UIC
REVIEW OF INTELLECTUAL PROPERTY LAW

SYMPOSIUM ON THE RETIREMENT OF JUSTICE STEPHEN BREYER

FOREWORD

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With the forthcoming retirement of Justice Stephen Breyer in June or July 2022,[1] the editors of the *UIC Review of Intellectual Property Law* have asked four contributors to look back on Breyer's contributions to intellectual property law while on the Supreme Court. This sort of symposium could probably be done for many retiring justices, but it's particularly appropriate for Breyer. At the time of his appointment in 1994, Breyer was seen as having some expertise in copyright[2]—and being skeptical about its scope, as revealed in his 1970 *Harvard Law Review* article on the "Uneasy Case for Copyright."[3] To be sure, Breyer's interest in copyright was overshadowed by his interest and experience with antitrust and administrative law,[4] but he described the 1970 article as "awfully important" to him and the subject of great effort.[5]

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[1] Breyer said his retirement would take effect when the Court's current term ends, "typically late June or early July," provided the appointment of his successor has occurred by then. *See* Letter from Stephen Breyer to President Joseph Biden (Jan. 27, 2022), https://www.supremecourt.gov/publicinfo/press/Letter_to_President_January-27-2022.pdf. The Senate met Breyer's proviso by confirming President Biden's nomination of by a vote of 53 to 47 on April 7, 2022. *See* Mary Clare Jalonick & Mark Sherman, *Historic Step*, CHI. TRIB., at 1 (April 8, 2022).

[2] *See* Christopher Wilson, *Breyer Survivor Free of Partisan Enemies*, L.A. TIMES (May 15, 1994) ("Friends and associates say Breyer is no ideologue. He has concentrated on cases involving copyright, anti-trust and government regulation.").

[3] Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

[4] *See, e.g.*, *Nomination of Stephen G. Breyer to be Associate Justice of the Supreme Court of the United States: Hearing before the S. Comm. on the Judiciary*, 103rd Cong. 8 (1994) (opening statement of Sen. Orrin Hatch referring to Breyer's "expertise in administrative law and antitrust"); 11 (opening statement of Sen. Edward Kennedy referring to Breyer achieving an "outstanding reputation for his scholarship in the areas of antitrust law and administrative law").

[5] *Id.* at 124 ("[T]hat article was awfully important to me, because what turned on that article for me was a job. The question was whether I would get tenure, so I put quite a lot of effort into that article.").

Breyer's article on copyright—and even a published opinion on trademark law—could have been the subject of some meaningful discussion in 1994, but during his confirmation hearings, the senators on the Judiciary Committee did not show much interest in Breyer's views on copyright specifically or intellectual property law generally. Topics like constitutional law and antitrust understandably took center stage. Senator Orrin Hatch did ask Breyer one question about the article, however. He asked Breyer if his views had changed since its publication, but despite noting the article had been controversial, Hatch didn't seem all that interested in the answer. He eventually cut Breyer off without any follow-up questions and then moved on to a different topic.[6] During his tenure on the First Circuit, then Judge Breyer also said some interesting things about trademark liability in a case about unofficial television coverage of the Boston Marathon.[7] Breyer pushed back against an earlier First Circuit decision that arguably expanded Lanham Act liability.[8] According to a fair reading of the earlier case, which also involved the Boston Marathon, the court treated a showing of the defendants' free riding on the plaintiff's reputation as sufficient to satisfy the likelihood of confusion requirement for infringement.[9] Breyer's opinion "interpreted" the earlier case narrowly, emphasizing the need for a plaintiff to show a likelihood of confusion.[10] Breyer's thoughts on trademark law did not generate even one question from the senators. Nor was the press much interested in either intellectual property topic.[11]

Even if Justice Breyer's *potential* contributions to intellectual property law did not grab the senators' or the press' interest in 1994, we can devote some attention to Breyer's *actual* contributions now. So how did things turn out? I'll leave it to the four essays that follow to offer answers to this question, but I will note that many criticisms lie ahead. Shubha Ghosh refers to Breyer's "confounding treatment of patentable and copyright subject matter."[12] David Taylor credits Breyer with "arguably one of the worst Supreme Court decisions in the field of patent law in recent memory[.]"[13] (He's talking about *Mayo*.[14]) Kevin Noonan's title gives away his take, as it refers to Justice Breyer as "No Friend to IP Law."[15] Noonan focuses mainly on patent law, but he also comments on Breyer's copyright opinions.

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[6] *Id.* at 124–25.

[7] *See* WCVB-TV v. Bos. Ath. Ass'n, 926 F.2d 42 (1st Cir. 1991).

[8] *Id.* at 45.

[9] *See* Bos. Ath. Ass'n v. Sullivan, 867 F.2d 22, 33 (1st Cir. 1989).

[10] *WCVB-TV*, 926 F.2d at 45 ("The trademark statute does not give the appellants any 'property right' in their mark *except* 'the right to prevent confusion.'") (emphasis in original).

[11] The level of interest in these topics at the time of Breyer's confirmation was not zero. *See* Richard Carelli, *Breyer's Approach Low-Key on Controversial Topics*, THE ADVOCATE (Baton Rouge, La., May 14, 1994) (referring to the *WCVB-TV* case). But the level of interest appears to have been negligible. Feel free to do whatever searches you wish in the various electronic news databases to measure journalistic (dis)interest in these topics.

[12] Shubha Ghosh, *A La Recherche De Breyer Perdu*, 21 UIC REV. INTELL. PROP. L. 38, 43 (2022).

[13] David O. Taylor, *Justice Breyer and Patent Eligibility*, 21 UIC REV. INTELL. PROP. L. 71, 71 (2022).

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

[15] Kevin E. Noonan, *Justice Breyer: No Friend to IP Law*, 21 UIC REV. INTELL. PROP. L. 58 (2022)

But things are not all bad in this Breyer IP retrospective. Despite various criticisms, Ghosh praises Breyer's "lemony sponge cake" opinions[16] and his multidisciplinary approach to judging.[17] In *Qualitex*, the decision involving the use of color as a trademark,[18] Ghosh finds "consequentialism at its finest,"[19] and he also sees some commendable nuance in Breyer's thinking about copyright.[20] And Willajeanne McLean, who focuses exclusively on *Qualitex*, is also quite positive, finding the decision sound and the contemporary predictions of disaster inaccurate.[21]

Lemony sponge cake ahead, but with some sour notes.

Cite as William K. Ford, *Symposium of the Retirement of Justice Stephen Breyer*, 21 UIC REV. INTELL. PROP. L. 35 (2022).

[16] Ghosh, *supra* note 12, at 38.
[17] *Id*. at 48.
[18] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995).
[19] Ghosh, *supra* note 12, at 41.
[20] *Id*. at 42.
[21] Willajeanne F. McLean, *Coloring Inside the Lines: A Look at* Qualitex v. Jacobson, 21 UIC REV. INTELL. PROP. L. 49 (2022).