


2018

# The Supreme Court Puts the Brakes on Cuozzo Speed Technologies: Investigating the Intersection of Administrative Law and the Judiciary

Jason Kuchar

Follow this and additional works at: <https://open.mitchellhamline.edu/cybaris>

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

## Recommended Citation

Kuchar, Jason (2018) "The Supreme Court Puts the Brakes on Cuozzo Speed Technologies: Investigating the Intersection of Administrative Law and the Judiciary," *Cybaris*®: Vol. 9 : Iss. 1 , Article 2.

Available at: <https://open.mitchellhamline.edu/cybaris/vol9/iss1/2>

This Article is brought to you for free and open access by the Law Reviews and Journals at Mitchell Hamline Open Access. It has been accepted for inclusion in Cybaris® by an authorized administrator of Mitchell Hamline Open Access. For more information, please contact [sean.felhofer@mitchellhamline.edu](mailto:sean.felhofer@mitchellhamline.edu).

© Mitchell Hamline School of Law

**THE SUPREME COURT PUTS THE BRAKES ON CUOZZO  
SPEED TECHNOLOGIES: INVESTIGATING THE  
INTERSECTION OF ADMINISTRATIVE LAW AND THE  
JUDICIARY**

BY JASON KUCHAR

Table of Contents

I. INTRODUCTION.....	23
II. THE PATENT OFFICE HAS HISTORICALLY BEEN GRANTED ONLY A LIMITED ABILITY TO PROMULGATE ITS OWN RULES.....	25
III. ORIGINS OF POST GRANT PATENT REVIEW.....	31
IV. THE ADMINISTRATIVE PROCEDURES ACT.....	33
<i>A. Judicial Review of the Administrative Procedures Act.....</i>	<i>36</i>
V. WHAT IS THE PROPER CLAIM CONSTRUCTION STANDARD TO USE DURING AN INTER PARTES REVIEW PROCEEDING.....	37
<i>A. The Patent Office Uses the Broadest Reasonable Interpretation Standard When Construing Claim Construction.....</i>	<i>37</i>
<i>B. The Courts Use the “Ordinary Meaning as Understood by Those Skilled in the Art” Standard in Claim Construction....</i>	<i>38</i>
VI. CUOZZO SPEED TECHNOLOGIES V. LEE.....	39
<i>A. Procedural history.....</i>	<i>39</i>
<i>B. The Majority’s Opinion Holds That The Patent Office’s Decision To Institute Inter Partes Review Is Not Reviewable.....</i>	<i>41</i>
<i>C. Justice Thomas’s Concurring Opinion.....</i>	<i>45</i>
<i>D. Justice Alito’s Dissent (Joined by Justice Sotomayor....</i>	<i>45</i>
VII. FUTURE DIRECTIONS AFTER CUOZZO.....	47
<i>A. Will Courts Show Complete Deference to the Patent Office Going Forward?.....</i>	<i>48</i>
<i>B. Will the Patent Office Advance Toward the Deference Accorded to Other Administrative Agencies?.....</i>	<i>49</i>
<i>C. Will the Court Defer to the Patent Office when interpreting Section 102?.....</i>	<i>51</i>

*D. The Broadest Reasonable Interpretation Should Not Be Used in an Inter Partes Review Proceeding*.....52

*E. Different Outcomes In Different Settings*.....54

VIII. THE COURT IN *CUOZZO* GOT IT WRONG.....55

*A. Because legislative intent was not ambiguous, the Court should not have employed Chevron to decide the case*.....55

*B. The Court should have ruled in favor of Cuozzo based on Administrative Law principles*.....55

IX. CONCLUSION.....56

## I. INTRODUCTION

The purpose of the United States patent system is to balance the goals of “promot[ing] the Progress of Science and useful Arts,” with “. . . securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>1</sup> Congress has enacted the patent statutes<sup>2</sup> in an effort to optimize the public benefit of encouraging investment into research and development against the social cost of granting to inventors exclusive rights to their inventions for 20 years.<sup>3</sup> As such, Congress has determined that an applicant must meet four criteria in order to overcome the general public policy against the granting of a monopoly—even if for only a limited time. First, the invention must have utility.<sup>4</sup> Second, the invention must be novel.<sup>5</sup> Third, the invention must not be obvious in view of a person of ordinary skill in the art.<sup>6</sup> Fourth, the invention must be fully described with

---

<sup>1</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>2</sup> See 35 U.S.C. §§ 1-390 (2015).

<sup>3</sup> See generally STUDY OF THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE COMMITTEE ON THE JUDICIARY, 85<sup>TH</sup> CONG. 2D SESSION, AN ECONOMIC REVIEW OF THE PATENT SYSTEM (1958) (Fritz Machlup).

<sup>4</sup> 35 U.S.C.A. § 101 (West, through Act 2015) (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).

<sup>5</sup> 35 U.S.C.A. § 102 (West, through Act 2015) (“(a) Novelty; prior art.--A person shall be entitled to a patent unless--(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention....”).

<sup>6</sup> 35 U.S.C.A. § 103 (West, through Act 2015) (“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.”).

specificity in an enabling disclosure.<sup>7</sup>

The United States Patent and Trademark Office (Patent Office) has been tasked by Congress with administering the day-to-day operation of examining patent applications, issuing patents, and reexamining existing patents. In spite of this, the historic practice has been that Congress and the courts have denied the Patent Office the same rule making authority granted to other agencies under the Administrative Procedures Act<sup>8</sup> to effectuate their mission. With the passage of the America Invents Act<sup>9</sup> and the decision in *Cuozzo Speed Technologies, LLC v. Lee*,<sup>10</sup> the Patent Office's rule making authority makes a significant stride toward having the ability to interpret congressional statutes and be given deference by the courts for those interpretations similar to the deference given to other agencies. Although courts are typically considered the final arbiters to say what the law is,<sup>11</sup> this proposition is in doubt when administrative agencies are able to promulgate their own rules; enforce those rules through agency actions; and adjudicate those cases in administrative proceedings. Because the Court chose not to reign in the Patent Office when it clearly went beyond its statutory authority, the courts are likely to defer to the Patent Office's interpretation of patent issues going forward.<sup>12</sup>

This article explores the intersection of patent law and administrative rules, and the role of both agencies and courts in divining legislative intent viewed through a study of the decision in *Cuozzo Speed Technologies, LLC v. Lee*.<sup>13</sup> First, this article explores the historical practice the Patent Office has played in administering the patent laws and the traditional view of Congress and the courts to deny the Patent Office substantive rule making authority. Second, the origins of the Administrative Procedures Act and how its subsequent application has affected Patent Office practice is reviewed. This includes a discussion of the seminal Supreme Court case interpreting the Administrative Procedures Act, because this seminal case, *Chevron*,

---

<sup>7</sup> 35 U.S.C.A. § 112 (West, through Act 2015) (“(a) **In general.**—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention . . .”).

<sup>8</sup> 5 U.S.C. §§ 551-559 (2015).

<sup>9</sup> Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, 125 Stat. 284 (2011).

<sup>10</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016).

<sup>11</sup> *See Marbury v. Madison*, 5 U.S. 137, 177 (1803).

<sup>12</sup> *See infra* part VII.

<sup>13</sup> *Cuozzo*, 136 S. Ct. 2131.

*U.S.A., Inc. v. Natural Resource Defense Council, Inc.*,<sup>14</sup> was cited as controlling precedent in deciding *Cuozzo*. Before moving onto an in-depth discussion of *Cuozzo*, a comparison is made on one of the key points of contention in the case between the Patent Office's claim construction standard which uses the broadest reasonable interpretation and the court's claim construction standard which uses 'as understood by those skilled in the art.' With this back drop the Supreme Court decision in *Cuozzo* is discussed in detail. Lastly, an analysis of the impact of the *Cuozzo* decision is made and an analysis of whether or not the courts will continue to give deference to Patent Office interpretations of congressional intent or will return the historical practice of leaving the interpretation of the core patent statutes to the courts.

## II. THE PATENT OFFICE HAS HISTORICALLY BEEN GRANTED ONLY A LIMITED ABILITY TO PROMULGATE ITS OWN RULES

Many of the principles and fundamental doctrines surrounding patent rights were firmly established well before the Patent Office came into being. For example, patent rights were granted throughout the colonies in the new world even prior to the establishment of the federal patent system.<sup>15</sup> The ability of the United States government to grant letters patent and copyrights were then subsequently incorporated into the United States Constitution.<sup>16</sup> Initially, patents were granted solely through an act of Congress and not through the executive branch.<sup>17</sup> This quickly became overly cumbersome for Congress to decide on the merits of every patent application.<sup>18</sup> Thus, Congress delegated this duty to the executive branch through the first Patent Act of 1790.<sup>19</sup> The first Act spelled out in great detail how the executive branch was to carry out its duties regarding patents including who specifically was to examine the patent applications and how they were to decide

---

<sup>14</sup> *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

<sup>15</sup> Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (5 Part I)*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 615, 615-16 (1996).

<sup>16</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>17</sup> The ability of a patent applicant to receive a patent through a private bill submitted to congress is still available, but is rarely used anymore. *See, e.g.*, Devin Dwyer, *Looking for a Bailout? Just Call Your Congressman*, ABC NEWS (Nov. 5, 2009), <http://abcnews.go.com/Politics/congress-private-laws-bailout-americans-special-cases/story?id=8995047>.

<sup>18</sup> P.J. Frederico, *The Patent Act of 1793*, 18 J. PAT. OFF. SOC'Y 77 (1936) (SPECIAL ISSUE).

<sup>19</sup> Patent Act of 1790, 1 Stat. 109 (1790).

which patents met the Act's provisions. These specifics left very little discretion to the executive branch as to how to administrate the patent system. This slowly changed over time with Congress deferring more and more responsibility to the executive branch in determining how best to administer the patent system at least regarding internal procedural matters. This is illustrated by the subsequent history of the Patent Office.

The first Patent Act passed in 1790<sup>20</sup> was replaced by a somewhat longer and more detailed Act in 1793.<sup>21</sup> One of the first provisions to be changed was the designation of who would be able to grant a patent. Because the process of examination was so intensive, it did not make sense to burden top level cabinet officials such as the Secretary of the Department of War with this work.<sup>22</sup> This onerous examination process combined with the omission of the requirement of "sufficiently useful" caused the patent system to effectively move from a patent examination system to a patent registration system for a time.<sup>23</sup> Another change in the Patent Act of 1793 gave the executive branch the discretion, without direct congressional oversight, to appoint a Superintendent of the Patent Office.<sup>24</sup> As the case load of patent examinations increased, the Patent Office eventually became a separate agency under the Superintendent within the Department of State.<sup>25</sup> Nonetheless, a number of provisions from these early acts have survived in the modern patent statutes to this day including: the patenting of inventions that were not previously known or used; limiting patents to the first inventor; a system of judicial remedies for infringement; and the requirement of disclosure.<sup>26</sup> As the number of applications increased so did the need for the Patent Office to adopt standard procedures for handling the increased workload.

---

<sup>20</sup> Patent Act of 1790, 1 Stat. 109 (1790). *See generally* Edward C. Walterscheid, *Charting A Novel Course: The Creation of the Patent Act of 1790*, 25 AIPLA Q.J. 445 (1997).

<sup>21</sup> Patent Act of 1793, 1 Stat. 318 (1793).

<sup>22</sup> *Compare* Patent Act of 1790, 1 Stat. 109 (1790) ("[I]t shall and may be lawful to and for the Secretary of State, the Secretary for the department of war, and the Attorney General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out."), *with* Patent Act of 1793, 1 Stat. 318 (1793) ("[I]t shall and may be lawful for the said Secretary of State, to cause letters patent to be made out."); *see* Lawrence C. Kingsland, *The United States Patent Office*, 13 LAW AND CONTEMPORARY PROBLEMS 354–57 (Spring 1948), <http://scholarship.law.duke.edu/lcp/vol13/iss2/8>.

<sup>23</sup> *Kingsland*, *supra* note 22, at 357.

<sup>24</sup> *Id.* at 358.

<sup>25</sup> *Id.*

<sup>26</sup> 1 MOY'S WALKER ON PATENTS § 1:18 (4th ed.) (Jan. 2016).

These earlier Acts were repealed and replaced in 1836, and further added to by the 1839 amendments, which introduced some new provisions to the substantive patent laws at that time.<sup>27</sup> For example, one of the major changes was to move away from the *de facto* patent registration system that had been established back to an application and examination system where the Superintendent of the Patent Office was to issue patents only to applications that met the statutory requirement of validity.<sup>28</sup> This was done because many inventors were apparently abusing the system by registering invalid patents as a means of asserting frivolous

---

<sup>27</sup> Patent Act of 1836, 5 Stat. 117 (1836).

<sup>28</sup> *Id.* at sec. 7. For example, a letter sent by Mr. C. W. Peale illustrates the informal nature of the registration system of patents prior to this change in a letter sent to William Thornton, the Superintendent of the Patent Office during this time:

Dear Sir,

On my return from the head of the Chesapeake I find that my son Rubens had received the papers respecting Mr. Hawkins' Patent right of the Polygraph and Physionotrace accompanied with your letter of the 27 Ult. For which please to accept my thanks—

I have further to request of you, that he enclosed transferred right of the use of the Physiognotrace in the City of Philadelphia made to me, may be recorded in the secretary of States Office and then to be returned here immediately, with a certificate under the seal of office of its being recorded. This ought to have been done sooner, which my want of knowledge of the Law made me neglect, but my Lawer [sic] advises it now, and wishes to have them before he commences the suit. I do not love law suits, yet something must b3 [sic] done to prevent unjust men from robing me of my privileges.

I contemplate a small Tour in Europe as soon as I can arrange some family affairs, but most particularly to settle some exchanges with the Paris Museum, and to dispose of a Skeleton of the mammoth, a business my Son Rembrandt ought to have done before his return to America. My respectful complements to the family, with due respect your friend.

C W Peale

Papers relating to the administration of the U.S. Patent Office during the superintendency of William Thornton, 1802–1828, (compiled and edited by C.M. Harris, Daniel Preston) (May 21, 1805).



patent infringement claims.<sup>29</sup> In response, the Patent Office began to assert its authority regarding various procedural matters.<sup>30</sup> One of the congressional compromises in passing the Act introduced a new provision that allowed a grace period in which patentees had to file a patent application before the invention was deemed to have been abandoned and relegated to the public domain, rendering the invention unpatentable.<sup>31</sup> During the ensuing years, the Superintendent of the Patent Office title was replaced and changed to the Commissioner of the Patent Office and the Patent Office began to promulgate its own procedural rules for examining patent applications.<sup>32</sup>

Additional substantive changes were introduced by Congress in the Patent Act of 1870 including the requirement that an inventor disclose the best mode of carrying out the invention<sup>33</sup> and including a change to the justification for the presence of the grace period, from an inventor's subjective abandonment to a system based on laches.<sup>34</sup> The Patent Office introduced some additional changes of its own during this time relating to how patents were to be examined internally. For example, recognizing the imprecision in language, by applicants, in the language being used when claiming an invention, the Patent Office now required peripheral claiming rather than central claiming in order for the patent applicant to be

---

<sup>29</sup> *Thompson v. Haight*, 23 F. Cas. 1040, 1041 (C.C.S.D.N.Y. 1826) (“Exactions and frauds, in all the forms which rapacity can suggest, are daily imposed and practised under the pretence [sic] of some legal sanction. The most frivolous and useless alterations in articles in common use are denominated improvements, and made pretexts for increasing their prices, while all complaint and remonstrance are effectually resisted by an exhibition of the great seal. . . . Impositions of this sort, are of common occurrence, and will continue to multiply while the door to imposture is left open and unguarded.”).

<sup>30</sup> *See, e.g., Grant v. Raymond*, 31 U.S. 218, 224 (1832) (“[T]he executive departments, it is understood, have acted on the construction adopted by the circuit court, and have considered it as settled. We would not willingly disregard the settled practice, in a case where we are not satisfied it is contrary to law; and where we are satisfied it is required by justice and good faith.”).

<sup>31</sup> Patent Act of 1839, § 7, 5 Stat. 353 (1839).

<sup>32</sup> For example, the Commissioner of the Patent Office, at this time Edmund Burke, submitted an opinion penned by the Secretary of State directly to the Supreme Court in support of his examination decision. *Bain v. Morse*, 2 F. Cas. 394, 402 (C.C.D.D.C. 1849) (“I have the honor to reply to your letter submitting an inquiry propounded by the commissioner of patents.”).

<sup>33</sup> Patent Act of 1870, § 26, 16 Stat. 198 (1870).

<sup>34</sup> *See, e.g., The Driven-Well Cases*, 123 U.S. 627, 627 (1887).

successful.<sup>35</sup> Notably, the Act gave the Patent Office the explicit statutory authority to promulgate its own rules for the first time, but limited the ability to only include proceedings within the Patent Office.<sup>36</sup>

The Patent Act of 1952 essentially codified the existing patent laws into Title 35 of the United States Code.<sup>37</sup> One of the most significant changes to the patent statutes was the express addition of the section regarding anticipation.<sup>38</sup> In order to overcome the anticipation requirement for patentability, one's invention could not have been obvious to one skilled in the art.<sup>39</sup> Although the Patent Office had some authority to promulgate its own rules,<sup>40</sup> many patent law issues remained under Congress's purview, including areas such as fee setting, where the agency arguably was in a much better position than Congress to determine appropriate fees.<sup>41</sup>

In 1982, Congress enacted legislation to move appellate review for infringement cases from the regional circuit courts of appeal to the newly formed Court of Appeals for the Federal Circuit.<sup>42</sup> The new court was also granted jurisdiction to take appeals directly from the United States Patent and Trademark Office's Board of Patent Appeals and Interferences.<sup>43</sup> This allowed the same judicial

---

<sup>35</sup> See 1 MOY'S WALKER ON PATENTS § 1:21 (4th ed.) (Jan. 2016); see, e.g., O'Reilly v. Morse, 56 U.S. 62, 62 (1853) (displaying both peripheral and central claiming styles). The Supreme Court condoned the Patent Office's change through a series of holdings. See, e.g., Merrill v. Yeomans, 94 U.S. 568, 573 (1876) ("The growth of the patent system in the last quarter of a century in this country has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded.").

<sup>36</sup> Patent Act of 1870, § 19 (1870) ("[The Commissioner], subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of the proceedings in the patent office.").

<sup>37</sup> Patent Act of 1952, Pub. L. No. 82-593, ch. 950, 66 Stat. 792 (July 19, 1952).

<sup>38</sup> 35 U.S.C. § 103 (1952).

<sup>39</sup> *Id.*

<sup>40</sup> Patent Act of 1952, Pub. L. No. 82-593, § 6, 66 Stat. 792, 793 (July 19, 1952).

<sup>41</sup> Patent Act of 1952, Pub. L. No. 82-593, § 41, 66 Stat. 792, 796 (July 19, 1952).

<sup>42</sup> Federal Courts Improvement Act of 1982 (FCIA), Pub. L. No. 97-164, 96 Stat. 25 (1982); 17 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 4101 (3d ed. 2016); see, e.g., *Bray v. United States*, 785 F.2d 989, 990 (Fed. Cir. 1986) (discussing merits of Court of Appeals for Federal Circuit).

<sup>43</sup> 17 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE & PROCEDURE § 4104 (3d ed. 2016); see, e.g., *In re Voss*, 557 F.2d 812 (C.C.P.A. 1977).

body to now have judicial review of both infringement cases and review of the initial administrative decision to grant a patent.<sup>44</sup> These review functions had been judicially isolated for about 150 years and, thus, had diverged on some matters of substantive law.<sup>45</sup>

*Animal Legal Defense Fund v. Quigg* was one of the key decisions after the establishment of the new Federal Circuit.<sup>46</sup> Although the Federal Circuit ruled in favor of the USPTO the language the court used was actually seen to curtail the Patent Office's rule making authority.<sup>47</sup> This was explicitly emphasized in *Merck & Co. v. Kessler*.<sup>48</sup> The court declined to accept the Patent Office Commissioner's argument that the office's decision should be given "controlling weight"<sup>49</sup> under *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*,<sup>50</sup> and determined that the Patent Office lacked the authority to promulgate any substantive rules.<sup>51</sup> Therefore, even though the Patent Office was given the authority to enact some

---

<sup>44</sup> WRIGHT & MILLER, *supra* note 43, at n.25.

<sup>45</sup> See, e.g., *In re Ochiai*, 71 F.3d 1565, 1569 (Fed. Cir. 1995) (stating that the USPTO did not use the legally correct method for determining obviousness); *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (stating that the USPTO imposed an improper obviousness rejection).

<sup>46</sup> See generally *Animal Legal Def. Fund v. Quigg*, 932 F.2d 920 (Fed. Cir. 1991).

<sup>47</sup> *Id.* at 931. ("[T]he Commissioner's Notice falls within the 'interpretative' exception to the section 553 public notice and comment procedures. Appellants thus have no standing to assert Count I of the Complaint by reason of 'procedural harm.'"); *id.* at 930. ("A substantive declaration with regard to the Commissioner's interpretation of the patent statutes, whether it be section 101, 102, 103, 112 or other section, does not fall within the usual interpretation of such statutory language."). It is this second statement that has since been used by litigants in numerous cases seeking to circumscribe the Patent Office's rule making authority. See, e.g., *Koninklijke Philips Elecs. N.V. v. Cardiac Sci. Operating Co.*, 590 F.3d 1326, 1336 (Fed. Cir. 2010) ("The district court and the Board's legal errors stem from a failure to appreciate the consequences of the PTO's rulemaking authority. The PTO lacks substantive rulemaking authority.").

<sup>48</sup> *Merck & Co. v. Kessler*, 80 F.3d 1543, 1550 (Fed. Cir. 1996).

<sup>49</sup> *Id.* at 1549.

<sup>50</sup> *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

<sup>51</sup> *Merck*, 80 F.3d at 1549 (quoting *Atchison v. Pena*, 44 F.3d 437, 441 (7th Cir.1994) (en banc), *aff'd*, 516 U.S. 152 (1996)) ("As the Seventh Circuit recently had occasion to note, however, 'only statutory interpretations by agencies with rulemaking powers deserve substantial deference.'"); *id.* at 1549–50 ("As we have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. § 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does *not* grant the Commissioner the authority to issue substantive rules."); see also ANIMAL LEGAL DEFENSE FUND, 932 F.2d at 930.

rules, this was narrowly interpreted by the courts to only apply to procedural matters within the agency.

### III. ORIGINS OF POST GRANT REVIEW OF PATENTS

Congress instituted a new proceeding in 1980, the *ex parte* reexamination, to be administered by the Patent Office, because over the years a growing number of complaints were being levied at the United States patent system.<sup>52</sup> In response, Congress and the Patent Office began to try and address two of the major criticisms: First, patents were being routinely granted for inventions that represented an advance in the arts that was not significant enough to justify the resulting monopoly as embodied in *Great Atlantic & Pac. Tea Co. v. Supermarket Equip. Corp.*;<sup>53</sup> As the majority states:

The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The Patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents-gadgets that obviously have had no place in the constitutional scheme of advancing scientific knowledge. A few that have reached this Court show the pressure to extend monopoly to the simplest of devices . . . . The patent involved in the present case belongs to this list of incredible patents which the Patent Office has spawned. The fact that a patent as flimsy and as spurious as this one has to be brought all the way to this Court to be declared invalid dramatically illustrates how far our patent system frequently departs from the constitutional standards which are supposed to govern.”); *Pfizer Inc. v. Lord*, 456 F.2d 532, 542 (8th Cir. 1972) (quoting statement of district court judge in record on appeal: “I think you ought to tell your Attorney General, if he wants to look at something, he ought to look at that Patent Office. That has got to be the sickest institution that our Government has ever invented. It is just, as far as I can see, an attritional war between the patent applicant and the patent examiners, who apparently get paid on the piece work for how many patents they could put out. And you can examine for months some poor fellows that are out doing business and finally arrive at a price structure, and you might get an antitrust suit. But if you want to look, go back and look in your Patent Office and see what is

---

<sup>52</sup>Kristen Jakobsen Osenga, *Rethinking Reexamination Reform: Is It Time for Corrective Surgery, or Is It Time to Amputate?*, 14 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 217, 229–30 (2003).

<sup>53</sup>SEE, E.G., *Great Atlantic & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 156–58 (1950) (Douglas, J., concurring).

happening to the Patent Office. I say that for the record and for posterity. That has got to be the weakest link in the competitive system in America.”<sup>54</sup>

The second criticism addressed was that a large percentage of awarded patents were being invalidated in litigation.<sup>55</sup> This first major attempt in 1980 was under taken to address these issues by Congress resulting in the ability of third parties to raise the issue of a patent’s validity without filing a lawsuit.<sup>56</sup> However, the ability to challenge an existing patent was limited, because only ‘prior art’ invalidity and no other invalidating activity would be considered, and secondly, because the reexamination was essentially an *ex parte* proceeding.<sup>57</sup> Therefore, there was still a lot of discord among the patent bar, and as such “reexamination, according to many, has failed”.<sup>58</sup> In 1999, Congress then amended the act to add another post-issuance review proceeding—the inter partes reexamination.<sup>59</sup> This amendment allowed the requesting third party to have some ability to participate in the proceeding after a reexamination had been instituted by the Patent Office.<sup>60</sup>

The Leahy-Smith America Invents Act was enacted in 2011.<sup>61</sup> Three major

---

<sup>54</sup> SEE, E.G., *Great Atlantic & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 156–58 (1950) (Douglas, J., concurring).

<sup>55</sup> See, e.g., *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560, 572 (1949) (Jackson, J., dissenting) (“It would not be difficult to cite many instances of patents that have been granted, improperly I think, and without adequate tests of invention by the Patent Office. But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this Court for striking them down so that the only patent that is valid is one which this Court has not been able to get its hands on.”).

<sup>56</sup> Pub. L. No. 96-517, § 1, 94 Stat. 3015 (Dec. 12, 1980).

<sup>57</sup> See *id.* The patent office would only reexamine the issued patent based on the existence of prior art that was either an existing patent or printed publication at the time of invention. Additionally, a third party after filing the initial claim could no longer participate in the proceedings (i.e. they could not respond to any patentee arguments).

<sup>58</sup> See, e.g., Mark D. Janis, *Rethinking Reexamination: Toward A Viable Administrative Revocation System for U.S. Patent Law*, 11 HARV. J.L. & TECH. 1, 43 (1997) (stating that “a lingering debate has centered around” the question of what role the PTO should “play in regards to issued patents”).

<sup>59</sup> Intellectual Property and Communications Omnibus Reform Act of 1999, Pub. L. No. 106-113, § 4608(a), 113 Stat 1501 (Nov. 29. 1999).

<sup>60</sup> See *id.* The third-party requestor could now respond to the patentee’s arguments presented to the patent office.

<sup>61</sup> Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, 125 Stat. 284 (Sept. 16, 2011).

changes were made by the America Invents Act: (1) moving from a first-to-invent system to a first invento- to-file system; (2) giving the Patent Office fee-setting authority; and (3) upgrading the administrative proceedings within the Patent Office, which can be used to challenge patent validity after it has issued.<sup>62</sup> Although formal review by the patent office of a patent that had already issued had been around since 1980 in the form of an *ex parte* reexamination,<sup>63</sup> this process was expanded even further by the America Invents Act.<sup>64</sup> The new proceedings included the post grant review, inter partes review, and covered business methods. Of specific interest in this article is the inter partes review proceeding, which is typically initiated by a third party who makes a claim of invalidity on an existing patent.<sup>65</sup> The Patent Office reviews the claim(s) of the third party and then makes an initial determination of whether or not to institute an inter partes review proceeding.<sup>66</sup> Congress gave the Patent Office substantive rule-making authority under the America Invents Act regarding fee-setting<sup>67</sup> and implementing the new review proceedings.<sup>68</sup>

#### IV. THE ADMINISTRATIVE PROCEDURES ACT

As the U.S. government has grown, so too has the need for Congress to delegate more authority to the executive branch to carry out its policies. This transition was especially evident during the New Deal Era.<sup>69</sup> At the same time, concerns about the substantive powers and policy objectives given to the executive

---

<sup>62</sup> See generally ALAN J. KASPER ET AL., PATENTS AFTER THE AIA: EVOLVING LAW AND PRACTICE 1-6 (2016).

<sup>63</sup> Pub. L. No. 96-517, § 1, 94 Stat. 3015 (Dec. 12, 1980) (establishing a formal process for *ex parte* reexamination).

<sup>64</sup> Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, § 3, 125 Stat. 284 (Sept. 16, 2011).

<sup>65</sup> 35 U.S.C. § 311 (2013).

<sup>66</sup> 35 U.S.C. § 314 (2013).

<sup>67</sup> Memorandum from Bernard J. Knight, Jr., Gen. Counsel, USPTO, Patent Fee Setting (Feb. 10, 2012), [https://www.uspto.gov/sites/default/files/aia\\_implementation/fee\\_setting](https://www.uspto.gov/sites/default/files/aia_implementation/fee_setting)

[\\_opinion.pdf](#) (“[Section 10 of the America Invents Act] provides the [Patent Office] with the authority to set individual fees based on policy considerations.”).

<sup>68</sup> See, e.g., 35 U.S.C. § 316(a)(4) (2015).

<sup>69</sup> Roni A. Elias, *The Legislative History of the Administrative Procedure Act*, 27 FORDHAM ENVTL. L. REV. 207, 207 (2016).

branch agencies began to surface.<sup>70</sup> The lack of disclosure from executive branch agencies exacerbated concerns about insufficient oversight of agency decision-making procedures.<sup>71</sup>

Eventually, the Administrative Procedures Act<sup>72</sup> was passed in 1946 after much debate.<sup>73</sup> The purposes of the Act were to:

- (1) To require agencies to keep the public informed of their organization, procedures, and rules;
- (2) To provide for public participation in the informal rulemaking process;
- (3) To prescribe uniform standards for the conduct of formal rulemaking and adjudicative proceedings, i.e., proceedings that are required by statute to be made on the record after an agency hearing; and
- (4) To restate the law of judicial review.<sup>74</sup>

The Administrative Procedures Act has set the standards under which agencies promulgate regulations, defined the scope of those regulations, and set forth the circumstances under which they are subjected to judicial review.<sup>75</sup> Even in the early years of the Administrative Procedures Act, courts deferred to the agencies expertise and reversed agency decisions only rarely.<sup>76</sup> Over time, the Administrative Procedures Act began to morph as judges made changes through judicial review and Congress would respond with changes when writing the procedural provisions for new agency statutes.<sup>77</sup> Then, the Court's decision in *Chevron* reset judicial review back to a position of general deference to administrative agencies.<sup>78</sup>

Interestingly, the courts have historically declined to give the Patent Office

---

<sup>70</sup> *Id.* at 209.

<sup>71</sup> *Id.* at 209 (citing John Joseph Wallis, *The Political Economy of New Deal Federalism*, 29 ECON. INQUIRY 510 (July 1991) (“When Congress asked Harry Hopkins, head of the Federal Emergency Relief Administration in the early New Deal era, to explain how he made his decisions and to identify the criteria he used to allocate funds, he simply declined to answer.”)).

<sup>72</sup> 5 U.S.C. § 551 et seq. (2011).

<sup>73</sup> Elias, *supra*, note 69 at 211–12.

<sup>74</sup> Jill Nylander, *The Administrative Procedure Act*, 85 MICH. B.J. 38, 39 (Nov. 2006).

<sup>75</sup> *Id.*

<sup>76</sup> Martin Shapiro, *Golden Anniversary: The Administrative Procedure Act of 1946*, A, 19 REGULATION 40, 42 (1996), <http://scholarship.law.berkeley.edu/facpubs/379>.

<sup>77</sup> *Id.* at 42-43 (This reflects the change in public perception regarding Administrative Agencies. “Once viewed as benevolent, political eunuchs in white coats, scientists came to be seen as part of ‘big science,’ an interest group with its hand out for big public funding and part of the military-industrial complex that President Eisenhower denounced.”).

<sup>78</sup> *See Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 844 (1984).

*Chevron* deference afforded to other administrative agencies, such as the EPA and FCC, without much explanation.<sup>79</sup> However, the Supreme Court has on occasion chastised the Federal Circuit for substituting its interpretation of certain administrative rules and evidentiary standards in place of those of the Patent Office.<sup>80</sup> In *Dickinson*, the Federal Circuit found that the Patent Office's factual findings were "clearly erroneous."<sup>81</sup> The Supreme Court held that the Federal Circuit was not justified in substituting the court's evidentiary standard for the Patent Office's standard under the Administrative Procedures Act and remanded the case for rehearing using the agency's standard.<sup>82</sup>

Shortly thereafter, Congress passed the American Inventors Protection Act to reinforce that decision.<sup>83</sup> The specific language used by Congress in the Act suggests that they intended to grant substantive rule making authority to the Patent Office.<sup>84</sup> Even so, the Federal Circuit has continued to make the distinction between procedural and substantive rules and deciding the cases based on this distinction.<sup>85</sup> This distinction was anything but clear as illustrated by *Tafas v. Doll*.<sup>86</sup> Judge Prost, writing for the majority, held that the rules in question were procedural.<sup>87</sup> Judge Radar disagreed and said the rules were substantive.<sup>88</sup> Judge Bryson opined that this distinction was not helpful and held only that the rules under discussion here were

---

<sup>79</sup> Compare *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996), with *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 844 (1984).

<sup>80</sup> See, e.g., *Dickinson v. Zurko*, 527 U.S. 150, 153 (1999).

<sup>81</sup> *Id.*

<sup>82</sup> *Id.* at 165 ("Neither the Circuit nor its supporting *amici*, however, have explained convincingly why direct review of the PTO's patent denials demands a stricter fact-related review standard than is applicable to other agencies. Congress has set forth the appropriate standard in the [Administrative Procedures Act].").

<sup>83</sup> American Inventors Protection Act, Pub. L. No. 106-113, § 4711-4712, 113 Stat. 1501A-552, at 1501A-572 to 1501A-575 (1999) (stating that, "establish[ing] regulations, not inconsistent with law, which--(A) shall govern the conduct of proceedings in the Office . . ."); see also 35 U.S.C. § 132(b) (2012) ("The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant.").

<sup>84</sup> See generally Sarah Tran, *Administrative Law, Patents, and Distorted Rules*, 80 GEO. WASH. L. REV. 831, 857–62 (2012).

<sup>85</sup> See, e.g., *Tafas v. Doll*, 559 F.3d 1345, 1354-56 (Fed. Cir. 2009).

<sup>86</sup> *Id.*

<sup>87</sup> *Tafas v. Doll*, 559 F.3d 1345, 1356 (Fed. Cir.) ("While we do not purport to set forth a definitive rule for distinguishing between substance and procedure in this case, we conclude that the Final Rules challenged in this case are procedural."), reh'g en banc granted, opinion vacated, 328 F. App'x 658 (Fed. Cir. 2009).

<sup>88</sup> *Tafas v. Doll*, 559 F.3d 1345, 1371 (Fed. Cir.) (Radar, Circuit Judge, concurring in part and dissenting in part) ("The Final Rules are substantive. The Final Rules affect individual rights and obligations, and mark a startling change in existing law and patent policy."), reh'g en banc granted, opinion vacated, 328 F. App'x 658 (Fed. Cir. 2009).



the sort congress had in mind when constructing the rule making statutes that applied to the Patent Office.<sup>89</sup> The incongruous opinions penned in *Tafas* attracted the attention of the full circuit who agreed to rehear the case *en banc*. However, the new Director of the Patent Office rescinded the rules in question before the rehearing, resulting in the court dismissing the appeal as moot.<sup>90</sup>

### A. Judicial Review of the Administrative Procedures Act

One of the seminal judicial decisions interpreting the Act was laid out in *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*<sup>91</sup> In *Chevron*, the Environmental Protection Agency (EPA) promulgated rules associated with the Clean Air Act Amendments of 1977.<sup>92</sup> This required the EPA to institute a strict permitting scheme for “nonattainment” states who had not achieved the desired national air quality standards pursuant to previous legislation.<sup>93</sup> In contention was the definition of the term ‘stationary source.’ Specifically, the EPA allowed a state to apply the term on a plantwide basis.<sup>94</sup> Thus, a plant could add additional sources of pollution without going through the permitting process as long as the total pollution emitted from the plant remain unchanged.<sup>95</sup>

The first question addressed by the *Chevron* court was whether Congress had specifically spoken to the issue. If Congress unambiguously spoke to the matter, that is the end of the analysis as neither an administrative body nor the courts may insert constructions which are contrary to clear legislative intent.<sup>96</sup> However, the second question addresses when Congress has not spoken directly on the issue: Has the administrative agency promulgated a rule which is a reasonable interpretation of

---

<sup>89</sup> *Tafas v. Doll*, 559 F.3d 1345, 1366 (Fed. Cir.) (Bryson, Circuit Judge, concurring) (“I do not think it necessary, or particularly helpful, to consider whether those regulations would be deemed ‘substantive,’ ‘interpretive,’ or ‘procedural’ . . . .”), *reh’g en banc granted*, opinion vacated, 328 F. App’x 658 (Fed. Cir. 2009).

<sup>90</sup> *Tafas v. Kappos*, 586 F.3d 1369, 1371 (Fed. Cir. 2009).

<sup>91</sup> *See generally* *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

<sup>92</sup> Clean Air Act Amendments of 1977, Pub. L. 95–95, 91 Stat. 685 (1977).

<sup>93</sup> *Chevron*, 467 U.S. at 840.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *See, e.g.*, *FEC v. Democratic Senatorial Campaign Comm.*, 454 U.S. 27, 32 (1981) (“[T]he courts are the final authorities on issues of statutory construction. They must reject administrative constructions of the statute, whether reached by adjudication or by rule-making, that are inconsistent with the statutory mandate or that frustrate the policy that Congress sought to implement.”).

congressional intent?<sup>97</sup> The *Chevron* court held that the EPA made a reasonable choice in defining ‘stationary source’ and any judgement as to whether it amounts to good policy or not must be dismissed.<sup>98</sup>

#### V. WHAT IS THE PROPER CLAIM CONSTRUCTION STANDARD TO USE DURING AN INTER PARTES REVIEW PROCEEDING?

Another key point of tension in *Cuozzo* is whose claim construction standard is proper in an inter partes review; should it be the broadest reasonable interpretation standard used by the Patent Office or the ‘as understood by those skilled in the art’ standard used by the courts? A discussion of the policies and history behind the establishment of each standard is necessary before turning to the Supreme Court decision in *Cuozzo*.

##### A. *The Patent Office Uses The Broadest Reasonable Interpretation Standard When Construing Claim Terms*

For more than 100 years the Patent Office has used the broadest reasonable interpretation in claim construction during patent examination.<sup>99</sup> This practice has continued uninterrupted since that time even though no patent statute has explicitly

---

<sup>97</sup> *Chevron*, 467 U.S. at 843.

<sup>98</sup> *Id.* at 866 (“When a challenge to an agency construction of a statutory provision, fairly conceptualized, really centers on the wisdom of the agency’s policy, rather than whether it is a reasonable choice within a gap left open by Congress, the challenge must fail. In such a case, federal judges—who have no constituency—have a duty to respect legitimate policy choices made by those who do. The responsibilities for assessing the wisdom of such policy choices and resolving the struggle between competing views of the public interest are not judicial ones.”);

*see also* *Train v. Nat. Res. Def. Council, Inc.*, 421 U.S. 60, 87 (1975) (“Congress . . . left to the States considerable latitude in determining specifically how the standards would be met. We therefore conclude that the Agency’s interpretation . . . was ‘correct.’ . . . [W]e have no doubt whatever that its construction was sufficiently reasonable to preclude the Court of Appeals from substituting its judgment for that of the Agency.”); *United States v. Shimer*, 367 U.S. 374, 381–82 (1961) (quoting *Bates & Guild Co. v. Payne*, 194 U.S. 106, 108–09 (1904) (“[W]here Congress has committed to the head of a department certain duties requiring the exercise of judgment and discretion, his action thereon, whether it involve questions of law or fact, will not be reviewed by the courts unless he has exceeded his authority or this court should be of opinion that his action was clearly wrong.”)); *Shimer*, 367 U.S. at 383 (“If this choice represents a reasonable accommodation of conflicting policies that were committed to the agency’s care by the statute, we should not disturb it unless it appears from the statute or its legislative history that the accommodation is not one that Congress would have sanctioned.”).

<sup>99</sup> *Miel v. Young*, 29 App. D.C. 481, 484 (D.C. Cir. 1907) (“This claim should be given the broadest interpretation which it will support, and we should not strive to import limitations from the specification to meet the exigencies of the particular situation in which the claim may stand at a given time.”).

stated whether the broadest reasonable interpretation should be used by the Patent Office or not.<sup>100</sup> The purpose for using the broadest reasonable interpretation is to encourage patent applicants to draft narrowly.<sup>101</sup> This has a two-fold result, first is to deny the patentee a monopoly on more knowledge than what was actually invented<sup>102</sup> and second is to “apprise the public of what is still left open to them.”<sup>103</sup> Interestingly, the Patent Office promulgated a rule stating for the first time that this standard of claim construction was to be used during an inter partes review in response to the passage of the America Invents Act in 2011.<sup>104</sup>

*B. The Courts Use the “Ordinary Meaning as Understood by One of Ordinary Skill in the Art at the Time of the Invention” Standard in Claim Construction.*

As a first principle, it is “the claims of a patent [that] define the invention to which the patentee is entitled the right to exclude.”<sup>105</sup> It is the individual terms used when construing the claim that define the scope of the invention.<sup>106</sup> The terms are “generally given their ordinary and customary meaning.”<sup>107</sup> Because inventors often use specific terminology related to the technological area in which they work, customary meaning refers to the meaning it would have to one of ordinary skill in the art.<sup>108</sup> Furthermore, courts have held that inventors are able to define the claim terms in their specification which have a meaning different than their ordinary and customary meaning.<sup>109</sup> These points were well stated in

---

<sup>100</sup> *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1276 (Fed. Cir. 2015), cert. granted sub nom., *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890, 193 L. Ed. 2d 783 (2016), and aff’d sub nom., *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016).

<sup>101</sup> *See, e.g., Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2128-29 (2014).

<sup>102</sup> *Id.* at 2128-30.

<sup>103</sup> *Id.* at 2129 (quoting *MARKMAN V. WESTVIEW INSTRUMENTS*, 517 U.S. 370, 373 (1996)); *MCCLAIN V. ORTMAYER*, 141 U.S. 419, 424 (1891).

<sup>104</sup> 37 C.F.R. § 42.100(b) (“A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.”).

<sup>105</sup> *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004).

<sup>106</sup> *See, e.g., Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (“First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention.”).

<sup>107</sup> *Id.*

<sup>108</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

<sup>109</sup> *See, e.g., Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed. Cir. 1990) (“It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings.”) (citation omitted).

---

**Multiform Desiccants, Inc. v. Medzam, Ltd.**:<sup>110</sup>

It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention—the inventor's lexicography—must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology. Thus the court starts the decision making process by reviewing the same resources as would that person, VIZ., the patent specification and the prosecution history.

Thus, the courts use the 'as understood by those skilled in the art' standard because they are tasked with resolving a specific controversy. Frequently, this dispute revolves around whether a particular invention falls within or out of the claim scope recited in the patent. Necessarily, the court needs to determine the exact scope of a claimed invention in order to give the inventor the benefits of a patent to which he is entitled by right, but no more. To err on either side of this would either deprive the individual of an earned right granted by the patent system or deprive the public of the ability to make, use, or sell an invention to which the patent holder had no right to exclude. In other words, if the courts used the broadest reasonable interpretation standard (aside from greatly increasing the amount of litigation), this would unduly restrict a patentee's rights to the invention and would give the public rights to knowledge that are otherwise within the scope of the invention.

**IV. CUOZZO SPEED TECHNOLOGIES V. LEE****A. Procedural history**

Giuseppe A. Cuzzo applied for a patent on March 18, 2002. The prosecution of the application continued until February 18, 2004 at which time a notice of allowance was issued by the Patent Office.<sup>111</sup> More than 8 years had transpired before Garmin International, Inc. and Garmin USA, Inc. filed a petition for inter partes review on September 16, 2012 asserting claims 1-20 of U.S. Patent No. 6,778,074,<sup>112</sup> owned by Cuzzo Speed Technologies, were invalid.

The Patent Trials and Appeal Board instituted an inter partes review on

---

<sup>110</sup> MULTIFORM DESICCANTS, INC. V. MEDZAM, LTD., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

<sup>111</sup> The prosecution history of the patent application can be found at, <http://portal.uspto.gov/pair/PublicPair>; select the 'PATENT NUMBER' radio button and search patent number '6,778,074' (follow "Image File Wrapper" hyperlink).

<sup>112</sup> U.S. Patent No. 6,778,074.

January 9, 2013 because they determined that Garmin was reasonably likely to prevail on at least one claim of unpatentability.<sup>113</sup> Specifically, the Patent Trials and Appeal Board denied the petition in part as to claims 1-9, 11-13, 15, 16, and 18-20, but granted review of claims 10, 14, and 17 on two grounds of unpatentability, novelty and obviousness. The Patent Trials and Appeal Board rendered a decision on November 13, 2013, cancelling claims 10, 14, and 17.<sup>114</sup>

Briefly, the ('074) patent claims an indicator and an associated method for showing a driver his current speed relative to the legal posted speed limit in a given area that is updated in real time. This is accomplished either through a liquid crystal display showing both a driver's speed and the current speed limit or through a movable needle indicating the driver's current speed and a colored filter that is rotatable to show the current speed limit. It is this second implementation, embodied in claims 10, 14, and 17 that were reviewed and ultimately cancelled.<sup>115</sup>

Cuozzo appealed the Patent Trials and Appeal Board decision to the US Court of Appeals for the Federal Circuit. The Court of Appeals held that the Patent Trials and Appeal Board's use of the broadest reasonable interpretation standard

---

<sup>113</sup> Garmin Int'l, Inc., No. IPR2012-00001, 2013 WL 5947691 (P.T.A.B. Jan. 9, 2013).

<sup>114</sup> Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC, No. IPR2012-00001, 108 U.S.P.Q.2d 1852 (P.T.A.B. Nov. 13, 2013).

<sup>115</sup> U.S. Patent No. 6,778,074, cls. 10, 14, and 17 states:

10. A speed limit indicator comprising:  
 a global positioning system receiver;  
 a display controller connected to said global positioning system receiver, wherein said display controller adjusts a colored display in response to signals from said global positioning system receiver to continuously update the delineation of which speed readings are in violation of the speed limit at a vehicle's present location; and  
 a speedometer integrally attached to said colored display.

...

14. The speed limit indicator as defined in claim 10, wherein said colored display is a colored filter.

...

17. The speed limit indicator as defined in claim 14, wherein said display controller rotates said colored filter independently of said speedometer to continuously update the delineation of which speed readings are in violation of the speed limit at a vehicle's present location.

was within their discretion and the decision to initiate the review was final and non-appealable.<sup>116</sup> Cuozzo appealed to the United States Supreme Court and certiorari was granted.

On appeal Cuozzo argued that the Patent Office improperly granted inter partes review at least in respect to claims 10 and 14, because Garmin failed to challenge those claims with specificity.<sup>117</sup> Cuozzo also challenged the decision of the Patent Trials and Appeal Board to use the broadest reasonable interpretation standard versus the standard employed by the courts to determine patentability.<sup>118</sup>

*B. The Majority's Opinion Holds That the Patent Office's Decision to Institute Inter Partes Review Is Not Reviewable*

First, in reviewing the Federal Circuit panel decision that the Patent Office's institution of an inter partes review was final and non-appealable, the Supreme Court construed two provisions of the Leahy-Smith America Invents Act.<sup>119</sup> The first provision is in reference to the ability of Cuozzo to appeal the Patent Trials and Appeal Board's decision to institute inter partes review. The statute states, "No Appeal.—The determination by the Director [of the Patent Office] whether to institute inter partes review under this section shall be final and non-appealable."<sup>120</sup> The second provision is regarding the Patent Office's ability to promulgate regulations used in inter partes review. The provision states, "The Director shall prescribe regulations-- establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title."<sup>121</sup> Cuozzo argued review of claims 10 and 14 were improperly granted, because all challenged claims must be pleaded "with particularity" according to the statute.<sup>122</sup> The Patent Office disagrees and says a mere recitation of the same argument is not necessary when the claims are "all logically linked," that the claims "rise and fall" together,<sup>123</sup> and the same argument is "obviously implied."<sup>124</sup> Thus, while Cuozzo has a valid technical argument, logic dictates that if dependent claim 17 is found

---

<sup>116</sup> *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015), cert. granted sub nom.

<sup>117</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2139 (2016).

<sup>118</sup> *Id.*

<sup>119</sup> Leahy-Smith America Invents Act, Pub. L. 112-29, Sept. 16, 2011, 125 Stat. 284 (2011).

<sup>120</sup> 35 U.S.C. § 314(d) (2015).

<sup>121</sup> 35 U.S.C. § 316(a)(4) (2015).

<sup>122</sup> 35 U.S.C. § 312 (a)(3) (2015).

<sup>123</sup> See *In re Cuozzo Speed Techs., LLC*, 793 F. 3d 1268, 1281 (Fed. Cir. 2015).

<sup>124</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2139 (2016).

unpatentable then any claim that subsumes claim 17—claims 10 and 14 here—must be invalid as well. “Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”<sup>125</sup>

The majority in *Cuozzo* held—at a minimum—the language in the provision forbids an appeal that raises some minor statutory technical argument and nothing more.<sup>126</sup> Furthermore, allowing review of the decision to institute inter partes review would undermine congressional intent,<sup>127</sup> which specifically grants the Patent Office authority to re-examine already issued patents.<sup>128</sup> The majority also points to other similar provisions and patent statutes to support their holding.<sup>129</sup> The Court unanimously holds that using the broadest reasonable claim construction during an inter partes review is a reasonable exercise of the Patent Office’s authority granted by Congress.

Next, *Cuozzo* argued that the provision requiring the Patent Office to give a claim “its broadest reasonable construction in light of the specification of the patent in which it appears”<sup>130</sup> is contrary to established law set by the courts which give claims their “ordinary meaning . . . as understood by a person of skill in the art.”<sup>131</sup> However, the Supreme Court unanimously held that the Patent Office had within its discretion the ability to use a broadest reasonable claim construction under 35 U.S.C. section 316(a)(4).<sup>132</sup> The Court relied upon *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.* and *United States v. Mead Corporation* as

<sup>125</sup> Application of Lintner, 458 F.2d 1013, 1015 (C.C.P.A. 1972); see also Application of Mraz, 455 F.2d 1069, 1072–73 (C.C.P.A. 1972).

<sup>126</sup> 35 U.S.C. § 314(d) (2015) (stating that the determination by the [Patent Office] whether to institute an inter partes review under this section shall be FINAL AND NONAPPEALABLE); *Cuozzo*, 136 S. Ct. at 2139–40.

<sup>127</sup> *Cuozzo*, 136 S. Ct. at 2140.

<sup>128</sup> *Id.* at 2139–40 (explaining that the statute seeks to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents” (citing H.R. Rep., at 45, 48)); 157 Cong. Rec. 9778 (2011) (remarks of Rep. Goodlatte) (noting that inter partes review “screen[s] out bad patents while bolstering valid ones”).

<sup>129</sup> *Cuozzo*, 136 S. Ct. at 2140 (limiting appellate review to the “final written decision” (citing 35 U.S.C. § 319)); § 312(c) (2006 ed.) (repealed) (the “determination” that a petition for inter partes REEXAMINATION “raise[s]” a “substantial new question of patentability” is “final and non-appealable”); § 303(c) (2012 ed.); *IN RE HINIKER CO.*, 150 F.3d 1362, 1367 (C.A. Fed.1998) (“Section 303 ... is directed toward the [Patent Office’s] authority to institute a reexamination, and there is no provision granting us direct review of that decision.”).

<sup>130</sup> 37 C.F.R. § 42.100(b) (2016).

<sup>131</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

<sup>132</sup> 35 U.S.C. § 316(a)(4) (2015) (granting the Patent Office the authority to promulgate regulations governing inter partes review).

controlling precedent.<sup>133</sup>

Where the clear intent of Congress is articulated and no ambiguity exists the administrative agency has no discretion.<sup>134</sup> However, when Congress leaves a gap to be filled, the court interprets this as giving the administrative agency authority to use reasonable means to carry out the intent of Congress.<sup>135</sup> Because the statute does not explicitly tell the agency whether to use one standard of claim construction or another, Congress has implicitly authorized the agency to legislate a reasonable regulation.<sup>136</sup>

Cuozzo argued Congress intended for inter partes review to closely resemble a court proceeding and, therefore, should employ the same claim construction that is used by the courts—the *Phillips* standard.<sup>137</sup> Cuozzo pointed the Court to the legislative history regarding the inter partes review statutes for support.<sup>138</sup> The Court emphasized how inter partes review is less like a court action and more like an administrative proceeding.<sup>139</sup> Furthermore, the Court found the purpose of inter partes review is not the same as district court litigation.<sup>140</sup> Specifically, Congress wanted to enable the Patent Office to reexamine a previous

---

<sup>133</sup> *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984); *United States v. Mead Corp.*, 533 U.S. 218 (2001).

<sup>134</sup> *See Chevron*, 467 U.S. at 842–43 (1984).

<sup>135</sup> *See Mead Corp.*, 533 U.S. at 218–19 (2001).

<sup>136</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (citing *United States v. Mead Corp.*, 533 U.S. 218, 229 (2001) (“No statutory provision unambiguously directs the agency to use one standard or the other. And the statute ‘express[ly] . . . authoriz[es] [the Patent Office] to engage in the process of rulemaking’ to address that gap.”)).

<sup>137</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143 (2016).

<sup>138</sup> *Id.* at 2143 (2016) (Inter partes review is a “quick and cost effective alternativ[e] to litigation.” (citing H.R. Rep. at 48)); *id.* at 46–47 (“The Act converts inter partes reexamination from an examinational to an adjudicative proceeding.”); S.Rep. No. 110–259, p. 20 (2008) (Inter partes review is “a quick, inexpensive, and reliable alternative to district court litigation.”); 157 Cong. Rec. 3429–3430 (2011) (remarks of Sen. Kyl) (“Among the reforms that are expected to expedite these proceedings [is] the shift from an examinational to an adjudicative model”).

<sup>139</sup> *Consumer Watchdog v. Wisconsin Alumni Research Found.*, 753 F.3d 1258, 1261 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015) (quoting *SIERRA CLUB V. E.P.A.*, 292 F.3d 895, 899 (D.C. Cir. 2002) (“Article III standing is not necessarily a requirement to appear before an administrative agency, once a party seeks review in a federal court, ‘the constitutional requirement that it have standing kicks in.’”)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016) (“[T]he burden of proof in inter partes review is different than in the district courts: In inter partes review, the challenger (or the Patent Office) must establish unpatentability “by a preponderance of the evidence”; in district court, a challenger must prove invalidity by “clear and convincing evidence”).

<sup>140</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016).



administrative decision without having to litigate the issue in district court.<sup>141</sup> Finally, the Court conceded this analysis does not shed any light on Congress's intent regarding which standard should be applied during an inter partes review.<sup>142</sup> Thus, the correct standard to use remains ambiguous.<sup>143</sup>

This resulted in the Court reviewing the regulation only as to whether designating use of the broadest reasonable interpretation standard was reasonable or not.<sup>144</sup> The Court held that it was a reasonable exercise of the Patent Office's authority because first, using the broadest reasonable claim construction helps to ensure that an inventor does not draft too broadly and circumscribe too much knowledge which unfairly denies from the public the use of information not contained in the patent<sup>145</sup> and secondly, the Patent Office's long history of employing the broadest reasonable interpretation claim construction in agency determinations without congressional comment for not only reviewing patent applications, but also other related proceedings.<sup>146</sup>

Cuozzo responds with two arguments. The first is that the process is unfair and points to the scarcity of successful claim amendments made during an inter partes review proceeding. The Court rejects Cuozzo's statistical argument and retorts, "these numbers may reflect the fact that no amendment could save the inventions at issue, I.E., that the patent should have never issued at all."<sup>147</sup> The Court noted that they did not consider whether the manner in which the Patent Office exercises its authority is compliant with 5 U.S.C. § 706(2)(a),<sup>148</sup> because Cuozzo did not explicitly raise this issue.<sup>149</sup>

Cuozzo's second argument raises the issue that having two standards of claim construction, one for administrative proceedings and one in the courts, may result in inconsistent results and confusion.<sup>150</sup> The Court agrees with

<sup>141</sup> *Id.* (quoting *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 816 (1945)) ("[I]nter partes review helps protect the public's 'paramount interest in seeing that patent monopolies ... are kept within their legitimate scope.'"); see H.R. Rep., at 39–40 (Inter partes review is an "efficient system for challenging patents that should not have issued.").

<sup>142</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016).

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 2144–45.

<sup>145</sup> See 35 U.S.C. § 112(a) (2012); *NAUTILUS, INC. V. BIOSIG INSTRUMENTS, INC.*, 134 S. Ct. 2120, 2129 (2014); see also *IN RE YAMAMOTO*, 740 F.2d 1569, 1571 (Fed. Cir. 1984).

<sup>146</sup> See *supra*, notes 93–98 and accompanying text; *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2145 (2016).

<sup>147</sup> *Cuozzo*, 136 S. Ct. at 2145.

<sup>148</sup> 5 U.S.C. § 706(2)(A) (2011) ("(2) hold unlawful and set aside agency action, findings, and conclusions found to be—(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law").

<sup>149</sup> *Cuozzo*, 136 S. Ct. at 2146.

<sup>150</sup> *Id.* at 2146.

Cuozzo on the one hand that this is a possibility.<sup>151</sup> On the other hand, this has long been the case in the United States patent system which provides two different tracks, one in the courts and one in the Patent Office, and consolidating the claim construction standard would prove difficult.<sup>152</sup>

### C. Justice Thomas's Concurring Opinion

Justice Thomas argued the holding in *Chevron* should be overturned and that “ambiguity in a statutory term is best construed as an implicit delegation of power to an administrative agency to determine the bounds of the law” is false.<sup>153</sup> Justice Thomas proposed revisiting *Chevron* and its descendants in an appropriate case.<sup>154</sup> He concurred in full with the decision, but only on the grounds that it is compliant with 5 U.S.C. section 706(2)(A).<sup>155</sup>

### D. Justice Alito's Dissent and Justice Sotomayor Joins

Justice Alito began with the strong presumption for judicial review.<sup>156</sup> He agreed Congress has given the Patent Office considerable authority to promulgate its own rules regarding inter partes review.<sup>157</sup> He disagreed congressional intent was to bar judicial review of whether the Patent Office exceeded its authority or not when instituting an inter partes review – the only limitation is that a challenge to the agency's decision must be channeled through the agency's final decision.<sup>158</sup>

The dissent points out that a number of statutory requirements need to be

---

<sup>151</sup> *Id.*

<sup>152</sup> *Id.*

<sup>153</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2148 (2016) (Thomas, J., concurring).

<sup>154</sup> *Id.*

<sup>155</sup> *Id.*

<sup>156</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2149–50 (2016) (Alito, J., dissenting in part, concurring in part); *see Mach Mining, LLC v. EEOC*, 135 S. Ct. 1645, 1651 (2015) (“Congress rarely intends to prevent courts from enforcing its directives to federal agencies. For that reason, this Court applies a ‘strong presumption’ favoring judicial review of administrative action.”).

<sup>157</sup> *Cuozzo*, 136 S. Ct. at 2148–49.

<sup>158</sup> *Id.* at 2149.

satisfied in order for the Patent Office to institute an inter partes review.<sup>159</sup> The dissent also pointed to *LINDAHL V. OFFICE OF PERSONNEL MANAGEMENT*, to illustrate the strong presumption of judicial review.<sup>160</sup> In *Lindahl*, the Court held that even though congressional intent was repeated three times in one sentence regarding finality, the statute could be read as final only to factual determinations and not to questions of law.<sup>161</sup> The dissent notes that Congress employs far stronger language when it intends to prohibit judicial review altogether.<sup>162</sup> Previous cases have held that final agency decisions, while not reviewable at the time (no interlocutory appeals), are nonetheless still subject to judicial review upon final judgment.<sup>163</sup> The dissent emphasizes that this judicial review upon a final judgment of agency decisions is standard practice, including review of earlier agency

---

<sup>159</sup> Compare 35 U.S.C. § 312(a)(3) (2015) (stating that a petition must, “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim”), and 35 U.S.C. § 315(a)(1), (b) (2015) (A petition may not be advanced by a party who either filed an action claiming invalidity or was itself sued for infringement more than one year earlier.), and 35 U.S.C. § 314(a) (2015) (The petition must show that, “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”), with Brief for Respondent at 16, *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016) (No. 15-446), 2016 WL 1298034, at \*16 (“By barring judicial review of all institution decisions, § 314(d) does not allow the Board to ignore the limits on its authority. Even when Congress intends to bar judicial review of an agency decision, this Court and others have recognized ‘an implicit and narrow exception’ for ‘claims that the agency exceeded the scope of its delegated authority or violated a clear statute mandate.’ *Achates*, 803 F.3d at 658–59 . . . . This exception has no application here, however, because requirements such as § 312’s ‘particularity’ rule are not clear statutory limits on the Board’s authority to declare patent claims unpatentable. These requirements are instead claims-processing rules that speak to the petitioner’s procedural obligations, not the Board’s adjudicative power.”).

<sup>160</sup> *Lindahl v. Office of Pers. Mgmt.*, 470 U.S. 768 (1985).

<sup>161</sup> See *id.* at 779.

<sup>162</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2150 (2016) (“‘[W]hen Congress intends to bar judicial review altogether, it typically employs language far more unambiguous and comprehensive,’ giving as an example a statute that made an agency decision ‘final and conclusive for all purposes and with respect to all questions of law or fact’ and ‘not subject to review by another official of the United States or by a court by mandamus or otherwise.’” (quoting *Lindahl v. Office of Pers. Mgmt.*, 470 U.S. 768, 779–80 & n. 13 (1985))).

<sup>163</sup> See *MOHAWK INDUS., INC. V. CARPENTER*, 558 U.S. 100, 105 & n.1, 109 (2009) (agreeing with decisions holding that attorney-client privilege rulings are “nonappealable” because “post judgment appeals generally suffice to protect the rights of litigants”); *COOPERS & LYBRAND V. LIVESAY*, 437 U.S. 463, 469, 472 & n.17 (1978) (describing an order denying class certification as “nonappealable” but noting that it “is subject to effective review after final judgment.”).

decisions that were not reviewable at the time.<sup>164</sup> In contrast, the majority analogized to cases in other contexts where the court has held that review of preliminary decisions are unreviewable.<sup>165</sup> Justice Alito countered the majority employs the wrong analogy.<sup>166</sup>

Despite the general presumption for judicial review, Justice Alito acknowledged that review may not be appropriate in every case.<sup>167</sup> He went on to write that although *Cuozzo* may have ultimately failed, due to lack of any prejudice the decision had on his case, the perceived weakness in *Cuozzo*'s suit should not bar review by a court.<sup>168</sup> By not allowing review, he argued the Court has set up the potential for unfairness to the patentee.<sup>169</sup> For example, if the Patent Office does not follow the statutes when instituting inter partes review or any of the other post grant proceedings, the majority decision in *Cuozzo* makes this unreviewable.<sup>170</sup> He opined this surely could not have been Congress's intent.<sup>171</sup>

## VII. FUTURE DIRECTIONS AFTER *CUOZZO*

The result after *Cuozzo* is a continuation of the slow trend of granting the Patent Office more rule-making authority especially relating to activities carried out within the agency itself. This is discussed extensively below. Another alternative is

---

<sup>164</sup> 5 U.S.C. § 704 (2011) (“A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action.”); 15A C. WRIGHT, A. MILLER, & E. COOPER, FEDERAL PRACTICE AND PROCEDURE § 3905.1, pp. 250, 252 (2d ed. 1992) (“[T]he general rule that an appeal from final judgment ... permits review of all rulings that led up to the judgment” and “[t]he variety of orders open to review on subsequent appeal from a final judgment is enormous.”).

<sup>165</sup> See *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“The grand jury gets to say—without any review, oversight, or second-guessing—whether probable cause exists to think that a person committed a crime.” (quoting *Kaley v. United States*, 134 S. Ct. 1090, 1097–98 (2014))).

<sup>166</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2153 & n.7 (2016) (“[The majority] draws the wrong analogy for this case. *Cuozzo*'s complaint is that the petition for inter partes review did not articulate its challenge to certain patent claims with adequate particularity. This is more akin to an argument that an indictment did not sufficiently allege an offense and provide notice of the charges against the defendant, which is reviewable after trial and judgment.”); *Id.* at n.7 (overturning a conviction based on the insufficiency of the indictment (citing *United States v. Carll*, 105 U.S. 611, 612–613 (1882))).

<sup>167</sup> 5 U.S.C. § 706 (2011) (“[T]he court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.”).

<sup>168</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2154 (2016) (Alito, J., dissenting).

<sup>169</sup> *Id.*

<sup>170</sup> *Id.*

<sup>171</sup> *Id.*

an almost complete deference given to the Patent Office under *Chevron* as long as the Patent Office's interpretation is compliant with 5 U.S.C. § 706. This possibility is addressed briefly below.<sup>172</sup>

*A. Will Courts Grant Complete Deference to the Patent Office Going Forward?*

There are strong arguments that *Cuozzo* establishes the precedent for almost complete deference. In other contexts, *Chevron* deference has been widely applied giving agencies broad discretion in interpreting congressional intent.<sup>173</sup> This discretion has been extended to apply even where the court has already spoken on the matter.<sup>174</sup> It has been argued that the fundamental reason why courts should defer to agency discretion is because Congress has told them to do so.<sup>175</sup> Nonetheless, this broad discretion raises some important separation of powers questions and suggests that it is the administrative agency who is the final arbiter to say what the law is.<sup>176</sup> *Chevron* deference has even been suggested to give agencies authority similar to *McCulloch v. Maryland* to do as they please as long their interpretation of

---

<sup>172</sup> *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

<sup>173</sup> See, e.g., *Luminant Generation Co. LLC v. U.S. EPA*, 714 F.3d 841, 852–53 (5th Cir. 2013) (using the two step analysis under *Chevron* held that congress didn't speak directly to the issue and the agency's interpretation of congressional intent was permissible); *VERIZON COMM'NS INC. V. FCC*, 535 U.S. 467, 468 (2002) ('[T]he incumbents have not met their burden of showing unreasonableness to defeat the deference [under *Chevron*] due the FCC.').

<sup>174</sup> In *AT&T CORP. V. PORTLAND*, the Ninth Circuit held that cable modem service is a "telecommunications service." 216 F.3d 871, 878 (2002). The Federal Communications Commission (FCC) then made a declaratory ruling which determined it had "appropriately classified [broadband cable modem service] as an 'information service' [that] does not contain a distinct telecommunications service." *In re Inquiry Concerning High-Speed Access to Internet over Cable and Other Facilities (Cable Modem Declaratory Ruling)*, 17 FCC Rcd. 4798, 4847 (2002). The Ninth Circuit subsequently heard the appeal for the declaratory ruling and based its holding on stare decisis from Portland. The Supreme Court reversed the Ninth Circuit in *Nat'l Cable & Telecommunications Ass'n v. Brand X Internet Servs.* The Court said that even if 'telecommunications service' was the best reading of the statute, the Commissioner's interpretation is still entitled to *Chevron* deference if it is a reasonable interpretation. Furthermore, "A court's prior construction of a statute trumps an agency construction otherwise entitled to *Chevron* deference only if the prior court decision holds that its construction follows from the unambiguous terms of the statute and thus leaves no room for agency discretion." 125 S. Ct. 2688, 2690–91 (2005).

<sup>175</sup> See Cass R. Sunstein, *Chevron Step Zero*, 92 VA. L. REV. 187, 196–98 (2006) (stating that other proposed reasons such as administrative experts being able to interpret congressional intent better than judges; agency decisions require policy judgments and are better suited for the political rather than the judicial branches of government; or executive interpretations should be given deference based on a separation of powers argument, have been displaced by the simple statement, because congress has told the judiciary to give deference, they should do so).

<sup>176</sup> *Contra Marbury v. Madison*, 5 U.S. 137 (1803).

congressional intent is reasonable.<sup>177</sup> Justice Antonin Scalia once opined, “I tend to think, however, that in the long run *Chevron* will endure and be given its full scope . . . because it more accurately reflects the reality of government, and thus more adequately serves its needs.”<sup>178</sup>

However, *Chevron* is not without its critics, indicating there is at least some pushback to agency deference. One does not need to look any further than Justice Thomas’s concurrence in *Cuozzo*.<sup>179</sup> Justice Thomas has been a vocal critic of *Chevron* and the cases decided based on its doctrine.<sup>180</sup> Still others have questioned the prudence of *Chevron* as well.<sup>181</sup> Given the historical precedent set by the past practice of the Federal Circuit to interpret the substantive patent laws,<sup>182</sup> any deference given to the Patent Office will be limited to the new post-grant review proceedings.<sup>183</sup> Congress would need to expressly tell the courts if its intent is to change this and determine that it should also defer to the agency when interpreting the substantive patent laws, such as sections 101 – 103.<sup>184</sup>

---

<sup>177</sup> See Cass R. Sunstein, *Chevron Step Zero*, 92 VA. L. REV. 187, 190 (2006); *McCulloch v. Maryland*, 17 U.S. 316, 353 (1819) (“The power to establish such a corporation is implied, and involved in the grant of specific powers in the constitution; because the end involves the means necessary to carry it into effect. A power without the means to use it, is a nullity. . . . [T]he constitution . . . expressly gives to congress the power ‘to make all laws which shall be necessary and proper for carrying into execution the foregoing powers . . . or in any department or officer thereof.’”).

<sup>178</sup> Antonin Scalia, *Judicial Deference to Administrative Interpretations of Law*, 1989 DUKE L.J. 511, 520 (1989).

<sup>179</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2148 (2016) (Thomas, concurring).

<sup>180</sup> See, e.g., *Perez v. Mortg. Bankers Ass’n*, 135 S. Ct. 1199, 1213–25 (2015) (Thomas, concurring) (“This line of precedents undermines our obligation to provide a judicial check on the other branches, and it subjects regulated parties to precisely the abuses that the Framers sought to prevent.”).

<sup>181</sup> See, e.g., Ronald A. Cass, *Is CHEVRON’s Game Worth the Candle? Burning Interpretation at Both Ends*, in *LIBERTY’S NEMESIS* 57, 69 (D. Reuter & J. Yoo eds., 2016) (“Perhaps the best course at this point is to scrap the *Chevron* framework and return to the terms laid out in the APA’s Section 706.”); DAVID RUDENSTINE, *THE AGE OF DEFERENCE: THE SUPREME COURT, NATIONAL SECURITY, AND THE CONSTITUTIONAL ORDER 7* (2016) (“[I]nstead of fulfilling one of the highest aims of civil society—providing a remedy for unlawful government conduct—the Supreme Court betrays that lofty aspiration and clothes the denial of a remedy in a technical legal doctrine permitting the executive officials who may have committed an unlawful act to escape judicial accountability.”).

<sup>182</sup> See discussion *supra* Section II.

<sup>183</sup> See discussion *supra* Section III.

<sup>184</sup> 35 U.S.C. §§ 101 – 103 (2012).

*B. The Patent Office Gains a Small Foothold Toward the Deference Accorded to Other Administrative Agencies*

The reading of *Cuozzo* results in a continuation of the slow trend of deference granted to the Patent Office. Historical practice has been for the courts not to accede deference to the Patent Office to the same extent as other agencies.<sup>185</sup> The courts by and large have retained their claim to reviewing Patent Office decisions and reversing when they conflict with the court's interpretation of the patent statutes—with some notable exceptions.<sup>186</sup> *Cuozzo* continues this slow trend by explicitly holding that *Chevron* deference is controlling.<sup>187</sup>

However, this ruling should not be seen as setting a new standard for court deference to the Patent Office; deference will remain dissimilar to that given to other government agencies. A narrowly construed application of *Cuozzo* to future cases is the result. First, the facts in *Cuozzo* lent themselves to defeat. Axiomatically, if a dependent claim is invalidated because it is not novel, then by definition any claim subsuming the dependent claim must also be invalid due to lack of novelty. It is hard to see how *Cuozzo* was prejudiced based on the appeal presented; even the dissent made specific reference to the weakness of *Cuozzo*'s arguments.<sup>188</sup> Thus, not only was prejudice against *Cuozzo* regarding institution of inter partes review difficult to find, but so also was prejudice regarding the Patent Office's use of the broadest reasonable interpretation standard. While a patent claim could at least theoretically be valid using the court's 'as understood by those skilled in the art' standard, but invalid using the Patent Office's broadest reasonable interpretation standard, this would be a rare instance. It is most likely that *Cuozzo*'s claim would have been invalidated even using the court's less stringent standard.

However, the dissent is writing with an eye toward future cases and asks, "[If a Patent Office decision] grossly exceed[s] the Patent Office's authority and would be manifestly prejudicial to the patent owner, [could] Congress really have intended to shield such shenanigans from judicial scrutiny?"<sup>189</sup> The majority emphasizes their analysis is employed only when the decision by the Patent Office to institute inter partes review is closely tied to those corresponding patent

---

<sup>185</sup> See, e.g., *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001); see Sarah Tran, *Patent Powers*, 25 HARV. J.L. & TECH. 609, 616 (2012) ("[The Federal Circuit] has assumed exclusive responsibility for making substantive interpretations of the Patent Act."); Sapna Kumar, *Expert Court, Expert Agency*, 44 U.C. DAVIS L. REV. 1547, 1550 (2011) ("The Federal Circuit treats appeals from patent agencies differently than those from non-patent agencies. The Federal Circuit has granted *Chevron* or the lesser *Skidmore* deference to decisions from all of its non-patent agencies. In contrast, the Federal Circuit has historically chosen not to defer to agencies on issues of patent law.")

<sup>186</sup> *Dickinson v. Zurko*, 527 U.S. 150, 152 (1999) ("[T]he Federal Circuit must use the framework set forth in [5 U.S.C.A. § 706].").

<sup>187</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016).

<sup>188</sup> *Id.* at 2154 ("Assuming that *Cuozzo* must show prejudice from the error it alleges, it is hard to see how *Cuozzo* could do so here. . . . But any perceived weakness in the merits of *Cuozzo*'s appeal does not mean that such issues are unworthy of judicial review.")

<sup>189</sup> *Id.* at 2155.

statutes.<sup>190</sup> Further, if due process or other constitutional issues are raised by a future litigant, this holding would not impede judicial review of such a case.<sup>191</sup> Thus, the holding in *Cuozzo* is quite narrow.

Limiting the effect of the *Cuozzo* decision even further is the fact that the Court used the rule-making authority granted by Congress cabined within the post-grant review patent statutes.<sup>192</sup> The Patent Office's rule-making ability has historically been limited to only procedural matters. For the first time, Congress has granted the Patent Office substantive rule-making authority, meaning they can use certain policies identified by Congress<sup>193</sup> to promulgate their own rules regarding these post-grant review proceedings and certain other proceedings.<sup>194</sup> This same rule-making authority has not been extended to the other patent statutes which would threaten the holdings in thousands of cases that have interpreted the core patent statutes establishing patentability—namely, sections 101, 102, 103, and 112.<sup>195</sup>

### *C. Would the Court Defer to the Patent Office when interpreting Section 102?*

For example, prior to the America Invents Act, section 102(b) of the patent statutes would bar a patent from issue if the invention was 'on sale.'<sup>196</sup> Case law has already interpreted the on-sale bar to include sales that involve non-public informing uses.<sup>197</sup> However, when Congress rewrote section 102 for the America Invents Act, they changed the statutory language.<sup>198</sup> The Patent Office has penned an opinion

<sup>190</sup> *Id.* at 2141.

<sup>191</sup> *Id.* at 2141–42 (2016) (“Thus, contrary to the dissent's suggestion, we do not categorically preclude review of a final decision where . . . there is a due process problem with the entire proceeding, nor does our interpretation enable the agency to act outside its statutory limits. . . . Such “shenanigans” may be properly reviewable in the context of § 319 and under the Administrative Procedure Act, which enables reviewing courts to “set aside agency action” that is “contrary to constitutional right,” “in excess of statutory jurisdiction,” or “arbitrary [and] capricious.”).

<sup>192</sup> 35 U.S.C. § 316 (2015).

<sup>193</sup> 35 U.S.C. § 316 (2015) (“(b) Considerations.--In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.”).

<sup>194</sup> Sarah Tran, *Patent Powers*, 25 HARV. J.L. & TECH. 609, 640–44 (2012).

<sup>195</sup> *See id.* at 615.

<sup>196</sup> 35 U.S.C. § 102(b) (1952) (“[T]he invention was patented or described in a printed publication in this or a foreign country or in public use or ‘on sale’ in this country, more than one year prior to the date of the application for patent in the United States.”) (emphasis added).

<sup>197</sup> *See, e.g., Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir. 1946) (“[I]t is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.”).

<sup>198</sup> 35 U.S.C.A. § 102, *supra*, note 5.



that the ‘on sale’ bar now only applies to inventions that are publically informing and does not apply to sales that do not teach the public how to practice the invention.<sup>199</sup> Thus, in the Patent Office’s opinion, *Metalizing Engineering* is no longer good law because the sale in that case did not disclose to the public how the invention was made.

The courts are likely to give little if any weight to the Patent Office’s opinion even under *Cuozzo*. First, as previously discussed, the historical practice has been for the federal circuit to interpret the patent statutes regarding substantive rules and only to give deference when the Patent Office interprets a procedural matter that takes place within the Patent Office. Second, the issue of whether or not an invention was ‘on sale’ only comes up in litigation.<sup>200</sup> Not only does the Patent Office not have any experience in adjudicating these cases, but also would not have ruled on any cases that, at least arguably, the court would need to give deference. Lastly, when Congress passed the America Invents Act, the only substantive rule making authority conferred to the Patent Office was in regards to the post grant review proceedings.<sup>201</sup> Congress could have explicitly extended this authority to the other patent statutes as well if it had intended to do so. Therefore, the courts are the appropriate interpreters of the new section 102 patent statute—not the Patent Office.

Based on policy arguments, the courts will not overturn *Metallizing Engineering* and will continue to hold that non-informing public sales also bar patentability.<sup>202</sup> The courts have interpreted the patent statutes to require a decision by an inventor early on to either apply for a patent or to designate the invention as a trade secret. This is to prevent an inventor from extending the right to exclude others from practicing the invention beyond the statutory limit of 20 years. The courts have consistently held that this is the primary reason that patents are denied when an applicant has commercialized its invention outside the grace period.<sup>203</sup>

#### *D. The Broadest Reasonable Interpretation Should Not Be Used in an Inter*

---

<sup>199</sup> MPEP § 2152.02(d) (“The phrase ‘on sale’ in AIA 35 U.S.C. 102(a)(1) is treated as having the same meaning as ‘on sale’ in pre-AIA 35 U.S.C. 102(b), except that the sale must make the invention available to the public.”) (emphasis added).

<sup>200</sup> See, e.g., *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 518 (2d Cir. 1946).

<sup>201</sup> 35 U.S.C. §§ 300 – 329 (2012).

<sup>202</sup> See, e.g., *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 855 F.3d 1356, 1370, n.11 (Fed. Cir. 2017) (“A primary rationale of the on-sale bar is that publicly offering a product for sale that embodies the claimed invention places it in the public domain, regardless of when or whether actual delivery occurs.”). The Helsinn Court explained that requiring the details of the claimed invention be publicly disclosed before the on-sale bar is triggered “would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.” *Id.* at 1369 (citing *Pennock v. Dialogue*, 27 U.S. 1, 19 (1829)).

<sup>203</sup> See, e.g., *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir. 1946); *The Driven-Well Cases*, 123 U.S. 267, 274 (1887).

---

### Partes Review *Proceeding*

The Patent Office's use of the broadest reasonable interpretation standard during an inter partes review proceeding is not a reasonable interpretation of Congressional intent under *Chevron*. When a statute is ambiguous, any administrative rule applying the statute must be a reasonable interpretation of Congressional intent.<sup>204</sup> Otherwise, it is invalid. The broadest reasonable interpretation standard has historically been used during the pendency of a patent application in front of the Patent Office where the claims are amended in an iterative process. The use of the broadest reasonable interpretation standard when construing claims has a two-fold purpose. First, it is to eliminate any ambiguity in the claim language so that the public may understand exactly what knowledge is protected by the patent claims and what remains open to them. Secondly, the purpose is to limit the scope of the invention to only encompass what the inventor actually created—and no more. These overriding considerations are in place to protect the public and any perceived injury to the patent applicant is alleviated by his ability to amend the claims.

This is analogous to the specificity requirement, 35 U.S.C. § 112. An invention needs to be described completely and with specificity such that a person of ordinary skill in the art could make and use the invention. The patent system is a compromise designed to incentivize the invention process where an inventor receives the right to exclude others from practicing the invention in exchange for disclosing the knowledge of the invention to the public. It is this disclosure by the inventor to the public that is deemed by Congress to be worthy of the social costs associated with granting an inventor a monopoly in the invention even if for a limited time. However, Congress has explicitly allowed a patent to be reviewed during an inter partes review with respect to sections 102 or 103 only—not 101 or 112. Implicit in this decision is that any deficiencies with respect to those sections should have already been addressed and will give deference to the Patent Office's initial determination regarding those sections. Therefore, issues within those sections can only be raised in district court.

Similarly, any issues arising from using the broadest reasonable interpretation standard should already be addressed by the time the patent is challenged in an inter partes review proceeding. It is difficult to understand how a patent, that is challenged eight years after it has been issued, in an inter partes review furthers the public interest of removing ambiguity from the language or limiting the scope of the invention through the use of the broadest reasonable interpretation standard. That is not to say that if prior art is introduced that reads on the claim the claims should not be limited, only that using the broadest reasonable interpretation standard is not the appropriate mechanism to achieve this. Any claim scope already determined to be patentable using the broadest reasonable interpretation, similar to section 112 determinations, should be given the same deference as a previously adjudicated agency decision. Thus, the Patent Office's use of the broadest

---

<sup>204</sup> See 5 U.S.C. § 706(A) (1966); *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 844 (1984).

reasonable interpretation during inter partes review is not a reasonable interpretation of Congressional intent. The Patent Office should employ the standard used by the courts, “as understood by a person of skill in the art.”<sup>205</sup>

Instead, in *Cuozzo*, the Patent Office essentially raised the issue de novo during the inter partes review proceeding and gave no weight to their own examiners previous decision. As already discussed, the use of the broadest reasonable interpretation does not further the public interests after the patent has already issued. In fact, it undermines confidence in the Patent Office when a determination is made by an administrative agent (patent examiner) and then given no deference within the same agency. The use of the broadest reasonable interpretation standard during an inter partes review additionally places an undue hardship on the patentee. Again, the purpose of using the broadest reasonable interpretation standard is to encourage an applicant to remove ambiguous language and narrow the claim scope to only cover the invention that was created through an iterative process. This iterative process is absent in an inter partes review and thus the patentee only gets one *chance* to amend his claims by motion to the Patent and Trademark Administration Board. The record to date shows that it is not much of a *chance* at that. Because the unnecessary burdens placed on a patentee substantially outweigh any benefit to the public by using the broadest reasonable interpretation during an inter partes review, the Patent Office should instead employ the “as understood by one of skill in the art” standard used by courts during an inter partes review proceeding.<sup>206</sup>

### *E. Two Different Outcomes in Different Settings*

The court concedes the fact that two different outcomes are possible, one outcome within the Patent Office and a different outcome in district court.<sup>207</sup> However, the Court fails to address the issues raised by this scheme. The first issue is the inherent unfairness experienced by the patentee discussed above. The second issue is the potential for excess litigation.<sup>208</sup> Having even the potential for different outcomes in different forums encourages forum shopping and other undesirable behaviors by litigants. The last issue is the potential for economic dislocation.

---

<sup>205</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2139 (2016).

<sup>206</sup> *Id.* at 2139.

<sup>207</sup> *Id.* at 2146 (2016) (“We recognize that [the possibility of different outcomes] is so. This possibility, however, has long been present in our patent system, which provides different tracks—one in the Patent Office and one in the courts—for the review and adjudication of patent claims. As we have explained above, inter partes review imposes a different burden of proof on the challenger. These different evidentiary burdens mean that the possibility of inconsistent results is inherent to Congress' regulatory design.”).

<sup>208</sup> STUDY OF THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE COMMITTEE ON THE JUDICIARY, 85<sup>TH</sup> CONG. 2D SESSION, AN ECONOMIC REVIEW OF THE PATENT SYSTEM (1958) (Fritz Machlup) (noting that two different standards applied in different forums will likely greatly increase litigation).

VIII. THE COURT IN *CUOZZO* GOT IT WRONG

*A. Because legislative intent was not ambiguous, the Court should not have employed Chevron to decide the case.*

Congress clearly stated in the legislative history that its intent was that post-grant review proceedings were to be more like litigation in court rather than historical adjudications performed solely within the agency.

*B. The Court should have ruled in favor of Cuozzo based on Administrative Law principles*

The Court all but says explicitly that if *Cuozzo* would have argued the case on administrative law grounds, the case would have come out differently. The Court says, “*Cuozzo* does not contend that the decision not to allow its amendment is ‘arbitrary’ or ‘capricious,’ or ‘otherwise [un]lawful,’”<sup>209</sup> in reference to the Patent Office denying *Cuozzo*’s attempt to amend the claims. This applies equally well to *Cuozzo* not raising the same issue in regards to the Patent Office’s decision to institute inter partes review regarding claims 10 and 14.<sup>210</sup>

Even the majority agreed non-reviewable decisions can be reviewed if it raises any constitutional issue.<sup>211</sup> Just as importantly, the Court has held that agencies must be constrained to making decisions within their jurisdictional purview and that agency discretion does not apply when they act outside of their jurisdiction.<sup>212</sup> In *Cuozzo*, when the Patent Office instituted inter partes review of claims 10 and 14, they acted outside of their jurisdictional authority and therefore had no discretion to institute review of those claims. The statute states, “[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . .”<sup>213</sup> The statute clearly limits claims and issues to be limited to those raised in the petition. The Patent Office does not have any jurisdictional authority to raise issues outside of those presented in the petition. If Congress had wanted the Patent Office to be able to raise issues outside of the four corners of the petition, it would have said so.

---

<sup>209</sup> *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2146 (2016) (citing 5 U.S.C. § 706(2)(a) (1966)).

<sup>210</sup> *Id.* at 2156.

<sup>211</sup> *Id.* at 2141-42.

<sup>212</sup> *See, e.g., Berkovitz v. United States*, 486 U.S. 531, 544 (1988) (“The agency has no discretion to deviate from [] mandated procedure. . . . When a suit charges an agency with failing to act in accord with a specific mandatory directive, the discretionary function exception does not apply.”).

<sup>213</sup> 35 U.S.C. § 314(a) (2011).

## IX. CONCLUSION

The decision in *Cuozzo* establishes, at least regarding the post-grant review of patent proceedings, that the courts will defer to the Patent Office's interpretation of congressional intent as long as its interpretation is reasonable. This has not been extended and is unlikely to be in the near future to the core statutes regarding patentability—sections 101, 102, 103, and 112. The Court rightly points out that Congress has constructed the patent statutes in this way and the Court should not substitute their judgment in its place. Although there are good arguments as to why this may be a good rule, there are also strong arguments against. The Court seems to be conceding that an administrative agency is a better 'judge' in interpreting congressional intent.<sup>214</sup> The Court does not seem to acknowledge the inherent problems of improper influences that may present themselves that are unrelated to underlying congressional policy considerations or that compel an agency to not keep fidelity to the Constitution such as concerns about retaining influence and power as an agency, political pressures outside the scope of the statute in question, or denying substantive due process to applicants in the name of efficiency. Effectively relegating administrative rules to rational basis review by courts of interpretive questions seems to defer to the agencies the power to say what the law is and only the underlying statute circumscribes that interpretation. If that interpretation is reasonable, then the judiciary does not have the power to review it.

---

<sup>214</sup> *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 865 (1984) (“In these cases, the Administrator's interpretation represents a reasonable accommodation of manifestly competing interests and is entitled to deference: the regulatory scheme is technical and complex, the agency considered the matter in a detailed and reasoned fashion, and the decision involves reconciling conflicting policies. Congress intended to accommodate both interests, but did not do so itself on the level of specificity presented by these cases. Perhaps that body consciously desired the Administrator to strike the balance at this level, thinking that those with great expertise and charged with responsibility for administering the provision would be in a better position to do so; perhaps it simply did not consider the question at this level; and perhaps Congress was unable to forge a coalition on either side of the question, and those on each side decided to take their chances with the scheme devised by the agency. For judicial purposes, it matters not which of these things occurred.”).

---

---

## **Cybaris®**

Cybaris®, an Intellectual Property Law Review, publishes non-student articles and student comments on all areas of intellectual property law, including patents, copyrights, trademarks, licensing, and related transactional matters.

[mitchellhamline.edu/cybaris](http://mitchellhamline.edu/cybaris)

## **Intellectual Property Institute**

Cybaris® is a publication of the Intellectual Property Institute at Mitchell Hamline School of Law.

[mitchellhamline.edu/ip](http://mitchellhamline.edu/ip)

---

**MH**

MITCHELL | HAMLINE

School of Law

© Mitchell Hamline School of Law  
875 Summit Avenue, Saint Paul, MN 55105

[mitchellhamline.edu](http://mitchellhamline.edu)