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Defective Patent Deference

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DEFECTIVE PATENT DEFERENCE

Tejas N. Narechania*

Abstract: The Supreme Court’s implicit deference to the Office of the Solicitor General in patent cases is well-documented: What the Solicitor General requests, the Solicitor General typically receives. But we know far less about how the Solicitor General arrives at these preferred policy positions, or why the Solicitor General comes to advocate for some outcomes over others. This is problematic. In practically every other corner of the administrative state, an agency earns substantial deference to its views only where robust procedural protections attend to the policymaking process, where the agency’s outcome reflects its substantive expertise, and where the agency may, through presidential removal and election, be held politically accountable for its policy choices.

Not so in patent law. The Patent Office has never claimed to exercise any substantive rulemaking power. Meanwhile, the Solicitor General develops and advocates for patent policy outcomes, but behind closed doors, without deep internal expertise, and under the time constraints of appellate litigation. These shortcomings (among others) suggest that we should reexamine the Solicitor General’s influence over patent policy in favor of alternate interpretive practices that improve Executive Branch decisionmaking. And they counsel in favor of several reforms—most importantly, to the policymaking power of the Patent Office.

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INTRODUCTION

The Solicitor General of the United States is known to wield a wide influence over the United States Supreme Court's decisions,¹ so much so that the Solicitor General is sometimes called the "Tenth Justice."² This moniker suggests a role for the Office of the Solicitor General (OSG) that is adjunct to the Judiciary. But in patent contexts, OSG seems instead more like its counterparts across the Executive Branch, making (as well as defending) substantive policy.

Consider, for example, the Supreme Court's seminal decision on the patentability of isolated genetic matter, *Association for Molecular Pathology v. Myriad Genetics*.³ There, the Court unanimously held that "synthetically created DNA . . . is patent eligible because it is not naturally occurring" and that "a naturally occurring DNA segment is a product of nature and not patent eligible merely because it has been

1. See, e.g., Margaret M. Cordray & Richard Cordray, *The Solicitor General's Changing Role in Supreme Court Litigation*, 51 B.C. L. REV. 1323, 1324 (2010) ("The U.S. Solicitor General, as the U.S. Supreme Court's premier advocate, has long exerted significant influence over both the Court's case selection decisions and its substantive decisions on the merits.")

2. E.g., LINCOLN CAPLAN, *THE TENTH JUSTICE: THE SOLICITOR GENERAL AND THE RULE OF LAW* (1987); REBECCA MAE SALOKAR, *THE SOLICITOR GENERAL: THE POLITICS OF LAW* 94–100 (1992); David A. Strauss, *The Solicitor General and the Interests of the United States*, 61 L. & CONTEMP. PROBS. 165, 168–69 (1998). Justice Kagan, however, once (perhaps jokingly) repudiated this characterization, suggesting that the Solicitor General was more like the "37th clerk" than the "10th Justice." *Confirmation Hearing on the Nominations of Thomas Perrelli, Nominee, to be Associate Attorney General of the United States, and Elena Kagan, Nominee, to be Solicitor General of the United States Before the S. Comm. on the Judiciary*, 111th Cong. 47 (Feb. 10, 2009), <https://www.govinfo.gov/content/pkg/CHRG-111shrg55828/pdf/CHRG-111shrg55828.pdf> [<https://perma.cc/V5LZ-LHKT>] (statement of Elena Kagan) ("It is frequently said that the Solicitor General serves as the 10th Justice. . . . I suspect that the Justices think of the Solicitor General more as the 37th clerk."); see also Roger Clegg, *The Thirty-Fifth Law Clerk*, 1987 DUKE L.J. 964 (1987).

3. 569 U.S. 576 (2013).

isolated.”⁴ That is, a gene’s patentability depends on whether it is “naturally occurring.”⁵

But one exceptional aspect of this decision hides behind the Court’s opinion and in the Government’s *amicus curiae* brief in the case. There, the Solicitor General, on behalf of the Executive Branch, argued for this very same distinction: “Synthesized genetic materials . . . are patent-eligible subject matter because they do not occur in nature” and that “isolated but otherwise unmodified DNA is not patent-eligible.”⁶ Some scholars have explained that though the Solicitor General’s argument (and the Supreme Court’s holding) is “not entirely compelling” “[f]rom a formal scientific or legal perspective,” it nevertheless embodies a reasonable policy approach in light of the difficult line drawing problems that attend to deciding what, exactly, ought to be patentable.⁷ In short, faced with the legal ambiguity regarding the contours of patent eligibility, the Court seems to have accepted the policy approach advanced by the Solicitor General.

One further, remarkable feature of *Myriad* lurks in the internal deliberative processes that informed the Solicitor General’s *amicus* brief. Unusually, no personnel from the U.S. Patent and Trademark Office (or Patent Office, for short) signed the Government’s brief in the case.⁸ And that notable absence seemed to reflect a “continuing inter-agency disagreement[.]” over the correct policy approach to the patentability of isolated-but-naturally occurring DNA.⁹ That patent conflict was ultimately resolved—first, within the Executive Branch; and second, in the Judiciary—against the Patent Office.¹⁰

Myriad thus highlights two important aspects of the Supreme Court’s approach to its patent docket.

4. *Id.* at 580.

5. *Id.*

6. Brief for the United States as Amicus Curiae in Support of Neither Party at 9, *Myriad*, 569 U.S. 576 (No. 12-398), 2013 WL 390999 [hereinafter *Myriad* Amicus Brief].

7. Arti K. Rai, *Patent Validity Across the Executive Branch: Ex Ante Foundations for Policy Development*, 61 DUKE L.J. 1237, 1258–60 (2012) (“From a formal scientific or legal perspective, the distinction . . . is not entirely compelling From a policy standpoint, however, the U.S. government’s distinction has some appeal.”); see also Rochelle C. Dreyfuss, Jane Nielsen & Dianne Nicol, *Patenting Nature—A Comparative Perspective*, 5 J. L. & BIOSCIENCES 550, 571 (2018) (explaining that Australia’s High Court rejected a similar distinction because both types of DNA bear the same relevant characteristics).

8. See *Myriad* Amicus Brief, *supra* note 6, at 34.

9. *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 689 F.3d 1303, 1358 (Fed. Cir. 2012) (Bryson, J., concurring in part and dissenting in part).

10. See *infra* section I.B.1; see also Tejas N. Narechania, *Patent Conflicts*, 103 GEO. L.J. 1483 (2015); cf. Jeffrey A. Burt & Irving S. Schloss, *Government Litigation in the Supreme Court: The Roles of the Solicitor General*, 78 YALE L.J. 1442, 1457 (1969) (OSG’s “power over the agencies’ litigation substitutes executive for judicial review.”).

First, the Supreme Court often (though not always) appears to defer to the Executive Branch's interpretations of the patent laws: Viewing the Executive Branch as more institutionally competent (for any of a variety of reasons) to decide these complex, technical cases, the Court seems content to adopt the views advanced by the Executive.¹¹ Indeed, other scholars have explained that the Supreme Court applies a regime of "consultative deference" in patent cases, yielding a "shift in power from the courts to the [E]xecutive [B]ranch."¹² Such deference may be especially likely—and especially consequential—where the Executive Branch clarifies legal ambiguity through exercises of policy discretion. In most contexts, this would be rather unremarkable. Ever since the Supreme Court's decision in *Chevron v. Natural Resources Defense Council*,¹³ such deference to executive determinations has been routine.¹⁴ But the administration of the patent system has long been one notable exception to this hornbook rule.¹⁵ For example, the Court of Appeals for the Federal Circuit—the near-exclusive arbiter of patent appeals—has held (incorrectly, in my view) that the Patent Office has no authority to issue substantive patent rules.¹⁶ Indeed, the Supreme Court has since called the Federal Circuit's rule into question.¹⁷ But the Patent Office nevertheless seems reluctant to issue authoritative rules of, say, patent

11. See *Myriad*, 569 U.S. at 596 (Scalia, J., concurring); cf. David C. Thompson & Melanie F. Wachtell, *An Empirical Analysis of Supreme Court Certiorari Petition Procedures: The Call for Response and the Call for the Views of the Solicitor General*, 16 GEO. MASON L. REV. 237, 281 (2009).

12. Lauren E. Baer & William N. Eskridge, Jr., *The Continuum of Deference: Supreme Court Treatment of Agency Statutory Interpretations from Chevron to Hamdan*, 96 GEO. L.J. 1083, 1111–15 (2008); John Duffy, *The Federal Circuit in the Shadow of the Solicitor General*, 78 GEO. WASH. L. REV. 518, 545 (2010).

13. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 842–44 (1984).

14. See generally Thomas W. Merrill, *The Story of Chevron: The Making of an Accidental Landmark*, 66 ADMIN. L. REV. 253 (2014).

15. See, e.g., Melissa F. Wasserman, *The Changing Guard of Patent Law: Chevron Deference for the PTO*, 54 WM. & MARY L. REV. 1959, 1971 (2013) ("The Federal Circuit has yet to afford the PTO's validity determinations any deference, much less the highly deferential standard announced in *Chevron*."); see also Duffy, *supra* note 12, at 544–45.

16. See, e.g., *Cooper Techs. v. Dudas*, 536 F.3d 1330, 1335–36 (Fed. Cir. 2008) (explaining that the Patent Office has the power to issue to procedural rules, but not substantive ones); *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996) (holding that even "the broadest of the PTO's rulemaking powers . . . does NOT grant the Commissioner the authority to issue substantive rules").

17. See *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2143 (2016) (noting that the Patent Act "does not clearly contain" the Federal "Circuit's claimed limitation" on Patent Office rulemaking power "to procedural rules" only); see also William C. Neer, *Discerning the Retroactive Policymaking Powers of the United States Patent and Trademark Office*, 71 ADMIN. L. REV. 413, 422 & n.69 (2019).

eligibility.¹⁸ Hence, *any* deference to the Executive Branch on matters of patent policy may seem—as a descriptive matter—remarkable.

Second, the Supreme Court appears to defer to the Solicitor General’s Office in particular. *Myriad* highlights OSG’s practice of sometimes advancing arguments inconsistent with the Patent Office’s practices or rationales (to the extent the Patent Office has any such articulated views). It is, to be sure, somewhat unusual for the Solicitor General to directly contravene the views advanced by an agency with primary authority over a policy matter.¹⁹ But more subtle conflicts between OSG and the Patent Office often arise. Sometimes, for example, OSG will advocate for a rule that is inconsistent with the Patent Office’s established practices, or it will advance a new rationale for a Patent Office regulation. It is these arguments—rather than the established practices or the given rationales of the Patent Office—that seem to hold special sway.

OSG’s special influence turns, in significant part, on the identity of its client: The United States of America. When the Solicitor General speaks, he speaks as the voice of a political branch, accountable to the public and committed to the country’s best interests.²⁰ And OSG’s

18. But, as I elaborate *infra* notes 328–330 and accompanying text, the Patent Office has issued guidance to its examiners, attempting to “simplify and clarify” the work of determining whether an invention is patentable. See Andrei Iancu, Dir., U.S. Patent & Trademark Office, Remarks Delivered at the U.S. Chamber of Commerce: Driving American Innovation Policy Conference (Feb. 25, 2019), <https://www.uspto.gov/about-us/news-updates/remarks-director-iancu-us-chamber-commerce-driving-american-innovation-policy> [<https://perma.cc/7S82-58JX>]. And this Patent Office’s specific practices in this respect may be problematic in various respects. See *infra* notes 380–386 and accompanying text. Moreover, the Patent Office has increasingly relied on adjudicative processes to set out, via agency precedent, procedural rules (as opposed to substantive patent rules). See Saurabh Vishnubhakat, *Disguised Patent Policymaking*, 76 WASH. & LEE L. REV. 1667, 1720 (2019) (noting that, “in the main, these [precedential] opinions pertain to the procedural structure” of the Patent Office’s adjudicative processes).

19. But for one such example, see Lorelei Laird, *DOJ Argues that Law Doesn’t Protect Transgender Workers, Opposing the EEOC*, A.B.A. J. (Oct. 26, 2018, 9:40 AM), https://www.abajournal.com/news/article/doj_argues_that_law_doesnt_protect_transgender_workers_opposing_the_eoc [<https://perma.cc/PM5W-9J2U>]; see also Margaret H. Lemos, *The Solicitor General as Mediator Between State and Agency*, 2009 MICH. ST. L. REV. 185, 197–204.

20. It is also true, of course, that the Solicitor General’s Office has a well-earned reputation for producing especially skilled advocates. Perhaps some of OSG’s successes can be attributed to such skill. But empirical studies of the Solicitor General’s Office and its lawyers cast serious doubt on that claim. See, e.g., RYAN C. BLACK & RYAN J. OWENS, *THE SOLICITOR GENERAL AND THE UNITED STATES SUPREME COURT: EXECUTIVE BRANCH INFLUENCES AND JUDICIAL DECISIONS* 89–91 (2012) [hereinafter BLACK & OWENS, *EXECUTIVE BRANCH INFLUENCES*] (finding that OSG’s relative success cannot be explained by the experience of its attorneys, the quality of its attorneys, its resource advantages, or its selectivity in case selection); see also Ryan C. Black & Ryan J. Owens, *A Built-In Advantage: The Office of the Solicitor General and the U.S. Supreme Court*, 66 POL. RES. Q. 454, 457–61 (2012) [hereinafter Black & Owens, *A Built-In Advantage*] (similar). Instead, these studies suggest it is the Office’s professional, “credible commitment to broader goals of justice and efficiency” that “influences the Court.” BLACK & OWENS, *EXECUTIVE BRANCH INFLUENCES*, *supra*, at 91; see also Stephen I. Vladeck, *The Solicitor General and the Shadow*

defenses of agency policies are, in the usual case, informed by the choices made by an expert agency, one that is itself delegated policymaking power from Congress, and that is required to undertake a public process of debate and consideration. Indeed, the Court recently explained that formal deference to the Executive Branch depends on such features, including congressional delegation, agency expertise, and deliberative process.²¹

But these conditions do not typically apply to the views advanced by the Solicitor General's Office in patent matters. So where there is conflict or inconsistency between OSG and the Patent Office—or even where there is no conflict, but where, instead, the Patent Office channels its policy preferences to the Court via OSG before testing these choices through typical administrative process—it is worth considering where authority, accountability, and expertise lie. Congress has not, for example, delegated any substantive interpretative authority over the patent laws to the Solicitor General.²² Though most agency policymaking processes are open for public comment and somewhat flexible, the Solicitor General's consultative processes are largely shielded from public scrutiny and are governed by the relatively rigid demands of judicial process. And the Solicitor General has no special expertise in, say, innovation policy.²³ In the end, OSG has arrived at a

Docket, 133 HARV. L. REV. 123, 123–24 (2019) (quoting Simon E. Sobeloff, *Attorney for the Government: The Work of the Solicitor General's Office*, 41 A.B.A. J. 229, 229 (1955)). In short, OSG's institutional commitment to the interests of the public and the federal government—as opposed to mere short-term gains—seems to get some special credit from the Supreme Court. See *infra* notes 209–210 and accompanying text; section III.B; cf. Lisa F. Grumet, *Hidden Nondefense: Partisanship in State Attorneys General Amicus Briefs and the Need for Transparency*, 87 FORDHAM L. REV. 1859, 1860 (contending, analogously, that state attorneys general owe “accountability” and internal “separation of powers” duties to their home governments and constituencies in their Supreme Court advocacy).

21. See, e.g., *Kisor v. Wilkie*, 588 U.S. ___, 139 S. Ct. 2400, 2415–18 (2019) (explaining that deference to an agency's interpretations of its own regulations depends on such factors).

22. See 28 U.S.C. § 505 (2019).

23. Of course, in cases like *Myriad*, the Solicitor General's position may reflect the views of some other agency with relevant domain expertise—such as the National Institutes of Health. See Sandra S. Park, *Gene Patents and the Public Interest: Litigating Association for Molecular Pathology v. Myriad Genetics and Lessons Moving Forward*, 15 N.C. J. L. & TECH. 519, 526 (2014); see also Narechania, *supra* note 10, at 1504–06; Rai, *supra* note 7, at 1261. But even where the Solicitor General is thrust into the position of mediating such an interagency policy dispute, there remain competence- and process-based reasons to reconsider the extent of the Solicitor General's influence. It is, for example, far from clear that Congress has delegated to OSG the power and responsibility to mediate such intra-Executive patent conflicts. Moreover, in such innovation contexts, OSG would seem to suffer an expertise deficit. And unlike many other forms of interagency deliberation, interested parties—private parties and sister agencies, among others—may have only limited, if any, opportunities to participate in OSG's process of policymaking-by-litigation. See, e.g., 17 U.S.C. § 1201(a)(1)(C) (2019) (describing a public rulemaking proceeding, but one which requires the Register of Copyrights to “consult with the Assistant Secretary for Communications and Information of the Department of Commerce”). I explore the interagency

variety of patent policy positions: some OSG positions conflict with the Patent Office's practices; some OSG rationales are inconsistent with the Patent Office's reasoning; and some OSG outcomes endorse the Patent Office's unenacted, untested, and potentially-controversial policy preferences. In short, the Solicitor General's Office is an odd candidate for the special solicitude that it appears to enjoy.

The Supreme Court's apparent practice of deferring to the Solicitor General, thereby shifting the locus of Executive Branch patent policymaking to OSG, thus merits further scrutiny. The Patent Office, faced with a reviewing court that has expressed severe skepticism of agency deference, has rarely attempted to exercise substantive policymaking power. This is so even though its statutory powers might be understood as conferring (at least some) policymaking power on the Patent Office.²⁴ Instead, the Patent Office issues—at best—nonbinding guidelines. Or it informally channels its substantive expertise and policy preferences to the Supreme Court by way of the Solicitor's General Office. There is, of course, significant value to ensuring that OSG's arguments are informed by the Patent Office's expertise, and OSG may offer the Patent Office a useful channel for challenging the Federal Circuit's interpretations of patent law.²⁵ But OSG has the final word. In short, the Solicitor General's Office has, by way of its role coordinating the Executive Branch's participation in litigation, been thrust into the position of effectively making patent policy. And though OSG is ill-equipped to make policy on its own and in the first instance, the Court nevertheless often seems content to defer to the arguments advanced by the Solicitor General. In other contexts, such deference to the Executive Branch may be appropriate because the Solicitor General conveys to the Court the underlying, procedurally-compliant, and well-considered views of an expert agency anointed by Congress to set policy.²⁶ Not so here: The Patent Office often has no authoritative policy views, and the

conflict dimension of the Solicitor General's role in greater depth in another project, entitled *Structuring Intraexecutive Patent Conflict*.

24. See, e.g., 35 U.S.C. §§ 2(b)(2)(A), 316(a)(4) (2018); see also *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2143 (2016); Neer, *supra* note 17, at 422 & n.69 (2019); Sarah Tran, *Patent Powers*, 25 HARV. J. L. & TECH. 609, 614 n.29 (2012).

25. See John M. Golden, *The Supreme Court as Prime Percolator: A Prescription for Appellate Review of Questions in Patent Law*, 56 UCLA L. REV. 657, 662 (2009) (contending that the Supreme Court plays a valuable role in "percolating" Federal Circuit rules); cf. John F. Duffy & Craig A. Nard, *Rethinking Patent Law's Uniformity Principle*, 101 NW. U. L. REV. 1619, 1623 (2007) (suggesting that more circuits, beyond only the Federal Circuit, should have jurisdiction over patent claims); Dmitry Karshedt, *Acceptance Instead of Denial: Pro-Applicant Positions at the PTO*, 23 B.U. J. SCI. & TECH. L. 319, 324 (2017) (suggesting that the Patent Office directly advocate against its internal decisions to challenge Federal Circuit precedent).

26. Lemos, *supra* note 19, at 187 ("[T]he SG's intervention is more legalistic than political.").

Solicitor General is neither empowered nor best-placed to make them. The Supreme Court's implicit regime of patent deference has no clothes.

These shortcomings counsel in favor of a Patent Office that exercises more policymaking power.

One might suggest, instead, that the Supreme Court revisit its latent patent deference regime. But the Court itself is no more expert than the Solicitor General in issues of patent and innovation policy. And to the extent this expertise deficit motivates its deference to the Executive Branch,²⁷ it would seem odd to advocate for substantial changes to the Court's mode of judicial review (at least, of course, without more fundamental changes to the Court's own substantive expertise).²⁸

Another possible locus for such change may be the Solicitor General's Office itself. That Office might, for example, be required to receive public comment from private actors and interested agencies alike before responding to the Court's calls for *amicus* help. But such process reforms cannot address other objections to the Court's deference to the Solicitor General, including those related to the absence of any legislative delegation, OSG's relative political independence, and the problems of litigation as a forum for policymaking, among others. And correcting for these problems might have the effect of undermining the institutional strengths—independence from short-term political influence, for example—that help make OSG a stable, trusted advisor to the Supreme Court.²⁹

The best option, in my view, is a Patent Office that looks more like its counterparts across the administrative state—one which makes policy decisions by way of regular administrative process, and which defends those decisions (with the Solicitor General's "legalistic" assistance) before the Judiciary.³⁰ The Patent Office is Congress's delegee on questions of intellectual property policy.³¹ The Patent Office is,

27. See Baer & Eskridge, *supra* note 12, at 1092 (“[A]gency interpretations prevail most frequently . . . in areas where the Justices perceive themselves as least competent to handle the substantive issues, areas such as . . . intellectual property.”); cf. Thompson & Wachtell, *supra* note 11, at 281.

28. Cf. Eric A. Posner & Adrian Vermuele, *Inside or Outside the System?*, 80 U. CHI. L. REV. 1743, 1744 (2013) (explaining how it is “incoherent” to “posit[] nonideal motivations for purposes of diagnosis and then posit[] idealized motivations for purposes of prescription”).

29. See, e.g., SALOKAR, *supra* note 2, at 94; see also CAPLAN, *supra* note 2, at 254–56.

30. See Lemos, *supra* note 19, at 187.

31. See, e.g., 35 U.S.C. § 2(b)(2)(A) (2018); 35 U.S.C. § 2(b)(8)–(12) (explaining that the Patent Office “shall advise the President,” the “Secretary of Commerce,” and other federal “departments and agencies” “on matters of intellectual property policy”); see also Neer, *supra* note 17, at 422 & n.69.

comparatively, the more expert option.³² The Patent Office’s political leadership can be made to account (by the President, and, by extension, the public) for its policy decisions.³³ And the Patent Office can use well-established administrative process to arrive at its policy conclusions.³⁴ Hence, I conclude that the Patent Office should exercise more policymaking power, and *those* policy conclusions that should be evaluated under the Court’s formal deference doctrines. This allocation of authority helps to improve Executive Branch decisionmaking. Under the current regime, policymaking and policy defense have collapsed into a single action at a non-ideal site—the Solicitor General’s Office. Instead, the Patent Office should set policy and OSG should defend those decisions as appropriate (as in most other matters of agency regulation). Of course, Patent Office policymaking may itself be an imperfect solution in some situations, especially in cases presenting interagency conflict, such as *Myriad*. But the Patent Office is the best of the possibilities considered here.

This Article proceeds in four parts.

First, I extend the descriptive claim, advanced by John Duffy, Rebecca Eisenberg, as well as Lauren Baer and William Eskridge (among others), that the Supreme Court effectively defers to the Solicitor General in a wide variety of patent cases.³⁵ These cases present, as I describe below, a range of intra-Executive postures, from conflict with the Patent Office to interpretative views that seem outside the scope of executive authority.³⁶ But the SG’s merits-stage briefing across all such scenarios nevertheless remains critically influential and important.³⁷ This is especially so in cases, such as *Myriad*, where the

32. See, e.g., Rai, *supra* note 7, at 1278; Jarrod Shobe, *Agency Legislative History*, 68 EMORY L.J. 283, 302 n.72 (2018); Wasserman, *supra* note 15, at 2012.

33. See *Oil States Energy Servs. v. Greene’s Energy Grp.*, 584 U.S. ___, 138 S. Ct. 1365, 1380 (2018) (Gorsuch, J., dissenting).

34. E.g., Wasserman, *supra* note 15, at 1964–65.

35. See Baer & Eskridge, *supra* note 12, at 1111–13; Duffy, *supra* note 12, at 544 (describing a shift in policymaking authority “from the judiciary to the executive branch”); Rebecca S. Eisenberg, *The Supreme Court and the Federal Circuit: Visitation and Custody of Patent Law*, 106 MICH. L. REV. FIRST IMPRESSIONS 28, 29 (2007) (noting that the Supreme Court has often resolved patent cases “in accordance with the Solicitor General’s advice”); see also Colleen V. Chien, *Patent Amicus Briefs: What the Courts’ Friends Can Teach Us About the Patent System*, 1 U.C. IRVINE L. REV. 395, 429–30 (2011); Ben Picozzi, *The Government’s Fire Dispatcher: The Solicitor General in Patent Law*, 33 YALE L. & POL’Y REV. 427, 433 (2015); Arti K. Rai, *Competing with the “Patent Court”*: *A Newly Robust Ecosystem*, 13 CHI.-KENT J. INTEL. PROP. 386, 389 (2013).

36. See *infra* section I.B.

37. I clarify, however, that the extent of this deference has varied somewhat in recent years, especially at the certiorari stage. Compare Tejas N. Narechania, *Certiorari, Universality, and a Patent Puzzle*, 116 MICH. L. REV. 1345, 1381, 1404–05 (2018) (describing recent trends at the certiorari stage), with *infra* section I.B (describing OSG’s merits-stage participation in various cases).

Court might expect to see the Executive Branch clarify legal ambiguity through policy discretion.

Second, drawing on the literature studying the Solicitor General's Office as well as that on agency deference, I compare the Court's apparent practice of deferring to the Solicitor General in patent cases to the usual rationales for judicial deference to the Executive Branch. In so doing, I aim to help expand the patent literature's connection with a broader range of administrative law concerns: I build upon the existing administrative law oriented studies of the Patent Office, focusing on expertise-related matters, while drawing upon other values, too.³⁸ For example, cases like *Chevron* and *Mead* suggest that courts defer in view of executive agencies' accumulated expertise, but also because the Executive's agents may be held to account for their decisions through elections (among other reasons).³⁹ Likewise, the Court's decision in *Kisor* emphasizes that (in addition to expertise) both congressional delegation and public deliberation matter, too.⁴⁰ Cases like *Chenery* and *Bowen v. Georgetown University Hospital* further explain that courts must not defer to litigation positions that vary from the Executive Branch's original rationales for policy action.⁴¹

The Solicitor General falls short on these metrics. Outside its participation in the Supreme Court's patent docket, OSG has little experience with substantive patent law and policy. OSG's reputation and standing with the Supreme Court is itself derived from the Office's relative independence from short-term political influence.⁴² And the SG has, on multiple occasions, advanced litigating positions that vary from the Patent Office's actions.⁴³ Indeed, such litigation-specific rationales

38. See, e.g., Stuart Minor Benjamin & Arti K. Rai, *Who's Afraid of the APA?: What the Patent System Can Learn from Administrative Law*, 95 GEO. L.J. 269, 308–20 (2007) (focusing on expertise and capture); Wasserman, *supra* note 15, at 2007–18 (same).

39. *United States v. Mead Corp.*, 533 U.S. 218 (2001); *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984).

40. See *Kisor v. Wilkie*, 588 U.S. ___, 139 S. Ct. 2400 (2019).

41. *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 212–13 (1988); *SEC v. Chenery Corp. (Chenery II)*, 332 U.S. 194 (1947); see also Lemos, *supra* note 19, at 206 n.68 (“*Bowen* . . . means that strong *Chevron* deference will not apply to positions advanced for the first time in the SG's briefs.”); Kevin M. Stack, *The Constitutional Foundations of Chenery*, 116 YALE L.J. 952, 958–59 (2007) (“*Chenery* provides a structural check for the very presumptions of agency accountability, rationality, and expertise upon which *Chevron* deference is based.”).

42. See, e.g., SALOKAR, *supra* note 2, at 94; see also BLACK & OWENS, EXECUTIVE BRANCH INFLUENCES, *supra* note 20, at 91; CAPLAN, *supra* note 2, at 256–54; Black & Owens, *A Built-In Advantage*, *supra* note 20, at 461.

43. See, e.g., *Ass'n for Molecular Pathology v. Myriad Genetics*, 569 U.S. 576, 594 (2013) (explaining that the Solicitor General's arguments before the Supreme Court and the Federal Circuit “undercut[.]” the Patent Office's preexisting practice of granting patent applications claiming naturally occurring DNA).

appear to have helped sway the Court in cases such as *Myriad* and *Cuozzo Speed Technologies v. Lee*.⁴⁴

Third, I consider the implications of the SG's extensive—but perhaps unwarranted—influence over patent policy. Given the flimsy foundations for the Court's de facto deference to the Solicitor General, I consider possible reforms to OSG, including the possibility of adding procedural controls to OSG's decisionmaking processes. Controls like those found in the Administrative Procedure Act would address some of the defects described in the second part. But not all of them. Implementing such reforms, moreover, may be infeasible—or even undesirable for reasons unrelated to patent law. I therefore turn instead to the Patent Office, and consider the possibility that the Patent Office exercise substantive policymaking power. John Golden, Arti Rai, and Melissa Wasserman, among other scholars, have considered the appropriate scope of the Patent Office's policymaking power, and have studied which formal deference doctrine, *Chevron* or *Skidmore*, should apply to Patent Office determinations.⁴⁵ But the Supreme Court's longstanding implicit deference to the Executive Branch suggests a slightly different frame for this debate: Taking the Court's proclivity to defer to the Executive Branch as constant, the more foundational question, in my view, is where *within that Branch* principal responsibility over patent policy should lie. That is, I ask not whether the Patent Office can exercise power over policy, or the extent to which the Patent Office's policy determinations should receive deferential treatment—but rather, who inside the Executive Branch must make patent policy in the first instance, and how. The answer is the Patent Office, by way of regular agency process. The Court should therefore carefully review the basis for the Executive's advocacy in patent cases, deferring only when appropriate, and otherwise referring unresolved questions back to the Patent Office under the doctrine of primary jurisdiction, in order to improve the legitimacy and quality of executive patent policymaking.⁴⁶

Finally, I conclude with several observations that put the Court's relationship with the Solicitor General in the context of the recent debates over judicial deference. I suggest that one aspect of the recent

44. 579 U.S. ___, 136 S. Ct. 2131 (2016); see *Myriad*, 569 U.S. 576; see also *infra* sections I.B.1 and I.B.2.

45. See John Golden, *Working Without Chevron: The PTO as Prime Mover*, 65 DUKE L.J. 1657 (2016); Rai, *supra* note 7, at 1278; Wasserman, *supra* note 15, at 2012.

46. *Pharm. Res. & Mfrs. of Am. v. Walsh*, 538 U.S. 644, 673 (2003) (Breyer, J., concurring in part); see *Nat'l Cable & Telecomms. Ass'n v. Gulf Power*, 534 U.S. 327, 361 (2002) (Thomas, J., concurring) (similar, but for the FCC); see also Golden, *supra* note 45, at 1696 (describing the Patent Office's authority as a “variant of ‘primary jurisdiction’”).

critiques of doctrines such as *Auer* and *Chevron* centers on some cases—including some patent cases—where the advocating agent does not appear to have earned the deference accorded to it by the Judiciary. That is, deference to the Executive Branch seems “reflexive” rather than appropriately grounded in such factors as “agency expertise” and “administrative experience.”⁴⁷ Thus, in my view, the Deference Question is not *whether* deference is appropriate but *when*. And the patent experience suggests, perhaps unsurprisingly, that a studied return to deference’s foundations helps to provide an answer.

I. DE FACTO DEFERENCE

A. *Deference De Jure*

Chevron v. Natural Resources Defense Council provides a starting point for the modern doctrine governing judicial review of—and judicial deference to—executive agency action.⁴⁸ One typical hornbook account of *Chevron* follows three steps, numbered zero through two.⁴⁹ First, at “Step Zero,” a reviewing court considers whether Congress has granted the agency the authority to administer a statutory program by issuing decisions carrying the force of law.⁵⁰ If so, then the court moves on to consider *Chevron*’s Steps One and Two.

When a court reviews an agency’s construction of the statute which it administers, it is confronted with two questions. First, always, is the question whether Congress has directly spoken to the precise question at issue. If the intent of Congress is clear, that is the end of the matter; for the court, as well as the agency, must give effect to the unambiguously expressed intent of Congress. If, however, the court determines Congress has not directly addressed the precise question at issue . . . the question

47. Compare *Pereira v. Sessions*, 585 U.S. ___, 138 S. Ct. 2105, 2120 (2018) (Kennedy, J., concurring), with *SAS Inst. v. Iancu*, 584 U.S. ___, 138 S. Ct. 1348, 1364 (2018) (Breyer, J., dissenting) (citing *Barnhart v. Walton*, 535 U.S. 212, 225 (2002)).

48. 467 U.S. 837 (1984).

49. There is, to be sure, quite a bit of “choreographic confusion” over exactly how many steps are in the analysis. See Daniel J. Hemel & Aaron L. Nielson, *Chevron Step One-and-a-Half*, 84 U. CHI. L. REV. 757, 759–60 (collecting descriptions of *Chevron* that range from one step to four).

I do not mean to suggest that this three-step account is the best description of *Chevron* doctrine today. But this three-step account does account for much of the current *Chevron* literature, see, e.g., Thomas W. Merrill & Kristin E. Hickman, *Chevron’s Domain*, 89 GEO. L.J. 833, 873–89 (2001); Cass R. Sunstein, *Chevron Step Zero*, 92 VA. L. REV. 187, 188 (2006), and, perhaps more importantly, succinctly encapsulates the features of *Chevron* deference that are relevant to my account of the Supreme Court’s implicit deference to the Solicitor General in patent cases.

50. Merrill & Hickman, *supra* note 49, at 912–13; see *United States v. Mead Corp.*, 533 U.S. 218, 229–31 (2001); see also Sunstein *supra* note 49, at 193.

for the court is whether the agency's answer is based on a permissible construction of the statute.⁵¹

Stated simply, the questions for the reviewing court are: (1) does the agency have authority to administer the statute; (2) if so, has Congress directed the agency to act in some specific manner; and (3) if Congress has not so directed, is the agency's exercise of congressionally-conferred discretion reasonable? If the duly-authorized agency's interpretation of the ambiguous statute is reasonable, then the court must defer to the agency's view.

The Supreme Court offered three rationales for this mandatory deference. One, statutory ambiguity may reflect Congress's intent to delegate (perhaps implicitly) interpretative authority to an agency.⁵² Two, as compared to the courts, agencies have greater expertise to decide what is, say, "reasonable" in respect to technical questions of environmental or telecommunications policy.⁵³ And three, agency officials, unlike courts, may be held to account for their policy decisions through presidential control, and, ultimately, presidential election.⁵⁴ In short, executive agencies often have a fair amount of leeway to administer their own regulatory programs by interpreting ambiguous statutes in view of their technical expertise and the President's policy aims.

But what if, at Step Zero, a reviewing court concludes that Congress did not grant an agency the authority to issue legally binding rules? Even then the court may defer to an agency, in view of that agency's expertise, thoroughness, and consistency (among other considerations). The Supreme Court explained in *Skidmore* that, even where agency decisions are "not controlling upon the courts," those agency "rulings, interpretations and opinions" "do constitute a body of experience and informed judgment to which courts . . . may properly resort for guidance."⁵⁵ Indeed, in *Mead*—the decision that sets out *Chevron*'s Step Zero—the Court found *Chevron*'s framework inapplicable, but nevertheless remanded for consideration under *Skidmore*.⁵⁶

51. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 842–43 (1984) (footnotes omitted).

52. *Id.* at 965; see also Abbe R. Gluck & Lisa Schultz Bressman, *Statutory Interpretation from the Inside—An Empirical Study of Congressional Drafting, Delegation, and the Canons: Part I*, 65 STAN. L. REV. 901, 995–98 (2013). But see, e.g., John F. Manning, *Chevron and the Reasonable Legislator*, 128 HARV. L. REV. 457, 458 (2014) (suggesting that such implied congressional delegation to agencies is a legal fiction).

53. *Chevron*, 467 U.S. at 865.

54. *Id.* 865–66.

55. *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

56. *United States v. Mead Corp.*, 533 U.S. 218, 221 (2001).

Chevron and *Skidmore*, then, present two related (though distinct) doctrines of de jure deference. If an agency has the authority to administer an ambiguous statute, then courts must defer to that agency's reasonable interpretation of that statute. And Congress, it seems, understands this: Legislators "draft in *Chevron*'s shadow," sometimes leaving "gaps" for the agency to fill.⁵⁷ And even where an agency lacks formal authority to administer a statute, reviewing courts may nevertheless defer to an agency interpretation that has the "power to persuade" in view of the agency's expertise, deliberative processes, and consistency over time, among other factors.⁵⁸

Here's the upshot: If either *Chevron* or *Skidmore* applies, executive agencies can exercise significant authority over the rules and policies within their domain. There are, to be sure, significant and important differences between the two. For one, where *Chevron* applies, deference is mandatory; where *Skidmore* applies, deference turns on the agency's persuasive power. And while cases following in *Chevron*'s jurisprudential lineage embrace an agency's policy flexibility, *Skidmore* expressly values an agency's "consistency with earlier and later pronouncements."⁵⁹ But these differences notwithstanding, these deference doctrines collectively recognize the Executive Branch's comparative advantages along several dimensions—expertise, deliberative capacity, political accountability, and democratic legitimacy, among others—and they empower agencies to issue substantive rules or to offer the courts substantial guidance accordingly.

B. *Deference De Facto*

The standard account of patent doctrine is quite unlike these deference regimes. Instead, this account suggests that substantive patent rules are made in Congress and in the Judiciary—and not in the Executive Branch.⁶⁰ That account is, from one narrow perspective, descriptively accurate. Congress, of course, has passed a wide range of patent statutes.⁶¹ And though those provisions empower the U.S. Patent

57. Gluck & Bressman, *supra* note 52, at 995–98; *see also infra* notes 219–220 and accompanying text.

58. *Skidmore*, 323 U.S. at 140.

59. *Compare, e.g., Nat'l Cable & Telecomms. Ass'n v. Brand X Internet Servs.*, 545 U.S. 967 (2005), with *Skidmore*, 323 U.S. at 140.

60. *E.g., Paul R. Gugliuzza, The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1828 (2013) (noting that "a strong claim can be made that power over [patent policy] is consolidated in the Federal Circuit"). *But see id.* at 1823–27 (describing some executive branch influence over patent policy).

61. Some examples include the Patent Act of 1790, Pub. L. No. 1-7, 1 Stat. 109 (1790) and Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).

and Trademark Office (an executive agency) to review patent applications, issue patents, and make related determinations, the Court of Appeals for the Federal Circuit—the near-exclusive arbiter of patent appeals—has *never* deferred to the Patent Office’s views on substantive patent doctrine under *Chevron*.⁶² Indeed, the Federal Circuit could barely have been more emphatic that, in its view (and perhaps to protect its own jurisdictional terrain⁶³), the Patent Office lacks the power to make substantive patent rules: Even “the broadest of the [Patent Office]’s rulemaking powers . . . do[] NOT grant the [Patent] Commissioner the authority to issue substantive rules.”⁶⁴ The Federal Circuit has similarly declined to defer to the Patent Office’s views under *Skidmore*, too.⁶⁵ Instead, the Judiciary—including, especially, the Federal Circuit and the Supreme Court—has shouldered the burden of construing and authoritatively interpreting Congress’s directives.

But if we view the Executive Branch through a wider lens, the standard account seems flawed. The Solicitor General has exercised an important and powerful influence over the Supreme Court’s merits determinations in patent cases. Lauren Baer and William Eskridge, for example, have suggested that the Court “consultative[ly] defer[s]” to the Executive Branch, finding that OSG’s amicus briefs are “particularly influential” in patent cases.⁶⁶ Other scholars have described similar results.⁶⁷ John Duffy finds that the Supreme Court often—and sometimes expressly—“embrace[s] legal tests and holdings that bear remarkable resemblance to the tests articulated by the Solicitor General,” highlighting several cases, including *Merck KGaA v. Integra Lifesciences I*⁶⁸ and *Microsoft v. AT&T*.⁶⁹ I take a close look at these

62. Wasserman, *supra* note 15, at 1971.

63. See Timothy R. Holbrook, *The Federal Circuit’s Acquiescence(?)*, 66 AM. U. L. REV. 1061, 1064, 1068–74 (2017) (describing the “turf wars” between the agency and the court “over what deference was owed”); see also Gugliuzza, *supra* note 60, at 1820; cf. Benjamin & Rai, *supra* note 38, at 299–301.

64. *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996) (emphasis in original); see also *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1335 (Fed. Cir. 2008). But see *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2143 (2016) (noting that the Patent Act “does not clearly contain the [Federal] Circuit’s claimed limitation” “to procedural rules” (emphasis omitted)).

65. See, e.g., *Cleveland Clinic Found. v. True Health Diagnostics*, 760 F. App’x 1013, 1020 (Fed. Cir. 2019).

66. Baer & Eskridge, *supra* note 12, at 1111–13.

67. See, e.g., Chien, *supra* note 35, at 429–30; Eisenberg, *supra* note 35, at 29 (2007) (noting that the Supreme Court has often resolved patent cases “in accordance with the Solicitor General’s advice”); Picozzi, *supra* note 35, at 433; Rai, *supra* note 35, at 389; see also Michael E. Solimine, *The Solicitor General Unbound: Amicus Curiae Activism and Deference in the Supreme Court*, 45 ARIZ. ST. L.J. 1183, 1212 (2013) (describing “[t]he Court’s [c]ontinuum of [d]eference to the Solicitor General’s [a]micus [b]riefs” across subject areas).

68. 545 U.S. 193 (2005).

69. Duffy, *supra* note 12, at 541 (highlighting *Merck KGaA*, 545 U.S. 193 (2005) and *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007) as examples of OSG’s influence). John Duffy also

cases (among others) and likewise conclude that the Supreme Court frequently defers substantially, if only implicitly, to the views advanced by the Solicitor General.

The result is a longstanding regime of de facto deference.⁷⁰ In cases that present legalistic issues, or where the Court discerns a clear statutory command, the Court may decide the matter for itself. But in cases that may turn on policy judgments in the face of legal ambiguity, the Court has frequently adopted the views of the Executive Branch.

Remarkably, as I describe below, the Court exhibits this deference across a range of circumstances. First, such deference appears where the Patent Office and the Office of the Solicitor General disagree. Second, it seems to apply even where OSG has replaced the Patent Office's stated rationale with some new, litigation-specific justification. And, third, the Court even seems to let the Patent Office launder its policy preferences through OSG without complying with the administrative processes that must typically attend to agency policymaking.⁷¹

1. *Deference Despite OSG and Patent Office Conflict*

I begin with *Myriad*. In 2009, several doctors, patients, and advocacy groups sought a judgment declaring invalid Myriad's BRCA-related patents—patents covering genes that help predict someone's risk of developing breast and ovarian cancer.⁷² Typically, “products of nature” are not patentable.⁷³ But the Patent Office defended its practice of granting patent applications claiming isolated DNA molecules: It contended that “isolated genes are chemicals” and such chemicals comprise patentable subject matter because their status as “isolated” renders them different from their state “as they are found in nature.”⁷⁴ The district court, however, concluded that the molecules were produced by nature and hence unpatentable.⁷⁵

highlights *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008) and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Duffy, *supra* note 12, at 541.

70. Cf. Baer & Eskridge, *supra* note 12, at 1184 (suggesting that the Court clarify its deference regime and incorporate instances of informal “consultative deference” into its usual forms of doctrinal deference).

71. See Clarisa Long, *PTO and the Market for Influence in Patent Law*, 157 U. PA. L. REV. 1965, 1988 (2009) (explaining that the Patent Office is becoming a “more aggressive” “supplier of legal rules” but noting the transparency-related concerns that attend to this mode of rulemaking).

72. *Ass'n for Molecular Pathology v. Myriad Genetics*, 569 U.S. 576, 586 (2013).

73. *Id.* at 589.

74. Memorandum of Law in Support of Defendant U. S. Patent and Trademark Office at 23–25, *Ass'n for Molecular Pathology v. U.S. Patent & Trademark Office*, 702 F. Supp. 2d 181 (S.D.N.Y. 2010) (No. 09 Civ. 4515 (RWS)).

75. *Ass'n for Molecular Pathology*, 702 F. Supp. 2d. at 232.

On appeal to the Federal Circuit, the Department of Justice took control of the litigation and (at the urging of other agencies, including the National Institutes of Health) reversed course.⁷⁶ OSG acknowledged that its new position was “contrary to the longstanding practice of the [Patent Office], as well as the practice of . . . government agencies that . . . sought and obtained patents for isolated genomic DNA,” but noted that the case “prompted the United States to reevaluate” its position.⁷⁷ The Patent Office, however, “remained firmly behind its policy.”⁷⁸

The Federal Circuit sided with the Patent Office, concluding that the patents were valid. And the intra-Executive divide played an important role in the Federal Circuit’s resolution of the case. Though the majority noted that OSG declined to “defend the [Patent Office’s] longstanding position that isolated DNA molecules are patent eligible,” the Court of Appeals explained that its own approach “comports” with that “longstanding practice,” and that any policy change must come from Congress.⁷⁹ The concurrence, moreover, reasoned that the Patent Office’s practice had engendered industry reliance interests that also counseled in favor of patentability.⁸⁰

To be sure, the Federal Circuit’s decision does not formally defer under either *Chevron* or *Skidmore* to the Patent Office’s guidance documents. But Judge Bryson, in partial dissent, nevertheless accused the majority of “defer[ring]” to the Patent Office in view of “the fact that since 2001 the [agency] has had guidelines in place that have allowed patents on entire human genes.”⁸¹ And, in Judge Bryson’s view, this deference (such as it was) was especially unwarranted in light of the intra-Executive conflict:

[W]hatever force the [Patent Office]’s views on the issue of patent eligibility may have had in the past has, at the very least, been substantially undermined by the position the government has taken in this case. The Department of Justice filed a brief on

76. See Park, *supra* note 23, at 526.

77. Brief for the United States as Amicus Curiae in Support of Neither Party at 18, *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 653 F.3d 1329 (Fed. Cir. 2011) (No. 2010-1406).

78. Park, *supra* note 23, at 526.

79. *Ass’n for Molecular Pathology*, 653 F.3d at 1349, 1354. To be sure, the Patent Office’s position was barely reasoned. See *id.* at 1380 (explaining that the Patent Office’s guidelines were “perfunctory”). And that should matter for deference’s purposes. See *infra* section II.A.3. But that the Patent Office’s guidelines were perfunctory is hardly any reason to shift decisionmaking authority to OSG. Instead, as I describe below, the better practice is for the court to remand to the agency for a better agency deliberative process. See *infra* section III.C.

80. *Ass’n for Molecular Pathology*, 653 F.3d at 1354; *id.* at 1368, 1370 (Moore, J., concurring).

81. *Id.* at 1380 (Bryson, J., concurring in part and dissenting in part).

behalf of the United States in this court taking the position that Myriad's gene claims (other than the cDNA claims) are not patent-eligible. Although the [Patent Office] did not "sign" the brief and we are left to guess about the status of any possible continuing interagency disagreements about the issue, the Department of Justice speaks for the Executive Branch, and the [Patent Office] is part of the Executive Branch, so it is fair to assume that the Executive Branch has modified its position from the one taken by the [Patent Office] in its 2001 guidelines and, informally, before that.⁸²

Moreover, Judge Bryson reasoned that the Patent Office's "lac[k] [of] substantive rulemaking authority" undermined the majority's reliance on the agency's past practice.⁸³ Judge Bryson also found the Patent Office's "perfunctory" 2001 guidelines to "not reflect [the] thorough consideration" that is a precondition to judicial deference.⁸⁴ And, finally, Judge Bryson explained that "Congress has not accorded" "lawmaking authority" on the Patent Office.⁸⁵

As I suggested in the Introduction (and as I elaborate *infra* section II.A), this dialogue among the majority, the concurrence, and the dissent sounds in the values that form the basis for deference. In noting that "Congress has not accorded" "lawmaking authority" on the Patent Office, for example, Judge Bryson highlights deference's delegation theory, suggesting that deference may not be appropriate where Congress has declined to delegate policymaking power to a particular agency.⁸⁶ Likewise, in describing the 2001 guidelines as "perfunctory" and commenting on the Patent Office's lack of "rulemaking authority," Judge Bryson asks whether the guidelines are truly the product of an agency's reasoned deliberation.⁸⁷ And, in trying to discern which agency "speaks for the Executive Branch," Judge Bryson draws from accountability theories of deference.⁸⁸

82. *Id.* at 1380–81.

83. *Id.* at 1380.

84. *Id.*

85. *Id.* at 1381.

86. *Id.* To be sure, Judge Bryson seems mistaken to suggest that the Patent Office lacks the delegated authority to set patent policy. Judge Bryson's view is correct under the then-prevailing Federal Circuit precedent. But as I've noted above (and below), the Supreme Court has since called the Federal Circuit's view into question, suggesting that the Patent Office may indeed have the authority to set substantive rules. *See, e.g., supra* notes 16–18 and accompanying text. And, as Melissa Wasserman has suggested, the Patent Office certainly seems able to set substantive patent policy through adjudication at the Patent Trial and Appeal Board. Wasserman, *supra* note 15; *cf. Vishnubhakat, supra* note 18.

87. *Ass'n for Molecular Pathology*, 653 F.3d at 1380.

88. *Id.*

Though the Patent Office's past practice proved persuasive at the Federal Circuit, the Supreme Court agreed to review the case and was ultimately swayed by the Solicitor General's view. Myriad asked the Court to defer to the Patent Office's "past practice of awarding gene patents."⁸⁹ But the Court declined to do so, noting that Congress had not expressly "endorsed the views of the [Patent Office]," and that the Solicitor General's contrary arguments both "undercut[] the [Patent Office's] practice" and "weigh against deferring" to the Patent Office.⁹⁰

Indeed, not only did OSG's presence at the Court "undercut" the Patent Office's practice—OSG's preferred outcome carried the day. As I noted in the Introduction, the Solicitor General contended that "isolated but otherwise unmodified DNA is not patent-eligible" (though "[s]ynthesized genetic materials" ought to be treated as "patent-eligible . . . because they do not occur in nature").⁹¹ Arti Rai, among others, has explained that this distinction—between isolated DNA and synthetic cDNA—is suspect: "From a formal scientific or legal perspective, the distinction . . . is not entirely compelling."⁹² This is because neither is truly naturally occurring; rather, each requires some substantial human intervention. But, from a "policy standpoint," this may seem one reasonable approach—one which balances concerns for patent thickets against adequate incentives to invest in genetic diagnostics and therapeutics.⁹³ And it is this approach that the Court in fact adopted: "[A] naturally occurring DNA segment is a product of nature and not patent eligible," but "[synthetically created DNA] . . . is patent eligible because it is not naturally occurring."⁹⁴ In short, determining what, exactly, is patent-eligible presents the familiar difficulty of line-drawing.⁹⁵ And in the face of that difficulty, the

89. *Ass'n for Molecular Pathology v. Myriad Genetics*, 569 U.S. 576, 593 (2013).

90. *Id.* at 594.

91. *Myriad* Amicus Brief, *supra* note 6, at 9.

92. Rai, *supra* note 7, at 1258–60 ("From a formal scientific or legal perspective, the distinction . . . is not entirely compelling. . . . From a policy standpoint, however, the U.S. government's distinction has some appeal."); *see also* Dreyfuss, Nielsen & Nicol, *supra* note 7, at 571 (explaining that Australia's High Court rejected a similar distinction because both types of DNA bear the same relevant characteristics).

93. Rai, *supra* note 7, at 1258–60.

94. *Myriad*, 569 U.S. at 580.

95. Rai, *supra* note 7, at 1258–60; *see also* Tun-Jen Chiang, *The Rules and Standards of Patentable Subject Matter*, 2010 WIS. L. REV. 1353, 1407–10. Here, the line drawing challenge pertains to the standard for "naturally occurring" substances. The DNA sequences in question exist in nature—but they might never exist as a stand-alone substance (rather than as part of some larger sequence). Do substances that exist in nature—but never on their own—count as naturally occurring? *See* *Ass'n for Molecular Pathology v. U.S. Patent & Trademark Office*, 653 F.3d 1329, 1376 (Fed. Cir. 2011) (analogizing the question to that of "elemental lithium," which "does not

Supreme Court adopted OSG's view—notwithstanding the Patent Office's contrary (and similarly scientifically reasonable) position.⁹⁶

2. *Deference Despite OSG and Patent Office Inconsistency*

The Court's decision in *Cuozzo Speed Technologies* offers one further important and notable example of the Supreme Court's deference to the Executive Branch.⁹⁷ Indeed, *Cuozzo* is a rare example of the Court extending formal, de jure deference (under *Chevron*) in a patent case.⁹⁸ But as I describe in detail here, the Court's decision to invoke *Chevron* (ostensibly to the Patent Office) hinges on an OSG argument that is nowhere to be found in the Patent Office rule under review. In short, the Court defers to the Solicitor General's view, notwithstanding a significant inconsistency between OSG's litigation-specific rationale and the Patent Office's reasoning—indeed, the Court's decision in this case seems to violate its usual doctrines against crediting *post hoc* rationalizations.⁹⁹

Cuozzo challenged several aspects of inter partes review—an administrative proceeding designed to allow the Patent Office to take a “second look” at a patent after having initially granted the patent's application.¹⁰⁰ *Cuozzo* asked the Court to review, among other features, the Patent Office's legal standard for construing the scope of the challenged patent.¹⁰¹ The Patent Office had decided to evaluate the validity of a patent's claims under their “broadest reasonable interpretation”—the same standard that the Patent Office applies when, say, examining a patent application for the first time.¹⁰² But *Cuozzo* would have preferred that the Patent Office apply the *Phillips* standard—the standard used by the district courts to evaluate a granted patent's validity.¹⁰³

Cuozzo's contentions sharply divided the Federal Circuit. The panel majority concluded primarily that the Leahy-Smith America Invents Act

occur naturally because it reacts with air and water and thus is found in nature only as part of a chemical compound”).

96. *Myriad*, 569 U.S. at 596 (Scalia, J., concurring).

97. *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131 (2016).

98. *Id.* at 2142–46; see also *supra* note 62 and accompanying text (explaining that “the Federal Circuit . . . has never deferred to the Patent Office's views on substantive patent doctrine under *Chevron*”).

99. E.g., *SEC v. Chenery Corp. (Chenery II)*, 332 U.S. 194, 196 (1947).

100. *Cuozzo Speed Techs.*, 136 S. Ct. at 2144.

101. *In re Cuozzo Speed Techs.*, 793 F.3d 1268, 1272 (Fed. Cir. 2015).

102. *Id.* at 1275.

103. *Cuozzo Speed Techs.*, 136 S. Ct. at 2134.

(the Act which gave rise to the inter partes review proceedings at the heart of *Cuozzo*'s challenges) required that the Patent Office's apply the "broadest reasonable interpretation" standard.¹⁰⁴ But five judges dissented from the Court of Appeals' denial of *Cuozzo*'s petition for rehearing *en banc*, reaching a starkly opposite conclusion: They read the Act as mandating *Phillips*.¹⁰⁵

Before the Supreme Court, the Solicitor General's Office defended the Patent Office's practice—but on significantly different terms. Where the Federal Circuit suggested that the Act implicitly compelled the Patent Office to apply the broadest reasonable interpretation standard, the Solicitor General argued that the Patent Office's choice was one reasonable interpretation of an ambiguous statute: "The [Patent Office] has reasonably decided to use its longstanding broadest-reasonable-[interpretation] approach in inter partes review proceedings."¹⁰⁶ That is, the Solicitor General argued that the *Chevron* framework governed the question and, under *Chevron*'s second step, the agency's interpretation was reasonable.

The Solicitor General's position was based, in part, on the Patent Office's view; the Solicitor General, after all, defended the agency's choice of substantive standard.¹⁰⁷ In short, there was no obvious policy conflict between OSG and the Patent Office.

But the Solicitor General's argument diverged substantially from the original rationale for the Patent Office's regulation. As noted, the Solicitor General primarily framed the Patent Office's rule as reasonable under *Chevron*.¹⁰⁸ That is, OSG described the agency's rule as informed by the Patent Office's "expert judgment" and hence deserving of

104. *In re Cuozzo Speed Techs.*, 793 F.3d at 1278 ("We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA."). The Federal Circuit also added that, if it were wrong as to Congress's clear intent, the Patent Office's regulation was a reasonable measure under *Chevron*. *Id.* at 1279.

105. *Id.* at 1303 (Prost, C.J., dissenting from the denial of rehearing *en banc*) ("[In inter partes review], as in district court litigation, an already issued claim is being analyzed solely for the purposes of determining its validity. In this context, it makes little sense to evaluate the claim against the prior art based on anything than the claim's actual meaning.").

106. Indeed, this was the Government's opening statement at oral argument. See Transcript of Oral Argument at 26, *Cuozzo Speed Techs.*, 136 S. Ct. 2131 (No. 15-446) (statement of Curtis E. Gannon, Assistant to the Solicitor General, Department of Justice).

107. See U.S. PATENT & TRADEMARK OFFICE, PERFORMANCE & ACCOUNTABILITY REP.: FISCAL YEAR 2016, at 20 (2016) (noting the Patent Office's role in defending the agency's regulation before the Supreme Court).

108. See Transcript of Oral Argument, *supra* note 106, at 26; see also Brief for Respondent at 34–42, *Cuozzo Speed Techs.*, 136 S. Ct. 2131 (No. 15-446), 2016 WL 1165967 [hereinafter *Cuozzo* Respondent Brief]. To be sure, OSG also defended the Federal Circuit's main holding on its own terms. But the primary thrust of the Solicitor General's argument, as evinced by, for example, oral argument in the case, centered on the regulation's reasonableness under *Chevron*.

“judicial deference.”¹⁰⁹ In short, OSG argued that the choice among standards is a “policy matter” best left to the “particular expertise of the Patent Office.”¹¹⁰

A closer look at the Patent Office’s regulation, however, hardly reflects such a policy choice (as opposed to an interpretative view). The Patent Office’s regulation seems to rest upon the view that Congress implicitly commanded the Patent Office to apply the broadest reasonable interpretation standard: The agency’s order reasons that “the provisions of the Leahy-Smith America Invents Act indicate that the” “broadest reasonable interpretation standard” “should apply . . . to [inter partes review] proceedings,” and that the Act’s “legislative history” “is further consistent” with that standard.¹¹¹ Stated simply, the agency’s original view was—like the Federal Circuit majority—that the statute mandated the broadest reasonable interpretation standard. But in the context of the Supreme Court’s review, the Solicitor General reframed the Patent Office’s interpretation of the America Invents Act as a reasonable policy choice.

The Solicitor General’s strategy proved successful. The Supreme Court agreed that Congress had expressly granted the Patent Office the authority to issue “regulations . . . governing inter partes review.”¹¹² And, finding that “[n]o statutory provision unambiguously directs the agency to use one standard or the other,” the Court concluded that the agency’s choice was reasonable in view of the several policy rationales described in the Solicitor General’s brief, including, for example, that the broadest reasonable interpretation standard would ease administrability (given that the same standard applied in nearly every other Patent Office proceeding), and therefore declined to consider which claim construction standard was “better . . . as a policy matter.”¹¹³ But the Patent Office likewise never publicly considered this policy question. Instead, its public reasoning reflected, as noted above, an interpretative view—not a policy call.

Other cases suggest similar results under similar conditions.

Consider, for example, the Court’s decision regarding the doctrine of obviousness in *KSR International Co. v. Teleflex, Inc.*¹¹⁴ There, the Patent Office was able to win a change to the standard governing its review of patent applications by laundering its preferences through

109. *Cuozzo* Respondent Brief, *supra* note 108, at 41.

110. *Cuozzo Speed Techs.*, 136 S. Ct. at 2146.

111. 77 Fed. Reg. 48,680, 48,679 (Aug. 14, 2012) (to be codified at 37 C.F.R. pt. 42).

112. *Cuozzo Speed Techs.*, 136 S. Ct. at 2142 (quoting 35 U.S.C. § 316(a)(4) (2018)).

113. *Id.* at 2142, 2146.

114. 550 U.S. 398 (2007).

OSG—without ever having to subject those policy views to standard administrative procedures.

The case asked the Supreme Court to review the Federal Circuit’s standard for assessing obviousness: According to the Court of Appeals, an invention was obvious only if “some motivation or suggestion to combine the prior art teachings’ can be found in the prior art.”¹¹⁵ And the Federal Circuit applied this “teaching, suggestion, or motivation,” or “TSM,” “test” rigidly, requiring that the prior art offer “precise teachings directed to the specific subject matter of the challenged claim,” and emphasizing, as prior art, only “published articles” and “issued patents.”¹¹⁶

The Solicitor General urged the Court to grant certiorari, explaining that the case presented an important issue of patent law, and that the Federal Circuit’s decision wrongly imposed upon the Patent Office an “inflexible requirement” for proving obviousness.¹¹⁷ The Court granted the petition in *KSR* on the Solicitor General’s recommendation.¹¹⁸

On the merits, OSG reiterated its belief that the Court “should not adopt th[e] flawed categorical [TSM] test as the exclusive means of determining” obviousness.¹¹⁹

But as the Solicitor General argued for the end of the TSM test, the Patent Office continued to apply it in its own review of patent applications.¹²⁰ In short, OSG’s advocacy did not match the Patent Office’s practices, notwithstanding the agency’s authority to establish regulations governing its review of patent applications.¹²¹ Instead, the Patent Office circumvented questions about the scope of that authority by helping OSG urge the Supreme Court to abandon the test. In its Annual Report, the Patent Office explained that it “assisted the Solicitor General’s Office in preparing the government’s *amicus curiae* brief on the merits, arguing that the Supreme Court should reverse Federal

115. *Id.* at 407 (quoting *Al-Site Corp. v. VSI Int’l*, 174 F.3d 1308, 1323–24 (Fed. Cir. 1999)).

116. *Id.* at 418–19.

117. Brief for the United States as Amicus Curiae Supporting Petitioner at 10, *KSR Int’l Co. v. Teleflex, Inc.*, 548 U.S. 902 (2006) (mem.) (granting certiorari) (No. 04-1350), 2006 WL 1455388.

118. *KSR Int’l Co.*, 548 U.S. 902.

119. Brief for the United States as Amicus Curiae Supporting Petitioner at 23, *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (No. 04-1350) [hereinafter *KSR Amicus Brief*].

120. Manual of Patent Examining Procedure § 2143.01 (8th ed., 5th rev., Aug. 2006) (explaining that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so” and that “[t]he teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art”).

121. 35 U.S.C. § 2(b)(2)(A) (2018); *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2144 (2016).

Circuit precedent and its application of the motivation-suggestion-teaching test.”¹²² Indeed, the Solicitor General’s brief draws on policy considerations that would be of special concern to the Patent Office. The Solicitor General’s brief, for example, explains that the Federal Circuit’s rigid test undermines the Patent Office’s expertise and imposes unduly burdensome evidentiary requirements on patent examiners, requiring them to conduct “extensive search[es]” for prior art that simply state a point that would be clear to someone skilled in the relevant field of invention.¹²³ Hence, the Patent Office and the Solicitor General’s Office argued that the Court should not require such “burdensome” and “unnecessary search[es] for evidence showing a particular suggestion, teaching, or motivation.”¹²⁴

Of course, there is significant value in having OSG’s arguments informed by the Patent Office’s expert views, and OSG may offer the Patent Office a useful channel for challenging the Federal Circuit’s interpretations of patent law.¹²⁵ But expertise is not all that matters. The Patent Office, for example, never tested these arguments in the tournament that is notice and comment rulemaking—despite having the express authority to “establish regulations . . . [that] shall govern the conduct of proceedings in the Office,” including its review of patent applications.¹²⁶ Instead, even as it continued to apply the TSM test, the Patent Office pitched a different policy preference to the Solicitor General, who relayed it to the Court.

The Court sided with the Government.¹²⁷ The Court reversed the Federal Circuit’s decision in *KSR*, explaining that, as the SG argued, the obviousness inquiry should be “expansive and flexible,” not rigid.¹²⁸ Moreover, the Court’s decision reflects, in places, OSG’s policy arguments: For example, the Court suggests that limits on the Patent

122. U.S. PATENT & TRADEMARK OFFICE, PERFORMANCE AND ACCOUNTABILITY REP.: FISCAL YEAR 2006, at 47 (2006).

123. See *KSR* Amicus Brief, *supra* note 119, at 22–23.

124. Compare *id.* at 21, 26, with *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (No. 04-1350), 2006 WL 2453601.

125. See Golden, *supra* note 25 (contending that the Supreme Court plays a valuable role in “percolating” Federal Circuit rules); cf. Duffy & Nard, *supra* note 25 (suggesting that more circuits, beyond only the Federal Circuit, should have jurisdiction over patent claims); Karshedt, *supra* note 25, at 324 (suggesting that the Patent Office advocate against its own procedures in order to challenge Federal Circuit precedent).

126. 35 U.S.C. § 2(b)(2)(A) (2018); see *Cuozzo Speed Techs.*, 136 S. Ct. at 2144; *United States v. Havis*, 927 F.3d 382, 386 (6th Cir. 2019).

127. Compare *KSR* Amicus Brief, *supra* note 119, at 23–24 (“This Court should not adopt [the Teaching-Suggestion-Motivation (TSM)] test.”), with *KSR Int’l Co.*, 550 U.S. at 402 (“[T]he TSM test is incompatible with this Court’s precedents.”); see also Duffy, *supra* note 12, at 539.

128. *KSR Int’l Co.*, 550 U.S. at 415.

Office's ability to draw upon its expertise undermine "the presumption of validity" conferred on issued patents.¹²⁹

3. *Deference Despite Falling Outside the Patent Office's Apparent Authority*

As noted, Congress has given the Patent Office the authority to "establish regulations . . . [that] shall govern the conduct of proceedings in the Office," which might be understood to encompass regulations that apply to questions of claim construction, obviousness, or patentability.¹³⁰ But the Court's implicit deference regime seems to reach beyond such matters, to questions of infringement—cases that typically regard a dispute between two private parties about whether one has infringed another's patent, rather than the more foundational question of what patents should issue at all.

Consider, for example, *Microsoft v. AT&T*.¹³¹ There, AT&T alleged that Microsoft Windows, once installed on a computer, infringed an AT&T patent.¹³² AT&T thus sought damages for every personal computer manufactured to run the operating system, including computers manufactured outside the United States.¹³³ AT&T contended that, even where the computer's manufacture was abroad and where the software was installed on foreign soil, Microsoft had nevertheless "supplie[d]" the infringing software "component" "from the United States," in violation of the Patent Act's extraterritorial infringement provision at Section 271(f)(1).¹³⁴

AT&T's case thus turned, in part, on the meaning of the term "component" as it relates to software.¹³⁵ The Court, drawing on the case's briefing, explained that the matter "can be conceptualized in (at least) two ways."¹³⁶

129. *Id.* at 426.

130. 35 U.S.C. § 2(b)(2)(A) (2018); *Cuozzo Speed Techs.*, 136 S. Ct. at 2144.

131. 550 U.S. 437 (2007).

132. *AT&T v. Microsoft Corp.*, No. 01 Civ.4872(WHP), 2004 WL 406640, at *2 (S.D.N.Y. Mar. 5, 2004).

133. *Id.*

134. 35 U.S.C. § 271(f)(1) (2018); *see also AT&T*, 2004 WL 406640, at *2.

135. *Microsoft* identifies two questions critical to its analysis. "First, when, or in what form, does software qualify as a 'component' under § 271(f)? Second, were 'components' of the foreign-made computers involved in this case 'supplie[d]' by Microsoft 'from the United States'?" *Microsoft*, 550 U.S. at 447 (alterations in original). Here, I explore the Court's treatment of the term "component" in the first question. I have explored the Supreme Court's analysis of the second question—and, in particular, its use of universal, or trans-substantive, canons of statutory interpretation—in more detail in other work. *See Narechania, supra* note 37, at 1379–80.

136. *Microsoft*, 550 U.S. at 447.

First, the software “component” might be software “in the abstract”—computing “instructions” that are “detached from any medium.”¹³⁷ AT&T advocated for this view: Because Windows was designed and produced by Microsoft in Redmond, Washington, this interpretation would require that the software was a “component” “supplied” “from the United States” (even if any tangible copies on compact discs or installed on the infringing foreign computers’ hard drives were locally supplied).¹³⁸ Though Microsoft agreed that software is simply “intangible information,” it nevertheless seemed to contend that such intangibles are categorically incapable of being a “component.”¹³⁹

Second, the Court explained that the software “component” might refer to a “computer-readable” “tangible ‘copy’” of an application.¹⁴⁰ This view reflects OSG’s position. Unlike Microsoft, the Solicitor General reasoned that software could indeed be a component of a patented invention.¹⁴¹ And unlike AT&T, the Solicitor General contended that “software in the abstract cannot be a component of a patented invention”—only a “physical copy of the executable software code” may be.¹⁴² That is, software, when encoded on some tangible medium (such as a portable or hard drive), may be a component of some larger innovation.

The Government’s interpretation of the term “component” was informed by policy concerns. The Government explained that AT&T’s contrary interpretation would “impos[e] liability for a single transmission to a foreign country,” thereby denying the domestic software industry “any realistic avenue of competing in overseas markets without risking [infringement] liability” in domestic courts for foreign conduct—even where local laws governing those foreign markets would not impose liability for such conduct.¹⁴³ Meanwhile, “companies in other industries that design components in the United

137. *Id.* at 447–48.

138. *Id.* at 448.

139. See Petition for Writ of Certiorari at 12, 15–17, *Microsoft Corp. v. AT&T Corp.*, 549 U.S. 991 (2006) (mem.) (granting certiorari) (No. 05-1056), 2006 WL 403897; see also Brief for the United States as Amicus Curiae Supporting Petitioner at 14, *Microsoft*, 550 U.S. 437 (No. 05-1056), 2006 WL 3693464 [hereinafter *Microsoft* Amicus Brief] (“[Microsoft] argues that software cannot be a ‘component’ because it is ‘intangible information’ rather than a ‘physical product.’” (citation omitted)). *But see* Brief for Petitioner at 13, *Microsoft*, 550 U.S. 437 (No. 05-1056) (suggesting that “physical media” containing software copies could be “components”). Microsoft thus seems to have shifted its view on the proper interpretation of component between the petition and merits stages of the case.

140. *Microsoft*, 550 U.S. at 448–49.

141. *Microsoft* Amicus Brief, *supra* note 139, at 11–12.

142. *Id.* at 13.

143. *Id.* at 25.

States can replicate those components abroad without fear of [analogous infringement] liability.”¹⁴⁴ This, OSG reasoned, “frustrates the goal of a technology-neutral statutory scheme.”¹⁴⁵ Each of these concerns presents a policy conclusion. First, the Government’s position reflects a preference against placing domestic companies at a competitive disadvantage vis-à-vis their foreign counterparts. Second, the Government draws from comity concerns to suggest that domestic law should not be construed in ways that may conflict with foreign law. And third, the Government’s argument reinforces the policy view that patent law should be technologically neutral in application.¹⁴⁶

The Court adopted the Government’s view, agreeing that “a copy of Windows, [but] not Windows in the abstract, qualifies as a ‘component’ under § 271(f).”¹⁴⁷ And the Court’s opinion confirms the influence of the policy concerns advanced by the Solicitor General. The Court, for example, explains that comity concerns “tug[] strongly against construction of § 271(f) to encompass as a ‘component’ not only a physical copy of software, but also software’s intangible code.”¹⁴⁸ The Court likewise explained that its approach does not vary by industry: Its treatment of software in *Microsoft* is level with the law’s treatment of “blueprints, schematics, templates, and prototypes,” among other forms of instructions relevant to other industries.¹⁴⁹

Justice Stevens dissented. He conceded that “[s]trong policy considerations” favored the majority’s outcome.¹⁵⁰ But, in his view, AT&T’s construction of the statute—treating even intangible software instructions as a “component” within the meaning of the statute—was “faithful to the intent of the Congress that enacted § 271(f).”¹⁵¹

The difference between the majority and the dissent might be characterized on *Chevron*’s terms. The majority begins by explaining that software can be understood “in (at least) two ways.”¹⁵² And, in the

144. *Id.*

145. *Id.*

146. The contention that the interpretation of the patent laws should reflect a technology-neutral scheme is itself a policy choice—one that may be belied by, for example, the pharmaceutical-specific provision at issue in *Merck*, *infra* notes 156–175 and accompanying text. *See also* Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1577 (2003); Narechania, *supra* note 10, at 1489 (favoring “industry- and context-specific patent tailoring”); *cf.* Brad A. Greenberg, *Rethinking Technology Neutrality*, 100 MINN. L. REV. 1495, 1500 (2016) (outlining the “policy goals of technology neutrality”).

147. *Microsoft Corp. v. AT&T*, 550 U.S. 437, 451–52 (2007); *see also* Duffy, *supra* note 12, at 542.

148. *Microsoft*, 550 U.S. at 455–56.

149. *Id.* at 457.

150. *Id.* at 462 (Stevens, J., dissenting).

151. *Id.*

152. *Id.* at 447 (majority opinion).

face of this ambiguity, the Court defers to the Solicitor General's view. That is, the majority appears to conclude, at *Chevron's* second step, that OSG's proposed characterization is at least reasonable in view of the policy concerns advanced by that Office. Justice Stevens's dissent, by contrast, might be understood to decide the question at *Chevron's* first step: Even though policy considerations may favor the majority's view, Justice Stevens appears to conclude that "Congress has directly spoken to the precise question at issue."¹⁵³

I do not mean to imply that the Court's opinion formally invokes *Chevron*. Indeed, no opinion in the case cites *Chevron*, *Skidmore*, or any other related case. And Justice Ginsburg's majority opinion implies that its construction of "component," as applied to software, follows from the statute's plain text.¹⁵⁴ But viewed together, Justice Ginsburg's majority opinion and Justice Stevens's dissent offer a striking contrast: one proceeds from the evident (in its view) intent of Congress; the other sees greater room for discretion, and reaches a decision based, at least in part, on policy concerns—the very policy concerns advanced by the Solicitor's General Office. Remarkably, given the apparent limits on the Patent Office's policymaking authority, the Court defers even absent any obvious reason, under Step Zero, for the Court to defer to the Government's view on matters of infringement in particular. In short, the Patent Office's power to "establish regulations . . . govern[ing] the conduct of proceedings in the Office," would not ordinarily seem to extend to statutes such as the extraterritorial infringement provision at issue here.¹⁵⁵

The Court's decision in *Merck v. Integra Lifesciences* offers a similarly representative infringement example.¹⁵⁶ There, Merck asked the Court to consider the scope of a statutory exception to patent infringement.¹⁵⁷ Section 271(e)(1) explains that it is not patent infringement to "use" a "patented invention" "for uses reasonably related to the development and submission of information" under the federal laws regulating pharmaceutical approvals and manufacturing.¹⁵⁸ But when is a potentially infringing use "reasonably related" to a pharmaceutical company's application to manufacture and sell a new drug?

153. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 842–43 (1984).

154. *Microsoft Corp.*, 550 U.S. at 449.

155. 35 U.S.C. § 2(b)(2)(A).

156. 545 U.S. 193 (2005).

157. *Id.* at 200–02.

158. 35 U.S.C. § 271(e)(1).

Integra contended that certain “preclinical studies” are not “reasonably included” in a regulatory application to manufacture and sell a drug, and thus such uses fall outside the scope of the statutory exception.¹⁵⁹ And Integra’s position aligned closely with the Federal Circuit decision on review. The Federal Circuit reasoned that, even where a pharmaceutical company attempts to “identif[y] the best drug candidate to subject to future clinical testing,” the FDA has no immediate “interest in th[at] hunt for drugs that may or may not later undergo clinical testing.”¹⁶⁰ That is, such early, preclinical studies were relatively far removed from any subsequent, hypothetical applications for regulatory approval. The Federal Circuit’s decision thus limited the scope of the exception primarily to studies directly related to applications for generic drugs.¹⁶¹ In that court’s view, a generic manufacturer could seek FDA approval while the pioneering pharmaceutical is still patent-protected in order to launch its substitute as soon as the patent expires, but using patented compounds for early new drug testing fell outside the exception’s scope. And the Federal Circuit further explained its view that the provision’s legislative history made clear this congressional purpose for the statutory exception: “The meaning of the phrase ‘reasonably related to the development and submission of information’ . . . is clearer in the context of the role of the 1984 Act in facilitating expedited approval of a generic version of a drug previously approved by the FDA.”¹⁶²

OSG disagreed. Its brief explained that such preclinical studies may indeed be “reasonably related to the development and submission” of drug approval information even outside the generic drug context.¹⁶³ They may, for example, inform the FDA’s decision whether even to allow clinical studies and thus move the pharmaceutical compound down the regulatory approval line.¹⁶⁴ The agency may conclude, in light of such preclinical information, that a putative drug is simply too risky to be used in human studies.¹⁶⁵ Hence, such uses of patented chemical

159. *Merck*, 545 U.S. at 203.

160. *Integra Lifesciences I, Ltd. v. Merck KGaA*, 331 F.3d 860, 865–66 (Fed. Cir. 2003).

161. *Id.* at 866–67. *But cf.* Brief for the United States as Amicus Curiae Supporting Petitioner at 15, *Merck*, 545 U.S. 193 (No. 03-1237), 2005 WL 429972 [hereinafter *Merck Amicus Brief*] (explaining that the Federal Circuit “issued an ‘errata’ sheet indicating that ‘the scope of the safe harbor is not limited to generic drug approval,’” but nevertheless issued a “revised opinion [that] continues to suggest that the statutory exemption should be construed to focus primarily on generic drugs”).

162. *Integra Lifesciences I, Ltd.*, 331 F.3d at 866; *see also id.* at 865 (quoting H.R. REP. NO. 857, at 8 (1984)).

163. *See Merck Amicus Brief*, *supra* note 161, at 12.

164. *Merck*, 545 U.S. at 204.

165. *Id.*

compounds may be “reasonably related” to the development of information necessary to the FDA’s drug approval processes.

The Court adopted the Government’s view: Its opinion explains that the section 271 exemption includes “the use of patented compounds in preclinical studies” “as long as there is a reasonable basis for believing that the experiments” may lead to the development of a new drug.¹⁶⁶ This, of course, was not the only possible outcome: The Supreme Court might have easily adopted the Federal Circuit’s interpretation of the statute, concluding (as the Court of Appeals did) that the statute’s text should be understood narrowly in view of the enactment’s apparent “nature and purpose.”¹⁶⁷ Instead, the Court—expressly “giving appropriate recognition to the source for its holding”—adopted the more expansive interpretation of “reasonably related” advanced by the Solicitor General.¹⁶⁸

Merck is especially notable for two reasons.

First, *Merck* is notable for the statutory term—reasonableness—that the Court was tasked with interpreting. The word “reasonable” is a paradigmatic example of an ambiguous statutory term, one to which an agency might typically give further content through, say, rulemaking.¹⁶⁹ Where an agency, acting within its authority, properly promulgates a reasonable rule outlining the bounds of “reasonable” conduct, courts will defer.¹⁷⁰ In *Merck*, OSG (together with the Patent Office and the Department of Health and Human Services, both also on the brief) advanced an interpretation of reasonableness that, in its view, best suited the purposes of the patent statute and the needs of the regulatory drug approval process: As in *Microsoft*, the Executive Branch’s position was expressly informed by “policy concerns animating the [statutory] exception.”¹⁷¹ Indeed, portions of the Solicitor General’s brief read like an expert agency order: Part B of the brief outlines the stages of drug development, from “basic research” to selecting compounds for “inclusion in the final version of a drug,” explaining that while “basic research” is “too attenuated” from the regulatory process, any further

166. *Id.* at 208; *see also id.* at 206 (“[T]he development of a new drug . . . is a process of trial and error . . . [N]either the drugmaker nor its scientists have any way of knowing whether an initially promising candidate will prove successful over a battery of experiments. That is the reason they conduct the experiments.”).

167. *Cf. Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2135, 2142 (2016).

168. 35 U.S.C. § 271(e)(1) (2018); Duffy, *supra* note 12, at 542.

169. *See, e.g., All. for Cmty. Media v. FCC*, 529 F.3d 763, 777–78 (6th Cir. 2008) (noting “inherent ambiguity in words such as ‘reasonable’ and ‘unreasonable’”); *Capital Network Sys., Inc. v. FCC*, 28 F.3d 201, 204 (D.C. Cir. 1994).

170. *See, e.g., All. for Cmty. Media*, 529 F.3d at 778; *Capital Network Sys.*, 28 F.3d at 204.

171. *Merck* Amicus Brief, *supra* note 161, at 12.

“attempt to develop a particular drug” would be “reasonably related” to an application for agency approval.¹⁷² OSG thus described the technical process of pharmaceutical innovation and, in light of that description, developed a policy-informed standard for the sort of conduct that is “reasonably related” to FDA’s drug approval processes. And the Court, faced with both that phrase’s inherent ambiguity and the competing readings offered by the parties and *amici*, seems to defer to OSG’s interpretation.

But, second, as noted, deference may be appropriate only where an agency’s rule falls within the scope of the agency’s authority (here, over “proceedings in the [Patent] Office.”)¹⁷³ So *Merck* is also notable because, as noted above, deference on matters of infringement seems unlikely under traditional conceptions of Step Zero.¹⁷⁴ Perhaps, failing Step Zero, the Court’s implicit deference here is more akin to that arising out of *Skidmore*. But the agency’s litigation-based pronouncements here lack the procedural “thoroughness” that typically attends to *Skidmore* deference.¹⁷⁵ As in *KSR*, no agency—neither the Patent Office nor HHS—was required to subject this interpretation to public review and comment. Hence, as I explain in greater detail in Part III, deference under this entire range of conditions—conflict between OSG and an underlying policy determination; litigation-specific rationales for agency rules; and revisions to agency practices that are untested by administrative process—seems suspect.

4. Deference Exceptions?

Myriad, *Cuozzo*, *KSR*, *Microsoft*, and *Merck*, among other cases, all suggest that the Supreme Court implicitly defers to the Executive Branch in a wide range of patent cases. Moreover, these cases provide examples of deference in cases presenting unusual intra-Executive postures: where the Patent Office and OSG disagree over the correct policy outcome; where OSG has substituted a litigation-specific rationale for the Patent Office’s original reasoning; where the Patent Office seeks to modify policy by circumventing notice-and-comment procedures; and where the Patent Office seeks to affect policy concerns that seem outside its scope. In short, OSG wields significant influence over patent policy matters.

172. *Id.* at 16–19.

173. 35 U.S.C. § 2(b)(2)(A) (2018).

174. See *supra* text accompanying note 130.

175. *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

I am careful not to overstate my claim. The Supreme Court does not, to be sure, always follow the Solicitor General's advice.¹⁷⁶ But some of these cases echo a regular pattern of deference. After all, as noted above, deference to the Executive Branch may be warranted only where Congress has not already "directly spoken to the precise question at issue."¹⁷⁷ And where the Court and the Solicitor General's Office have differed, that disagreement has, in several cases, centered on the nature and clarity of Congress's directives.

In *SAS Institute*, for example, the petitioner challenged another aspect of the Patent Office's inter partes review proceedings, namely, the agency's practice of "partial[ly] institut[ing]" review.¹⁷⁸ This is akin to the Court's own practice of limiting its certiorari grants to selected questions:¹⁷⁹ If a petitioner challenges a patent's first ten claims, the agency might agree to review only the first five. *SAS Institute*, whose petition for inter partes review had been only partially instituted, challenged this practice, contending that the agency had contravened the statute authorizing the agency to "issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner."¹⁸⁰ In its view, the statute's reference to "any . . . claim" meant, in fact, *every* claim.¹⁸¹ OSG's response suggested that the statute was ambiguous. In its view, "any" need not mean "every."¹⁸² And OSG highlighted several policy considerations—including, for example, administrability concerns—that counseled in favor of giving the Patent Office the flexibility and discretion to review only the "most promising challenges and avoid spending time and resources on others."¹⁸³

The Court sided with *SAS Institute*. The Court explained that, "after applying traditional tools of interpretation," it could only conclude that the "statut[e] deliver[s] unmistakable commands" to review *every* challenge.¹⁸⁴ *Chevron* deference therefore did not apply.¹⁸⁵ Stated simply, the Court's unwillingness to defer to the Solicitor General was grounded in the view that Congress had already "directly spoken" to the

176. See, e.g., *Mayo Collaborative Servs. v. Prometheus Labs.*, 566 U.S. 66, 88–89 (2012).

177. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 842 (1984).

178. *SAS Inst. v. Iancu*, 584 U.S. ___, 138 S. Ct. 1348, 1351 (2018).

179. See, e.g., *Dex Media v. Click-to-Call*, ___ U.S. ___, 139 S. Ct. 2742 (2019) (mem.) (granting certiorari, but only as to "Question I presented by the petition").

180. 35 U.S.C. § 318(a) (2018); *SAS Inst.*, 138 S. Ct. at 1354.

181. 35 U.S.C. § 318(a) (emphasis added); *SAS Inst.*, 138 S. Ct. at 1354.

182. *SAS Inst.*, 138 S. Ct. at 1355–57.

183. *Id.* (citing Brief for Federal Respondent at 35–36, *SAS Inst.*, 138 S. Ct. 628 (No. 16-969)).

184. *Id.* at 1358.

185. *Id.*

matter, and the Patent Office thus lacked the discretion to vary its practice from Congress's commands.¹⁸⁶

Consider, also, the Court's decision in *Helsinn Healthcare v. Teva Pharmaceuticals*.¹⁸⁷ Inventors may not obtain a patent for a product that has already been put "on sale," as patent law has long treated such sales as part of the relevant prior art.¹⁸⁸ But the America Invents Act amended the relevant statutory provision to note that the relevant prior art includes inventions that have been placed "on sale, or otherwise available to the public."¹⁸⁹ *Helsinn Healthcare* asked the Court to decide whether this new language modified the longstanding rule that the "on-sale bar" included secret sales—sales that were not publicly disclosed and subject to non-disclosure agreements.¹⁹⁰ *Helsinn* contended that the new language clarified that only public sales counted.¹⁹¹ And the Solicitor General agreed, citing, among other arguments, policy rationales in favor of limiting the on-sale bar.¹⁹² OSG, for example, explained that excluding secret sales would help small innovators: If the on-sale bar were still to apply to secret sales, then small companies would face continued difficulties in preparing to launch their innovations (by, say, being unable to share them with manufacturers and distributors without triggering the prohibition), while large, vertically-integrated companies faced no similar constraints.¹⁹³

But the Court was unmoved. In its opinion, the Court explained that it had long held that an invention was "on sale" "when it was 'the subject of a commercial offer for sale' and 'ready for patenting'" without regard to whether that sale "ma[de] the details of the invention available to the public."¹⁹⁴ The Solicitor General conceded at oral argument that "if 'on sale' had a settled meaning before the [America Invents Act] was adopted, then adding the phrase 'or otherwise available to the public' to the statute 'would be a fairly oblique way of attempting to overturn' that 'settled body of law.'"¹⁹⁵ The Court thus concluded that Congress

186. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 842 (1984); *SAS Inst.*, 138 S. Ct. at 1358.

187. 586 U.S. ___, 139 S. Ct. 628 (2019).

188. 35 U.S.C. § 102(a) (2018).

189. *Helsinn Healthcare*, 139 S. Ct. at 631–32 (emphasis modified) (describing the pre- and post-amendment statutes).

190. *Id.* at 632.

191. *See id.* at 634.

192. *E.g.*, Brief for the United States as Amicus Curiae Supporting Petitioner at 21–26, *Helsinn Healthcare*, __ U.S. ___, 139 S. Ct. 628 (No. 17-1229), 2018 WL 4179034.

193. *Id.* at 28.

194. *Helsinn Healthcare*, 139 S. Ct. at 630 (quoting *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67 (1998)).

195. *Id.* at 631–32 (quoting Transcript of Oral Argument at 28, *Helsinn Healthcare*, 139 S. Ct. 628 (No. 17-1229) (statement of Malcolm Stewart, Deputy Solicitor Gen., Dep't of Justice)).

reenacted the on-sale bar against a backdrop of settled law without changing its meaning. Since Congress had clearly spoken to the scope of the on-sale bar, the Executive Branch was obliged to apply that settled standard to its review of patent applications.

* * *

In all, the Solicitor General exerts an unmistakably important influence on the Court's deliberations across a wide range of patent cases. Lauren Baer and William Eskridge have termed this sort of quiet influence "consultative deference," a regime in which the Executive Branch's inputs "shape [the Court's] reasoning and influence its decision," but without "explicitly stating that it is deferring to the agency."¹⁹⁶ *Myriad*, *KSR*, and *Cuozzo* reflect the power of the Solicitor General's briefs in particular—sometimes even as opposed to the Patent Office's preferred policies, established practices, or stated rationales. Similarly, *Merck* and *Microsoft* help to clarify how those briefs influence outcomes outside the Patent Office's apparent scope of influence. In these close cases of statutory interpretation, OSG's arguments and policy guidance can be dispositive. And in this respect, the Court's informal regime of consultative deference to the Solicitor General mirrors—in effect—its more formal deference regimes.

But a closer look reveals some important differences between the Court's formal deference regimes and the special solicitude that OSG enjoys in these patent cases. The Court's willingness to defer to OSG in cases of intra-Executive conflict, or in cases where OSG's explanation for an agency practice is mismatched to the Patent Office's rationale, is odd. Hence, the Supreme Court's implicit deference to the Solicitor General—a practice that shifts the locus of Executive Branch patent policymaking to OSG—merits further scrutiny.

II. DEFECTIVE DEFERENCE

The practical consequence of the Court's apparent deference to the Solicitor General is a shift in policymaking power away from the Judicial Branch and to the Executive Branch. And inside the Executive Branch, this practice shifts policymaking power to the Solicitor General's Office. But this apparent description of (at least some of) the Supreme Court's patent cases gives rise to a more fundamental question: *Should* the courts defer to the Executive Branch's representative in such cases?

The answer to this question requires examining the foundations for deference more generally: Should the courts defer to the Executive

196. Baer & Eskridge, *supra* note 12, at 1111–13.

Branch *at all*? When? In *Chevron*, the Supreme Court offered three rationales in favor of its rule of mandatory deference: expertise, accountability, and delegation. I consider whether these rationales (among others) apply to interpretations of patent law developed by the Solicitor General's Office, almost always during the pendency of Supreme Court litigation, often then for the first time, and sometimes in conflict with the Patent Office's own practices. They do not.

A. *Defects Under Deference Theories*

The Supreme Court's implicit deference to the Solicitor General's Office on matters of patent policy is inconsistent with the usual theoretical rationales favoring deference.

As I noted above, the Court's decision in *Chevron* offers three rationales for its regime of mandatory deference.¹⁹⁷ First, agencies are relatively more expert than the courts.¹⁹⁸ Second, agency officials may be held politically accountable for their policy decisions.¹⁹⁹ Third, statutory ambiguity may reflect congressional intent to delegate interpretative authority to an agency.²⁰⁰ Likewise, the Court's decisions in *Mead* and *Skidmore* may suggest that agency exercises of policy discretion via regular administrative procedures are more likely to receive mandatory deference—and even when agencies don't clear the bar for such deference under *Chevron*, an agency's views may nevertheless carry the day in view of its thorough investigations and accumulated experience.

In all, scholars have sorted the Court's varied pronouncements in three decades of cases (from 1984's *Chevron* to 2013's *City of Arlington*, and beyond) into several doctrinally-grounded theories of deference.²⁰¹ Among the most prominent are implied delegation, agency expertise, reasoned deliberation, political accountability, and policy flexibility.²⁰²

197. See *supra* text accompanying notes 52–54.

198. *Chevron*, U.S.A., Inc. v. Nat. Res. Def. Council, Inc., 467 U.S. 837, 865 (1984).

199. *Id.* at 865–66.

200. *Id.* at 865; see Gluck & Bressman, *supra* note 52, at 995–98. *But see, e.g.*, Manning, *supra* note 52, at 458 (suggesting that such implied congressional delegation to agencies is a legal fiction).

201. *City of Arlington v. FCC*, 569 U.S. 290 (2013); *Chevron*, 467 U.S. 837.

202. See, e.g., Kent Barnett, Christina L. Boyd & Christopher J. Walker, *Administrative Law's Political Dynamics*, 71 VAND. L. REV. 1463, 1475–81 (2018); Evan J. Criddle, *Chevron's Consensus*, 88 B.U. L. REV. 1271, 1283–91 (2008) (describing the “host of theories [that] have sprung up . . . to justify *Chevron's* revolution”). In addition to the considerations set out above, there is at least one more basis for deference that merits a quick word: national uniformity. See, e.g., Peter L. Strauss, *One Hundred Fifty Cases per Year: Some Implications of the Supreme Court's Limited Resources for Judicial Review of Agency Action*, 87 COLUM. L. REV. 1093, 1095, 1112 (1987). I set this consideration aside here. This is because uniformity concerns do not bear on the

I do not mean to suggest that any one (or all) of these rationales definitively explain or justify *Chevron* or *Skidmore*: It is enough for my purposes here to take the position of a deference pluralist. Nor do I mean to suggest that all the Supreme Court's patent cases are decided under either *Skidmore*'s or *Chevron*'s framework expressly.²⁰³ Rather, I simply mean to suggest that these deference doctrines seem to sit atop this cluster of ideas about comparative institutional competence and related legal values—but these ideas do not apply to the policy views developed by the Solicitor General for the purposes of patent litigation at the Supreme Court. Courts defer to agencies because Congress so empowered them and separation of powers principles thus counsel in favor of such deference;²⁰⁴ because they are more expert; because they may be held to account for their decision;²⁰⁵ because administrative process serves public participation values;²⁰⁶ and because agency rulemaking is comparatively flexible and can thus respond to changing conditions.²⁰⁷ Each of these theories plausibly explains deference in the general case. But no matter which of these theories of deference you choose, they have little purchase as applied to the policy views developed by OSG in patent litigation.²⁰⁸

Even skeptics of de facto deference—those who might think that OSG's successes are more fairly attributable to its advocacy skill than to some form of implicit deference—should be concerned about the policy

choice between executive agents: No matter whether patent policy is set by the Patent Office or the Solicitor General's Office, either one helps to establish uniform, national rules. Moreover, the existence of the Federal Circuit—a single appellate court with nationwide jurisdiction over patent appeals—limits the power of the uniformity theory for deference in patent contexts. *See* Narechania, *supra* note 37, at 1363–64 (describing the Federal Circuit's effect on uniformity concerns).

203. *See, e.g., supra* text accompanying notes 153–154 (clarifying that the Supreme Court does not typically invoke its formal deference doctrines in patent cases).

204. *See, e.g., Chem. Mfrs.' Ass'n v. Nat. Res. Def. Council*, 470 U.S. 116, 138 (1985) (Marshall, J., dissenting); *see also* Lisa Schultz Bressman, *Deference and Democracy*, 75 GEO. WASH. L. REV. 761, 798 (2007); Thomas W. Merrill, *The Mead Doctrine: Rules and Standards, Meta-Rules and Meta-Standards*, 54 ADMIN. L. REV. 807, 824 (2002) (suggesting that the delegation theory “has resuscitated the axiom that Congress is the primary source of authority to make law within our system of separation of powers”).

205. *E.g., Chevron*, 467 U.S. at 865.

206. *E.g., Merrill & Hickman, supra* note 49, at 884–86; Jim Rossi, *Respecting Deference: Conceptualizing Skidmore within the Architecture of Chevron*, 42 WM. & MARY L. REV. 1105, 1122–23 (2001).

207. *Nat'l Cable & Telecomms. Ass'n v. Brand X Internet Servs.*, 545 U.S. 967 (2005) (quotation marks and citations omitted) (quoting *United States v. Mead Corp.*, 533 U.S. 218, 247 (Scalia, J., dissenting)); *see also Motor Vehicle Mfrs.' Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29 (1983).

208. *Cf. Kathryn E. Kovacs, Constraining the Statutory President*, WASH. U. L. REV. (forthcoming) (similar, but for the President instead of OSG).

views advanced by OSG in patent litigation.²⁰⁹ This is because of the nature of OSG's representation: When the Solicitor General stands before the Supreme Court, he does so on behalf of the United States of America (and the Executive Branch in particular), accountable to the public and "commit[ted] to broader goals of justice and efficiency."²¹⁰ Hence, even to the extent the Solicitor General's views are merely persuasive to the Supreme Court (rather than the object of the Court's deference), we might still examine how the Solicitor General develops its (ultra-persuasive) arguments on behalf of the public. This is because these foundations of deference—substantive expertise, reasoned decisionmaking, among others—offer one set of standards against which to measure the Executive Branch's exercise of policymaking power.²¹¹ In short, OSG's comparative disadvantages (as compared to the Patent Office) along these dimensions should have important implications for the scope of the Solicitor General's policy influence, no matter whether that influence arises from formal deference, informal deference, or mere persuasion.

1. *Implied Delegation*

I begin with the theory of implied delegation. Under *Chevron*, judicial deference is appropriate in part because statutory ambiguity reflects Congress's intent to leave the matter to the agency. Sometimes "Congress has explicitly left a gap for the agency to fill."²¹² In other cases, Congress uses a vague term—say, "reasonable"—which the agency may further define. In either event, deference reflects, at least in part, separation of powers principles and the courts' longstanding respect for Congress's legislative choices, including its decisions over who—agency, legislature, or court—should make particular policy judgments.²¹³

209. *But see* BLACK & OWENS, EXECUTIVE BRANCH INFLUENCES, *supra* note 20, at 89–91 (finding that OSG's relative success cannot be explained by the experience of its attorneys, the quality of its attorneys, its resource advantages, or its selectivity in case selection); Black & Owens, *A Built-In Advantage*, *supra* note 20, at 457–61 (similar).

210. Black & Owens, *A Built-In Advantage*, *supra* note 20, at 91; *see also* Vladeck, *supra* note 20, at 123–24.

211. *Cf.* Grumet, *supra* note 20, at 1860 (contending, analogously, that state attorneys general owe "accountability" and internal "separation of powers" duties to their home governments and constituencies in their Supreme Court advocacy).

212. *Chevron*, U.S.A., Inc. v. Nat. Res. Def. Council, Inc., 467 U.S. 837, 843 (1984); *see also* Lemos, *supra* note 19, at 206 n.69 (explaining that delegation is important under *Skidmore* too).

213. *See, e.g.*, Chem. Mfrs. Ass'n v. Nat. Res. Def. Council, Inc., 470 U.S. 116, 138 (1985) (Marshall, J., dissenting); *see also* Bressman, *supra* note 204, at 798; Merrill, *supra* note 204, at 824 (suggesting that delegation theory "has resuscitated the axiom that Congress is the primary source of authority to make law within our system of separation of powers").

To be sure, scholars (among others) have criticized this implied delegation theory of deference.²¹⁴ Primary among these critiques is the view that the theory “‘is fictional or fraudulent’—fictional because ambiguity does not necessarily evince congressional intent, and fraudulent because the Supreme Court seems disinterested in actually assessing congressional intent.”²¹⁵ This critique has mixed empirical support: In their study on congressional drafting, Lisa Schultz Bressman and Abbe Gluck find that “ambiguity sometimes signals intent to delegate” but “often it does not.”²¹⁶ Rather, statutory ambiguity may instead be a function of other considerations, including the need for consensus among a legislative majority.²¹⁷

These critiques, then, offer one reason to question the Court’s apparent deference to OSG’s views in patent cases. If the entire enterprise of judicial deference is based on delegation, and if delegation itself is a fraudulent fiction, there is no reason to defer to any executive agent.

There are, however, reasons to think that implied delegation theory is not a fraudulent fiction—at least not entirely.²¹⁸ As noted above, Lisa Bressman and Abbe Gluck’s study suggests that “ambiguity sometimes signals intent to delegate.”²¹⁹ Indeed, some of their respondents say expressly that statutory ambiguity is “about punting to the agency,” “know[ing] the agency can fill the gaps.”²²⁰ That is, at least some statutory ambiguities may reflect a congressional desire to delegate the finer points of policy to an executive agency (perhaps in order to secure a legislative majority).

But which agency? Even if there is some (perhaps weak) support for implied delegation theory generally, there is no reason to think that Congress has delegated—impliedly or expressly—patent policymaking authority to the Solicitor General’s Office. The Patent Office—not

214. See, e.g., *Gundy v. United States*, 588 U.S. 2116, 2131 (2019) (Gorsuch, J., dissenting) (criticizing delegation).

215. Barnett, Boyd & Walker, *supra* note 202, at 1476; see also Manning, *supra* note 52, at 458 (“Every framework used by the Court for determining the availability of deference has rested on a legal fiction about presumed legislative intent.”); Thomas W. Merrill, *Judicial Deference to Executive Precedent*, 101 *YALE L.J.* 969, 995 (1992).

216. Gluck & Bressman, *supra* note 52, at 996.

217. *Id.*

218. And, as I discuss in subsequent sections, there are reasons to think that the enterprise of deference is based on more than only delegation-related theories.

219. Gluck & Bressman, *supra* note 52, at 996.

220. *Id.* at 997; see also *id.* at 999 (explaining that Congress may intend to delegate policymaking authority where it confers rulemaking power under the Administrative Procedure Act); *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 843 (1984) (reasoning that deference is warranted where “Congress has explicitly left a gap for the agency to fill”).

OSG—is Congress’s delegee on questions of patent policy. This selection matters: Congress exercises legislative oversight and control by choosing from among different possible executive agents.²²¹

Congress has given the Patent Office the clear power to “establish regulations,” using standard administrative procedures, that “govern the conduct of proceedings in the Office,” including patent application review.²²² The Supreme Court, moreover, has explained that this power extends to substantive policy determinations (even if the Patent Office has not yet invoked it).²²³ Hence, to the extent that deference is grounded in congressional delegations of policymaking power, these provisions of the Patent Act might be read as evidence of Congress’s intent to give the Patent Office, rather than any other office in the Executive Branch, some decisional authority.²²⁴

There are, by contrast, no analogous directives from Congress to OSG. Indeed, the only statutory provision regarding the Solicitor General simply provides that “[t]he President shall appoint . . . a Solicitor General, learned in the law, to assist the Attorney General in the performance of his duties.”²²⁵ That bare qualification—to be “learned in the law”—reflects the Solicitor General’s responsibility to represent the Government in litigation, but offers practically no support for a policymaking role, let alone a patent one.²²⁶

Viewed against this backdrop, *Myriad*’s story seems striking. Two executive agencies offered two distinct views on patentability: The Solicitor General’s Office argued that isolated DNA was not patentable, while the Patent Office remained committed to its practice of granting such patent applications. And though the Patent Office has a much stronger case to legislative delegation than OSG, the Court followed the

221. Cf. Rebecca Ingber, *Congressional Administration of Foreign Affairs*, 106 VA. L. REV. (forthcoming 2020); Sharon Jacobs, *The Statutory Separation of Powers*, 129 YALE L.J. 378, 378 (2019).

222. 35 U.S.C. § 2(b)(2)(A)–(C) (2018); *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2144 (2016).

223. *Cuozzo*, 136 S. Ct. at 2143.

224. The Federal Circuit, of course, disagrees. See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996); see also *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1335 (Fed. Cir. 2008). But, as noted above, the Supreme Court might be understood to have taken a different view. See *Cuozzo*, 136 S. Ct. at 2143 (questioning *Cooper Techs.*, 536 F.3d 1330); see also *id.* (construing a similarly worded statute as granting the Patent Office the authority to issue regulations concerning the substantive standard for claim construction in inter partes review). Compare 35 U.S.C. § 2(b)(2)(A) (2018) (“The Office may establish regulations . . . [that] shall govern the conduct of proceedings in the Office.”), with 35 U.S.C. § 316(a)(4) (“The Director shall prescribe regulations . . . governing inter partes review . . .”).

225. 28 U.S.C. § 505 (2018).

226. See Lemos, *supra* note 19, at 207–08 (quoting 28 U.S.C. § 505) (reasoning that OSG, like the courts, should defer to agencies when defending Government action, because “Congress chose to delegate to the agency, not to the SG”).

Solicitor General’s advice—even as the Court has elsewhere suggested that no deference is due where one agency purports to interpret the statutory provisions administered by another agency.²²⁷ Indeed, the Court even suggested that OSG’s contrary position had “undercut” the Patent Office’s persuasive power. Instead, perhaps, it is the Patent Office’s decision to dissent from the Solicitor General’s brief that, under delegation theory, should have undermined OSG’s influence. I should be clear that my objection to the Court’s decision in *Myriad* is not substantive. I am (for present purposes) agnostic as to the right substantive standard for patent eligibility.²²⁸ But if that standard is to come from an executive agency, Congress likely would have preferred that the Patent Office, more than any other executive agency, make this policy decision.

This is so even accounting for the underlying interagency conflict that led to the Solicitor General’s “reevaluation” of the Patent Office’s position.²²⁹ To the extent that the National Institutes of Health and the Patent Office disagreed over the patentability of certain genomic matter,²³⁰ it is far from clear that Congress gave OSG the authority to mediate such interagency patent disputes. First, Congress has expressly directed the Patent Office to “advise” other “agencies and departments on matters of intellectual property policy.”²³¹ So if the National Institutes of Health have questions about gene patents, the Patent Office seems assigned, by Congress, to provide the answers. And second, even if a persistent interagency conflict about patent policy arises, the responsibility to adjudicate such an intra-Executive conflict has often fallen to the Justice Department’s Office of Legal Counsel, or to the White House itself, rather than to OSG.²³² Though it is true that OSG has sometimes been thrust into the position of mediating interagency

227. See *Epic Sys. v. Lewis*, 584 U.S. ___, 138 S. Ct. 1612, 1629 (2019) (“[O]n no account might we agree that Congress implicitly delegated to an agency authority to address the meaning of a second statute it does not administer.”).

228. Indeed, I find *Myriad* persuasive. I explain this view—and how it is consistent with my views on decisionmaking procedure—*infra* note 378.

229. Brief for the United States as Amicus Curiae in Support of Neither Party at 18, *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 653 F.3d 1329 (Fed. Cir. 2011) (No. 2010-1406).

230. See *Park*, *supra* note 23, at 526; see also *Narechania*, *supra* note 10, at 1504–06; *Rai*, *supra* note 7, at 1261.

231. 35 U.S.C. § 2(b)(8)–(9) (2018).

232. 28 U.S.C. § 511 (2018); 28 C.F.R. § 0.25 (2019); Exec. Order No. 12,146, 44 Fed. Reg. 42657 (July 20, 1979); see Randolph D. Moss, *Executive Branch Legal Interpretation*, 52 ADMIN. L. REV. 1303, 1308 (2000); see also Trevor W. Morrison, *Constitutional Alarmism*, 124 HARV. L. REV. 1688, 1732 (2011); Trevor W. Morrison, *Stare Decisis in the Office of Legal Counsel*, 110 COLUM. L. REV. 1448 (2010).

disputes,²³³ there is little reason to think that Congress expected the Executive Branch to deviate from its otherwise well-established practices for the patent conflict class alone.²³⁴

The Executive Branch's influence in *Merck* and *Microsoft* also seems inconsistent with the scope of the congressional delegation described above. Unlike the conflict at issue in *Myriad*, the Patent Office and OSG in fact agreed on the standard for reasonableness in *Merck*. But *Merck*, recall, was an infringement case.²³⁵ And such infringement matters would seem to be outside the scope of "proceedings in the Office."²³⁶ Indeed, though the Patent Office passes upon hundreds of thousands of patent applications each year, the questions at issue in cases like *Merck* and *Microsoft* do not arise until well after it issues a patent. In *Merck*, for example, the question of "reasonabl[y]" excused infringement did not arise until years after the patent in question issued.²³⁷ That is, while the Patent Office's standard for patentability should govern the review of patent applications (and, hence, the scope of valid patents), it has no claim to authoritatively interpret infringement-related provisions.²³⁸

In short, across many cases, the Supreme Court's apparent deference to the views of the Solicitor General's Office cannot be explained by any explicit (or implicit) delegation of policymaking authority from Congress. Congress has delegated no patent policymaking power to OSG, and so OSG has no obvious power to override the Patent Office's policy determinations, or to step into a policy void left open by that agency's inaction. Even when OSG relays the Patent Office's views in infringement cases, a close look at Congress's delegation would seem to put infringement-related matters outside the Executive Branch's scope.

2. Agency Expertise

The Solicitor General's Office also lacks the sorts of technical and legal patent expertise that may serve as the basis for deference. *Chevron* explains that an agency's reasonable views are entitled to "considerable weight" where "a full understanding" of the "statutory policy" requires

233. See Rebecca Ingber, *Interpretation Catalysts and Executive Branch Legal Decisionmaking*, 38 YALE J. INT'L L. 359, 370–71 (2013).

234. Indeed, in other conflicts between intellectual property and other regulatory regimes, White House offices have helped mediate. See Narechania, *supra* note 10, at 1526, 1540.

235. See *supra* notes 156–158, 174–176 and accompanying text.

236. 35 U.S.C. § 2(b)(2)(A).

237. See *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193, 197–99 (2005).

238. Moreover, as I described above, *supra* text accompanying note 175, OSG's pronouncements in these cases might also seem to fail *Skidmore*'s requirement that an agency's view evince some procedural "thoroughness . . . in its consideration." *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

“more than ordinary knowledge” about the regulatory subject.²³⁹ *Skidmore* likewise explains that courts may resort to an agency’s views for guidance in light of that agency’s “experience and informed judgment.”²⁴⁰ Together, *Chevron* and *Skidmore* both suggest that at least two dimensions of expertise are salient to the question of deference: first, agencies often have relevant technical knowledge about the industry or technology at issue; and second, agencies have relevant legal insight into, say, the purposes of Congress’s enactments, or the meaning of a statute’s terms and structure. But the Solicitor General’s Office, at least in respect to the Supreme Court’s patent docket, cannot stake a claim to either form of expertise.

Consider technical expertise first. Courts defer to executive agencies because their deep, specialized knowledge about, say, the process of drug development enables them to more readily discern what limits on that process might be “reasonable.”²⁴¹ That is, deference doctrines attempt to assign responsibility over substantive rules to a more institutionally competent actor—executive agencies. Agencies may, for example, employ specialist staff who can draw on their accumulated knowledge of the relevant technology or industry.²⁴² Agencies may also gather information critical to rulemaking by, for example, holding public hearings, conducting original studies, and conferring with industry experts.²⁴³

But none of these features apply to OSG. Maggie Lemos, for example, has explained that “true specialization is rare” in the Solicitor General’s Office.²⁴⁴ Indeed, this lack of specialization is sometimes described as one of OSG’s assets: As it defends the Government’s portfolio of actions before the Judiciary, OSG takes a “broa[d] view” of litigation, one that is unencumbered by the “unproductive tunnel vision” that might characterize a single’s agency defense of its parochial

239. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 844 (1984) (citing, *inter alia*, *Nat’l Broad. Co. v. United States*, 319 U.S. 190 (1943)).

240. *Skidmore*, 323 U.S. at 140.

241. See Barnett, Boyd & Walker, *supra* note 202, at 1477 (explaining that courts defer, “at least in part because those agencies are more expert than the courts in the subject matter”); see also *supra* notes 169–170 and accompanying text (discussing “reasonable” exceptions to patent infringement rules for drug development in *Merck*).

242. See, e.g., *Chevron*, 467 U.S. at 865; see also Deborah Pearlstein, *Justice Stevens and the Expert Executive*, 99 GEO. L.J. 1301, 1305–06 (2011).

243. See, e.g., Wasserman, *supra* note 15, at 2009 (explaining that the Patent Office “enjoys superior mechanisms of gathering information necessary to make informed patent policy decisions” because it “conducts hearings,” “partakes in research studies,” and “engages in rulemaking,” among other activities).

244. Lemos, *supra* note 19, at 211–12.

interests at the expense of the Executive's more long-term view.²⁴⁵ There are, thus, at least two significant benefits to OSG's intervention as a generalist. First, the Solicitor General's control over litigation may offer the President one means by which to execute on a long-term policy vision by helping to coordinate activity across the administrative state.²⁴⁶ Second, the Solicitor General can play a valuable interpretative role, translating the agency's technical work in more lucid terms.²⁴⁷ But those benefits do not hinge upon the Office's expertise: Indeed, they may gain from that Office's lack of substantive knowledge. Hence, though there are advantages to having the Solicitor General serve in this unique role of interbranch translator, those advantages do not accord with the doctrines of judicial deference.

The same can be said for the second form of expertise, legal expertise. *Chevron* itself, for example, is understood to maintain that where an agency is responsible for "administer[ing]" some "statutory schema," that agency usually has "far greater expertise than courts as to the legislative processes that resulted in th[at] statutory schema."²⁴⁸ This may be for several reasons. One, the agency's repeat interactions with the statute can give rise to greater familiarity with the various details of Congress's (sometimes lengthy and interlocking) statutory schemes. Two, some scholars have described the agencies' own direct participation in the legislative process, explaining that such participation justifies deference.²⁴⁹ Indeed, both Justice Breyer and Justice Scalia agreed that the agencies' involvement in legislative process enable them to better implement a statute's purpose.²⁵⁰ And three, some agency personnel may have experience that similarly provides unique insight into a statute's nature and purpose.

None of these attributes appear to apply to the Solicitor General's Office. Instead, they better describe the Patent Office.

First, while the volume of patent cases on the Supreme Court's docket is, on average, higher than before, the number and nature of these cases seem hardly likely to turn OSG into a Patent Act expert. In some Terms, patent cases may occupy a sizable portion of the Supreme Court's total

245. *Id.* at 211.

246. *See* Picozzi, *supra* note 35, at 445–46. This is only true to the extent that the President exercises some control over the Solicitor General. But there may be some reasons to question the extent of the President's control. *See infra* notes 310–314 and accompanying text.

247. Lemos, *supra* note 19, at 211.

248. Barnett, Boyd & Walker, *supra* note 202, at 1477.

249. *E.g.*, Shobe, *supra* note 32, at 286.

250. *See* Barnett, Boyd & Walker, *supra* note 202, at 1477 (first citing Antonin Scalia, *Judicial Deference to Administrative Interpretations of Law*, 1989 DUKE L.J. 511, 521; then citing Stephen Breyer, *Judicial Review of Questions of Law and Policy*, 38 ADMIN. L. REV. 363, 368 (1986)).

docket.²⁵¹ But even when patent cases take up 10% of the Court's argument time, that amounts to six cases in total.²⁵² Moreover, several of these cases pertain to procedural or remedial questions that are outside the "core" of patent doctrine.²⁵³ By contrast, the Patent Office passes on over 300,000 patent applications each year, and it has conducted over 1,000 post-issuance review proceedings.²⁵⁴

Second, the Solicitor General seems unlikely to have had a hand in helping to draft aspects of the Patent Act. OSG's absence from the legislative process suggests that it has no special insight into the meaning of Congress's provisions. By contrast, Congress enacted a landmark 2011 patent reform statute, the Leahy-Smith America Invents Act, "after many years of negotiation between the United States Patent and Trademark Office . . . and various congressional committees. The [Patent Office] prepared an early version of the legislation, then proceeded to send at least six views, letters, and various reports to congressional committees in the following years."²⁵⁵

And, finally, one of the principal drafters of the America Invents Act, Joe Matal, eventually served as the Patent Office's Deputy General Counsel and Interim Director.²⁵⁶ But there is no obvious connection between OSG's personnel and patent-related legislative activity.

The Patent Office's legal expertise has important implications for cases such as *Cuozzo*. As noted above, the Patent Office regulation at issue in *Cuozzo* directed the Patent Trial and Appeal Board to apply the

251. See Narechania, *supra* note 37, at 1346 ("In its 2016 Term, the Supreme Court dedicated nearly ten percent of its docket to patent cases.").

252. *Id.* at 1346 n.1.

253. *Id.* at 1349; Paul R. Gugliuzza, *How Much Has the Supreme Court Changed Patent Law?*, 16 CHI.-KENT J. INTEL. PROP. 330, 331 (2017) ("[T]he Supreme Court's recent decisions, though substantial in number, have rarely involved the fundamental legal doctrines that directly ensure the inventiveness of patents and regulate their scope.").

254. See U.S. PATENT & TRADEMARK OFFICE, U.S. PATENT STATISTICS CHART: CALENDAR YEARS (1963–2015), https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm [<https://perma.cc/S8LG-S63M>]; U.S. PATENT & TRADEMARK OFFICE, TRIAL STATISTICS: IPR, PGR, CBM (2019), https://www.uspto.gov/sites/default/files/documents/trial_statistics_mar_2019.pdf [<https://perma.cc/E3LN-UFFV>]. But see Narechania, *supra* note 10, at 1487 (questioning the sufficiency of the Patent Office's expertise in instances of conflict between patent law decisions and other regulatory regimes). I continue to believe that, in cases arising out of the interstices of patent policy and other regulatory interests, the Patent Office may not possess the sort of expertise necessary to resolve the policy conflict. Indeed, as I suggest elsewhere, some formal mechanism may help resolve such intra-Executive conflicts. See Tejas N. Narechania, *Structuring Intraexecutive Patent Conflict* (2020) (unpublished manuscript) (on file with author); *cf.* *Return Mail, Inc. v. U.S. Postal Serv.*, 587 U.S. ___, 139 S. Ct. 1853, 1853 (2019). But, in all events, the Patent Office is likely to possess more expertise than the Solicitor General's Office.

255. Shobe, *supra* note 32, at 302 n.72.

256. See *Joseph Matal*, U.S. PATENT & TRADEMARK OFF., <https://www.uspto.gov/about-us/executive-biographies/joseph-matal> [<https://perma.cc/8BEB-N67N>].

“broadest reasonable construction” standard in inter partes review.²⁵⁷ And the Patent Office’s rule implied that the America Invents Act required it to apply this standard; the Act’s provisions, structure, and legislative history all suggested, in that agency’s view, that this was the standard that Congress expected the Patent Office to employ. But the Solicitor General reframed the agency’s defense as primarily about legislative delegation: Congress, the SG argued, expressly gave the agency discretion to choose which standard to apply by authorizing it to issue regulations “governing inter partes review.”²⁵⁸ But under this theory of expertise, it is the Patent Office—not the Solicitor General’s Office—that is most likely to best approximate Congress’s intent. That is, the Patent Office is comparatively better suited to know whether Congress intended the agency to apply one particular standard or whether Congress intended to give the agency discretion to choose. The Solicitor General’s success in substituting its judgment for the agency’s has real consequences: By successfully defending the agency’s regulations on *Chevron*’s terms, the Solicitor General gave future Patent Office directors the flexibility to change course. And, indeed, the next administration issued a new rule, changing the governing standard from broadest reasonable interpretation to *Phillips*—the standard employed in the district courts.²⁵⁹ So though the present Patent Office may value that flexibility, the past Patent Office seemed to suggest—based on its legislative expertise regarding a statute it helped to draft—that Congress did not grant any such discretion.

If deference turns on expertise, then OSG falls short. Though deference to the Executive Branch may be founded on the agencies’ comparative advantages in substantive and legal expertise, the Solicitor General’s Office possesses neither. Of course, a similar objection might be levied at the Supreme Court’s decision to defer to *any* Executive policy judgment: After all, the Solicitor General generally defends the Executive’s actions in all cases, not just patent ones. But there is a critical difference: In, say, a telecommunications case, the underlying action reflects the agency’s expertise. NTIA’s decisions, for example, are often based on its lengthy experience with telecommunications regulation, on advice from industry and experts, its own data analyses, and its own interactions with Congress, among other inputs. And the Solicitor General’s role is generally to defend that underlying action. But

257. 37 C.F.R. § 42.100(b) (2016).

258. 35 U.S.C. § 316(a)(4) (2018). *See generally* Hemel & Nielson, *supra* note 49.

259. Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 21221, 21221 (proposed May 9, 2018) (to be codified at 37 C.F.R. pt. 42).

in patent cases, policymaking and policy defense seem to happen simultaneously. Moreover, as the next section describes, even where the Patent Office shares its expertise with the Solicitor General's Office in litigation contexts, the Patent Office's own input may not reflect the reasoned deliberation that typically informs the Judiciary's deference to the Executive.²⁶⁰

3. *Reasoned Deliberation*

In *Mead*, the Supreme Court explained that “express congressional authorizations to engage in the process of rulemaking or adjudication” are a “very good indicator” that deference is warranted.²⁶¹ Why do deference doctrines care about such deliberative process? Such process requirements are, in part, a proxy for the other foundations of deference. Authorization to use formal rulemaking authority might signal some legislative intent to delegate policymaking power.²⁶² Likewise, requiring an agency to make policy through regular administrative processes helps to ensure that the agency's regulations are informed by both its internal expertise, as well as its capacity to coordinate external expertise through comments and hearings.²⁶³

But there are distinct (though related) reasons that such reasoned deliberation forms an independent theoretical basis for deference. Stated simply, “[r]ulemaking is an excellent policymaking mechanism.”²⁶⁴ That is, “agencies are better at collecting and synthesizing information through rulemaking processes than are courts through litigation.”²⁶⁵ And requiring—and enforcing, through, say, the *Chenery* doctrine (which prevents agencies from justifying policy decisions through *post hoc* or litigation-specific rationales)—such administrative process helps to ensure that an agency has in fact “worked through” a regulatory problem.²⁶⁶ Finally, such process requirements increase opportunities for

260. See U.S. PATENT & TRADEMARK OFFICE, PERFORMANCE AND ACCOUNTABILITY REP.: FISCAL YEAR 2005, at 48 (2005) (“The [Patent Office] also assisted the Solicitor General's Office with the government's brief in *Merck* . . .”).

261. *United States v. Mead Corp.*, 533 U.S. 218, 229 (2001); see also *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) (highlighting the importance of the “thoroughness” of an agency's investigation).

262. Barnett, Boyd & Walker, *supra* note 202, at 1478–79; Gluck & Bressman, *supra* note 52, at 999.

263. See *Mead*, 533 U.S. at 230 (Such “relatively formal administrative procedure[s] tend[] to foster the fairness and deliberation that should underlie a pronouncement of such force.”).

264. Charles H. Koch, Jr., *Judicial Review of Administrative Discretion*, 54 GEO. WASH. L. REV. 469, 486 (1986).

265. Criddle, *supra* note 202, at 1291.

266. See *Stack*, *supra* note 41, at 1005; see also *Encino Motorcars v. Navarro*, 584 U.S. ___, 136 S. Ct. 2117, 2127 (2016).

public participation, and thereby enhance the democratic legitimacy of the agency's action.²⁶⁷

Hence, this basis for deference consists of at least three components. First, the agency must “collect[] and synthesize information” by, say, soliciting public comment and “facilitat[ing] public participation.”²⁶⁸ Second, the agency must actually “work through” the problem.²⁶⁹ And third, to merit deference under *Chevron*, the agency's position in litigation must actually reflect that deliberative process.²⁷⁰

As compared to other executive agencies, the Solicitor General's Office, acting as patent policymaker, falls short along each of these three requirements.

First, OSG's decisionmaking processes do not appear to closely track regular, formal rulemaking procedures. To be sure, *Mead* acknowledges that such formal administrative processes are not strictly required: Courts may defer under *Skidmore* “even when no such administrative formality was required and none was afforded.”²⁷¹ And representatives of the Solicitor General's Office have described aspects of its process in ways that sound in traditional administrative process. OSG, for example, does “seek input from all affected federal agencies,” and it “will meet with a party to a case in which it's going to file . . . [a]nd it will give an equal opportunity to lawyers for the other side if they ask.”²⁷² That is, the Solicitor General's Office will consult with other agencies that it believes will have a stake in the case's outcome—and the Office will agree to meet with the parties to the litigation.

But because the effects of the Supreme Court's cases range far beyond the parties to the litigation, the Solicitor General's views often

267. *E.g.*, Merrill & Hickman, *supra* note 49, at 884–86; Rossi, *supra* note 206, at 1122–23.

268. Criddle, *supra* note 202, at 1291, 1317.

269. *See* Stack, *supra* note 41, at 1005; *cf.* Jeremy Rozansky, Note, *Waiving Chevron*, 85 U. CHI. L. REV. 1927, 1927 (2018) (“Congress wants agency policy change to be channeled through rigorous procedures. Such procedures—like notice-and-comment rulemaking and formal adjudication—help ensure that the agency actually wrestles with technical arguments, more fully deliberates, alerts Congress and interested individuals to a pending action, works with elected officials, and provides a basic opportunity for individual participation in the decisionmaking.”).

270. *E.g.*, *Encino Motorcars*, 136 S. Ct. at 2127 (citing, *inter alia*, *SEC v. Chenery Corp.*, 332 U.S. 194, 196 (1947)).

271. *See* *United States v. Mead Corp.*, 533 U.S. 218, 231 (2001).

272. Patricia A. Millett, “*We’re Your Government and We’re Here To Help*”: *Obtaining Amicus Support from the Federal Government in Supreme Court Cases*, 10 J. APP. PRAC. & PROCESS 209, 218 (2009); Ginger D. Anders, *Calls for the Views of the Solicitor General: An Obscure But Important*

Part of Supreme Court Practice, A.B.A.: TRENDS (June 26, 2017), https://www.americanbar.org/groups/environment_energy_resources/publications/trends/2016-2017/july-august-2017/calls-for-the-views-of-the-solicitor-general/ [<https://perma.cc/UB8M-WXDW>].

implicate broad interests.²⁷³ *Merck*, for example, had implications for the entire pharmaceutical industry.²⁷⁴ *Microsoft* mattered for a wide range of computer hardware and software manufacturers.²⁷⁵ Yet OSG does not appear to solicit the views of representatives of such interests, nor do such representatives have many, if any, opportunities to participate in OSG's process. That is, because "there are no formal avenues for the public to participate in SG decisionmaking," interested groups have scant procedural protections.²⁷⁶ Hence, even if OSG runs a thorough, open, and inclusive decisionmaking process in one case, it is not required to do so in all cases. And, indeed, OSG's practices can vary widely, from case-to-case and administration-to-administration.²⁷⁷

And even for those sister agencies and parties that are invited to participate in OSG's decisionmaking process, that Office's process differs from usual rulemaking proceedings in notable respects. For example, an agency typically "has an obligation to make its views known to the public in a concrete and focused form so as to make criticism or formulation of alternatives possible."²⁷⁸ And agencies must typically respond to all major objections raised in a proceeding.²⁷⁹ OSG, by contrast, obfuscates. "[C]ounsel [for interested parties] should not expect attorneys from [OSG] to discuss their anticipated position in the case."²⁸⁰ And outside observers often do not know why the Solicitor General's Office has reached one conclusion over another.

To be sure, former Solicitors General have described such silence as a necessary byproduct of OSG's decisionmaking process.²⁸¹ But other agencies, of course, routinely adhere to this procedural requirement in

273. See SUP. CT. R. 10(c) (2019) (explaining that the Supreme Court may agree to hear cases that present an "important question of federal law").

274. See, e.g., Brief of Amici Curiae Applera Corp. & Isis Pharm., Inc. in Support of Respondents at 6, *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193 (2005) (No. 03-1237), 2005 WL 682090 [hereinafter *Applera & Isis Amicus Brief*].

275. See, e.g., Brief of U.S. Philips Corp. & Philips Elecs. N. Am. Corp. as Amici Curiae in Support of Respondent at 5–6, *Microsoft v. AT&T*, 550 U.S. 437 (2007) (No. 05-1056), 2007 WL 197102 [hereinafter *Philips Amicus Brief*].

276. Lemos, *supra* note 19, at 221.

277. See, e.g., Vladeck, *supra* note 20, 125, 132–34 (describing differences across presidential administrations); *infra* notes 359–360 and accompanying text (describing variance in OSG's CVSG practice across patent cases).

278. *Home Box Office, Inc. v. FCC*, 567 F.2d 9, 36 (D.C. Cir. 1977); see also *U.S. Chamber of Commerce v. OSHA*, 636 F.2d 464, 472 (D.C. Cir. 1980) (Bazelon, J., concurring in the judgment) ("I believe that advance notice and opportunity for public participation are vital if a semblance of democracy is to survive in this regulatory era.").

279. See, e.g., *Weyerhaeuser Co. v. Costle*, 590 F.2d 1011, 1031 (D.C. Cir. 1978).

280. Millett, *supra* note 272, at 221–22.

281. *Id.* (OSG will not disclose its policy preferences because meetings with interested parties are "part of the Solicitor General's process of formulating its own position.").

their own decisionmaking processes, in order to both help interested commenters focus their contributions and to avoid any unfair surprise in the agency's final outcome. Not so at OSG.

Likewise, former Solicitors General have described the Office's process of soliciting input as a series of cross-examinations: Each interaction is like its own "moot court," putting each party's preferred position on trial.²⁸² Such a series of discrete interrogations, mediated by the Solicitor General's office, contrasts sharply with a typical rulemaking proceeding. Agency dockets can read much more like a conversation among commenters: Interested parties respond directly to one another (and the agency, too), disputing each others' factual premises, identifying policy concerns, and proposing alternative regulations and outcomes. This latter, more robust model of "publi[c] participation in the administrative process can make the law better—better informed, and better calibrated" to its possible effects, whereas OSG's closed, private process remains susceptible to errors and omissions.²⁸³

This secretive process also undermines the integrity of the Solicitor General's influence over patent policy. This is so even where the SG and the Patent Office are in accord—when, that is, OSG might be said to be able to draw upon the primary agency's expertise.²⁸⁴ Consider *Merck*, a case with important ramifications for the pharmaceutical industry. There, officials from both the Patent Office and the Department of Health and Human Services signed the Solicitor General's brief, which argued in favor of a construction of "reasonable" that favored generic drug manufacturers over pharmaceutical innovators. And the Court deferred to that position. But neither the Patent Office nor Health and Human Services ever had to issue a notice of proposed rulemaking regarding that proposed construction, nor was either forced to respond to the objections of pharmaceutical companies. Indeed, other *amici* in *Merck* contended that the Government's proposed rule would undermine

282. See, e.g., Anders, *supra* note 272; Millett, *supra* note 272, at 221–22; Gene Quinn, *Mechanics of a Supreme Court Decision to Grant Certiorari*, IPWATCHDOG (Nov. 29, 2012), <https://www.ipwatchdog.com/2012/11/29/mechanics-of-a-supreme-court-decision-to-grant-certiorari/id=30526/> [<https://perma.cc/7TPK-3H7M>] (interviewing former Solicitor General Seth Waxman).

283. Compare, e.g., Eugene Scalia, *The Value of Public Participation in Rulemaking*, REG. REV. (Sept. 25, 2017), <https://www.theregreview.org/2017/09/25/scalia-public-participation-rulemaking/> [<https://perma.cc/PEB9-7XMR>], with, e.g., Nancy Morawetz, *Convenient Facts: Nken v. Holder, the Solicitor General, and the Presentation of Internal Government Facts*, 88 N.Y.U. L. REV. 1600 (2013), and Allison Orr Larsen, *The Trouble with Amicus Facts*, 100 VA. L. REV. 1757, 1787–88 (2014).

284. Long, *supra* note 71, at 1988 (explaining that the Patent Office is becoming a "more aggressive" "supplier of legal rules" but noting the transparency-related concerns that attend to this mode of rulemaking).

incentives for some basic research, would violate the Government's treaty obligations, and would have adverse long-term effects on public health.²⁸⁵ The agencies were never made to respond to these arguments, and it is practically impossible to know whether they would have modified their position in response to comments such as these. Such deficits undermine the case for deference under either *Chevron* or *Skidmore*.²⁸⁶ Similarly, in *Microsoft*, the Solicitor General argued that its proposed rule would advance "the goal of a technology-neutral statutory scheme."²⁸⁷ But Philips Electronics argues, in its own amicus brief, that the SG's position "unfairly favors the software industry over traditional electronics hardware companies."²⁸⁸ How did the Executive Branch address this apparent contradiction? We do not know.

The Solicitor General's procedures thus differ from the policymaking processes imposed on other agencies. Agencies must, under *Chevron*, typically disclose their proposed rules and open those proposals to comment and criticism from the public. OSG, by contrast, need not offer any hints as to its preliminary leanings, and it is free to solicit input from only a select group of interested agencies and parties (and to do so on its own terms). In short, the public has few, if any, procedural protections in the Solicitor General's decisionmaking process—and thus enjoys only limited, if any, opportunities to contribute to the SG's final decision.²⁸⁹ These process deficiencies not only risk omitting critical information that might alter OSG's proposed rules, their closed and secretive nature also harms these rules' legitimacy.²⁹⁰

Second, even with these limited inputs, OSG's opportunity to work through the patent policy problem presented in a given case is sharply limited by the demands of the Supreme Court's judicial process. Whenever the Solicitor General is thrust into the position of defending (or making) executive policy, litigation is necessarily the "triggering event" that compels the Government to "consider, determine, and potentially assert an interpretation of its obligations and authority."²⁹¹

285. See Brief of Amici Curiae Wis. Alumni Research Found. et al. in Support of Respondents at 19–23, *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193 (2005) (No. 03-1237); *id.* at 23–25; Applera & Isis Amicus Brief, *supra* note 274.

286. *United States v. Mead Corp.* 533 U.S. 218 (2001); *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944) (deference is based, in part, on the "thoroughness evident in [the agency's] consideration").

287. *Microsoft* Amicus Brief, *supra* note 139, at 25.

288. See, e.g., Philips Amicus Brief, *supra* note 275, at 1.

289. Lemos, *supra* note 19, at 221.

290. See, e.g., Robert B. Reich, *Public Administration and Public Deliberation: An Interpretive Essay*, 94 *YALE L.J.* 1617, 1624–25 (1985); Rossi, *supra* note 206, at 1122–23.

291. See Ingber, *supra* note 233, at 360.

But litigation is a comparatively poor “interpretive catalyst”: Litigation imposes, for example, serious time pressure and can thereby result in serious adverse policy consequences.²⁹²

In those cases in which the Supreme Court has asked OSG to file a certiorari-stage amicus brief, OSG tends to hold itself to a few informal, self-imposed deadlines.²⁹³ This means that the Executive’s deliberative processes usually stretches for no more than a few months, with the timeline dictated (to some extent) by the Court. By contrast, the Government Accountability Office has found that major agency proceedings require an “average time . . . [of] about four years,” with a lower bound of about one year.²⁹⁴ That is, major agency actions seem to require at least twice the time that the Solicitor General’s Office typically allots to cases that have attracted the Supreme Court’s attention. Indeed, the Patent Office’s decision to change the claim construction standard applied in inter partes review took, from inception to promulgation, nearly one year: The Patent Office Director, Andrei Iancu, appears to have first floated the possibility in response to the Senate’s questions during his confirmation hearing, and the final rule issued over ten months later.²⁹⁵ To be sure, the Patent Office’s formal comment period did not occupy all ten months: Instead, the Office had the opportunity to solicit input, formulate an initial view, and craft its notice of proposed rulemaking, all before beginning its formal six-month rulemaking process.²⁹⁶ Agencies thus enjoy more time—and greater flexibility—when “working through” their policy problems.²⁹⁷

292. See *id.*; see also Dan Levine & Lawrence Hurley, *Google Versus Oracle Case Exposes Differences Within Obama Administration*, REUTERS (May 15, 2015), <https://www.reuters.com/article/us-google-oracle-lawsuit-insight-idUSKBN0017Z20150515> [<https://perma.cc/3H5Z-28E9>].

293. See, e.g., Lisa McElroy, “*CVSG*’s in Plain English”, SCOTUSBLOG (Feb. 10, 2010, 10:15 AM), <https://www.scotusblog.com/2010/02/last-week-in-plain-english-2/> [<https://perma.cc/BG7N-E9HT>] (explaining that OSG “has filed most invitation briefs at three times of the year: late May, so that the cases can be considered before the summer recess; around August, so that the cases can go on the summer list; and December, so that the cases can be considered in time to be argued that Term if the Court grants cert”).

294. U.S. GOV’T ACCOUNTABILITY OFFICE, FEDERAL RULEMAKING: IMPROVEMENTS NEEDED TO MONITORING AND EVALUATION OF RULES DEVELOPMENT AS WELL AS TO THE TRANSPARENCY OF OMB REGULATORY REVIEWS 5 (2009), <https://www.gao.gov/new.items/d09205.pdf> [<https://perma.cc/9PP4-W9K2>].

295. Compare, e.g., Nomination of Andrei Iancu to be the Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office, 115th Cong.

(Dec. 6, 2017), <https://www.judiciary.senate.gov/imo/media/doc/Iancu%20Responses%20to%20QFRs.pdf> [<https://perma.cc/KT7A-X8GZ>] (written response of Andrei Iancu) (suggesting that changing the claim construction standard may be one way to improve inter partes review), *with* 83 Fed. Reg. 51340 (Oct. 11, 2018) (changing the claim construction standard).

296. Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 21221, 21221 (May 9, 2018) (to be codified at 37 C.F.R. pt. 42).

297. See Stack, *supra* note 41, at 1005.

These time- and flexibility-related advantages do not account for the other advantages, such as in human resources, that agencies have vis-à-vis OSG: The Solicitor General's Office has only a relatively "small staff" of lawyers.²⁹⁸ And the nature of Supreme Court litigation means that OSG faces other limits, too. For example, OSG must explain its views in less than 9,000 words.²⁹⁹ By contrast, the Patent Office used more than 21,000 words to explain and defend its recently promulgated rule switching the substantive claim construction standard in inter partes review.³⁰⁰

Agencies enjoy deference in part because they must adhere to formal processes that invite public participation, and because they do, in fact, have substantial and lengthy interactions with the interested public. OSG, by contrast, need not submit to such procedural requirements. And, once called upon by the Supreme Court, OSG seems to feel obligated to offer its opinion in relatively short order. It is practically impossible to pinpoint any one case where these limits on OSG's decisionmaking process has altered the outcome. But that reflects part of the problem: The Solicitor General's litigation-based interventions lack the transparency that is a hallmark of much agency policymaking, making it difficult to discern *how* OSG has reached a decision, or *why* the Solicitor General advocates for one outcome over another.

This is problematic in cases, such as *KSR* and *Cuozzo*, where the Solicitor General's view in litigation differs from the Patent Office's administrative practice. Cases such as *Chenery* and *Bowen*, for example, explain that "the object of [the Judiciary's] deference is the result of agency decision-making, and not some *post hoc* rationale developed as part of a litigation strategy."³⁰¹ That is, "deference . . . is implicitly conditioned on the agency's having worked through the problem, with reason-giving as the overt expression of its exercise of discretion and expertise."³⁰²

Moreover, the Court's implicit deference to the views advanced in OSG's briefs gives the Patent Office an end-run around this requirement of regularity. In *Cuozzo*, for example, the agency's regulation rested on its view that the America Invents Act required the agency to employ the broadest reasonable interpretation standard. There, it did not have to justify that standard as the better policy choice—only as the superior

298. Millett, *supra* note 272, at 211.

299. SUP. CT. R. 33(g)(xi) (2019).

300. See 83 Fed. Reg. 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

301. *Kan. City v. Dep't of Hous. & Urban Dev.*, 923 F.2d 188, 192 (D.C. Cir. 1991); see Stack, *supra* note 41, at 1005–06.

302. Stack, *supra* note 41, at 1005.

interpretative result.³⁰³ But OSG’s brief defended the rule as a reasonable policy choice—and, in doing so, did not have to respond to commenters that might argue that *Phillips* is the better policy choice given agency discretion.

So too in *KSR*: In *KSR*, the agency continued to apply the TSM test in patent examination, even as it urged OSG to favor a different obviousness standard, on the grounds that such a standard would save the agency needless time and expense.³⁰⁴ The Executive Branch never had to receive—let alone respond to—policy objections to *KSR*’s more flexible obviousness standard (that, say, the tradeoff in agency time for accuracy is well worth it), and the Court deferred to the Executive Branch’s litigating positions, even though those arguments did not have to face the tests imposed by, say, the Administrative Procedure Act. The Patent Office, of course, need not engage in notice-and-comment rulemaking for every agency action (including, for example, interpretative rules).³⁰⁵ But to the extent that the nature of a court’s deference to an agency is informed by the nature of the agency’s process, *KSR* falls short.³⁰⁶ Instead, such concerns were raised only at the Court and between *amici*. But, as I describe in the following section, this shift in forum has other effects for other theories of deference.

In all, the Court’s decisions to defer to the Solicitor General’s views fail to accord with this theory of deference—that deference is due where it is the product of an agency’s reasoned deliberation. This is due not only to OSG’s comparative procedural disadvantages, but also especially to the range of intra-Executive conflict that sometimes presents in these patent cases.

4. *Political Accountability*

Courts may also defer to the Executive Branch’s policy determinations because agency officials may, unlike Article III judges, be held to account for the consequences of their decisions. *Chevron* itself

303. See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,679, 48,698 (Aug. 14, 2012) (to be codified at 37 C.F.R. pt. 42). There, the Patent Office responded to comments favoring the *Phillips* standard by highlighting its view that the “broadest reasonable interpretation” standard is required by the “statutory language,” “legislative history,” and “judicial precedent.” *Id.*

304. See *supra* notes 120–124 and accompanying text.

305. See 5 U.S.C. § 553(b)(A) (2018); *Perez v. Mortg. Bankers Ass’n*, 575 U.S. 92, 95–97 (2015).

306. *Cf.* *United States v. Mead Corp.* 533 U.S. 218, 230 (2001) (such “relatively formal administrative procedure[s] tend[] to foster the fairness and deliberation that should underlie a pronouncement of such force”).

describes this basis for deference: “[I]t is entirely appropriate for [the Executive Branch] of the Government to make such policy choices—resolving the competing interests which Congress itself either inadvertently did not resolve, or intentionally left to be resolved by the agency charged with the administration of the statute in light of everyday realities.”³⁰⁷

This accountability rationale has two dimensions. The first is internal: Because the President can exercise oversight—at the extreme, by way of removal—agencies will faithfully carry out the President’s policy vision.³⁰⁸ The second, which depends on the first, is external: Because agencies must reflect the President’s policy vision, the national public can hold—through, say, presidential election—the Executive responsible for its agencies’ actions (and the policies they implement).³⁰⁹

But this accountability theory, when applied to OSG’s role in patent cases, suffers at least two defects. One, the Solicitor General’s Office is treated as relatively independent from the President, and thus may not reflect the President’s patent policy preferences. That is, there is—by design—less internal accountability between the President and the Solicitor General over OSG’s litigating positions. Moreover, because there is less internal accountability, external accountability—e.g., election—may be less effective. And two, even where OSG and the President agree, the Solicitor General must launder its preferences through the Supreme Court. This, however, deflects blame onto the Judiciary, and thereby complicates the voting public’s ability to hold a responsible party accountable.

First, the Solicitor General’s Office is relatively (if incompletely) independent of the President. In his seminal book on the Solicitor General, Lincoln Caplan explains that OSG “must be free to reach [its] own carefully reasoned conclusions about the proper answer to a question of law, without second-guessing or insistence that [its] legal advice regularly conform to the politics of the administration he represents.”³¹⁰ That is, the Solicitor General cannot be made a

307. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 865–66 (1984).

308. *See, e.g.*, Elena Kagan, *Presidential Administration*, 114 HARV. L. REV. 2245, 2376 (2001) (“If deference follows, as *Chevron* stated, from the political leadership and accountability that the President offers, then deference should attach not to the whole but only to some subset of agency action. The task for post-*Chevron* courts, on this view, would involve developing doctrine that recognizes, and thereby promotes, actual rather than assumed presidential control over administrative action.”); *see also* *Oil States Energy Servs. v. Greene’s Energy Grp.*, 584 U.S. ___, 138 S. Ct. 1365, 1380 (2018) (Gorsuch, J., dissenting).

309. *Chevron*, 467 U.S. at 865 (“While agencies are not directly accountable to the people, the Chief Executive is . . .”).

310. CAPLAN, *supra* note 2, at 18.

“mouthpiece for the President.”³¹¹ Indeed, the Justice Department’s Office of Legal Counsel has agreed that the Solicitor General should be “permitted to exercise independent and expert legal judgment essentially free from extensive involvement in policy matters.”³¹² And this view appears to in fact inform the Executive’s relationship with OSG: Jeffrey Wall, a Principal Deputy Solicitor General during the Trump Administration, has explained that consultation with the President is “very, very rare.”³¹³

Such independence may undermine the case for deference: “If the SG’s decisions cannot be traced in some meaningful way to the President,” then the Solicitor General’s vast influence over patent policy “seem[s] inconsistent with the notions of political accountability that run throughout administrative law.”³¹⁴ In short, even if patent policy were a presidential or national priority, it is not at all clear that the Executive could influence the SG’s litigating positions—nor is it clear that the voting public could influence patent policy. Indeed, the opaque nature of OSG’s processes, described above, both limits the public’s participation in OSG policymaking, and obscures from the voting public any links between the Executive’s policy preferences and the Solicitor General’s advocacy.

Second, though the Court appears, in many cases, to defer to the Solicitor General, it only occasionally expressly explains that it is deferring to the Executive Branch or otherwise cites the source of its policy reasoning. That is, though the Court’s opinions often mirror the Solicitor General’s briefs, the Court does not always formally invoke its deference doctrines.

This unusual mode of deference—de facto rather than de jure, as I’ve explained above—has problematic implications for the accountability theory. The Court’s opinions incorporating the Solicitor General’s views into its own precedent do not consistently credit the Executive Branch with such reasoning. And the Court’s relative silence as to the source of the policy concerns in cases such as *Microsoft* or *Myriad*, among others, means the public may attribute those rationales—perhaps incorrectly—to the Court, rather than the Executive. The public may thus hold the

311. *Id.*

312. OFFICE OF LEGAL COUNSEL, NO. 77-56, MEMORANDUM OPINION FOR THE ATTORNEY GENERAL: ROLE OF THE SOLICITOR GENERAL 232 (Leon Ulman ed., 1977).

313. Marie-Rose Sheinerman, *U.S. Deputy Solicitor General Discusses Upcoming Supreme Court*

Cases, PRINCETONIAN (Apr. 3, 2019), https://www.dailyprincetonian.com/article/2019/04/jefferywalltalk?utm_source=email&utm_medium=enl&utm_campaign=supremecourtbrief&utm_content=20190410&utm_term=nlj [https://perma.cc/9VTR-6CX8].

314. Lemos, *supra* note 19, at 218.

wrong Branch responsible, and so they do not hold the Executive accountable.

This is evident in the commentary on the Court's patent cases. There is no shortage of commentators decrying the Supreme Court's various interventions on questions of patent validity—eligibility and obviousness—as misguided at best.³¹⁵ But to the extent that the Court's opinions are vessels for the Solicitor General's arguments in cases like *KSR* or *Myriad*, such criticism may be better directed at executive officials rather than the Supreme Court.³¹⁶

5. Policy Flexibility

Finally, deference doctrines may reflect values related to flexibility and policy experimentation.³¹⁷ *Chevron*, for example, directs executive agencies to “consider varying interpretations and the wisdom of [their] polic[ies] on a continuing basis.”³¹⁸ And *Brand X* goes even further, holding that agencies may not only revisit their own understandings of statutes, but may also upend judicial constructions of ambiguous statutes. Together, these decisions reflect a view that agencies must be able to avoid statutory and regulatory “ossification” by “revising unwise . . . constructions of ambiguous statutes” in order to respond to changing circumstances.³¹⁹

315. See, e.g., Gene Quinn, *Did the Supreme Court Intentionally Destroy the U.S. Patent System?*, IPWATCHDOG (May 22, 2018), <https://www.ipwatchdog.com/2018/05/22/did-the-supreme-court-intentionally-destroy-the-u-s-patent-system/id=97514/> [https://perma.cc/6W7X-RR7Y].

316. For *KSR*, see, for example, Gene Quinn, *KSR—The 5th Anniversary: One Supremely Obvious Mess*, IPWATCHDOG (Apr. 29, 2012), <https://www.ipwatchdog.com/2012/04/29/ksr-the-5th-anniversary-one-supremely-obvious-mess/id=24456/> [https://perma.cc/7ZSM-UYCF] (arguing “the Supreme Court undid [Congress’s] policy decision” by adopting a new obviousness test, and suggesting that the “Court is openly hostile to patents”). For *Myriad*, see, for example, Noam Prywes, *The Supreme Court’s Sketchy Science*, SLATE (June 14, 2013), <https://slate.com/technology/2013/06/supreme-court-patent-case-science-the-justices-misunderstand-molecular-biology.html> [https://perma.cc/WT4D-H4MW] (criticizing the Court’s “haphazard understanding” of the biotechnology at issue in *Myriad*); Gene Quinn, *Why SCOTUS Myriad Ruling Overrules Chakrabarty*, IPWATCHDOG (July 14, 2013), <https://www.ipwatchdog.com/2013/07/14/why-scotus-myriad-ruling-overrules-chakrabarty/id=43249/> [https://perma.cc/3AAW-5KEW] (“*Myriad* is . . . a disaster.”).

317. See, e.g., Criddle, *supra* note 202, at 1279–83 (2008); Cass R. Sunstein, *Beyond Marbury: The Executive’s Power To Say What the Law Is*, 115 YALE L.J. 2580, 2587–88, 2595 (2006).

318. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837, 863–64 (1984).

319. *Nat’l Cable & Telecomms. Ass’n v. Brand X Internet Servs.*, 545 U.S. 967, 983 (2005) (quotation marks and citations omitted) (quoting *United States v. Mead Corp.*, 533 U.S. 218, 247 (Scalia, J., dissenting)); see also *Motor Vehicle Mfrs.’ Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 42 (1983).

But the Court’s unusual mode of deference to the Solicitor General undermines these values. As noted above, the Court’s deference is informal rather than formal. The Court thus enshrines its interpretations in precedent and thereby limits the Executive’s power to shape patent policy on an ongoing basis.

Cuozzo is the exception that helps illustrate the rule. In *Cuozzo*, the Court formally applied *Chevron*’s framework and deferred, at Step Two, to the Patent Office’s decision to apply the “broadest reasonable construction” standard in its own administrative proceedings.³²⁰ Because Court’s decision defers to the Patent Office’s rule filling a gap in the statute, that Office retained the power to assess “the wisdom of its policy on a continuing basis.”³²¹

After further review, the Patent Office decided to reverse course: As noted above, the Patent Office has since promulgated a new rule directing the Patent Trial and Appeal Board to apply the “ordinary meaning” standard.³²² The Patent Office’s decision explains that it is making this switch for policy reasons: After reflecting on “almost six years of historical data, user experiences, and stakeholder feedback,” the Patent Office concluded that applying the ordinary meaning standard would, in its view, yield “greater uniformity and predictability” and thereby “improv[e] the integrity of the patent system.”³²³ And the Patent Office further notes that the Supreme Court—by formally invoking deference in *Cuozzo*—expressly granted the Patent Office the flexibility to shift course in view of these six years of data.³²⁴

The Patent Office, however, has (so far) been largely unable to execute similar policy shifts in other areas of patent law. Consider patent eligibility. As noted above, the Court’s decision on patent eligibility in *Myriad* reflects, in significant part, the Solicitor General’s argument. *Alice*, a case about the patent eligibility of abstract ideas implemented

320. *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2144–46 (2016).

321. *Chevron*, 467 U.S. at 863–64.

322. Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 81 Fed. Reg. 51340, 51341 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

323. *Id.* at 51341–42.

324. *Id.* at 51341 (“The Supreme Court of the United States has endorsed the Office’s ability to choose an approach to claim construction for AIA proceedings. ‘That is a question that Congress left to the particular expertise of the Patent Office.’” (citation omitted) (quoting *Cuozzo*, 136 S. Ct. at 2144–46)); see also *id.* at 51346–47 (“[T]he six years of experience with AIA proceedings, the many additional parallel court cases, as well as the numerous requests from stakeholders . . . make clear that using the same claim construction standard as in federal courts and the ITC better serves the public.”). *But see supra* notes 259–260 and accompanying text (explaining how the Court may have conferred this policy flexibility on the Patent Office in a manner that is inconsistent with an expertise-focused theory of deference).

via a computer, is similar.³²⁵ There, the Solicitor General, drawing on Patent Office guidance (among other sources), advocates for a rule that distinguishes patent-eligible “innovation[s] in computing” from general, “abstract methods”—like using escrow to settle transactions—that “incorporat[e] a computer . . . in a conventional role.”³²⁶ Citing the Solicitor General’s brief, *Alice* explains that the patent under review is invalid: The claimed technology did not “improve the functioning of the computer itself,” but rather, was directed at an abstract idea and relied on a computer only to perform mere “conventional” tasks.³²⁷ In short, the Supreme Court’s opinions in both *Myriad* and *Alice* reflect the Solicitor General’s guidance on patentability.

However, the Patent Office has since attempted—unsuccessfully—to vary these standards for patentability. In various documents, the Patent Office has revised its own interpretations of *Alice*, *Myriad*, and *Mayo* (the third case in the Court’s recent trilogy on patent eligibility). Most recently, for example, the Patent Office has explained that applications claiming an abstract idea that has been “integrated into a practical application” may be patent-eligible.³²⁸ Moreover, when determining whether a claim is so integrated into a practical application, the patent examiner must “exclude consideration of whether the additional elements represent well-understood, routine, conventional activity.”³²⁹ But that guidance contradicts the Supreme Court’s directives in *Alice*, which explain that “well-understood, routine, [or] conventional” additions (such as relying on a computer, as a conventional tool, to implement an abstract idea) are insufficient to render an abstract idea patentable.³³⁰

These apparent attempts at shifting the eligibility analysis have not gone well for the Patent Office. To be sure, the Patent Office’s 2019 Guidance has yet to receive substantial judicial scrutiny. But even more modest increments in the Patent Office’s examination guidelines have earned substantial skepticism. For example, the Federal Circuit, considering a 2016 guidance document, explained that though it

325. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014).

326. Brief for the United States as Amicus Curiae in Support of Respondents at 25–30, *Alice Corp.*, 573 U.S. 208 (No. 13-298), 2014 WL 828034 [hereinafter *Alice Amicus Brief*].

327. *Alice Corp.*, 573 U.S. at 225–26 (citing *Alice Amicus Brief*, *supra* note 326, at 28–30).

328. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 55 (Jan. 7, 2019) (emphasis added).

329. *Id.*

330. *Alice Corp.*, 573 U.S. at 225 (citation omitted); see also Pamela Samuelson (@PamelaSamuelson), TWITTER, (Sept. 26, 2018, 9:18 AM), <https://twitter.com/PamelaSamuelson/status/1044984627474182144> [<https://perma.cc/8XSP-ESDK>] (suggesting that the Patent Office’s new guidance attempts to “[o]verrule the Supreme Court”).

“respect[s] the [Patent Office’s] expertise,” it was “not bound by its guidance,” “especially regarding the issue of patent eligibility.”³³¹ And the Federal Circuit’s rationale is exactly the one that *Chevron* and *Brand X* reject: Where *Brand X*, for example, stresses the Executive’s need for flexibility in the face of changing circumstances, the Federal Circuit’s decision on patentability is especially “mindful of the need for consisten[cy].”³³²

In short, in the rare case where the Court has formally deferred to the Patent Office’s regulations, that Office has retained the policy flexibility that inheres in the doctrinal bases of such deference. But the Court more typically incorporates the reasoning presented in the Solicitor General’s briefs into precedent. And this mode of deference has hampered the Patent Office’s ability to later change course.³³³ Hence, the Court’s unusual, de facto mode of deference to the arguments of the Solicitor General constrains the Executive Branch’s ability to “adapt [patent] rules and policies” to “changing circumstances.”³³⁴ Instead, the Executive’s only recourse is to ask the Court to overturn Federal Circuit decisions or revise existing precedent under doctrines of *stare decisis*. But overturning patent precedents may be exceptionally hard to do.³³⁵

* * *

As I described above, the Court appears to implicitly defer to the Solicitor General’s merits determinations in many patent cases. But is this influence appropriate? To the extent that deference is founded on delegation, expertise, process, accountability, or flexibility, the answer seems to be no. OSG is not Congress’s patent policy delegate—and this matters when the Patent Office and the Solicitor General disagree. OSG has only limited patent- or Patent Act-related expertise. And even when the Patent Office and the Solicitor General confer and agree, the Solicitor General’s interventions allow the Patent Office to avoid the administrative procedures that would otherwise attend to rulemaking and

331. *Cleveland Clinic Found. v. True Health Diagnostics*, 760 F. App’x 1013, 1020 (Fed. Cir. 2019).

332. *Id.*

333. *Id.*; see also Criddle, *supra* note 202, at 1279–81.

334. *Motor Vehicle Mfrs.’ Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 42 (1983).

335. See *Kimble v. Marvel Entm’t, LLC*, 576 U.S. ___, 135 S. Ct. 2401, 2410 (2015) (some patent doctrines may enjoy a “superpowered form of *stare decisis*,” requiring “superspecial justification[s]” for overturning precedent); see also *Allen v. Cooper*, 589 U.S. ___, 140 S. Ct. 994, 1003 (2020) (similar). But cf. *Franchise Tax Bd. of Cal. v. Hyatt*, 587 U.S. ___, 139 S. Ct. 1485, 1499 (2019) (“But *stare decisis* is ‘not an inexorable command.’” (quoting *Pearson v. Callahan*, 555 U.S. 223, 233 (2009) (quotation omitted))). Notably, OSG’s brief in *Kimble* argued in favor of *stare decisis*, explaining that there was no policy basis for overturning the precedent, *Brulotte*, at issue in the case. See *Kimble*, 576 U.S. at 2414 (“[T]he United States, which acts as both a licensor and a licensee of patented inventions while also implementing patent policy, vigorously disputes that *Brulotte* has caused any ‘significant real-world economic harm.’” (quoting Brief for United States as Amicus Curiae Supporting Respondent at 30, *Kimble*, 576 U.S. 2401 (No. 13-720))).

rule changing, thereby limiting both the public's influence over policy and its access to relevant policymakers. Moreover, the informal mode of this deference both deflects blame on to the Judiciary and constrains the Patent Office's policy flexibility. To be sure, some cases present mixed results: *Cuozzo*, for example, scores well on flexibility but poorly on expertise. But on the whole, there is little, in terms of deference's most favored rationales, to justify the Court's apparent regime of implicit deference.

B. Defective Deference Beyond Patent

The problems that attend to the Solicitor General's interventions in patent law may not be limited to that context. Wherever the Court applies its regime of de facto, implicit, or "consultative" deference to views developed by the Solicitor General (rather than any competent agency with principal policymaking responsibility), it is likely that the Solicitor General's Office will suffer deficits in terms of delegation, expertise, process, and accountability. Stated simply, this is a problem of a general form: It may extend to other intellectual property domains, to other complex areas of law that lack substantive administrative oversight, and even (in some limited circumstances) to legal fields that include agencies with rulemaking power.

Copyright offers one example. The Court's most recent copyright decisions may seem to exhibit a similar pattern: The Copyright Office (like the Patent Office) exercises only limited substantive policymaking authority in only limited domains,³³⁶ and yet the Solicitor General's views carried the day in both OT2018 copyright cases—*Rimini Street v. Oracle USA*³³⁷ and *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*.³³⁸ To the extent the Court implicitly defers in these contexts, too, such deference seems unwarranted. The decision in *Fourth Estate*, for example, turned on the definition of "registration" for copyrighted works, and the Court's interpretation closely matched OSG's.³³⁹ And though OSG's interpretation of the term "registration" draws from the Compendium of U.S. Copyright Office Practices, the

336. See, e.g., 17 U.S.C. § 1201(a)(1)(C) (2018).

337. 586 U.S. ___, 139 S. Ct. 873, 876 (2019).

338. *Id.* at 888–89.

339. Compare *Fourth Estate Pub. Benefit Corp.*, 139 S. Ct. at 888–89 ("Read together, § 411(a)'s opening sentences focus not on the claimant's act of applying for registration, but on action by the Copyright Office."), with Brief for United States as Amicus Curiae Supporting Respondent at 13, 15–19, *Fourth Estate Pub. Benefit Corp.*, 139 S. Ct. 881 (No. 17-571) [hereinafter *Fourth Estate Amicus Brief*] ("The term 'registration' in Section 411(a) is most naturally read to refer to the Copyright Office's official recording of an accepted copyright claim."). The extent of the overlap between the decision and the briefs is even greater than I've highlighted here.

Copyright Office’s interpretation did not have to survive the “gauntlets of . . . notice and comment” rulemaking, and so neither the Copyright Office nor OSG had to reply every “material[ly]” “cogent” objection raised to its rule, as agencies are typically required to do.³⁴⁰

This pattern also extends beyond intellectual property domains and into other fields of law, such as bankruptcy. Lauren Baer and William Eskridge describe the Court’s “consultative deference” to the Solicitor General in bankruptcy cases in some detail:

In bankruptcy cases, there is no agency to which the Court can defer; there is no Bankruptcy Commission. Yet the Court often requests amicus briefs from the Solicitor General in bankruptcy cases. The attorneys who work on bankruptcy cases for the Solicitor General come to know their subject matter more deeply than the Justices could be expected to, consulting bankruptcy experts and drawing on the resources of the office of the United States Trustee, located in the Department of Justice. The analysis in these briefs often influences the Court’s judgment in ways that resemble *Skidmore* deference.³⁴¹

Yet in bankruptcy cases, as in patent cases, the Court’s deferential practice lacks foundation. The absence of any executive bankruptcy agency might suggest that Congress has declined to delegate policymaking power in bankruptcy cases to the Executive Branch. But OSG’s “textual and policy analyses” nevertheless wield wide influence in bankruptcy cases.³⁴² And though OSG’s attorneys may come to understand bankruptcy law “more deeply than the Justices,” the Solicitor General’s Office is not itself actively involved in the development and enactment of bankruptcy law or policy.³⁴³ Rather, OSG’s expertise is borrowed from other experts and the office of the United States Trustee.³⁴⁴ This, again, is problematic from process and public participation perspectives. Indeed, the Solicitor General’s practice of consulting with the U.S. Trustee may bias OSG’s presentations to the

340. *United States v. Havis*, 927 F.3d 382, 386 (6th Cir. 2019); *United States v. Nova Scotia Food Prods. Corp.*, 568 F.2d 240, 252 (2d Cir. 1977). *Compare, e.g.*, Brief for the Nat’l Music Publishers’ Ass’n et al. as Amici Curiae in Support of Petitioner at 2, *Fourth Estate Pub. Benefit Corp.*, 139 S. Ct. 881 (No. 17-571), 2018 WL 4252035 (explaining that administrative delays at the Copyright Office can “consume most or all of the Copyright Act’s three-year limitations period, thereby eliminating altogether a copyright owner’s ability to bring an infringement action”), with *Fourth Estate* Amicus Brief, *supra* note 337, at 3–4 (“The average time for the [Copyright] Office to resolve a registration application is approximately eight months.”).

341. Baer & Eskridge, *supra* note 12, at 1113.

342. *Id.*

343. *Id.*

344. *Id.*

Court: The United States is “often a creditor in bankruptcy” and has accordingly advanced “pro-creditor rule[s].”³⁴⁵ Because OSG’s meetings are generally private, there are only limited opportunities for the public to counter the influence exercised by the United States Trustee and the SG’s other favored experts. And because OSG’s decisionmaking process is closed, the public can have only a limited understanding of the reasoning behind the SG’s favored rule.

Finally, the influence of the Solicitor General may be worrisome in any case where the Court defers to OSG after that Office has decided to override a primary agency’s policy determination. This is especially so where the primary agency’s determination has been made in accord with the powers conferred on the agency by Congress, where that decision has been informed by the agency’s expertise, and where the agency’s rule is the product of a public rulemaking process. Indeed, Maggie Lemos has detailed instances of such conflict between the Solicitor General and other agencies, including, especially, the Equal Employment Opportunity Commission. And her work details how, along many of these same metrics, OSG falls short to its agency adversary: She explains that, in such instances of agency conflict, the Court should play closer attention to Congress’s intended delegate, to loci of expertise, to the procedural protections attending to the agency’s rulemaking process (as compared to OSG’s brief-drafting process), among others.³⁴⁶ In short, these cases of interagency conflict present one further general category of defective deference to the Solicitor General.

III. DEFERENCE AND DECISIONAL AUTHORITY

The Court seems to informally defer to the views of the Solicitor General in a range of patent cases. But, as I describe above, the Court’s treatment of the Solicitor General’s Office finds little footing in deference’s usual justifications. This gap thus gives rise to a further

345. *Id.* at 1114 n.115 (2008) (describing *Associates Commercial Corp. v. Rash*, 520 U.S. 953, 966–67 (1997) as an illustrative example). To be sure, this is consonant with the Solicitor General’s duty to represent the interests of the United States *as a creditor*. But the United States’s interest as creditor may not align with the public’s interest in an equitable or welfare-enhancing rule of bankruptcy. *See, e.g., Rash*, 520 U.S. at 966–67 (Stevens, J., dissenting) (explaining that the Court’s rule “grants a general windfall to undersecured creditors at the expense of unsecured creditors”).

346. To be sure, Maggie Lemos explains that her project is “not about deference” because the Supreme Court has not “purported to defer to the views of the SG in the same way it does those of agencies.” Lemos, *supra* note 19, at 206 n.68. But the patent cases described above, together with the studies described in work by Lauren Baer and William Eskridge, John Duffy, and others, seems to suggest that the SG’s influence does seem to operate like this deference, at least in patent contexts. Indeed, Lauren Baer and William Eskridge suggest that the Court formalize its regime of consultative deference and fold it into its existing practices. Baer & Eskridge, *supra* note 12, at 1184.

question: If OSG is not properly the object of the Court's deference, who, then, should decide the patent questions that present in cases like *KSR*, *Merck*, and *Cuozzo*? That is, who should exercise primary responsibility over such matters of patent policy? I consider here three possibilities: the Supreme Court, a reformed Solicitor General's Office, and the Patent Office. The Patent Office is the winner.

A. *The Supreme Court*

One possible response to the problem of defective deference is to end the Court's practice of deferring to the Executive Branch, and thereby return to the "standard account," described above, of patent policymaking: The Judiciary (with the Supreme Court at its apex) decides questions of patent law and patent policy.³⁴⁷ If, after all, the Court's practice is flawed, then it should stop deferring to Executive Branch and—as in some other areas of law—take up the decisional reins itself.

That is plausible. But before declaring that the Court must itself decide matters of patent policy, it is worth considering why the Court has decided to defer to the Solicitor General, even absent a formal doctrine directing such deference. To the extent the Court's decisions in these patent cases is explained by an implicit deference regime, what motivates the Court's decision to defer at all?

There may be two related explanations. First, the Court often relies on outside help in technical cases—say, patent or bankruptcy cases—because of the Court's own comparative inexpertise.³⁴⁸ The complex, technical details of these cases can sometimes confound the Court or cause the Justices to hesitate before setting out substantive, prescriptive rules.³⁴⁹ Second, the Court relies on OSG in particular because of its long-term institutional commitment to the interests of the public and the federal Government.³⁵⁰ The Solicitor General's Office has an earned

347. See *supra* text accompanying note 60.

348. See, e.g., Golden, *supra* note 25, at 694; Rebecca Haw, *Amicus Briefs and the Sherman Act*, 89 TEX. L. REV. 1247, 1263 (2011).

349. See, e.g., Thompson & Wachtell, *supra* note 11, at 281; see also Narechania, *supra* note 37, at 1356 (explaining that the Court seemed to demur on a technical and difficult question of patent law that it did not anticipate having to address).

350. See, e.g., BLACK & OWENS, EXECUTIVE BRANCH INFLUENCES, *supra* note 20, at 91; see also *id.* (finding that OSG's relative success cannot be explained by the experience of its attorneys, the quality of its attorneys, its resource advantages, or its selectivity in case selection); Black & Owens, *A Built-In Advantage*, *supra* note 20, at 457–61 (similar). Instead, these studies suggest it is the Office's professional, "credible commitment to broader goals of justice and efficiency" that influences the Court. BLACK & OWENS, EXECUTIVE BRANCH INFLUENCES, *supra* note 20, at 91; see also Vladeck, *supra* note 20, at 123–24 (quoting Simon E. Sobeloff, *Attorney for the Government: The Work of the Solicitor General's Office*, 41 A.B.A. J. 229, 229 (1955)).

reputation as the reliable, trustworthy voice of the Executive.³⁵¹ Together, these two explanations suggest that the Supreme Court needs some help in patent cases, and it trusts the Solicitor General to provide it.

These explanations, to the extent they adequately explain the Court's practice, undermine the case for the Supreme Court: The Court's relative inexpertise (or, at a minimum, its self-perception as inexpert) suggests that—absent some more fundamental change to the Supreme Court—deference to outside actors is likely.³⁵² That is, no matter whether patent rules are informally constructed by OSG during litigation, or crafted elsewhere in the Executive Branch, defended by the SG, and formally reviewed under *Chevron* or *Skidmore*, some form of a deference regime is likely to prevail. The Court often wants outside help on substantive matters of patent law. So, taking such deference as given, to whom should the Court defer?

B. *The Solicitor General's Office*

Given the Court's apparent preference for deference, I turn away from the Court and to the Executive Branch. When the Court calls on the Executive Branch for advice, who should answer?

One possibility is for the Solicitor General's Office to continue to control and coordinate the Executive Branch's patent policy responses—but to reform OSG in ways that are responsive to the concerns set out above.³⁵³

351. *E.g.*, BLACK & OWENS, EXECUTIVE BRANCH INFLUENCES, *supra* note 20, at 112; Kristen A. Norman-Major, *The Solicitor General: Executive Policy Agendas and the Court*, 57 ALB. L. REV. 1081, 1090 (1994).

352. One might imagine any number of fundamental changes to the Court, many of which would be responsive to this expertise concern. For example, some commentators have suggested replacing the current Court's composition with one drawn from the Courts of Appeals (including the Federal Circuit). Daniel Epps & Ganesh Sitaraman, *How to Save the Supreme Court*, 129 YALE L.J. 148, 181–85 (2019). This structure might help to mitigate some of the concerns regarding patent expertise. (Other possibilities—that cut in quite different directions—might include requiring the Justices to hire law clerks from all the Courts of Appeals (including the Federal Circuit, thereby helping to build relevant expertise at the Supreme Court), or stripping the Supreme Court of jurisdiction over patent cases altogether (giving the Federal Circuit the last word in such cases, thereby making the Court's comparative inexpertise irrelevant)). But because the effects of such drastic changes—changes to the Court's composition, the Court's jurisdiction, and the Court's hiring and personnel practices—are so far-reaching, I put such possibilities to one side for the purposes of this project. *Cf. id.* at 151 (explaining that their proposal is intended to help “preserv[e] the Court's legitimacy as an institution above politics” and not to address questions of expertise or subject-area competency at the Court).

353. *Cf.* Cornelia T.L. Pillard, *The Unfulfilled Promise of the Constitution in Executive Hands*, 103 MICH. L. REV. 676, 683 (2005) (“Reforms should focus, for example, on supplying the executive's constitutional approach with firmer empirical footing, greater institutional and popular insight, and more vigilant scrutiny of constitutional risk areas.”).

One objection, for example, to OSG’s process of policymaking-by-litigation regards the public’s ability to participate in that Office’s decisionmaking process. As I described above, OSG’s litigation-based interventions depart from the processes that usually attend to agency rulemaking, and these departures limit the public’s ability to meaningfully inform the Executive Branch’s policies in certain classes of cases, including patent and bankruptcy matters.³⁵⁴ These procedural differences, however, are partially due to the differences in forum: Litigation moves on the Court’s timetable, whereas agencies control their own calendar. And, as a result, OSG’s ability and willingness to set out a proposed position, receive public comment, and respond substantively to those comments before advocating for a given rule—say, an interpretation of the term “reasonable” or “component”—is often sharply limited.

But not always. The Solicitor General’s Office must, to be sure, file its merits briefs in accord with the Supreme Court’s rules.³⁵⁵ And I assume (for present purposes) that the Court is unlikely to accommodate many special privileges for cases involving the Solicitor General.³⁵⁶ But OSG has far more flexibility when it responds to the Court’s calls for *amicus* help: When the Court invites OSG to file a certiorari-stage brief (known as a call for the views of the Solicitor General, or CVSG), the SG treats the invitation as a command. And though OSG tends to hold itself to a few informal and self-imposed deadlines, it retains significant flexibility over the schedule for filing a response.³⁵⁷ OSG’s self-imposed deadline is neither mandatory nor rigid.³⁵⁸

For example, on January 7, 2019, the Court asked the Solicitor General for the Government’s views in two patent cases—*Texas*

354. Two contrasting anecdotes help illustrate. During one workshop discussion of this article, a workshop participant—a patent law professor—expressed some serious frustration at OSG’s lack of transparency in two pending patent cases: “It’s killing me that I don’t know what the SG is working on or going to say” in these two (redacted) cases. The following week, another professor mentioned a set of interactions with OSG regarding a different intellectual-property-related case. That stark contrast regarding notice, opportunity, and information—within a single population (the academy)—is suggestive of the transparency and process deficits that affect OSG’s policy-crafting and brief-drafting processes.

355. *E.g.*, SUP. CT. R. 33(g)(xi) (2019).

356. *But cf.* SUP. CT. R. 34(4) (explaining that the Solicitor General need not seek leave to file an *amicus* brief).

357. *See* McElroy, *supra* note 293 (“First, although the Court merely ‘invites’ the SG to file a brief, the SG treats it as a command. And . . . there are no deadlines for the SG to file” but OSG “has filed most invitation briefs at three times of the year: late May, so that the cases can be considered before the summer recess; around August, so that the cases can go on the summer list; and December, so that the cases can be considered in time to be argued that Term if the Court grants cert.”).

358. *See id.*

Advanced Optoelectronic Solutions, Inc. v. Renesas Electronics America, Inc. and *HP v. Berkheimer*.³⁵⁹ OSG filed its brief in *Renesas* a few months later, on May 21, recommending that the Court decline to review the case. But even by the end of the 2018 Term, OSG had not responded to the Court's request in *Berkheimer*—informally extending its own self-imposed, triannual deadline for responding to the Court's calls to almost one year. This example highlights both of the features of the SG's process described above. First, it reinforces the view that the SG's process is opaque. What was the cause of the (comparative) delay in *Berkheimer*? Why did this case take longer than others? Was the delay suggestive of some intra-Executive conflict? As in other examples of the SG's decisionmaking process, we simply do not know. Second, the difference between *Berkheimer* and *Renesas* suggests that there is at least some flexibility in OSG's internal processes.

Such flexibility may allow OSG to craft a more accessible and accountable decisionmaking process. To the extent OSG's closed process is designed (at least partially) around litigation's time constraints, OSG's control over its calendar in CVSG contexts enables it—either on its own accord, or on command from the President or Congress—to receive and respond to public comment from private actors and interested agencies before responding to the Court's calls for *amicus* help. That is, where the Court has asked the SG to weigh in, OSG can run a decisionmaking process that more closely mimics regular administrative process, such as is set out in the Administrative Procedure Act.³⁶⁰ Such a process would have the virtues—consonant with deference's theoretical foundations—of greater democratic accountability and deliberative process.

But such process reforms—which themselves require significant changes to the operating norms of the Solicitor General's Office—fail to address the several other objections to the Court's deference to the Solicitor General. Even if, for example, OSG's process was more transparent and procedurally rigorous, OSG's influence might conflict with Congress's apparent delegation to the Patent Office of such

359. Compare Brief for the United States as Amicus Curiae, *Tex. Advanced Optoelectronic Solutions, Inc. v. Renesas Elecs. Am., Inc.*, __ U.S. __, 139 S. Ct. 2741 (2019) (mem.) (denying certiorari) (No. 18-600), with Brief for the United States as Amicus Curiae, *HP v. Berkheimer*, __ U.S. __, 140 S. Ct. 911 (2020) (mem.) (denying certiorari) (No. 18-415).

360. Cf. Joshua Kastenbergh, *Safeguarding Judicial Integrity By Making the Executive Branch's Unfettered Amicus Gateway Transparent*, 38 N. ILL. U. L. REV. 1, 25 (2017) (suggesting that the Judiciary impose added transparency requirements on briefs filed by OSG to facilitate closer review of Executive Branch positions).

policymaking power.³⁶¹ Similarly, OSG—like the Court itself—is comparatively inexperienced in patent policy. And OSG must act, if at all, through the Court—thereby deflecting responsibility on to another branch and limiting policy flexibility for future administrations.

It is, to be sure, possible to imagine further reforms to OSG that respond to some of these concerns. If Congress were, for example, to authorize funding for a patent seat in the Solicitor General’s Office in view of the Court’s increased patent docket, that authorization would both reflect at least some congressional intent to confer (a particular sort of) decisionmaking power on OSG and improve that Office’s patent expertise. But even these more dramatic changes would not address the accountability and flexibility concerns that attend to this mode of policymaking-by-litigation. Such changes, moreover, may have the effect of undermining the very qualities that make the Solicitor General’s Office a trusted advisor to the Court. As noted above, OSG’s “broad[] view of litigation”—unencumbered by the “tunnel vision” that may characterize a single agency’s defense of its policy aims—gives it a distinct litigation advantage: The Solicitor General is able to translate the agency’s technical work more clearly.³⁶² But, as more field-specific depth and expertise is built into particular personnel in OSG, that Office risks its ability to present cases to the Court in such familiar terms. It is also possible to imagine reforms to OSG that bring that Office closer to the President, and thus more accountable for its policy aims. But OSG’s political independence is one important font of the Supreme Court’s trust in that Executive Branch institution.³⁶³ Such reforms would thus undermine OSG’s ability to “to exercise independent and expert legal judgment” and reach its “own carefully reasoned conclusions.”³⁶⁴ Without these features, OSG’s briefs might be seen primarily as political statements, and may thus be no more helpful to the Court than those filed by only one party’s members in Congress.³⁶⁵

361. See, e.g., 35 U.S.C. §§ 2(b)(2)(A), 316(a)(4) (2018); see also *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2143 (2016); *Neer*, *supra* note 17, at 422 & n.69; *Tran*, *supra* note 24, at 614 n.29.

362. *Lemos*, *supra* note 20, at 209, 211.

363. See, e.g., OFFICE OF LEGAL COUNSEL, *supra* note 312, at 288; SALOKAR, *supra* note 2, at 94; see also CAPLAN, *supra* note 2, at 254–56.

364. OFFICE OF LEGAL COUNSEL, *supra* note 312, at 232; CAPLAN, *supra* note 2, at 18.

365. See Pillard, *supra* note 353, at 684–85 (explaining that such reforms to OSG raise “[c]oncerns about adding to the institutional mechanisms of an already complex government machinery, [and] risks of interest-group capture of such mechanisms,” among others); see also Neal Devins, *Measuring Party Polarization in Congress: Lessons from Congressional Participation in Amicus Curiae*, 65 CASE W. RES. L. REV. 933, 955 (2015) (“[T]he Supreme Court should treat lawmaker briefs with skepticism. They are largely partisan statements intended to win favor with constituents.”).

Hence, correcting for the defects (in deference's terms) in OSG's institutional structure and internal processes problems might have the effect of undermining some of the important strengths that help make the Solicitor General's Office a trusted advisor to the Supreme Court. This sets out a minor paradox: Strengthening the SG's theoretical claim to deference undermines some of the features that, in fact, lead the Court to defer to the SG's judgment.

This paradox is resolved in other areas of the administrative state by separating the two functions that have collapsed into one in these patent cases: policymaking and policy defense.³⁶⁶ In most other fields of law governed by executive regulations, an administrative agency issues rules after expert consideration under regular process. OSG typically steps in only to help defend those rules (as it deems appropriate) from legal challenges, in view of its "independent and expert legal judgment."³⁶⁷ This model thus suggests a way forward for patent policy, too: OSG should continue to control policy defense—but the power to make policy should sit with an expert agency entrusted by Congress to set standards through regular administrative process.

C. *The Patent Office*

Given the Court's proclivity to defer to the Executive Branch in technical and complex cases, such as patent cases, the Patent Office—rather than any other executive agency (including the Solicitor General's Office)—should exercise principal responsibility over matters of patent policy. I share this conclusion with Arti Rai, Melissa Wasserman, and John Golden—all of whom agree that the Patent Office has earned at least some deference from the Judiciary. But, as I suggested above, my path to this conclusion is somewhat different: While Melissa Wasserman, for example, examines the America Invents Act to conclude that the statute descriptively appears to confer policymaking authority (via adjudication) on the Patent Office, I begin, instead, with the premise that the Court seems bound to defer to the Executive Branch, and I conclude that, among the available options, the Patent Office is the entity within that Branch best suited to exercise such policymaking

366. I explore other aspects of this paradox in the Conclusion. Namely, I consider what it means for deference more generally that deference in practice does not seem to align with deference in theory, and I argue that practice should better reflect these theoretical foundations.

367. OFFICE OF LEGAL COUNSEL, *supra* note 312, at 232; *see also* Brief for the United States as Amicus Curiae Supporting Petitioners at 13, *Epic Sys. Corp. v. Lewis*, 584 U.S. ___, 138 S. Ct. 1612 (2018) (Nos. 16–285, 16–300, 16–307) (explaining that in the SG's view, "[a]lthough the Board's interpretation of ambiguous NLRA language is ordinarily entitled to judicial deference, courts do not defer to the Board's conclusion as to the interplay between the NLRA and other federal statutes").

power.³⁶⁸ Along practically every dimension relevant to deference’s theoretical foundations, the Patent Office is best suited to exercise the policymaking authority that typically earns the Court’s respect.

I have already described how the Patent Office is, in many respects, Congress’s delegee on matters of intellectual property policy. The Patent Act, for example, directs the Patent Office to counsel the Executive Branch “on matters of intellectual property policy.”³⁶⁹ And Congress has also long given the Patent Office the power to “establish regulations” that “govern the conduct of proceedings in the Office,” including patent application review.³⁷⁰ Hence, to the extent that deference is grounded in congressional delegations of policymaking power, these provisions of the Patent Act are best read as evidence of Congress’s intent to give the Patent Office such decisional power, and the Patent Office should so construe its statutory authority.³⁷¹

Moreover, Melissa Wasserman has described how the America Invents Act—the most recent set of major patent law reforms—strengthens the Patent Office’s claim to the mantle of patent policy: In her view, Congress, by that Act, has “anoint[ed] the Patent Office as the chief expositor of substantive patent law,” authorizing it to set standards under its adjudicatory powers.³⁷² Even John Golden—who has argued, contra Melissa Wasserman, that the Patent Office is eligible for only *Skidmore*, rather than *Chevron*, deference—agrees that Congress has, by the America Invents Act, effectively conferred on the Patent Office some “variant of ‘primary jurisdiction’” over patent policy.³⁷³

Likewise, the Patent Office is, comparatively, the most expert executive agent. Though commentators (including myself) have long been skeptical of the Patent Office’s expertise over the matters of economics, technology, and innovation that must inform patent policy, both Arti Rai and Melissa Wasserman have lauded the Patent Office’s

368. Compare Wasserman, *supra* note 15, at 1977–2005, with *infra* notes 369–386 and accompanying text.

369. 35 U.S.C. § 2(b)(8)–(9) (2018).

370. *Id.* § 2(b)(2)(A)–(C); *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2144 (2016).

371. The Federal Circuit, of course, disagrees. See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996); see also *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1335 (Fed. Cir. 2008). The Supreme Court, however, should be understood to have taken a different view. See *Cuozzo*, 136 S. Ct. at 2143 (questioning *Cooper Techs.*); see also *id.* (construing a similarly worded statute as granting the Patent Office the authority to issue regulations concerning the substantive standard for claim construction in inter partes review). Compare 35 U.S.C. § 2(b)(2)(A) (2018) (“The Office may establish regulations . . . [that] shall govern the conduct of proceedings in the Office.”), with 35 U.S.C. § 316(a)(4) (“The Director shall prescribe regulations . . . governing inter partes review.”).

372. Wasserman, *supra* note 15, at 1965; see also Rai, *supra* note 7, at 1280.

373. Golden, *supra* note 45, at 1696.

strides toward developing such expertise, including by creating and staffing an internal Chief Economist's Office.³⁷⁴ And, again, even John Golden agrees that the Patent Office "is unlikely to be deemed to have 'no expertise' in substantive patent law."³⁷⁵ Moreover, as I described above, the Patent Office is deeply expert in various specific aspects of the America Invents Act: Congress enacted that Act only "after many years of negotiation between the United States Patent and Trademark Office . . . and various congressional committees. The [Patent Office] prepared an early version of the legislation, then proceeded to send at least six views, letters, and various reports to congressional committees in the following years."³⁷⁶ Nor are we necessarily limited to the Patent Office in its current form: The agency may expand its substantive expertise even further (and, indeed, might have motives to do so if it understood its statutory powers more broadly) by developing more expertise in innovation economics more generally, and by seeking congressional authorization to hire additional such staff, among other possibilities. In sum, the Patent Office has deep legislative expertise and growing technical expertise over core matters of patent policy—with the potential for even more.

Similarly, along dimensions of political accountability, Justice Gorsuch has explained that the Patent Office's Director "is a political appointee who serves at the pleasure of the President."³⁷⁷ And the Director can (and has) used his powers under the America Invents Act to secure policy judgments that he and, presumably, the President seek.³⁷⁸

374. Rai, *supra* note 7, at 1278; Wasserman, *supra* note 15, at 2012; *see also* Benjamin & Rai, *supra* note 38, at 316; Rai, *supra* note 7, at 1262; Wasserman, *supra* note 15, at 2008 ("[T]here is near-universal agreement that the institution charged with creating sound patent policy needs access both to economic and to technological data, as well as sufficient expertise to analyze and interpret this information.").

375. Golden, *supra* note 45, at 1692.

376. Shobe, *supra* note 32, at 302 n.72.

377. Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC, 584 U.S. ___, 138 S. Ct. 1365, 1380 (2018) (Gorsuch, J., dissenting).

378. *Id.*; *see also* Saurabh Vishnubhakat, *When Can the Patent Office Intervene in Its Own Cases?*, 73 N.Y.U. ANN. SURV. AM. L. 201, 225–27 (2018). Indeed, this growth in the Patent Office's institutional capacity for policymaking since the America Invents Act's passage may be more evident in view of the contrast between two cases—*Myriad* and *Alice*—described above. *See supra* notes 325–327 and accompanying text. I start from the (perhaps controversial, but certainly not unreasonable) position that the outcome of each decision is desirable. *See, e.g., Patentable Subject Matter Reform, Hearing Before the S. Judiciary Comm.*, 116th Cong. (June 4, 2019) (statement of Mark A. Lemley, Stanford Law School) (explaining that the Court's decisions have "allowed defendants to weed out weak patent claims more quickly and cheaply than before"). But the Patent Office was on opposite sides of the outcome across these two cases: it disagreed with *Myriad*; it agreed with *Alice*. In *Myriad*, the relevant Patent Office guidelines were promulgated well before the passage of the America Invents Act and the instantiation of the Patent Office's own Office of the Chief Economist. Indeed, as I noted above, Judge Bryson found the Patent Office's 2001 guidelines to be "perfunctory," failing "reflect [the] thorough consideration" that is the

I do not, however, mean to suggest that the Patent Office is a model agency. Indeed, along dimensions of, say, reasoned deliberation, the Patent Office's claims to deference sometimes falls short. For one, the Patent Office's primary mechanism of policymaking under the America Invents Act is adjudication. But it is rulemaking—not adjudication—that confers many of the most important benefits to an agency's policy-setting processes.³⁷⁹

Moreover, even when the Patent Office engages in policymaking through procedures that resemble rulemaking—by, say, issuing guidelines to its patent examiners on eligibility or obviousness—its present procedures seem imperfect. In respect to the Patent Office's revised guidelines on eligibility, for example, the agency announced its new guidelines on January 7, 2019, and made them immediately effective—while simultaneously opening a comment period.³⁸⁰ That is, the Patent Office activated its new policy before receiving and considering public comment on the new rules. To the extent the Patent Office wants these guidelines to have the “force and effect of law,” this is irregular.³⁸¹ The Executive Branch is not typically able to bypass standard notice-and-comment procedures (except in emergencies) for such legislative rules.³⁸² To be sure, the Patent Office may simply wish to issue “interpretative,” rather than binding “legislative,” rules.³⁸³ But it is difficult to imagine that the rules that patent examiners are required to apply in their review of patent applications do not effectively bind the public and the agency.³⁸⁴ Moreover, to the extent the Patent Office's

hallmark of judicial deference to agency decisionmaking. *Ass'n for Molecular Pathology v. U.S. Patent & Trademark Office*, 653 F.3d 1329, 1380 (Fed. Cir. 2011) (Bryson, J., concurring in part and dissenting in part). These perfunctory procedures, moreover, reflected the Patent Office's relative lack of decisional authority. Stated simply, in 2001, the Patent Office had neither the responsibility nor the capacity to set substantive policy. The Solicitor General's brief in *Alice*, by contrast, cites Patent Office guidelines that were issued after the Patent Office hired its Chief Economist and after Congress enacted the America Invents Act. The Court, in turn, cites those aspects of the SG's brief in its opinion setting out the bounds of patent eligibility for software. Hence, to the extent that *Myriad* and *Alice* reflect desirable policy outcomes, the Patent Office's progression toward the outcome in *Alice* may be suggestive of that agency's growing institutional capacity for sound policymaking.

379. Koch, *supra* note 264, at 486; Rai, *supra* note 7, at 1281 (“Rulemaking, not adjudication, is the innovation of the administrative state.”); *see also* John F. Manning, *Nonlegislative Rules*, 72 GEO. WASH. L. REV. 893, 903–05 (2004).

380. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019).

381. *Perez v. Mortg. Bankers Ass'n*, 575 U.S. 92, 95–97 (2015).

382. 5 U.S.C. § 553(b)(B) (2018) (notice and comment procedures are not required when “the agency for good cause finds . . . [such procedures to be] impracticable, unnecessary, or contrary”); *see, e.g.*, *Nat. Res. Def. Council v. NHTSA*, 894 F.3d 95, 114 (2d Cir. 2018) (“[T]he good cause exception . . . is generally confined to emergency situations.”).

383. *Perez*, 575 U.S. at 95–97.

384. Brendan Costello, Note, *Rulemaking §101*, 129 YALE L.J. __ (forthcoming 2020) (contending that the Patent Office's eligibility guidelines are legislative rules); *see also* Manning,

more powerful adjudicatory proceedings are to be informed “by an activity much like rulemaking”—“guideline formation through widespread consultation with relevant stakeholders”—the Patent Office should employ procedures, like standard notice-and-comment rulemaking, that more closely resemble so-called legislative rulemaking.³⁸⁵ Indeed, these procedural defects continue to offer courts, including the Federal Circuit, a ready excuse to dismiss the Patent Office’s guidelines.³⁸⁶ A turn toward more standard procedures would lend more legitimacy—and perhaps even formal deference—to the Patent Office’s determinations.

But even accounting for these defects in the Patent Office’s current procedures, that agency is, compared to OSG, better suited along several dimensions to exercise policy-setting authority. Stated simply, the Court is likely to defer, one way or another, to the Executive Branch on matters of patent policy—and, under those circumstances, it is the Patent Office, more than any other agency, that ought to exercise principal policymaking responsibility over such questions.

* * *

My claim that the Patent Office ought to exercise primary jurisdiction over questions of patent policy might seem, when viewed against the backdrop of the existing deference doctrines, unremarkable. But, as I describe above, the Supreme Court appears to defer (if implicitly) to the views advanced by the Solicitor General in patent cases—even in cases where the Solicitor General and the Patent Office disagree, in cases where the Solicitor General’s rationale varies from the Patent Office’s reasoning, and in cases where the Solicitor General acts as conduit for the Patent Office’s own untested and procedurally defective policy preferences. Such de facto deference to the Solicitor General is problematic along a variety of dimensions, including delegation,

supra note 354, at 894 (suggesting that the distinction between a legislative rule and an interpretative one turns on a “subtle judgment—that such a rule does not reflect excessive policymaking discretion, but rather reflects sufficient policy guidance from an antecedent statute or legislative regulation. So understood, the D.C. Circuit’s nonlegislative rule case law simply seeks to ensure that important policy judgments emerge from the more formal deliberative processes that produce legislation or legislative rules”). And by the Patent Office Director’s own admission, the rules at issue here almost certainly rise to the level of importance that should require notice-and-comment procedures. *See, e.g.*, Andrei Iancu, Dir., U.S. Patent & Trademark Office, Remarks Delivered at the Intellectual Property Owners Association 46th Annual Meeting (Sept. 24, 2018) (explaining that he is issuing new guidelines because the Patent Office “cannot wait” while Congress undertakes a “long” and “uncertain” legislative process to respond to cases like *Alice* and *Myriad*); *see also* *Enzo Biochem v. Gen-Probe*, 323 F.3d 956, 964 (Fed. Cir. 2002) (explaining that the Patent Office’s guidelines “gover[n] its internal practice”).

385. Rai, *supra* note 7, at 1280–81.

386. *See, e.g.*, *Cleveland Clinic Found. v. True Health Diagnostics*, 760 F. App’x 1013, 1020 (Fed. Cir. 2019).

expertise, and accountability, among others. In view of these defects, any number of institutions may take the lead on matters of patent policy. The Court, for example, might decide these questions without reference to the policy preferences of the Executive Branch. Or the Solicitor General's Office might implement reforms to legitimate its claim to such deference. But the obvious—and, in my view, the obviously correct—answer is to confer such policymaking power on the Patent Office. I do not make a strong claim here as to whether the Patent Office has earned deference under *Chevron* or merely under *Skidmore*. Rather, my claim is somewhat narrower: To the extent the Court defers to the Executive Branch *at all* in patent cases—implicitly or explicitly, *Skidmore* or *Chevron*—that deference is owed primarily to the Patent Office, and only in view of the considerations that have traditionally informed deference doctrines—delegation, deliberation, expertise, and accountability, among others.

And while I contend that the Patent Office should exercise principal responsibility over patent policy, I do not mean for these possibilities to be mutually exclusive. Indeed, all three institutions should respond to these defects in the relationship between the Executive Branch and the Judiciary. The Court, for example, should be more mindful of the source and the pedigree of the rules that OSG advances in its patent briefs. Is OSG's advocacy consistent with Patent Office practice? Is the Executive Branch seeking a policy change that has not been tested through some sort of administrative process before the patent community? Such checks for procedural regularity are well within the Court's competence.³⁸⁷ And if any of the regular indicia undergirding deference are absent, then the Court should treat OSG's substantive claims with greater skepticism than it would arguments that are consistent with Patent Office practices developed in accord with regular agency procedure. In such cases, the Court, might, for example, formally "refer" the issue to the Patent Office under the "doctrine of 'primary jurisdiction,'" which "seeks to produce better informed and uniform legal rulings by allowing courts to take advantage of an agency's specialized knowledge, expertise, and central position within a regulatory regime."³⁸⁸ Such hard look review gives the Executive Branch an incentive to align its own patent policymaking processes with the administrative procedures set out in the Administrative Procedure Act and in cases like *Chenery*.

387. See, e.g., *Encino Motorcars v. Navarro*, 584 U.S. ___, 136 S. Ct. 2117, 2127 (2016).

388. *Pharm. Res. & Mfrs. of Am. v. Walsh*, 538 U.S. 644, 673 (2003) (Breyer, J., concurring in part); see *Nat'l Cable & Telecomms. Ass'n v. Gulf Power*, 534 U.S. 327, 361 (2002) (Thomas, J., concurring) (similar, but for the FCC); see also *Golden*, *supra* note 45, at 1696 (describing the Patent Office's authority as "a variant of 'primary jurisdiction'").

Likewise, the Solicitor General should move incrementally towards a more transparent decisionmaking process. OSG need not upend entirely its brief-drafting process. But it might accept comments on pending CVSGs, describe publicly how interested parties can file comments, and make all such comments publicly available—including those it receives from other agencies and parties to the litigation. In view of OSG's flexibility in responding to certiorari-stage calls for amicus help, and its existing practices of meeting with parties and interested agencies, these reforms are relatively modest—yet go a long way toward a process that reflects greater public participation and accountability. And to the extent that such deference exists along a continuum,³⁸⁹ such modest shifts in favor of greater procedural rigor and public accountability improve OSG's claim to the de facto deference that it in fact enjoys.

Finally, the Patent Office should wield its authority to make rules governing patent examination to shape patent policy.³⁹⁰ In doing so, it should also employ procedures that more closely resemble ordinary rulemaking, by, for example, announcing new policies and seeking comment on such proposals before implementing them. And, consistent with the proposals by Melissa Wasserman and Chris Walker, the Patent Office should seek agency-head review of adjudication decisions, in order to bring that agency's process of policymaking-by-adjudication in line with the rest of the administrative state.³⁹¹ This is so no matter whether it formally seeks deference under *Chevron*: Even under *Skidmore*, such process and accountability concerns may affect whether the Patent Office's practices reflect the sort of "informed judgment to which courts . . . may properly resort for guidance."³⁹²

CONCLUSION: DEFERENCE THROUGH A PATENT LENS

The Solicitor General's Office quietly wields important influence over a wide range of the Supreme Court's cases, including, notably, patent cases. Indeed, this influence mimics, in many respects, the Court's more formal doctrines of deference: Where the Court can discern a clear command from Congress (as in *SAS Institute* or *Helsinn*

389. See, e.g., Baer & Eskridge, *supra* note 12, at 1184; see also John M. Golden, *The USPTO's Soft Power*, 66 SMU L. REV. 541, 549 (2013) ("As opposed to the uniformly heavy thumb that *Chevron* purports to provide in favor of agency interpretations, *Skidmore* thus gives deference on a sliding scale."); Peter L. Strauss, "Deference" Is Too Confusing—Let's Call Them "Chevron Space" And "Skidmore Weight," 112 COLUM. L. REV. 1143, 1145 (2012).

390. 35 U.S.C. § 2(b)(2)(A) (2018); *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2144 (2016).

391. Christopher J. Walker & Melissa F. Wasserman, *The New World of Agency Adjudication*, 107 CALIF. L. REV. 141, 175–78 (2018).

392. *Skidmore v. Swift & Co.*, 323 U.S. 134, 140 (1944).

Healthcare), the Court will require the Executive to follow the statute as enacted. But where a statute speaks in indefinite terms—say, allowing for “reasonable” exceptions from infringement liability—the Court is often content to let the Executive prescribe the policies that inform the interpretation of that ambiguous provision.

At first blush, this seems utterly unremarkable: In many other fields of law, the Court defers to Executive Branch interpretations of ambiguous statutes under *Chevron* or, less decidedly, under *Skidmore*. And *Chevron* and *Skidmore* are themselves grounded in various ideals: Courts (and the Supreme Court) defer to executive agencies because Congress so intended, because those agencies have relevant specialized knowledge, because agencies can be held to account for their decisions, because agencies have greater capacity to collect and analyze salient data, and (perhaps to a lesser degree) because agencies can adapt their rules to changing times.

But a closer look at these patent cases reveals that the Court’s decisions align often with the advocacy of the Solicitor General’s Office—but not necessarily with the preferences or the reasoning of the Patent Office. The Solicitor General’s advocacy in such patent cases fails to reflect these ideals of deference.

So what should we make of the Court’s apparent implicit deference to the Executive Branch? In view of the Court’s comparative inexpertise (or its own view that it is inept), I expect that the Court will continue to seek outside help in such technical and complex cases. Hence, taking the Court’s preference to defer as constant, I conclude that the Executive Branch should amend its practices to ensure that the Patent Office exercises principal responsibility over patent policy questions. And I consequently contend that the SG’s claims in patent cases may sometimes deserve a hard look, in order to discern whether they accord with Patent Office practices and rationales. That is, the Supreme Court should vary its existing practices to defer only when appropriate (as assessed by deference’s own lights),³⁹³ and to refer open questions to the Patent Office under the doctrine of primary jurisdiction, in order to improve Executive Branch decisionmaking.

These questions about the appropriate scope of the Supreme Court’s deference to the Executive Branch in patent cases sound in a contemporary debate about *Chevron* and deference itself. Should the Judiciary defer to the Executive *at all*? Here, a *Chevron* counterrevolution has been brewing: Scholars have raised a variety of objections to the apparent concentration of policymaking power in the

393. See, e.g., *Kisor v. Wilkie*, 588 U.S. 2400 (2019).

Executive Branch, Congress has proposed legislation revising the standard for judicial review of agency action, and even Members of the Supreme Court have lamented the scope and nature of the Judiciary's deference to executive agencies.³⁹⁴ Among these myriad critiques, which range from structural constitutional concerns to concerns that deference is systematically biased in favor of government litigants,³⁹⁵ is a view that the Judiciary "reflexively defers" to the Executive, even when such deference may be unwarranted.³⁹⁶

Though a complete defense of *Chevron* is outside my present scope, the patent experience nevertheless helps to illuminate both this specific reaction to *Chevron* as well as one possible solution. The Court's implicit deference to the Solicitor General seems emblematic of a deference regime run amok—one that allows the Court "to punt hard questions of statutory interpretation or administrative law" to a trusted executive agent, even where it seems evident that Congress did not intend for that particular agency to exercise that particular policy discretion.³⁹⁷ The Court's deference to the SG seems "reflexive"—and to the extent the Court defers to the Solicitor General's views in patent cases because of OSG's accumulated institutional capital, or because it offers a facially reasonable answer to a complex question in a technical field of law, this critique is valid. The Solicitor General has little claim to the mantle of patent policy, and so policy positions secretly crafted in the heat of litigation defense rightfully require a hard look from the Court. Judicial deference is not a reward for the favored or the trustworthy: Instead, as I have said several times already, it reflects Congress's allocation of decisionmaking authority, it reflects an agency's expertise and analytic capacity, and it reflects the President's (and, ostensibly, the voting public's) policy priorities. As in *Kisor*, then, deference is appropriate only where these conditions are satisfied.³⁹⁸

This valid critique, however, is specific to such reflexive applications of deference, and does not to apply to deference more generally. Indeed,

394. See, e.g., Separation of Powers Restoration Act of 2017, H.R. 76, 115th Cong. (2017); *Gutierrez-Brizuela v. Lynch*, 834 F.3d 1142, 1149–58 (10th Cir. 2016) (Gorsuch, J., concurring); PHILIP HAMBURGER, *IS ADMINISTRATIVE LAW UNLAWFUL?* (2014).

395. E.g., HAMBURGER, *supra* note 394, at 130.

396. *Pereira v. Sessions*, 585 U.S. ___, 138 S. Ct. 2105, 2120 (Kennedy, J., concurring) ("In according *Chevron* deference to the BIA's interpretation, some Courts of Appeals engaged in [only] cursory analysis The type of reflexive deference exhibited in some of these cases is troubling.").

397. Jonathan H. Adler, *What's Wrong with Chevron Deference Is Congress*, NAT'L REV. ONLINE (June 6, 2019), <https://www.nationalreview.com/magazine/2019/06/24/whats-wrong-with-chevron-deference-is-congress/> [https://perma.cc/A9ZU-4ZQL].

398. *Kisor v. Wilkie*, 588 U.S. 2400 (2019); *Pharm. Res. & Mfrs. of Am. v. Walsh*, 538 U.S. 644, 673 (2003) (Breyer, J., concurring in part).

judicial deference to the well-considered views advanced by Congress's expert delegee under the President's supervision is, and ought to be, uncontroversial: Such deference is founded in values sounding in the separation of powers, comparative institutional competence, and public accountability.

In short, there appears a gap between deference as it ought to be and deference as it sometimes is. But the right response to this disconnect is not to eliminate deference entirely. Instead, as I have suggested for the patent context, it is simply to return to the doctrine's foundations, and to eliminate "reflexive" applications of deference in favor of more studied ones. Courts should carefully examine a statute's "text, nature, and purpose" to discern the scope of Congress's delegation to the agency,³⁹⁹ and they should ultimately "respect that leeway which Congress intended the agencies to have," in view of such factors as "agency expertise," "administrative experience," among others.⁴⁰⁰ The *Chevron* Question is thus not *whether* deference is appropriate but *when*. The answer depends—as it does in choosing between the Patent Office and the Solicitor General's Office—on the foundations of deference.

399. *Cuozzo Speed Techs. v. Lee*, 579 U.S. ___, 136 S. Ct. 2131, 2142 (2016).

400. *SAS Inst. v. Iancu*, 584 U.S. ___, 138 S. Ct. 1348, 1364 (2018) (Breyer, J., dissenting) (quoting *Barnhart v. Walton*, 535 U.S. 212, 225 (2002)).