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Matthew J. Dowd

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# Rule 36 Decisions at the Federal Circuit: Statutory Authority

Matthew J. Dowd\*

## ABSTRACT

*Recent commentary has questioned the validity of the US Court of Appeals for the Federal Circuit's use of Rule 36 affirmances in deciding appeals from the US Patent and Trademark Office (USPTO). One article in particular posits that 35 U.S.C. § 144 and 15 U.S.C. § 1071(a)(4) require the Federal Circuit to write an opinion in every appeal from the USPTO and therefore the court's use of Rule 36 affirmances, particularly with appeals of cases from the America Invents Act, is improper. This Article presents a reasoned counterpoint to that argument. A complete analysis of the statutory text, the legislative history, the historical context of the statutes, and other considerations, including other applicable Federal Rules of Appellate Procedure, the delegation of authority under the Rules Enabling Act, and traditional deference afforded the judiciary in how it applies procedural rules, support the conclusion that Rule 36 affirmances are entirely within the authority and discretion of the court. A contrary conclusion would rest on a slender reed of statutory text and would create a rare situation—perhaps the only instance—in which Congress has directly dictated procedure for the federal courts of appeal since the enactment of the Rules Enabling Act.*

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## I. INTRODUCTION

An intriguing argument has recently been advanced, based on a purportedly novel theory, about the permissibility of so-called “Rule 36 affirmances.”<sup>1</sup> Professor Dennis Crouch and others have argued that the use of Federal Circuit Rule 36 (“Rule 36”) affirmances by the US Court of Appeals for the Federal Circuit in appeals from the US Patent and Trademark Office (USPTO) violates statutory mandates established by Congress in 35 U.S.C. § 144<sup>2</sup> and 15 U.S.C. § 1071(a)(4).<sup>3</sup> As the argument goes, because those two statutory provisions state that

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1. Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 WAKE FOREST L. REV. 561, 561–62 (2017).

2. 35 U.S.C. § 144 (2018) (“The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination *the court shall issue to the Director its mandate and opinion*, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.” (emphasis added)); Crouch, *supra* note 1, at 561–62.

3. 15 U.S.C. § 1071(a)(4) (2018) (“The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination *the court shall issue its mandate and opinion* to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.” (emphasis added)); Crouch, *supra* note 1, at 561–62.

the Federal Circuit “shall issue to the Director [of the USPTO] its mandate and opinion,” the Federal Circuit is obligated to write an opinion in every such appeal, which provides the court’s reasons for affirmance, rather than simply a one-word affirmance by means of Rule 36.<sup>4</sup>

The argument, while not new, exhibits some superficial attractiveness. It reads like a straightforward, text-based interpretation of the statutes. The proponents of the argument suggest there is no room for doubt or debate.<sup>5</sup> The argument also seemingly validates increasing concerns raised by certain members of the patent bar about the use of Rule 36 affirmances by the Federal Circuit.<sup>6</sup>

Upon a more thorough analysis, however, the question of the validity of Rule 36 affirmances runs deeper than a quick read of the statute. This Article presents a comprehensive and reasoned analysis to demonstrate that the Federal Circuit is well within its authority to issue Rule 36 affirmances for USPTO appeals. A complete analysis of the statutory text, the historical context of the statute, separation of powers considerations, and other factors supports the conclusion that Rule 36 affirmances are entirely within the authority and discretion of the Federal Circuit. A contrary conclusion would rest on the slender reed of misreading the statutory text and would create a rare situation—perhaps the only instance—in which Congress has directly dictated a procedural requirement for the federal courts of appeal since the enactment of the Rules Enabling Act.

This Article endeavors to put to rest the continued confusion about the Federal Circuit’s authority to use Rule 36 affirmances. The resurgence of the argument that the Federal Circuit cannot issue Rule 36 opinions has received greater attention with the increased number of appeals from the USPTO. But it is not a new argument, and the

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4. Crouch, *supra* note 1, at 562.

5. See Crouch, *supra* note 1, at 562, 571 (“Quite simply, Rule 36 judgments are not opinions and thus do not satisfy the opinion requirement. . . . The statutes are so straightforward that it appears almost laughable to argue that no opinion is required.”).

6. See, e.g., Dennis Crouch, *The Federal Circuit Strides Forward with No-Opinion-Judgments*, PATENTLY-O (Sept. 14, 2018), <https://patentlyo.com/patent/2018/09/federal-circuit-judgments.html> [<https://perma.cc/UW7R-YKPZ>]; Peter Harter & Gene Quinn, *Rule 36: The Ides of March for the Federal Circuit?*, IPWATCHDOG (Mar. 1, 2017), <http://www.ipwatchdog.com/2017/03/01/rule-36-ides-march-federal-circuit/id=78985/> [<https://perma.cc/V8J9-AGVF>]; Peter Harter & Gene Quinn, *Does the Federal Circuit’s Use of Rule 36 Call into Question Integrity of the Judicial Process?*, IPWATCHDOG (Feb. 14, 2017), <http://www.ipwatchdog.com/2017/02/14/federal-circuit-rule-36-integrity-judicial-process/id=78261/> [<https://perma.cc/M4Q9-PBQY>]; Peter Harter & Gene Quinn, *Rule 36: Unprecedented Abuse at the Federal Circuit*, IPWATCHDOG (Jan. 12, 2017), <http://www.ipwatchdog.com/2017/01/12/rule-36-abuse-federal-circuit/id=76971/> [<https://perma.cc/PDQ2-WHYU>] (“In the patent world the Federal Circuit is further placing America’s inventors under siege as the result of their mercurial use of Rule 36.”).

Supreme Court has, for at least twenty-five years, declined invitations to grant cert petitions based on this argument.

The Article starts with a brief background and history of written judicial opinions, which provides useful context for understanding the purpose of 35 U.S.C. §144 (“§ 144”). The background includes an examination of the Federal Rules Enabling Act, which statutorily delegated judicial rulemaking to the judiciary itself. The background also considers the growth of unpublished, or nonprecedential, opinions.

Next, the Article turns to the statutory analysis of § 144. The statute’s plain text does not command the Federal Circuit to write an opinion, with reasons, in every case appealed from the USPTO. All the statute requires is that the court’s mandate and opinion—assuming one is written—are “issue[d] to the Director” of the USPTO.<sup>7</sup> The textual command to issue to the Director instructs the court to transmit the decision and mandate to the USPTO. Had Congress wanted to impose the unusual requirement of having to write an opinion in every USPTO appeal, Congress could have been explicit; it could have adopted statutory language widely used by states that require courts to issue written opinions with reasons stated.<sup>8</sup> Congress also could have taken a cue from language used in establishing the former US Court of Appeals of the District of Columbia Circuit in 1893 or the former Court of Customs and Patent Appeals (CCPA) in 1929. In those instances, Congress expressly stated that “the opinion of the said court of appeals in every case shall be rendered in writing, and shall be filed in such case as a part of the record thereof.”<sup>9</sup> Congress did not include any such express requirement in § 144 or 15 U.S.C. § 1071(a)(4) (“§ 1071(a)(4)”).

By 1984—when the “issue to the Director” language was added to § 144 and § 1071(a)(4)—affirmances without opinions were routine dispositions in the federal courts of appeal. Since 1967, Federal Rule of Appellate Procedure (FRAP) 36, promulgated pursuant to the Rules Enabling Act of 1934, has authorized federal courts of appeals to decide cases without writing an opinion.<sup>10</sup> FRAP 36 has the force of law, like

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7. 35 U.S.C. § 144.

8. See *infra* Section III.A.1.

9. See Act of Mar. 2, 1929, ch. 488, § 3, 45 Stat. 1475 (1929); Act of Feb. 9, 1893, ch. 74, § 10, 27 Stat. 436 (1893). Even these statutes leave open the question as to what was required in the opinion, as they say nothing about requiring the court’s reasoning or bases for its opinion. See *infra* Section III.A.1. Thus, these earlier statutes may merely be directives to ensure that an opinion from the court, if given, would be in writing and not delivered orally from the bench. Like the current § 144, they did not expressly command the court to write an opinion in every case and did not expressly require the court to provide the reasons for its decision. *But see infra* note 117 (discussing provisions in state constitutions).

10. FED. R. APP. P. 36; see also Rules Enabling Act, Pub. L. No. 73-415, 48 Stat. 1064 (1934) (codified at 28 U.S.C. § 2072 (2018)).

an act of Congress, and courts have repeatedly rejected challenges to Rule 36 affirmances without an opinion.<sup>11</sup> The Supreme Court has also accepted the practice, upholding the affirmance when faced with a challenge to the US Court of Appeals for the Fifth Circuit's local rule in the 1960s that permitted its version of Rule 36 affirmances.<sup>12</sup> Other courts of appeals have since implemented similar rules and rejected challenges to the rules.<sup>13</sup> Even the CCPA—the Federal Circuit's predecessor—would, when warranted, dispose of an appeal with a two-line affirmance.<sup>14</sup>

Historical context and legislative history also confirm that the 1984 amendments to § 144 and § 1071(a)(4) were not intended to repeal FRAP 36 and impose a novel requirement that the Federal Circuit must write an opinion with reasons in every USPTO appeal. Rather, the amendments were proposed by Chief Judge Howard T. Markey as technical amendments to the recently enacted Federal Courts Improvement Act of 1982, which created the Federal Circuit.<sup>15</sup> The amendments to § 144 and § 1071(a)(4) were intended to conform appeals from the USPTO with other appeals and general appellate practice. It was Chief Judge Markey who, just a few years later, spoke approvingly of Rule 36.<sup>16</sup> It is highly improbable that Chief Judge Markey would approve Rule 36 if that rule violated the very statutory amendment he proposed to Congress just a few years prior.

In fact, it would have made little sense for Congress to pass a technical amendment to require what the Federal Circuit was already doing. At the time, the Federal Circuit's Local Rule 18(a) stated that the court could dispose of appeals by a published or unpublished opinion.<sup>17</sup> And the Federal Rules of Appellate Procedure required the court to produce a mandate.<sup>18</sup>

In short, the only reasonable interpretation of § 144 and § 1071(a)(4) is that they do not require written opinions in every appeal from the USPTO. Such an interpretation would create an incongruent situation where the court could issue a Rule 36 affirmance in a district court appeal—or any other type of appeal for that matter, such as from the International Trade Commission—but could not do so for a USPTO

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11. See *infra* Section II.C.1.

12. See *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) (per curiam); *infra* Section II.C.1.

13. See cases cited *infra* note 88.

14. See *infra* Section III.B.

15. See *infra* Section III.D.

16. See *The Seventh Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, 128 F.R.D. 409, 420 (1989).

17. See *infra* Section III.A.1.

18. See *infra* Section III.A.1.

appeal. Instead, the statute is a procedural directive, instructing the court to transmit its opinion to the USPTO director, assuming an opinion is written.

To be clear, this Article analyzes only the Federal Circuit's authority to issue Rule 36 affirmances. The court has sound statutory authority to do so, but whether it should use Rule 36 as much as it has in recent years is a much different issue, and one to be fully analyzed in a separate article.

## II. BACKGROUND AND HISTORY OF WRITTEN OPINIONS

To understand Rule 36's place in the judicial decision-making process, a brief review of the historical development of judicial opinion writing is necessary. This background provides the necessary understanding to accurately interpret the statutory provisions and to accurately understand the implications of the argument that the Federal Circuit's Rule 36 affirmances are unauthorized for USPTO appeals. This Part first details what a Rule 36 affirmance entails. The Part next examines the Rules Enabling Act and its implications for interpreting statutes purporting to establish requirements of judicial opinion writing. The Part then briefly explores the historical practice of appellate opinion writing, including the more modern creation of the "unpublished" opinion.

### *A. What Is a Rule 36 Disposition?*

Before examining the history of the statutes and rules governing written judicial decisions, a preliminary review of Rule 36 and certain terminology is warranted.

FRAP 36 provides as follows:

- (a) Entry. A judgment is entered when it is noted on the docket. The clerk must prepare, sign, and enter the judgment:
  - (1) after receiving the court's opinion—but if settlement of the judgment's form is required, after final settlement; or
  - (2) if a judgment is rendered without an opinion, as the court instructs.
- (b) Notice. On the date when judgment is entered, the clerk must serve on all parties a copy of the opinion—or the judgment, if no opinion was written—and a notice of the date when the judgment was entered.<sup>19</sup>

This rule applies to all federal courts of appeals, and, as explained below, the rule is approved by the Supreme Court and Congress. The rule expressly recognizes that a judgment in an appeal

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19. FED. R. APP. P. 36.

may be “rendered without an opinion.”<sup>20</sup> Thus, under FRAP 36, all federal courts of appeals may enter a judgment without the need for a written opinion. By logical extension, all federal appellate courts are implicitly authorized to dispose of cases without providing the reasoning or bases of their decisions.<sup>21</sup> As the advisory committee notes explain, FRAP 36 embodies the “typical rule” that was in place in the various appeals courts when the FRAP were enacted in 1967.<sup>22</sup>

Current Rule 36 reads as follows:

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

- (a) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (b) the evidence supporting the jury’s verdict is sufficient;
- (c) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
- (e) a judgment or decision has been entered without an error of law.<sup>23</sup>

On its face, Rule 36 does not expand the authority granted to the court by FRAP 36. Instead, Rule 36 simply specifies the instances in which affirmance without an opinion is appropriate. Rather than expand what the court can do, Rule 36 actually limits the broader authority—at least broader based on the text—of FRAP 36 by limiting the use of an affirmance without opinion to five situations. Rule 36 also restricts the use of decisions without opinions to “affirmances,” which is not a limitation included in FRAP 36.

One further definitional point is needed in order to understand the historical and statutory aspects of Rule 36 affirmances. For purposes of this Article, the term “Rule 36 affirmance” refers

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20. *Id.*

21. *See* 28 U.S.C. § 2106 (2018) (giving the federal appellate courts broad authority to issue rulings “as may be just under the circumstances”).

22. FED. R. APP. P. 36 advisory committee’s note to the 1967 adoption.

23. FED. CIR. R. 36. For additional background, see Justin A. Hendrix & Jacob A. Schroeder, *Surf’s Up: Is the Federal Circuit Using Rule 36 to Rubber-Stamp the PTAB’s Decisions in IPRs?*, FINNEGAN (Nov. 16, 2015), <https://www.finnegan.com/en/insights/blogs/federal-circuit-ip/surfs-up-is-the-federal-circuit-using-rule-36-to-rubber-stamp-the-ptabs-decisions-in-iprs-1.html> [<https://perma.cc/V3AN-M9LM>]; Rachel Hughey, *How To Get To Federal Circuit Rule 36*, LAW360 (July 29, 2015, 10:19 AM), <https://www.law360.com/articles/684264/how-to-get-to-federal-circuit-rule-36> [<https://perma.cc/Y9GW-M543>]; Anthony C. Tridico, Timothy P. McAnulty & Kassandra M. Officer, *PTAB Affirmance at the Federal Circuit*, FINNEGAN (June 2015), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=b20beda3-76a3-4f34-b1d8-a0a0f449364f> [<https://perma.cc/658V-XJW4>].



specifically to the single-line decisions affirming the lower tribunal's decision that are issued pursuant to FRAP 36 or Rule 36.

In contrast, the term "summary affirmance" generally refers to an affirmance prior to briefing on the merits.<sup>24</sup> A summary affirmance "is appropriate, inter alia, when the position of one party is so clearly correct as a matter of law that no substantial question regarding the outcome of the appeal exists."<sup>25</sup> Not dictated by any procedural rule, a summary affirmance is a concise opinion used by the Federal Circuit and other circuits to dispose of appeals prior to full briefing on the merits or prior to oral argument.<sup>26</sup> The Federal Circuit generally issues a written opinion explaining the reasons for granting summary affirmance, which is another distinction between a Rule 36 affirmance and a summary affirmance.<sup>27</sup>

This distinction has important implications about the precedential value of a Rule 36 affirmance versus that of a summary affirmance. A Rule 36 affirmance offers no explanation of the court's decision, other than recording that the court agrees with the judgment of the lower tribunal. Indeed, "a Rule 36 judgment simply confirms that the trial court entered the correct judgment. It does not endorse or reject any specific part of the trial court's reasoning."<sup>28</sup> For this reason, a Rule 36 affirmance generally will not trigger the mandate rule.<sup>29</sup>

24. For purposes of this Article, the terms "summary affirmance" and "Rule 36 affirmance" are not used interchangeably, unless citing particular usage from another source. The term "summary affirmance" has frequently been used to refer to a "Rule 36 affirmance." See, e.g., *Memorylink Corp. v. Motorola, Inc.*, 676 F.3d 1051, 1052 (Fed. Cir. 2012) (O'Malley, J., dissenting from denial of petition for rehearing en banc) (referring to Rule 36 as "our rule permitting summary affirmance of appeals"). Such usage is not necessarily incorrect, but this Article maintains the distinction is preferable and more precise. See Aaron S. Bayer, *I Know a Frivolous Appeal When I See One*, NAT'L L.J., Mar. 12, 2012, at 1 (summarizing the courts of appeals' various approaches to summary affirmances).

25. *Joshua v. United States*, 17 F.3d 378, 380 (Fed. Cir. 1994); see also *Taxpayers Watchdog, Inc. v. Stanley*, 819 F.2d 294, 297-98 (D.C. Cir. 1987) (explaining that summary affirmance is proper when "the merits of [the] case are so clear that expedited action is justified" and "no benefit will be gained from further briefing and argument of the issues presented").

26. See *Joshua*, 17 F.3d at 380; *Chem. Eng'g Corp. v. Marlo, Inc.*, 754 F.2d 331, 335 (Fed. Cir. 1984) ("The grant of summary judgment is *sua sponte* hereby summarily AFFIRMED . . ."). To be clear, however, the term "summary affirmance" has also been used to refer to certain affirmances even after briefing on the merits. See, e.g., *Mossburg v. Maryland*, 676 F. App'x 211, 212 (4th Cir. 2017) (unpublished), *cert. denied*, 138 S. Ct. 102 (2017); *infra* Section III.C.

27. See, e.g., *Kenney v. United States*, No. 2013-5003, 2013 U.S. App. LEXIS 4504, at \*1-3 (Fed. Cir. Mar. 5, 2013) (granting motion for summary affirmance because the complaint in the Court of Federal Claims failed to set forth a jurisdictional basis); *Amodeo v. Dep't of Transp.*, Fed. Aviation Admin., 788 F.2d 1549, 1552 (Fed. Cir. 1986) (granting fees based on prior summary affirmance).

28. *Rates Tech., Inc. v. Mediatrice Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012).

29. See *TecSec, Inc. v. Int'l Bus. Machs. Corp.*, 731 F.3d 1336, 1343 (Fed. Cir. 2013) ("Here, the mandate rule does not preclude TecSec from challenging claim construction."). The mandate rule is, in essence, a specific application of the law of the case doctrine. See, e.g., *United States v. Bell*, 5 F.3d 64, 66 (4th Cir. 1993) ("[I]t is indisputable that a lower court generally is 'bound to

Depending on the issues litigated, a Rule 36 affirmance also may not trigger collateral estoppel.<sup>30</sup>

Several circuit courts also have local rules for summary dispositions.<sup>31</sup> In addition, other circuits have rules that specifically permit “summary affirmances,” which do little more than state the decision of the court.<sup>32</sup> Summary affirmances are routinely used by federal courts to dispose of appeals prior to briefing on the merits.<sup>33</sup> Note again, however, that a “summary affirmance” in this context is slightly different than a Rule 36 affirmance because the summary affirmance provides some additional statement other than merely

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carry the mandate of the upper court into execution and [may] not consider the questions which the mandate laid at rest.” (quoting *Sprague v. Ticonic Nat'l Bank*, 307 U.S. 161, 168 (1939) (alteration in original))).

30. See *TecSec*, 731 F.3d at 1344 (“Because claim construction was neither actually determined by nor critical and necessary to our summary affirmance [i.e. Rule 36 affirmance] in the IBM appeal, collateral estoppel does not preclude the present challenge.”).

31. See, e.g., 8TH CIR. R. 47A (“SUMMARY DISPOSITION. (a) On Motion of Court. The court on its own motion may summarily dispose of any appeal without notice.”); 9TH CIR. R. 3-6; 10TH CIR. R. 27.3.

32. E.g., 4TH CIR. R. 36.3 (“36.3. Summary Opinions. If all judges on a panel of the Court agree following oral argument that an opinion in a case would have no precedential value, and that summary disposition is otherwise appropriate, the Court may decide the appeal by summary opinion. A summary opinion identifies the decision appealed from, sets forth the Court’s decision and the reason or reasons therefor, and resolves any outstanding motions in the case. It does not discuss the facts or elaborate on the Court’s reasoning.”); 6TH CIR. R. 36 (“Entry of Judgment - Dispositions in Open Court[.] The court may announce its decision in open court when the decision is unanimous and each judge of the panel believes that a written opinion would serve no jurisprudential purpose. The clerk will enter a signed written judgment in accordance with the panel’s decision from the bench. A person may pay a fee to obtain a recording of the decision announced from the bench.”); 9TH CIR. R. 36-1 (“Each written disposition of a matter before this Court shall bear under the number in the caption the designation OPINION, or MEMORANDUM, or ORDER.”); 10TH CIR. R. 36.1 (“Orders and judgments. The court does not write opinions in every case. The court may dispose of an appeal or petition without written opinion. Disposition without opinion does not mean that the case is unimportant. It means that the case does not require application of new points of law that would make the decision a valuable precedent.”); D.C. CIR. R. 36(d) (“Abbreviated Dispositions. The court may, while according full consideration to the issues, dispense with published opinions where the issues occasion no need therefor, and confine its action to such abbreviated disposition as it may deem appropriate, e.g., affirmance by order of a decision or judgment of a court or administrative agency, a judgment of affirmance or reversal, containing a notation of precedents or accompanied by a brief memorandum. If the parties have agreed to such disposition, they may so state in their briefs or may so stipulate at any time prior to decision. In any such case the court will promptly issue a judgment unless compelling reasons dictate otherwise.”).

33. See, e.g., *Peavey v. Holder*, No. 09-5389, 2010 WL 3155823, at \*1 (D.C. Cir. Aug. 9, 2010) (per curiam) (granting the agencies’ motion for summary affirmance where “[a]ppellant has not demonstrated that any agency ‘improperly withheld’ a record within its possession” and “the district court correctly concluded that the agencies conducted searches reasonably calculated to uncover all relevant documents”); *Lewis v. U.S. Dep’t of Justice*, No. 09-5225, 2010 WL 1632835, at \*2 (D.C. Cir. Apr. 7, 2010) (per curiam) (unpublished) (“The district court properly determined that [one of plaintiff’s requests] was beyond the scope of the litigation. Construing appellant’s complaint liberally, the complaint does not adequately notify the government that appellant sought to litigate [that request] in the district court, and appellant failed to move to amend his complaint.”); *Roman v. NSA*, 354 F. App’x 591, 592 (2d Cir. 2009) (unpublished) (summary order).

“affirmed,” even if the additional statement does not say much about the basis for affirmance.

The distinction also aids in understanding the development of published versus unpublished (or precedential versus non-precedential) opinions. During the 1960s and 1970s, much debate focused on whether courts should be permitted to produce “non-published” decisions, which was followed by debate on whether parties should be permitted to cite unpublished decisions. In the 1970s, if a case was not published, it was functionally equivalent to not existing, and thus, an unpublished decision was much less likely to be cited back to the court. But this has changed in the internet era.

### *B. The Rules Enabling Act and the Federal Rules of Appellate Procedure*

Beyond Rule 36 specifically, it is also important to understand the procedural authority under which federal courts of appeals operate and how the courts’ rules—both the FRAP and the local rules of the courts of appeals—are enacted. The argument that Congress forbade the use of Rule 36 affirmances in USPTO appeals does not account for the legal force of the FRAP. Moreover, the correct interpretation of § 144 must take account of significant issues about separation of powers and deference to the judiciary on procedural issues that are implicated when Congress purports to enact legislation prescribing court procedure, particularly in a key judicial role of substantive decision-making and opinion writing.

Article III courts are authorized by the Constitution but subject to control by Congress. Congress “may from time to time ordain and establish” “such inferior Courts” of the federal judiciary as it deems necessary.<sup>34</sup> From a constitutional perspective, Congress has arguably broad authority to limit what the judiciary can do and has the authority to eliminate courts of appeals, if it so chooses. Unsurprisingly, scholars have debated the extent of Congress’s authority over the judiciary once the judiciary is established.<sup>35</sup>

Not debated is the fact that Congress has delegated to the Article III branch much of the authority concerning judicial procedures.<sup>36</sup> With

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34. U.S. CONST. art. III.

35. For instance, a vast body of scholarship explores issues such as jurisdiction stripping. See, e.g., Richard H. Fallon, Jr., *Jurisdiction-Stripping Reconsidered*, 96 VA. L. REV. 1043, 1044–45 (2010); John Harrison, *The Power of Congress to Limit the Jurisdiction of Federal Courts and the Text of Article III*, 64 U. CHI. L. REV. 203, 204 (1997); Martin H. Redish, *Text, Structure, and Common Sense in the Interpretation of Article III*, 138 U. PA. L. REV. 1633, 1637 (1990).

36. See 28 U.S.C. §§ 2071–2075, 2077 (2018).

the Judiciary Act of 1789, Congress authorized the federal courts “to make and establish all necessary rules for the orderly conducting [of] business in the said courts, provided such rules are not repugnant to the laws of the United States.”<sup>37</sup> In 1934, Congress passed the Rules Enabling Act, which further delegated rulemaking authority to the judiciary.<sup>38</sup> In its current statutory form, chapter 131 of title 28, the Rules Enabling Act provides that the federal courts “may from time to time prescribe rules for the conduct of their business,” with the caveat that “[s]uch rules shall be consistent with Acts of Congress and rules of practice and procedure prescribed under section 2072 of this title [i.e., 28 U.S.C. 2072].”<sup>39</sup> Beyond chapter 131 of title 28, there are few, if any provisions in the United States Code that establish specific rules of procedure governing the federal courts of appeals.<sup>40</sup>

Sections 2073 and 2074 of the Rules Enabling Act codify the procedures by which the rules governing the judiciary are proposed and approved.<sup>41</sup> The Judicial Conference establishes various committees for “recommending rules to prescribed.”<sup>42</sup> After proposed rules are approved by the Judicial Conference, they are transmitted by the Supreme Court to Congress for final approval.<sup>43</sup> The proposed rules are approved and become effective if Congress takes no action on the proposed rules by a certain deadline.<sup>44</sup> In short, rules promulgated in accordance with the Rules Enabling Act, including the FRAP, have the approval of both the Supreme Court and Congress, and such rules are deemed to have the force of law, just as any other act of Congress.<sup>45</sup>

In addition to the FRAP, each circuit court can establish its own local rules.<sup>46</sup> The local rules are promulgated “by a majority of its judges in regular active service [and they] may, after giving appropriate public notice and opportunity for comment, make and amend rules governing its practice.”<sup>47</sup> Moreover, a court’s local rule “must be

37. Act of Sept. 24, 1789, ch. 20, § 17(b), 1 Stat. 73, 83 (1789).

38. Rules Enabling Act, Pub. L. No. 73-415, 48 Stat. 1064 (1934) (codified at 28 U.S.C. § 2072 (2018)).

39. 28 U.S.C. § 2071.

40. See, e.g., 28 U.S.C. §§ 41–49, 1651–2113 (chapter 3 of title 28 covers the organization, composition, and the like of the courts of appeals, and part V of title 28 covers Procedure).

41. See 28 U.S.C. §§ 2073, 2074.

42. 28 U.S.C. § 2073.

43. See 28 U.S.C. § 2704(a).

44. See *id.* (Congress retains power to reject Federal Rules submitted to it by the Supreme Court).

45. See *Hanna v. Plumer*, 380 U.S. 460, 473–74 (1965) (noting that Congress exercises its power over federal procedure through its delegation to the Supreme Court in the Rules Enabling Act).

46. See FED. R. APP. P. 47(a)(1).

47. *Id.*

consistent with—but not duplicative of—Acts of Congress and rules adopted under 28 U.S.C. § 2072.”<sup>48</sup> In general, a rule set forth in the FRAP generally displaces a law concerning the same issue, assuming that the rule does not impermissibly address a substantive right. By statute, the federal rules “shall not abridge, enlarge or modify any substantive right.”<sup>49</sup> Further, “[a]ll laws in conflict with such rules shall be of no further force or effect after such rules have taken effect.”<sup>50</sup> Based on the implementation process, the federal rules have a general presumption of validity.<sup>51</sup> No federal rule has ever been invalidated by the Supreme Court.<sup>52</sup> Furthermore, no court has ever suggested that FRAP 36 is invalid.

In contrast, the local rules do not receive the same approval of Congress or the Supreme Court. Local rules of appellate procedure are implemented entirely by the individual courts, such as the Federal Circuit. A local rule therefore does not receive the same presumption of validity, or at least not to the same degree, as a rule within the FRAP. There have been occasions where a local rule was held invalid.<sup>53</sup> Even so, no court has ever invalidated a local rule authorizing decision without reasons or summary dispositions. In other words, no court has ever invalidated a local rule that was implemented pursuant to FRAP 36, which expressly allows for decisions without reasons.

### *C. A Brief Historical Background of Appellate Opinion Writing in the Federal Courts*

The history of federal appellate courts and appellate opinion writing is far too extensive to explore in meaningful detail in this short

48. *Id.*

49. Rules Enabling Act, Pub. L. No. 73-415, 48 Stat. 1064 (1934) (codified at 28 U.S.C. § 2072).

50. § 2070(b); *accord* *Kenyon v. United States*, 676 F.2d 1229, 1231 (9th Cir. 1981) (“Thus Congress has stated that the rules of procedure enacted by the Supreme Court replace any laws in conflict therewith, as long as those laws do not involve substantive rights.”).

51. *See* *Shady Grove Orthopedic Assocs., P.A. v. Allstate Ins. Co.*, 559 U.S. 393, 422 (2010); *Sibbach v. Wilson & Co.*, 312 U.S. 1, 14–15 (1941); Stephen B. Burbank, *Hold the Corks: A Comment on Paul Carrington’s “Substance” and “Procedure” in the Rules Enabling Act*, 1989 DUKE L.J. 1012, 1041–42 (1989); Stephen B. Burbank, *The Rules Enabling Act of 1934*, 130 U. PA. L. REV. 1015, 1027 (1982); Paul D. Carrington, “Substance” and “Procedure” in the Rules Enabling Act, 1989 DUKE L.J. 281, 296 (1989); John Hart Ely, *The Irrepressible Myth of Erie*, 87 HARV. L. REV. 693, 697–98, 718 (1974).

52. *See* *Shady Grove Orthopedic Assocs.*, 559 U.S. at 407 (“Applying that test, we have rejected every statutory challenge to a Federal Rule that has come before us.”).

53. *See* *Ashland Chem. Inc. v. Barco Inc.*, 123 F.3d 261, 265 (5th Cir. 1997) (holding that the local rule of the Civil Justice Expense and Delay Reduction Plan of the Eastern District of Texas “is substantive in nature and therefore requires congressional approval as mandated by the Supreme Court in *Alyeska*”); *Rodgers v. U.S. Steel Corp.*, 508 F.2d 152, 164–65 (3d Cir. 1975) (holding that the Western District of Pennsylvania’s Local Rule 34(b) was invalid).

Article.<sup>54</sup> It is worthwhile, however, to provide at least a cursory overview of the history of the appellate opinion in federal courts. This history encompasses two aspects. First, the traditional practice of US courts has emphasized written opinions, but not to the exclusion of more concise means of disposing of appeals, including without any opinion at all. Second, the rules governing appellate procedure have likewise for many decades authorized the courts of appeals to dispose of appeals without issuing a written opinion.

### 1. Historical Practice of Appellate Opinion Writing

The norm in the US appellate judiciary has generally been to favor written opinions over oral opinions and over dispositions without any opinion, either written or oral. Nonetheless, oral opinions and dispositions without an opinion have been a common practice in American courts from the earliest days. Early in US history, many appellate decisions were decided from the bench without a written opinion since there was no requirement that federal courts issue written opinions.<sup>55</sup> The early Supreme Court did not issue written opinions in the process used today; rather, the Court's decisions were summarized and distributed by the early unofficial reporters, with varying degrees of accuracy and timeliness.<sup>56</sup> As one academic noted:

For a short time, in the nation's early years, the Supreme Court justices rendered their opinions orally, like their English counterparts. Eventually, however, the justices began to write out their opinions before reading them in court. And ultimately, the Court adopted the practice of having one judge write the opinion for the majority, without presenting it orally.<sup>57</sup>

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54. For literature on the history of opinions, see generally HON. RUGGERO J. ALDISERT, *OPINION WRITING* (2d ed. 2009); WILLIAM D. POPKIN, *EVOLUTION OF THE JUDICIAL OPINION: INSTITUTIONAL AND INDIVIDUAL STYLES* (2007); RICHARD A. POSNER, *REFLECTIONS ON JUDGING* (2013).

55. See Harrison, *supra* note 35, at 230 ("Neither the Constitution nor the Judiciary Act of 1789 provided for the delivery of written opinions, let alone their public distribution.").

56. The first two reporters of the Supreme Court were "unofficial" reporters and the reports varied in quality and accuracy. The first, Alexander Dallas, was the reporter for the landmark *Chisholm v. Georgia* decision in 1793, but he did not report the case until five years later after the Eleventh Amendment was adopted. See Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291, 1294 (1985); John V. Orth, *The Truth About Justice Iredel's Dissent in Chisholm v. Georgia (1793)*, 73 N.C. L. REV. 255, 262 (1994); Linda Greenhouse, *After 30 Years, Supreme Court History Project Turns a Final Page*, N.Y. TIMES (Dec. 30, 2006), <http://www.nytimes.com/2006/12/30/washington/30scotus.html> [<https://perma.cc/Z2NB-MAJZ>] (noting that "Mr. Dallas did not always get it exactly right" and that "he was sometimes flat-out wrong").

57. Suzanne Ehrenberg, *Embracing the Writing-Centered Legal Process*, 89 IOWA L. REV. 1159, 1184 n.151 (2004) (citing ROBERT J. MARTINEAU, *APPELLATE JUSTICE IN ENGLAND AND THE UNITED STATES: A COMPARATIVE ANALYSIS* 110 (1990)); accord John P. Kelsh, *The Opinion*

In 1817, Congress authorized the Supreme Court to appoint an official reporter of the Court's decisions.<sup>58</sup> In 1834, the Court issued an order requiring its opinions be delivered to the reporter, and the reporter would then return the opinions for filing with the clerk of the Court after publication.<sup>59</sup> Today, all Supreme Court opinions are issued in written form, but the Court continues its practice of orally announcing opinions from the bench on the day of issuance.<sup>60</sup>

The historical record suggests that written opinions quickly became the norm in the US judicial system.<sup>61</sup> In 1784, the Connecticut legislature passed the first law in the United States requiring that all judges must "reduce to Writing" the reasons for their judgments.<sup>62</sup> Other states followed suit, enacting similar "written opinion" requirements.<sup>63</sup> Eventually, and as noted below, many states incorporated "written opinion" requirements into their written constitutions.<sup>64</sup> Thus, "written opinions became the accepted practice within the first decades of the Nineteenth Century."<sup>65</sup> Even so, it was still acceptable in many courts to issue decisions without any opinion.<sup>66</sup> Indeed, as Professor Crouch notes, "no-opinion judgments have also remained popular throughout the nation's history."<sup>67</sup>

*Delivery Practices of the United States Supreme Court 1790-1945*, 77 WASH. U. L.Q. 137, 140, 142 (1999).

58. See Act of Mar. 3, 1817, ch. 16, 3 Stat. 376 (1817) (providing for a Supreme Court Reporter).

59. See Mark R. Kravitz, *Written and Oral Persuasion in the United States Courts: A District Judge's Perspective on Their History, Function, and Future*, 10 J. APP. PRAC. & PROCESS 247, 250 (2009) (citing G. EDWARD WHITE, *THE MARSHALL COURT AND CULTURAL CHANGE, 1815-1835*, at 389 (1988)).

60. See SUP. CT. R. 41.

61. See Ehrenberg, *supra* note 57, at 1184 ("Almost from the beginning, the written opinion has been a prominent feature of appellate review in the United States.").

62. Kravitz, *supra* note 59, at 249 (citing Acts & Laws of Conn. § 41, at 129 (Hudson & Goodwin 1796)); accord POPKIN, *supra* note 54, at 183-87.

63. Kravitz, *supra* note 59, at 249; see also *Houston v. Williams*, 13 Cal. 24, 25 (1859). Such efforts were not always met with approval by the judiciary. In *Williams*, Justice Stephen Field famously held as invalid an 1854 statute requiring courts to write opinions with reasons as "a most palpable encroachment upon the independence of [the judicial] department" and was therefore unconstitutional. *Williams*, 13 Cal. at 25. A substantially similar requirement was eventually incorporated into the California state constitution, thereby legislatively overruling the *Williams* decision. See *People v. Kelly*, 146 P.3d 547, 550-51 (Cal. 2006).

64. See sources cited *infra* note 117 and accompanying text.

65. ERWIN C. SURRENCY, *A HISTORY OF AMERICAN LAW PUBLISHING* 42 (1990); see also Peter M. Tiersma, *The Textualization of Precedent*, 82 NOTRE DAME L. REV. 1187, 1225 (2007) ("American judges at the close of the eighteenth century were already beginning to draft their opinions in writing . . .").

66. See, e.g., Philip Marcus, *Affirmance Without Opinion*, 6 FORDHAM L. REV. 212, 214 n.10 (1937) (reporting that, in 1934, the Court of Appeals of New York decided 195 cases with opinion and 455 cases without an opinion).

67. Crouch, *supra* note 1, at 566.

In the 1960s, judicial practice entered a period of significant change. Facing increasing caseloads, many courts responded by modifying the way they processed and disposed of appeals. For instance, “the federal Courts of Appeal began adopting procedures for disposing of cases without oral argument around the middle of the twentieth century.”<sup>68</sup> In addition, federal courts started disposing of a larger percentage of appeals without an opinion, implementing screening mechanisms and pre-appeal conferences, and permitting unpublished opinions.<sup>69</sup>

One specific change was the Fifth Circuit’s Local Rule 21, which was a local implementation of FRAP 36. Local Rule 21 was part of the Fifth Circuit’s broader implementation of a pre-argument screening program intended to address the growing caseload problem.<sup>70</sup> At the time, Fifth Circuit Local Rule 21 read:

Rule 21. Affirmance without opinion. When the court determines that any one or more of the following circumstances exists and is dispositive of a matter submitted to the court for decision: (1) that a judgment of the district court is based on findings of fact which are not clearly erroneous; (2) that the evidence in support of a jury verdict is not insufficient; (3) that the order of an administrative agency is supported by substantial evidence on the record as a whole; and the Court also determines that no error of law appears and an opinion would have no precedential value, the judgment or order may be affirmed or enforced without opinion.<sup>71</sup>

On its face, Fifth Circuit Rule 21 is functionally equivalent to the Federal Circuit’s current Rule 36. Much of the wording is nearly identical, and it specifies the circumstances under which the court could dispose of an appeal without providing a written opinion.

Daniel Meador described the Fifth Circuit’s rule as a “pioneering step” and that “apostles were eager to spread this gospel of the new

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68. Ehrenberg, *supra* note 57, at 1183–84 (citing ROBERT J. MEADOR, APPELLATE JUSTICE IN ENGLAND AND THE UNITED STATES 734 (1990)); accord JOE CECIL & DONNA STIENSTRA, FED. JUDICIAL CTR., DECIDING CASES WITHOUT ARGUMENT: A DESCRIPTION OF PROCEDURES IN THE COURTS OF APPEALS 2 (1987).

69. See, e.g., DONNA STIENSTRA, FED. JUDICIAL CTR., UNPUBLISHED DISPOSITIONS: PROBLEMS OF ACCESS AND USE IN THE COURTS OF APPEALS 1 (1985) (“In the search for more efficient ways to dispose of the expanding appellate caseload, the U.S. courts of appeals have, over the past decade, adopted a variety of procedural innovations designed to reduce the time judges spend on many cases.”).

70. See Griffin B. Bell, *Toward a More Efficient Federal Appeals System*, 54 JUDICATURE 237, 243–44 (1971); Charles R. Haworth, *Screening and Summary Procedures in the United States Courts of Appeals*, 1973 WASH. U. L.Q. 257, 264, 274–75 (1973) (“[T]he Fifth Circuit’s experience has confirmed the time-saving potential inherent in disposing of cases without written opinions.”); Daniel J. Meador, *Toward Orality and Visibility in the Appellate Process*, 42 MD. L. REV. 732, 732–24 (1983); Philip Shuchman & Alan Gelfand, *The Use of Local Rule 21 in the Fifth Circuit: Can Judges Select Cases of “No Precedential Value”?*, 29 EMORY L.J. 195, 199, 204 (1980).

71. 5TH CIR. R. 21 (affirmance without opinion currently allowed under 5TH CIR. R. 47.6).



appellate order.”<sup>72</sup> The Fifth Circuit put its Local Rule 21 to use. According to one report by former Solicitor General Wade McCree Jr., “during the fiscal year ending June 30, 1980, the Fifth Circuit disposed of 1,078 cases without oral argument” and “[a]bout one-third of those cases were disposed of in ‘opinions’ that said simply: ‘AFFIRMED. See Local Rule 21,’ or ‘ENFORCED. See Local Rule 21.’”<sup>73</sup>

Since then, other federal courts of appeals implemented local rules that are functionally equivalent to the Fifth Circuit’s then-Local Rule 21 and Federal Circuit Rule 36.<sup>74</sup> The First, Sixth, Ninth, Tenth, and D.C. Circuits all have current local rules expressly permitting affirmances without opinions.<sup>75</sup> In a 1990 article, then-Chief Judge Boyce Martin of the US Court of Appeals for the Sixth Circuit explained the utility of the court’s local rule that permitted disposition without an opinion: “[U]nder local Rule 19 the panel can dispose of a case in open court following oral argument if ‘each judge of the panel believes that no jurisprudential purpose would be served by a written opinion.’ We ‘Rule 19’ a case by announcing our decision from the bench.”<sup>76</sup>

In a footnote to the cited text, Chief Judge Martin explained that “Sixth Circuit Rule 19 supplements Federal Rule of Appellate Procedure 36, which discusses entry of judgment. Federal Rule of Appellate Procedure 36 provides for entry of judgment in all cases,

72. Meador, *supra* note 70, at 733 (citing Winslow Christian, *Using Prehearing Procedures to Increase Productivity*, 52 F.R.D. 55, 55–57 (1971)); accord *Murphy v. Houma Well Serv.*, 409 F.2d 804, 805 (5th Cir. 1969) (noting “the need for exercising judicial inventiveness to increase productivity and expedite disposition”); *Huth v. S. Pac. Co.*, 417 F.2d 526, 527 (5th Cir. 1969) (discussing the prescreening procedures before calendaring a case). Meador’s description also referred to the summary screening period that was part of the new procedures, which included Local Rule 21, implemented by the Fifth Circuit to address the increasing number of appeals. See Meador, *supra* note 70, at 732, 735.

73. Wade H. McCree, Jr., *Bureaucratic Justice: An Early Warning*, 129 U. PA. L. REV. 777, 790 (1981).

74. See David F. Johnson, “You Can’t Handle the Truth!”—Appellate Courts’ Authority to Dispose of Cases Without Written Opinions, 22 APP. ADVOC. 419, 419–20 (2010) (briefly summarizing federal and state appellate courts that expressly permit affirmance without opinion).

75. 1ST CIR. R. 36.0(a) (“The volume of filings is such that the court cannot dispose of each case by opinion. Rather it makes a choice, reasonably accommodated to the particular case, whether to use an order, memorandum and order, or opinion.”); 1ST CIR. R. 36.0(b)(2)(A) (“As members of a panel prepare for argument, they shall give thought to the appropriate mode of disposition (order, memorandum and order, unpublished opinion, published opinion.”); 6TH CIR. R. 36 (“The court may announce its decision in open court when the decision is unanimous and each judge of the panel believes that a written opinion would serve no jurisprudential purpose.”); 9TH CIR. R. 36-1 (“Each written disposition of a matter before this Court shall bear under the number in the caption the designation OPINION, or MEMORANDUM, or ORDER.”); 10TH CIR. R. 36.1 (“The court does not write opinions in every case. The court may dispose of an appeal or petition without written opinion.”); D.C. CIR. R. 36.

76. Boyce F. Martin, Jr., *In Defense of Unpublished Opinions*, 60 OHIO ST. L.J. 177, 186 (1999).

including those where ‘a judgment is rendered without an opinion.’”<sup>77</sup> Thus, the Sixth Circuit, like other circuits, held the uncompromising view that courts were not required to write an opinion in every case.<sup>78</sup>

Over the years, courts of appeals have disposed of many cases with single-word, Rule 36-type dispositions. One article summarized:

Although some Courts of Appeal, such as the Eleventh Circuit, have embraced the use of no-comment decisions, others, such as the D.C. and Seventh Circuits, have tried to keep one-word affirmations to a minimum. In 1998, the D.C. Circuit issued only a single one-word affirmation, and the Seventh Circuit issued only thirty-seven (compared to the Eleventh Circuit, which issued 502). And the Third Circuit, which once used summary orders as a case management tool, made a conscious decision to reverse that strategy. After issuing 404 no-comment decisions in 1998, the Circuit pledged to “virtually eliminate” such decisions as a means of case management because it “owed the bar more.” In the first four months of 1999, the Third Circuit issued only fifteen judgment orders without opinion, down 95% from the 280 in the same period in 1998. The majority of the Third Circuit’s no-comment opinions have been replaced with unpublished per curiam and memorandum opinions, which briefly explain the court’s rationale.<sup>79</sup>

Per an *American Bar Association Journal* article, the federal courts of appeals in 1998 disposed of 25,020 appeals on the merits.<sup>80</sup> Of those, “[a]bout 6 percent of the total were disposed of ‘without comment,’ meaning the court did not expound the law as applied in the case, or did not explain the reasons for the ruling.”<sup>81</sup> Interestingly, in 1998, 113 appeals were disposed of by an oral ruling from the bench—all in the US Court of Appeals for the Seventh Circuit.<sup>82</sup> The Sixth Circuit also has expressly permitted the disposition of appeals from the bench without an opinion.<sup>83</sup>

With the adoption of the local rules, as well as the increasing caseload of federal appeals courts, it was only a matter of time before the Supreme Court was asked to weigh in on the issue. And it did by concluding that summary affirmances and decisions without written opinions are permissible and within the “wide latitude” courts of

77. *Id.* at 186 n.38 (citing FED. R. APP. P. 36).

78. See Stephen Louis A. Dillard, *Open Chambers: Demystifying the Inner Workings and Culture of the Georgia Court of Appeals*, 65 MERCER L. REV. 831, 851–52 (2014) (“[T]he unfortunate reality is that Rule 36 is a crucial time-management tool for judges in addressing the court of appeals considerable caseload and the always-looming deadlines imposed by the two-term rule.”).

79. Ehrenberg, *supra* note 57, at 1184 n.155 (internal citations omitted).

80. See William C. Smith, *Big Objections to Brief Decisions*, AM. BAR ASS’N J., Aug. 1999, at 34, 36.

81. *Id.*

82. See *id.*; Wilfred Feinberg, *Unique Customs and Practices of the Second Circuit*, 14 HOFSTRA L. REV. 297, 317 n.62 (1986) (noting that the US Court of Appeals for the Second Circuit decided 34 percent of its cases by oral disposition in 1977).

83. See 6th CIR. R. 36.

appeals have in choosing “whether or how to write opinions.”<sup>84</sup> In *Taylor v. McKeithen*, the Supreme Court vacated and remanded a Fifth Circuit appeal in which the appeals court had issued a summary reversal without opinion.<sup>85</sup> The Supreme Court’s disapproval was limited to the Fifth Circuit’s reversing a trial court’s decision without an explanation. The Supreme Court vacated and remanded “[b]ecause this record does not fully inform us of the precise nature of the litigation and because we have not had the benefit of the insight of the Court of Appeals.”<sup>86</sup>

In doing so, the Supreme Court expressly accepted the propriety of the Fifth Circuit’s Local Rule 21, which is essentially equivalent to the Federal Circuit’s Rule 36. Specifically, the Court stated:

We, of course, agree that the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances. See Rule 21, Court of Appeals for the Fifth Circuit. But here the lower court summarily reversed without any opinion on a point that had been considered at length by the District Judge. Under the special circumstances of this case, we are loath to impute to the Court of Appeals reasoning that would raise a substantial federal question when it is plausible that its actual ground of decision was of more limited importance.<sup>87</sup>

Since *Taylor*, several courts of appeals have expressly rejected challenges to the disposition of appeals without an opinion.<sup>88</sup> The US Court of Appeals for the Second Circuit, following *Taylor*, rejected one such challenge and noted that, “[n]ot surprisingly, given its adoption of FRAP 36, the Supreme Court has seen no legal impediment to an appellate court’s decision of an appeal without opinion.”<sup>89</sup>

Another notable yet often overlooked point in the current debate about Rule 36 decisions is the Supreme Court’s repeated denial of cert petitions challenging Rule 36 affirmances. A denial of a writ of

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84. *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) (per curiam); see also *Conn. Bd. of Pardons v. Dumschat*, 452 U.S. 458, 472 (1981) (Stevens, J., dissenting) (“Judges often decide difficult and important cases without explaining their reasons, and I would not suggest that they thereby commit constitutional error.”).

85. See *Taylor*, 407 U.S. at 193–94.

86. *Id.* at 194.

87. *Id.* at 194 n.4 (emphasis added); see also *Lego v. Twomey*, 404 U.S. 477, 482 n.6 (1972) (reviewing and affirming the summary affirmance of the Seventh Circuit without comment on its summary nature).

88. See, e.g., *King v. Champion*, 55 F.3d 522, 526 (10th Cir. 1995); *Furman v. United States*, 720 F.2d 263, 264 (2d Cir. 1983) (“There is no requirement in law that a federal appellate court’s decision be accompanied by a written opinion.”); *United States v. Baynes*, 548 F.2d 481, 483 (3d Cir. 1977) (rejecting petitioner’s challenge to a judgment order filed pursuant to Rule 36 and noting that “[t]he Supreme Court has approved the practice of using judgment orders with this language in *Taylor*”); see also *Bernklau v. Principi*, 291 F.3d 795, 801 (Fed. Cir. 2002) (citing *Furman* approvingly and rejecting a challenge to a decision of Court of Appeals for Veterans claims).

89. *Furman*, 720 F.2d at 264.

certiorari may not speak to the merits of the issue presented, but in this instance, the Supreme Court has repeatedly declined, in so many instances over so many years, to revisit its decision in *Taylor*. One well-respected legal commentator has identified over a dozen petitions raising the identical issue or a very similar issue.<sup>90</sup> And petitions raising the very same issue continue to be raised.<sup>91</sup> The Supreme Court's refusal to revisit *Taylor* is consistent with the general understanding that appellate courts have no duty to write an opinion when affirming, absent a direct statutory requirement.<sup>92</sup>

The Court's lack of concern with Rule 36 affirmances may be reflected in the Court's use of its own version of a Rule 36 decision—namely the Court's "summary affirmance."<sup>93</sup> In this context, the Supreme Court's "summary affirmance" is, in effect, a "Rule 36-type affirmance." The Court issues a one-line statement, such as "the

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90. Hal Wegner, *Chet's Shoes; Ex parte Chan: Rule 36/Per Curiam Affirmance Practice*, <http://static1.1.sqspcdn.com/static/f/343607/16743345/1329929104303/ChetsShoesPerCuriamPractice.pdf?token=xkq46bwNKGMSJ0WJJx7owOEaCCc%3D> [https://perma.cc/344U-BZAU] (last visited Mar. 25, 2019) (identifying the following denied petitions as raising similar questions: Petition for Writ of Certiorari at i, *In re Bucknam*, 502 U.S. 1060 (1992) (No. 91-909); Petition for Writ of Certiorari at i, *Astronics Corp. v. Patecell*, 506 U.S. 967 (1992) (No. 92-396); Petition for Writ of Certiorari at i, *Intermedics, Inc. v. Ventritex Co.*, 513 U.S. 876 (1994) (No. 94-222); Petition for Writ of Certiorari at i, *U.S. Surgical Corp. v. Ethicon, Inc.*, 517 U.S. 1164 (1996) (No. 94-2081); Petition for Writ of Certiorari at i, *Pirkle v. Ogontz Controls Co.*, 516 U.S. 863 (1995) (No. 95-45); Petition for Writ of Certiorari at i, *Schoonover v. Wild Injun Prods.*, 516 U.S. 960 (1995) (No. 95-410); Petition for Writ of Certiorari at i, *Donaldson Co. v. Nelson Indus., Inc.*, 516 U.S. 1072 (1996) (No. 95-734); Petition for Writ of Certiorari at i, *Bowen v. Bd. of Patent Appeals & Interferences*, 530 U.S. 1263 (2000) (No. 99-1793); Petition for Writ of Certiorari at i, *Laberge v. Dep't of the Navy*, 541 U.S. 935 (2004) (No. 03-739); Petition for Writ of Certiorari at i, *Bivings v. Dep't of Army*, 541 U.S. 935 (2004) (No. 03-738); Petition for Writ of Certiorari at i–ii, *DePalma v. Nike, Inc.*, 549 U.S. 811 (2006) (No. 05-1360); Petition for Writ of Certiorari at i, *Hancock v. Dep't of Interior*, 549 U.S. 885 (2006) (No. 06-93); Petition for Writ of Certiorari at i, *City of Gettysburg, S.D. v. United States*, 549 U.S. 955 (2006) (No. 06-235); Petition for Writ of Certiorari at i, *Tehrani v. Polar Electro*, 556 U.S. 1236 (2009) (No. 08-1116); Petition for Writ of Certiorari at i, *Wayne-Dalton Corp. v. Amarr Co.*, 558 U.S. 991 (2009) (No. 09-260); Petition for Writ of Certiorari at i–ii, *Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, 562 U.S. 1201 (2011) (No. 10-777); Petition for Writ of Certiorari at 12, *White v. Hitachi, Ltd.*, 565 U.S. 825 (2011) (No. 10-1504); Petition for Writ of Certiorari at i, *Max Rack, Inc. v. Hoist Fitness Sys., Inc.*, 564 U.S. 1057 (2011) (No. 10-1384).

91. See, e.g., Petition for Writ of Certiorari at i, *Sec. People, Inc. v. Ojmar US, LLC*, 138 S. Ct. 2681 (2018) (No. 17-1443); Petition for Writ of Certiorari at i, *Stambler v. Mastercard Int'l Inc.*, 139 S. Ct. 54 (2018) (No. 17-1140); Petition for Writ of Certiorari at i, *In re Celgard, LLC*, 138 S. Ct. 1714 (2018) (No. 16-1526); Petition for Writ of Certiorari at i, *Concaten, Inc. v. AmeriTrak Fleet Sols., LLC*, 137 S. Ct. 1604 (2017) (No. 16-1109); Petition for Writ of Certiorari at i, *Shore v. Lee*, 137 S. Ct. 2197 (2017) (No. 16-1240); Petition for Writ of Certiorari at i, 126 S. Ct. 1723 (2016) (No. 16-1109); Petition for Writ of Certiorari at i, *Hyundai Motor Am., Inc. v. Clear with Computs., LLC*, 571 U.S. 1010 (2013) (No. 13-296).

92. See Mathilde Cohen, *When Judges Have Reasons Not to Give Reasons: A Comparative Law Approach*, 72 WASH. & LEE L. REV. 483, 527 n.254 (2015) ("Historically, there has never been an affirmative reason-giving requirement bearing on the federal courts.").

93. See, e.g., *Bluman v. Fed. Election Comm'n*, 565 U.S. 1104, 1104 (2012); see also cases cited *infra* note 95. Note that the Supreme Court's "summary affirmance" is functionally different than the appeals court's "summary affirmance" discussed above. See *supra* notes 31–33 and accompanying text.

judgment is affirmed.”<sup>94</sup> The Court has explained the limits of such a disposition:

We have often recognized that the precedential effect of a summary affirmance extends no further than “the precise issues presented and necessarily decided by those actions.” A summary disposition affirms only the judgment of the court below, and no more may be read into our action than was essential to sustain that judgment.<sup>95</sup>

Thus, the Supreme Court itself apparently believes that it has the power and authority to affirm lower court opinions without writing an opinion. There is little reason to think that the Court would think differently about an appeals court’s ability to do the same. The Court’s continued declinations of petitions challenging Rule 36 dispositions strongly suggests that the Court is unlikely to grant any future petitions on this issue.

## 2. Published Versus Unpublished Opinions

Another mechanism the courts devised for dealing with their growing caseloads was adopting what might be considered a middle road between one-word affirmances and fully drafted precedential opinions. In the 1960s, the federal courts of appeal started the era of “unpublished” or “non-precedential” opinions as a means of disposing of appeals.<sup>96</sup> In 1964, the Judicial Conference of the United States

94. See, e.g., *Bluman*, 565 U.S. at 1104 (“Judgment affirmed.”).

95. *Anderson v. Celebrezze*, 460 U.S. 780, 784 n.5 (1983) (citing *Ill. State Bd. of Elections v. Socialist Workers Party*, 440 U.S. 173, 182–83 (1979); *Mandel v. Bradley*, 432 U.S. 173, 176 (1977); *Fusari v. Steinberg*, 419 U.S. 379, 391–92 (1975) (Burger, C.J., concurring)).

96. See, e.g., Keith H. Beyler, *Selective Publication Rules: An Empirical Study*, 21 LOY. U. CHI. L.J. 1, 1 (1989) (“The great majority of this country’s intermediate appellate courts have selective publication rules that limit the publication and use of their decisions.”); Danny J. Boggs & Brian P. Brooks, *Unpublished Opinions and the Nature of Precedent*, 4 GREEN BAG 17, 19 (2000) (“The practical need to dispose of a certain percentage of cases on an expedited basis, as a simple docket management matter, flows from the stark reality of a relatively small federal appellate bench and an ever-increasing caseload.”); Meador, *supra* note 70, at 732–34; Hon. Philip Nichols, Jr., *Selective Publication of Opinions: One Judge’s View*, 35 AM. U. L. REV. 909, 913 n.13 (1986) (noting the increased publishing rate of opinions during his time on the bench and that “[t]his was when the Judicial Conference selective publication plans had been several years in effect. Without them, one can only guess what the figure might have been”); Chad M. Oldfather, *Writing, Cognition, and the Nature of the Judicial Function*, 96 GEO. L.J. 1283, 1288–89 (2008) (“In the eyes of at least some judges, the practical need to process cases is the only legitimate basis for truncating or dispensing with the opinion at the appellate level.”); William L. Reynolds & William M. Richman, *An Evaluation of Limited Publication in the United States Courts of Appeals: The Price of Reform*, 48 U. CHI. L. REV. 573, 577 (1981) [hereinafter Reynolds & Richman, *An Evaluation of Limited Publication*]; William L. Reynolds & William M. Richman, *Limited Publication in the Fourth and Sixth Circuits*, 1979 DUKE L.J. 807, 808 (1979) [hereinafter Reynolds & Richman, *Limited Publication*]; William L. Reynolds & William M. Richman, *The Non-Precedential Precedent-Limited Publication and No-Citation Rules in the United States Courts of Appeals*, 78 COLUM. L. REV. 1167, 1169–70 (1978) [hereinafter Reynolds & Richman, *The Non-Precedential Precedent-Limited Publication*]. The body of literature addressing “unpublished”

concluded that courts need only publish opinions of “general precedential value.”<sup>97</sup> Each circuit then implemented local plans or rules concerning published versus unpublished opinions.<sup>98</sup> By 1994, all federal courts and most state courts had adopted rules to permit unpublished opinions.<sup>99</sup>

Judges have had varying views on publication versus nonpublication, ranging from seeing no value in publishing every opinion, to recognizing the pragmatic tradeoffs, to asserting that there is no reasoned basis for selective publication.<sup>100</sup> The bar has perhaps been more uniformly against the idea of nonpublication of appellate opinions.<sup>101</sup>

Prior to the internet age, nonpublication had a significant and practical effect on limiting the accessibility of an “unpublished” opinion. If the opinion was not published, then it would not be included in an official report (e.g., *West’s Federal Reporter, 2d*). Because the “unpublished” opinion was not in the official reporter, other litigants and their attorneys would likely be unaware of the opinion, at least prior to the *Federal Appendix* reporter. The unpublished opinion was unlikely to create any “mischief” in the court’s jurisprudence. An unpublished opinion was the equivalent of a tree falling in the forest with no one around to hear it, except the specific parties involved.<sup>102</sup>

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opinions is too vast to summarize, or to even cite, all of the leading articles. Professors William Reynolds and William Richman authored several widely cited law review articles in the 1970s and 1980s that explored the various issues associated with the nonpublication of appellate opinions. In addition to the academic literature, the Federal Judicial Center has published several reports of nonpublication of opinions. See, e.g., ROBERT TIMOTHY REAGAN ET AL., FED. JUDICIAL CTR., CITING UNPUBLISHED OPINIONS IN FEDERAL APPEALS 5 (2005); STIENSTRA, *supra* note 69, at 2.

97. WARREN OLNEY III, ADMIN. OFFICE OF THE U.S. COURTS, REPORT OF THE PROCEEDINGS OF THE JUDICIAL CONFERENCE OF THE UNITED STATES, MARCH 16-17, 1964, at 11 (1964); accord THOMAS E. BAKER, RATIONING JUSTICE ON APPEAL: THE PROBLEMS OF THE U.S. COURTS OF APPEALS 127 (1994); REAGAN ET AL., *supra* note 96, at 1–4 (describing developments in nonpublication); STIENSTRA, *supra* note 69, at 5–14 (describing the history of the debate about nonpublication).

98. See, e.g., Reynolds & Richman, *Limited Publication*, *supra* note 96, at 808.

99. See Robert J. Martineau, *Restrictions on Publication and Citation of Judicial Opinions: A Reassessment*, 28 U. MICH. J.L. REFORM 119, 125 (1994).

100. Compare Nichols, *supra* note 96, at 916 (“The true reason behind the selective publication policy is that it is wrong to ask publishers to publish, libraries to collect, and scholars to read opinions that merely labor the obvious.”), with RICHARD A. POSNER, THE FEDERAL COURTS: CRISIS AND REFORM 122–25 (1985) (explaining that selective publication of opinions reflects the decision “between preparing but not publishing opinions in many cases and preparing no opinions in those cases,” which is like “giving the parties reasons for the decision . . . and not giving them reasons even though the appeal is not frivolous”).

101. See *supra* note 6 and accompanying text.

102. See *The Seventh Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, *supra* note 16, at 419 (statement of former Chief Justice Howard T. Markey) (“An unpublished opinion should be, to everybody but the parties, incomprehensible and useless. It’s certainly useless as precedent.”).

This changed, however, with the advent of electronic databases. Legal research service providers, such as LexisNexis and Westlaw, began including unpublished opinions in their databases at least since the mid-1990s. In 2001, Westlaw published the *Federal Appendix*, which was the “official” hardcopy version of the collection of unpublished opinions.<sup>103</sup> The *Federal Appendix* eviscerated any distinction between “published” and “unpublished” opinions. Indeed, then-Judge Samuel Alito explained in 2002 that unpublished opinions are, for all intents and purposes, published.<sup>104</sup>

Courts wrote unpublished, or non-precedential, opinions so the parties would gain at least some insight into the reasoning of the court. At the same time, though, many cases were straightforward decisions—at least in the judges’ view—and did not warrant the significant expenditure of time necessary to write a “published” or precedential opinion. In response, most courts implemented rules barring the citation of non-precedential opinions.<sup>105</sup>

The rules barring citation of non-precedential opinions were greeted with substantial criticism. Litigants initiated legal challenges to the rules.<sup>106</sup> The federal judiciary studied the impact of the rules.<sup>107</sup> Many law journal articles discussed the advantages and disadvantages of unpublished opinions and the rules barring citation of those opinions.<sup>108</sup> Eventually, the FRAP were amended so that the courts of appeal were not permitted to bar the citation of non-precedential opinions issued after January 1, 2007.

This brief survey highlights the evolution of the practices of the appellate courts. Just over seventy years ago, the general norm was that appeals usually ended with a written opinion—but not necessarily a detailed account of the reasoning. Oral decisions from the bench were also prevalent. As caseloads increased, the courts’ practices changed

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103. See REAGAN ET AL., *supra* note 96, at 23.

104. See *Unpublished Judicial Opinions: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 107th Cong. 5 (2002) [hereinafter *Hearing Before the Subcomm. on Courts*] (statement of Judge Alito) (explaining that the term “unpublished opinion” is “somewhat misleading” and that essentially all opinions “are published in any sense of the word”).

105. See REAGAN ET AL., *supra* note 96, at 2–4; David R. Cleveland, *Appellate Court Rules Governing Publication, Citation, and Precedential Value of Opinions: An Update*, 16 J. APP. PROC. 257, 257 (2015). For background, see *Anastasoff v. United States*, 223 F.3d 898, 900–01 (8th Cir. 2000); LAURAL L. HOOPER ET AL., *FED. JUDICIAL CTR., CASE MANAGEMENT PROCEDURES IN THE FEDERAL COURTS OF APPEALS* 30–34 (2d ed. 2011); REAGAN, *supra* note 96; Cleveland, *supra*, at 257; Lance A. Wade, *Honda Meets Anastasoff: The Procedural Due Process Argument Against Rules Prohibiting Citation to Unpublished Judicial Decisions*, 42 B.C. L. REV. 695, 695–96 (2001).

106. See *Anastasoff*, 223 F.3d at 899.

107. See HOOPER ET AL., *supra* note 105, at 31; REAGAN ET AL., *supra* note 96, at 1–4.

108. See, e.g., Cleveland, *supra* note 105, at 258–80; Wade, *supra* note 105 at 695.

and the courts introduced time-saving measures, including dispositions without opinion, decreased availability of oral argument, prescreening of appeals, summary disposition, and unpublished opinions. With the advent of electronic databases, unpublished opinions were unpublished in name only, and such decisions, which can now be cited back to the court (or lower tribunals), create minefields in the court's jurisprudence. A large percentage of cases are issued as nonprecedential or unpublished decisions.<sup>109</sup> They are just as readily available as precedential opinions. And, of course, courts have Rule 36 affirmances. Given the evolution of unpublished opinions, Rule 36 affirmances are, in one respect, akin to unpublished opinions of years past because, in the past, the general bar would remain unaware of the reasoning for an unpublished decision.

### III. THE FEDERAL CIRCUIT DOES NOT HAVE TO WRITE AN OPINION WITH REASONS IN EVERY APPEAL FROM USPTO

With that historical background and an overview of the applicable rules, this Article now turns to the specific legal question: Do § 144 and § 1071(a)(4) forbid the use of Rule 36 affirmances in USPTO appeals? Based on the statutory text, the historical context, the legislative history and purpose behind the amendments, and the governing rules of appellate procedure—as well as the deference traditionally granted to the judiciary—the only reasonable conclusion is that those statutory provisions do not prohibit the Federal Circuit from utilizing Rule 36 affirmances to dispose of appeals from the USPTO. Instead, the amendments were technical amendments instructing the court to transmit the court's mandate and written opinion to the USPTO.

#### A. *The Statutory Text Does Not Require the Federal Circuit to Write an Opinion—Only to Transmit an Opinion if Written*

To start, the full text of § 144 reads as follows:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.<sup>110</sup>

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109. See HOOPER ET AL., *supra* note 105, at 30.

110. 35 U.S.C. § 144 (2018) (emphasis added). For purposes of simplicity, the analysis here focuses its discussion on § 144 but applies equally to the trademark provision, 15 U.S.C. § 1071(a)(4) (2018). See 15 U.S.C. § 1071(a)(4) (employing language identical to 35 U.S.C. § 144).



In interpreting the statute, three phrases are dispositive in reaching the correct interpretation. First, what does “issue to the Director” mean? Does it mean that the court must affirmatively write an opinion, with reasons, or does it mean that the court must “transmit” to the USPTO Director the court’s mandate and written opinion, if any?

Second, what does “its mandate and opinion” mean, versus “a mandate and opinion?” In other words, by using “its,” did Congress recognize that, under the then-existing rules, the Federal Circuit was already required to issue a mandate under FRAP 41 and also had a local rule specifying that appeals would be disposed of by written opinion?

Third, what does the word “opinion” mean? Does it include a Rule 36 affirmance? If so, then a Rule 36 affirmance satisfies the court’s obligation even under the erroneous argument that § 144 requires a written opinion in every appeal from the USPTO.

The statute lends itself to at least three conceivable interpretations. First, the statute could require the court to write an opinion with reasons and bases in every appeal from the USPTO, as Crouch and others argue.<sup>111</sup> Second, the statute could be using a broader definition of the term “opinion”—so broad that a Rule 36 affirmance constitutes an opinion for purposes of the statute. Third, the statute can be understood as a command to the court to transmit to the agency (i.e., “to the Director”) the court’s mandate and opinion—if written—but the statute does not expressly require the court to write an opinion in every USPTO appeal. This Section examines each of these. First, this Section examines and contrasts the “transmittal” interpretation and “mandatory written opinion with reasons” interpretation.<sup>112</sup> Next, it explores the interpretation that a Rule 36 order constitutes an opinion for the purposes of the statute.

### 1. “Transmittal” Versus “Mandatory Written Opinion”

The first interpretation, which this Article refers to as the “transmittal” interpretation, reads the statute as a command to the Federal Circuit to transmit its mandate and its opinion, if any, to the USPTO Director upon the court’s final determination in the appeal.

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111. See, e.g., Crouch, *supra* note 1, at 562.

112. The Author calls this interpretation the “mandatory written opinion theory,” but one interesting twist should be noted. Even if one were to accept the thesis that the statutes preclude Rule 36 affirmances in USPTO appeals, that thesis still does not require a *written* opinion. The statute says nothing about “written.” Perhaps the court could issue an oral opinion from the bench, with the recording (or transcription thereof) being sent to the USPTO Director and therefore complying with the “issued to the Director” requirement. Would we want the court to issue decisions from the bench right after oral argument? The Author explores this further possibility later in this Article. See *infra* Section I.C.1.

This is an instruction to the court of what it must do once it decides the case. The interpretation recognizes that the text itself does not expressly address whether a written opinion must be prepared by the court in every case.

In contrast, the second interpretation is the “mandatory written opinion” interpretation. This interpretation views the statute as a command to the Federal Circuit that every USPTO appeal must conclude with a written opinion that provides some reasoning for the court’s ultimate decision. If the prepositional phrase in the relevant language is dropped, the text reads “the court shall issue . . . its mandate and opinion.”<sup>113</sup> Read this way, the language appears to command the Federal Circuit to issue an opinion in all appeals from the USPTO.

First, from a purely textual perspective, the statute does not expressly command or direct the Federal Circuit to actually write an opinion. The statute uses the verb “issue.” The word “issue” means to “[s]upply or distribute (something).”<sup>114</sup> It does not instruct the court to write or produce anything. Accordingly, on its face, the statute is an instruction to send the mandate and opinion to the USPTO—assuming those two documents exist.

True, the command to “issue” a mandate and opinion may inferentially lead one to conclude that an opinion must be written for it to be issued. One could interpret the term “issue” to include, in its operational meaning, the act of creating or writing. Thus, perhaps one interpretation of “issue” is that the court must “write and send” the mandate and opinion to the USPTO. Alternatively, the word “issue” can be interpreted merely as sending, and it implies a predicate act of writing the opinion. Then, the predicate act of writing the opinion must be inferred to be mandatory. But this interpretation is at best an inferential conclusion. The text does not directly command the court to *write* an opinion.<sup>115</sup>

Professor Crouch acknowledges the possibility of the interpretation this Article calls the “transmittal” interpretation. He writes that “a *conceivable* interpretation of the statute would require issuance of the opinion only if such an opinion exists—rendering the requirement merely an illusory request.”<sup>116</sup> This Article argues that the text is neither a requirement to write an opinion nor an illusory request.

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113. 35 U.S.C. § 144.

114. *Issue*, OXFORD LIVING DICTIONARIES, <https://en.oxforddictionaries.com/definition/issue> [<https://perma.cc/9D4Z-XJJ2>] (last visited Mar. 25, 2019).

115. 35 U.S.C. § 144. As explained below, FRAP 41 controls the issuance of the court’s mandate. See *supra* notes 128–130 and accompanying text.

116. Crouch, *supra* note 1, at 576.

Rather, the text of the statute instructs the court what to do once it has decided the case and, in part, if it has written an opinion—not on the issue of whether the court must write an opinion.

Had Congress intended to require the Federal Circuit to write opinions in all appeals from the USPTO, it could have used direct language instructing the court to do so. For example, Congress could have written that “the court shall write an opinion and issue the mandate and opinion to the Director.”

Congress could have also employed language employed by several states in their constitutions and laws instructing state courts to produce written opinions with reasons. Several states have constitutional mandates to their courts requiring the opinions of those courts be issued in writing.<sup>117</sup> For instance, under the California constitution, the California Supreme Court and appellate courts must make decisions “in writing with reasons stated.”<sup>118</sup> The inclusion of the language “with reasons stated” is important because the phrase specifically requires the California courts to provide an opinion that is more than simply a Rule 36-type affirmance. In these instances, the states have made the policy choice imposing a “written opinion with reasons” requirement on their courts, but that same policy choice is not evident from the language of § 144 and § 2701(a)(4).

Had Congress wanted to impose a mandatory written opinion requirement, it was aware of language that would have spoken more directly to the issue of a written opinion.<sup>119</sup> When Congress created the

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117. See, e.g., ARIZ. CONST. art. VI, § 2 (“The decisions of the court shall be in writing and the grounds stated.”); CAL. CONST. art. VI, § 14 (“Decisions of the Supreme Court and courts of appeal . . . shall be in writing with reasons stated.”); MD. CONST. art. IV, § 15 (Supreme Court determinations must be in “an opinion, in writing”); MICH. CONST. art. VI, § 6 (“Decisions of the supreme court . . . shall be in writing and shall contain a concise statement of the facts and reasons for each decision and reasons for each denial of leave to appeal.”); OHIO CONST. art. IV, § 2(C) (“The decisions in all cases in the Supreme Court shall be reported, together with the reasons therefor.”); WASH. CONST. art. IV, § 2 (“In the determination of causes all decisions of the [supreme] court shall be given in writing and the grounds of the decision shall be stated.”); W. VA. CONST. art. VIII, § 4 (“[E]very point fairly arising upon the record shall be considered and decided; the reasons therefor shall be concisely stated in writing and preserved with the record . . .”).

118. CAL. CONST. art. VI, § 14; see also Max Radin, *The Requirement of Written Opinions*, 18 CAL. L. REV. 486, 486 (1930).

119. For the present discussion, the Author accepts that the 1893 and 1929 acts require an opinion that is more than a Rule 36-type affirmance. It is not entirely clear, however, whether the statute requires the court to *write an opinion with its reasons*, as opposed to merely requiring the court to reduce its judgment to writing instead of issuing a ruling from the bench, if it chose to provide reasons for the decision. Further, the requirement in the 1893 Act that “the opinion of the said court of appeals in every case shall be rendered in writing” was a general requirement for the new court and not specific for patent cases. Act of Feb. 9, 1893, ch. 74, § 10, 27 Stat. 434, 436 (1893). Specifically, section 9 of the Act established jurisdiction for appealing from the Patent Commissioner. § 9, 27 Stat. at 436. In contrast, the requirement for written opinions was set forth in section 10: “That the opinion of the said court of appeals in every case shall be rendered in writing, and shall be filed in such case as a part of the record thereof.” § 10, 27 Stat. at 436.

CCPA from the old US Court of Customs Appeals in 1929, it transferred jurisdiction over appeals from the Patent Office to the new CCPA.<sup>120</sup> In the legislation, Congress instructed the following:

The opinion of the Court of Customs and Patent Appeals in every case on appeal from decision of the Patent Office shall be rendered in writing, and shall be filed in such case as part of the record thereof, and a certified copy of said opinion shall be sent to the Commissioner of Patents and shall be entered of record in the Patent Office.<sup>121</sup>

Even earlier in 1893, Congress similarly created the (former) D.C. Circuit—which, under the same legislation, was granted jurisdiction over appeals from the Patent Office; Congress directly instructed that “the opinion of the said court of appeals in every case shall be rendered in writing, and shall be filed in such case as a part of the record thereof.”<sup>122</sup> Thus, there was clear federal legislative precedent for statutory language requiring a court to render its opinion in writing.

In 1984, if Congress wanted to impose (or re-impose) a requirement that the Federal Circuit could not use Rule 36 affirmances for USPTO appeals, it could have at least used the language it used for the CCPA prior to 1952.<sup>123</sup> The clear textual differences between § 144 and the 1893 and 1929 statutes are enough to demonstrate that the plain text of § 144 does not require the Federal Circuit to write an opinion with reasoning in every USPTO appeal.<sup>124</sup>

In addition, the use of the term “its” in the phrase “its mandate and opinion” in § 144 further indicates that the amendment did not add any requirement of creating a mandate and an opinion in every USPTO appeal. In fact, the use of “its” almost certainly reflects the fact that, at the time, the Federal Circuit produced both an opinion and a mandate in every appeal. There was no need for Congress to impose any such requirement.<sup>125</sup>

Specifically, in the Federal Circuit’s first set of local rules, Federal Circuit Rule 18(a) stated, in part, that the “[d]isposition of appeals shall be with a published opinion or an unpublished opinion.”<sup>126</sup> This rule remained in place until July 15, 1985, when the court amended it to read, “Disposition of appeals may be announced in a

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120. Act of Mar. 2, 1929, ch. 488, §§ 1–2, 45 Stat. 1475, 1475–76 (1929).

121. § 3, 45 Stat. at 1476.

122. § 10, 27 Stat. at 436.

123. See Act of Mar. 2, 1929, ch. 488, § 3, 45 Stat. 1475 (1929).

124. See 35 U.S.C. § 144 (2018); Act of Feb. 9, 1893, ch. 74, § 10, 27 Stat. 436 (1893); Act of Mar. 2, 1929, ch. 488, § 3, 45 Stat. 1475 (1929).

125. See 35 U.S.C. § 144.

126. FED. CIR. R. 18(a) (Feb. 1, 1984).

published or unpublished opinion or order.”<sup>127</sup> Thus, from 1984 to 1986, the court had decided, as a question of court-specific policy, to provide an opinion, either published or unpublished, in every appeal.

Similarly, the court has long been required to prepare a mandate in every appeal. FRAP 41 requires a court to issue its mandate within a specified timeframe.<sup>128</sup> The mandate establishes what the lower tribunal can consider on remand.<sup>129</sup> FRAP 41’s requirement to issue a mandate was already in effect at the time Congress passed the amendment to § 144 in 1984. Congress therefore had no reason to command the Federal Circuit to produce its mandate, as FRAP 41 already controlled. The “mandatory written opinion” view of § 144 therefore leads to an incorrect construction that would render some of the statute’s language superfluous to the preexisting FRAP 41.<sup>130</sup>

When § 144 is understood as a transmittal directive, the inclusion of the “its mandate and opinion” requirement is understandable. The statute simply instructs the court to send the mandate and opinion to the agency. When this amendment was enacted, Congress and the court understood that both a mandate and an opinion were prepared for every appeal, and there was no need to enact a superfluous amendment.

The transmittal interpretation § 144 disposes of the argument that “[i]t would be absurd to interpret this provision as requiring neither a mandate nor an opinion because without either, the case is never decided.”<sup>131</sup> The transmittal interpretation does not lead to such an “absurd” view because FRAP 41 already requires the court to issue a mandate. Section 144 does not need to be interpreted as directing the court to prepare a mandate because that directive pre-existed in FRAP 41. Interestingly, if one accepts the mandatory written opinion interpretation of § 144, the logical extension is that the Federal Circuit had no obligation to prepare a mandate. That conclusion is incorrect.

127. See *id.*; FED. CIR. R. 18(a) (July 15, 1985). Of course, the Federal Circuit was within its authority to later change the old Rule 18(a) and enact a new local rule permitting decisions without opinions, pursuant to FRAP 36. See FED. R. APP. P. 36.

128. See FED. R. APP. P. 41(b) (“When Issued. The court’s mandate must issue 7 days after the time to file a petition for rehearing expires, or 7 days after entry of an order denying a timely petition for panel rehearing, petition for rehearing en banc, or motion for stay of mandate, whichever is later.”).

129. See *Sibbald v. United States*, 37 U.S. 488, 492 (1838); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 576 F.3d 1348, 1356 (Fed. Cir. 2009).

130. See *Hibbs v. Winn*, 542 U.S. 88, 101 (2004) (“A statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant . . .”) (quoting 2A N. SINGER, STATUTES AND STATUTORY CONSTRUCTION § 46.06 (rev. 6th ed. 2000)); *Corley v. United States*, 556 U.S. 303, 314 (2009) (describing the anti-superfluous canon as “one of the most basic interpretive canons”).

131. Crouch, *supra* note 1, at 578.

The important point is that, when the amendment to § 144 was proposed, the Federal Circuit had decided, as court policy, to issue opinions in all of its appeals, per Federal Circuit Rule 18(a).<sup>132</sup> The court also always issued mandates for all appeals per FRAP 41. This explains why the statutory amendment refers to “*its* mandate and opinion.”<sup>133</sup> Congress understood that the court’s practice was to provide a mandate and opinion in every case.

Other points warrant a response in the context of the statute’s text. The amendments to § 144 and § 1071(a)(4) were proposed in the shadow of FRAP 36—which expressly authorized courts, including the Federal Circuit—to decide appeals without an opinion. Any interpretation of the statutory text must be made with the understanding that, since 1967, Congress had expressly authorized all courts of appeals to dispose of appeals without writing an opinion. Having been promulgated pursuant to the Rules Enabling Act and being a procedural rule, FRAP 36 has the force of law, just as any other federal statute. To accept the “mandatory written opinion” interpretation would require the conclusion that Congress impliedly repealed the availability of FRAP 36 for the Federal Circuit in patent and trademark appeals from the USPTO. Thus, one must apply the “implied repeal” doctrine when construing § 144 and § 1071(a)(4).<sup>134</sup>

But implied repeal arguments are rarely favored when construing statutes.<sup>135</sup> As the Supreme Court explained in *United States v. Borden Co.*, “[i]t is a cardinal principle of construction that repeals by implication are not favored. When there are two acts upon the same subject, the rule is to give effect to both if possible.”<sup>136</sup>

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132. FED. CIR. R. 18(a) (July 15, 1985).

133. 35 U.S.C. § 144 (2018).

134. See, e.g., *Rodriguez v. United States*, 480 U.S. 522, 524 (1987); *Wood v. United States*, 41 U.S. 342, 362–63 (1842).

135. See, e.g., *United States v. Madigan*, 300 U.S. 500, 506 (1937) (“[T]he modification by implication of the settled construction of an earlier and different section is not favored.”); *Samuels v. District of Columbia*, 770 F.2d 184, 194 n.7 (D.C. Cir. 1985) (“[R]epeals [by implication] are strongly disfavored on the ground that Congress is normally expected to be aware of its previous enactments and to provide a clear statement of repeal if it intends to extinguish an extant remedy.”); *Chem. Mfrs. Ass’n v. EPA*, 673 F.2d 507, 512 (D.C. Cir. 1982) (“[A]n argument of implied repeal [is] an argument that rarely succeeds . . . .”); ANTONIN SCALIA & BRYAN GARNER, *READING LAW: THE INTERPRETATION OF LEGAL TEXTS* 331 (2012) (“A clear, authoritative judicial holding on the meaning of a particular provision should not be cast in doubt and subjected to challenge whenever a related though not utterly inconsistent provision is adopted in the same statute or even in an affiliated statute.”).

136. *United States v. Borden Co.*, 308 U.S. 188, 198 (1939).

Generally, implied repeal occurs only when the two statutes are irreconcilably inconsistent or “positive[ly] repugnant.”<sup>137</sup>

Here, § 144 and Rule 36 are not plainly repugnant because, under the “transmittal” interpretation, § 144 does not require an opinion with reasons to be written—only that one be transmitted to the USPTO if written—and thus § 144 does not impliedly repeal the availability of Rule 36 to the Federal Circuit for USPTO appeals. The statutory text is lacking the strong evidence necessary to conclude that Congress intended to limit the scope of FRAP 36, and limit it in a way that was applicable only to the Federal Circuit and only in USPTO appeals. It would have been highly unusual, fifty years after the enactment of the Rules Enabling Act, for Congress to include an amendment in a “technical amendments” bill that significantly limited the scope of a previously enacted rule of appellate procedure, without proceeding through the normal rulemaking process.

Second, proponents of the “mandatory written opinion” theory analogize § 144 and § 1071(a)(4) to Federal Rule of Civil Procedure 52.<sup>138</sup> Rule 52 requires district judges to “find the facts specially and state its conclusions of law separately.”<sup>139</sup> From a textual standpoint, the analogy is misplaced. If anything, it reinforces the conclusion that § 144 and § 1071(a)(4) do not require a written opinion. Rule 52 does not require the trial court’s findings of facts and conclusions of law to be written as an opinion by the court. Rather, the court’s findings “may be stated on the record after the close of the evidence.”<sup>140</sup> The purpose of Rule 52 perhaps supports the normative argument that an appeals court’s opinion should always be in writing with its reasoning explained, but the present question is the positive question of what the law requires under § 144 and § 1071(a)(4). As a further distinguishing point, one may argue that because a party has the right to appeal a trial court decision, there exists a much stronger need for detailed factual findings and legal conclusions in trial court decisions. Conversely, because only a small percentage of appellate decisions are reviewed by

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137. *United States v. Batchelder*, 442 U.S. 114, 122 (1979) (“[T]he legislative intent to repeal must be manifest in the ‘positive repugnancy between the provisions.’” (quoting *Borden*, 308 U.S. at 199)); *Posadas v. Nat’l City Bank of N.Y.*, 296 U.S. 497, 503–04 (1936).

138. *Crouch*, *supra* note 1, at 564–66.

139. *See* FED. R. CIV. P. 52(a)(1) (“In General. In an action tried on the facts without a jury or with an advisory jury, the court must find the facts specially and state its conclusions of law separately. The findings and conclusions may be stated on the record after the close of the evidence or may appear in an opinion or a memorandum of decision filed by the court. Judgment must be entered under Rule 58.”).

140. *See id.* at 52(a); 9C CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 2571 (3d ed. 2008) (explaining that the 1948 and 1983 amendments to Rule 52(a) make clear that findings and conclusions are not necessary when deciding most motions and that the trial judge orally make findings and conclusions and have them recorded in open court).

the Supreme Court, the need for a detailed opinion— particularly in the case of an affirmance—is substantially reduced. Overall, analogizing to Rule 52 does not lend much support to the “mandatory written opinion” interpretation.

Another point raised in support of the mandatory opinion interpretation is that it appears that the “appellate panels do create and exchange informal opinions—either oral or written—of the cases that eventually lead to the R.36 judgments.”<sup>141</sup> That argument misunderstands the actual deliberative process by the court. In general, there is no “opinion” drafted for a case decided via Rule 36. An opinion is usually written only after the panel has voted on how to rule on the case and decided to write an opinion, assigning one judge on the panel as the lead author of the opinion.<sup>142</sup> No doubt, the panel discusses the case at the conference immediately following oral argument, but there can be no argument that the judges’ deliberation during conference would or should constitute an opinion for the court.

As Professor Crouch’s article notes, Judge Reyna is reported to have remarked that, “when a Rule 36 affirmance is delivered the court has done 90% of the work needed for a written opinion.”<sup>143</sup> Assuming it to be an accurate report, Judge Reyna’s remark likely refers to the percentage of decision-making work performed in reaching the decision—but not the additional drafting and reviewing time needed to publish an opinion. The judges and their clerks spend many hours reading the briefs and the record, conducting additional legal research, and discussing the issues on appeal, all without writing an opinion. Once the court has heard oral argument, 90 percent—perhaps more—of the decisional work has been done. But to write a carefully worded opinion requires a significant amount of additional time. In the end, however, this consideration is better left for the normative issues of what should be the best practice of the Federal Circuit in deciding USPTO appeals.<sup>144</sup>

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141. Crouch, *supra* note 1, at 577–78.

142. See, e.g., U.S. COURT OF APPEALS FOR THE FED. CIRCUIT, INTERNAL OPERATING PROCEDURES 18 (2008), <http://www.cafc.uscourts.gov/sites/default/files/IOPs122006.pdf> [<https://perma.cc/9E26-WTLU>]; 9TH CIR. R. 8.

143. Crouch, *supra* note 1, at 578 (internal quotation marks omitted); see also Peter Harter & Gene Quinn, *Rule 36: Unprecedented Abuse at the Federal Circuit*, IPWATCHDOG (Jan. 12, 2017), <http://www.ipwatchdog.com/2017/01/12/rule-36-abuse-federal-circuit/id=76971/> [<https://perma.cc/4WYN-FMQP>].

144. See *infra* Section III.A.2.



## 2. The Term “Opinion” Includes “Rule 36 Affirmance”

A second conceivable interpretation of the statute focuses on the meaning of the term “opinion.” One conceivable interpretation is that the term “opinion,” as used in § 144, means simply any written document that states the court’s decision, regardless of whether the written decision provides the court’s reasoning or bases for its decision. If the term “opinion” includes a Rule 36 affirmance, then there obviously is no concern about the Federal Circuit’s use of Rule 36 affirmances in USPTO appeals, because the plain language of the statute would authorize them.

A purely textual approach offers some support for this interpretation of “opinion.” An opinion can be any written document that captures the court’s decision. A Rule 36 affirmance does state that the decision is affirmed. And there is also reason to distinguish a bare-bones “opinion” from an “opinion with reasons or bases,” as several state constitutions have done.<sup>145</sup>

Indeed, on occasion, Rule 36 affirmances have been referred to as “opinions.”<sup>146</sup> In essence, this interpretation posits that the statute is using the term “opinion” to merely refer to the document that captures the court’s decision.

That being said, this interpretation of § 144 has hurdles. As Professor Crouch explains, the term “opinion” has a generally accepted meaning. Indeed, the term “opinion” is understood by the Federal Circuit itself as “[a] court’s written statement explaining its decision in a given case, . . . including the statement of facts, points of law, rationale, and dicta.”<sup>147</sup> The Federal Circuit has more frequently used the term “opinion” in a manner distinguishing it from a Rule 36 affirmance.<sup>148</sup> The weight of persuasiveness appears to fall on the side of the term “opinion” as including something more than a one-word order that states “affirmed.”

Of course, that conclusion only begs the question of how much is required in order for a court’s order to rise to the level of a “written opinion.” If § 144 does actually require the Federal Circuit to write an

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145. See, e.g., ARIZ. CONST. art. VI, § 2; CAL. CONST. art. VI, § 14; MD. CONST. art. IV, § 15; MICH. CONST. art. VI, § 6; OHIO CONST. art. IV, § 2(C); WASH. CONST. art. IV, § 2; W. VA. CONST. art. VIII, § 4.

146. See *Barco N.V. v. Tech. Props. Ltd.*, No. 5:08-cv-05398-JF/HRL, 2010 U.S. Dist. LEXIS 99668, at \*3 (N.D. Cal. Sept. 10, 2010) (“[T]he Federal Circuit affirmed the judgment in a Rule 36 opinion.” (emphasis added) (citing *Tech. Props. Ltd. v. Arm, Ltd.*, 276 F. App’x 1019 (Fed. Cir. 2008) (unpublished))).

147. *Opinion*, BLACK’S LAW DICTIONARY (10th ed. 2014).

148. See U.S. COURT OF APPEALS FOR THE FED. CIRCUIT, *supra* note 142, at 19; Crouch, *supra* note 1, at 573–75.

opinion in every appeal from the USPTO, would a one-paragraph opinion suffice? As explained below, these questions are a further reason to reject the argument that Congress intended to micromanage the Federal Circuit's opinion writing.

*B. The Historical Context of Section 144 Does Not Support a Mandatory Written Opinion with Reasons Requirement*

In addition to the specific legislative history, it is useful to understand the broader historical context. Courts routinely consider the "historical context" when construing statutory text.<sup>149</sup> Indeed, the Supreme Court undertook this historical context analysis in *Bilski v. Kappos*, where the Court ruled on the scope of patent-eligible subject matter under 35 U.S.C. § 101.<sup>150</sup> The historical context of the statute is particularly important because the stated purpose of the 1984 amendment was to make the procedure for USPTO appeals consistent with other types of appeals.<sup>151</sup>

The historical context adds further support to the argument that § 144 and § 1071(a)(4) do not impose a written opinion requirement on the Federal Circuit. By 1984, it was long established that federal appellate courts did in fact dispose of appeals without an opinion.<sup>152</sup> As noted above, for example, the Fifth Circuit had implemented its Local Rule 21.<sup>153</sup> The Supreme Court approved summary affirmances without an opinion.<sup>154</sup> It would have been extraordinary for Congress to impose a novel requirement on the Federal Circuit with language that does not expressly require the court to write an opinion.

This historical context is also consistent with the amendment to the applicable statute in the Patent Act of 1952 (1952 Act).<sup>155</sup> The 1952

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149. See, e.g., *Sandifer v. U.S. Steel Corp.*, 571 U.S. 220, 229 (2014) (rejecting petitioners' statutory construction because it was "incompatible with the historical context surrounding" the passage of the legislation); *Kiobel v. Royal Dutch Petroleum Co.*, 569 U.S. 108, 124 (2013) ("Nothing about this historical context suggests that Congress also intended federal common law under the ATS to provide a cause of action for conduct occurring in the territory of another sovereign.").

150. See *Bilski v. Kappos*, 561 U.S. 593, 601–02, 626 (2010).

151. See *infra* Section III.D.

152. See *supra* notes 68–69 and accompanying text; Richard A. Posner, *Will the Federal Courts of Appeals Survive until 1984?: An Essay on Delegation and Specialization of the Judicial Function*, 56 S. CAL. L. REV. 761, 764–65 (1983) (noting that "disposing of a bigger fraction of appeals without a published opinion" is a possible response to dealing with a "federal appellate caseload crisis").

153. See *infra* Section I.C.1.

154. See *id.*

155. Act of July 15, 1952, Pub. L. No. 82-593, 66 Stat. 792, 802–03 (codified as amended at 35 U.S.C. § 144 (1952)) ("The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the

Act eliminated the prior statutory language, which imposed a written opinion requirement. Instead of instructing that “the opinion of the Court . . . shall be rendered in writing” from 1929, the 1952 Act’s command was that “the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.”<sup>156</sup>

The 1952 amendment is understandable when placed into historical context. The amendment occurred after the passage of the Rules Enabling Act of 1934. By that point, Congress had granted, to the Supreme Court, “the power to prescribe, by general rules, for the district courts of the United States and for the courts of the District of Columbia, the forms of process, writs, pleadings, and motions, and the practice and procedure in civil actions at law.”<sup>157</sup> When Congress revised the patent laws in 1952, Congress may have seen no need to codify a specific requirement about court procedure. Congress had already transferred to the judiciary the broad responsibility of selecting and implementing rules governing judicial procedure.

The CCPA used a summary affirmance mechanism to dispose of appeals that lacked merit. For example, in *General Electric Co. v. United States*, the court’s opinion consisted of two sentences: “We agree with the decision of the Court of International Trade that the imported electronic and amplifier packs were correctly classified in [the Tariff Schedules of the United States], items 685.23 and 684.70, respectively. Accordingly, we affirm the judgment below and adopt the trial court’s opinion as our own.”<sup>158</sup> In another, the CCPA summarized the Trademark Trial and Appeal Board’s finding with two sentences.<sup>159</sup> Then the CCPA presented the sum and substance of its analysis: “We agree with, approve and adopt the opinion of the board, and its decision is affirmed.”<sup>160</sup> While such summary affirmances were not the norm for the CCPA, they evidence the fact that the court did not see itself to be required to write an opinion explaining its reasoning in every appeal.

The CCPA’s use of two-line affirmances conforms to its stated understanding that it was not required to provide any detailed written

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decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.”)

156. Compare *id.*, with Act of Mar. 2, 1929, ch. 488, § 3, 45 Stat. 1475 (1929).

157. Rules Enabling Act, Pub. L. No. 73-415, 48 Stat. 1064 (1934) (codified at 28 U.S.C. § 2072).

158. *Gen. Elec. Co. v. United States*, 681 F.2d 785, 786 (C.C.P.A. 1982).

159. See *Long John Distilleries Ltd. v. Sazerac Co.*, 426 F.2d 1406, 1407 (C.C.P.A. 1970).

160. *Id.*

review of the Board's decision when affirming. In *Hamer v. White*, the court wrote:

The decisions of the board, of course, will be available to all who may care to read it after our decision shall have been published. Any written review of the evidence made by us could be little more than a paraphrase of what the board said. Were we reversing the decision of the board it would be incumbent upon us to give a written review and point out the reasons for disagreement. *Since we are affirming, no such review is necessary.*<sup>161</sup>

The court came to a similar conclusion in *Kenyon v. Platt*:

It is not necessary for us to discuss all the exhibits or to quote extensively from the testimony. The Board has gone into this matter at great length and since we are in agreement with its conclusion that priority was properly awarded to the appellees it would serve no useful purpose to here restate in detail the attempts shown in appellees' voluminous record to prove reduction to practice. We will content ourselves with calling attention to certain features of the same, following in part this court's practice in *Hamer v. White et al.*[], 143 F.2d 987, 31 C.C.P.A., Patents, 1186.<sup>162</sup>

These statements by the CCPA reflect the general, historical practice that, absent a specific statutory requirement, federal courts of appeals had no requirement to prepare a written opinion, let alone an opinion explaining in detail its reasoning when affirming a lower tribunal's decision.

Another argument advanced in support of the mandatory written opinion interpretation is that the "general principal [sic] of federal administrative law requir[ing] written explanations of adverse judgments" further militates against the propriety of Rule 36 affirmances.<sup>163</sup> The argument misses the mark, however, with respect to the issue of positive law. The analogy to agency decision-making may be tangentially relevant to the normative question of what the court should do, but there are significant differences between agencies and federal appeals courts, which require an administrative agency to explain in detail its decision but do not require a federal appeals court to do the same.<sup>164</sup>

The requirement for federal agencies to provide reasons for their decisions has been addressed and explored extensively in the case law and academic commentary.<sup>165</sup> The Supreme Court's landmark

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161. *Hamer v. White*, 143 F.2d 987, 990 (C.C.P.A. 1944).

162. *Kenyon v. Platt*, 152 F.2d 1006, 1008 (C.C.P.A. 1946).

163. Crouch, *supra* note 1, at 566.

164. See Cohen, *supra* note 92, at 528–31.

165. See, e.g., Lisa Bressman, *Judicial Review of Agency Inaction: An Arbitrariness Approach*, 79 N.Y.U. L. REV. 1657, 1690–92 (2004); Gillian E. Metzger, *Ordinary Administrative Law as Constitutional Common Law*, 110 COLUM. L. REV. 479, 491 (2010); David Zaring, *Reasonable Agencies*, 96 VA. L. REV. 135, 135 (2010); see also Edward Rubin, *It's Time to Make the*

decisions in *S.E.C. v. Chenery Corp.*<sup>166</sup> and *Overton Park v. Volpe*<sup>167</sup> form the bedrock of the judicial review case law. As Professor Metzger has explained, “Part of the explanation for this expansion of substantive judicial scrutiny of agency decision-making lies in constitutional concerns with broad delegations of power to agencies and the attendant risk of unaccountable and arbitrary exercises of administrative power.”<sup>168</sup> Furthermore, the Administrative Procedure Act establishes a statutory requirement for an agency to explain its decision.<sup>169</sup> These same concerns do not exist when the judicial decision is made by a court of appeals. While it may be preferable for an appeals court to explain its decision in detail every time, that is a normative argument.

Additionally, a “mandatory written opinion” requirement would conflict with the legislative purpose of making Federal Circuit appeals uniform. Such a requirement would be unique to only patent and trademark appeals. The general remarks about the amendments during the legislative process expressed a desire to make the appeals practice uniform across the types of cases the Federal Circuit hears. The Department of Justice viewed the amendments to § 144 and § 1071(a)(4) as “conform[ing] these sections [including § 144] to the usual procedure for taking appeals to the circuit courts.”<sup>170</sup> While not definitive, the general impression is an intent to make a uniform appeals process—not one specific to patent and trademark cases. The “mandatory written opinion” interpretation is not consistent with the general objective of the legislation.<sup>171</sup>

This transmittal requirement makes sense when placed in the proper historical context. Today, with the ubiquitous flow of information and instantaneous news reporting, it is easy to forget that society was not always so interconnected. In 1984, there was no Twitter or Facebook to announce the latest decisions by the Federal Circuit. Instead, hard copies of the decisions were sent to the parties. Once the

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*Administrative Procedure Act Administrative*, 89 CORNELL L. REV. 95, 181–88 (2003) (explaining an administrative law rule that enforces the norm of decisionmaking rationality on agencies).

166. See generally *SEC v. Chenery Corp.*, 332 U.S. 194 (1947).

167. See generally *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402 (1971).

168. Metzger, *supra* note 165, at 491.

169. 5 U.S.C. § 555(e) (2018) (requiring an agency to provide a “brief statement of the grounds for denial” when denying a petition or application); 5 U.S.C. § 706(2)(A) (instructing the reviewing court to hold unlawful agency action that it deems “arbitrary, capricious, an abuse of discretion”).

170. *Technical Amendments to the Federal Court Improvements Act of 1982: Hearing on H.R. 3824 Before the Subcomm. on Courts, Civil Liberties & the Admin. of Justice of the H. Comm. on the Judiciary*, 98th Cong. 29 (1983) [hereinafter *1983 Hearing*].

171. Similarly, the “mandatory written opinion with reasons” requirement would lead to the non-uniform result of making the USPTO the only federal agency for which a reviewing court would have to provide a written opinion with reasons. *Cf.* D.C. CIR. R. 36(d).

Federal Circuit decided a USPTO appeal, the USPTO would have to be informed of the decision by the instruction set forth in § 144 that “the court shall issue to the Director its mandate and opinion.”<sup>172</sup>

In short, the correct reading of § 144 and § 1071(a)(4) does not impose a unique requirement on the Federal Circuit that it must prepare a written opinion in every appeal from the USPTO. To read the statute in that manner would “wrench statutory words out of their legislative and historical context and treat legislation as no more than a ‘collection of English words’ rather than ‘a working instrument of government.’”<sup>173</sup> The text of § 144 and § 1071(a)(4) does not demonstrate the congressional intent to depart from the long history of federal courts using abbreviated means of disposing of appeals. The statute is merely an instruction that the court’s mandate, that is necessarily prepared per FRAP 41, and the court’s opinion, if written, be transmitted to the USPTO Director.

### *C. Deference to the Judiciary and Separation of Powers*

In interpreting the statutes, it is reasonable to consider the deference that ought to be granted to the federal judiciary in determining which procedures are best employed to decide cases and render justice. It has been the traditional understanding that it is within a court’s authority to limit the “publication” of a decision.<sup>174</sup> Congress has generally deferred and given courts the power and authority to issue a decision as either a “published” decision or an “unpublished” decision. Absent a potential constitutional concern, such as due process, federal courts generally are given wide discretion in this area.

The principle of deference to courts about how they operate and fulfill their judicial obligations is rooted in separation-of-powers concerns. Deference to the judiciary and separation-of-powers concerns are further reasons to construe § 144 and § 1071(a)(4) as not requiring a mandatory written opinion. Congress has traditionally been deferential with respect to imposing procedural requirements on the federal judiciary. As noted earlier, since the enactment of the Rules Enabling Act, Congress has had little to say with respect to federal

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172. 35 U.S.C. § 144 (2018).

173. *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281, 315 (1988) (Brennan, J., dissenting) (quoting *United States v. Dotterweich*, 320 U.S. 277, 280 (1943)).

174. Kenneth Anthony Laretto, *Precedent, Judicial Power, and the Constitutionality of “No-Citation” Rules in the Federal Courts of Appeals*, 54 STAN. L. REV. 1035, 1038 (2002) (“Limited publication of judicial decisions was the accepted course of practice for the Framers, and no one has seriously questioned the ability of courts to determine which of their decisions are fit for publication.”); see also *Anastasoff v. United States*, 223 F.3d 898, 903 (8th Cir. 2000).

court rules, and Congress has generally delegated all procedural rulemaking to the courts.<sup>175</sup>

Further, there is a long history of courts issuing opinions without any meaningful explanation of the court's decision, other than that the court fails to see any reversible error. For instance, the US Court of Appeals for the Fourth Circuit grants "summary affirmances" which provide no more reasoning than what can be inferred from a Rule 36 affirmance:

Christopher Maddox Mossburg appeals the district court's order dismissing his complaint pursuant to Fed. R. Civ. P. 12(b)(6). We have reviewed the record and find no reversible error. Accordingly, although we grant leave to proceed in forma pauperis, we affirm for the reasons stated by the district court. . . . We dispense with oral argument because the facts and legal contentions are adequately presented in the materials before this court and argument would not aid the decisional process.<sup>176</sup>

The Federal Circuit has done so on occasion:

In light of our decision in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), we affirm the District Court's grant of summary judgment that these claims are invalid under 35 USC § 101. Dr. Classen's claims are neither "tied to a particular machine or apparatus" nor do they "transform[] a particular article into a different state or thing." . . . Therefore we affirm.<sup>177</sup>

These two examples highlight important issues if one was to conclude that § 144 requires the Federal Circuit to write an opinion in all USPTO appeals. Congress has apparently not seen any deficiency with such short opinions. Two- or three-sentence opinions stating affirmance with one or two other points do not seem to have bothered Congress.

Moreover, if the mandatory written opinion with reasons requirement were correct, it would require either the Supreme Court or Congress to assess whether the Federal Circuit's opinions satisfy any statutory written opinion requirement. Would an opinion be statutorily sufficient if it merely stated, "The decision of the Board is affirmed for one or more of the reasons set forth in the Board's decision"? A major administrability issue arises for any statute requiring a court to issue an opinion with reasons because the statute requires some assessment of whether the court's opinion is sufficiently detailed to satisfy the statutory mandate. This would be an extraordinary shift from the deference Congress has traditionally afforded the federal courts in

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175. Much has been written about the extent to which Congress can delegate rulemaking authority to the federal judiciary. See, e.g., Alexander Volokh, *Judicial Non-Delegation, the Inherent-Powers Corollary, and Federal Common Law*, 66 EMORY L.J. 1391, 1391 (2017).

176. *Mossburg v. Maryland*, 676 F. App'x 211, 212 (4th Cir. 2017), *aff'd per curiam*, No. 8:15-cv-01633-RWT (D. Md. June 29, 2016) (citation omitted) (unpublished).

177. *Classen Immunotherapies, Inc. v Biogen IDEC*, 304 F. App'x 866, 867 (Fed. Cir. 2008) (citation omitted) (unpublished).

deciding cases and managing its docket, and it would likely lead to satellite litigation concerning the sufficiency of the Federal Circuit's decision unrelated to the merits of the case.<sup>178</sup>

*D. The Legislative History Shows That Congress Did Not Intend to Eliminate Affirmance Under Federal Rule of Appellate Procedure 36*

Finally, this Article turns to the legislative history, including the purpose of the statutory amendments. While the legislative history is thin, it does not support a conclusion that § 144 and § 1071(a)(4) were intended to impose a “written opinion with reasons” requirement on the Federal Circuit in all appeals from the USPTO. Instead, the legislative history confirms that the amendment was little more than a technical amendment, intended to conform Federal Circuit procedure for USPTO appeals with the standard practice in all appeals.

The most relevant legislative history dates back to just after the creation of the Federal Circuit in 1982 by the Federal Courts Improvement Act of 1982 (FCIA).<sup>179</sup> Section 163 of FCIA included conforming amendments specifically, “strik[e] out ‘Court of Customs and Patent Appeals’ each place it appears and inserting in lieu thereof ‘Court of Appeals for the Federal Circuit.’”<sup>180</sup> It also specifically made those amendments to “[s]ections 141 through 146 of title 35, United States Code.”<sup>181</sup> The same amendment was made to “the section analysis of chapter 13 of title 35, United States Code” and the heading for § 141.<sup>182</sup> Thus, when the Federal Circuit was established, Congress did not substantively amend § 144. At that time, § 144 was the same as it was written in the 1952 Patent Act.<sup>183</sup>

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178. See, e.g., *People v. Kelly*, 146 P.3d 547, 559 (Cal. 2006); *People v. Rojas*, 173 Cal. Rptr. 64, 68 (1981).

179. Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982); see also STEVEN FLANDERS, *THE FEDERAL CIRCUIT—A JUDICIAL INNOVATION: ESTABLISHING A US COURT OF APPEALS* 2, 77 (2010); Daniel J. Meador, *Retrospective on the Federal Circuit: The First 20 Years—A Historical View*, 11 FED. CIR. B.J. 557, 558–59 (2001); Daniel J. Meador, *Origin of the Federal Circuit: A Personal Account*, 41 AM. U. L. REV. 581, 588–90 (1992).

180. § 163, 96 Stat. at 49.

181. *Id.* § 163(a)(7).

182. § 163(b)(1)–(2), 96 Stat. at 49–50.

183. See 35 U.S.C. § 144 (2018). Section 144, as enacted in the 1952 Patent Act, was based on R.S. 4914, which read as follows: “The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same way may be called into question.” Patent Act of 1952, Pub. L. No. 593, ch. 950, § 144, 66 Stat. 792, 802–03 (1952).



After the Federal Circuit was created, Congress followed quickly with some relatively minor tweaks to the controlling statutes.<sup>184</sup> On November 8, 1984, Congress enacted the Technical Amendments to the Federal Courts Improvement Act of 1982 (Technical Amendments Act).<sup>185</sup>

On August 4, 1983, Representative Robert W. Kastenmeier introduced H.R. 3824, a bill titled Technical Amendments to the Federal Courts Improvements Act.<sup>186</sup> The bill was intended make certain technical modifications to the FCIA. The statutory revisions in the Technical Amendments to the Federal Courts Improvement Act focused on the then-requirement that certified copies of the record from USPTO proceedings had to be transmitted to the Federal Circuit. Chief Judge Markey explained that doing away with this requirement would reduce cost to litigants, courts, and the public.<sup>187</sup>

One other change was a proposed amendment to § 144. As originally proposed, the amendment to § 144 read as follows:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the evidence produced before the Patent and Trademark Office and transmitted to the court under section 143 of this title. Upon its determination the court *shall return to the Commissioner a certificate of its proceedings and decision*, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.<sup>188</sup>

The proposed amendment included analogous wording for trademark appeals.<sup>189</sup> Notably, the proposed amendment to § 144 retained the “shall return to the Commissioner a certificate of its proceedings and decision” language that existed in § 144 since 1952.<sup>190</sup>

On September 28, 1983, the subcommittee held hearings on the proposed bill. The hearings included three witnesses: Chief Judge Markey; Rene Tegtmeyer, Assistant Commissioner for Patents; and Stuart E. Schiffer, Deputy Assistant Attorney General for the Department of Justice’s Civil Division.<sup>191</sup>

Chief Judge Markey noted the general basis for the amendment:

When the Act was under consideration, the focus was not directed to appeals from the Patent and Trademark Office, jurisdiction of which merely transferred over from the former Court of Customs and Patent Appeals. The provisions governing such

184. See 1983 Hearing, *supra* note 170, at 1.

185. Technical Amendments to the Federal Courts Improvement Act of 1982, Pub. L. No. 98-620, 98 Stat. 3362 (1984).

186. H.R. 3824, 98th Cong. 1 (1983).

187. See 1983 Hearing, *supra* note 170, at 5.

188. See H.R. 3824 at 3; 1983 Hearing, *supra* note 170, at 34.

189. See H.R. 3824 at 4.

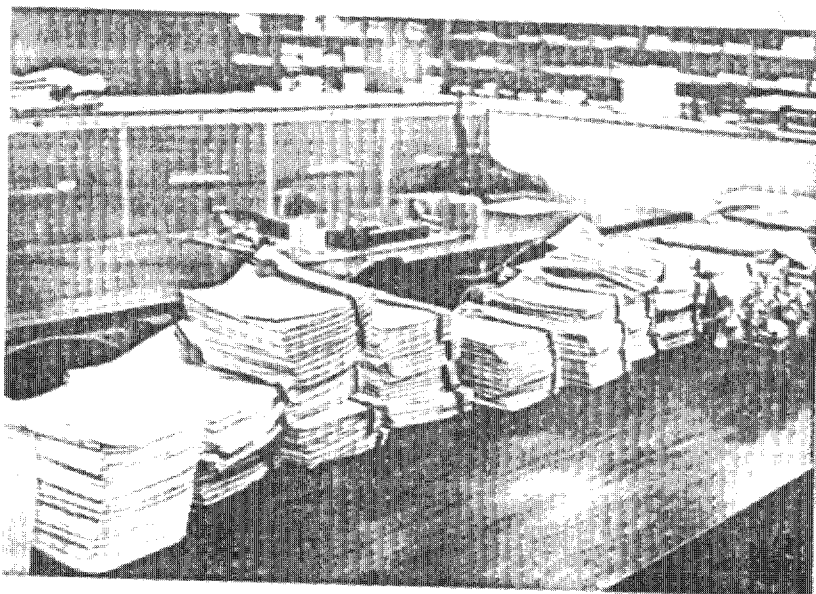
190. *Id.* at 3.

191. 1983 Hearing, *supra* note 170, at iii.

appeals appear, moreover, in Title 35, not in Title 28, where lay the major provisions of the Act. Certain retained provisions of Title 35 describe longstanding procedures occurring before and after an appeal is docketed and decided by the court. Those procedures, as described, do not match with simpler, cheaper, and more expeditious procedures available to litigants before the court in all other types of cases. H.R. 3824, modified as suggested here, would make those simpler procedures available to all parties filing an appeal in the Court of Appeals for the Federal Circuit.<sup>192</sup>

Chief Judge Markey's testimony was primarily focused on the requirement that the USPTO automatically prepare and send a certified copy of the record to the court before anything of substance occurred in the appeal. In his view, "[c]ertification requires substantial expenditure of often many months of time and of substantial taxpayer funds" and was "unnecessary."<sup>193</sup> As support, he included a photograph of one such certified record, which is produced in Figure 1:

**Figure 1. Photograph of Certified Record<sup>194</sup>**



Beyond his testimony and prepared statement, Chief Judge Markey proposed specific amendments to the bill. Relevant to the present discussion, Chief Judge Markey stated:

Again to equate the practice in appeals from the Patent and Trademark Office, the court recommends that lines 6 and 7 of page 3, and lines 12 and 13 of page 4 of H.R. 3824 as introduced be revised to read:

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192. *Id.* at 7.

193. *Id.* at 7–8.

194. *Id.* at 4.

"Upon its determination the court shall issue to the Commissioner its mandate and opinion.

These proposed revisions are the very amendments that would end up in § 144 and § 1071(a)(4) as the purported 'mandatory written opinion with reasons' language. The revision was being offered solely to make appeals from the USPTO consistent with appeals from the other tribunals.<sup>195</sup>

Indeed, in his prepared remarks, Chief Judge Markey noted the desire to make appeals uniform in procedure:

No pride of authorship resides in the foregoing recommendations, Mr. Chairman. We believe, however, that such revisions would make the same expeditious procedures available to those filing appeals from the Patent and Trademark Office as are available to those filing appeals from the other 113 tribunals from which appeals may be taken to the court.<sup>196</sup>

Based on this statement, Chief Judge Markey's apparent intention behind his proposed revision to H.R. 3824 was to make appeals from the USPTO as similar as possible to appeals from "the other 113 tribunals" (i.e., the district courts).<sup>197</sup> While his remarks appear primarily directed more to the issue of certified records, the comments evince a general intent to make the appeals process the same, regardless of the subject matter. To read the proposed amendment as creating a special "written opinion" requirement for USPTO appeals would run counter to Chief Judge Markey's comments.<sup>198</sup>

Rene Tegtmeyer, Assistant Commissioner for Patents, also testified. As with Chief Judge Markey, Mr. Tegtmeyer's remarks were primarily directed to the "certification of the record" but nevertheless included other comments and proposed revisions to the bill.<sup>199</sup>

Mr. Tegtmeyer provided "copies of 35 USC 143 and 144 and 15 USC 1071(a)(3) and (4) marked-up to reflect this change as well as minor editorial suggestions,"<sup>200</sup> which are produced in Figures 2 and 3:

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195. *Id.* at 8.

196. *See id.* at 9

197. *Id.*

198. *See id.* at 5 ("The suggested amendments also have the benefit of making appeals to the court, from all of the 116 tribunals from which appeals may be taken, identical.")

199. *Id.* at 15.

200. *Id.* at 17.

### Figure 2. Redlined Copy of 35 U.S.C. § 144

\*§144. Decision on appeal

"The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the evidence produced before the Patent and Trademark Office, ~~[and transmitted to the court under section 143 of this title.]~~ Upon its determination the court shall ~~[return]~~ issue to the Commissioner ~~[a certificate of its proceedings and decisions,]~~ its mandate and opinion which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case."

### Figure 3. Redlined Copy of 15 U.S.C. § 1071(a)(4)

"(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the ~~[evidence produced]~~ record before the Patent and Trademark Office, ~~[and transmitted to the court under paragraph (3) of this subsection.]~~ Upon its determination the court shall ~~[return]~~ issue its mandate to the Commissioner ~~[a certificate of its proceedings and decision,]~~ which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case."

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According to Mr. Tegtmeyer, "[t]he proposed revision of 35 USC 144 obviously flows with the change to 35 USC 142."<sup>202</sup> His comment here does not appear to be referring to the amendment that would include the so-called opinion requirement because § 142 relates only to the notice of appeal.

Mr. Tegtmeyer further stated: "[W]e would concur completely in the proposed revisions that Chief Judge Markey presented in his testimony and in his prepared statement. Our own proposed revisions follow or track his identically."<sup>203</sup> From this statement, the USPTO similarly did not view the amendment to § 144 and § 1071(a)(4) as adding a new requirement that the Federal Circuit was required to write an opinion in every appeal from the USPTO. Instead, the purpose of the amendments was to make the appeal process uniform.

Rather, understanding § 144 as a transmittal requirement is also supported by the language of § 144 prior to the 1984 amendment. The earlier version of the statute instructed that the court "shall *return* to the Commissioner a certificate of its proceedings and decision."<sup>204</sup>

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201. *Id.* at 18–19.

202. *Id.* at 16.

203. *Id.* at 15.

204. *See* H.R. 3824 at 3.

The old imperative was to *send* a certificate of the Court's decision to the USPTO. The objective was presumably to inform the USPTO of the outcome of the appeal, ensure that subsequent USPTO proceedings would be conducted in accordance with the outcome, and conform Federal Circuit practice with the practice of other appellate courts.

Finally, the legislative history includes remarks from Mr. Schiffer, which primarily focused on jurisdictional issues but also included comments about the proposed revisions to § 144 and § 1071(a)(4)<sup>205</sup>:

Section 4(a) of the bill amends sections 142, 143 and 144 of Title 35. These sections deal with appeals from the Patent and Trademark Office in patent cases. *The amendments conform these sections to the usual procedure for taking appeals to the circuit courts.* Section 4(b) of the bill amends sections 21(a)(2), (3) and (4) of the Lanham Act (15 U.S.C. § 1071(a)(2), (3) and (4)), which deal with appeals from the Patent and Trademark Office in trademark cases. The proposed amendments are identical to those proposed in section 4(a) for patent cases. Section 4(c) of the bill makes section 4(a) and 4(b) applicable to cases pending in the Patent and Trademark Office and in the Court of Appeals for the Federal Circuit.<sup>206</sup>

Consistent with the above, the Department of Justice viewed the amendments as making the appeal process uniform. In the Department of Justice's view, the amendments simply "conform[ed] these sections [including § 144] to the usual procedure for taking appeals to the circuit courts."<sup>207</sup> This testimony supports the conclusion that the amendment was not intended to impose a new, unique requirement on the Federal Circuit to write an opinion in every appeal from the USPTO. Nor is there evidence of intent to restrict the applicability of FRAP 36.

In the Sectional Analysis of H.R. 3824, the purpose of making the appeal process uniform was once again noted:

Section 4(a) of the bill amends sections 142, 143 and 144 of Title 35, United States Code. These sections deal with appeals from the Patent and Trademark Office in patent cases. The amendments conform these sections to the usual procedure for taking appeals to the circuit courts. Section 4(b) of the bill amends sections 21(a)(2), (3) and (4) of the Lanham Act (15 U.S.C. § 1071(a)(2), (3) and (4)), which deal with appeals from the Patent and Trademark Office in trademark cases. The proposed amendments are identical to those proposed in section 4(a) for patent cases.<sup>208</sup>

After the subcommittee hearing, on October 26, 1983, Representative Kastenmeier introduced H.R. 4222.<sup>209</sup> H.R. 4222 included the amendment to Section 144 as first proposed by Chief Judge Markey:

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205. 1983 Hearing, *supra* note 170, at 24–31.

206. *Id.* at 29 (emphasis added).

207. *Id.*

208. *Id.* at 36–37.

209. H.R. 4222, 98th Cong. 1 (1983); 1983 Hearing, *supra* note 170, at 72.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Commissioner its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.<sup>210</sup>

Based on this legislative history, the precise language in § 144 and § 1071(a)(4) is traceable directly to Chief Judge Markey. After the revised bill H.R. 4222 was introduced, Representative Kastenmeier solicited the comments of Judge Giles Rich of the Federal Circuit.<sup>211</sup> By letter dated January 16, 1984, Judge Rich replied.<sup>212</sup> His comments responded primarily to the revision that eliminated the need to file a “reasons of appeal” contained in 35 U.S.C. § 142–144 at the time.<sup>213</sup> Judge Rich noted that this “reasons of appeal” requirement had already been eliminated from trademark appeals.<sup>214</sup>

Judge Rich also noted that the proposed amendments to the trademark statutes include § 1071(a)(4):

I note that your H.R. 4222, Sec. 4(b), contains revisions to the trademark statute, 15 USC 1071(a) (2), (3), and (4) but clearly that is for reasons other than the abolition of reasons of appeal, which is now an accomplished fact. One such reason I assume to be the change in the name of the court from the CCPA to the CAFC, or “Fed. Cir.”<sup>215</sup>

Again, Judge Rich did not appear to view the amendment to § 144 and § 1071(a)(4) as imposing a new, unique requirement on the court that it must, in every instance, prepare a written opinion with reasons for its decision. Judge Rich’s letter confirms the nonsubstantive nature of the amendment to § 144. Moreover, nothing in Judge Rich’s letter indicates any suggestion that the amendment was intended to limit the applicability of FRAP 36.

In November 1984, the Technical Amendments to the Federal Court Improvements Act of 1982 was enacted into law.<sup>216</sup> No further amendments relevant to the present issue were made to the bill prior to its passage into law.

From the above review of the legislative history, several general observations can be made. First, nothing in the legislative history indicates that the amendments were intended to impose a new, unique “mandatory written opinion with reasons” requirement on the Federal

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210. H.R. 4222 at 3; 1983 *Hearing*, *supra* note 170, at 74.

211. 1983 *Hearing*, *supra* note 170, at 151.

212. *Id.*

213. *Id.*

214. *Id.* at 152.

215. *Id.*

216. See Technical Amendments to the Federal Courts Improvement Act of 1982, Pub. L. No. 98-620, 98 Stat. 3362 (1984).

Circuit for USPTO appeals. Second, the primary thrust of the amendments were procedural—and thus non-substantive—amendments, which is consistent with a bill styled as a “technical amendment.” Third, the expressed purpose of the amendments was to increase uniformity to the appeal process, not to impose a unique requirement. Indeed, as the subcommittee explained, “The amendments conform these sections to the usual procedure for taking appeals to the circuit courts to make the appeal process uniform.”<sup>217</sup>

Finally, there is no indication in the legislative history that the statutory amendment to § 144 was intended to codify the Federal Circuit’s prior Local Rule 18(a) (which had been in place from 1984 to 1986). As noted above, former Federal Circuit Rule 18(a), in place at the time of the amendment to § 144, was the court’s own rule that specified that appeals would result in either a published or nonpublished opinion. The legislative history has no hint that Congress sought to codify old Federal Circuit Rule 18(a). One would expect that Chief Judge Markey or someone else involved in the legislation would make at least one remark reflecting an intent to impose a legislative opinion-writing requirement if that were the intent. Overall, it would have been a highly unusual proposition for Congress to impose a specific statutory amendment that was already addressed by the court’s local rule, particularly given the scope of FRAP 36.

#### IV. CONCLUSION

In conclusion, the statutory text, the legislative history, the historical context, the purpose behind the legislative amendments to § 144 and § 1071(a)(4), and the governing rules of appellate procedure—not to mention the deference traditionally granted to the judiciary—all lead to the conclusion that the most reasonable statutory interpretation is that § 144 and § 1071(a)(4) do not prohibit the Federal Circuit from utilizing Rule 36 affirmances to dispose of appeals from the USPTO.

If the opposite theory were correct, the Federal Circuit would have to substantially revise its management of cases. Namely, if Rule 36 affirmances were not permitted, the court would have to devote resources to writing opinions in cases that do not meaningfully add to patent and trademark jurisprudence. And if that is the result, resource constraints beg the question of whether the court will have to reduce its efforts in other areas, such as offering oral argument in every represented case or writing detailed opinions for pro se appellants. The court could resort to issuing one-paragraph affirmances, as it has done

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217. 1983 Hearing, *supra* note 170, at 29.

on occasion and which would be similar to the current practice of other courts of appeals.

To be clear, the legal question of whether Rule 36 affirmances are permitted under the applicable laws and rules is distinct from the normative question of whether Rule 36 affirmances should be used in affirming USPTO decisions. The latter question is complex and draws upon a long history of judicial and academic debate, including the history associated with “published” versus “unpublished” opinions. Rule 36 affirmances undoubtedly rankle many in the patent bar—and the legal community in general. These one-word affirmances also run against courts’ general, historical practice of providing some explanation of their decisions. But Rule 36 affirmances provide distinct benefits—to the court, the litigants, and the public.<sup>218</sup>

Ultimately, the Federal Circuit is well within its statutory authority to issue Rule 36 affirmances. For parties who disagree with the court’s use of Rule 36 and seek to limit it, those parties’ efforts would be better spent focusing on the policy reasons why the court should write opinions—even short ones—in as many appeals as possible.

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218. See Matthew J. Dowd, *Banning Rule 36 Affirmances: Be Careful What You Ask For*, LAW360 (Aug. 25, 2017, 12:02 PM), <https://www.law360.com/articles/956672/banning-rule-36-affirmances-be-careful-what-you-ask-for> [<https://perma.cc/JE59-V5VZ>].



