp. 2d 892 (N.D. Cal. 2007). cursory asides were overlooked when courts readily accepted the narrower proposition that, in contexts such as recovery of Medicaid overpayments and a suit to prohibit a college that received federal funds from releasing student records in violation of federal law, the United States can sue to enforce conditions on the receipt of funding. See, e.g., *United States v. Lahey Clinic Hospital, Inc.*, 399 F.3d 1, 15 (1st Cir. 2005).

67. *United States v. City of Philadelphia*, 644 F.2d 187 (3d Cir. 1981).

68. Stephen Rushin, *Federal Enforcement of Police Reform*, 82 *FORDHAM L. REV.* 3189, 3605-06 (2104) (describing previous prosecutions, the City's response, and statements by federal officials to the effect that the problems were "institutional").

69. *City of Philadelphia*, 644 F.2d at 191.

70. *Id.*

71. *Id.*

did not establish a “different standard for inferring rights of action in favor of the government” because the Court there stated that it relied on “cases involving civil actions or private parties”⁷² and cited *Wyandotte* in *Cort* “in developing further the test for inferring private rights of action.”⁷³ Accordingly, *Wyandotte* had been superseded by subsequent Supreme Court implied right decisions. Its “unrefined analysis”⁷⁴ was “no longer an accurate statement of the law.”⁷⁵

Judge Gibbons, in a lengthy dissent, accused the majority of “Calhounism”⁷⁶ and championed what he characterized as a distinct line of analysis emanating from *United States v. San Jacinto Tin*,⁷⁷ *United States v. American Bell Telephone*,⁷⁸ and *In re Debs*.⁷⁹ He argued that those decisions supported the government’s position—which was largely ignored by the plurality—that the claim was supported by inherent authority that is not implied from a particular statute, but rather, in this case, concerned a “constitutional duty to protect the public from injury to the general welfare.”⁸⁰ Curiously, Judge Gibbons did not discuss *Wyandotte*, though he did assert that “[i]t is one thing to perceive no legislative intent to supplement the caseloads (and incomes) of private lawyers, and quite another to hold that the [Attorney General] . . . may not bring an action.”⁸¹ *City of Philadelphia* is now accepted more with resignation⁸²—if not approval⁸³—than with anger. With *City*

72. *Id.* (quoting *Wyandotte Transportation Company v. United States*, 389 U.S. 191, 202 (1967)).

73. *Id.* at 191–92 (citing *Cort v. Ash*, 422 U.S. 66, 79 (1975)).

74. *Id.* at 192.

75. *Id.*

76. *Id.* at 227 (Gibbons, J., dissenting).

77. *United States v. San Jacinto Tin*, 125 U.S. 273 (1888).

78. *United States v. American Bell Telephone*, 128 U.S. 315 (1888).

79. *In re Debs*, 158 U.S. 564 (1895).

80. *City of Philadelphia*, 644 F.2d at 216 (Gibbons, J., dissenting). Because this article agrees that those decisions were, indeed, the genesis of a distinct non-statutory based authority residing in the United States, they (and Judge Gibbons’ dissent) will be discussed, along with their progeny, in the next Part. Judge Gibbons did not, however, rely simply on those decisions, which were not discussed, much less distinguished, in the majority opinion. He also sharply criticized the majority for implicitly reversing its recent opinion in *Halderman v. Penhurst State School and Hosp.*, 612 F.2d 84 (3d Cir. 1979), *rev’d and remanded on other grounds*, *Halderman v. Penhurst State School and Hosp.*, 451 U.S. 1 (1981), in which the court had permitted the United States to intervene in a civil rights case. There, the Third Circuit had rejected the Fourth Circuit’s *United States v. Solomon*, 563 F.2d 1121 (4th Cir. 1977), decision, which it now adopted.

81. *City of Philadelphia*, 644 F.2d at 226 (Gibbons, J., dissenting). Gibbons argued that while *Cort* “defined the scope of a private attorney general’s ability to enforce statutory rights” it had “nothing to do with the Attorney General’s authority.” *Id.* More attention was paid to the proposition that the plurality’s *Cort* discussion was “an elaborate straw man”, *id.* at 227, because express statutory remedies were present.

82. See, e.g., Rachel Harmon, *Promoting Civil Rights Through Proactive Policing Reform*, 62 STAN. L. REV. 1, 3 (2009).

83. Davis, *supra* note 13, at 43.

of *Philadelphia*'s summary treatment of *Wyandotte*, the United States faced an uphill battle when it soon thereafter asked the same court to find that the government has an implied right of action under the patent statutes in *United States v. FMC Corporation*.⁸⁴

E. Denying the United States an Implied Right to Enforce a Patent Statute: United States v. FMC Corporation

FMC Corporation, the only court of appeals decision to examine whether the United States has an implied right of action under the patent statutes, followed *City of Philadelphia* by only two and a half years. The complaint sought declaratory and injunctive relief against FMC for failing to file four written agreements between FMC and Bayer AG concerning the licensing and patenting of the pesticide carbofuran.⁸⁵ The agreements appeared in the offices of the Antitrust Division ten years later, in the course of an investigation concerning FMC.⁸⁶ The district court, in reviewing the United States' complaint, noted that statutory provision did not expressly grant a right of action to the United States and that all of the prior litigation concerning it involved private parties.⁸⁷ It viewed *Wyandotte* as "suggest[ing] that the Court might be more lenient in implying rights of action in the United States"⁸⁸ but recognized that *City of Philadelphia* had stated that "*Wyandotte* was not an accurate statement of the law, but had been narrowed by subsequent opinions"⁸⁹ with *Cort* setting forth the then-applicable standard. The court noted that *City of Philadelphia* had stated "in dictum that the government might be required to meet the same standard as a private party to have a cause of action inferred in its favor."⁹⁰

84. *United States v. FMC Corporation*, 717 F.2d 775 (3d Cir. 1983).

85. *Id.* at 776. FMC held the United States patent, and marketed the pesticide through the trade name Furadan. Apparently, the pesticide was invented at about the same time by both FMC and Bayer, and both companies had applied for patents in the United States and in several other countries. The PTO opened an interference proceeding in September 1965 to determine priority of invention, and during the proceeding the companies engaged in extensive negotiations. Afterwards, on September 18, 1968, only one of the agreements, the one pertaining to the United States, was filed with the Patent Office under 35 U.S.C. § 135(c) (2012). That section, which was added in 1962, provides that any "agreement of understanding between parties to an interference" made "in connection with or in contemplation of the termination of the interference" be filed with the PTO prior to termination of the interference proceeding. *FMC*, 717 F.2d at 777. "The sanction for the failure to file an agreement is the permanent unenforceability of both the patent and the agreement." *Id.*

86. *United States v. FMC Corp.*, 514 F. Supp. 1166 (E.D. Pa. 1981).

87. *Id.* at 1168 n.3 (collecting cases).

88. *Id.* at 1171.

89. *Id.*

90. *Id.* at 1172.

The Third Circuit agreed that *Cort* was applicable and that, with particular reference to the first factor, the United States was not the “especial beneficiary” of the legislation.⁹¹ Significantly, the Antitrust Division did not discuss *Wyandotte* in its brief⁹² and relied exclusively upon *Cort*. Nor, of course, had the district court relied on the proposition that *Wyandotte* had any present value, much less on a rationale that public implied rights are to be construed differently than private ones. The Third Circuit, however, did not ignore the issue; it dedicated several pages of its opinion to voicing concerns “against an expansive judicial role in the creation of implied remedies for the enforcement of statutory rights.”⁹³ It acknowledged that the Supreme Court has “devoted considerably less attention to implied rights of action” by the United States,⁹⁴ but concluded that because there had been changes in the Court’s view concerning private implied rights, it was obligated to “consider the extent to which the reasoning in *Wyandotte* survives the Court’s more recent analysis.”⁹⁵ It noted in passing that *Wyandotte* concerned “two peculiarly important circumstances”⁹⁶—the “urgent necessity” of removing a “menace to the public health” that required “immediate action,”⁹⁷ and the possibility that “in the absence of an implied remedy the negligent owner would profit by his own wrong.”⁹⁸ Those were, however, not factual distinguishing grounds for the court. Instead, it concluded, like the *City of Philadelphia* majority, that the law of implied rights had changed, leaving *Wyandotte* behind and, effectively, reversed. That subsequent, “refined”⁹⁹ approach meant that the capstone for recognition of an implied right of action in the government was, just as with private parties, congressional intent.

II. LOOKING BEYOND *WYANDOTTE*: THE INHERENT AUTHORITY POWER

A. Implications of the Limited Reach of Wyandotte, in General and for Claims to Enforce Private Patents

Wyandotte has, despite the government’s efforts, been effectively cabined to relatively insignificant quarrels about *in rem* and *in perso-*

91. United States v. FMC Corporation, 717 F.2d 775, 790 (3d Cir. 1983)..

92. Reply Brief of Appellant United States of America and Brief for United States of America as Cross-Appellee, United States v. FMC Corp., 717 F.2d 775 (3d Cir. 1983) (No. 82-1605).

93. *FMC*, 717 F.2d at 780.

94. *Id.* at 782.

95. *Id.*

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.*

nam jurisdiction regarding the Wreck Act and the RHA.¹⁰⁰ Indeed, *Wyandotte* is at risk even with regard to its arguably circumscribed origins. Because the decision concerned, as the Third Circuit noted in *FMC Corporation*, a lawsuit by the United States to protect its corporate or pecuniary interest, there is a good argument that it should be reconsidered and limited, in light of *Sandoval*, even as to those types of claims. That is because, as Seth Davis noted in a comprehensive analysis of public implied rights, when the United States sues in a corporate capacity, it is “entitled to no more judicial solicitude than a private litigant.”¹⁰¹ Accordingly, “when a public litigant sues in what amounts to a private capacity” courts “should treat the public litigant like a private litigant.”¹⁰² Davis notes that “corporate capacity suits are indistinguishable from the classic private beneficiary suit where a private litigant sues under a statute that creates a right for her benefit.”¹⁰³ He contends that judicial application of private rights doctrine in such cases is consistent with “the federal common law of the rights and obligations of the United States” in “proprietary and contractual controversies.”¹⁰⁴ This is, of course, the same position that was championed by the Third Circuit. It will continue to bedevil even narrowly tailored proposed applications of *Wyandotte*.¹⁰⁵

100. Perhaps as a result of the negative Third Circuit rulings, the United States has subsequently rarely invoked it outside of the RHA damage to locks or dams context. In particular, the United States has not made another implied right claim under the patent laws. Nor has it sought to apply *Wyandotte* more broadly with regard to proposed implied rights to enforce the environmental, other natural resource, or Indian laws.

101. Davis, *supra* note 13, at 34.

102. *Id.*

103. *Id.* at 35.

104. *Id.* at 38. Seizing upon Davis’ rationale, a party in a Wreck Act proceeding has argued that the logical consequence of a claim that the government must be treated precisely like a private party when it sues in its corporate interest is that *Wyandotte* should no longer be followed even in the RHA context. Its holding and rationale, the argument goes, are inconsistent with the parsimonious reach of the private implied rights cases. Reply Brief of Plaintiff—Appellant, In re: American River Transportation Co. v. United States, 2014 WL 3909288 (8th Cir. filed July 31, 2014).

105. This does not, however, necessarily mean that public implied rights of action have no separate doctrinal origin, or that no claim can be made by the government outside of the narrow reimbursement context. Davis argues convincingly that all public implied right claims should not be uniformly treated in the same manner as private actions. Instead, judicial recognition of a public implied right is based on the fundamental precept that “a federal court may elaborate the remedial implications of federal law in a regulatory mode in order to ensure an effective enforcement system.” Davis, *supra* note 13, at 5. While the jurisprudence of implied public rights is something of a “muddle” there are sound grounds for viewing the jurisdiction involving public implied rights as “distinctive.” *Id.* at 4, 5. After all, as *Wyandotte* itself demonstrates, courts have with some regularity and in certain, albeit typically narrow, contexts viewed public implied rights as somehow different. In addition, there is the Powell dissent, as well as the less significant fact that the Court has, since *Cort*, referred to “private” implied rights in cases such as *Sandoval*.

Davis' rationale and typology for such claims does not, in any categorization sense, rely exclusively on *Wyandotte*. However, if Davis' taxonomy of four general categories of implied public rights—"corporate, institutional, administrative, and substitutive"¹⁰⁶—is accepted and applied, a successful suit by the United States to enforce a private patent is highly unlikely to succeed as an implied right claim. A suit to enforce a private party's patent does not implicate the United States' corporate or cost-recovery interest, even if *Wyandotte* is viable in that arena. In any event, as noted Davis argues that "corporate" suits should be treated in the same manner as an implied right suit by a private party, and he would assumedly agree that a public claim should be rejected if *Sandoval* would require dismissal of a private suit. Since there is no clear evidence of congressional intent to provide a federal claim to seek injunctive relief, much less recovery of damages, for the infringement of a private patent, a Davis corporate category public implied right lawsuit would likely fail.

An institutional implied public right claim, one described by Davis as an effort to "vindicate intergovernmental immunities or its authority to regulate"¹⁰⁷ is, in a broad sense, instead a type of claim that the Justice Department would likely advance in the private patent infringement context. There would ostensibly be an argument, perhaps in the alternative, that the United States in attempting to address a private patent infringement is seeking to redress "injuries to [its] political powers and rights"¹⁰⁸ even if it is not articulating specific traditional grounds such as sovereign immunity, preemption, or the government's role as a trustee sovereign with plenary authority over Indian tribes.¹⁰⁹ However, an implied right claim is not necessary in such cases, and is in fact likely to be unsuccessful for the reasons discussed above. Davis cites¹¹⁰ as an example of a successful recent public implied right suit claiming an institutional interest related to a statutory context an action by the Civil Rights Division for damages to enforce the Servicemembers' Civil Relief Act.¹¹¹ But, as will be discussed below, the United States did not claim an implied right of action in that litigation, and the court's ruling was not on that basis. Instead, the court accepted that the United States possesses a broad inherent, non-

106. Davis, *supra* note 13, at 5.

107. *Id.* at 6.

108. *Id.* at 18.

109. *Id.* (referencing *Cherokee Nation v. Georgia*, 30 U.S. (5 Pet.) 1 (1831)).

110. *Id.* at 50.

111. *United States v. B.C. Enterprises, Inc.*, 696 F. Supp. 2d 593, 597 (E.D. Va. 2010), *aff'd*, 447 Fed. App'x (4th Cir. 2011).

statutorily dependent enforcement authority. Nor does Davis reference another recent federal opinion as an example of a public implied right institutional category lawsuit not involving a preemption claim.¹¹²

Ultimately, *Wyandotte* provides an unstable foundation for suits by the United States to address patent infringements, just as it does not readily support application in the broader contexts in which it has been advanced and might arguably apply. But that is not because the Court initially erred in distinguishing public and private implied rights, or because no such distinction exists, and certainly not because the United States lacks any authority to sue in the types of lawsuits in which *Wyandotte* has been cited. Instead, *Wyandotte* is hobbled by the inherent limitations of any claim that is premised solely on implication from a federal statute. Any implied rights claim, whether public or private, is linked to a particular statute rather than an inherent federal power, and therefore is subject to a potential constraint of consistency with prior congressional action. As Part I discussed, by their nature such claims present serious questions of consistency with congressional action, the meaning of any congressional inaction, and the role of the executive under the separation of powers. More generally, such claims are examined skeptically by courts concerned with federalism or separation of powers implications.¹¹³ The search for a suitable

112. See Davis, *supra* note 13, at 49 (discussing *Arizona v. United States*, 132 S. Ct. 2492 (2012)). A patent infringement public implied right claim could, again applying Davis' classification scheme, alternatively be classified as an "administrative" one, in which the "government litigant claims an implied right of action as an adjunct to its administrative authority to implement federal objectives." *Id.* at 20. Administrative cases, to Davis, are "full of contradictions." *Id.* Davis cites *In re Debs*, 158 U.S. 564 (1895), as an administrative implied right case, Davis, *supra* note 13, at 21, but as discussed in the next Part the Court's ruling did not imply a right from a statute but rather recognized a broader, inherent authority. In addition, while Davis sees administrative implied right claims in which the government contends that an action is consistent with and enforces a statutory interest as unhampered by narrow or specific statutory remedial provisions, he recognizes that such suits are "to enforce Congress' will", Davis, *supra* note 13, at 21, and therefore agrees that courts analyzing such claims should look at a statute's language and legislative history to determine consistency with congressional objectives. To that end, congressional refusal regarding a proposed federal enforcement mechanism or remedy is telling, and therefore Davis believes *FMC Corporation* was correctly decided because the legislative history there showed "Congress had rejected additional enforcement mechanisms." *Id.* at 60. Davis goes further to agree that if Congress sets forth an explicit enforcement mechanism—as it has with regard to patentees—recognition of an implied statutory right would likely "contravene the congressional scheme." *Id.* at 54. None of Davis' categories are a good fit for a suit by the United States to enforce a patent issued to a private party.

113. See, e.g., *Alexander v. Sandoval*, 532 U.S. 275, 286 (2001). ("private rights of action to enforce federal law must be created by Congress"); *Boswell v. Skywest Airlines, Inc.*, 361 F.3d 1263, 1267 (10th Cir. 2004) ("the Supreme Court has emphasized that the private right of action inquiry focuses on the Congressional intent underlying the particular statute at issue"); *United States v. City of Philadelphia*, 644 F.2d 187, 194–199 (3d Cir. 1981); *United States v. Mattson*, 600 F.2d 1295, 1299–1300 (9th Cir. 1979); *United States v. Solomon*, 563 F.2d 1121, 1125 (4th Cir. 1977).

broad and sustainable doctrine that both justifies suits by the United States in a variety of contexts and particularly may encompass actions seeking relief from private patent infringement therefore must continue. While authority for such actions arguably exists, it has infrequently been summoned, and has been characterized as either a historical artifact or viewed as limited to several categories of particular federal importance. Its parameters, at least in the reported decisions, are imprecise. Yet its perseverance, through invocation by the Justice Department in several recent lawsuits and judicial acceptance of the argument, cannot be ignored.¹¹⁴

B. The Inherent, Non-Statutory Federal Right of Action: Its Past, Present, and (Possibly) Future

Several never overruled decisions suggest that the United States has broad authority to bring suit in federal court to protect its sovereign or proprietary interests.¹¹⁵ It seems uncontroversial that the United States may, as a sovereign, and even in the absence of explicit statutory authority and independent of any derived implied right, sue

114. Two other potential grounds for a federal cause of action are worthy of discussion; neither can alone justify a federal claim. On occasion, but rarely in modern cases, the United States has asserted that 28 U.S.C. §§ 516 & 518 (2012), which respectively provide that the “conduct of litigation” in which the United States is a party is “reserved to officers of the Department of Justice” and that the Attorney General may “personally conduct and argue any case in a court of the United States in which the United States is interested” provide statutory support for a federal cause of action. In *United States v. California*, 332 U.S. 19, 27 (1947), the Court accepted the premise that predecessor statutes granted a right of action to the United States “to safeguard national interests.” Most courts, however, have viewed the provisions as mere “housekeeping.” *Solomon*, 563 F.2d at 1124, measures that, in the case of Section 516, “authorizes the Attorney General to bring an action where there is independent statutory authority.” *Mattson*, 600 F.2d at 2987 n.1. Another potential, but also unlikely, basis for a federal claim is the United States acting as a “quasi-sovereign” under the *parens patriae* doctrine. That doctrine, as long applied to the states, provides that a state government may bring a claim when it acts to address an injury to the population at large, or at least a substantial segment of the population. There are, in contrast, very few instances in which courts have suggested that the United States has a *parens patriae* interest. See, e.g., *Massachusetts v. Mellon*, 262 U.S. 447, 485 (1923) (dicta; state lacks authority when its power derives from federal law). Acceptance of *parens patriae* would at best confer standing rather than demonstrate the existence of a cause of action. *Hawaii v. Standard Oil Co. of Cal.*, 405 U.S. 251, 259 (1972) (*parens patriae* does not confer cause of action); Davis, *supra* note 13, at 13 (referring to “*parens patriae* standing”); Ryke Longest, *Massachusetts versus EPA: Parens Patriae Vindicated*, 18 DUKE ENVTL. L. & POL’Y F. 277, 277 n.3 (2008) (distinguishing). As noted below, *infra* note 180, *parens patriae* status is not necessary for the United States to have standing in an action to enforce a private patent.

115. See, e.g., *In re Debs*, 158 U.S. 564, 584 (1895) (“Every government. . . has a right to apply to its own courts for any proper assistance in the exercise of [its powers] and the discharge of [its duties].”); *Sanitary District of Chicago v. United States*, 266 U.S. 405 (1925) (obstruction to navigation); *Heckman v. United States*, 224 U.S. 413, 438–41 (1912) (Indian allotment conveyances); *United States v. American Bell Tel. Co.*, 128 U.S. 315, 367 (1888) (suit to cancel patents obtained by fraud).

to recover pecuniary losses.¹¹⁶ Likewise, courts readily accept that the United States may sue absent statutory authorization to enforce a contractual obligation.¹¹⁷ What has proven more unsettled is whether this inherent, non-statutorily-based power extends to remedy alleged infractions of the government's non-proprietary sovereignty interests, and if so, how the interest is defined and in which contexts the authority may be expressed. The "(in)famous"¹¹⁸ ruling in *In re Debs*¹¹⁹ which concerned the Pullman Strike of 1894 and upheld the government's non-statutory, inherent right to sue even when it had "no pecuniary interest in the controversy",¹²⁰ has, in the commentary, been criticized as a vast overreach of federal authority,¹²¹ marginalized as "an anomaly that has not since had generative power",¹²² classified as a long-bygone example of "judicial boundness",¹²³ categorized as merely an action "to protect the public interest in the free flow of interstate commerce" through mail delivery,¹²⁴ described as limited to instances

116. See, e.g., *Snapp & Son*, 458 U.S. at 601-02 ("As a proprietor, it is likely to have the same interests as other similarly situated proprietors. And like other such proprietors it may at times need to pursue those interests in court."); *United States v. Standard Oil Co.*, 332 U.S. 301, 315 n.22 (1947) ("not been necessary for Congress to pass statutes imposing civil liability in those situations"); *Kern River Co. v. United States*, 257 U.S. 147 (1921); *Loftin Cotton v. United States*, 52 U.S. 229 (1850) (suit in trespass "as a corporation or body politic," *id.* at 231, for money damages for conversion of timber, when government could have brought criminal action); *United States v. San Jacinto Tin Co.*, 125 U.S. 273 (1888); 91 C.J.S. §§ 175 ("same right as a private owner to sue to protect its property"), 176 ("(T)he United may sue those who commit tortious acts which result in pecuniary loss to the United States. . .").

117. See, e.g., *United States v. Marion County School Dist.*, 625 F.2d 607, 615-17 (5th Cir. 1980). This is distinct from suits in which a governmental entity seeks to recover costs that are incurred through tax-supported services. See, e.g., *District of Columbia v. Air Florida, Inc.*, 750 F.2d 1077 (D.C. Cir. 1984) (no common law recovery for costs of emergency services and cleanup after air disaster).

118. Davis, *supra* note 13, at 21.

119. *In re Debs*, 158 U.S. 564 (1895).

120. *Id.* at 586. For a discussion of the ruling as part of the judicial expansion of injunctive relief in labor disputes, see Nirej S. Sekhon, *Punitive Injunctions*, 17 U. PA. J. L. & SOC. CHANGE 175, 207-10 (2014). See also David Gray Adler, *The Steel Seizure Case and Inherent Presidential Power*, 19 CONST. COMMENT. 155, 183-88 (2002) (*In re Debs* did not answer the question of the scope of inherent executive power).

121. Kenneth M. Casebeer, "Public. . . Since Time Immemorial": *The Labor History of Hague v. CIO*, 66 RUTGERS L. REV. 147, 149 (2103) (example of judicial suppression of free assembly); Michael P. Van Alstine, *Constitutional Necessity and Presidential Prerogative: Does Presidential Discretion Undergird or Undermine the Constitution?*, 45 TULSA L. REV. 631, 646 (2010) ("erroneous conflation of executive and national power"); Recent Development, *United States Has Nonstatutory Standing To Sue To Enforce Policies of a Federal Statute*, 64 COLUM. L. REV. 951, 955 (1964) (non-statutory inherent authority would mean that "the United States would have standing to sue to implement the policies of any statute, notwithstanding the absence of express congressional authorization, a result Congress certainly never contemplated nor the courts ever suggested.").

122. Robert J. Reinstein, *The Limits of Executive Power*, 59 AM. U. L. REV. 259, 319 (2009).

123. DUNCAN KENNEDY, *THE RISE AND FALL OF CLASSICAL LEGAL THOUGHT* 253 (2006).

124. Tara Lee Grove, *Standing as an Article II Nondelegation Doctrine*, 11 U. PA. J. CONST. L. 781, 793 (2009).

in which the government has an obligation or duty to act,¹²⁵ limited to infrequent and true national emergencies or instances of domestic unrest,¹²⁶ or actions “to protect national security interests and to vindicate constitutional rights,”¹²⁷ and disparaged as elevating private property rights over the Bill of Rights.¹²⁸ Perhaps the most notable criticism came from Henry P. Monaghan, who stated that *In re Debs* can constitutionally be justified only if it is viewed as endorsing the “use [of] force as necessary to enforce federal law when a breakdown in the normal civil process has occurred, and not only to defend the United States against sudden attack, but also to ‘protect’ the government’s personnel, property, and instrumentalities.”¹²⁹

Yet *In Re Debs*, or at least the concept of a broad non-statutory inherent power to sue, has its academic supporters.¹³⁰ And while the Court’s rationale was partially justified by the desirability of ensuring delivery of mail, what to make of the statement that “[e]very government, entrusted, by the very terms of its being, with powers and duties to be exercised and discharged for the general welfare, has a right to apply to its own courts for any proper assistance in the exercise of the one and the discharge of the other.”¹³¹ Similarly, the Court’s earlier statement in *San Jacinto Tin*¹³² that government has “enormous power” and the suggestion that *American Bell Telephone*¹³³ infers an ability to

125. Davis, *supra* note 13, at 21.

126. See, e.g., Michael Bahar, *The Presidential Intervention Principle: The Domestic Use of the Military and the Power of the Several States*, 5 HARV. NAT’L SEC. J. 537, 597 (2104); Anthony O’Rourke, *Theorizing American Freedom*, 110 MICH. L. REV. 1101, 1106 (2012); Martin H. Scheffer, *Does Absolute Power Corrupt Absolutely?*, 24 OKLA. CITY L. REV. 233, 261-63 (1999); Note, *Nonstatutory Executive Authority to Bring Suit*, 85 HARV. L. REV. 1566, 1575, 1581 (1972) [hereinafter HARVARD NOTE].

127. Note, *Protecting the Public Interest: Nonstatutory Suits by the United States*, 89 YALE L.J. 118, 136 (1979) [hereinafter YALE NOTE].

128. See, e.g., Gerard N. Magliocca, *Why Did the Incorporation of the Bill of Rights Fail in the Late Nineteenth Century?*, 94 MINN. L. REV. 102, 131-36 (2009); J. Gordon Hylton, *The Perils of Popularity: David Josiah Brewer and the Politics of Judicial Reputation*, 62 VAND. L. REV. 567, 579 (2009).

129. Henry P. Monaghan, *The Protective Power of the Presidency*, 93 COLUM. L. REV. 1, 66 (1993).

130. See, e.g., Joseph W. Mead, *Interagency Litigation and Article III*, 47 GA. L. REV. 1217, 1227 (2013) (declaring that “an inherent aspect of sovereignty is the right to invoke the nation’s courts to enforce its sovereign prerogatives”); John C. Duncan, Jr., *A Critical Consideration of Executive Orders: Glimmerings of Autopoiesis in the Executive Role*, 35 VT. L. REV. 333, 373 (2010) (*In re Debs* “supports the expansive view of presidential power”); Aaron-Andrew P. Bruhl, *Return of the Line Item Veto? Legalities, Practicalities, and Some Puzzles*, 10 U. PA. J. CONST. L. 447, 493 (2008) (suggesting expansive authority).

131. *In re Debs*, 158 U.S. 564, 584 (1895).

132. *United States v. San Jacinto Tin Co.*, 125 U.S. 273, 284 (1888).

133. *United States v. American Bell Tel. Co.*, 128 U.S. 315 (1888).

sue to “fill in the interstices of a statutory scheme”¹³⁴ suggest, through what one unpersuaded court tagged as “high-flying rhetoric”¹³⁵ a potentially unbridled authority. The language is indeed nebulous and the interpretative case law is both sparse¹³⁶ and unrevealing. Courts have rarely attempted to opine on the constitutional basis for the “right.”¹³⁷ To the extent commentators have addressed the question, it has largely been in the larger realm of executive unilateral action.¹³⁸ The most typical adverse judicial response is to list the kinds of decisions that have cited and applied *In re Debs*, *San Jacinto*, and *Sanitary District or American Bell Telephone*, classify them by the subject matter at issue, and conclude that the authority, however defined and from wherever derived, surely must be limited to the listed arenas. Yes, those courts concede, there are categories, but they admit of no exceptions, and no other classifications or variations are possible.

But the categories themselves, as established by courts that seek to limit the import of *In re Debs*, are inconsistent. For example, in *United States v. Solomon*¹³⁹ the Fourth Circuit in rejecting the government’s Fourteenth Amendment enforcement effort described the “doctrine” as anything that permits the United States to sue even in the absence of express or implied statutory authority¹⁴⁰ and categorized the cases as

134. *United States v. City of Philadelphia*, 644 F.2d 187, 216 (3d Cir. 1981). (Gibbons, J., dissenting).

135. *In re National Security Agency Telecommunications Records Litigation*, 633 F. Supp. 2d 892, 900 (N.D. Cal. 2007).

136. See ERWIN CHERMERINSKY, *FEDERAL JURISDICTION* § 2.3 (4th ed. 2003) (“little has been made of this broad authorization to sue [since] in most instances, the federal government has sued pursuant to federal statutes and not based on its inherent interest in protecting its citizens.”).

137. *But see City of Philadelphia*, 644 F.2d at 199 (rejecting Take Care Clause as basis); *Id.* at 217 (Gibbons, J., dissenting) (suggesting that it may derive “from the constitutional duty to protect the public from injury to the public welfare.”); *United States v. Solomon*, 419 F. Supp. 358, 372 (D. Md. 1976), *aff’d*, 563 F.2d 1121 (4th Cir. 1977) (same).

138. Some have suggested that the executive’s authority derives from the Take Care Clause, *see, e.g.*, Peter Margulies, *Taking Care of Immigration Law: Presidential Stewardship, Prosecutorial Discretion, and the Separation of Powers*, 94 B.U. L. REV. 105, 129 (2014) (authority under the Clause encompasses “values underlying the Framers’ vision of a strong federal government”); Grove, *supra* note 124, at 794 (noting that the Clause supports executive standing in enforcement actions); HARVARD NOTE, *supra* note 126, at 1567, while others point concurrently or alternatively to the Vesting Clause, *see, e.g.*, Bruce A. Ledewitz, *The Power of the President to Enforce the Fourteenth Amendment*, 52 TENN. L. REV. 605, 669–76 (1985), or to an omnibus executive “completion power.” Jack Goldsmith & John F. Manning, *The President’s Completion Power*, 115 YALE L.J. 2280, 2302–11 (2006). *See* Thomas P. Crocker, *Presidential Power and Constitutional Responsibility*, 52 B.C. L. REV. 1551, 1555–60 (2001) (surveying, in analyzing the authority of the executive to act in the absence of statutory authority, the debate). *But see* YALE NOTE, *supra* note 127, at 138 (contending that nonstatutory inherent authority suits should be delimited because “the creation of remedies is characteristically a legislative, rather than an executive, function.”).

139. *United States v. Solomon*, 563 F.2d 1121, 1126 (4th Cir. 1977).

140. *Id.* at 1126.

involving suits to protect a property right, to “protect the public”,¹⁴¹ to act as “guardian of the Indian tribes”,¹⁴² to protect “national security”¹⁴³ and, in order to preclude the government’s claim in that case, when interstate commerce is “obstructed by a denial of civil rights in violation of some congressional enactment.”¹⁴⁴ With the prior decisions posited in that manner, the court was able to reject as an “extreme reading”¹⁴⁵ *United States v. Brand Jewelers, Inc.*¹⁴⁶ which had applied *In re Debs* to enjoin, under the Fourteenth Amendment, a jeweler from engaging in sham service practices prior to obtaining judgments by default.¹⁴⁷ Yet the Ninth Circuit, on the heels of *Solomon* and reaching the same conclusion about the ability of the United States to bring a suit to enforce the Fourteenth Amendment, in *United States v. Mattson* both defined the doctrine differently—“some interest that can be construed to warrant an implicit grant of authority”¹⁴⁸ –and limited it to “a property interest, interference with national security or a burden on interstate commerce.”¹⁴⁹ At about the same time, the First Circuit confined the doctrine to undefined “great moment[s] of urgency,” “fraud on the United States” and instances of “fiduciary duty owed to an individual such as would justify suit under the aegis of constitutional grant.”¹⁵⁰ The supportive courts have been of no greater assistance. More recently, the district court in the consolidated *In re National Security Agency Telecommunications Records Litigation*,¹⁵¹ approving a government request for an injunction prohibiting five states from enforcing subpoenas issued to telephone companies in the wake of disclosures of customer information to the National Security Agency, thought better of *Brand Jewelers* by bestowing upon it a distinctive category. The court viewed the “circumstances” in which *In re Debs* had been invoked and applied as “suits to enforce immunity of the armed forces from certain state taxes”, to “enforce civil rights under the Commerce Clause”, to “enjoin sellers from obtaining default judgments

141. *Id.* (citing *San Jacinto* and *American Bell Telephone*).

142. *Id.*

143. *Id.* at 1127.

144. *Id.* at 1128.

145. *Id.*

146. *United States v. Brand Jewelers, Inc.*, 318 F. Supp. 1293, 1298–99 (S.D.N.Y. 1971).

147. For a contemporaneous criticism of *Brand Jewelers*, see HARVARD NOTE, *supra* note 126, at 1576–77 & n.52.

148. *United States v. Mattson*, 600 F.2d 1295, 1298 (9th Cir. 1979).

149. *Id.* at 1298–99.

150. *Ruotolo v. Ruotolo*, 572 F.2d 336, 339–40 (1st Cir. 1978).

151. *In re National Security Agency Telecommunications Records Litigation*, 633 F. Supp. 2d 892 (N.D. Cal. 2007).

without proper service of process”, and “in disputes over interference with national security.”¹⁵²

These courts would presumably agree that the law in this area has “developed haphazardly” and that “clarification of its parameters [have] not been adequately made.”¹⁵³ Yet the *National Security Agency* court had a point, whether intended or not, in using the word “circumstances,” as that is precisely what courts on both sides of the ledger have done. Instead of attempting to delineate with precision the origin, nature, and extent of the doctrine, they have simply listed the cases previously decided, described what they concerned, slotted the instant proceeding into a category (or found that there is no neat fit), and assumed that the “doctrine” is limited to those particulars. The courts have, in essence, neither defined the doctrine nor set its parameters.¹⁵⁴

To be sure, there are a number of decisions that were argued in discrete factual contexts and could be neatly categorized in fairly narrow confines. Consider, for example, the Indian cases. Courts, including the Supreme Court, have post-*In re Debs* held that the United States has a sovereign interest, as well as a role as trustee, that justifies bringing suit for the benefit of Indian tribes and individual Indians.¹⁵⁵ Prior to the Civil Rights Act of 1964, and the adverse decisions in *Solomon*, *City of Philadelphia*, and *Mattson*, an energetic Justice Department brought a number of lawsuits in southern states seeking desegregation of bus terminals and other transit hubs, typically under the premise that the Commerce Clause was violated. The claims often involved alternative statutory grounds¹⁵⁶ and, with the notable exception of Judge Wisdom’s opinion in *United States v. City of Jackson*,¹⁵⁷ the rulings contained little substantive discussion.¹⁵⁸ They are highly unlikely, for both practical and legal reasons, to be brought today.

152. *Id.* at 900.

153. *U.S. v. Mattson*, 600 F.2d 1295, 1298 (9th Cir. 1979)

154. What was said in a student note in 1979 remains true today: “neither *Solomon* nor any other case denying government standing to sue has proposed a coherent doctrine that would support both its own decision and principled exceptions. . . .” YALE NOTE, *supra* note 127, at 126.

155. *See, e.g.*, *Heckman v. United States*, 224 U.S. 413, 438–41 (1912); *United States v. Minnesota*, 270 U.S. 181, 194–95 (1926) (“emphasiz[ing] the duty, and therefore the right, of the United States to sue”); *Cramer v. United States*, 261 U.S. 219, 233 (1923). *See generally* Seth Davis, *Tribal Rights of Action*, 45 COLUM. HUM. RTS. L. REV. 499, 534 (2014).

156. *See, e.g.*, *United States v. City of Montgomery*, 201 F. Supp. 590, 594 (M.D. Ala. 1960) (Federal Aviation Act).

157. *United States v. City of Jackson*, 318 F.2d 1, 11–17 (5th Cir. 1963). *See* Ledewitz, *supra* note 138, at 613 (discussing views of two panel members who believed the suit could be decided solely on statutory grounds).

158. *See, e.g.*, *United States v. City of Shreveport*, 210 F. Supp. 36, 36 (W.D. La. 1962). For discussions and lists of these cases, *see* *U.S. v. City of Philadelphia*, 644 F.2d 187, 218 (3d Cir. 1980) (Gibbons, J., dissenting) (listing cases); *United States v. Solomon*, 563 F.2d 1121, 1128 (4th

The “national security” cases are typified by *United States v. Arlington County*,¹⁵⁹ in which the Fourth Circuit, in enjoining local taxation of active duty servicemembers, declared that the “interest of the national government in the proper implementation of its policies and programs involving the national defense is such as to vest in it the non-statutory right. . .”¹⁶⁰ Many of the decisions, including the recent one in *United States v. B.C. Enterprises, Inc.*,¹⁶¹ involve the servicemembers’ Civil Relief Act, which until recently did not expressly grant the United States (or servicemembers, for that matter) a civil right of action. *B.C. Enterprises* is significant both because it is a recent *In re Debs* application and because the Civil Rights Division suggested that it does not view the “categories” as sacrosanct. The case involved a company that towed and sold absent servicemembers’ vehicles, in contravention of the statute. The Division acknowledged that *Solomon* had narrowed *In re Debs*’ application in the Fourth Circuit, but stressed that its claim fell squarely within the acknowledged national security category and argued that *Arlington County* was binding. But it also stated, in its brief in the Fourth Circuit, that “*Solomon* did not try to define the outer limits of the United States’ inherent authority under *In re Debs*,” but rather “define[d] several categories of suit that clearly fit within that authori-

Cir. 1977). (same); HARVARD NOTE, *supra* note 126, at 1572–76; Recent Development, *United States has Nonstatutory Standing to Sue to Enforce Policies of a Federal Statute*, 64 COLUM. L. REV. 951, 953 (1964). See also Randolph D. Moss, Note, *Participation and Department of Justice School Desegregation Consent Decrees*, 95 YALE L.J. 1811, 1824 n.68 (1986) (effect of Civil Rights Act of 1964).

159. *United States v. Arlington County*, 326 F.2d 929 (4th Cir. 1964).

160. *Id.* at 932–33. See also *United States v. Marchetti*, 466 F.2d 1309, 1313 & n.3 (4th Cir. 1972), *cert. denied*, 409 U.S. 1063 (1972) (action to enjoin former CIA agent from publishing memoir). *New York Times Co. v. United States*, 403 U.S. 713 (1971), could also be categorized as a national security case; the opinions “disclosed an awareness and concern with regard to the government’s right to sue.” *Solomon*, 563 F.2d at 1127 n.5. See Peter D. Junger, *Down Memory Lane: The Case of the Pentagon Papers*, 23 CASE W. RES. L. REV. 3, 27–28, 31 (1971) (decision turned on assumption of inherent executive authority).

161. *United States v. B.C. Enterprises, Inc.*, 696 F. Supp. 2d 593 (E.D. Va. 2010), *aff’d*, *United States v. B.C. Enterprises, Inc.*, 447 Fed. App’x 468 (4th Cir. 2011). The Act is a successor to the Soldiers’ and Sailors’ Civil Relief Act, which was enacted following World War I and has been amended on numerous occasions. Among its provisions is 50 U.S.C. App. 537, which provides that the property of servicemembers may not be taken and sold pursuant to a lien during the period of active duty or within 90 days thereafter in the absence of a court order. The United States filed a complaint alleging that the defendant had towed and sold without a court order a car belonging to a Navy lieutenant. Afterwards, the Civil Rights Division obtained evidence that the defendant had also sold the cars of at least 20 other servicemembers. The district court granted the United States summary judgment, after denying a motion filed by the defendant regarding the government’s standing and absence of statutory authority to bring the suit. In its motion, the United States presented documentation as to the identity of the other servicemembers, the towing and sale of the vehicles, and proof of damages including auction prices and appraisal values. After a different judge in the same district held that there is no implied private right of action, the defendant in *B.C. Enterprises* filed a motion for judgment on the pleadings in which it reargued the proposition that the United States is bound by the private implied right of action case law. The district court denied the motion and certified its order for interlocutory appeal.

ty.”¹⁶² It reasoned that between the “two points” of the distinct categories set forth in *Solomon* and that of giving *In re Debs* “its most expansive possible meaning,”¹⁶³ lies an unexplored, “murky” area.¹⁶⁴ And it cited *Wyandotte* as relying on *In re Debs* in “assessing the United States’ inherent authority to sue.”¹⁶⁵ It also referenced *Ruotolo v. Ruotolo*¹⁶⁶ and *Mattson*, two oppositional cases, as nonetheless generally endorsing the “rule” that the United States has expansive inherent authority to sue.¹⁶⁷ Any doubt as to whether that Division views the *In re Debs* line of cases as distinct from the private and public implied right of cases was put to rest by the assertion that “whether the United States can enforce a statute under its inherent authority and whether a statute creates an implied private cause of action do not intersect.”¹⁶⁸ Indeed, in a separate proceeding in the same district, the Division appeared as *amicus curiae* to support a serviceman’s implied private right, arguing that *Cort* was applicable.¹⁶⁹

Then there are the outliers, the decisions that defy, or at least challenge, easy classification in the acknowledged/tolerated categories. First, within the national security classification itself, decisions such as *Arlington County* and *B.C. Enterprises* are arguably only tangentially related to national security “or the exercise of military powers.”¹⁷⁰ They can alternatively be explained as furthering, through an inherent litigation authority, a statutory objective.¹⁷¹ And in which category is *United States v. Colorado Supreme Court*,¹⁷² in which the United States

162. Brief of the United States as Appellee at 8, *United States v. B.C. Enter., Inc.*, 447 Fed. App’x 468 (4th Cir. 2011) (No. 10-1372).

163. *United States v. Solomon*, 563 F.2d 1121, 1127 (4th Cir. 1977)..

164. Brief of the United States as Appellee, *supra* note 162, at 14.

165. *Id.* at 9.

166. *Ruotolo v. Ruotolo*, 572 F.2d 336, 339 (1st Cir. 1978) (no right of action to seek disqualification of counsel for bankruptcy debtor when United States not a party to proceeding).

167. Brief of the United States as Appellee, *supra* note 162, at 9.

168. *Id.* at 14. “A different test and body of caselaw applies. . .” *Id.* at 15.

169. Brief for the United States as Amicus Curiae in Support of Plaintiff-Appellant Urging Reversal, *Gordon v. Pete’s Auto Service of Denbigh*, 637 F.3d 454 (4th Cir. 2011) (No. 09-2393). The defendant in that case agreed that *B.C. Enterprises* was decided under a different theory. Brief of Appellee, *Gordon v. Pete’s Auto Service of Denbigh, Inc.*, 637 F.3d 454 (4th Cir. 2011) (No. 09-2393).

170. Note, *Implied Executive Authority to Bring Suit to Enforce the Rights of Institutionalized Citizens*, 26 CATH. U. L. REV. 794, 799 n.27 (1977).

171. The *Solomon* court, after identifying instances in which it had permitted the United States to seek recovery of improperly disbursed federal funds, *Wilson Clinic & Hospital, Inc. v. Blue Cross of South Carolina*, 494 F.2d 50, 52 (4th Cir. 1974), and to enforce tax immunity for national defense objectives, *Arlington County; Marchetti*, noted that in those cases “the United States had a property interest to be protected or there was a well-defined statutory interest of the public at large to be protected.” 563 F.2d at 1127 (emphasis added).

172. *United States v. Colorado Supreme Court*, 87 F.3d 1161, 1165-66 (10th Cir. 1996).

successfully challenged the State of Colorado regarding the application of a professional ethics rule to federal prosecutors. Or *Commonwealth of Pennsylvania v. Porter*,¹⁷³ which post-*City of Philadelphia* relied on *In re Debs* for its finding that the United States has *parens patriae* standing to remedy civil rights violations and that “federal sovereign interests support the settled standing of the United States to bring” actions seeking injunctive relief.¹⁷⁴ Or *Brennan v. Buckeye Industries, Inc.*,¹⁷⁵ involving a non-statutorily authorized injunction to secure a workplace inspection. These decisions, and the Civil Rights Division’s brief in *B.C. Enterprises*, suggest two things. The categories are not, at least in the view of that Division, a complete recitation of the government’s inherent authority, and there are instances, albeit few in number, in which the government does in fact assert *In re Debs*’ applicability in non-traditional contexts and meets with judicial approval. Indeed, the government did not seek to apply *In re Debs* in both the national security and civil rights/Commerce Clause arenas until the 1960s, in ways that must have seemed non-traditional to both courts and Justice Department lawyers at the time.¹⁷⁶

Given the waning strength of *Wyandotte* as support for such actions, it would be surprising if the Civil Division ignored *In re Debs* and its progeny in future lawsuits seeking recovery for damage to government property or the recovery of costs. Moreover, and more significantly for potential patent actions, the Department seems highly reluctant to voluntarily straightjacket the doctrine by acquiescing to narrow categories when *In re Debs* speaks of broad authority. Courts are unlikely to find that the “mere incantation of ‘sovereign interests’”¹⁷⁷ is sufficient, but between that extreme and cramped traditional categories lies the “murky” area that, in a post-*Wyandotte* era, the United States may increasingly need to explore.

173. *Commonwealth of Pennsylvania v. Porter*, 659 F.2d 306 (3d Cir. 1981) (en banc).

174. *Id.* at 316.

175. *Brennan v. Buckeye Industries, Inc.*, 374 F. Supp. 1350, 1353 (S.D. Ga. 1974).

176. The Justice Department’s tactical approach and decision to argue for the applicability of *In re Debs* are described in Steven J. Pollak et al., *Civil Rights Division Association Symposium: The Civil Rights Division*, 30 MCGEORGE L. REV. 957, 964-66 (1999).

177. *In re National Sec. Agency Telecommunications Records Litigation*, 633 F. Supp. 2d 892, 901 (N.D. Cal. 2007).

III. PROCEDURAL AND TACTICAL CONSIDERATIONS AND IMPACTS

A. Subject Matter Jurisdiction and Standing Would Not be Problematic

If a cause of action exists, the United States through the Justice Department will have standing to pursue it, and subject matter jurisdiction for either an implied or inherent non-statutory action in which the United States is a plaintiff is provided by statute. 28 U.S.C. § 1345 (2012) grants federal district courts “original jurisdiction of all civil actions, suits or proceedings commenced by the United States, or by any agency or officer thereof expressly authorized to sue by Act or Congress.”¹⁷⁸ Standing and the existence of a cause of action are separate concepts, even though courts (including in the implied and inherent cases) often conflate the two, as do some commentators.¹⁷⁹ While the catchphrase, “without more, a federal interest based solely on sovereignty is likely insufficient to justify a cause of action, “ should be given credence, courts have made clear that, in essence, the mere articulation of a public interest in a case brought by the United States suffices to demonstrate standing.¹⁸⁰ Accordingly, when courts have rejected implied or inherent claims by the United States,¹⁸¹ they have

178. The Supreme Court has interpreted Section 1345 to provide for subject matter jurisdiction if the litigation is commenced by a federal party, the United States or agency plaintiff has standing to sue, and there is no statutory exception to the general grant of jurisdiction. *Fed. Sav. & Loan Ins. Co. v. Ticktin*, 490 U.S. 82, 85 (1989). Thus, the inquiry is dependent, in part, on the outcome of the standing analysis. Standing should not, however, prove an obstacle here, and while there is a sound argument that no separate inquiry into the United States’ standing is either necessary or proper, because of the presence of the patentee as a plaintiff, it ought not be necessary for the Justice Department to further contend that private standing rules are inapplicable.

179. See, e.g., *In re Debs*, 158 U.S. 564, 582 (1895); *Sanitary Dist. of Chi. v. United States*, 266 U.S. 405, 426 (1925); YALE NOTE, *supra* note 127, at 118; Recent Development, *supra* note 158, at 951.

180. See, e.g., *Vt. Agency of Natural Res. v. United States ex rel. Stevens*, 529 U.S. 765, 771 (2000); *FTC v. Dean Foods Co.*, 384 U.S. 597, 606 (1966); *United States v. Arlington County*, 326 F.2d 929, 931 (4th Cir. 1964).; See generally Tara Leigh Grove, *Standing Outside of Article III*, 162 U. PA. L. REV. 1311, 1326 (2014).

181. See, e.g., *U.S. v. City of Philadelphia*, 644 F.2d 187 (3d Cir. 1980); *U.S. v. Solomon*, 563 F.2d 1121 (4th Cir. 1977); *U.S. v. Mattson*, 600 F.2d 1295 (9th Cir. 1979). Doubters might argue that because *San Jacinto Tin* stated that “if it is apparent that the suit is brought for the benefit of some third party” the United States lacks standing absent a pecuniary interest or obligation, it may not sue to enforce a private patent. *U.S. v. San Jacinto Tin Co.*, 125 U.S. 273, 286 (1888). Likewise, the Court in *In re Debs*, without elaboration, stated that the government should not “interfere in any mere matter of private controversy.” *In re Debs*, 158 U.S. at 586. But the *San Jacinto Tin* Court found that the United States had standing even though there was an identified non-party that would likely obtain the land patent if the claim for nullification succeeded. 125 U.S. at 287. The fact that there was a beneficiary was not disqualifying, as long as the government had an independent interest in bringing the litigation. Similarly, the court in *B.C. Enterprises* vocalized no standing concerns even though the United States was seeking damages for particular absent servicemembers. *U.S. v. B.C. Enters Inc.*, 696 F. Supp. 2d 593 (E.D. Va. 2010). In a patent case, the United States would not be pursuing the lawsuit solely for the purpose of benefitting the patentee,

impliedly done so on the basis that no right of action exists, not because of the absence of standing.¹⁸²

B. Much About the Conduct of Litigation Would Not Change

The presence of the United States, through the Justice Department, as a plaintiff in a private patent case would present several case management issues. The determinations made by the Civil Division on these questions could affect the extent to which patentees view the United States as a desirable co-plaintiff. For example, presumably one benefit to patentees could be that patent examiners might be more frequently made available to testify, or perhaps required to do so by courts. During claim construction, the United States could seek to present examin-

but rather to advance its own sovereign interest in promoting the integrity of the patent system. Likewise, the United States would not be standing in the shoes of the patentee, who would be a co-plaintiff. Therefore, even though the patentee would benefit by a successful action, there should be no third-party standing concern.

182. As an alternative to filing a complaint with the patentee, e.g., in instances in which the United States either independently determines to participate in an existing suit (either to fully support the patentee's case or to present a different claim construction or merits argument) or is courted to do so, the Justice Department could seek to intervene. A possible, but slight, advantage could be strategic filing in light of a circuit split concerning whether a proposed intervenor as of right must demonstrate Article III standing. *See San Juan County v. United States*, 420 F.3d 1197, 1204-05 (10th Cir. 2005) (describing circuit split), *rev'd on other grounds*, *San Juan County v. United States*, 503 F.3d 1163, 1167 (10th Cir. 2007). The Federal Circuit has apparently not addressed the issue. To intervene as of right under Rule 24(a), the United States would be obligated to show (1) it has an interest, (2) disposition of the case without intervention, would, as a practical matter, impair or impede its interest, (3) the interest is inadequately represented by the patentee, and (4) the motion is timely made. *See Ewers v. Heron*, 419 F.3d 1, 3 (1st Cir. 2005). The interest need not be the same as the patentee's. *See, e.g., Solid Waste Agency of N. Cook Cnty v. U.S. Army Corps*, 101 F.3d 503, 506 (7th Cir. 1996). Courts routinely accept statements of government interest that are broader than the concerns of a private party. *See, e.g., Sierra Club v. Robertson*, 960 F.2d 83, 86 (8th Cir. 1992) (recognizing the scope of government interest is broader than that of a private party); *Smith v. Pangilinan*, 651 F.2d 1320, 1324-25 (9th Cir. 1981) (allowing the Attorney General to intervene on behalf of the U.S. due to the protected interest in an action concerning citizenship). For example, in *Heaton v. Monogram Credit Card Bank*, 297 F.3d 416 (5th Cir. 2002), the court noted the FDIC's "broader interest in protecting the proper and consistent application of the Congressionally designed framework to ensure the safety and integrity of the federal deposit insurance system." *Id.* at 424. It observed that "[g]overnment agencies such as the FDIC must represent the public interest, not just the economic interests of one industry." *Id.* at 425. Some courts have held that the interest prong does not mandate demonstration of a right to sue. *See, e.g., U.S. v. Philip Morris USA, Inc.*, 566 F.3d 1095, 1145 (D.C. Cir. 2009) ("intervention of right only requires 'an interest' in the litigation—not a 'cause of action' or 'permission to sue.'" (citation omitted)); *Flying J, Inc. v. J.B. Van Hollen*, 578 F.3d 569, 571--72 (7th Cir. 2008).), but others disagree. *See, e.g., Sokaogon Chippewa Cmty. v. Babbit*, 214 F.3d 941, 946 (7th Cir. 2000); *Heyman v. Exchange Nat'l Bank of Chi.*, 615 F.2d 1190, 1193 (7th Cir. 1980); *Diaz v. S. Drilling Corp.*, 427 F.2d 1118, 1124 (5th Cir. 1970). *See generally* Justin P. Gunter, Note, *Dual Standards for Third-Party Intervenors: Distinguishing Between Public-Law and Private-Law Intervention*, 66 VAND. L. REV. 645, 664--67 (2013) (surveying different approaches to the sufficient-interest requirement). Once the court accepts the presence of an interest or cause of action, it should readily find that the third prong is satisfied. And courts have little difficulty understanding that intervenor status conveys advantages over amicus participation. Timeliness, in a private patent case, presents no unique issues.

er testimony to explain a reference,¹⁸³ an isolated statement,¹⁸⁴ a cryptic remark,¹⁸⁵ or an ambiguity¹⁸⁶ in the prosecution history, particularly if an issue of disclaimer¹⁸⁷ arises, and could therefore provide a justification for courts to give increased weight to prosecution history.¹⁸⁸ At present, in light of judicial determinations that examiners, as quasi-judicial officers,¹⁸⁹ should not be subject to deposition or required to give to give testimony regarding their mental processes, analyses, or conclusions,¹⁹⁰ examiner depositions are rarely sought in infringement cases.¹⁹¹ The PTO's Manual of Patent Examining Procedure relies in part upon those rulings in stating that examiners should "refuse to express to any person any opinion as to the validity or invalidity of" a patent.¹⁹² The regulation that the PTO adheres to concerns both expert and opinion testimony by government employees but addresses cases in which the United States is a party only by providing that "an employee [of the United States] may not testify as an expert or

183. See *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1343 (Fed. Cir. 2009) (discussing weight to be placed on statements by an examiner).

184. See *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371-72 (Fed. Cir. 2007) (finding that particular statement did not result in a disclaimer where they "did not amount to a clear and unmistakable surrender of claim scope").

185. See, e.g., *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1377 (Fed. Cir. 2009) (having access only to the prosecution history, the court placed no emphasis on the examiner's "cryptic remarks" in interview summaries).

186. The Federal Circuit has noted that prosecution history, because it reflects an ongoing negotiation process, is often less helpful than the written specifications and therefore of less utility during claim construction. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc).

187. See *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323-26 (Fed. Cir. 2003).

188. See Greg Reilly, *Judicial Capacities and Patent Claim Construction: An Ordinary Reader Standard*, 20 MICH. TELECOMM. & TECH. L. REV. 243, 259 (2014) ("Phillips held that a court should consider a patent's prosecution history if it is in evidence."); Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 NW. U. L. REV. 1, 45 (2013) (discussing how the Federal Circuit's ruling in *Phillips* has impacted utilization of prosecution history).

189. *U.S. v. Am. Bell Tel. Co.*, 128 U.S. 315, 363 (1888) ("The patent . . . is the result of a course of proceeding quasi judicial in its character . . ."); *Butterworth v. U.S. ex rel. Hoe*, 112 U.S. 50, 67 (1884).

190. See *U.S. v. Morgan*, 313 U.S. 409, 422 (1941) (holding that the Secretary of Agriculture, as an administrative agent, should not be subjected to depositions resembling judicial proceedings); *Western Elec. Co. v. Piezo Tech., Inc.*, 860 F.2d 428, 432-33 (Fed. Cir. 1988) (disallowing questions posed to examiner for a number of reasons, including the concern that "(t)hey tend to be disruptive of the decisionmaking process and thereby interfere with the PTO's administrative functions"); *In re Nilssen*, 851 F.2d 1401, 1402 (Fed. Cir. 1988) ("The technical background and other professional qualifications of the particular Examiners-in-Chief [of the Patent Trial and Appeal Board] are not legally relevant in an appeal to the board . . .")

191. Laurence H. Pretty, *Where the Veil Against Discovery in Patent Litigation Falls*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 71, 71-86 (1994).

192. U.S. PAT. & TRADEMARK OFFICE, MANUAL OF PAT. EXAMINING PROC. § 1701 (9th ed. 2014). See Edward D. Manzo, *How to Improve Patent Claim Interpretations*, 22 FED. CIRCUIT B.J. 203, 208 (2012) ("[t]hrough their testimony would be helpful, patent examiners are not allowed to testify on their mental processes or various other issues").

opinion witness for any party other than the United States.”¹⁹³ Yet the concern that subjecting examiners to questioning interferes with the PTO’s administrative functions¹⁹⁴ has equal force when the United States is seeking to enforce a private patent. Moreover, questioning examiners on mental processes in evaluating applications or with regard to validity is inconsistent with the statutory presumption of patent validity and the presumption that the examiner has properly exercised her duties.¹⁹⁵ Accordingly, the PTO should take the position that it will not authorize examiners to testify in a private patent enforcement case in which the United States is a plaintiff, except as provided in its procedures manual,¹⁹⁶ and the Civil Division should object to subpoenas issued to examiners when the procedures for requesting testimony are not complied with or when the PTO General Counsel has determined that the examiner should not testify or may testify only on specified matters. PTO attorneys should participate in any depositions or trial proceedings in which an examiner is testifying in order to lodge appropriate objections.¹⁹⁷

Other procedural and litigation participation issues¹⁹⁸ concern the prevalence of patent fraud,¹⁹⁹ the ability of third parties to seek post-grant²⁰⁰ and inter partes review²⁰¹ by the Patent Trial and Appeal

193. 37 C.F.R. § 104.23(d) (2014).

194. *Western Elec. Co.*, 860 F.2d at 432–33.

195. 35 U.S.C. § 282 (2012). *See* *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2243 (2011) (describing the origin and significance of the presumption of validity). Likewise, courts should continue to reject any testimony regarding the capabilities of the examiner, or how much time she spent on the application. *See, e.g., Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984).

196. While the PTO has statutory authority to issue procedural rules under 35 U.S.C. § 2(b)(2)(A) (2012), no new rule or revision to the procedures manual is necessary.

197. If the PTO has a disagreement with the Civil Division regarding this matter or otherwise, it would not set forth a competing position in the litigation, but rather would resolve the dispute within the Executive Branch by submitting the issue to the Attorney General. *See* Exec. Order 12,146, 44 Fed. Reg. 42,657 (July 20, 1979). Even agencies with independent litigating authority must submit disputes pursuant to the Executive Order. *See, e.g., Tenn. Valley Auth. v. U.S.*, 13 Cl. Ct. 692, 702 (Cl. Ct. 1987). The existence of a disagreement would not justify a refusal to accord privilege protection to communications between Civil and the PTO, or between Civil and another Division within DOJ. *See, e.g., U.S. v. Jicarilla Apache Nation*, 131 S. Ct. 2313, 2321 (2011) (holding that attorney-client privilege protects communications between government officials and government attorneys).

198. This discussion is not intended to be exclusive.

199. *See Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*, 382 U.S. 172, 174 (1965) (finding that patent fraud may violate the Sherman Act); *Handgards, Inc. v. Ethicon, Inc.*, 601 F.2d 986, 993 (9th Cir. 1979). *See generally* Christopher R. Leslie, *Monopolization Through Patent Theft*, 103 GEO. L.J. 47, 48–50 (2014) (identifying prevalence of patent theft in many fields) R. Leslie, *Antitrust, Inequitable Conduct, and the Intent to Deceive the Patent Office*, 1 UC IRVINE L. REV. 323, 325 (2011) (discussing the impact of invalid patents on competition).

200. 35 U.S.C. §§ 321–29 (2012).

201. *Id.* at §§ 311–19.

Board, patentee requests for reconsideration²⁰² and PTO reexaminations,²⁰³ and antitrust and settlement concerns. If a third-party-initiated review, reconsideration, or reexamination is ongoing at the time a patentee requests that the Civil Division join in a complaint or seek to intervene, no action should be undertaken until the conclusion of the PTO or Board process, through the issuance of written findings or the exhaustion of appeals, as appropriate. Similarly, for infringement cases, the Division should support a stay, including of discovery, pending the outcome of any reexamination or reissuance proceeding involving the patent at issue (and should do so even if such proceedings did not routinely result in invalidation or modification of the original patent).²⁰⁴ The United States should also uniformly agree to litigation stays if third-party review is initiated during the pendency of a case it has joined. Although the presumption of validity still attaches until the PTO determination, stays often result in simplifying the issues to be determined by the court, and a stay recognizes the integrity of the PTO process.²⁰⁵ Further, the Civil Division should, before filing a complaint or intervening, consult with the PTO to ascertain whether there is any evidence of patent fraud,²⁰⁶ and refer such cases to the Criminal Division. But because of the presumption of validity, in the absence of such evidence there need be no independent investigation of the strength of the patent prior to bringing, or intervening in, an infringement claim.²⁰⁷ If the patentee proposes a settlement involving a

202. *Id.* § 257(a).

203. *Id.* § 257(b).

204. Courts have recognized the benefits of the reexamination and reissuance processes. *See, e.g.,* MercExchange, L.L.C. v. eBay, Inc., 500 F. Supp. 2d 556, 563–64 (E.D. Va. 2007); *In re Cygnus Telecomms. Tech., LLC, Patent Litig.*, 385 F. Supp. 2d 1022, 1023 (N.D. Cal. 2005). A stay is appropriate because a reexamination is “probative to the issue of whether defendants have raised a substantial question of validity.” *Pergo, Inc. v. Faus Group, Inc.*, 401 F. Supp. 2d 515, 524 (E.D.N.C. 2005).

205. Courts have discretion on this issue. *See, e.g.,* Viskase Corp. v. Am. Nat’l Can Co., 261 F.3d 1316, 1328 (Fed. Cir. 2001). The exception would be a requested stay that would impose an obligation upon the PTO. Such requests should be opposed as inappropriate under Federal Circuit precedent. *See* *Emerson Elec. Co. v. Davoil, Inc.*, 88 F.3d 1051, 1054 (Fed. Cir. 1996).

206. The PTO Director has an affirmative obligation to report any known evidence of a material fraud in connection with a patent subject to a supplemental examination by the Attorney General. 35 U.S.C. § 257(e) (2012). *See* J. Thomas Rosch, *Patent Law and Antitrust Law: Neither Friend Nor Foe, But Business Partners*, 13 SEDONA CONF. J. 95, 98 (2012).

207. *See* *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295, 1303 (Fed. Cir. 2004). Of course, to satisfy professional ethical obligations, the Division should examine evidence of infringement obtained by the patentee or by government personnel, in accordance with Rule 11 and judicial interpretations of the Rule, to determine independently that there is a good faith basis for the suit. This is the same standard that is applicable to the patentee. *See, e.g.,* *Source Vagabond Sys. Ltd. v. Hydrapak, Inc.*, 753 F.3d 1291, 1298 (Fed. Cir. 2014) (stating that Rule 11(b) requires a reasonable inquiry that the legal contentions are warranted by existing law and that the factual contentions have evidentiary support). Relatedly, and again operating on the statutory presumption, the United States should oppose counterclaims for declaratory judgment as to

licensing arrangement, the Civil Division should consult with the Antitrust Division and the Federal Trade Commission (FTC) to determine whether there are monopolization concerns. In appropriate cases, the Civil Division should either seek voluntary dismissal of its claim or actively oppose a settlement on the ground that the claim will harm competition.²⁰⁸ If, however, there is an antitrust counterclaim, it would be appropriate for the United States to take the position that the infringement issue should be determined first, then reassess its view during a subsequent antitrust phase. Similarly, unless there is evidence of patent fraud, the Civil Division should treat requests to intervene in a separate declaratory judgment action brought by a purported infringer in the same manner it examines a potential or existing affirmative claim.

These suggested approaches, if adopted, may dampen the ardor to some extent, though much about patent litigation would not change. There is, for example, little reason to believe that the presence of the United States as co-plaintiff will affect the statistical odds that a lawsuit will survive a defensive summary judgment motion,²⁰⁹ or that the use of offensive summary judgment will increase.²¹⁰ Nor will cases brought

invalidity. Likewise, if the court finds that there is no infringement, and a declaratory claim on validity is pending or subsequently filed, the Civil Division should ordinarily oppose the requested relief. *See MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 136 (2007) (court has discretion to hear claim). And the mere existence of an inequitable conduct defense should not deter the Division from proceeding in the case or intervening, because courts require clear and convincing evidence of intentional deceit. *See Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) (en banc).

208. There are other issues related to settlements, which are commonplace in patent litigation that the Division will need to consider. *See, e.g.*, Jay P. Kesan & Gwendolyn G. Ball, *How Are Patent Cases Resolved? An Empirical Examination of the Adjudication and Settlement of Patent Disputes*, 84 WASH. U. L. REV. 237, 272 & n.216, 273-74 (2006) (highlighting commonplace settlement issues, their probability of settlement, and indicators that parties are preparing to settle). Part of the objection to the frequent use of so-called "secret settlements" in patent cases is that the settlements can shroud antitrust violations. Megan M. La Belle, *Against Settlement of (Some) Patent Cases*, 67 VAND. L. REV. 375, 408--09 (2014). Subjecting proposed settlements to FTC and Antitrust Division review would help address that concern, but others, as La Belle points out, remain, among them that a sealed settlement makes it difficult for others to ascertain reasonable royalty payments. *Id.* at 407-08; Matthew Sag & Kurt Rohde, *Patent Reform and Differential Impact*, 8 MINN. J.L. SCI. & TECH. 1, 83 (2007). But objecting to such settlements might result in either no settlement at all or the disclosure of trade secrets. *See* Robert Timothy Reagan, *The Hunt for Sealed Settlement Agreements*, 81 CHI.-KENT L. REV. 439, 453 (2006). And there is little that the Civil Division can do to prevent a patentee from using the potential that the United States might intervene in existing litigation, or has filed a motion for intervention, as a bargaining chip to extract more favorable royalty payments or other settlement terms. But the Division can certainly inquire of patentees whether settlement negotiations have been ongoing and factor that into the analysis.

209. *See* John R. Allison, Mark A. Lemley & David L. Schwartz, *Understanding the Realities of Modern Patent Litigation*, 92 TEX. L. REV. 1769, 1784--85 (2014) (showing that infringers typically do not succeed on summary judgment).

210. *Id.* at 1789-90.

under an implied or inherent authority claim likely streamline pretrial discovery,²¹¹ impact the number of cases that actually go to trial,²¹² or affect the societal costs of patent litigation in an era of “litigation-for-settlement.”²¹³ The Civil Division’s participation, albeit not as a neutral party, could potentially assist courts in determining whether, in the post-*eBay Inc. v. MercExchange, L.L.C.*²¹⁴ environment, permanent injunctions should be granted. The United States might articulate, hopefully better than private parties have done, why the “public interest would not be disserved” by issuance. That could help give shape to an equitable factor that has been poorly examined by courts.²¹⁵ But the importance of the United States as a plaintiff is not because its presence will reform patent litigation or dramatically change the odds; instead, it will enable the government to best advance its own interests through instituting or intervening in infringement cases.

CONCLUSION

The United States arguably has substantial interests in the protection of patent rights through infringement suits, not only when it is the patentee or licensee, but also in certain instances in which the patent is issued to a non-governmental entity. For example, a legitimate interest may exist when the government has placed emphasis on securing patents for companies and non-profits engaged in clean technologies or other emerging and strategic sectors identified by Congress or the executive. While this article does not seek to cabin the instances in which

211. See James F. Holderman & Halley Guren, *The Patent Litigation Predicament in the United States*, 2007 U. ILL. J.L. TECH. & POL’Y 1, 10 (“Pretrial discovery in a patent case typically takes several months and sometimes years.”).

212. Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U. L. REV. 1495, 1501 (2001) (stating that the number of patents providing the basis of lawsuits are relatively few in comparison to number of patents).

213. Damon C. Andrews, *Why Patentees Litigate*, 12 COLUM. SCI. & TECH. L. REV. 219, 223 (2011) (describing development of “litigation-for-settlement” mentality and why it has come to dominate decisions to engage in patent infringement litigation and outcomes).

214. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006). 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, 204–05 (2012) (discussing impact of decision’s adoption of traditional four-prong equitable test for injunctions).

215. Liza Vertinsky details the relatively small weight given by post-*eBay* courts to the public interest prong. Liza S. Vertinsky, *Making Room for Cooperative Innovation*, 41 FLA. ST. U. L. REV. 1067, 1105–06 (2014). This does not suggest, however, that the Justice Department should uniformly endorse permanent injunctions whenever it acts as a co-plaintiff. The Civil Division should coordinate with the Solicitor General’s office and interested agencies on macro- and micro-strategy given the myriad issues related to the issuance of injunctive relief. See, e.g., Golden, *supra* note 18, at 578–82 (discussing potential pro-injunction presumptions); Thomas F. Cotter, *Patent Holdup, Patent Remedies, and Antitrust Responses*, 34 J. CORP. L. 1151, 1179 (2009) (arguing general principle of awarding injunctive relief should not be followed in every instance).

the Justice Department should give serious examination to filing an infringement action as a co-plaintiff or by intervening as of right in existing litigation concerning a private patent, it has discussed a means by which identified government interests in private patent enforceability can, in the most effective manner, be advanced.