How the Supreme Court Decides to Review Intellectual Property Cases

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ABSTRACT

Because Supreme Court review is essentially discretionary, it is increasingly rare for the Court to hear an argument concerning Intellectual Property rights. However the Supreme Court will critically review cases that belong in one of four distinct categories. These include cases in which: (1) lower court decisions conflict, (2) lower courts have departed from accepted and usual court proceedings, (3) an important federal question is decided, and (4) lower courts have departed from Supreme Court precedent. This article provides practitioners with some guidance in determining whether the Supreme Court is likely to review a lower court decision on an Intellectual Property issue.

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HOW THE SUPREME COURT DECIDES TO REVIEW INTELLECTUAL PROPERTY CASES*

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INTRODUCTION

The U.S. Supreme Court plays a crucial role in the field of intellectual property ("IP") as the final arbiter of IP rights based on federal law.[1] This means that the Supreme Court provides ultimate guidance in most core areas of IP law, including patents,[2] copyrights,[3] trademarks and trade dress,[4] which are governed by federal statutes. While many states may still have statutes on their books or common law precedents governing IP rights in the fields of patents, trademarks, trade dress and unfair competition, for the most part federal law is clearly dominant in these areas today.[5] Federal IP law is based either on federal statutes providing for exclusive coverage in areas such as patents and copyright,[6] or practical recognition that federal law provides all the relief necessary, making parallel state law claims superfluous. One notable exception to this federal law dominance is the law of trade secrets, but even here, new federal statutes are beginning to encroach in this area by providing alternate bases for protecting against trade secret theft.[7]

Given the Supreme Court's preeminent role the field of IP rights, it is important to understand the basics of advocacy and presentation of cases before the Supreme Court, particularly when dealing with IP cases. For many years now, most of the Supreme Court's case load has been essentially discretionary, based on its *certiorari*

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[1] *See* 28 U.S.C. § 1338(a) (2000) (vesting exclusive jurisdiction over federal patent, plant variety protection, copyrights and trademarks claims on federal courts).

[2] *See* 35 U.S.C. §§ 1–376 (2000).

[3] *See* 17 U.S.C. §§ 101–810 (2000).

[4] *See* 15 U.S.C. §§ 1051–1127 (2000).

[5] *Cf.* Cover v. Hydramatic Packing Co., 83 F.3d 1390 (Fed. Cir. 1996) (analyzing whether a state commercial code was pre-empted by the federal patent code). "[S]tates may not intervene and provide protection to subject matter that is statutorily unprotected by our patent laws . . . [S]tates are free to regulate the use of . . . intellectual property in any manner not inconsistent with federal law." *Id.* at 1392-93 (internal citations and quotations omitted).

[6] *See supra* notes 2–3.

[7] *See, e.g.,* Computer Fraud & Abuse Act of 1986, 18 U.S.C. § 1030 (2002) (providing for a private cause of action for compensatory and punitive damages, as well as equitable relief, for, *inter alia,* theft of trade secrets stored in electronic format by means of "hacking" or unauthorized use from computers connected to the Internet).

jurisdiction.[8] Since the beginning of the Rehnquist Court in 1986, that discretion has been exercised only in limited circumstances. This is reflected in the fact that since the late 1980's, the Supreme Court has only been agreeing to hear argument in roughly seventy-five to eighty cases each Term, rather than the 150 or more that were typically reviewed each year during the Burger Court years.[9] In the past decade, a total of fewer than twenty-five of these cases involved IP rights in some fashion or another. That means the Supreme Court hears argument, on average, in only two or three IP cases each year, with no cases being heard in some years.

How the Supreme Court goes about deciding which cases to hear when dealing with issues involving IP rights requires an understanding of the Supreme Court's review process, together with a brief review of some of the cases it has heard in this area. This article provides practitioners with some guidance in the area of Supreme Court review of IP cases.

I. THE BASIC *CERTIORARI* PROCESS

Since the essentially exclusive vehicle for obtaining Supreme Court review for a case involving federal IP rights is by means of a *writ of certiorari*, one of the best references for guidance on this process is the Court's own established Rules, which set forth in detail the procedures for going about seeking *certiorari* review.[10] Under the Rules, an aggrieved party in a lower court must file a petition seeking leave to appeal, using a very strict format for the submission. Although the details of briefing and presenting a *certiorari* petition are beyond the scope of this paper, it is imperative to keep in mind that the Court does not simply grant broad appeals of decisions below, but instead only grants review of specified "issues" that are presented for review. The crafting of these "questions presented" is an art form in itself, requiring careful consideration to attract the Court's attention, as discussed *infra*.

The Court reviews *certiorari* petitions at its weekly conferences when the Court is in session, based on the question or questions presented. Prior to consideration by the Court, law clerks assigned to the Justices will typically have reviewed the petition and any related responses or *amicus* briefs. As part of this process, law clerks will review the lower court opinion and any cited conflicting decisions and generally try to determine what precise issues are being raised by the parties. In other words, they will not simply rely on the issues as framed by the petitioning party, who in many cases may be appearing *pro se*. Based on their preliminary review of the case law and facts as set forth in the parties' submissions, the law clerks will prepare memoranda for their Justices summarizing the case below,

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[8] Prior to statutory amendments in the late 1980's, the Supreme Court also heard many direct appeals when a lower appellate court held a federal statute invalid in some respect. Review of these appeals was mandatory, rather than discretionary, which was something the Supreme Court disfavored. The jurisdictional statute ultimately was amended 1988 to require *certiorari* for review even in this limited category of appeals. Act of June 27, 1988, Pub. L. No. 100–352, 102 Stat. 662 (codified as amended at 28 U.S.C. §§ 1254, 1257, 1258, 2101, 2104, and 2350 (1988)).

[9] Warren Burger succeeded Earl Warren as Chief Justice in 1969 and served until he retired in 1986.

[10] *See* SUP. CT. R. 1–48, *available at* http://www.supremecourtus.gov/ctrules/ctrules.html.

including the issues presented, their thoughts on whether the issues were properly preserved for appeal, and their recommendation on whether or not to grant *certiorari*. The Justices then consider the petitions at their conferences, based on these summaries and their own review of the parties' submissions. But unless a Justice specifically requests to place a particular petition on the list for discussion, there is no actual "consideration" of the petition at the conference, with the presumption simply being that the petition will be denied. In those instances where a Justice has flagged a petition for review (which is the clear exception, and not the rule) the Justices will at a minimum affirmatively vote on whether or not to grant *certiorari*, and possibly discuss the case at some length. A petition ultimately will be granted only if at least four Justices vote to hear the case.

II. FACTORS INFLUENCING *CERTIORARI* REVIEW

The Supreme Court's Rules provide a glimpse of how the Court proceeds in determining what its docket will look like based on its jurisdiction on *writ of certiorari*. This snapshot is set forth in Supreme Court Rule 10, which is set forth below in its entirety:

RULE 10. CONSIDERATIONS GOVERNING REVIEW ON *CERTIORARI*

> Review on a writ of certiorari is not a matter of right, but of judicial discretion. A petition for writ of certiorari will be granted only for compelling reasons. The following, although neither controlling nor fully measuring the Court's discretion, indicate the character of the reasons the Court considers:
>
> (a) a United States court of appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter; has decided an important federal question in a way that conflicts with a decision by a state court of last resort; or has so far departed from the accepted and usual course of judicial proceedings, or sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power;
> (b) a state court of last resort has decided an important federal question in a way that conflicts with the decision of another state court of last resort or of a United States court of appeals;
> (c) a state court or a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court.

> A petition for *writ of certiorari* is rarely granted when the asserted error consists of factual findings or the misapplication of a properly stated rule of law.[11]

Based on this guidance, it is clear that there are only a few categories of cases which the Supreme Court is interested in hearing:

1) Cases involving conflicting decisions on the same legal topic;
2) Cases which have "departed from the accepted and usual course of judicial proceedings,"[12] such that the Supreme Court should exercise its supervisory powers to correct the error;
3) Cases in which a lower appellate court has decided an "important question of federal law" that should not await further review by other lower courts; and
4) Cases in which it appears that a lower appellate court has failed to adhere to the Supreme Court's past precedent.

The next section discusses in turn how the Supreme Court has applied its review process to IP cases that fall within categories 1, 3, and 4. A departure from the accepted course of judicial proceedings has yet to be an issue in an IP case.

III. APPLICATION OF THE COURT'S REVIEW CATAGORIES IN IP CASES

A. Conflicting Decisions Below

The need for resolving conflicting lower appellate court holdings on identical issues of federal law, such as the interpretation of the scope of a federal statute on patent or copyright topics, is obvious. If the notion of having a federal system in certain areas of IP law is to have any meaning, it is critically important that the law be clearly articulated without conflicting interpretations among the various federal circuits. Given today's global economy, authors and inventors need to know what their federal IP rights are. In addition, competitors need to know the limits of federal IP rights for these authors' works and inventors' patents. Unfortunately, the Supreme Court does not hear every case in which a conflict is evidenced, even on what many practitioners may consider to be important federal questions. The trend since the Burger Court of reviewing far fewer cases has included a decline in the number of *certiorari* grants in pure conflict situations.[13]

Two recent examples of conflicts at the federal appellate level that have led to Supreme Court review in IP rights cases are illustrative. In *Traffix Devices, Inc. v.*

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[11] SUP. CT. R. 10.

[12] *Id.*

[13] Conflicting lower court decisions were an area in which Justice Byron White in particular felt the Supreme Court had a duty to act. When petitions for *certiorari* raised such a conflict and the Court nonetheless denied *cert.*, Justice White typically would write a dissent highlighting the need for the Court to step in and resolve the conflict. City of North Muskegon v. Briggs, 473 U.S. 909 (1985); *See e.g.*, Gee v. Boyd, 471 U.S. 1058 (1985).

Marketing Displays, Inc., the Court determined the scope of trade dress protection for a traffic sign design that was the subject of expired utility patents.[14] The federal circuits had split on the issue whether an expired utility patent foreclosed the possibility of trade dress protection for the product's design.[15] The Court noted that the party asserting trade dress protection must demonstrate that the matter sought to be protected is not functional, and in the case of a design claim, the fact that the design had once been the subject of a utility patent is strong evidence that the features claimed for the design are functional.[16] As a result, the Court put the burden on the party claiming protection to demonstrate that the feature is *not* functional.[17] In so holding, the Court chastised the Sixth Circuit for misinterpreting trade dress principles generally on the topic of protection for designs, which the Court then undertook to summarize in some detail.[18]

The Supreme Court's level of unhappiness at the lower court's reasoning in *Traffix Devices*, and its desire to grant *certiorari*, was likely influenced by the fact that the Court had only recently addressed the scope of trademark and trade dress protection in three separate cases, reflecting an extraordinary level of scrutiny by the Court for this narrow topic.[19] Of these three cases, *Qualitex* also involved a conflict among the federal circuits.[20] In *Qualitex*, the Court faced the issue whether a party could register a trademark based solely on the color of the product.[21] The Court held that color alone could serve as a trademark, to the extent that customers identified the color as Qualitex's (such that it had developed secondary meaning), and the color did not serve any other function.[22] This resolved a conflict among at least four federal circuits that had emerged over the previous decade.[23]

Of course, in the area of patent law, there is considerable uniformity in appellate rulings based on the simple fact that the Federal Circuit has exclusive jurisdiction over cases "arising under" the federal patent laws.[24] What that means is that in cases in which a patent holder sues for infringement, or in which a declaratory judgment action is brought to determine whether or not a party's conduct infringes or the patent is invalid, the appellate court will be the Federal Circuit, applying what hopefully will be its own uniform precedent. But even here, there is

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[14] 532 U.S. 23 (2001).

[15] *Id.* at 28.

[16] *Id.* at 28–29.

[17] *Id.* at 29–30.

[18] *See id.* at 32–35.

[19] *See* Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000) (holding that product design for trade dress purposes is only protectable upon a showing of secondary meaning); Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (holding that color of product alone could constitute protectable trademark upon showing of secondary meaning); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (holding that distinctive restaurant design could be protected under trade dress principles).

[20] 514 U.S. at 161.

[21] *Id.* at 160–161.

[22] *See id.* at 164–66.

[23] *Id.* at 161.

[24] *See* 28 U.S.C. § 1295(a)(1) (2000) (vesting the Federal Circuit with the exclusive jurisdiction over appeals from district courts if the district court's jurisdiction "was based, in whole or in part," on 28 U.S.C. § 1338(a), which vests exclusive jurisdiction over federal patent law claims in the federal district courts).

not 100% uniformity, because it remains feasible for a patent claim to be raised in certain circumstances – such as by way of a counterclaim in an otherwise non-patent case – that will give rise to appellate review by a federal circuit other than the Federal Circuit. This is because the federal statute granting appellate review on patent matters to the Federal Circuit was not drafted to encompass all potential scenarios, as the Supreme Court pointed out in one of its most recent pronouncements in the area of IP law, *Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*[25]

B. "Important Questions"

The Supreme Court will not hesitate to grant review in cases raising what the Justices perceive to be issues of significant importance warranting their immediate attention, rather than waiting to see how lower courts wrestle with the issue over a reasonable period of time. These types of cases frequently involve legal disputes that have been on the front pages of the news for some time as they percolate their way up to the Court. A good example involved the publication by the *New York Times* of the Pentagon Papers, and whether the Executive Branch could enjoin such publication based on national security grounds.[26]

As technology advances at an unstoppable and increasingly rapid pace, cases involving IP law are beginning to emerge as more likely candidates for this type of early review. The Justices read the national newspapers, and generally follow trends in the economy and broad areas of technological innovation just like many other readers of these publications. It does not require a genius to recognize a significant and newsworthy ruling below by the time it reaches the Supreme Court. Not only are the issues presented in the media, they are flagged for attention on arrival at the Court by the frequent submissions of numerous amicus briefs by major business, academic, and public interest organizations. And in many cases, there are additional submissions by the Executive Branch, expressing the "official" views of the United States government on the topic at hand. Indeed, when a major issue surfaces without any federal government amicus filing, the Court will often affirmatively request that the United States government express its views.

Based on the Supreme Court's record in the past several years, the "important question" basis for review appears to underlie the granting of *certiorari* petitions more often than conflicts among the federal circuits, particularly in the field of IP law. Important questions, of course, can fall within several different categories, some of which have more attraction for the Court than others. These categories can be roughly segmented as follows: (1) broad constitutional questions, (2) jurisdictional questions, (3) procedural questions, and (4) basic substantive law questions, which typically include issues of statutory interpretation or potential conflicts among statutes.

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[25] 535 U.S. 826 (2002) (holding that "arising under" requirement for patent appeals to Federal Circuit must be analyzed solely on basis of complaint, and not answer or counterclaims, similar to the analysis utilized in other types of cases involving removal authority).

[26] *See* N.Y. Times v. United States, 403 U.S. 713 (1971).

1. Constitutional Questions

Questions raising constitutional issues of significance can be counted on to attract the interest of the Supreme Court. Because the Court only has the opportunity to shape the Constitution by means of cases that rise to the surface in somewhat random fashion – *i.e.*, the Court cannot simply reach out and decide to resolve an issue that appeals to them that is not raised in a case being appealed subject to a *certiorari* petition – the temptation to grant *certiorari* when such a case is within its grasp is often overpowering.

Broad constitutional questions, while generally rare in the area of IP law, have surfaced several times in the past few years. Most recently, in *Eldred v. Ashcroft*,[27] the Court considered the scope of congressional power to extend the term of both existing and future copyrights by twenty additional years,[28] in the face of the Constitution's language limiting such power to granting copyrights only for "limited Times."[29] While the Court at oral argument appeared to be skeptical as to the *desirability* of providing such an extension (which although "fixed" in duration reflects, from a practical standpoint, what amounts to a nearly perpetual grant), the Court nevertheless deferred to Congress in the face of clear constitutional language giving it the right to establish appropriate duration limits, as well as long-standing precedent permitting such extensions.[30] In this case, however, there had been no conflicting rulings below, with the Court of Appeals for the District of Columbia reaching the same result that the Supreme Court ultimately reached.[31] Why, then, did the Court grant *certiorari* review in this case? Obviously, the case raised important issues for the business community (leading to widespread media coverage debating whether the copyrights on Mickey Mouse and other well-known works should be extended yet again), as well as issues of foreign affairs, based on copyright terms in the European Union. Moreover, counsel for the opposing parties – Lawrence Lessig and Theodore Olson – were well known to the Court, which undoubtedly helped influence their decision to take the case.

The other recent decision involving a significant constitutional issue is *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, which concerned the ability of a patent holder to sue a state for patent infringement.[32] This case raised issues as to the scope of sovereign immunity and congressional power to abrogate such immunity[33], a matter which is near and dear to many current Justices. Resolution of this case required interpretation of several clauses of the Constitution,

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[27] 123 S. Ct. 769 (2003) (holding that Congress acted within its authority in extending the copyright term).

[28] *See* 1998 Copyright Term Extension Act, Pub.L. 105–298, §102(b) and (d), 112 Stat. 2827–2828 (amending 17 U.S.C. §§ 302, 304) (2000).

[29] U.S. Const., art. I, § 8, cl. 8, (providing as to copyrights that "Congress shall have Power [t]o promote the Progress of Science . . . by securing [to Authors] for limited Times . . . the exclusive Right to their . . . Writings").

[30] *Eldred*, 123 S. Ct. at 778–80.

[31] *Id.* at 775.

[32] 527 U.S. 627, 635 (1999).

[33] *Id.*

including the Due Process Clause,[34] the Interstate Commerce Clause,[35] the Eleventh Amendment[36] and the Fourteenth Amendment,[37] as well as several federal statutes drafted by Congress in an attempt to provide patent holders with a federal remedy for any patent infringement involving a state governmental authority. Despite the broad power of Congress to grant patents to inventors, and its separate authority to provide remedies for Fourteenth Amendment violations (such as remedying violations of IP rights by a state in contravention of the Due Process Clause), the Court ultimately determined that Congress had acted too hastily in concluding that the States had not provided a constitutionally adequate remedy to an injured patent owner when attempting to abrogate the States' sovereign immunity for patent claims.[38] That the Court reached this holding is not surprising, given the trend in cases upholding States' Rights over the past fifteen years.

2. Jurisdictional Questions

Questions concerning appellate jurisdiction in the area of IP law have arisen only infrequently in the past decade. As noted above, in *Holmes Group*, the Court held that the Federal Circuit had overreached its jurisdiction when accepting an appeal in which the initial complaint filed by the plaintiff did not raise a claim "arising under" federal patent laws.[39] This is one of many instances in which the Court has not hesitated to overrule the Federal Circuit, without need for any conflicting decisions below to support a grant of *certiorari*.

In somewhat similar circumstances, the Court had earlier taken the Federal Circuit to task in *Cardinal Chemical Co. v. Morton International, Inc.*[40] for refusing to review a district court's holding that a patent was invalid after affirming the district court's separate holding that the patent had not been infringed. In that case, the Court emphasized the need to resolve issues that had been fully litigated below in order to protect the public against prolonging the life of invalid patents and encouraging "endless litigation" or uncertainty over the validity of a patent.[41] The Court also expressed concern that by treating the patent validity issue as moot, once non-infringement was found, the Federal Circuit appeared to be attempting to deprive the Supreme Court of the ability to consider the validity ruling, thereby

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[34] U.S. CONST., amend. V, (providing that "No person shall be . . . deprived of life, liberty, or property, without due process of law").

[35] U.S. CONST., art. I, § 8, cl. 3, (providing that "Congress shall have Power . . . [t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes . . .").

[36] U.S. CONST., amend. XI, (providing that " The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State").

[37] U.S. CONST., amend. XIV, (providing that "No State shall . . . deprive any person of life, liberty, or property, without due process of law").

[38] College Savings Bank, 527 U.S. at 639–48.

[39] *Holmes Group*, 535 U.S. 826 (2002) (holding that "arising under" requirement for patent appeals to Federal Circuit must be analyzed solely on the basis of the complaint, and not answer or counterclaims).

[40] 508 U.S. 83 (1993).

[41] *See id.* at 99–103.

limiting the Court's own power.[42] That type of action at the appellate court level is virtually guaranteed to attract scrutiny by the Supreme Court.

3. Procedural Questions

Procedural questions, while not typically raising issues as controversial as those involving major constitutional questions, are often the grist of appellate rulings and ultimately Supreme Court rulings. Procedure goes to the process of handling litigation in federal courts, and the Supreme Court has expressed a fair level of interest in how IP rights are litigated at both the trial and appellate levels. This includes questions concerning the roles of the trial court and juries in such cases.

Perhaps the most notable procedural case in the area of IP law in recent years is *Markman v. Westview Instruments, Inc.*, which held that claim construction in patent cases was exclusively within the province of the district court, leaving the jury with only the factual resolution of infringement claims, should they survive the district court's "Markman" hearing stage.[43] While the resolution of this case rested on an interpretation of the Seventh Amendment and the respective roles of the trial court and the jury, as a practical matter, the fundamental issue to be decided was whether to treat a patent similar to a contract and apply the longstanding rule that interpretation of a contract raises an issue of law for the trial court.[44] For this reason, this case is better classified as a procedural case rather than a significant constitutional question case.

A similar overlap between procedural issues and constitutional questions arising out of Seventh Amendment concerns was presented in *Feltner v. Columbia Pictures Television, Inc.*[45] In *Feltner*, the issue was who should determine the amount of statutory damages for copyright violations: judge or jury?[46] The Court first determined that the copyright statute did not expressly provide for a right to a jury trial when the copyright owner elects to recover statutory damages; as a result, the Court had to face the constitutional issue.[47] The Court then had little trouble concluding that juries historically have determined money damages claims, and that there was no basis for altering this practice when faced with the assessment of statutory damages.[48]

A recent procedural issue of a more mundane but still important nature concerned the deference that the Federal Circuit is required to give to factual findings made by the Patent and Trademark Office (PTO) when denying a patent application. In *Dickinson v. Zurko*,[49] the Supreme Court reversed the Federal Circuit's holding that a "clear error" standard should apply, instead adopting the more deferential standard required under the Administrative Procedures Act,[50]

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[42] *Id.* at 97.
[43] 517 U.S. 370, 391 (1996).
[44] *Id.* at 376–90.
[45] 523 U.S. 340 (1998).
[46] *Id.* at 342.
[47] *See id.* at 345–47.
[48] *See id.* at 347–55.
[49] 527 U.S. 150 (1999).
[50] 5 U.S.C. § 706 (2002).

which permits the appellate court to ignore or set aside an administrative factual finding only if the court concludes that it was either arbitrary, capricious, an abuse of discretion, or unsupported by substantial evidence. While this might be viewed by some as the Court dabbling in an area of little significance, this topic falls squarely within the overall area of separation of powers between the Executive Branch and the Judicial Branch, based on an Act of Congress setting forth the appropriate jurisdictional boundaries, which is an area of key interest to the Court.

4. Basic Substantive Law Questions

Substantive law questions in the area of IP law typically involve the interpretation of the federal statutes granting IP rights, such as patents, trademarks and copyrights. The Court has granted review of several cases in this area in the past few years even in the absence of any conflict among the federal circuits, particularly in patent and copyright areas. Some of these cases fall within the "significant issue" category based on any scale for measuring significance. For example, in *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred International, Inc.*, the Court faced the issue whether newly developed plant breeds are patentable subject matter under the statutory scheme for general utility patents. [51] The Federal Circuit had answered this question in the affirmative, and the Supreme Court in turn affirmed.[52] This ruling ultimately upheld the PTO's interpretation of the utility patent statute,[53] when faced with an argument that two narrower statutes governing plant patents should have applied exclusively.[54] Why did the Court grant *certiorari* only to affirm? This case presented potentially conflicting statutes which had been interpreted by an Executive Branch agency acting within its area of expertise. It also presented a matter of major significance to the business community and the public, *i.e.*, the scope of patents covering living matter, which led to the submission of some thirteen *amicus* briefs, including one by the United States. These factors undoubtedly influenced the Court's decision to not leave resolution of this issue to the Federal Circuit alone.

A second patent law example in this category is *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, which upheld the doctrine of equivalents and gave considerable guidance on its proper application in patent litigation.[55] In particular, the Court held that the doctrine of equivalents must be applied to individual elements of a patent claim, rather than the invention as a whole, and that prosecution history estoppel does not apply automatically whenever a patent claim has been amended during the application process, without regard for the reasons for the amendment.[56] For this case, the Court spelled out its reasons for granting *certiorari* with some specificity, noting that the Federal Circuit was having difficulty

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[51] 534 U.S. 124, 127 (2001).

[52] *Id.* at 129–30.

[53] *See* 35 U.S.C. § 101 (2000).

[54] *See* Plant Variety Protection Act, 84 Stat. 1542, as amended, 7 U.S.C. § 2321-2582., Plant Patent Act of 1930, 46 Stat. 376 (as amended 35 U.S.C. §§ 161–164 (2002).

[55] 520 U.S. 17 (1997).

[56] *See id.* at 28–34.

applying a fifty-year old precedent, as exemplified by three separate dissents below, and that it was generally necessary to clarify the proper scope of the doctrine of equivalents.[57]

The need to clarify prior holdings of the Supreme Court and lower courts adding gloss to a broad statute with little inherent guidance arose again in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,[58] which interpreted the scope of trade dress protection for product design under Section 43(a) of the Lanham Act.[59] In this case, the Court adopted a bright-line rule that product design for trade dress purposes is only protectable upon a showing of secondary meaning, with the hope that this would clear up confusion in the courts below and facilitate summary judgment motions.[60] In reaching this result, the Court found it necessary to clarify the interplay between two of its earlier decisions.[61]

Another example in the "significant issue" category, based the widespread ramifications of the decision, was *New York Times Co., Inc. v. Tasini*,[62] which involved the copyright laws. In this case, freelance authors who had written articles published in a variety of periodicals brought copyright infringement claims against the publishers of the periodicals and the owners of certain electronic databases (such as NEXIS®), after the authors' articles were made available in these databases with the consent of only the publishers.[63] The case turned on the construction of a provision of the Copyright Act governing rights in collective works.[64] The Court had little difficulty adhering to the plain language of the statute, which required the database owners to obtain the consent of the freelance authors before including the articles in this database, due to the limited releases obtained by the publishers when the articles were initially written (which in many cases was prior to the existence of electronic databases of this type). But the decision had wide-spread ramifications, because it caused uncertainty in a large business segment, with no means for readily obtaining consents from all the various authors. Nonetheless, the Court was not deterred when ruling for the authors and against "big business," noting that issuance of an injunction against the databases was not necessarily inevitable upon remand, and that authors and publishers had previously developed practical solutions for resolving such disputes, such as blanket licenses in the music industry.[65] Once again, the Court granted *certiorari* when there was no conflict in the federal circuits, reflecting the significance of the appellate court's ruling below to the national media and the rapidly growing electronic media database industry.

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[57] *See id.* at 21. The precedent at issue was *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), which set out the parameters for the doctrine of equivalents.

[58] 529 U.S. 205 (2000).

[59] 15 U.S.C. § 1125(a) (2000).

[60] *See* Wal-Mart, 529 U.S. at 212–14.

[61] *See id.* at 211–12 (citing Qualitex v. Jacobson Prods. Co.,, 514 U.S. 159 (1995) (holding that color of product alone could constitute protectable trademark upon showing of secondary meaning)); *id.* at 214–15 (citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (holding that distinctive restaurant design could be protected under trade dress principles)).

[62] 533 U.S. 483 (2001).

[63] *Id.* at 487–90.

[64] *See* 17 U.S.C. § 201(c) (2000).

[65] *See Tasini*, 533 U.S. at 505–06.

Not all cases reaching the Supreme Court garner the attention of the media as much as *Tasini*, however. There are many cases being granted, albeit infrequently, which Court observers who do not practice in the field of IP law might classify as more "mundane" statutory questions. One recent example is *Pfaff v. Wells Electronics, Inc.*, which involved the issue as to when the statutory one-year "on-sale" period is triggered for purposes of invalidating a patent.[66] Under the "on-sale" bar doctrine, an "invention" cannot be patented if it has been "on sale" more than one year prior to filing a patent application.[67] In reaching its decision, the Court had to interpret the meaning of "invention" under the Patent Act of 1952[68] in order to determine whether an invention could be patented before it was reduced to practice. Noting that the statute did not contain any express requirement of reduction to practice before an invention could be patented, the Court rejected imposing such an additional requirement, based on precedent dating back to Alexander Graham Bell's patent on the telephone.[69] Instead, the Court held that the on-sale bar was triggered once the invention was the subject of a commercial offer for sale and ready for patenting, either by proof of reduction to practice or the preparation of drawings or descriptions sufficient to enable a person skilled in the art to practice the invention.[70]

While *Pfaff* resulted in affirming the Federal Circuit, a Supreme Court grant of *certiorari* in what might be considered by many to be a less significant case more often is based on the Court's intent to promptly overturn what it considers to be a mistaken ruling below. This has occurred in several areas of IP law in the past decade, including copyright and patent cases.[71]

C. Failure to Adhere to Precedent

The failure of an appellate court to follow relatively recent Supreme Court precedent renders the likelihood of a grant of *certiorari* quite high. This is evidenced in the Court's recent decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*,[72] which revisited the doctrine of equivalents only five years after the Court's prior decision in *Warner-Jenkinson*.[73] In the course of reversing the Federal Circuit, the Court held, *inter alia*, that prosecution history estoppel may apply to any claim amendment made to satisfy a Patent Act requirement, but that estoppel need

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[66] 525 U.S. 55, 57 (1998).

[67] *See* 35 U.S.C. § 102(b) (2000).

[68] *See* 35 U.S.C. §§ 1–376 (1952).

[69] *See Pfaff*, 525 U.S. at 61–62 (citing *The Telephone Cases*, 126 U.S. 1 (1888)).

[70] *Id.* at 67–68.

[71] *See, e.g.*, Quality King Dist., Inc. v. L'Anza Research Int'l, Inc., 523 U.S. 135 (1998) (holding that first sale doctrine, under which owner of a copy of a copyrighted work is permitted to sell his copy without the consent of the copyright owner, applies to imported copies); Asgrow Seed Co. v. Winterboer, 513 U.S. 179 (1995) (holding that farmer could sell seed protected by Plant Variety Protection Act under statutory exemption only if the seed had been saved by farmer to replant his own acreage); Campbell v. Acuff–Rose Music, Inc., 510 U.S. 569 (1994) (holding that rap group 2 Live Crew's parody of Roy Orbison's rock ballad, "Oh, Pretty Woman," was fair use and that the commercial character of parody did not create a presumption against fair use, but rather was only one element in fair use inquiry).

[72] 535 U.S. 722 (2002).

[73] 520 U.S. 17 (1997).

not bar suit against every equivalent to the amended claim element.[74] This holding overturned the Federal Court's attempt to impose a bright-line rule requiring the patentee to surrender *all* equivalents to the amended claim element, which the Court viewed as ignoring the "guidance" provided by *Warner-Jenkinson* and "disrupt[ing] the settled expectations of the inventing community."[75]

IV. PRACTICAL CONSIDERATIONS IN SEEKING *CERTIORARI* REVIEW

Preparing a petition for *certiorari* is not an easy task, and there is no magic formula that guarantees success. This is particularly true in the area of IP law, where the Court grants at most two or three cases a year, with some Terms experiencing a complete dearth of IP cases. Some practical pointers that should be followed in all cases are worth reviewing.

A. Narrow the Issues

It is important to recognize that, like all appellate review, the petitioner-appellant must take the time to narrow the issues on which review is sought. Appeals courts are not interested in reviewing every plausible error below; there simply is no time for a complete retrial on appeal. This consideration is even more important at the Supreme Court level. A petitioner must attempt to narrow the issues presented to one or two, and not pursue multiple issues that suggest a lack of significance, given the unlikely prospect that one case will raise multiple issues warranting *certiorari* review. What this means is that by the time you reach the Supreme Court, you have to recognize that you must drop some issues that you lost below, and try instead to focus on picking one or two potential winners. This is often a very difficult process for a trial lawyer who does not want to relinquish any possible argument, but that is the art and necessity of appellate practice.

B. Frame the Questions Presented

The drafting of the question presented can be a formidable challenge. Good drafting requires the preparation of alternatives that can be eliminated, each of which attempts to phrase the issue for review in a different manner. Simple and easily understood questions that appear compelling in their logic are more likely to grab the attention of law clerks and Justices than complex and poorly worded examples that are indecipherable. Your question should make the Justices want to reach out and grab the issue, rather than dulling their eye as they weigh through a convoluted iteration that is impossible to comprehend. Remember, this is your fifteen seconds of fame as the nine Justices each review your question, which will be presented up front at the very beginning of your petition. Since the Court reviews many thousands of petitions in a given year, you cannot expect them to try and

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[74] *See Festo*, 535 U.S. at 737–38.
[75] *Id.* at 738.

distill what the issues really are on their own; there simply is not enough time or resources available. Once again, the Court provides guidance on this topic in Supreme Court Rule 14, as follows:

> RULE 14. CONTENT OF A PETITION FOR A *WRIT OF CERTIORARI*
>
> 1. A petition for a writ of certiorari shall contain, in the order indicated:
> (a) The questions presented for review, expressed concisely in relation to the circumstances of the case, without unnecessary detail. The questions should be short and should not be argumentative or repetitive. . . . The questions shall be set out on the first page following the cover, and no other information may appear on that page. The statement of any question presented is deemed to comprise every subsidiary question fairly included therein. Only the questions set out in the petition, or fairly included therein, will be considered by the Court.[76]

C. Deal with Stare Decisis

It is hard enough to get the Supreme Court to accept your petition in cases where the Court has not yet spoken. It is even more difficult to get the Court to accept a petition that appears to seek (or expressly seeks) to overturn prior decisions of the Court, particularly if the law has become settled in that area. But it is not impossible, especially if the make-up of the Court has changed over the intervening years, or the economy or other circumstances have changed. One caveat is that the petitioner must not attempt to hide the fact that the petition seeks to overturn applicable precedents, as it is highly unlikely that the Court will overlook them when considering the petition. Any perception that the petitioner is trying to gloss over such precedent will only discredit the arguments presented.

D. Emphasize the Practical Importance of the Case.

No matter what the topic area, the Court is most interested in deciding only significant cases that are worthy of its time and attention. But since most Justices have little experience as practitioners in any specialty area (or at least, any recent experience), particularly in the field of IP law, it is crucial that the petition explain, in simple terms, why it is so critical to the field of IP law to reverse the decision below. This factor is one that generally favors IP law petitions over many others. The rapid pace of technological change often provides the platform for advocating for new rules to replace or distinguish outmoded doctrines that no longer meet the needs of the current state of technology. Hence the interest of the Court in taking on cases involving patents in new areas (such as patenting life forms) or new forms of copying that suggest the need for addressing older copyright statutory provisions (such as the

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[76] SUP. CT. R. 14(1)(a).

invention of the VCR and the development of electronic databases, which make it simple and nearly cost-free to make perfect electronic copies of protected works).

The interest of the Justices in a given case is not infrequently influenced at least in part by their law clerks' enthusiasm for a topic. Once again, IP law is one area that gains from this factor. Law clerks frequently are more current on the state of new technology than their employers. They often are attracted to technology cases and thus willing to put in extra effort to dig into the issues presented to see if there are any diamonds in the rough that warrant a strong recommendation for review.

E. Solicit Help From Others.

There is no need to go it alone in seeking review in many instances. Supporters willing to submit an amicus brief in support of your position should be lined up well in advance of the due date for a petition, as the same due date applies to their briefs. Moreover, if the opposing party does not consent to an amicus brief, a motion for leave to file it will be necessary.[77] One key supporter in many cases is the United States, particularly when questions of statutory interpretation or constitutional issues are presented.

V. CONCLUSION

Advocacy before the U.S. Supreme Court is not an art that is practiced by large numbers of practitioners. Given the limited number of cases in which review is granted each year, the chances of having a petition for *certiorari* granted are quite slim, and even slimmer for IP cases generally. That does not mean, however, that a case that ultimately reaches the federal appellate level is not generally *certiorari*-worthy. The vast majority of complaints filed in federal courts concerning IP matters are settled prior to trial. Even fewer are appealed after a verdict is reached or a judgment is entered. In those few cases that are the subject of a federal circuit court opinion, the issues raised on appeal tend to be those that are less certain as to their outcome and thus more significant in the eyes of the Court, unless the appeal was taken despite the lack of any support for the arguments presented. As a result, many appellate court decisions, if properly presented, have the potential for selection for review by the Supreme Court. For that reason, close attention to detail in preparing the petition, and especially close attention to the legal argument and prior rulings of the Court in the area at issue, may lead to success even for practitioners who have little or no prior experience before the Court.

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[77] *See generally* SUP. CT. R. 37.