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Certiorari in Patent Cases

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CERTIORARI IN PATENT CASES

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* © 2020 Christa J. Laser. Assistant Professor at Cleveland-Marshall College of Law. The Author thanks the Honorable Arthur J. Gajarsa, Retired Circuit Judge, United States Court of Appeals for the Federal Circuit, who contributed immeasurably, and each of the anonymous interviewees for their time, expertise, and courage. The Author likewise thanks Paul Gugliuzza, Ryan Vacca, and the participants in the 2019 Works-in-Progress IP Conference for their helpful commentary, and Ella Jenak, Greg Capaldini, Michelle Mattingly, Crystal Williams, Wendi Hoffenberg, and Paula Maher.

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I. INTRODUCTION

In the decade from 2010 to 2019, the Supreme Court has decided more patent law cases than in the prior three decades combined and nearly twice that of any prior decade since the 1952 Patent Act.[1] This increase in patent cases has occurred despite a marked decrease in the number of cases accepted for review by the Court. In recent years, the Supreme Court has decided roughly half the number of cases as it did in the 1970s or 80s.[2] In the last decade, however, patent opinions increased to more than 5% of issued Supreme Court opinions versus only 0.5% in the 1980s.[3] In other words, as a percentage of its opinions, the Supreme Court heard nearly ten times as many patent cases in the decade from 2010 to 2019 as it did in the 1980s, when Congress first created the Federal Circuit with the purpose of nationally unifying patent law.[4]

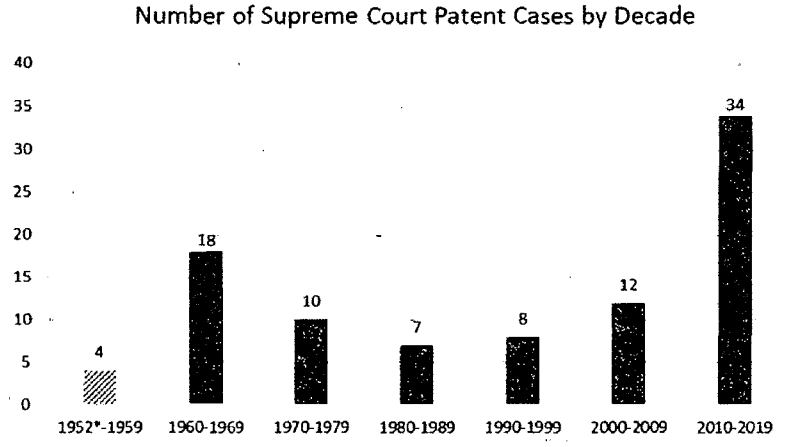

Figure 1. Supreme Court Patent Cases by Decade

Shows the number of patent opinions issued per year by the Supreme Court by decade, counting back from 2019 to the enactment of the 1952 Patent Act. The years from 1952 to 1959 do not constitute a full decade. [5]

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1 *Infra*, Figure 1.

2 *Infra* Section III, Figure 2.

3 *Infra* Section III, Figure 3.

4 *Infra* Section III, Figure 3; *infra* Section II.C; Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982) (codified at 28 U.S.C. § 1 (2018)).

5 Patent opinions since 1952 are based on the list of Supreme Court Patent Cases maintained by Professor Lisa Larrimore Ouellette, Stanford Law

Some scholarship on this issue attributes the increase to the rise of a specialized Supreme Court patent bar more adept at obtaining certiorari in patent cases and the increasing influence of the Solicitor General in patent cases.[6] Others urge that the Supreme Court in recent years is seeking to correct a Federal Circuit that relies on overly rigid tests or approaches to patent law that differ from other areas of law.[7] Yet no scholarship to date has undertaken to qualitatively test the reasons for the increase by examining not only the theory, but also the viewpoints of those with direct experience in the certiorari process in patent cases.

Prior studies have looked at correlative factors associated with Supreme Court decisions to grant the writ of certiorari, as well as correlative factors associated with review of Federal Circuit decisions.[8] Quantitative analysis, however, cannot determine for certain whether correlative factors are also causative. Beginning to address the gap, nearly two decades ago, political scientist H.W. Perry interviewed justices and former clerks seeking to ascertain what drives the Court's decisions to accept a case for review.[9] His book outlining these interviews provided a critical new understanding of the certiorari process.[10] Nonetheless, that analysis did not answer a missing piece of the certiorari puzzle, namely, how does the Supreme Court decide how to hear cases when the factors that drive decisions in ordinary cases, such as circuit splits, are not applicable? In the patent context, where the Federal Circuit has exclusive jurisdiction among the

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School. Lisa Larrimore Ouellette et al., *Supreme Court Patent Cases*, WRITTEN DESCRIPTION, https://writtendescription.blogspot.com/p/patents-scotus.html [https://perma.cc/7Q25-CTG6] (last visited Aug. 17, 2020).

6 *See* John F. Duffy, *The* Festo *Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 286–93 (2002); *see also* Paul R. Gugliuzza, *The Supreme Court Bar at the Bar of Patents*, 95 NOTRE DAME L. REV. 1233, 1246, 1253–58 (2020).

7 *See* Tejas N. Narechania, *Certiorari, Universality, and a Patent Puzzle*, 116 MICH. L. REV. 1345, 1348 (2018).

8 *E.g.*, Ryan Stephenson, *Federal Circuit Cases Selection at the Supreme Court: An Empirical Analysis*, 102 GEO. L.J. 271, 272 (2013).

9 H.W. PERRY, DECIDING TO DECIDE: AGENDA SETTING IN THE UNITED STATES SUPREME COURT 247 (1991) (reporting on interviews with former justices and clerks).

10 *See id.* at 246 (including statements by clerks and the justices on the procedures of the court, including the logistics of certiorari decisions).

appellate courts, the Supreme Court must rely on other factors to drive its determination of when to accept a case for review.[11]

The need for qualitative data on the patent certiorari process is particularly important at this time. The Supreme Court's increased patent docket has a derivative impact on the economy.[12] Tens of thousands of businesses in the United States and around the world rely upon United States patent law to structure their new products and investments.[13] It also is the driving force for research and development for a technological society.[14] A change in the law from the Supreme Court can impact whether patents are valid, whether products are infringed, whether patents are enforceable, or the amount of recoverable damages.[15] These changes can destabilize and revalue millions of investments in technology and pharmaceuticals.[16] In some cases, the patent law decisions of the United States Supreme Court can change the viability of industries or the standing of the United States as a leader in innovation.[17]

Addressing these gaps, the Author of this Article conducted structured interviews with former Supreme Court clerks and others involved in the certiorari process, with a focus on what drives the selection of certiorari petitions in patent cases. To protect the privacy of the interviewees, the information reported below is based on aggregated responses to these interviews, except where noted. The results of these interviews show that it is not, as many have urged, primarily an increased interest by the Supreme Court in patent law driving the increasing number of patent cases reviewed by the Supreme Court. Rather, the Author

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11 *Infra* Part V.

12 *See* Kevin Madigan & Adam Mossoff, *Turning Gold into Lead: How Patent Eligibility Doctrine Is Undermining U.S. Leadership in Innovation*, 24 GEO. MASON L. REV. 939, 946–47 (2017).

13 *See* USPTO, INTELLECTUAL PROPERTY AND THE U.S. ECONOMY: INDUSTRIES IN FOCUS (March 2012) at vi, https://www.uspto.gov/sites/default/files/news/publications/IP_Report_March_2012.pdf [https://perma.cc/Q7B9-W6Q5].

14 Dirk Czarnitzki & Andrew A. Toole, *Patent Protection, Market Uncertainty, and R&D Investment*, 93 REV. ECON. & STAT. 147 (2011), https://pubag.nal.usda.gov/download/53785/PDF [https://perma.cc/GJF3-PUAU].

15 *E.g.*, Bilski v. Kappos, 561 U.S. 593, 610 (2010) (determining what types of inventions are eligible for patenting).

16 *See* Madigan & Mossoff, *supra* note 12, at 946–47.

17 *See id.*

concluded from these interviews that Supreme Court review of Federal Circuit decisions is a multi-faceted decision-making process based not only on the merits of a particular case, but also on policy, timing, and the influence of expert advocates and amici. It is also driven by a unique narrative of the Federal Circuit as rogue, a narrative that those seeking certiorari use to buttress their petitions in an attempt to increase the likelihood of obtaining review of their case. For example, many petitions argue that the Federal Circuit creates overly rigid rules in its holdings in its attempt to normalize and unify patent law.[18] Additionally, the reports of some of the interviewees suggest that another reason for the rise of patent cases is that patent cases are not seen as ideologically divisive; in a time of noticeable ideological division at the Court, patent cases are unusual in their ability to generate unfractured and often unanimous majority opinions.

Part I of this Article provides a brief background on certiorari decision-making at the Supreme Court and the history of the Supreme Court's review of patent cases. Part II provides some statistics on Supreme Court review of patent cases, which includes showing that the Supreme Court decides more than ten times as many patent cases today as it did in the 1980s. Part III reports on structured interviews with those most involved in the certiorari process, comparing their reports of the key factors affecting certiorari to the factors theorized in scholarship.

Part IV presents a normative or policy analysis of how the Supreme Court's decision-making on certiorari in patent cases has impacted and will continue to impact patent law, technological innovation, and the economy in the decade to come. It also provides recommendations for considerations for certiorari in patent cases. In particular, the Supreme Court in patent cases should give particular weight to the impact of taking the case on the public interest, which in patent law must include consideration of whether a decision would contribute to or undermine the certainty and stability of the law. Indeed, in patent law, the certainty and stability of the law might be the most critical factor.

II. PROCEDURE AND HISTORY OF SUPREME COURT REVIEW OF PATENT CASES

A. PROCEDURE OF SUPREME COURT REVIEW

To understand the factors that influence the Supreme Court's decision-making on a writ of certiorari, it is important to discuss the procedure applied in the Supreme Court's certiorari process. Although the Supreme Court had

[18] *E.g.*, Petition for Writ of Certiorari at i, Octane Fitness, LLC v. Icon Health & Fitness, Inc., 572 U.S. 545 (2014) (No. 12-1184), 2013 WL 1309080.

mandatory jurisdiction over appeals from lower courts in its early years,[19] the Supreme Court's jurisdiction over patent appeals has been discretionary since the Judiciary Act of 1891.[20] Most other types of appeals to the Court became discretionary with the Judiciary Act of 1925, meaning that such a case would be heard at the Court only if the Court granted a petition for certiorari.[21] "Review on a writ of certiorari is not a matter of right, but of judicial discretion."[22] A party who loses on appeal before a federal circuit court or, in some cases, in a state court of last resort may seek the review of the Supreme Court by filing a petition for certiorari setting forth the question for review and bases that the party believes to justify Supreme Court review.[23]

In the modern era, the Supreme Court receives approximately 7,000 to 8,000 petitions for certiorari per term.[24] The workload to review these petitions is substantial.[25] As one interviewee described it, this amounts to about a four-to-six-foot-high stack of petitions every week that the Supreme Court is in session.[26] Given this volume, the Justices must rely heavily on clerks to serve a gatekeeping

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19 U.S. CONST., art. III, § 2 (giving the Supreme Court limited original jurisdiction, but expansive appellate jurisdiction, including over cases arising under the Constitution, the laws of the United States, and treaties, controversies between citizens of different states, and other scenarios).

20 Evarts Act, ch. 517, 26 Stat. 826 (1891).

21 *See* Judiciary Act of 1925, Pub. L. No. 68-415, § 237, 43 Stat. 936, 937 (codified as amended at 28 U.S.C. § 1294 (2018)).

22 SUP. CT. R. 10.

23 *See id.*

24 *The Supreme Court at Work*, SUP. CT. OF THE U.S., https://www.supremecourt.gov/about/courtatwork.aspx [https://perma.cc/ZKG7-GCY3] (last visited Aug. 17, 2020) ("Each Term, approximately 7,000-8,000 new cases are filed in the Supreme Court. This is a substantially larger volume of cases than was presented to the Court in the last century. In the 1950 Term, for example, the Court received only 1,195 new cases, and even as recently as the 1975 Term it received only 3,940.").

25 Note, however, that more than two thirds of Supreme Court petitions are in forma pauperis petitions that some consider to be less time-consuming to review for cert-worthiness than paid cases. Peter S. Menell & Ryan Vacca, *Revisiting and Confronting the Federal Judiciary "Crisis": Charting a Path for Federal Judiciary Reform*, 108 CALIF. L. REV. 789, 866–67 & fig.25 (2020) (charting changes in numbers of paid and in forma pauperis petitions from 1947 to 2017).

26 Interviews by Author.

function, particularly by identifying petitions that do not merit review.[27] Clerks will review the petition and prepare a memo for the Justices analyzing the merits of certiorari and recommending the grant of certiorari, the denial, or in some cases a call for the views of the Solicitor General.[28]

In interviews previously conducted by H.W. Perry regarding the certiorari practice generally, one Justice noted, "I usually could simply read their [the clerk's] memo and tell whether or not a case deserved to be granted certiorari."[29] Particularly when the clerk's recommendation is to deny certiorari, many Justices will not read more than the clerk's memo.[30] Of course, Justices have their own views on important issues and might disagree with the clerk's recommendation or want to read more from the petition first,[31] but the vast number of petitions makes it physically impossible for Justices to themselves perform an in-depth analysis of each petition that arrives before the Court. If the clerk's recommendation is to grant or the Justice disagrees with a clerk's recommendation to deny, the Justice will typically review a petition in more depth.[32] Justice Ruth Bader Ginsburg stated in 1993, "Whenever I think a case may be cert. worthy, I will do the homework required and will not rely solely on a pool memorandum."[33]

Currently, all of the Justices except Alito and Gorsuch participate in what is called the certiorari pool or "cert pool."[34] Clerks for Justices who participate in

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27 PERRY, *supra* note 9, at 70–71.

28 Interviews by Author.

29 PERRY, *supra* note 9, at 71.

30 *Id.* at 70 (quoting an anonymous Justice as saying, "First I decide if I can make a decision on the basis of the memo. In fact, on most of them I can, because most of these I vote to deny. If the case is a good candidate for a grant, then I will mark the memo 'read.' Or I will sometimes mark a memo read even though I would vote to deny but think that others will vote to grant so I read them offensively and defensively.").

31 *Id.* at 70–71.

32 *See id.*; interviews by Author.

33 Linda Greenhouse, *Word for Word; A Talk with Ginsburg on Life and the Court*, N.Y. TIMES (Jan. 7, 1994), https://www.nytimes.com/1994/01/07/us/word-for-word-a-talk-with-ginsburg-on-life-and-the-court.html [https://perma.cc/WK87-U244].

34 Adam Liptak, *Gorsuch, in Sign of Independence, Is Out of Supreme Court's Clerical Pool*, N.Y. TIMES (May 1, 2017), https://www.nytimes.com/2017/05/01/us/politics/gorsuch-supreme-court-labor-pool-clerks.html [https://perma.cc/6PYY-CN25]; Tony Mauro, *Unlike Gorsuch, Kavanaugh Jumps into SCOTUS Cert Pool*, LAW.COM (Oct. 11, 2018),

the certiorari pool will divide the work of initial review of the many petitions for certiorari that arrive at the Court.[35] For all petitions where the Supreme Court has voluntary jurisdiction, and therefore that need to be reviewed for a decision on whether to grant a writ of certiorari, the certiorari pool clerks distribute this stack of petitions evenly among the clerks for initial review.[36] The clerks assigned to a particular petition will prepare a detailed "pool memo" with their summary of the petition, their recommendation on whether to grant or deny certiorari, and the reasons for their recommendation, including noting whether there is a circuit split and often how the petition fits among other recent petitions with similar questions presented.[37] Sometimes, Justices will review only the pool memo, although many Justices will also ask one of their own clerks to review and comment on the pool memo to note agreement or disagreement.[38]

Clerks for Justices who do not participate in the pool will review at least the question presented, and often but not always the entire petition, for all of the petitions that arrive at the Court, divided among the clerks of that Justice.[39] The interviewees note that having some Justices outside the certiorari pool helps to provide a check on the pool recommendation.[40] Memos written solely for one's own Justice tend to be shorter and more informal than a pool memo.[41] If a clerk determines based on review of the question presented that certiorari is clearly not appropriate, they might stop review of the petition and write a short note that states why certiorari should be denied—such as the same issue being recently decided—rather than writing a complete memo.[42]

After the Justices review the memos prepared by their own clerks or the certiorari pool, and often review portions or the entirety of the petition themselves if it might be granted, the Justices will determine whether to place the case on the "discuss list"—a list of cases that the Justices consider, in private discussion, before

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https://www.law.com/nationallawjournal/2018/10/11/unlike-gorsuch-kavanaugh-jumps-into-scotus-cert-pool/ [https://perma.cc/VK2M-ZZSX].

35 Interviews by Author.

36 *Id.*

37 *Id.*

38 *Id.*

39 *Id.*

40 *Id.*

41 *Id.*

42 *Id.*

voting on whether to grant certiorari.[43] Generally, the only cases that a Justice places on the discuss list are those where the Justice believes both that certiorari should be granted and that a sufficient number of other Justices may agree that the case merits serious consideration for granting certiorari.[44] The discuss list is initially prepared by the Chief Justice, then circulated to the other Justices, any of whom may add a case to the discuss list.[45] Certiorari is granted if four Justices vote in favor of certiorari at the conference where the cases are discussed.[46] Cases not on the discuss list at the time of the conference and those that do not receive four votes are denied.[47]

B. SUPREME COURT'S OFFICIAL FACTORS IN GRANTING *CERTIORARI*

The Supreme Court's published Rule 10 provides examples of considerations that may merit the Court granting review on writ of certiorari, with the examples applicable to most federal questions being circuit splits, important but unanswered questions of federal law, and departure from Supreme Court precedent:

> Review on a writ of certiorari is not a matter of right, but of judicial discretion. A petition for a writ of certiorari will be granted only for compelling reasons. The following, although neither controlling nor fully measuring the Court's discretion, indicate the character of the reasons the Court considers:
>
> (a) a United States court of appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter; has decided an important federal question in a way that conflicts with a decision by a state court of last resort; or has so far departed from the accepted and usual

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43 *Id.*

44 *Id.*

45 PERRY, *supra* note 9, at 43–44.

46 *See id.* at 43–44. Voting is conducted in order of seniority, although sometimes Justices might pass to hear the vote of others first. *See id.* at 45. Some Justices cast a "Join-3" vote, meaning a vote to grant review only if at least three other Justices vote in favor. *See* Margaret Meriwether Cordray & Richard Cordray, *The Supreme Court's Plenary Docket*, 58 WASH. & LEE L. REV. 737, 777 n.208 (2001).

47 *See* PERRY, *supra* note 9, at 43.

> course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power;
>
> (b) a state court of last resort has decided an important federal question in a way that conflicts with the decision of another state court of last resort or of a United States court of appeals;
>
> (c) a state court or a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court.
>
> A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law.[48]

These considerations have not meaningfully changed since they were first articulated following a 1925 amendment to the Court's rules.[49] The interviewees noted that certiorari memos, especially when written for the certiorari pool, focus on applying the Rule 10 factors, such as by explaining the nature, scope, and timing of circuit splits.[50]

Past empirical and qualitative analyses have emphasized circuit splits as a primary basis for the Court's grant of certiorari in general cases, citing the harm of inconsistent law in different geographic regions.[51] The considerations named in

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48 SUP. CT. R. 10.

49 *E.g.*, SUP. CT. R. 35.5, 266 U.S. 645 (1925) (repealed 1928). In many prior editions of the Court's rules, the considerations for certiorari applicable to regional circuit court decisions were set out separately from the considerations applicable to decisions of the United States Court of Appeals for the District of Columbia Circuit. *E.g.*, SUP. CT. R. 38.5, 306 U.S. 671 (1939) (repealed 1954). The prior standard referenced only two reasons for review on writ of certiorari: an important question that "has not been, but should be, settled by this court" and failure to give "proper effect to an applicable decision of this court." *Id.* A record of all prior Supreme Court rules is available at https://www.supremecourt.gov/ctrules/scannedrules.aspx.

50 Interviews by Author.

51 *See* PERRY, *supra* note 9, at 247 (reporting on interviews with former justices and clerks and noting that those on the Court viewed geographic uniformity as important). *But see* Menell & Vacca, *supra* note 25, at 860 (urging that the

Rule 10 are not, however, the only factors that affect whether the Supreme Court will grant certiorari.[52] The factors outside of the considerations in Rule 10 that impact the likelihood of certiorari, discussed in more detail in Section III of this Article, include the influence of the Solicitor General and of amici, as well as signals of the importance of the question such as the dollar amount of judgment and factors showing whether the petitioned case provides the best vehicle to decide that question, such as the technical and procedural complexity of the case.[53]

C. THE FEDERAL CIRCUIT'S EXCLUSIVE JURISDICTION

The Federal Circuit has exclusive jurisdiction of appeals of claims arising under patent law, among other specialized subject matter.[54] Created in 1982, pursuant to the Federal Courts Improvement Act,[55] the Federal Circuit is the only circuit court of appeals with jurisdiction limited solely by subject matter rather than geography.[56] The Federal Circuit's decisions apply nationwide in patent

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declining number of accepted cases has resulted in fewer circuit splits being resolved).

52 *Infra* Part IV.

53 *Id.*

54 28 U.S.C. § 1295(a)(1) (2018) ("The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction . . . of an appeal from a final decision of a district court . . . in any civil action arising under, or in any civil action in which a party has asserted a compulsory counterclaim arising under, any Act of Congress relating to patents . . . ."). The Federal Circuit also has jurisdiction over patent appeals from forums other than district courts: the Federal Circuit has exclusive jurisdiction over appeals from final determinations of United States International Trade Commission in Section 337 investigations, *id.* § 1295(a)(6), including investigations into the importation into the United States of articles that infringe a U.S. patent. 19 U.S.C. § 1337 (2018). Additionally, the Federal Circuit has exclusive jurisdiction over appeals from final written decisions of the United States Patent Trial and Appeal Board in post-grant proceedings such as *inter partes* review. 35 U.S.C. § 141(c) (2018).

55 Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982) (codified in scattered sections of 28 U.S.C.).

56 *Compare* 28 U.S.C. § 1295(a), *with id.* § 1294 ("Except as [otherwise] provided . . . appeals for reviewable decisions of the district . . . courts shall be taken . . . to the court of appeals for the circuit embracing the district . . . ."); S. REP. NO. 97-275, at 3 (1981) ("The Court of Appeals for the

cases.[57] The birth of the Federal Circuit began with the 1975 Hruska Commission's study of the caseload crisis in the Federal Courts, which identified, among other issues, a problem for patent law: the Supreme Court was not considering the need for nationally binding judgments on issues of patent law, resulting in non-uniform patent law in different regional circuits.[58] In 1978, Professor Daniel J. Meador proposed a new court of appeals with nationwide jurisdiction over patent law, tax law, and environmental law, and in 1979 President Carter urged Congress to pass legislation creating the court.[59] After several failed attempts and narrowing of the proposed jurisdiction of the Federal Circuit (eliminating exclusive jurisdiction for tax and environmental law), the Federal Circuit was born.[60]

Congress established the Federal Circuit with the mandate of normalizing patent law, reducing the risk of inconsistent law across geographic regions, improving certainty and consistency in patent law, as well as ensuring that patent

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Federal Circuit differs from other federal courts of appeals . . . in that its jurisdiction is defined in terms of subject matter rather than geography.").

57 *See* 28 U.S.C. § 1295(a).

58 *See* COMM'N ON REVISION OF THE FED. CT. APP. SYS., STRUCTURE AND INTERNAL PROCEDURES: RECOMMENDATIONS FOR CHANGE 15, 152–53 (1975) (quoting a letter form Professor Gambrell and Mr. Dunner, stating, "It is our view that the principal cause of circuit-to-circuit deviations in the patent field stems from a lack of guidance and monitoring by a single court whose Judgments are nationally binding. True, the Supreme Court technically fills this role but in practice it has not and, indeed, it cannot. The few decisions it renders in critical patent law areas, e.g., obviousness, have done little to provide the circuit courts with meaningful guidance. The Supreme Court is just too busy to perform anything even resembling a monitoring function on patent-related issues."); *see also* Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 6 (1989).

59 U.S. JUD. CONF. COMM. ON THE BICENTENNIAL OF THE CONST. OF THE U.S., THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY, 1982-1990, at 4–5 (Marion T. Bennett ed., 1991) [hereinafter JUD. CONF. COMM.].

60 *Id.* at 5–6. However, tax and environmental law questions continue to arise at the Federal Circuit in its review of cases from the United States Court of Federal Claims, which has jurisdiction over actions for money damages brought against the United States. *See About the Court*, U.S. CT. OF FED. CLAIMS, https://www.uscfc.uscourts.gov/about-court [https://perma.cc/XN52-CJLH] (last visited Aug. 22, 2020) (explaining types of cases frequently heard at the court).

law issues were determined by judges with more expertise in patent law.[61] In hearings leading up to the creation of the Federal Circuit, Judge Markey, who became the Federal Circuit's first Chief Judge, emphasized, "[T]here is a crying need for uniform judicial interpretation of the national law of patents, an interpretation on which our citizens may rely and plan with some certainty."[62] He warned that the position of the United States in international trade had fallen, but that the trend could be reversed by "investment in new products, technology, under some encouragement that can be relied upon."[63] This suggested that more stable and certain laws applicable to technology could help innovation prosper in the United States.[64] Although the Federal Circuit was given jurisdiction over appeals in other areas of law as well—in part to avoid the dangers of excessive specialization[65]—Judge Markey highlighted the benefits of specialization with this analogy: "[I]f I am doing brain surgery every day, day in and day out, chances are very good that I will do your brain surgery much quicker, or a number of them, than someone who does brain surgery once every couple of years."[66]

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61 *See* Dreyfuss, *supra* note 58, at 2–3, 7–8; JUD. CONF. COMM., *supra* note 59, at xi (discussing purpose of establishing the Federal Circuit). Nonetheless, some scholars have argued against entirely centralized appellate decision-making from the Federal Circuit. *E.g.*, Craig Allen Nard & John F. Duffy, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1623–25 (2007) (arguing that a small number of competing appellate courts might be a more optimal amount of centralization).

62 *Court of Appeals for the Federal Circuit: Hearing on H.R. 4205 Before the Subcomm. on Courts, Civil Liberties and the Admin. of Justice of the H. Comm. on the Judiciary*, 97th Cong., 12 (1981) [hereinafter *Hearing on H.R. 4205*] (statement of the Honorable Howard T. Markey, C.J., Court of Customs and Patent Appeals).

63 *Id.*

64 *See id.*

65 *See* Dreyfuss, *supra* note 58, at 4.

66 *Court of Appeals for the Federal Circuit: Hearings Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the H. Comm. on the Judiciary*, 97th Cong., 42–43 (1981) (statement of the Honorable Howard T. Markey, C.J., Court of Customs and Patent Appeals); Daniel J. Meador, *Reducing Court Costs and Delay: An Appellate Court Dilemma and a Solution Through Subject Matter Organization*, 16 U. MICH. J.L. REFORM 471, 482 (1983). *But see* Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 788 n.4 (2008) (noting potential for overspecialization).

Because of the Federal Circuit's exclusive jurisdiction in cases arising under patent law,[67] there are generally no circuit splits on areas of substantive patent law. The exceptions are splits with cases prior to the formation of the Federal Circuit,[68] or splits on issues of procedural law where regional circuit law may apply.[69] Because of the exclusive jurisdiction of the Federal Circuit over claims arising under patent law, the Federal Circuit's patent law decisions rarely conflict with another United States court of appeals to create a circuit split on a matter that justifies review on writ of certiorari.[70]

The Federal Circuit issues both panel decisions (issued by the three Judges who initially heard the appeal) and *en banc* decisions (decisions of the full court).[71] Often, when the Federal Circuit denies *en banc* review, one or more Judges might disagree and write a dissent from the denial of *en banc*.[72] *En banc* decisions can also be divided, with some Judges concurring or dissenting from the majority opinion.[73] Although dissents from denial of *en banc* review or divided decisions *en banc* provide some indication to the Supreme Court of the contentiousness of an

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67 *See* 28 U.S.C. § 1295(a)(1) (2018).

68 *See, e.g.*, Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 60 (1998) (citing Timely Prods. Corp. v. Arron, 523 F.2d 288, 299–302 (2d Cir. 1975)) (explaining that prior to the Federal Circuit, § 102(b) had a different meaning among the different circuits).

69 Storage Tech. Corp. v. Cisco Sys., Inc., 329 F.3d 823, 836 (Fed. Cir. 2003) (noting that the Federal Circuit applies the law of the regional circuit on matters that are not substantive issues of patent law).

70 The Supreme Court has only granted certiorari based on a circuit split involving the Federal Circuit in a handful of cases since formation of the Federal Circuit. *E.g.*, United States v. Morton, 467 U.S. 822, 826 (1984) (addressing personal jurisdiction over a military officer).

71 Decisions of a panel are binding precedent on later panels until they are overturned by an *en banc* opinion. *See, e.g.*, Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988) ("This court has adopted the rule that prior decisions of a panel of the court are binding precedent on subsequent panels unless and until overturned *in banc*. . . . Where there is direct conflict, the precedential decision is the first.").

72 U.S. CT. OF APPEALS FOR THE FED. CIR., INTERNAL OPERATING PROCEDURES 36 (Mar. 8, 2018), http://www.cafc.uscourts.gov/sites/default/files/rules-of-practice/IOPs/IOPsMaster2.pdf [https://perma.cc/UG5J-V6MT].

73 *E.g.*, Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276, 1282 (Fed. Cir. 2011).

issue, the author understands from the interviewees, as discussed further below, that they are not considered equivalent to a circuit split.[74]

Without circuit splits, in most cases, the only considerations listed in Supreme Court Rule 10 that will apply to Federal Circuit decisions are the presence of important, but unanswered, questions of federal law or departure from Supreme Court precedent.[75] Like other grants of a certiorari petition—and indeed perhaps more so than in general certiorari grants—other factors beyond those listed in Rule 10 also have an impact on the Court's decision of whether to grant certiorari. Part IV will further examine the importance of each of these factors.

As will be amplified in Parts IV and V, the Supreme Court does not currently consider whether granting certiorari review in a patent case will promote or undermine the certainty and stability of patent law. The Federal Circuit, on the other hand, perhaps spurred by its mandate to promote the normalization and centralization of patent law, frequently adopts formalized, bright-line rules that differ from the more flexible approach usually espoused by the Supreme Court.[76] This tension between the Federal Circuit's rule-based approach and the Supreme Court's preference for flexible standards contributes, as discussed below, to a narrative of the Federal Circuit as a rogue appellate court.

III. STATISTICAL ANALYSIS AND DISCUSSION OF FREQUENCY OF SUPREME COURT PATENT CASES

A. NINETEENTH AND EARLY TWENTIETH CENTURIES

In the nineteenth century, patent cases appeared far more frequently on the Supreme Court's docket than they did at the end of the twentieth century.[77] Indeed, in a particularly active period at the end of the nineteenth century, the Court heard an average of upwards of fifteen patent cases per term.[78] This is in part because until 1892, the Court had mandatory jurisdiction over all patent

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74 *See infra* Section IV.H.

75 *See* SUP. CT. R. 10.

76 *Cf.* KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 401–02 (2007) (rebuking the Federal Circuit for the rigidity of its tests and noting, "Helpful insights, however, need not become rigid and mandatory formulas").

77 *See, e.g.*, Duffy, *supra* note 6, at 289 (explaining that the "golden age of the Supreme Court's patent jurisprudence" was in the 1800s).

78 *See* John F. Duffy, *The Federal Circuit in the Shadow of the Solicitor General*, 78 GEO. WASH. L. REV. 518, 521 (2010) (showing the average number of patent cases in Figure 1); *see also infra* Figure 2.

appeals.[79] But even after jurisdiction over patent appeals became discretionary, the Supreme Court in the early twentieth century continued to hear an average of five patent cases per year.[80]

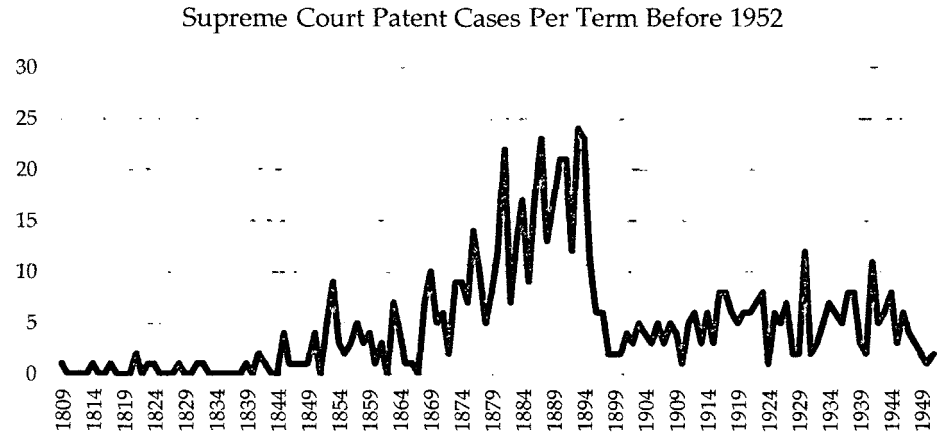

Figure 2.
Chart of Supreme Court patent cases by term prior to 1952.[81]

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79 *See* Duffy, *supra* note 6, at 293 (explaining that "[t]he switch to discretionary jurisdiction allowed the Court" to hear far more significant patent cases than it was typically deciding before the switch); Evarts Act § 6, ch. 517, 26 Stat. 826 (1891).

80 *See infra* Figure 2; *see, e.g.*, Duffy, *supra* note 78, at 522 (explaining how the Supreme Court decreased the number of patent cases it took per year to an average 5 cases).

81 Raw data and the final list of patent cases used is on file with the Author. Selection of cases was determined using Westlaw searches for Supreme Court opinions with "patent!" in the digest or synopsis, then cases were reviewed and culled by research assistant Ella Jenak and checked by the Author. As part of the culling process, the Author also compared the results against cases listed under Westlaw's patent law headnote 291 to help determine whether to add additional patent cases that did not fall within this initial search and to flag cases for potential removal. Cases were removed if they did not resolve a question arising under the patent statute, such as land patent cases, cases arising under the antitrust laws even if they involved patent products, and breach of contract disputes involving patented products. Data from the very early nineteenth century might be underinclusive due to errors in text searching of opinions from this time period. The data tabulated for this Article correlates closely with Professor

The high frequency of patent cases at the Court during this time was likely, at least in part, a result of the increased importance of technology during the Second Industrial Revolution, potentially increasing the number of patent petitions filed with the Court under its mandatory jurisdiction.[82] In addition to being more frequent, however, patent cases of this era also frequently drew lengthy, involved opinions on the substantive merits of patent law, indicative of the importance of these cases and the Court's high interest.[83] Many of the patent cases of the time, like Alexander Graham Bell's telephone patent cases, addressed accessible, clearly important technological innovations that captured the public's attention.[84] Many were seminal cases that set the standards for the validity of patents on revolutionary new technologies, like *O'Reilly v. Morse*, in which the Supreme Court decided that technology underlying the telegraph—the use of electronic current to communicate letters over a distance—was too abstract to patent.[85] These cases not only brought patent law issues to the forefront of public attention, but they set the stage for how patent law would be interpreted for more than a century to come until the modern day.[86] The late nineteenth century was also an important time for patent law due to major statutory changes, such as the Patent Act of 1870.[87]

Duffy's separate tabulations of similar Supreme Court patent opinion data, which began with cases under Westlaw patent headnote 291 and which he then modified by additional searching. *See* Duffy, *supra* note 78, at 521 (showing that the data correlates to the given research here).

82 The Second Industrial Revolution, or Technical Revolution, characterized by advancements in science and production methods, began in the latter third of the nineteenth century. *See The Second Phase of the Industrial Revolution: 1850–1940*, ENCYCLOPEDIA.COM (Nov. 8, 2020), https://www.encyclopedia.com/history/encyclopedias-almanacs-transcripts-and-maps/second-phase-industrial-revolution-1850-1940 [https://perma.cc/GN4Z-SF8N] (last updated Nov. 12, 2020).

83 *See* Duffy, *supra* note 78, at 520.

84 *See* Duffy, *supra* note 6, at 275 (citing *The Telephone Cases*, which confirmed Alexander Graham Bell's telephone patents).

85 *See* O'Reilly v. Morse, 56 U.S. 62, 135 (1854).

86 *See* Duffy, *supra* note 6, at 275.

87 *See* Patent Act of 1870, ch. 230, § 55, 16 Stat. 198, 206 (codified as amended at Rev. Stat. § 4921 (1874)) (altering patent procedure including to permit damages and injunctions in the same suit, among other key provisions setting forth substantive rules, requirements, and defenses in patent law).

B. 1952 PATENT ACT AND BEYOND

As shown in the introduction in Figure 1 and reproduced below, in the decade from 2010 to 2019, the Supreme Court issued more patent opinions than in the prior three decades combined and more than twice the amount of any prior decade since the 1952 Patent Act.[88]

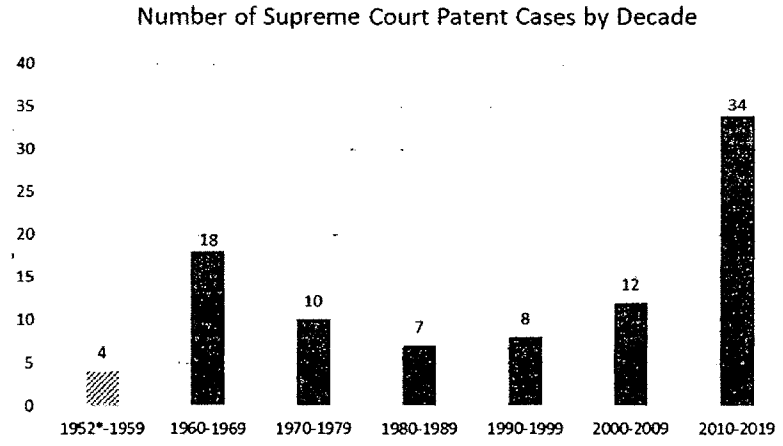

Figure 1 (reproduced).

This increase in patent cases is seen despite a marked decrease in the number of cases heard at the Court. The Supreme Court heard roughly half the number of cases in recent years as it did in the 1970s or 80s.[89]

The Patent Act of 1870 also added the requirement of patent claims, through which patentees were required to distinctly claim their invention. Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201 (1871); Craig Allen Nard, *Legal Forms and the Common Law of Patents*, 90 B.U. L. REV. 51, 70 (2010).

88 *See infra* Figure 1.

89 *See infra* Figure 3. Data tables on file with the Author. Underlying data was supplied by The Supreme Court Database. Harold J. Spaeth et al., *The Supreme Court Database*, WASH. UNIV. L. (Version 2019 Release 01), http://supremecourtdatabase.org/data.php?s=2 [https://perma.cc/PRJ5-MJHE]. Results were filtered to only include Decision Type: opinion of the court (orally argued).

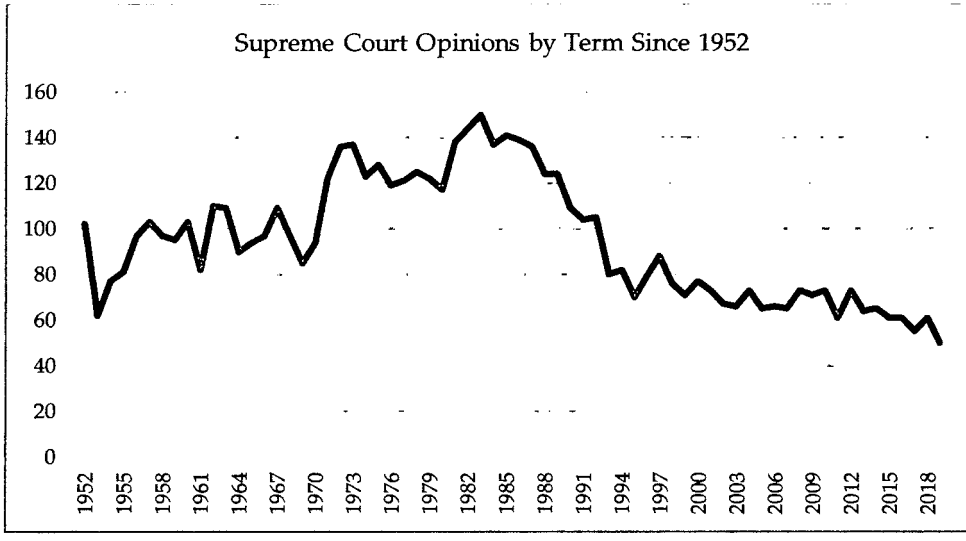

Figure 3.
Number of Supreme Court Opinions by Term.

Some scholars attribute this decline, in part, to increasing ideological divisions in the Court.[90] Others attribute the decline to procedural changes: Justice John Paul Stevens stated in an interview in 1998 that increasing reliance on the certiorari pool caused "the lessening of the docket" because clerks in the pool have a higher reputational incentive to recommend denial, saying, "You stick your neck out as a clerk when you recommend to grant a case. The risk-averse thing to do is to recommend not to take a case."[91] Still others have suggested that the decline is in part because modern justices simply vote to hear cases less often than their predecessors or because the Government—whose requests for appeal are often granted—is filing fewer petitions for certiorari.[92] Likely, the reduction in number

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[90] *See generally* Ryan J. Owens & David A. Simon, *Explaining the Supreme Court's Shrinking Docket*, 53 WM. & MARY L. REV. 1219, 1238 (2012) (explaining a reason for the decrease in patent cases taken by the court may be a result from changes in justices and their resulting ideologies).

[91] *See* Liptak, *supra* note 34, at 1 (quoting a statement made to *USA Today*). *But see* Cordray & Cordray, *supra* note 46, at 792 (noting differences in voting patterns between Justices in the pool and stating, "Indeed, for the first fifteen years after the cert pool made its debut, the number of cases granted plenary review remained in the range of 150 cases per Term.").

[92] *See* Adam Liptak, *The Case of the Plummeting Supreme Court Docket*, N.Y. TIMES (Sept. 28, 2009), https://www.nytimes.com/2009/09/29/us/29bar.html [https://perma.cc/3D4H-NBQQ] (reporting that Justices Scalia, Kennedy,

of Supreme Court opinions per term is some combination of increased ideological friction, changes at the Court, and differences in the views of current and previous Justices on when and how often the Court should grant certiorari.[93]

Despite the Supreme Court's generally declining docket, patent cases have increased both in number and as a percentage of the Supreme Court's overall docket.[94] In the last decade, patent cases were more than 5% of issued Supreme Court opinions versus only 0.5% in the 1980s.[95] In other words, as a percentage of its opinions, the Supreme Court heard 12.4 times as many patent cases in the decade from 2010 to 2019 as it did in the 1980s, when Congress first created the Federal Circuit.

Souter, Thomas, and Ginsburg had voted to hear cases less often than their predecessors); Linda Greenhouse, *Case of the Shrinking Docket: Justices Spurn New Appeals*, N.Y. TIMES (Nov. 28, 1989), https://www.nytimes.com/1989/11/28/us/case-of-the-shrinking-docket-justices-spurn-new-appeals.html [https://perma.cc/X3MF-QSG4] (explaining that the Supreme Court has dramatically cut back on the number of cases heard); Cordray & Cordray, *supra* note 46, at 776 (Explaining of the Supreme Court's docket system: "One of the most compelling explanations for the recent decline in the Supreme Court's plenary docket stems directly from changes in personnel. Recall that when a similar decline occurred fifty years ago, the primary cause was the retirement of Justices who had voted aggressively to review cases and their replacement by new Justices who were far less inclined to do so."); *id.* at 792 (explaining the changes in the Supreme Court's docket: "The single period of decline during this period [after the certiorari pool began] occurred after Justice Stevens replaced Justice Douglas in 1975. Neither belonged to the pool, however, and the drop in the caseload is traceable instead to their very different views of the Court's optimal capacity to hear and decide cases.").

93 *See* Menell & Vacca, *supra* note 25, at 867–68 ("The most likely causes of the Court's declining caseload seem to be (1) changes in the justices' view of the Court's role and (2) intra-Court dynamics. From 1986 through 1994, six justices retired. Their replacements were less inclined to grant review than were their predecessors. Justice White's retirement in 1993 was likely the most impactful in view of his outspoken support for granting certiorari in nearly all cases presenting circuit splits.").

94 *See infra* Figures 4, 5.

95 *See infra* Figure 4. Data tables on file with the Author.

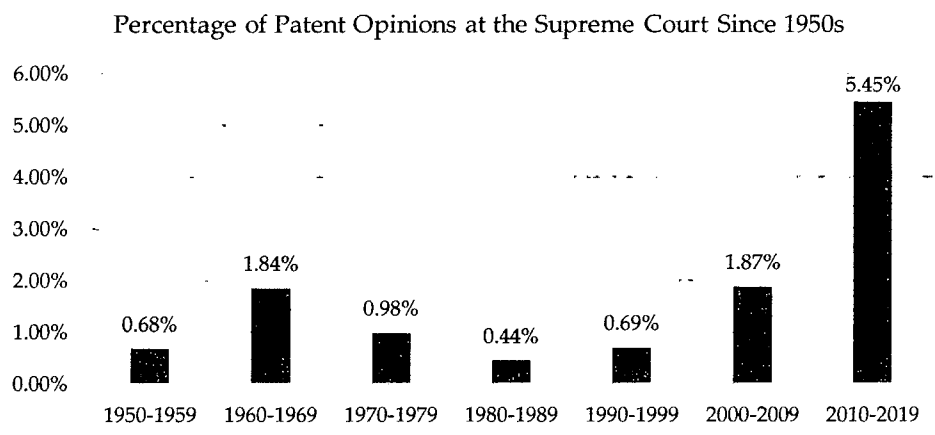

Figure 4.
Patent opinions per Supreme Court term as a percentage of Supreme Court opinions, compared by decade since 1959.

Nonetheless, the frequency of patent cases at the Supreme Court in the last ten years seems high only when viewed in comparison to the late twentieth century, a time period where the Supreme Court had far lower engagement with patent law than it did in the nineteenth and early twentieth centuries.[96] As shown in the following Figure, in the late twentieth century the Supreme Court issued only a fraction of the patent opinions that it did in the prior half-century and far fewer than in the boom of the 1890s.[97] The Supreme Court averaged only one patent opinion per year from 1950 to 1999.[98] In the 1980s and 90s, the Supreme Court issued an average of 0.6 patent opinions per year, a low rarely seen in the last century-and-a-half.[99] By comparison, at a peak in the 1890s, the Supreme Court decided an average of thirteen patent cases per year.[100]

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96 *See infra* Figure 5.

97 *See id.*

98 *See id.* Data tables on file with the Author. There was an average of 0.96 patent opinions per term from 1950 to 1999.

99 *See* Figure 5. The 1810s had an average of 0.2 patent opinions per year. The 1820s had an average of 0.5 patent opinions per year. The 1950s, leading up to and in the years after passage of the Patent Act of 1952, also had an average of 0.6 patent opinions per year.

100 *See infra* Figure 5. The 1890s averaged 12.8 patent opinions per year.

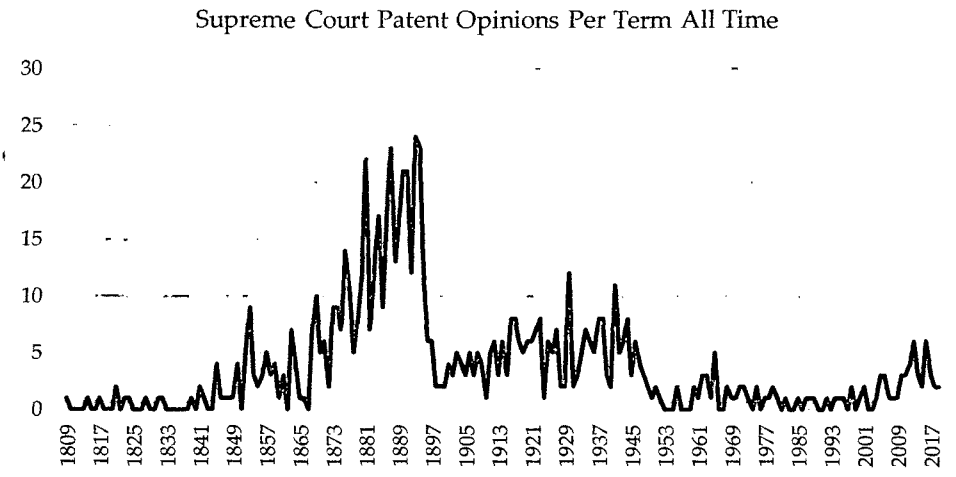

Figure 5.
Supreme Court patent cases by term since 1809.[101]

As shown in the Figure below, the current percentage of Supreme Court patent decisions is fairly similar to that seen in prior peak decades, namely during the Second Industrial Revolution, and higher than prior to passage of the Patent Act of 1952.[102] In the decade spanning the 2009 to 2018 terms, patent opinions were about 5.12% of the Supreme Court's issued opinions.[103] In comparison, 5.69% of the Supreme Court's issued opinions were patent opinions in the terms from 1889 to 1898.[104] Indeed, in 2016, 9.84% of the Supreme Court's opinions were patent

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[101] Data prior to 1952 is based on the tabulation used in Figure 2. Data from 1952 and beyond is based on the data tabulated in Figure 1, which is based on a list of patent cases maintained by Professor Ouellette. *See* Ouellette et al., *supra* note 5. The Author chose to use Professor Ouellette's list for cases for the years from 1952 onward given the general acceptance of this list in the academic community. The Author anticipates that the methods used to identify patent cases will produce similar lists of cases and that therefore few variations in the data will be attributable to differences in sources for the list of patent cases pre- and post-1952. Supporting the repeatability of this data, the data presented herein from both pre-1952 and post-1952 cases aligns with the numbers of patent cases reported by Professor Duffy. *See* Duffy, *supra* note 6, at 288 fig.1.

[102] *Infra* Figure 6.

[103] *Id.*

[104] *Id.*

opinions—higher than any term during the 1880s or 1890s.[105] Figure 7 also shows a running average per term.[106]

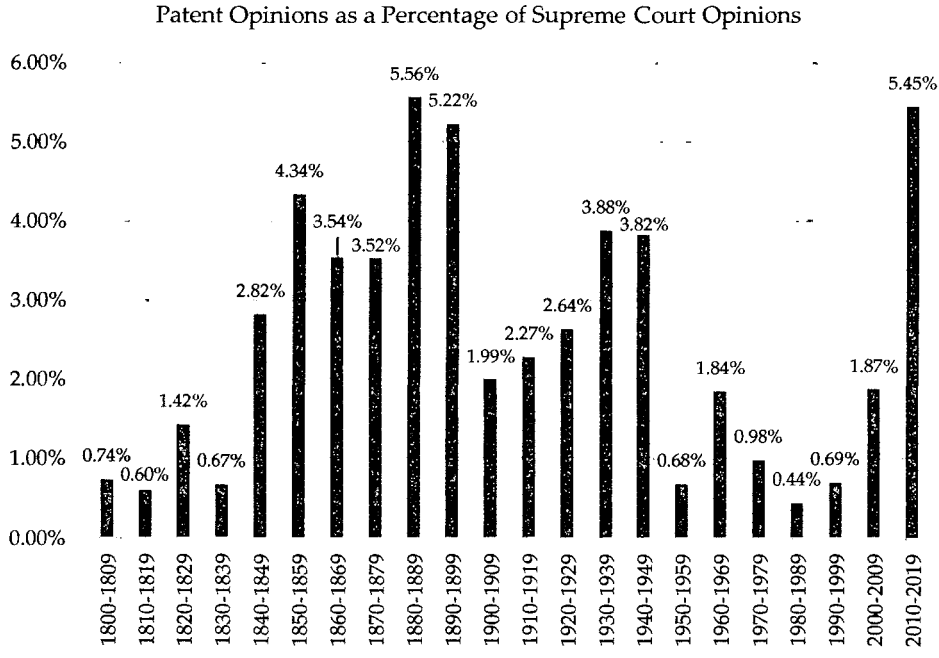

Figure 6.
Patent Opinions as a Percentage of Supreme Court Opinions.[107]

105 Data tables on file with the Author.

106 *Infra* Figure 6.

107 Data tables on file with the Author. This compares Supreme Court patent opinions as shown in Figure 5 against counts of all Supreme Court opinions from The Supreme Court Database. Spaeth et al., *supra* note 89.

Table 1. Percentage of Supreme Court Patent Cases per Decade

Decade	Number of Supreme Court Cases per Term	Patent Cases per Term	Percentage of Patent Cases
1800-1809	135	1	0.74%
1810-1819	332	2	0.60%
1820-1829	351	5	1.42%
1830-1839	445	3	0.67%
1840-1849	390	11	2.82%
1850-1859	876	38	4.34%
1860-1869	961	34	3.54%
1870-1879	2128	75	3.52%
1880-1889	2697	150	5.56%
1890-1899	2450	128	5.22%
1900-1909	1909	38	1.99%
1910-1919	2242	51	2.27%
1920-1929	1897	50	2.64%
1930-1939	1521	59	3.88%
1940-1949	1308	50	3.82%
1950-1959	882	6	0.68%
1960-1969	976	18	1.84%
1970-1979	1227	12	0.98%
1980-1989	1350	6	0.44%
1990-1999	864	6	0.69%
2000-2009	696	13	1.87%
2010-2019	624	34	5.45%

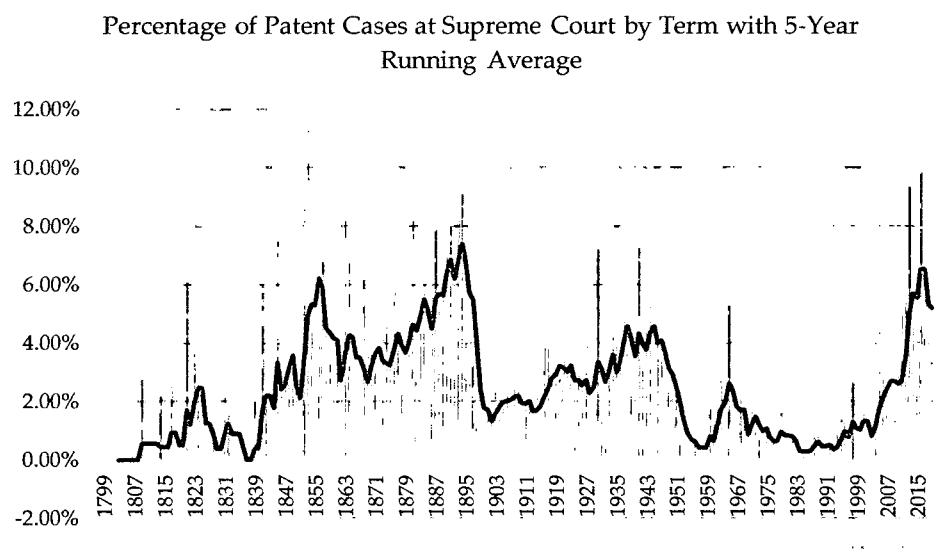

Figure 7.
Percentage of Patent Cases at the Supreme Court per Term.
Black line depicts a 5-year running average. Bars are percentages per term.

What was the reason for the lull in the late twentieth century? The most sudden shift, other than that seen after the change from mandatory to discretionary jurisdiction, coincided with the passage of the Patent Act of 1952. In the Patent Act, Congress codified many areas of substantive patent law that had percolated in the courts and significantly revised numerous substantive patent law doctrines.[108] Indeed, as the Supreme Court has interpreted, one key purpose of the Patent Act of 1952 was to "substitute statutory precepts for the general judicial rules that had governed prior to that time," an event that could result in less Supreme Court patent litigation if codification had the effect of promoting

[108] *See, e.g.*, Patent Act of 1952, ch. 950, § 282, 66 Stat. 792, 812 (codifying the presumption of patent validity); *see also* P.J. Federico, *Commentary on the New Patent Law*, 35 U.S.C.A. 1 (West 1954), *reprinted in* 75 J. PAT. & TRADEMARK OFF. SOC'Y 161, 166 (1993) ("The patent act of 1952 (this title) stems from two movements, one to amend the patent laws, and the other to revise and codify the laws of the United States."). As one key example, the drafters of the Patent Act of 1952 sought to stabilize the development of the law of obviousness. H.R. REP. NO. 82-1923, at 7 (1952) ("This section should have a stabilizing effect and minimize great departures which have appeared in some cases.").

uniformity and certainty in the law.[109] From the 1950s to 1970s, the Supreme Court was not heavily involved in development of substantive patent law.[110] Interviewees who clerked during the lull from the 1950s to 1970s informed us that the Court had recently faced criticism of its decisions in other highly technical areas of law and did not want to venture into patent cases that might require specialized knowledge or technical expertise to be correctly decided.[111]

The most dramatic low in Supreme Court patent opinions, the 1980s, came with the creation of the Federal Circuit.[112] As noted above, some of the key justifications for creation of the Federal Circuit were to promote certainty, uniformity of law, and to have more patent appeals decided by judges with expertise in patent law.[113] The Supreme Court left the Federal Circuit largely to this task, taking a fairly hands-off approach from the creation of the Federal Circuit from 1982 until 1988, when it issued the *Christianson*[114] decision.[115] During that time, the Supreme Court not only decided very few cases, but its decisions generally focused on procedural issues.[116] This left many substantive patent law questions to be addressed in the last instance by the Federal Circuit.[117]

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109 *See* Dawson Chem. Co. v. Rohm & Haas Co., 448 U.S. 176, 180 (1980) ("[I]n its 1952 codification of the patent laws Congress endeavored, at least in part, to substitute statutory precepts for the general judicial rules that had governed prior to that time.").

110 Interviews by Author.

111 *Id.*

112 *Supra* Table 1; Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982) (codified at 28 U.S.C. § 1295 (2018)).

113 *Supra* Section II.C.

114 *See generally* Christianson v. Colt Industries Operating Corp., 486 U.S. 800 (1988) (discussing whether the Court of Appeals for the Federal Circuit would have jurisdiction of the appeal of the final judgment in the case).

115 *See* Arthur J. Gajarsa & Lawrence P. Cogswell, *The Federal Circuit and the Supreme Court*, 55 AM. U. L. REV. 821, 824 (2006) (discussing the *Christianson* case, the first patent case the Supreme Court decided "since the creation of the Federal Circuit six years earlier").

116 *Id.*

117 *Id.*

The frequency of Supreme Court patent opinions began to rise again following the appointment of Justice Breyer to the Supreme Court in 1994.[118] Prior scholars have suspected that Justice Breyer had a particular affinity toward intellectual property law, having written a prominent law review article on copyright before joining the Court and authoring several opinions in intellectual property cases during his time on the Court.[119] One example of the increased attention of the Court to patent issues was the Court's 1995 opinion in *Markman v. Westview Instruments, Inc.*, which held that patent claim construction was a legal issue to be decided by courts, not left to the jury.[120] Another case that epitomized this time period was *Warner-Jenkinson* in 1997, where the Court expounded on patent law's doctrine of equivalents.[121] This was a time when the Supreme Court began to return to the substance of patent law, issuing opinions, like *Markman* and *Warner-Jenkinson*, that expounded on the nuts-and-bolts of patent law.[122] In 1994, the Supreme Court issued its first call for the views of the Solicitor General in a patent case.[123]

The increased interest of the Court in patent law since the mid-1990s also coincided with a period of heightened antitrust scrutiny of technological

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118 Duffy, *supra* note 78, at 524 (recognizing the significant influence of Justice Breyer's tenure on the Supreme Court's review of patent cases).

119 *See id.* at 524–25.

120 Markman v. Westview Instruments, Inc., 517 U.S. 370, 391 (1996); *see also* Gajarsa & Cogswell, *supra* note 115, at 822 (recognizing *Markman* as "the turning point in the history of the Supreme Court's review of Federal Circuit patent cases").

121 Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17, 17 (1997) (holding that the doctrine of equivalents is not inconsistent with patent law, must be applied to individual elements of patent claim, does not require proof of intent, and is not limited to equivalents disclosed within patent itself); *see also* John M. Golden, *The Supreme Court as "Prime Percolator": A Prescription for Appellate Review of Questions in Patent Law*, 56 UCLA L. REV. 657, 669 (2009) (stating that *Warner-Jenkinson* is the first Federal Circuit patent case reviewed by the Supreme Court on questions of substantive patent law).

122 Golden, *supra* note 121, at 669 ("[T]he Court's 1997 decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.* was a watershed. For the first time, the Court reviewed a Federal Circuit decision on core questions of substantive patent law . . . .").

123 Duffy, *supra* note 78, at 525 (citing Barr Lab'ys v. Burroughs Wellcome Co., 515 U.S. 1130 (1995) (No. 94-1527)).

innovations.[124] The viewpoint that patents are monopolistic can affect substantive patent law in areas such as remedies and equitable doctrines, which often depend upon considerations of the public interest.[125] The antitrust zeitgeist can also subtly impact doctrines of validity and infringement. For example, the Court might support stricter subject matter eligibility doctrines that would result in more patents being invalid during time periods when the public and the Court view expansive patents as monopolistic.

Additionally, John Roberts joined as Chief Justice of the Supreme Court on September 29, 2005.[126] The last fifteen years since then have involved high rates of review on substantive patent law issues.[127] The time period since Roberts's appointment has also been characterized by increasing tension between the Federal Circuit's rule-based approach to patent law and the more flexible approach of the Supreme Court.[128] As discussed further below, many of the interviewees noted that in the last fifteen years, the Supreme Court has started to view the Federal Circuit as overly rigid and tending to issue decisions in patent law that do not align with the Court's historical decisions in other areas of law.[129] Whether justified or not, this narrative has expanded to play an oversized role in

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124 *See* Adi Robertson, *How the Antitrust Battles of the '90s Set the Stage for Today's Tech Giants*, THE VERGE (Sept. 6, 2018), https://www.theverge.com/2018/9/6/17827042/antitrust-1990s-microsoft-google-aol-monopoly-lawsuits-history [https://web.archive.org/web/20200902072813/https://www.theverge.com/2018/9/6/17827042/antitrust-1990s-microsoft-google-aol-monopoly-lawsuits-history] (discussing antitrust issues raised against tech giants in the '90s.).

125 *See* Morton Salt Co. v. G. S. Suppiger Co., 314 U.S. 488, 492 (1942) (discussing patent misuse as an equitable defense that "forbids the use of the patent to secure an exclusive right or limited monopoly not granted by the Patent Office and which it is contrary to public policy to grant."); *see generally* Christa J. Laser, *Continuing the Conversation of "The Economic Irrationality of the Patent Misuse Doctrine,"* 11 CHI.-KENT J. INTELL. PROP. 104 (2012) (criticizing patent misuse as an overdeterrent when it applies beyond the scope of antitrust liability).

126 Press Release, Supreme Court of the United States (Sept. 29, 2005), https://www.supremecourt.gov/publicinfo/press/pressreleases/pr_09-29-05 [https://perma.cc/69FH-LSZK] (announcing Chief Justice Roberts's swearing-in ceremony).

127 *See supra* Figure 4.

128 *See, e.g.*, KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 401–02 (2007).

129 Interviews by Author; *infra* Part IV.

what many view as one reason for the higher number of patent cases at the Supreme Court today than in the latter part of the twentieth century.[130]

IV. QUALITATIVE ANALYSIS OF THE SUPREME COURT'S DECISION-MAKING WHEN GRANTING CERTIORARI IN PATENT CASES

A. METHODOLOGY AND REPORTING OF INTERVIEWS

Despite significant scholarship providing empirical support, no prior articles have conducted structured, qualitative interviews with those most familiar with the certiorari process to address the reasons for the rising Supreme Court patent docket. The Author conducted structured interviews with former clerks of the Supreme Court and spoke with others involved in the certiorari process.

The interviews involved asking open-ended questions about the clerks' experiences with certiorari petitions in general cases and patent cases, as well as the factors that influenced certiorari. The open-ended questions were typically the following: "Can you tell us about the logistics of cert[iorari] decisions during your time on the Court and with your Justice?;" "In general cases, what factors were considered in the certiorari decision?;" and "What considerations were used to determine certiorari in patent appeals?" Each initial open-ended question was followed by questions to get more detail on the answer and close out the participant's answers on that subject, such as why the individual believed that answer, what they believed the impact of that answer is, and whether there was anything else on that topic. Participants were then asked their views on the effect, if any, of particular factors such as solicitor general support, amicus briefs, and other factors discussed herein. The survey questions were honed over the course of initial interviews. However, throughout all interviews, attempts were made to focus on open-ended questions, begin with the most general questions, avoid leading or confusing questions, and to ask participants the source of their beliefs and whether there was anything else before moving on to a different topic.

Of the 193 potential participants contacted for interviews, nine completed the interview process. Interviewees span a wide range of time periods, include those who clerked for both conservative and liberal justices, and include those who clerked for Justices in and out of the certiorari pool. Specifically, interviews included clerks from the following decades: 2010s, 2000s, 1990s, and 1960s. Participants included former clerks who are currently in private practice or retired, located in cities across the United States. Participants also included former clerks with experience in government roles pertinent to the issues in this Article, such as the solicitor's office. Many interviews were conducted in person, although

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[130] *See infra* Part IV.

telephone interviews were used for participants who lived in other cities than the Author, for interviews conducted during social distancing efforts to prevent COVID-19, and as needed for the convenience of the participant.

Ethical and legal obligations to the Court prohibit clerks and Justices from sharing information about the merits of decision-making on particular cases.[131] Therefore, this Article only reports on information regarding the procedure of certiorari and the factors impacting the reason for granting certiorari as a general matter in patent cases. Discussion regarding particular cases is the commentary of the Author and does not reflect information obtained from interviewees. To protect the privacy of the interviewees, the information reported below is based on aggregated information from responses to interviews, except where noted.

B. THE ROLE OF THE SOLICITOR GENERAL

The Office of the Solicitor General's role in cases pending before the Supreme Court includes both representing the United States before the Court and—particularly in the last thirty years—participating as an amicus at the invitation of the Court.[132] The Supreme Court frequently calls for the views of the Solicitor General in cases where the United States is not a party.[133] The Solicitor may provide input on the merits of the case, as well as on the determination of whether to grant a petition for certiorari.[134]

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131 JUD. CONF., CODE OF CONDUCT FOR UNITED STATES JUDGES, Canon 3A(6) (Mar. 12, 2019), https://www.uscourts.gov/sites/default/files/code_of_conduct_for_united_states_judges_effective_march_12_2019.pdf [https://perma.cc/AAB5-23PP] [hereinafter CODE OF CONDUCT] ("A judge should not make public comment on the merits of a matter pending or impending in any court. A judge should require similar restraint by court personnel subject to the judge's direction and control. The prohibition on public comment on the merits does not extend to public statements made in the course of the judge's official duties, to explanations of court procedures, or to scholarly presentations made for purposes of legal education.").

132 *See* Seth P. Waxman, *Foreword: Does the Solicitor General Matter?*, 53 STAN. L. REV. 1115, 1117–18 (2001).

133 Duffy, *supra* note 78, at 519 ("At least in the last few decades, the United States has frequently appeared as an amicus in the Supreme Court even when the government is not directly involved in the litigation.") (citing Thomas Brennan, Lee Epstein & Nancy Staudt, *The Political Economy of Judging*, 93 MINN. L. REV. 1503, 1510–11 (2009)).

134 *See* Kristen A. Norman-Major, *The Solicitor General: Executive Policy Agendas and the Court*, 57 ALBANY L. REV. 1081, 1083 (1994); Wade H. McCree Jr., *The*

The interviewees inform that the Supreme Court pays particular attention to the views offered by the Solicitor General, and a call for the views of the Solicitor General often signifies the importance of a case. The Justices and clerks view the Solicitor as providing informed and balanced arguments about the issues presented in a case.[135] Prior empirical scholarship further supports the importance of the views of the Solicitor General.[136] A grant of certiorari is ten times more likely where the Court issues a Call for the Views of the Solicitor General, although the Court might be more likely to issue such a call when it is already considering granting certiorari.[137] Indeed, the interviewees expressed that the Court is likely to call for the views of the Solicitor when the Justices want additional time and input to make the decision of whether to grant certiorari, perhaps when good arguments exist both in favor of and against certiorari.

The interviewees universally agreed that in patent cases, the views of the Solicitor hold particular sway with the Court. Without a circuit split to signal the need for review, and with the technological issues in patent law often exceeding the Court's day-to-day experiences with complex technology and the nuances of this sometimes esoteric area of law, the Solicitor is viewed as providing critical expertise and knowledge.[138] The Solicitor, for example, has been viewed as having insight into which areas of patent law the Supreme Court should review or whether a case is an appropriate vehicle for review.[139] The interviewees inform us

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Solicitor General and His Client, 59 WASH. U. L.Q. 337, 341 (1981) (discussing the factors that the Solicitor considered in determining whether to recommend a grant of certiorari and noting that "it is the duty of the Solicitor General to serve as a first-line gatekeeper for the Supreme Court").

135 Brennan et al., *supra* note 133, at 1510–11.

136 Gugliuzza, *supra* note 6, at 1253.

137 *Id.*

138 Interviews by Author. *See generally* Duffy, *supra* note 78, at 519 (arguing that the "innovative jurisdictional structure of the [Federal Circuit] has fostered a unique relationship between the Federal Circuit and the Solicitor General's Office and has, in a subtle but meaningful way, shifted power over the development of patent law from the judicial to the executive branch of government"); *id.* at 520 ("[T]he interesting question is not whether the Solicitor General's Office now has significant power to control the developing path of patent law, but rather whether the Office holds more power over the long-term trends in the field than does the specialized appellate court that Congress created to govern the area.").

139 Interviews by Author. *See generally* Oral Argument at 47–48, Bilski v. Kappos, 561 U.S. 593 (2009) (No. 08-964) (In oral argument in this patent case

that the Court views the Solicitor as representing an important institutional interest of the federal government in patent law.[140]

These qualitative results are also in alignment with empirical research. In an empirical study of certiorari decisions in patent cases, Professor Paul Gugliuzza found that in patent cases from the 2002 to 2016 Terms, the Supreme Court agreed with the Solicitor General's recommendation on certiorari 93.3% of the time—or in in 28 of the 30 cases.[141] In contrast, over all case types, the Supreme Court agreed with the recommendation of the Solicitor General to grant or deny certiorari 78.9% of the time.[142] Professor Gugliuzza's empirical work also indicates that the Solicitor General more frequently recommends a grant of certiorari in patent cases (43.3% of the time) than in all cases overall (27.2%).[143]

C. THE ROLE OF AMICI

Professor Gugliuzza's empirical data likewise support a significant role of amici in patent cases. His study showed that in patent cases, a petition is nearly four times more likely to be granted if two to four amicus briefs are filed versus one, and 12.6 times more likely to be granted if five or more amicus briefs are filed at the certiorari stage versus one.[144] Although amicus support is generally helpful for both patent and non-patent cases, the effect of amicus support on the likelihood that certiorari is granted is more pronounced in patent cases. Professor Gugliuzza reported that across all cases (including non-patent cases), a petition is not much more likely to be granted if two to four amicus briefs are filed instead of only one.[145]

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regarding subject matter eligibility, the Solicitor noted, "we opposed cert in this case because we recognized that there are difficult problems out there in terms of patentability of software innovations and medical diagnostic—" Justice Kennedy interrupted, "You thought we'd mess it up." As the audience laughed, the Solicitor diplomatically explained, "We thought that this case would provide an unsuitable vehicle for resolving the hard questions . . . .").

140 Interviews by Author.

141 Gugliuzza, *supra* note 6, at 1234.

142 *Id.* at 1256.

143 *Id.* at 1258.

144 *Id.* at 1253.

145 *Id.* at 1252.

The interviews confirmed that amici play a particularly important role in patent cases. Again, with no circuit split to signal the importance and ripeness of a legal issue, the number, identity, and substantive positions of amici hold particular sway. The interviewees noted that amicus briefs were generally more important at the certiorari stage than the merits. In particular, amicus briefs that indicated that the decision would have a broad impact on an entire industry, rather than just the parties in suit, increased the perceived need for certiorari.[146] The merits of the position advocated by the amici were less important than the window the amicus briefs provided the Court into how the decision might affect different interests.[147] For example, if many amicus briefs were filed from a variety of companies across many sectors of the economy, it could signal that the issue at hand could be important.[148] Although different chambers have different views of which types of amici are most persuasive, many viewed briefs from groups perceived as neutral, such as academics, the American Intellectual Property Law Association ("AIPLA"), and other bar associations as especially noteworthy when considering whether to grant certiorari.[149] The Author understands from the interviewees, however, that the signaling value of amicus briefs has decreased slightly in recent years as more and more cases come to the Court with amicus support for certiorari.[150]

D. THE NARRATIVE OF THE FEDERAL CIRCUIT AS DEFIANT AND PROMOTING PATENT EXCEPTIONALISM

Some of the interviewees said that in the decades since its formation, the Federal Circuit has developed a reputation at the Supreme Court for favoring rules over flexible standards, and for disregarding Supreme Court precedent instructing for more flexible approaches.[151] Supporting this view, some scholars have urged that the Supreme Court is more likely to act on certiorari in patent cases where there is a narrative that the Federal Circuit has issued a decision in patent law that conflicts with Supreme Court precedent in other areas of law.[152] This scholarship

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146 Interviews by Author.

147 *Id.*

148 *Id.*

149 *Id.*

150 *Id.*

151 *Id.*

152 Tejas N. Narechania, *Certiorari, Universality, and a Patent Puzzle*, 116 MICH. L. REV. 1345, 1348 (2018).

suggests that "consistency across substantive fields of law[] is an important (but unstated) priority in certiorari decision-making."[153] The interviewees noted that although this narrative did not exist immediately after the creation of the Federal Circuit, it is prevalent today and has been prevalent in the past decade. Recognizing this, present Supreme Court advocates have learned to highlight when their case fits within this preexisting narrative.[154]

Of course, the negativity of this narrative might not be fair. As an initial matter of logical deduction, when the Supreme Court accepts an appeal from a regional circuit on the basis of an even circuit split, half of the regional circuits that had decided the issue will have taken a position that matches the Supreme Court's ultimate outcome. In contrast, when the Supreme Court accepts appeals from the Federal Circuit, which has exclusive jurisdiction and therefore typically no circuit splits, the correction of perceived errors becomes relatively more central. Therefore, the Federal Circuit's approach is perhaps less likely to match the ultimate decision of the Supreme Court than this more average rate for regional circuits. Moreover, the Federal Circuit's mandate to unify and normalize patent law[155] might naturally yield more rigid approaches—laws from which investors and patent stakeholders can more accurately determine the value of their investments and risk of their product launches. If the Supreme Court does not similarly view its purpose in patent cases as promoting uniformity and stability of law, its approach will differ.

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153 *Id.* at 1345; *see also id.* at 1349 (citing Robin Feldman, *Ending Patent Exceptionalism and Structuring the Rule of Reason: The Supreme Court Opens the Door for Both*, 15 MINN. J.L. SCI. & TECH. 61, (2014); Peter Lee, *The Supreme Assimilation of Patent Law*, 114 MICH. L. REV. 1413, 1453–61 (2016); Christopher J. Walker, *Chevron Deference and Patent Exceptionalism*, 65 DUKE L.J. ONLINE 149, (2016), https://scholarship.law.duke.edu/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1017&context=dlj_online [https://perma.cc/Q258-KF24]; Paul R. Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1817–18 (2013). *But cf.* James Donald Smith, *Patent Exceptionalism with Presidential Advice and Consent*, 65 DUKE L.J. 1551, 1552–53 (2016) (praising the PTAB's review process for patents and advocating that President Lincoln's "engagement with the patent system also contributes to the notion of a patent-system exceptionalism that always has existed and still is in evidence today, as can be seen in the existence and relevance of the PTAB").

154 Interviews by Author.

155 *Supra* Section II.C.

E. THE EMERGING SUPREME COURT BAR

The interviewees inform us that cases arising from the Federal Circuit often have well-written, paid petitions that lay out the issues for review in a way that highlights their cert-worthiness. Empirical work has shown that in recent patent cases, a petition for certiorari was three times more likely to be granted if it was filed by one of a small group of highly experienced Supreme Court advocates that the study termed the "elite advocates" of the Supreme Court bar.[156] These elite lawyers represented clients in 16% of total certiorari petitions from 2002 to 2016, but 40% of the petitions that the Supreme Court granted.[157]

Although the interviewees confirmed the importance of experienced Supreme Court advocates in patent petitions, the reasons were not entirely aligned with those suggested by prior scholarship.[158] The interviews indicated that petitions crafted by experienced advocates presented the questions in a manner that focused the interest of the Court. Petitions by these advocates demonstrated the importance of the questions presented by the certiorari petition, such as making clear that the answer would impact the viability of an industry. They showed how the case fits into the concerns that the Supreme Court has had with the Federal Circuit's jurisprudence. Moreover, they framed the case as an ideal vessel to decide the legal issue presented, such as by making the technology appear simple and the procedural posture seem clear. As the interviewees explained, elite advocates were also better at the key task of marshalling the support of numerous and influential amici and the Solicitor General's office. Contrary to prior scholarship, almost all of the interviewees urged that it was not the identity of the advocate that increased the likelihood of grant, but the skill the advocate brought to the most important components of the certiorari process and in presenting the questions submitted by the petition. One interviewee stated, however, that clerks do recognize the names of leading advocates as a signal that

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156 Gugliuzza, *supra* note 6, at 1236. "Elite Supreme Court advocates" were defined in this study as "lawyers who have presented oral argument in five or more Supreme Court cases in the preceding ten years." *Id.*

157 *Id.*

158 *Cf. id.* (suggesting a number of theories that align with those noted by interviewees here, such as the ability of elite advocates to marshal government and amicus support, but also hypothesizing that clerks might recognize the names of frequently-appearing advocates, that parties with cases more likely to obtain certiorari might be more likely to hire elite advocates, or that elite advocates are more likely to accept a case that is likely to be granted certiorari).

the petition will be well-written and at least non-frivolous, noting that although leading advocates will stretch and reach to fully represent their clients, leading advocates "don't waste their time writing frivolous petitions."

F. TECHNOLOGICAL COMPLEXITY

The Author understands from the interviewees that in trying to determine whether a particular case is the best vehicle to decide a legal issue, clerks often consider whether the facts are amenable to a straightforward decision. In particular, the interviewees indicated that in patent cases, clerks pay attention to the technical complexity of a case, avoiding cases with particularly complicated technology even if as a legal matter they present a fairly clean question to the Court.[159] The Court will often prefer to let issues about a new technology percolate longer in the lower courts.[160] If it does accept certiorari, the Court often relies heavily on the views of the Solicitor General in complex patent cases for technical guidance.[161]

The Supreme Court does not have the same institutional and technological expertise as the Federal Circuit. For example, although Federal Circuit judges frequently have at least one clerk in each of their chambers with an advanced degree in a STEM (science, technology, engineering, or mathematics) field, the interviewees stated that there has been little impetus at the Supreme Court to hire clerks with either a technical degree or experience in patent law.[162] Very few clerks have been hired to the Court from the Federal Circuit.[163] Moreover, no Supreme Court Justice has a scientific degree.[164] In contrast, multiple Federal Circuit judges have at least undergraduate degrees and a number have advanced degrees in STEM fields.[165]

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159 Interviews by Author.

160 *Id.*

161 *Id.*

162 *Id.*

163 *Id.*

164 *See Current Members*, SUP. CT. OF THE U.S., https://www.supremecourt.gov/about/biographies.aspx [https://perma.cc/6WWL-9H9D] (last visited Nov. 6, 2020) (noting that each Justice has only a B.A. or A.B. degree, not a Bachelor's of Science).

165 *E.g.*, *Alan D. Lourie, Circuit Judge*, U.S. CT. OF APPEALS FOR THE FED. CIR., http://www.cafc.uscourts.gov/judges/alan-d-lourie-circuit-judge [https://perma.cc/WX25-P63V] (last visited Sept. 9, 2020) (noting, for

The technology knowledge of the judges on the Federal Circuit and their clerks allows them to understand complex technologies and the impact of their decisions on the scientific community. The interviewees generally agreed that the Supreme Court would be better served in patent and other technical cases by having more clerks with technical backgrounds or a Justice with technology experience. However, a number of the interviewees urged that patent cases remain a small enough percentage of the Court's docket that expertise in other areas of law, such as constitutional law and criminal law, remain a higher priority.[166]

G. IMPORTANCE OF THE DECISION

The interviewees emphasized that in patent cases, where, again, no circuit split signals the importance and ripeness of a legal issue, clerks and Justices attempt to use other proxies for the importance of the case. In certain patent cases, the interviewees noted, the briefing of parties and amici often makes clear that the outcome of the case would have lasting impact throughout an industry or, in some cases, determine the viability of that industry. However, the interviewees did not believe that the Court frequently considers the impact of taking a patent case on the public interest. Even then, what would be in the public interest in patent cases is often unknown to those unfamiliar with patent law. One hypothesis of the author (which does not originate from interviewees) is that although patent stakeholders view certainty and stability of the law as more important than its contents in most cases, the Supreme Court might focus instead on the interest of the consuming public to have unrestrained access to technology—in a sense viewing patents as a monopolistic restraint on trade rather than an incentive for innovation. On the issue of certainty, the interviewees who had comments on this issue stated that the effect of a Supreme Court decision on the certainty and stability of patent law was not a factor that clerks frequently considered or wrote about in their certiorari memos.

H. PROXIES FOR CIRCUIT SPLITS? FEDERAL CIRCUIT DISSENTS AND *EN BANC* DECISIONS

With no circuit splits,[167] it can be tempting to assume that the Court will look to other close potential proxies for circuit splits to assess the need for review.

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example, that Judge Lourie has a Ph.D. in chemistry from University of Pennsylvania).

166 Interviews by Author.

167 The rare exception is splits between the Federal Circuit and pre-Federal Circuit law from a regional circuit court. *E.g.*, Pfaff v. Wells Electronics, Inc.,

Proxies for circuit splits at the Federal Circuit could include split *en banc* decisions or dissents from denials of *en banc* review.[168] However, the interviews did not indicate that Justices or clerks view split Federal Circuit opinions or split denials of *en banc* review as a prerequisite to review or as having importance equivalent to a circuit split. Nor would doing so provide the best indication of the patent cases in need of review.

For appeals arising from regional circuit courts, the circuit split is generally considered a prerequisite to review in all but a handful of cases.[169] The tendency to deny review for regional circuit court appeals not presenting a circuit split is so strong that one of the interviewees who was a former clerk noted seeing other clerks sometimes mistakenly write "deny—no circuit split" on the cover of petitions for appeal from the Federal Circuit. Other more recent interviewees, however, stated that clerks were well aware that the Federal Circuit is a court of exclusive jurisdiction and would not make this mistake. In appeals from the Federal Circuit, the interviewees indicated, some Justices will occasionally consider the substance of dissents, dissents from *en banc* opinions, or dissents from denial of *en banc* review on the merits, particularly when that dissent is written by a judge whom the Justice has come to view as intellectually or ideologically similar.

The Author has not, however, heard reports from the interviewees that the Justices or clerks consider the mere fact that the Federal Circuit decision was split a significant factor in granting certiorari. Rather, in appeals arising from the Federal Circuit, the interviewees noted that clerks and Justices focus on other factors affecting whether the case merits review. Indeed, with regularity, the Supreme Court grants certiorari despite the appeal arising from a unanimous or near-unanimous Federal Circuit decision.[170] As discussed in more detail above, the most important considerations for the Supreme Court's grant of certiorari in patent cases are the following: the importance of the case, whether the Solicitor

525 U.S. 55, 60 (1998) (citing Timely Prods. Corp. v. Arron, 523 F.2d 288, 299–302 (2d Cir. 1975)). These kinds of splits might be less urgent to resolve because they are not a "live" split between two courts that might decide future cases in different ways absent Supreme Court intervention.

168 *Supra* Section II.C.

169 Interviews by Author.

170 *See* Golden, *supra* note 121, at 658–59 (citing Quanta Comput., Inc. v. LG Elecs., Inc., 553 U.S. 617 (2008); KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007); eBay Inc. v. MercExchange LLC, 547 U.S. 388 (2006)) (discussing cases where a unanimous Supreme Court struck down decisions of a unanimous Federal Circuit).

General or certain trusted amici urge and set forward a persuasive basis for review, the rigidity of the rule proposed by the Federal Circuit below (and thus whether the case fits into the prevailing narrative about the Federal Circuit), and whether a majority of Justices believe that the Federal Circuit decision below is in need of correction.[171]

The different treatment of the considerations for review in patent cases versus appeals arising from the regional circuit courts may be entirely appropriate. In appeals arising from regional circuit courts, one of the key roles of the Supreme Court is to provide national uniformity of law where there are significant regional differences. However, in patent law, it is the Federal Circuit itself that corrects for any national disuniformity because it is a court of exclusive jurisdiction.[172] In patent cases, where appeals are taken from a court with exclusive jurisdiction and extensive experience in the area of law on which it is opining, the ideal role of the Supreme Court instead may be to correct for the types of errors that arise from a court with exclusive jurisdiction. For example: "ossification of legal doctrine,"[173] failure to appropriately consider analogous standards from other areas of law or other courts,[174] or the overlooking or misapplication of historical precedent from the Supreme Court.[175] When viewed from this lens of the need to correct the types of error most commonly arising from a court of exclusive jurisdiction, it is not surprising that a proxy for a circuit split would be an unimportant factor in review.

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171 *Supra* Sections IV.B–D.

172 *Supra* Section II.C.

173 Golden, *supra* note 121, at 662. ("The Court's primary role in this area should be to combat undesirable ossification of legal doctrine. Consequently, the Court should generally confine its review of substantive patent law to situations where there is a substantial risk that Federal Circuit precedent has frozen legal doctrine either too quickly or for too long. Further, the Court's decisions in this area should typically be modest, seeking to spur, rather than foreclose, subsequent legal development.").

174 *See* Narechania, *supra* note 7, at 1348 (stating that the Supreme Court has appeared to consider analogous standards from other areas of law).

175 Christa J. Laser, *Equitable Defenses in Patent Law*, 75 U. MIAMI L. REV. (forthcoming 2020) (manuscript at 2–3), (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3686120) (exploring the Supreme Court's historical approach to equitable defenses such as misuse, unclean hands, estoppel, and laches).

I. THE ROLE OF IDEOLOGICAL AGREEMENT

Some scholars urge that the reason the Supreme Court has heard fewer cases as a general matter in recent years is in part due to increasing ideological divisions at the Court that make it more difficult to summon a majority in controversial cases.[176] Other commentators disagree that ideological differences have had much impact on the cases taken by the Court, stating that the Supreme Court hears fewer cases today in large part because modern justices simply vote to hear cases less often than their predecessors and because fewer petitions are filed by the Government.[177] However, if ideological divisions have impacted the number of cases the Court takes, this could provide a residual explanation for the increasing percentage of patent cases before the Court.

The Author understands from the interviewees that patent law is sometimes viewed as a less politically divisive topic than other areas of the law, such as civil rights and constitutional law. Indeed, dozens of patent cases in recent years have resulted in unanimous or near-unanimous opinions.[178] The interviewees who clerked in recent decades emphasize a sense that patent cases are cases where a majority consensus will be easy to gather, regardless of which Justice writes the opinion of the Court. This suggests that one possible reason why

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176 Owens & Simon, *supra* note 90, at 1264 (illustrating the effects of ideological dispersion amongst Supreme Court Justices).

177 Liptak, *supra* note 34, at 1–2 (reporting that Justices Souter, Thomas, and Ginsburg voted to hear cases less often than their predecessors).

178 *E.g.*, Sandoz Inc. v. Amgen Inc., 137 S. Ct. 1664, 1678 (2017) (Breyer, J., concurring); TC Heartland LLC v. Kraft Foods Grp. Brands, 137 S. Ct. 1514, 1514 (2017) (resulting in a unanimous opinion); Life Tech. Corp. v. Promega Corp., 137 S. Ct. 734, 735 (2017) (Alito, J., concurring in part and concurring in the judgement); Samsung Elecs. Co. v. Apple, Inc., 137 S. Ct. 429, 429 (2016) (resulting in a unanimous opinion); Cuozzo Speed Techs., LLC v. Lee, 136 S. Ct. 2131, 2148–56 (2016) (Thomas, J., concurring; Alito, J., concurring in part and dissenting in part); Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1936–38 (2016) (Breyer, J., concurring); Alice Corp. v. CLS Bank Int'l, 573 U.S. 208, 227 (2014) (Sotomayor, J., concurring); Nautilus, Inc. v. Biosig Instruments, Inc., 572 U.S. 898, 900 (2014) (resulting in a unanimous opinion); Limelight Networks, Inc. v. Akamai Techs. Inc., 572 U.S. 915, 916 (2014) (resulting in a unanimous opinion); Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc., 572 U.S. 1744, 1744 (2014) (resulting in a unanimous opinion); Octane Fitness, LLC v. Icon Health & Fitness, Inc., 572 U.S. 545, 546 (2014) (resulting in a unanimous opinion); Medtronic, Inc. v. Mirowski Family Ventures, LLC, 571 U.S. 191, 193 (2014) (resulting in a unanimous opinion).

the Court hears more patent cases today is not because of increased interest in patent cases, but because patent cases are viewed as non-ideological in a time of increased ideological division. In other words, perhaps the Supreme Court hears more patent cases today as a percentage of its overall docket in part because patent cases do not cause the same ideological hold-ups to certiorari seen in other areas of the law.[179]

V. DISCUSSION OF THE IMPACT OF THE SUPREME COURT'S CURRENT APPROACH TO CERTIORARI IN PATENT CASES AND RECOMMENDATIONS FOR THE FUTURE

The Supreme Court, by all appearances, has granted certiorari in a number of patent cases without considering whether granting certiorari in that case will help or hinder the stability and uniformity of patent law.[180] Stability of the law is critically important, but particularly in patent law, where investment in entire industries can sometimes depend upon changes in the law made by the Supreme Court. Given the unique societal and procedural background of patent cases, the Supreme Court cannot simply consider the same balance of factors it applies in other cases when granting certiorari in a patent case.[181] Instead, given the incredible public policy interests in the stability and certainty of patent law, the Supreme Court in patent cases should consider whether the Court serves the public interest by intervening, particularly whether the grant of certiorari will promote or undermine stability of the law.

The Supreme Court was not formed for the mere purpose of correcting perceived legal error by the inferior courts. As the Supreme Court stated in the 1920s, "The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."[182] Chief Justice Vinson also noted, "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions."[183] Rather, the original purpose of the Supreme Court was to unify and reduce uncertainty in the law and clarify issues of great public importance. "The debates in the Constitutional Convention make clear that the purpose of the establishment of one

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179 Interviews by Author (noting that areas such as civil rights, constitutional law, and criminal law are often more divisive).

180 *See, e.g.*, Bilski v. Kappos, 561 U.S. 593, 609 (2010) (finding that a business method for hedging investments is not patent-eligible).

181 *See supra* Section II.B.

182 Magnum Import Co. v. Coty, 262 U.S. 159, 163 (1923).

183 Fred M. Vinson, *Work of the U.S. Supreme Court*, 12 TEX. B.J. 551, 551 (1949).

supreme national tribunal was, in the words of John Rutledge of South Carolina, 'to secure the national rights & uniformity of Judgmts [sic].'"[184] Indeed, the Supreme Court itself stated that it has two main purposes: "first to secure uniformity of decision between those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this Court of last resort."[185] It is notable that the tension which arises between the Supreme Court and the Federal Circuit may derive from the concept that the Federal Court is the only other court that has national jurisdiction aside from the Supreme Court.[186]

As discussed above, the Federal Circuit was formed in part based on a desire to unify and nationalize patent law and develop a court of specialized expertise.[187] The problems identified in the Hruska Commission that spurred the creation of the Federal Circuit, such as the inability of the Supreme Court to take a sufficient number of cases to keep up with the need for nationally binding judgments on issues of patent law,[188] have been remedied at least in part by the consolidation of patent cases to the Federal Circuit. The Supreme Court in patent cases, then, should look to the second component of its charge: the public interest in accepting the case. Rule 10 includes a consideration, whether a case "should be[] settled by this Court,"[189] which would support such an analysis.

The certainty and uniformity of law is critically important in patent cases and perhaps is the most significant public interest consideration that could be

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184 *See id* at 551–76 (explaining, generally, the purpose of the Supreme Court).

185 *Magnum Import*, 262 U.S. at 163.

186 *Supra* Section II.C.

187 *Supra* Section II.C; *See* Dreyfuss, *supra* note 58, at 7–8 (explaining the solutions offered by and resulting from formation of the Federal Circuit).

188 *See* COMM'N ON REVISION OF THE FED. CT. APP. SYS., *supra* note 58, at 152–53 (quoting a letter form Professor Gambrell and Mr. Dunner, stating, "It is our view that the principal cause of circuit-to-circuit deviations in the patent field stems from a lack of guidance and monitoring by a single court whose Judgments are nationally binding. True, the Supreme Court technically fills this role but in practice it has not and, indeed, it cannot. The few decisions it renders in critical patent law areas, e.g., obviousness, have done little to provide the circuit courts with meaningful guidance. The Supreme Court is just too busy to perform anything even resembling a monitoring function on patent-related issues."); Dreyfuss, *supra* note 58, at 6 (noting that the formation of the Court of Appeals for the Federal Circuit resulted from proposals made by the Hruska Commission).

189 SUP. CT. R. 10.

applied to certiorari in patent cases. Without clear and stable patent laws, investors in patented technology and those who practice technologies accused of infringement cannot accurately determine the scope of their rights. When an investment carries significant uncertainty, its value is depleted.[190] When a product being developed faces unpredictable risk that it will face injunctions and damages for patent infringement, this decreases companies' willingness to commercialize.[191] Uncertainty is the bane of technology markets.[192] In patent law, the certainty of the law perhaps should be the most important factor in the Supreme Court's test, balancing all of the circumstances.

The Supreme Court might need to correct errors where there is ossification of an incorrect standard. However, the interests of the public are not served where the Supreme Court serves merely to second guess the "rigid" approach of the Federal Circuit.[193] Certiorari in patent cases should not be granted merely because the Federal Circuit standard differs from the approach the Supreme Court believes is appropriate and the case presents a clean vehicle to overturn it. Businesses and other patent stakeholders need to trust that the decisions of the Federal Circuit will generally remain intact absent significant legal error. The current rate of Supreme Court review[194] undermines this confidence.

Moreover, despite increasing its patent docket, the Supreme Court has not matched the Federal Circuit's institutional expertise on issues of patent law or capacity for evaluating technologically complex scientific issues.[195] It is, of course, true that there are certain issues that arise in patent law where the Supreme Court can claim to have at least as much or more pertinent expertise and authority than the Federal Circuit, such as on issues of the constitutionality of provisions of the patent code[196] or questions that also arise in other areas of law such as the

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190 *See* Czarnitzki & Toole, *supra* note 14, at 147 (noting the relationship between uncertainty and value).

191 *See id.* at 157 (stating that "higher levels of uncertainty reduce current R&D investment, with a non-patenting firm in the German manufacturing sector reducing R&D investment by 23% in response to a 10% increase in uncertainty from the median").

192 *See id.* at 148 (suggesting a "negative relationship between the current level of R&D investment and uncertainty").

193 *See supra* Section IV.D.

194 *See supra* Figure 4; *see also* Madigan & Mossoff, *supra* note 12, at 946–47.

195 *See supra* Section IV.F.

196 *E.g.*, Oil States Energy Ser., LLC v. Greene's Energy Grp., 138 S. Ct. 1365, 1379 (2018) (finding that administrative *inter partes* review of patents by the

applicability of laches to bar damages when a statute of limitations applies.[197] But in other areas of patent law, scholars routinely criticize the Supreme Court's recent decisions for failing to act with awareness of the impact of its decisions on industry and the stability of the patent system.[198]

For example, a number of patent stakeholders have urged that the Supreme Court's decisions since 2010 on patent eligible subject matter doctrine (which determines what types of technologies can be patented), caused sweeping change to the scope of patent rights as they were previously understood.[199] In the last decade, the Supreme Court held innovations in numerous technology areas ineligible for patenting, including certain business methods, medical treatments and diagnostics, and too-abstract software—rendering significant investments in these types of technologies unrecoverable.[200] Some have characterized the

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patent office is not unconstitutional and does not violate the Seventh Amendment right to jury).

197 *See* SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 137 S. Ct. 954, 967 (2017) (holding that laches does not bar damages for patent infringement actions brought within the statute of limitations set out in the patent code).

198 *See* Madigan & Mossoff, *supra* note 12, at 941–42 (reporting that that from 2014 to 2017, a time period following various Supreme Court decisions on patent eligible subject matter, 1694 patent applications on technologies such as diagnostic tests, ultrasound imaging, and other medical devices were denied at the U.S. patent office for failing to be patent eligible, yet foreign counterparts were granted).

199 KEVIN J. HICKEY, CONG. RSCH. SERV., R45918, PATENT-ELIGIBLE SUBJECT MATTER REFORM IN THE 116TH CONGRESS 2 (2019) https://fas.org/sgp/crs/misc/R45918.pdf [https://perma.cc/N2AW-NXTQ] ("These cases have been widely recognized to effect a significant change in the scope of patentable subject matter, restricting the sorts of inventions that are patentable in the United States."); USPTO, PATENT ELIGIBLE SUBJECT MATTER: REPORT ON VIEWS AND RECOMMENDATIONS FROM THE PUBLIC 23 (2017), https://www.uspto.gov/sites/default/files/documents/101-Report_FINAL.pdf [https://perma.cc/K7WW-WJRJ] ("In general, commentators agreed that the Court decisions in *Bilski, Mayo, Myriad,* and *Alice* have had a significant impact on the scope of patent eligible subject matter."); Jeffrey A. Lefstin et al., *Final Report of the Berkeley Center for Law & Technology Section 101 Workshop: Addressing Patent Eligibility Challenges*, 33 BERKELEY TECH. L.J. 551, 555 (2018).

200 Alice Corp. v. CLS Bank Int'l, 573 U.S. 208, 226 (2014) (finding that a software program related to financial transactions was not eligible for patenting); Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 569 U.S.

Supreme Court's patent eligible subject matter jurisprudence as "subjective," "indeterminate," and "highly unpredictable."[201] Others argue that the Supreme Court's approach to patent eligible subject matter "lacks administrability"[202] or has undermined the United States' status as possessing the "gold standard" of patent systems.[203] The Author does not take a position that the Supreme Court's decisions were wrong as a legal matter. Indeed, finding patents on certain core technologies, abstractions, and natural phenomenon ineligible for patenting could help to promote innovation by weeding out patents that if granted, would threaten basic research and development.

But regardless of which position is a more correct legal interpretation or better policy, the Supreme Court's jurisprudence has had an impact on the law in the lower courts. Empirical evidence shows the dramatic change: in 2010, when the Supreme Court decided *Bilski*,[204] only two patent cases were terminated at the trial level based on a determination that the patents covered ineligible subject matter; in 2019, the most common reason for a patent to be found invalid was ineligible subject matter, with 57 lower court cases finding patents invalid on this basis.[205] This change has a significant impact on investments. Some patents that were by all appearances valid when written are no longer valid, when in many cases businesses spent millions of dollars investing in reliance on the belief of patent protection.[206] Indeed, legislative history of the America Invents Act suggests that one impetus for the implementation of Covered Business Method Review, an administrative review proceeding for business method patents at the

576, 591 (2013) (holding that isolated DNA for medical use not is patent-eligible); Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66, 73 (2012) (finding that a test to aid autoimmune disease treatment is not patent-eligible); Bilski v. Kappos, 561 U.S. 593, 609 (2010) (finding that a business method for hedging investments is not patent-eligible).

201 Hon. Paul R. Michel, *The Supreme Court Saps Patent Certainty*, 82 GEO. WASH. L. REV. 1751, 1758 (2014).

202 David O. Taylor, *Confusing Patent Eligibility*, 84 TENN. L. REV. 157, 160 (2016).

203 Madigan & Mossoff, *supra* note 12, at 940.

204 *Bilski*, 561 U.S. at 593.

205 GENEVA CLARK, LEX MACHINA, PATENT LITIGATION REPORT 23–24 (Rachel Bailey & Jason Maples eds., 2020).

206 *See* Madigan & Mossoff, *supra* note 12, at 950.

patent office, was to invalidate patents that were no longer patentable after Supreme Court decisions on subject matter eligibility.[207]

Even if the criticisms that the Supreme Court's patent decisions have undermined the stability of law are true, this result could not have been avoided because the Supreme Court's current approach to certiorari in patent cases under Rule 10[208] does not adequately take into account the effect of the Court's decisions on the stability and certainty of law. This was not always the case; the interviewees inform that in the mid-twentieth century, the Court often tried to avoid intervention in patent law where it lacked legal expertise on a nuanced issue of substantive law. Moreover, the current approach is not how patent certiorari should be determined. It is not in the interest of innovation in this country to have an unstable, unpredictable patent law.[209]

The Supreme Court precedent has noted a dual purpose of certiorari: first, nationalizing and unifying the law, and "second, to bring up cases involving questions of importance which it is in the public interest to have decided by this Court of last resort."[210] The Supreme Court's call in patent law is not to duplicate that function or to merely correct errors.[211] There is no procedural proxy in patent law that completely matches the signaling function of the circuit split to indicate

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207 *See* 157 CONG. REC. 9791 (2011) (statement of Rep. Smith) ("It is likely that most if not all the business method patents that were issued after State Street are now invalid under *Bilski*. There is no sense in allowing expensive litigation over patents that are no longer valid.").

208 *See supra* Section II.B.

209 The Supreme Court should also consider the impact of the antitrust zeitgeist on patent law. As discussed above, there can be a tendency for the Court to tighten patent law such that more patents would be invalid or unenforceable during time periods of heightened antitrust enforcement. Antitrust scrutiny has continued to rise from the 2000s to the present day and might soon reach levels like that seen in the early twentieth century. *See, e.g.*, Kari Paul, *Google Is Facing the Biggest Antitrust Case in a Generation. What Could Happen?*, THE GUARDIAN (Oct. 21, 2020, 4:57 PM), https://www.theguardian.com/technology/2020/oct/21/google-antitrust-charges-what-is-next [https://perma.cc/F7XN-MVGD]. Given the value of certainty in patent law, the Court should resist the urge to change patent laws as inconsistent with the present zeitgeist, favoring instead more consistent and predictable standards that promote business investment.

210 Magnum Import Co. v. Coty, 262 U.S. 159, 163 (1923).

211 *See id.* (recognizing that certiorari serves a function beyond just providing another hearing for the parties).

the need for Supreme Court review.[212] Absent this, the Court must consider the public interest at the forefront of its certiorari decision in patent cases. Because of the significant investments that require knowing the boundaries of patent rights, the public interest of certiorari in a patent case should include consideration of how the case will impact the stability and certainty of law.

The Supreme Court can—and, to avoid future crises, must—change its approach to certiorari in patent cases. Given the unique societal and procedural background of patent cases, the Supreme Court must apply Rule 10 differently in patent cases than in general cases. In a patent case, the Supreme Court should consider whether the Court serves the public interest by intervening, including most importantly whether a grant of certiorari will promote or undermine stability of patent law. The benefits of stability will then need to be weighed against the interest of correction of legal error.

VI. CONCLUSION

The Supreme Court has decided more patent cases in the past decade than the prior three decades combined. A number of scholars and patent stakeholders urge that the Supreme Court's frequent decisions are destabilizing the law, undermining the United States' position as a leader in innovation. Yet no scholarship to date has used qualitative data to investigate why the Supreme Court's patent docket is increasing and what factors the Supreme Court considers in its review of patent cases.

Without a circuit split to ascertain whether a petition is worthy of review, the Supreme Court must look to other factors in patent cases. The interviews confirm the teachings of prior scholarship that the views of the Solicitor General and the number, type, and focus of amicus support play an outsized role in patent cases. However, the interviews contradicted other views from prior scholarship, such as familiar names of top Supreme Court advocates spurring certiorari in patents cases. As to why cases filed by these advocates have a higher rate of success, it appears that such advocates are simply more skilled at preparing petitions that address the considerations most important to the Court.

The research presented in this Article also suggests that the narrative of the Federal Circuit as applying rigid rules rather than flexible standards urged by the Supreme Court is pervasive at the Court. The interviewees also suggest that patent cases are viewed as ideologically safe choices, which the Author

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[212] As noted above, splits *en banc* in decisions or dissents from denial of *en banc* review might have some signaling value, but the interviewees indicate that they do not remotely approach the weight of a circuit split in signaling the need for the Court's review.

hypothesizes might be partially responsible for the increase in the Supreme Court's percentage of patent cases in recent years of ideological division.

There is, however, a key factor that the Supreme Court is not considering in patent cases when it grants certiorari: whether a decision in the case will support or undermine the stability and certainty of patent law. Stability is critically important where industries and investments can be diminished by changes in the law made by the Supreme Court. Rule 10 permits the Court to consider whether a case "should be[] settled by [the] Court," but the public policy of patents is not being fully appreciated in modern Supreme Court certiorari decisions. Where the Federal Circuit already provides uniform national appellate decisions on patent law, the Supreme Court should consider more than merely the ordinary Rule 10 factors when granting certiorari in a patent case. The Court should consider whether the grant of certiorari will be in the best interest of the public, which in patent cases requires consideration of whether the decision will promote or undermine stability of patent law.

VII. APPENDIX: EXAMPLE SURVEY QUESTIONS

Note: although the same numbered open-ended questions were asked of each participant, follow-up questions varied based on the participant's initial responses. Follow-up questions were honed over the course of initial interviews, with the subject matter and style of questioning remaining the same.

Logistics of Certiorari.

1. Can you tell me about the logistics of cert decisions during your time on Court and with your Justice?
    a. Are you aware of which Justices participated in the certiorari pool during your time on the Court? [If yes] Who?
        i. [If Justice participated in the pool]
            1. How were petitions divided among chambers?
            2. What were the contents of a pool memo? How detailed were the memos? Did that differ from case to case? [If yes] How?
            3. Was a pool memo written for every petition?
            4. How were certiorari memos written by other chambers reviewed? Did clerks in [Justice's] chambers add their own written comments and suggestions for the Justice on the certiorari memo?
            5. Are you aware of what else the Justice reviewed beyond the certiorari memo? [If yes] What else?

Did what the Justice reviewed differ depending on the grant/deny recommendation or from case to case? [If yes] How?

ii. [If Justice did not participate in the pool]
    1. What were the logistics of certiorari analyses in your Justice's chambers? Did clerks write a memo with a recommendation?
    2. How detailed were the memos? Did that differ from case to case? [If yes] How?
    3. Was a memo written for every petition?
    4. Are you aware of what else the Justice reviewed beyond the certiorari memo? [If yes] What else? Did what the Justice reviewed differ depending on the grant/deny recommendation or from case to case? [If yes] How?

b. Are you aware of how the certiorari discussion list process worked from your time on the court? [If yes] How did it work?

Certiorari Considerations in General Cases

2. In general cases, what factors were considered in the certiorari decision?
    a. Supreme Court Rule 10 provides several considerations for certiorari, including circuit split, conflict with Supreme Court precedent, important but unsettled question of law.
        i. What was the effect, if any, of split?
        ii. What was the effect, if any, of conflicts with prior Supreme Court precedent?
        iii. What was the effect, if any, of important unsettled questions of law? What considerations were used to decide if an issue was "important" or "should be" settled by the Court? Did different chambers have different views on what makes an issue "important" or one that "should be" settled by the Court? [If yes] In what way?
    b. In general cases, do some of these factors have greater weight than others? [If yes] Which ones?
    c. How much did the clerk's certiorari memos track the Rule 10 factors?
    d. What other factors or considerations have an impact on certiorari in general cases?
        i. What was the effect, if any, of the solicitor general's views?

ii. What was the effect, if any, of amicus support?
iii. What was the effect, if any, of the identity of the attorneys petitioning or opposing certiorari?
iv. What was the effect, if any, of any agenda setting by a Justice or the Court?

Certiorari Considerations in Patent Cases

3. Because there is generally no circuit split in patent cases, what considerations were used to determine certiorari in patent appeals?
    a. In patent cases, do some of these factors have greater weight than others? [If yes] Which ones?
    b. What was the effect, if any, of conflicts with prior Supreme Court precedent? Was this consideration more or less important in patent cases than in general cases?
    c. What was the effect, if any, of important unsettled questions of law? Was this consideration more or less important in patent cases than in general cases?
        i. On what basis was a patent issue considered important or something that "should be" decided at that time?
        ii. Did certain Justices have certain issues in patent law that they sought out cases on?
        iii. In patent cases, did the Court consider the effect of a decision on the stability of patent law when deciding whether to grant certiorari?
        iv. In patent cases, did the Court consider the need for predictability and clarity of patent law when deciding whether to grant certiorari?
    d. Was any proxy used for a circuit split in patent cases?
        i. What was the effect, if any, of dissents from or denials of *en banc* review? Any other proxies for circuit split?
    e. In patent cases, how much did the clerk's certiorari memos track the Rule 10 factors?
    f. What other factors or considerations have an impact on certiorari in patent cases?
        i. What was the effect, if any, of the solicitor general's views? Was this consideration more or less important in patent cases than in general cases?
        ii. What was the effect, if any, of amicus support? Was this consideration more or less important in patent cases than in general cases?

iii. What was the effect, if any, of the identity of the attorneys petitioning or opposing certiorari? Was this consideration more or less important in patent cases than in general cases?

iv. What was the effect, if any, of any agenda setting by a Justice or the Court? Was this consideration more or less important in patent cases than in general cases?

v. Did the nature of the technology at issue have any bearing on whether the Court granted certiorari? [If yes] In what way? During your time at the court, what experience did the clerks in your Justice's chamber have with technology? With patent law?

vi. Are there any other considerations that had an impact on certiorari in patent cases? [If yes] Which ones? How, if at all, did these factors differ than in general cases?

vii. During your time on the court, how did the Court view the Federal Circuit or what was the prevailing narrative about the Federal Circuit at the Court?

1. What made you think that?
2. What effect, if any, did this narrative about the Federal Circuit have on the certiorari process in patent cases?
3. What effect, if any, did this narrative about the Federal Circuit have on the certiorari process in patent cases?

g. In patent cases, do some of these factors have greater consideration than others? [If yes] Which ones?

h. How else, if at all, did the certiorari process differ in patent cases than in general cases during your time at the Court? Anything else?

i. At the time you were with the Court, were there certain types of issues in patent law that were seen as important for the Supreme Court to resolve versus for the Federal Circuit to have the last word on?

i. [If yes] Which ones? Any others?

ii. [For each issue stated by participant] Do you know why __ was seen as important for the Supreme Court to resolve versus the Federal Circuit? Why do you think that?

j. Was there a sense at the time you were with the court that the Court should defer to the Federal Circuit on certain issues?
    i. [If yes] Which ones? Any others? [For each] Why do you think that?
    ii. How, if at all, did the Court's views on the deference owed to the Federal Circuit on __ [stated issue] impact certiorari during your time on the Court? Why do you say that?