UIC
REVIEW OF INTELLECTUAL PROPERTY LAW

FOREWORD: THE SUPREME COURT'S CHANGING APPROACH TO PATENT LAW

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INTRODUCTION

One of my proudest accomplishments as a law student from 1999-2002 at the John Marshall Law School ("JMLS") in Chicago was that I was one of the co-founders of what is today called the *UIC Review of Intellectual Property Law* ("RIPL").[2] Within the course of about a year, we co-founders took RIPL from a mere germ of an idea to a full-fledged journal. During this short time period, we were able to obtain administrative approval,[3] obtain faculty approval, recruit faculty advisors and interested students, and assemble an editorial board.

And once we got all of that out of the way, we were left with just a small detail: publish actual issues of our new journal with actual articles by actual authors. Somehow, in the 2001-02 academic year, we were able to publish the first two issues of RIPL. Amazingly, this first volume of RIPL featured articles from a Supreme Court

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[2] The original title was the *John Marshall Review of Intellectual Property Law*, which it remained until the merger of the John Marshall Law School ("JMLS") with the University of Illinois at Chicago in 2019. *UIC John Marshall Law School Makes History, Becomes Chicago's First and Only Public Law School*, https://today.uic.edu/uic-john-marshall-law-school-makes-history-becomes-chicagos-first-and-only-public-law-school (Sept. 16, 2019).

[3] The Dean of JMLS at the time was the late Robert Gil Johnston (1931–2018). *See* Bob Goldsborough, *Robert Johnston, Teacher and Mentor at John Marshall Law School, Dies*, CHI. TRIBUNE, July 27, 2018, https://www.chicagotribune.com/news/obituaries/ct-met-robert-johnston-obituary-20180726-story.html. Dean Johnston's enthusiastic support was vital to the success of RIPL.

Justice,[4] a Chinese judge,[5] distinguished professors[6] and practitioners,[7] as well as a full complement of student comments.[8] Moreover, we were extremely proud that Judge Paul R. Michel of the U.S. Court of Appeals for the Federal Circuit[9] wrote the foreword to our very first issue.[10]

To this day I am unsure of how we managed to accomplish so much in just those two years—particularly in academia, where the wheels of progress often turn slowly. Back then, I was a law student; today, I am a law professor. Now that I look at things from the "professor side" rather than the "student side," I am even more amazed at what we accomplished. With the founding of RIPL, we certainly caught lightning in a bottle.

Since its founding twenty years ago, RIPL has stood the test of time and has flourished. As of this writing, RIPL ranks third out of twenty-five U.S. intellectual-

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[4] John Paul Stevens, *Section 43(a) of the Shakespeare Canon of Statutory Construction: The Beverly W. Pattishall Inaugural Lecture in Trademark Law*, 1 J. MARSHALL REV. INTELL. PROP. L. 179 (2002).

[5] Guangliang Zhang, *Remedies for Patent Infringement: A Comparative Study of U.S. and Chinese Law*, 1 J. MARSHALL REV. INTELL. PROP. L. 35 (2001).

[6] Janice M. Mueller, *At Sea in a Black Box: Charting a Clearer Course for Juries Through the Perilous Straits of Patent Invalidity*, 1 J. MARSHALL REV. INTELL. PROP. L. 3 (2001); Doris Estelle Long, *"Unitorrial" Marks and the Global Economy*, 1 J. MARSHALL REV. INTELL. PROP. L. 191 (2002); Kenneth L. Port, *On Red-Haired Waitresses, Shakespeare, and Product Configuration: A Response to Justice Stevens*, 1 J. MARSHALL REV. INTELL. PROP. L. 218 (2002); Harold C. Wegner, *An Enzo White Paper: A New Judicial Standard for a Biotechnology "Written Description" Under 35 U.S.C. § 112, ¶ 1*, 1 J. MARSHALL REV. INTELL. PROP. L. 254 (2002).

[7] Robert L. Harmon, *When a Patent Claim is Broader Than the Disclosure: The Federal Circuit's Game Has No Rules*, 1 J. MARSHALL REV. INTELL. PROP. L. 21 (2001); Mark V.B. Partridge, *Trade Dress Protection and the Problem of Distinctiveness*, 1 J. MARSHALL REV. INTELL. PROP. L. 225 (2002); Charles W. Shifley, *The Three Stages to Successful Appellate Advocacy Before the Federal Circuit*, 1 J. MARSHALL REV. INTELL. PROP. L. 238 (2002).

[8] Ronald E. Andermann, *Employee Inventors, the Dual Ladder, and the Useful Arts: From Thomas Paine to the "Dilbert Boycott,"* 1 J. MARSHALL REV. INTELL. PROP. L. 310 (2002); Tony Goodman, *The California Gold Rush and the Model Rules: Do the Prospectors Have Sufficient Guidance?*, 1 J. MARSHALL REV. INTELL. PROP. L. 109 (2001); Willard L. Hemsworth III, *The Nexus Requirement and the Fatal Injury: Does an Offer to Sell an Infringing Product Give Rise to a Duty to Defend Under a CGL?*, 1 J. MARSHALL REV. INTELL. PROP. L. 344 (2002); Adam G. Kelly, *The Inherent Limitations Doctrine: How the Specification May Inherently Limit the Scope of the Claims*, 1 J. MARSHALL REV. INTELL. PROP. L. 124 (2001); Adrienne N. Kitchen, *Go to Jail—Do Not Pass Go, Do Not Pay Civil Damages: The United States' Hesitation Towards the International Convention on Cybercrime's Copyright Provisions*, 1 J. MARSHALL REV. INTELL. PROP. L. 364 (2002); Anna E. Morrison, *The USPTO's New Utility Guidelines: Will They Be Enough to Secure Patent Protection in Biotech?*, 1 J. MARSHALL REV. INTELL. PROP. L. 142 (2001); Starr Nelson, *Rock and Roll Royalties, Copyrights and Contracts of Adhesion: Why Musicians May Be Chasing Waterfalls*, 1 J. MARSHALL REV. INTELL. PROP. L. 163 (2001); Gregory F. Sutthiwan, *Prosecution Laches as a Defense to Infringement: Just In Case There Are Any More Submarines Under Water*, 1 J. MARSHALL REV. INTELL. PROP. L. 383 (2002).

[9] The Honorable Paul Redmond Michel is a retired judge of the U.S. Court of Appeals for the Federal Circuit. Federal Judicial Center, *Michel, Paul Redmond*, https://www.fjc.gov/node/1385081 (last visited Mar. 18, 2021). He served as judge from 1988 to 2004, and as chief judge from 2004 until his retirement in 2010. *Id.* Additionally, Judge Michel has served as an adjunct professor at JMLS since 1991. *Id.*

[10] Paul R. Michel, *Founding a New Journal in the Age of Electronic Law*, 1 J. MARSHALL REV. INTELL. PROP. L. 1 (2001).

property-law journals under the metric of the Washington and Lee School of Law.[11] And, it has been ranked in the top ten for the last ten years, and in the top five in the last seven years.[12] Thanks to the stewardship of twenty student editorial boards, along with the continued guidance of committed faculty advisors, RIPL has come a long way in twenty years. I am proud to contribute to the foreword of this special anniversary issue of RIPL.

Much has changed in the world of patent law since the founding of RIPL twenty years ago. In particular, the involvement of the United States Supreme Court in patent law has dramatically increased since RIPL began.[13] As a law student, I took Patent and Trade Secret Law at JMLS in Fall 2000 with Professor Janice Mueller.[14] I vividly remember at the start of that class that Professor Mueller taught us that the Supreme Court rarely heard patent cases. She told us that we should think of the U.S. Court of Appeals for the Federal Circuit as the real supreme court of patent law.[15] Indeed, the outline I created for this class[16] refers to forty Federal Circuit cases but only nineteen

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[11] W&L LAW JOURNAL RANKINGS, https://managementtools4.wlu.edu/LawJournals/ (for journal criteria, choose "Intellectual Property" as the subject and "United States" as the country) (last visited Mar. 18, 2021). This ranking is based on the Washington and Lee "combined score.".

[12] *Washington and Lee Ranks UIC Review of Intellectual Property as a Top IP Journal for the Tenth Consecutive Year*, https://news.jmls.uic.edu/featured-news/washington-and-lee-ranks-uic-review-of-intellectual-property-as-a-top-ip-journal-for-the-tenth-consecutive-year (last visited Sept. 9, 2020).

[13] Of course, I do not intend to imply any causal relationship between the founding of RIPL and the increase of the Supreme Court's role in patent law. *Cf.* Stephen M. Rice, *Argument's Design: The Post Hoc Ergo Propter Hoc Fallacy in Legal Argument and Analysis*, 89 UMKC L. REV. 279, 292 (2020) (characterizing the "post hoc ergo propter hoc" fallacy as one involving "arguments asserting that one event caused another event only because the earlier event preceded the later event").

[14] Janice M. Mueller was on the JMLS faculty from 1999 to 2004. *Curriculum Vitae: Janice M. Mueller*, (May 26, 2020), https://chisum-patent-academy.com/wp-content/uploads/cv_janice_mueller_26May2020-1.doc. She left JMLS to join the faculty of the University of Pittsburgh Law School, where she served until 2011. *Id.* In 2009, she "co-founded the Chisum Patent Academy with Donald S. Chisum," and she has served as a faculty member there ever since. *About Us: Chisum Patent Academy*, https://chisum-patent-academy.com/about-us/ (last visited Mar. 18, 2021). She is the author of a student treatise, JANICE M. MUELLER, PATENT LAW (Aspen Student Treatise Series) (6th ed. 2020), and an annually updated two-volume practitioner treatise, JANICE M. MUELLER, MUELLER ON PATENT LAW (2021).

Professor Mueller served in the first group of faculty advisors to RIPL. Without her guidance, advice, and encouragement throughout the founding process, RIPL would never have gotten off the ground. Moreover, she authored the very first article that ever appeared in RIPL: Janice M. Mueller, *At Sea in a Black Box: Charting a Clearer Course for Juries Through the Perilous Straits of Patent Invalidity*, 1 J. MARSHALL REV. INTELL. PROP. L. 3 (2001).

[15] Professor Mueller was not alone in this view. *See* Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 387 (2001) ("The Court of Appeals for the Federal Circuit, created in 1982, has become the de facto supreme court of patents."). *See also* Peter O. Huang, eBay v. MercExchange *as a Sign of Things to Come: Is the Supreme Court Still Reluctant to Hear Patent Cases*, 8 J. APP. PRAC. & PROCESS 373, 374–75 (2006) ("For the next two decades [after the creation of the Federal Circuit in 1982], the Supreme Court seemed almost to have delegated final review of patent cases to the Federal Circuit . . . ." (citing *id.*)).

[16] Yes, I saved and still have my outlines (and other papers) from law school. *Cf.* Alberto Pertusa, et al., *Refining the Diagnostic Boundaries of Compulsive Hoarding: A Critical Review*, 30 CLINICAL PSYCHOL. REV. 371, 383 (2010) (defining "compulsive hoarding" as "the excessive collection and failure to discard objects of apparently little value, leading to clutter, distress, and disability").

Supreme Court cases.[17] And of these nineteen Supreme Court cases, only four were less than ten years old when I created my outline in 2000, and four of them were from the nineteenth century.[18]

Of course, Professor Mueller's statements about the lack of Supreme Court involvement in patent law were completely correct at the time. But since then, the state of things has certainly changed. Beginning in 2002, the number of patent cases decided by the Supreme Court began to skyrocket.[19] And the Court went from deferring to the Federal Circuit's expertise to frequently altering the Federal Circuit's patent jurisprudence.[20] This change in the quantity and nature of the Supreme Court's involvement in patent law is one of the most significant changes to the patent-law landscape since RIPL's creation.

This essay contrasts the Supreme Court's involvement in patent law before RIPL began with the Court's involvement after RIPL began. Part A of this essay begins by describing the pre-RIPL role of the Supreme Court in patent law. Part B then discusses the Court's involvement in patent law after the creation of RIPL in 2001, as well as the reasons put forth by scholars as to why the Supreme Court has continually rejected the Federal Circuit's approach to various patent-law matters during this period.

A. PRE-RIPL: 2001 AND BEFORE

In 2001, the year in which RIPL began, Professor Mark Janis observed that "[t]he Supreme Court ha[d] rendered itself well nigh invisible in modern substantive patent law."[21] Indeed, from 1982—when the U.S. Court of Appeals for the Federal Circuit was created—to 2000, the Supreme Court decided only ten patent cases, which

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[17] Ted L. Field, Outline for Patent and Trade Secret Law (Dec. 15, 2000) (on file with author) (mentioning Dickinson v. Zurko, 527 U.S. 150 (1999); Pfaff v. Wells Elecs., Inc., 525 U.S. 55 (1998); Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997); Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996); Diamond v. Diehr, 450 U.S. 175 (1981); Diamond v. Chakrabarty, 447 U.S. 303 (1980); Dawson Chem. Co. v. Rohm & Haas Co., 448 U.S. 176 (1980); Brenner v. Manson, 383 U.S. 519 (1966); Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966); Walker Process Equip., Inc. v. Food Mach. & Chem. Corp., 382 U.S. 172 (1965); Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605 (1950); Morton Salt Co. v. G.S. Suppinger Co., 314 U.S. 488 (1942), *abrogated by* Illinois Tool Works Inc. v. Indep. Ink, Inc., 547 U.S. 28 (2006); Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926); Consol. Elec. Light Co. v. McKeesport Light Co., 159 U.S. 465 (1895); City of Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126 (1877); Hotchkiss v. Greenwood, 52 U.S. 248 (1850)).

[18] *See* Field, *supra* note 17.

[19] *See, e.g.*, Timothy B. Dyk, *Thoughts on the Relationship between the Supreme Court and the Federal Circuit*, 16 CHI.-KENT J. INTELL. PROP. 67, 67–68 (2016); Samuel F. Ernst, *A Patent Reformist Supreme Court and Its Unearthed Precedent*, 29 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1, 4 (2018); Paul R. Gugliuzza, *The Supreme Court Bar at the Bar of Patents*, 95 NOTRE DAME L. REV. 1233, 1234 (2020); Peter Lee, *The Supreme Assimilation of Patent Law*, 114 MICH. L. REV. 1413, 1416 (2016).

[20] *See, e.g.*, Ernst, *supra* note 19, at 4–5, 11–14; Gugliuzza, *supra* note 19, at 1234–35; Timothy R. Holbrook, *Is the Supreme Court Concerned with Patent Law, the Federal Circuit, or Both: A Response to Judge Timothy B. Dyk*, 16 CHI.-KENT J. INTELL. PROP. 313, 317 (2016); Huang, *supra* note 15, at 374; Lee, *supra* note 19, at 1416.

[21] Janis, *supra* note 15, at 387.

works out to about one case every two years.[22] During this period, the Court left issues of patent law almost exclusively to the Federal Circuit, which Congress gave "exclusive jurisdiction over appeals of patent decisions of the district courts"[23] as well as "appeals from denials of patent grants by the U.S. Patent and Trademark Office."[24] In creating the Federal Circuit, Congress intended that this new court should "contribute to increased uniformity and reliability" in patent law and its other areas of exclusive appellate jurisdiction.[25]

Because the Federal Circuit was given jurisdiction over almost all patent cases, the judges of this court were expected to develop "specialized expertise in the area of patent law."[26] Thus, it was not surprising that the Supreme Court would defer to the Federal Circuit most of the time.[27] An express example of this deference occurred in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,[28] in which the Court stated: "We expect that the Federal Circuit will refine the formulation of the test for equivalence in the orderly course of case-by-case determinations, and *we leave such refinement to that court's sound judgment in this area of its special expertise*."[29]

Of course, even before 2001, the Supreme Court never stayed out of patent law entirely. When I took Patent and Trade Secret Law at JMLS in 2000, although for the most part we studied Federal Circuit cases, we nonetheless studied these important Supreme Court patent cases:

- *Pfaff v. Wells Electronics, Inc.*,[30] setting out the rule for when an invention was on-sale for purposes of novelty under § 102;[31]
- *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,[32] refining the test for infringement under the doctrine of equivalents and the contours of prosecution history estoppel;

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[22] Huang, *supra* note 15, at 375. Even before the creation of the Federal Circuit, the Supreme Court decided relatively few patent cases. Ernst, *supra* note 19, at 9. Indeed, the Court decided only five patent cases in the 1950s, sixteen in the 1960s, and ten cases in the 1970s. *Id.*

[23] Ted L. Field, *Improving the Federal Circuit's Approach to Choice of Law for Procedural Matters in Patent Cases*, 16 GEO. MASON L. REV. 643, 643 (2009).

[24] *Id.* at 643 n.2 (citing 28 U.S.C. § 1295(a)(4)(A)).

[25] Howard T. Markey, *The Federal Circuit and Congressional Intent*, 41 AM. U. L. REV. 577, 577 (1992). The late Howard T. Markey (1920–2006) was the first Chief Judge of the Federal Circuit. Federal Judicial Center, *Markey, Howard Thomas*, https://www.fjc.gov/history/judges/markey-howard-thomas (last visited Mar. 19, 2021); Patricia Sullivan, *Howard Markey; First Chief Judge of Federal Circuit Appellate Court*, WASH. POST, May 5, 2006, https://www.washingtonpost.com/wp-dyn/content/article/2006/05/04/AR2006050402155.html. He received an LL.M. in patent law from the John Marshall Law School in 1950. Federal Judicial Center, *supra.* After retiring from the bench in 1991, he served as Dean of the John Marshall Law School until 1994. Sullivan, *supra.*

[26] Ernst, *supra* note 19, at 11.

[27] *See* Huang, *supra* note 15, at 374 ("For many years, the Supreme Court regularly deferred to the Federal Circuit in patent cases . . . ."); William C. Rooklidge & Matthew F. Weil, *En Banc Review,* Horror Pleni*, and the Resolution of Patent Law Conflicts*, 40 SANTA CLARA L. REV. 787, 815 (2000) ("Congress gave the Federal Circuit the task of ironing out the inconsistencies in patent law, and during the first dozen or so years of the Federal Circuit's existence, the Supreme Court was very deferential to the new court's substantive patent law decisions.").

[28] 520 U.S. 17 (1997).

[29] *Id.* at 40 (emphasis added).

[30] 525 U.S. 55 (1998).

[31] *Id.* at 67.

[32] 520 U.S. 17 (1997).

- *Markman v. Westview Instruments, Inc.*,[33] deciding that the judge should construe patent terms, not the jury;[34]
- *Diamond v. Diehr*,[35] considering the subject-matter eligibility of a patented process that was an inventive application of a scientific formula;
- *Diamond v. Chakrabarty*,[36] holding that a genetically engineered living organism was subject-matter eligible;[37]
- *Brenner v. Manson*,[38] providing a standard for the utility requirement for a chemical composition;[39]
- *Graham v. John Deere*,[40] outlining the legal framework for determining the obviousness of a claim under § 103;[41]
- *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*,[42] recognizing the existence of infringement under the doctrine of equivalents;[43]
- *Alexander Milburn Co. v. Davis-Bournonville Co.*,[44] establishing that an earlier-filed application that ultimately matures into a patent is prior art, a holding which was later codified as § 102(e) of the 1952 Patent Act and then § 102(a)(2) of the America Invents Act ("AIA");[45] and
- *City of Elizabeth v. Am. Nicholson Pavement Co.*,[46] establishing the doctrine of experimental use with respect to novelty determinations.[47]

Although these ten cases may seem like a lot at first glance, consider that these cases span from 1877 to 1998, and only three of them were decided after the creation of the Federal Circuit in 1982. But by 2001 when RIPL began, the Supreme Court's involvement in the world of patent law was about to change.

B. POST-RIPL: 2001 AND BEYOND

After RIPL began in 2001, things began to change with the Supreme Court and patent law.[48] Indeed, since 2001, the Supreme Court has issued opinions in forty-five patent cases.[49] If you haven't yet looked at the footnote supporting the previous

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[33] 517 U.S. 370 (1996).
[34] *Id.* at 372.
[35] 450 U.S. 175 (1981).
[36] 447 U.S. 303 (1980).
[37] *Id.* at 310.
[38] 383 U.S. 519 (1966).
[39] *Id.* at 534.
[40] 383 U.S. 1 (1966).
[41] *Id.* at 14.
[42] 339 U.S. 605 (1950).
[43] *Id.* at 608–09.
[44] 270 U.S. 390 (1926).
[45] *Id.* at 400.
[46] 97 U.S. 126 (1877).
[47] *Id.* at 134–35.
[48] *See, e.g.*, Lee, *supra* note 19, at 1416 ("Over the past decade and a half, the Supreme Court has significantly increased its review of patent decisions from the . . . Federal Circuit."). Again, I am pointing out a correlation; I do not intend to imply any causal link. *See supra* note 13.
[49] Thryv, Inc v. Click-To-Call Techs., LP, 140 S. Ct. 1367 (2020); Peter v. Nantkwest, Inc., 140 S. Ct. 365 (2019); Return Mail, Inc. v. United States Postal Serv., 139 S. Ct. 1853 (2019); Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc., 139 S. Ct. 628 (2019); WesternGeco LLC v. ION Geophysical Corp., 138 S. Ct. 2129 (2018); Oil States Energy Servs., LLC v. Greene's Energy Grp.,

sentence, please do so now; I'll wait. Did you see how long it was? The length of this footnote alone should impress upon you how large the number of patent cases is that the Supreme Court has decided since 2001. Unsurprisingly, these cases "have had a major impact on patent law."[50] Indeed, "most of the Court's cases have involved important and foundational questions with enormous impacts on patent litigation."[51]

Indeed, Judge Dyk of the Federal Circuit determined that from 2006 through 2016, the Supreme Court took an average of four Federal Circuit cases each term, making up "5.4% of the Court's merits cases."[52] Although not all these cases were patent cases, "[a] large proportion of [these] cases . . . involved patent law or related procedural issues."[53] During this time period, the Supreme Court reviewed proportionally more Federal Circuit cases than those of any other circuit, taking into account "the total number of cases decided by each circuit."[54] As Judge Dyk pointed out, these statistics show that "the Supreme Court was significantly more likely to review cases from [the Federal Circuit] and the D.C. Circuit than from any of the other circuits."[55]

Thus, unlike when I was in law school taking patent law at the time RIPL began, students in law school today taking patent law must study many Supreme Court patent cases. Back in 2001, a patent case from the Supreme Court was a relative

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LLC, 138 S. Ct. 1365 (2018); SAS Inst., Inc. v. Iancu, 138 S. Ct. 1348 (2018); Sandoz Inc. v. Amgen Inc., 137 S. Ct. 1664 (2017); Impression Prods., Inc. v. Lexmark Int'l, Inc., 137 S. Ct. 1523 (2017); TC Heartland LLC v. Kraft Foods Grp. Brands LLC, 137 S. Ct. 1514 (2017); SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC, 137 S. Ct. 954 (2017); Life Techs. Corp. v. Promega Corp., 137 S. Ct. 734 (2017); Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429 (2016); Cuozzo Speed Techs., LLC v. Lee, 136 S. Ct. 2131 (2016); Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923 (2016); Kimble v. Marvel Entm't, LLC, 576 U.S. 446 (2015); Commil USA, LLC v. Cisco Sys., Inc., 575 U.S. 632 (2015); Teva Pharm. USA, Inc. v. Sandoz, Inc., 574 U.S. 318 (2015); Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 573 U.S. 208 (2014); Limelight Networks, Inc. v. Akamai Techs., Inc., 572 U.S. 915 (2014); Nautilus, Inc. v. Biosig Instruments, Inc., 572 U.S. 898 (2014); Highmark Inc. v. Allcare Health Mgmt. Sys., Inc., 572 U.S. 559 (2014); Octane Fitness, LLC v. ICON Health & Fitness, Inc., 572 U.S. 545 (2014); Medtronic, Inc. v. Mirowski Family Ventures, LLC, 571 U.S. 191 (2014); FTC v. Actavis, Inc., 570 U.S. 136 (2013); Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 569 U.S. 576 (2013); Bowman v. Monsanto Co., 569 U.S. 278 (2013); Gunn v. Minton, 568 U.S. 251 (2013); Kappos v. Hyatt, 566 U.S. 431 (2012); Caraco Pharm. Labs., Ltd. v. Novo Nordisk A/S, 566 U.S. 399 (2012); Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66 (2012); Microsoft Corp. v. i4i Ltd. P'ship, 564 U.S. 91 (2011); Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc., 563 U.S. 776 (2011); Global-Tech Appliances, Inc. v. SEB S.A., 563 U.S. 754 (2011); Bilski v. Kappos, 561 U.S. 593 (2010); Quanta Computer, Inc. v. LG Elecs., Inc., 553 U.S. 617 (2008); Microsoft Corp. v. AT & T Corp., 550 U.S. 437 (2007); KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007); MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007); eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006); Illinois Tool Works Inc. v. Indep. Ink, Inc., 547 U.S. 28 (2006); Merck KGaA v. Integra Lifesciences I, Ltd., 545 U.S. 193 (2005); Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826 (2002); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002); J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc., 534 U.S. 124 (2001).

[50] Dyk, *supra* note 19, at 72.

[51] *Id.* Interestingly, "[s]ince 2000, patent cases have dominated the Supreme Court's docket compared to other intellectual property cases." Holbrook, *supra* note 20, at 314.

[52] Dyk, *supra* note 19, at 67.

[53] *Id.*

[54] *Id.* at 68. Interestingly, "the D.C. Circuit [was] a close second." *Id.*

[55] *Id.*

novelty, and professors must have been excited when the Court released such a case.[56] But today, we professors who teach patent law must view the Supreme Court as creating work for us: every year, we find ourselves compelled to add multiple Supreme Court cases from the previous year to our syllabi.

Importantly, the Supreme Court has not been kind to the Federal Circuit in these many cases that it has decided since 2001. Largely gone are the days of the Court deferring to the Federal Circuit's "sound judgment in this area of its special expertise."[57] Instead, after 2001, the Court became "increasingly interested in scrutinizing and, more often than not, correcting the patent law jurisprudence of the Federal Circuit."[58] Indeed, when I am teaching my students about these cases, I often refer to them as examples of the Supreme Court "spanking" the Federal Circuit.

It all began with the Supreme Court's first post-2001 patent case, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,[59] in which the Court certainly spanked the Federal Circuit.[60] In *Festo*, the Court "once again [addressed] the relation between two patent law concepts, the doctrine of equivalents and the rule of prosecution history estoppel," which it had considered just five years earlier in *Warner-Jenkinson*.[61] In *Festo*, the Federal Circuit sitting en banc held that "[w]hen [prosecution history] estoppel applies, it stands as a complete bar against any claim of equivalence for the element that was amended."[62] The majority of the Federal Circuit reasoned that "the flexible-bar rule [was] unworkable because it [would] lead[] to excessive uncertainty and burden[] legitimate innovation."[63] But the Supreme Court rejected the Federal Circuit's bright-line approach and instead adopted a flexible approach.[64]

After *Festo*, the Supreme Court was off and running. The Court began to decide patent case after patent case, most often disagreeing with the Federal Circuit's approach.[65] Since 2002, the Court has decided cases in many different areas of patent law. Highlights include the following:

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[56] For example, when I took Patent & Trade Secret Law at JMLS in 2000, I remember Professor Mueller excitedly teaching us the ins and outs of what was then the most recent Supreme Court patent case, *Dickinson v. Zurko*, 527 U.S. 150 (1999). In *Zurko*, the Court held that the Federal Circuit must follow the Administrative Procedure Act ("APA") and apply the APA's standards of review when reviewing findings of fact made by the U.S. Patent and Trademark Office. *Id.* at 152. Despite Professor Mueller's then-justified enthusiasm, the *Zurko* case was far from the most important of the Supreme Court's patent cases since the creation of the Federal Circuit. *See* Dyk, *supra* note 19, at 72 (characterizing *Zurko* as a case that "may not have had a significant impact").

[57] Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 40 (1997).

[58] Ernst, *supra* note 19, at 4–5.

[59] 535 U.S. 722 (2002).

[60] *See* John F. Duffy, *The* Festo *Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 283 (2002) ("The tenor of recent patent opinions shows that the Court is becoming increasingly comfortable in reviewing patent decisions and increasingly interested in directing the development of law in the field."). *See also* Paul R. Gugliuzza, *supra* note 19, at 1234 (citing *id.* and discussing *Festo* as the start of the Supreme Court's uptick in patent cases).

[61] *Festo*, 535 U.S. at 726 (citing *Warner-Jenkinson*, 520 U.S. 17).

[62] *Id.* at 730.

[63] *Id.* at 737. Four Federal Circuit judges dissented from this decision. *Id.* at 730.

[64] *Id.* at 737. Rejecting the Federal Circuit's bright-line rules was to become a theme of the Supreme Court during the post-2001 period. Ernst, *supra* note 19, at 13; *accord* Dyk, *supra* note 19, at 80; Lee, *supra* note 19, at 1416.

[65] *See* Ernst, *supra* note 19, at 11–12.

- **Subject-matter eligibility (§ 101[66])**: The Court has taken a deep dive into patent subject-matter eligibility—and not necessarily for the better[67]—in *Bilski*,[68] *Mayo*,[69] *Myriad*,[70] and *Alice Corp.*[71]
- **Prior art (§ 102[72])**: The Court weighed in on what qualifies as prior art under the AIA in *Helsinn*.[73]
- **Obviousness (§ 103[74])**: The Court rejected a rigid application of the Federal Circuit's application of the "teaching, suggestion, motivation to combine" test in *KSR*.[75]
- **Claim definiteness (§ 112(b)[76])**: The Court altered the test for whether a claim is sufficiently definite in *Nautilus*.[77]
- **Infringement**: The Court altered aspects of induced infringement under § 271(b)[78] three times in *Global-Tech*,[79] *Limelight*,[80] and *Commil*,[81] and it considered extraterritorial infringement under § 271(f)[82] three times in *Microsoft Corp.*,[83] *Life Technologies*,[84] and *WesternGeco*.[85]
- **Patent exhaustion**: The Court ruled on patent-exhaustion issues three times in *Quanta Computer*,[86] *Bowman*,[87] and *Impression Products*.[88]
- **Injunctions**: The Court rejected the Federal Circuit's patent-law-specific approach to permanent injunctions in *eBay*.[89]
- **Jurisdiction and venue**: The Court considered jurisdictional and venue issues in patent litigation three times in *Vornado*,[90] *Gunn*,[91] and *TC Heartland*.[92] The Court's decision in *TC Heartland* was particularly important in that it rejected the Federal Circuit's interpretation of the patent venue statute[93] and thus greatly reduced

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[66] 35 U.S.C. § 101 (2021).

[67] *See, e.g.*, Holbrook, *supra* note 20, at 319 (characterizing the Supreme Court's "foray into patentable subject matter" as "hav[ing] simply gone off the rails").

[68] Bilski v. Kappos, 561 U.S. 593 (2010).

[69] Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66 (2012).

[70] Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 569 U.S. 576 (2013).

[71] Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 573 U.S. 208 (2014).

[72] 35 U.S.C. § 102 (2021).

[73] Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc., 139 S. Ct. 628, 634 (2019).

[74] 35 U.S.C. § 103 (2021).

[75] KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 415 (2007).

[76] 35 U.S.C. § 112(b) (2021).

[77] Nautilus, Inc. v. Biosig Instruments, Inc., 572 U.S. 898, 910–11 (2014).

[78] 35 U.S.C. § 271(b) (2021).

[79] Global-Tech Appliances, Inc. v. SEB S.A., 563 U.S. 754 (2011).

[80] Limelight Networks, Inc. v. Akamai Techs., Inc., 572 U.S. 915 (2014).

[81] Commil USA, LLC v. Cisco Sys., Inc., 575 U.S. 632 (2015).

[82] 35 U.S.C. § 271(f) (2021).

[83] Microsoft Corp. v. AT & T Corp., 550 U.S. 437 (2007).

[84] Life Techs. Corp. v. Promega Corp., 137 S. Ct. 734 (2017).

[85] WesternGeco LLC v. ION Geophysical Corp., 138 S. Ct. 2129 (2018).

[86] Quanta Computer, Inc. v. LG Elecs., Inc., 553 U.S. 617 (2008).

[87] Bowman v. Monsanto Co., 569 U.S. 278 (2013).

[88] Impression Prods., Inc. v. Lexmark Int'l, Inc., 137 S. Ct. 1523 (2017).

[89] eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 394 (2006).

[90] Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826 (2002).

[91] Gunn v. Minton, 568 U.S. 251 (2013).

[92] TC Heartland LLC v. Kraft Foods Grp. Brands LLC, 137 S. Ct. 1514 (2017).

[93] 28 U.S.C. § 1400(b) (2021).

the availability of so-called patent-friendly districts (such as the Eastern District of Texas) to patentees.[94] The Court also rejected the Federal Circuit's approach to declaratory-judgment jurisdiction in *MedImmune*,[95] and it then considered declaratory-judgment jurisdiction again in *Medtronic*.[96]

- **Damages and fees**: The Court altered the Federal Circuit's approach to the award of compensatory damages, attorney fees, and enhanced damages in *Samsung*,[97] *Octane Fitness*,[98] and *Halo Electronics*,[99] respectively.
- **Standards of proof and standards of review**: In a rare affirmance of the Federal Circuit, in *i4i*,[100] the Court maintained that the standard of proof for invalidity is clear and convincing evidence.[101] But the Court rejected the Federal Circuit's approaches to standards of review for the issues of the award of attorney fees and claim construction in *Highmark*[102] and *Teva*,[103] respectively.
- **Inter-partes and other post-grant review**: The Court considered aspects of inter-partes and other post-grant review five times in *Cuozzo*,[104] *SAS*,[105] *Oil States*,[106] *Return Mail*,[107] and *Thryv*.[108]

As these examples[109] show, the Supreme Court has certainly created quite the large body of work in these and other patent-law decisions since 2001. Importantly, during this time, the Court has rejected the Federal Circuit's approach with respect to almost all these issues—often in favor of accused infringers and to the detriment of patentees.[110] The Court's increased involvement in patent law has led to a state of affairs described by Judge Dyk as follows:

> There is a perceived tension between the Supreme Court and our court by the bar and by the academy. We and the Supreme Court appear to be united in agreeing that patent law is important, but there is often a perception that the Supreme Court on the one hand, views us as having a parochial attitude or as we know best attitude toward patent law, as being deeply divided, and as being overly patent-friendly. On

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[94] *See, e.g.*, Will Nilsson, *Patently Unworkable: Fixing Patent Venue in the Wake of* TC Heartland *and In Re* Cray, 71 BAYLOR L. REV. 730, 739 (2019) ("Almost immediately after the Court's decision [in *TC Heartland*], filings in the Eastern District of Texas plummeted.").

[95] MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 137 (2007).

[96] Medtronic, Inc. v. Mirowski Family Ventures, LLC, 571 U.S. 191 (2014).

[97] Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 436 (2016).

[98] Octane Fitness, LLC v. ICON Health & Fitness, Inc., 572 U.S. 545, 555–56 (2014).

[99] Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1935 (2016).

[100] Microsoft Corp. v. i4i Ltd. P'ship, 564 U.S. 91 (2011).

[101] *Id.* at 95.

[102] Highmark Inc. v. Allcare Health Mgmt. Sys., Inc., 572 U.S. 559, 564 (2014).

[103] Teva Pharm. USA, Inc. v. Sandoz, Inc., 574 U.S. 318, 322 (2015).

[104] Cuozzo Speed Techs., LLC v. Lee, 136 S. Ct. 2131 (2016).

[105] SAS Inst., Inc. v. Iancu, 138 S. Ct. 1348 (2018).

[106] Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC, 138 S. Ct. 1365 (2018).

[107] Return Mail, Inc. v. United States Postal Serv., 139 S. Ct. 1853 (2019).

[108] Thryv, Inc v. Click-To-Call Techs., LP, 140 S. Ct. 1367 (2020).

[109] These cases are just examples—not all of the Supreme Court's patent cases since 2001 are included here. *See supra* note 49 (citing all the Court's patent cases since 2001).

[110] Ernst, *supra* note 19, at 35 ("The inescapable conclusion is that the Supreme Court is engaged in an ongoing project of patent litigation reform to favor accused infringers.").

> the other hand, our bar and the academy have expressed skepticism that the Supreme Court understands patent law well enough to make the governing rules—an attitude not likely to be endearing to the Supreme Court. As two commentators have uncharitably asked: "Is the Supreme Court too unsophisticated in patent law to appreciate the wise insights of expert Federal Circuit judges, or are those Federal Circuit judges too narrowly focused on patent law to appreciate the broader rules of jurisprudence, procedure, and statutory interpretation?"[111]

Interestingly, despite this state of affairs, Judge Dyk has stated that he "believe[s] that Supreme Court review of [the Federal Circuit's] patent cases has been critical to the development of patent law and likewise beneficial to [the] court."[112] Indeed, Judge Dyk further noted that "[t]he Supreme Court necessarily plays a critical role in reinterpreting, or even overruling, earlier Supreme Court decisions and in altering [the Federal Circuit's] jurisprudence to keep up with the demands of a changing world."[113]

Of course, the Supreme Court's approach to patent law during this time period raises the questions of why the Court suddenly began to take such an interest in patent law, and why the Court began to disagree with the Federal Circuit at such a high rate. Scholars have speculated that one, more, or all of the following rationales explain the Supreme Court's behavior.

- "The Federal Circuit's rule [under review by the Supreme Court] granted insufficient discretion to the district court . . . ."[114]
- "The Federal Circuit imposed a rigid, inflexible rule where a flexible standard would be more appropriate . . . ."[115]
- "The Federal Circuit improperly created a special rule for patent law, rather than relying on general legal frameworks or principles of federal law . . . ."[116]
- "The Federal Circuit disregarded Supreme Court precedent."[117]
- The Federal Circuit succumbed to interest-group capture because it is a specialized court.[118]
- "[T]he Supreme Court . . . might be playing the role of 'percolator' of patent doctrine—a necessary function in a field where, because of the Federal Circuit's

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[111] Dyk, *supra* note 19, at 80 (quoting Jeff Bleich & Josh Patashnik, *The Federal Circuit Under Fire*, S.F. ATT'Y, Fall 2014, at 40, 41–42).

[112] *Id.* at 71.

[113] *Id.* (quoting Timothy B. Dyk, *Does the Supreme Court Still Matter?*, 57 AM. U. L. REV. 763, 768 (2008)). *But cf.* Rebecca Emory, *Losing Your Head in the Washer—Why the Brainwashing Defense Can Be A Complete Defense in Criminal Cases*, 30 PACE L. REV. 1337, 1341 (2010) (defining "'Stockholm Syndrome' as a psychological phenomenon whereby a hostage develops positive feelings for his or her captor" (quoting United States v. Chancey, 715 F.2d 543, 547 (11th Cir. 1983))).

[114] *See* Ernst, *supra* note 19, at 12.

[115] *Id.* at 13; *accord* Dyk, *supra* note 19, at 80; Lee, *supra* note 19, at 1416.

[116] Ernst, *supra* note 19, at 13; *accord* Gugliuzza, *supra* note 19, at 1234–35; Lee, *supra* note 19, at 1416.

[117] Ernst, *supra* note 19, at 13.

[118] Gugliuzza, *supra* note 19, at 1234.

exclusive jurisdiction, intercircuit dialogue about the content of the law does not exist."[119]

- "[I]n a digitized and networked world, intellectual property rights are of greater social and economic importance than they were a few decades ago."[120]
- An increasing number of patent cases are brought to the Supreme Court by elite lawyers who specialize in Supreme Court litigation rather than patent law, and the Court "the Court is highly sympathetic to the arguments pressed by those elite lawyers, who often represent the world's largest corporations in matters of significant interest to the business community."[121]
- The Supreme Court has had to "rein in expansive Federal Circuit doctrine that has made it too easy to obtain patents and unduly enhanced their power."[122]

Most likely, all of these rationales are true to some extent. But whatever the explanations, no one can reasonably deny that since 2002, soon after RIPL began, the Supreme Court began to hear and decide patent cases at a much higher rate than before, and that the Court stopped deferring to the Federal Circuit and repeatedly altered that court's patent-law jurisprudence.

CONCLUSION

Patent law has undergone significant changes in the last twenty years since RIPL began. One of the biggest of these changes is that the Supreme Court has become much more active in patent law and much less likely to defer to the Federal Circuit's interpretations of both substantive and procedural patent law.

I hesitate to predict whether this trend will continue. The Court's increased involvement in patent law seemed to come out of the blue in 2002, and this involvement could wane just as quickly. Plus, the composition of the Court has changed greatly over the past few years, with Justices Gorsuch, Kavanaugh, and Barrett recently joining the Court. And some have speculated that Justice Breyer may retire in the not-too-distant future. All of these changes in Court personnel make it even more difficult to predict what will happen.

But if I had to predict, I believe that the Court will continue on its current path for the foreseeable future. And even if the Court eventually does return to pre-2001 levels of involvement in patent law, I predict that this change will not happen for some time; it seems that we are continuing to ride the crest of the wave for now.

I wait eagerly to see what happens with the Supreme Court and the Federal Circuit over the next twenty years. And I hope that I am around to read RIPL's fortieth-anniversary issue recapping exactly what does happen!

Cite as Ted Field, *Foreward: The Supreme Court's Changing Approach To Patent Law*, 21 UIC REV. INTELL. PROP. L. 1 (2021).

[119] *Id.* at 1235.
[120] *Id.*
[121] *Id.* at 1235–36.
[122] Lee, *supra* note 19, at 1416.