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## The Federal Circuit's Summary Affirmance Habit

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## The Federal Circuit’s Summary Affirmance Habit

*The Federal Circuit is certainly unique among the circuit courts of appeals. Its exclusive jurisdiction over patents places it in a powerful position. But with that power comes a responsibility to oversee the development of the law. And in the last decade, the court has fallen short of fulfilling this obligation—particularly with regard to clarifying provisions of the America Invents Act.*

*The court has repeatedly disregarded important questions of law by use of Rule 36 summary affirmance. Though other courts of appeals regularly use summary disposition as a means of dealing with burgeoning dockets, the Federal Circuit uses summary affirmance at a much higher rate and to dismiss unresolved legal questions.*

*This Comment explores some of the possible reasons why the court uses summary affirmance so frequently. After discussing summary disposition more generally, it specifically presents the theory of cert-proofing—or avoiding Supreme Court review—as one possible explanation. It concludes by offering some solutions to curb the court’s summary affirmance habit.*

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To say the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) is unique among appellate courts is an understatement. Whereas other federal courts of appeals are limited by region and function as courts of general jurisdiction, the Federal Circuit’s docket is governed primarily by subject matter.<sup>1</sup> Although the Federal Circuit’s jurisdiction encompasses adjudicatory authority in such areas as government contracts and labor disputes, it was primarily founded to oversee the development of patent law.<sup>2</sup>

In the 1970s, the Carter administration recognized that confusion in patent law was crippling the country’s economic growth.<sup>3</sup> Inconsistency among the regional circuits revealed the need for uniformity and consistency.<sup>4</sup> The solution to these problems was the creation of a national court with exclusive subject matter jurisdiction over patent appeals.

Yet since its creation in 1982, the Federal Circuit has been a source of controversy, with lawyers, academics, and judges criticizing the court’s alleged inconsistencies.<sup>5</sup> Many of these criticisms are

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1. See 28 U.S.C. § 1295 (2012).  
2. See Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 3–4 (1989).  
3. Pauline Newman, *The Federal Circuit in Perspective*, 54 AM. U. L. REV. 821, 822 (2005).  
4. *Id.* at 823.  
5. See, e.g., *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111, 2117 (2014) (sharply criticizing the Federal Circuit’s decision-making); Paul R. Gugliuzza, *Saving the Federal Circuit*, 13 CHI.-KENT J. INTELL. PROP. 350, 352 (2014); Laura G. Pedraza-Fariña, *Understanding the Federal Circuit: An Expert Community Approach*, 30 BERKELEY TECH. L.J. 89, 89 (2015); Ashby Jones, *Critics Fault Court’s Grip on Appeals for Patents*, WALL STREET J. (July 6, 2014, 7:10 PM), <http://www.wsj.com/articles/critics-fault-courts-grip-on-appeals-for-patents-1404688219>.

related to the development of patent doctrine and the decision-making of individual judges.<sup>6</sup> Little has been written concerning the court's procedural habits. Among the court's interesting procedural behaviors is its regular use of Rule 36 summary affirmance, or affirmance of the lower court without an opinion.<sup>7</sup> While academics have considered the court's summary affirmance rate from a statistical viewpoint,<sup>8</sup> the reasons for and practical implications of this practice have garnered much less attention.<sup>9</sup>

In this Comment, I analyze the Federal Circuit's Rule 36 practice and plausible explanations for the court's proportionally high use of summary affirmance. The court may very well be using summary affirmance properly in response to a growing and complex caseload. But based on a review of summarily affirmed cases, this seems unlikely. Rather, it appears that the Federal Circuit is using Rule 36 improperly and, consequently, hindering the development of patent law.<sup>10</sup> Although summary affirmance is a necessary tool the Federal Circuit should arguably employ to handle its case load,<sup>11</sup> I argue the court should avoid shying away from unresolved questions and instead look to other solutions that would have less-damaging effects on development of the law.

This Comment proceeds in five parts. In Part I, I provide background on the progression of patent law over the last half-century

6. See, e.g., Ted L. Field, *Hyperactive Judges: An Empirical Study of Judge-Dependent "Judicial Hyperactivity" in the Federal Circuit*, 38 VT. L. REV. 625 (2014).

7. See FED. CIR. R. 36.

8. E.g., Beth Zeitlin Shaw, *Please Ignore This Case: An Empirical Study of Nonprecedential Opinions in the Federal Circuit*, 12 GEO. MASON L. REV. 1013 (2004).

9. Two articles—recently made public—consider the legality of the Federal Circuit issuing an opinion in Patent and Trademark Office appeals. Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 WAKE FOREST L. REV. 561 (2017); Matthew J. Dowd, *An Examination of the Federal Circuit's Use of Rule 36 Summary Affirmances* (Feb. 25, 2017) (unpublished manuscript), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2920306](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2920306). Beyond these two articles, neither of which makes all the observations made herein, very little has been said about the Federal Circuit's summary affirmance habit.

10. I am not alone in this critique. See, e.g., Crouch, *supra* note 9; Matthew Bultman, *Fed. Cir. Issuing More 'Hidden Decisions' amid Case Influx*, LAW360 (Mar. 1, 2017, 12:06 PM), <https://www.law360.com/articles/894024/fed-circ-issuing-more-hidden-decisions-amid-case-influx>; Peter Harter & Gene Quinn, *Rule 36: Unprecedented Abuse at the Federal Circuit*, IPWATCHDOG (Jan. 12, 2017), <http://www.ipwatchdog.com/2017/01/12/rule-36-abuse-federal-circuit/id=76971/>.

11. *But see* Crouch, *supra* note 9 (arguing that the Federal Circuit is statutorily required to issue opinions in certain appeals).

and point out questions left unanswered by recent statutory reform. Although I focus on questions created by the America Invents Act, the discussion that follows is applicable to all legal questions presented before the Federal Circuit. In Part II, I discuss summary disposition generally and detail the primary benefits and drawbacks of the Federal Circuit's use of Rule 36. Specific cases are explored as a means of revealing the potentially damaging effects of summary affirmance. In Part III, I explore plausible explanations for why summary affirmance is being used at such a high rate. Some alternative means of controlling the court's docket are considered in Part IV. Part V concludes.

### I. BACKGROUND

The creation of the Federal Circuit came after a decade of heated debate. An overburdened judiciary and a need for greater uniformity in certain areas of federal law prompted discussion of creating a new federal court of appeals.<sup>12</sup> Yet there were concerns that a specialized court would become subject to tunnel vision, produce less than thorough opinions, and be at risk of capture by interest groups.<sup>13</sup> Ultimately, Congress decided to merge the United States Court of Customs and Patent Appeals and the appellate division of the United States Court of Claims to create a court with specialized subject matter jurisdiction, including jurisdiction over all patent appeals from the district courts.<sup>14</sup>

Congress hoped that endowing the court with exclusive jurisdiction over patent appeals would bring about uniformity in the law.<sup>15</sup> According to the former Chief Judge Howard T. Markey, prior to the creation of the Federal Circuit, the field of patent law was "glaringly chaotic."<sup>16</sup> However, the mere creation of a new court did not achieve the result of clarifying the law. Patent

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12. Charles Adams, *The Court of Appeals for the Federal Circuit: More than a National Patent Court*, 49 MO. L. REV. 43, 44-46 (1984) (discussing the formation of the Federal Circuit).

13. Marion T. Bennett, *The United States Court of Appeals for the Federal Circuit – Origins*, in *THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY 1982-1990*, at 28-30 (1991).

14. See Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982).

15. Lee Petherbridge, *Patent Law Uniformity?*, 22 HARV. J.L. & TECH. 421, 422-23 (2009).

16. HOWARD T. MARKEY, *THE FIRST TWO THOUSAND DAYS: REPORT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT 1982-1988*, at 3 (1988).

secrecy<sup>17</sup> was rampant, resulting in a system that “operated non-transparently, with great subjectivity, and with distressing unpredictability.”<sup>18</sup> The Bayh-Dole Act of 1980 and the Uruguay Round Agreements Act of 1994 brought much-needed reform to the patent system but failed to free the system from “non-transparency, subjectivity, unpredictability, and excessive complexity.”<sup>19</sup> Congressional efforts to overhaul the U.S. patent system began with the Patent Reform Act of 2005, but such efforts were met with industry group opposition and repeatedly failed.<sup>20</sup> In 2011, contention between Congress and industry groups finally transformed into legal change in the form of the Leahy-Smith America Invents Act (AIA).

#### A. *The America Invents Act*

The AIA is the most comprehensive piece of patent legislation in the last sixty years.<sup>21</sup> It attempts to reduce uncertainty in the patent system and “increas[e] opportunities for third-party involvement both pre- and post-issuance” of a patent.<sup>22</sup> To this end, the AIA changes from a first-to-file to a first-to-invent system, creates new post-grant methods of challenging a patent, and establishes a new Patent Trial and Appeals Board (PTAB) to handle post-grant reviews and *inter partes* reviews.<sup>23</sup> A thorough review of the AIA can and has occupied hundreds of pages of academic writing. Here, I limit my review of the AIA to a surface-level look at new post-grant proceedings and the creation of the PTAB to highlight questions of law left unanswered by the AIA’s plain meaning. The analysis that follows this background discussion is not limited to the AIA; I have simply chosen to analyze the AIA because it presents easy-to-find, unresolved questions.

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17. That is information only known to the inventor or, at the very least, information unavailable to the general public.

18. Robert A. Armitage, *Understanding the America Invents Act and Its Implications for Patenting*, 40 AIPLA Q.J. 1, 8 (2012).

19. *See id.* at 9.

20. Hung H. Bui, *An Overview of Patent Reform Act of 2011: Navigating the Leahy-Smith America Invents Act Including Effective Dates for Patent Reform*, 93 J. PAT. & TRADEMARK OFF. SOC’Y 441, 443 (2011).

21. *Id.* at 445.

22. Michael Dixon, *The Sweeping Changes of the 2011 America Invents Act*, 18 WESTLAW J. INTELL. PROP. 2, at \*1 (2012).

23. Bui, *supra* note 20 (providing a comprehensive overview of the AIA).

### 1. *Post-grant proceedings*

The AIA introduced three new types of post-grant procedures: *inter partes* review (IPR),<sup>24</sup> covered business method (CBM) patent review,<sup>25</sup> and post-grant review (PGR).<sup>26</sup> Each of these procedures is conducted before the newly created PTAB, providing third parties opportunities to challenge the validity of issued patents.

*a. Post-grant review.* A PGR is a PTAB trial proceeding during which a third party challenges the validity of a patent on the basis of any condition required for patentability.<sup>27</sup> A PGR must be initiated within nine months after the patent in question is granted or reissued.<sup>28</sup> The PTAB may institute a PGR if the petition “demonstrate[s] that it is more likely than not that at least one of the claims challenged in the petition is unpatentable.”<sup>29</sup> The PTAB may also institute a PGR upon “a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.”<sup>30</sup>

*b. Covered business method patent review.* A CBM patent is a patent “that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.”<sup>31</sup> CBM reviews are tried before the PTAB and governed by PGR procedures and general trial practice procedures explained in regulations.<sup>32</sup> Only a party sued or charged with patent infringement of a CBM patent may petition for CBM review.<sup>33</sup> And CBM review is only available nine months after the grant of the patent.<sup>34</sup> In order for the PTAB to begin a CBM patent review, (1) it must be more likely than not that the petitioner could prevail on at least one

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24. 35 U.S.C. § 311 (2015).

25. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329–31 (2011); 37 C.F.R. §§ 42.300–.304 (2012).

26. 35 U.S.C. § 321 (2015).

27. *Id.* § 321(a)–(b).

28. *Id.* § 321(c).

29. 37 C.F.R. § 42.208 (2016).

30. *Id.*

31. 37 C.F.R. § 42.301 (2012).

32. *Id.* § 42.300.

33. *Id.* § 42.302(a).

34. *Id.* § 42.403.

claim or (2) the petitioner must raise a novel or unsettled legal question important to other patents.<sup>35</sup> Although the CBM review does not allow for the review of all patents, it can be a powerful tool for accused infringers for a few reasons: (1) unlike an IPR, a CBM allows validity challenges on any ground that is a condition for patentability,<sup>36</sup> and (2) an accused infringer may file a petition for CBM review any time PGR is unavailable.<sup>37</sup>

*c. Inter partes review.* The IPR is another trial proceeding during which the validity of a patent is challenged using only prior art or printed publications with the petitioner requesting to cancel at least one claim as unpatentable under 35 U.S.C. §§ 102, 103.<sup>38</sup> Anyone other than the patent owner may file a petition.<sup>39</sup> The petition must be filed at the later of (1) nine months after the grant of the patent or (2) the close of any post-grant review.<sup>40</sup> The patent owner, in response to an IPR petition, may file a preliminary response "limited to setting forth the reasons why no *inter partes* review should be instituted."<sup>41</sup> The PTAB may grant IPR of a patent if there is a reasonable likelihood that the petitioner could prevail on at least one claim.<sup>42</sup>

## 2. Creation of the PTAB

The PTAB replaced the Board of Patent Appeals and Interferences, the main judicial body of the United States Patent and Trademark Office (USPTO). One of the primary reasons for creating an administrative body to adjudicate the three, new post-grant proceedings rather than relying on traditional Article III courts was to drive down litigation costs. The American Intellectual Property Law Association estimated that in low-stake patent lawsuits (in which less than \$1 million is sought), litigation costs rose from \$650,000 in 2005 to \$700,000 in 2013.<sup>43</sup> For high-stakes litigation

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35. 35 U.S.C. § 324(a)-(b) (2012).

36. 37 C.F.R. § 42.304(b)(2).

37. *Id.* § 42.303.

38. 35 U.S.C. § 311(b) (2012).

39. *Id.* § 311(a).

40. *Id.* § 311(c).

41. 37 C.F.R. § 42.107(a).

42. *Id.* § 42.108(c).

43. AM. INTELLECTUAL PROP. LAW ASS'N, REPORT OF THE ECONOMIC SURVEY 34 (2013).

during the same period, costs rose from \$4.5 million to \$5.5 million.<sup>44</sup> Expedited procedures before an administrative body will ideally curb those figures. The PTAB also has the potential to reduce error costs.<sup>45</sup> Whereas Article III judges are often generalists, administrative patent judges are required to be competent in matters of science and the law,<sup>46</sup> allowing them to efficiently handle patent issues generally considered to be highly complex.

Since its creation, the PTAB has been heavily used. In 2012, the USPTO published a regulation estimating the number of PGR, CBM review, and IPR petitions it expected the PTAB to handle.<sup>47</sup> Comparing these estimates to the actual number of petitions filed between 2013 and 2015, the PTAB experienced a 148% overage in petitions.<sup>48</sup> Clearly, the new post-grant procedures created by the AIA are being utilized, and these additional opportunities for litigation have created an abundance of new legal issues.

### 3. *Legal questions created by new post-grant proceedings*

Though the AIA clarified some aspects of the patent system, it also ushered in a myriad of new legal questions. I have chosen to review only a select number of those questions, not necessarily because of their ultimate importance in the patent law scheme, but because the Federal Circuit, through summary disposition, has seemingly ignored, or at least unduly delayed, answering them. Specifically, I consider new issues related to motions to amend, waiver, and secondary considerations.

During an IPR or PGR, the patent owner may file a motion to amend a patent, cancelling a challenged claim or proposing a reasonable number of substitute claims.<sup>49</sup> The IPR regulations promulgated under the AIA provide minimal guidelines with respect to motions to amend, leaving many questions unanswered; for

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44. *Id.*

45. Stuart Minor Benjamin & Arti K. Rai, *Administrative Power in the Era of Patent Stare Decisis*, 65 DUKE L.J. 1563, 1567 (2016).

46. 35 U.S.C. § 6(a) (2012).

47. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,651 (Aug. 14, 2012).

48. See U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD STATISTICS 2 (2016). In total, between September 16, 2012, and July 31, 2016, the PTAB received 5359 petitions. *Id.*

49. 37 C.F.R. §§ 42.121(a), 42.221(a).

example, the regulations do not say who bears the burden of proof regarding patentability of amended claims and what the specific requirements are for successfully amending claims.

The AIA is silent with respect to whether arguments not raised before the PTAB are waived on appeal. Although it is likely that the Federal Circuit will deem arguments not raised before the PTAB waived, it is unclear whether arguments made in an IPR preliminary response but not repeated after the PTAB's institution decision are considered waived on appeal.

The non-obviousness requirement is "the ultimate threshold for patentability."<sup>50</sup> Although obviousness is often proved by considering the scope and content of the prior art and differences between the prior art and the claims at issue, patent law allows for the use of secondary considerations to prove non-obviousness.<sup>51</sup> Secondary considerations are the "economic and motivational . . . issues" that "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."<sup>52</sup> The Supreme Court and the Federal Circuit have determined that in general patent disputes, secondary considerations can be given significant weight as they "may often be the most probative and cogent evidence in the record."<sup>53</sup> The question of what weight to give secondary considerations resurfaced with the creation of new post-grant proceedings and remains unanswered.

Each of the aforementioned issues has passed before the Federal Circuit. But rather than resolve these new issues on first appearance, the court used a method of summary disposition, allowing ambiguity and confusion to persist. Before exploring the specific cases in support of this claim, it is helpful to understand the development of summary disposition as a regular practice of the court.

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50. Natalie A. Thomas, *Secondary Considerations in Nonobviousness Analysis: The Use of Objective Indicia Following KSR v. Teleflex*, 86 N.Y.U. L. REV. 2070, 2074 (2011).

51. *Id.* at 2075.

52. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

53. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983).

## II. SUMMARY DISPOSITION

From June 30, 2015, to June 30, 2016, 60,099 cases were filed in the United States Courts of Appeals.<sup>54</sup> Between 1971 and 2005, the courts of appeals experienced nearly a 500% increase in filings.<sup>55</sup> Although the Federal Circuit's caseload has not experienced this type of growth, it has experienced both an increase in the total number of filings (particularly since implementation of the AIA<sup>56</sup>) and an "increase in the difficulty of the average case."<sup>57</sup> Given the number of cases pending before appellate courts, procedural remedies have been created to quickly dismiss frivolous suits and insignificant cases. The Federal Rules of Appellate Procedure (Federal Rules) describe a number of these procedures. However, one method of disposition, summary disposition, or judgment without an opinion, is not explicitly contemplated by the Federal Rules. That said, the Federal Rules give appellate courts broad discretion to apply expedited procedures as necessary.<sup>58</sup> Perhaps relying on this broad discretion, many courts have created specific provisions in their local rules describing the procedures for summary disposition.<sup>59</sup> The Federal Circuit has such a rule.<sup>60</sup>

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54. *U.S. Court of Appeals—Judicial Caseload Profile*, U.S. CTS. (2016), [http://www.uscourts.gov/sites/default/files/data\\_tables/fcms\\_na\\_appprofile0630.2016.pdf](http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_appprofile0630.2016.pdf).

55. Cathy Catterson, *Changes in Appellate Caseload and Its Processing*, 48 ARIZ. L. REV. 287, 287 (2006).

56. Jon E. Wright & Pauline M. Pelletier, *Don't Let Your Patent Appeal Get Lost in the Crowd*, NAT. L.J. (Jan. 25, 2016, 12:00 AM), <https://www.law.com/nationallawjournal/almID/1202747725537/> (noting that between 2013 and 2015, the number of appeals coming from the Patent Office increased from less than 150 to more than 400).

57. Paul R. Michel, *The Court of Appeals for the Federal Circuit Must Evolve to Meet the Challenges Ahead*, 48 AM. U. L. REV. 1177, 1181 (1999).

58. See FED. R. APP. P. 2.

59. *E.g.*, 9TH CIR. R. 3-6; 3D CIR. R. 27.4.

60. FED. CIR. R. 36.

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

- (a) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (b) the evidence supporting the jury's verdict is sufficient;
- (c) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or

Federal Circuit Rule 36 governs when the court may enter a judgment of affirmance without an opinion, requiring that certain conditions be met, including a determination that an opinion would have no precedential value and unanimity.<sup>61</sup> The former Chief Judge Markey of the Federal Circuit explained that summary affirmance is appropriate when “it’s not necessary to explain, even to the loser, why he lost.”<sup>62</sup> Explaining this principle in different terms, summary affirmance is appropriate “when the position of one party is so clearly correct as a matter of law that no substantial question regarding the outcome of the appeal exists.”<sup>63</sup>

In recent years, the rate of summary disposition in the federal courts of appeals has increased. In 2012, the federal courts of appeals decided approximately 35,000 cases on the merits.<sup>64</sup> Of those cases, about 5000 were summarily disposed.<sup>65</sup> When a court chooses to summarily dispose of a case, it announces its judgment without providing written reasoning or analysis. Such judgments lack precedential value.<sup>66</sup>

The creation of the PTAB resulted in a dramatic increase in the number of cases being appealed to the Federal Circuit, and the number of appeals coming from the district courts has held steady.<sup>67</sup> The result is an overburdened Federal Circuit seemingly forced to find new ways to deal with its saturated docket. The Federal Circuit appears to have turned to Rule 36 as a means of easing its burden. On appeals coming from the USPTO in 2010, the Federal Circuit utilized Rule 36 thirty-seven percent of the time.<sup>68</sup> In 2015, the Federal Circuit employed Rule 36 fifty-eight percent of

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(e) a judgment or decision has been entered without an error of law.

*Id.* (emphasis added).

61. *Id.*; INTERNAL OPERATING PROCEDURES FED. CIR. NO. 10.5.

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

63. *Joshua v. United States*, 17 F.3d 378, 380 (Fed. Cir. 1994).

64. Colter Paulson, *The Trend Toward the Use of Summary Dispositions*, SIXTH CIRCUIT APPELLATE BLOG (May 14, 2013), <http://www.sixthcircuitappellateblog.com/news-and-analysis/the-trend-toward-the-use-of-summary-dispositions/>.

65. *Id.*

66. *See Rates Tech., Inc. v. Mediatrice Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012) (citing *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir. 1997)).

67. *See Jason Rantanen, Data on Federal Circuit Appeals and Decisions*, PATENTLYO (June 2, 2016), <http://patentlyo.com/patent/2016/06/circuit-appeals-decisions.html>.

68. *Id.*

the time.<sup>69</sup> Since the creation of PTAB proceedings, the Federal Circuit has decided 113 PTAB appeals, sixty-one of which were disposed of by a Rule 36 affirmance.<sup>70</sup>

While an initial statistical glance suggests that the Federal Circuit may be ignoring the letter of the law and using Rule 36 to “rubber stamp” PTAB decisions, a strong argument can be made that the statistics are bloated. Between December 2013 and November 2015, the Federal Circuit issued forty-two decisions stemming from IPR appeals.<sup>71</sup> Of these decisions, twenty-one, or fifty percent, were summary affirmances.<sup>72</sup> However, this statistic does not take into consideration the number of appeals awaiting a decision. As of November 2015, fourteen appeals had been argued and sufficient time had lapsed to all but rule out the possibility of a Rule 36 summary affirmance.<sup>73</sup> Taking these appeals into consideration, the actual number of IPR appeals summarily disposed drops to thirty-seven percent. Comparing this figure to the summary affirmance rate in 2010, the recent use of Rule 36 seems reasonable from a statistical standpoint.

However, even if the aforementioned statistical argument is persuasive, the Federal Circuit often uses summary affirmance inappropriately.<sup>74</sup> Rule 36 summary affirmance should be used only when any of five conditions are met *and* an opinion would have no precedential value.<sup>75</sup> As I will demonstrate in section II.B, the Federal Circuit has passed over opportunities to issue

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69. *Id.*

70. Elliot C. Cook, Daniel F. Klodowski & David C. Seastrunk, *Federal Circuit PTAB Appeal Statistics: September 2016*, FINNEGAN (Sept. 12, 2016), <http://www.aiablog.com/ptab-stats/federal-circuit-ptab-appeal-statistics-september-2016/>.

71. Justin A. Hendrix & Jacob A. Schroeder, *Surfs Up: Is the Federal Circuit Using Rule 36 to Rubber-Stamp the PTAB's Decisions in IPRs?*, LEXOLOGY: FEDERAL CIRCUIT IP BLOG (Nov. 16, 2015), <https://www.lexology.com/library/detail.aspx?g=b86d0f48-659f-42ac-a00a-d31451e84767>.

72. *Id.*

73. *Id.*

74. When I speak of the Federal Circuit generally, I do not mean to impugn the court's integrity or dedication to the law. I speak of the judge who, on occasion at most, either reads Rule 36 loosely or pays less attention to the strict letter of the law.

75. FED. CIR. R. 36.

precedential opinions that could resolve issues generated by the creation of the AIA's post-grant review proceedings.<sup>76</sup>

*A. Purpose of Summary Affirmance*

The primary benefit of summary affirmance is the preservation of court resources and time. In 2013, the Federal Circuit handled 1381 appeals.<sup>77</sup> In 2016, that number rose to 1839.<sup>78</sup> The court's resources have not matched this growth.<sup>79</sup> Consequently, the court needs a tool to dispose of frivolous claims or cases presenting settled questions of law. Rule 36, with its discretion-limiting language restraining judges, can be an effective means of controlling the court's docket and resources without hurting development of the law.

Although courts should not operate like machines at the cost of equity or fairness, efficiency is an important aim of the court system.<sup>80</sup> Summary affirmance is a valuable tool for promoting efficiency, and when courts abide by summary affirmance guidelines, the aims of equity and efficiency can be simultaneously met. While more could be written about the value of summary affirmance, I focus on the primary drawbacks of improperly using Rule 36 to highlight a problem with the Federal Circuit's current practice.

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76. Litigants and scholars alike have expressly stated a belief that the Federal Circuit is dodging important questions of statutory interpretation through persistent use of Rule 36. See, e.g., Petition for Writ of Certiorari at 21, *Pactiv, LLC v. Lee*, 137 S. Ct. 248 (2016) (No. 16-205), 2016 WL 4363501 ("The Federal Circuit cannot avoid answering thorny questions of statutory interpretation by routinely issuing single-word summary affirmances."); Brief of Amicus Curiae Raymond A. Mercado at 22, *Pactiv, LLC v. Lee*, 137 S. Ct. 248 (2016) (No. 16-205), 2016 WL 4921165 ("The Federal Circuit has twice dodged an important issue of statutory construction, affirming the case without opinion under a rule permitting it to do so when 'an opinion would have no precedential value,' even though no direct precedent on this question exists.").

77. *United States Court of Appeals for the Federal Circuit Historical Caseload*, U.S. CT. APPEALS FOR FED. CIR. (2016), [http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/FY16\\_Caseload\\_Overall\\_2.pdf](http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/FY16_Caseload_Overall_2.pdf).

78. *Id.*

79. In the sense that the number of Federal Circuit judges and clerks has not increased.

80. See generally Charles E. Clark, *Making Courts Efficient*, 8 UCLA L. REV. 489 (1961) (discussing why efficiency is important and some efforts made to improve judicial efficiency).

*B. Hindering Development of Patent Law*

Summary disposition is an effective means of dismissing frivolous claims or suits that do not present a question of importance, but it comes with a significant error cost.<sup>81</sup> Most circuits—including the Federal Circuit—agree that when a published opinion is not produced, a case cannot serve as precedent. “The heart of the common law [sic] system is the written judicial opinion.”<sup>82</sup> Opinions “are what courts do . . . . They are the substance of judicial action . . . .”<sup>83</sup> Written opinions are key to the operation of our system of stare decisis,<sup>84</sup> and without them, the state of the law would be in confusion. “[J]udges and lawyers are utterly dependent upon published opinions to research, evaluate, argue, and decide cases—the most basic of legal tasks.”<sup>85</sup> Publishing opinions is a key function of appellate courts inasmuch the federal courts of appeals are “needed to announce, clarify, and harmonize the rules of decision employed by the legal system in which they serve.”<sup>86</sup> This function is particularly important in an age in which the Supreme Court hears a mere fraction of appellate court cases.<sup>87</sup>

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81. Many scholars and judges have discussed the potential drawbacks of summary disposition of appeals. See, e.g., *Nat'l Classification Comm. v. United States*, 765 F.2d 164, 174 (D.C. Cir. 1985) (“[T]his court should at least give the parties a statement of reasons in the court’s own words, if for no other reason than to indicate that the court in fact thoughtfully reviewed the agency’s determination.”); *United States v. Glover*, 731 F.2d 41, 48–53 (D.C. Cir. 1984) (Mikva, J., dissenting) (expressing concerns with deviating from the normal appellate process); William L. Reynolds & William M. Richman, *Limited Publication in the Fourth and Sixth Circuits*, 1979 DUKE L.J. 807, 814–15 (1979) (suggesting that the limited publication rule does not increase judicial productivity); Charles R. Haworth, *Screening and Summary Procedures in the United States Courts of Appeals*, 1973 WASH. U. L.Q. 257, 320 (1973) (explaining some of the consequences of summary disposition in the federal courts of appeals). I choose to focus on how summary affirmance hinders development of the law.

82. John Reid, *Doe Did Not Sit – the Creation of Opinions by an Artist*, 63 COLUM. L. REV. 59, 59 (1963).

83. Robert A. Leflar, *Some Observations Concerning Judicial Opinions*, 61 COLUM. L. REV. 810, 819 (1961).

84. Martha J. Dragich, *Will the Federal Courts of Appeals Perish if They Publish? Or Does the Declining Use of Opinions to Explain and Justify Judicial Decisions Pose a Greater Threat?*, 44 AM. U. L. REV. 757, 770–75 (1995) (discussing the relationship between published opinions and stare decisis).

85. *Id.* at 759.

86. PAUL D. CARRINGTON ET AL., JUSTICE ON APPEAL 3 (1976).

87. Between September 30, 2014, and September 30, 2015, 34,244 cases were decided on the merits in the courts of appeals (not including the Federal Circuit). ADMIN. OFFICE OF

The number of appeals has dramatically increased over the last few decades<sup>88</sup> while the number of cases heard by the Supreme Court has dropped.<sup>89</sup> The congruence of these two events has resulted in the appellate courts adopting a more important role as “the courts of last resort for the vast majority of litigants.”<sup>90</sup> The federal courts of appeals “have become important policymakers,”<sup>91</sup> leading some to suggest that “[j]udges on the U.S. courts of appeals are among the most powerful people in American politics.”<sup>92</sup> In the nineteenth century, some argued that judges do not “make” law — they only find and declare it.<sup>93</sup> That belief is now largely considered fantasy, with most contending that judges do “make” law inasmuch as they develop the common law, interpret statutes, and create precedent.<sup>94</sup> This is certainly true with regard to the Federal Circuit.

Up until the last decade, the Supreme Court had all but fled from the patent law scene, making the Federal Circuit “the de facto supreme court of patents.”<sup>95</sup> Although the Supreme Court has developed a greater interest in the development of patent law, the Federal Circuit remains the primary developer,<sup>96</sup> consistent

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U.S. COURTS, *Judicial Business of the United States Courts*, in ANNUAL REPORT OF THE DIRECTOR OF THE ADMINISTRATIVE OFFICE OF U.S. COURTS tbl. B (2015). That same year, 4715 petitions for review on writ of certiorari were filed from the circuit courts (not including the Federal Circuit), and only 136 were granted, representing a mere 0.4% of cases terminated in the federal courts of appeals. *Id.* at tbl. B-2.

88. Catterson, *supra* note 55, at 287.

89. Adam Liptak, *The Case of the Plummeting Supreme Court Docket*, N.Y. TIMES (Sept. 28, 2009), [http://www.nytimes.com/2009/09/29/us/29bar.html?\\_r=0](http://www.nytimes.com/2009/09/29/us/29bar.html?_r=0).

90. JENNIFER BARNES BOWIE ET AL., *THE VIEW FROM THE BENCH AND CHAMBERS: EXAMINING JUDICIAL PROCESS AND DECISION MAKING ON THE U.S. COURT OF APPEALS* 1 (2014).

91. *Id.* at 2.

92. *Id.* at 11.

93. Many of these arguments were founded on the philosophy of William Blackstone. See WILLIAM BLACKSTONE, 1 COMMENTARIES ON THE LAWS OF ENGLAND 63, 67-73 (Oxford Clarendon Press, 1765).

94. See EDWARD F. HENNESSEY, *JUDGES MAKING LAW* 1 (1994); LOUIS L. JAFFE, *ENGLISH AND AMERICAN JUDGES AS LAWMAKERS* 2 (1969); Lord Reid, *The Judge as Law Maker*, 12 J. SOC'Y PUB. TCHR. L. 22, 22 (1972).

95. Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 387 (2001).

96. Multiple reasons explain why the Federal Circuit remains, by and large, the developer of patent law. First, the Supreme Court often relies on the presence of a circuit split as an indicator when determining what cases to review. SUP. CT. R. 10; see H.W. PERRY, JR., *DECIDING TO DECIDE: AGENDA SETTING IN THE UNITED STATES SUPREME COURT* 246 (1991). The Federal Circuit's unique jurisdiction makes it difficult for the Supreme Court to rely on

with the role Congress envisioned when the Federal Circuit was created.<sup>97</sup>

Through the early 2000s, the Federal Circuit arguably did an effective job fulfilling its purpose to unify patent law.<sup>98</sup> And although the Federal Circuit by and large still fulfills this responsibility, recent use of Rule 36 summary affirmance has detracted from the court's central function. Rather than address pressing issues, the Federal Circuit has employed Rule 36 to the confusion of litigants and the lower courts, ultimately increasing litigation costs.

Some may argue that the PTAB's decisions and subsequent affirmances on appeal are a sufficient guide for litigants. Since the creation of PTAB proceedings, the Federal Circuit has decided 113 PTAB appeals.<sup>99</sup> The Federal Circuit affirmed every issue in ninety (79.65%) of the cases.<sup>100</sup> Some practitioners suggest that this high affirmance rate can be used as a guide for litigants wrestling with unresolved issues. Even assuming this pattern of affirmance is a good indicator of the Federal Circuit's disposition, a key function of the Federal Circuit is to clarify patent law. The PTAB was not created to establish patent precedent—that role remains with the Federal Circuit.

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this indicator when reviewing Federal Circuit decisions. Ryan Stephenson, *Federal Circuit Case Selection at the Supreme Court: An Empirical Analysis*, 102 GEO. L.J. 271, 275 (2013). Second, the Federal Circuit's expertise makes it the prime court to review patent issues. Zachary Shapiro, *Patent Law, Expertise, and the Court of Appeals for the Federal Circuit*, HARV. L.: BILL OF HEALTH (July 14, 2015, 1:43 AM), <http://blogs.harvard.edu/billofhealth/2015/07/14/patent-law-expertise-and-the-court-of-appeals-for-the-federal-circuit/>. One needs only look to the Supreme Court's decision in *Association for Molecular Pathology v. Myriad Genetics* to see the confusion that can potentially stem from nonexperts tackling patent issues. See Heidi Ledford, *Myriad Ruling Causes Confusion*, 498 NATURE 281 (2013) (explaining the confusion caused by the Court's decision).

97. See MARKEY, *supra* note 16, at 2; Marion T. Bennett, *The United States Court of Appeals for the Federal Circuit – Origins*, in UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT: A HISTORY: 1990–2002, at 3, 9–10 (2004) (suggesting that concerns over the state of patent law in America spurred the creation of the Federal Circuit).

98. See Rochelle Cooper Dreyfuss, *In Search of Institutional Identity: The Federal Circuit Comes of Age*, 23 BERKELEY TECH. L.J. 787, 788–89 (2008).

99. Klodowski, *supra* note 70.

100. *Id.* (including sixty-one cases where the court issued Rule 36 affirmances).

A habit of summary affirmance gives the impression – whether warranted or not – that the court is results oriented.<sup>101</sup> Although litigants can present their merit arguments, the court has the final say on which appeals will be summarily disposed. Without a view into the black box of the court, there is a real risk that the public will believe the court is adjudicating for results and not justice. And with no opinion to explain their rationale, courts are helpless to respond to such accusations.

In Owen Fiss's seminal work, *Against Settlement*, Fiss argues that settlement brings peace, but not necessarily justice.<sup>102</sup> The sigh of the judge whose case settles "is not a recognition that a job is done" but instead is an acknowledgment "that another case has been 'moved along.'"<sup>103</sup> While there can be value to avoidance, the lack of a judicial decision comes at a cost to society.<sup>104</sup> Megan La Belle applies this idea in the patent context, reasoning that settlement causes unpredictability in patent law.<sup>105</sup> The dearth of precedent caused by high proportions of settlement is particularly glaring in the patent world where development of the law is largely left to the courts.<sup>106</sup> Summary affirmance has a similar effect as settlement – the precedential value of a decision is lost. Rule 36 attempts to balance the worth of a precedential opinion with efficiency. Although efficiency is certainly a relevant and important public value, efficiency should not sharply undermine development of the law.<sup>107</sup>

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101. See John E. Simonett, *The Use of the Term "Result-Oriented" to Characterize Appellate Decisions*, 10 WM. MITCHELL L. REV. 187, 196–200 (1984).

102. Owen M. Fiss, *Against Settlement*, 93 YALE L.J. 1073, 1085–86 (1984).

103. *Id.* at 1086.

104. *Id.* at 1085–86; see Jill E. Fisch, *Rewriting History: The Propriety of Eradicating Prior Decisional Law Through Settlement and Vacatur*, 76 CORNELL L. REV. 589, 630 (1991); see also *supra* Section II.B (discussing the costs of summary disposition).

105. Megan M. La Belle, *Against Settlement of (Some) Patent Cases*, 67 VAND. L. REV. 375, 405 (2014).

106. *Id.* at 405–06 ("[D]ecisional law, specifically Federal Circuit jurisprudence, has primarily formed and defined the patent landscape.").

107. Additionally, a strong argument can be made that a precedential opinion actually increases the efficiency of the court system. See Fisch, *supra* note 104, at 591 ("[F]inality increases the efficiency of the judicial system by acting as a bar to relitigation of the same and similar claims and issues. . . .").

In the years following the passage of the AIA, the Federal Circuit repeatedly punted on important issues.<sup>108</sup> I consider a few of these issues to highlight a flaw with the court's summary affirmance practice.<sup>109</sup>

### 1. Motion to amend claims

The IPR introduced a method for patent owners to amend a patent by cancelling any challenged patent claim or by proposing substitute claims, so long as such substituted claims do not "enlarge the scope of the claims of the patent or introduce new matter."<sup>110</sup> Although the USPTO provided some additional details concerning motions to amend,<sup>111</sup> important questions, such as the requirements for amending claims, were initially left unanswered. Questions surrounding the motion to amend procedure, although not the hallmark of most patent disputes, were important and relevant inasmuch as motions to amend were filed by patent owners in twelve percent of all completed AIA proceedings.<sup>112</sup>

In *Helferich Patent Licensing, LLC v. CBS Interactive Inc.*, the PTAB determined that the challenged claims of a patent were unpatentable as obvious based on prior art references.<sup>113</sup> The Board also denied the patent owner's motion to amend.<sup>114</sup> In support of this conclusion, the PTAB stated that the patent owner failed to provide reasonable construction of the claim features added in the substitute claims, identify the written description support for the substitute claim, and prove that the new claims were patentable.<sup>115</sup> On appeal, the patent owner argued that it had clearly met the

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108. See *supra* Section I.A.3.

109. Before proceeding into these issues, I note that within the last year the Federal Circuit has resolved a few questions related to these matters. Nonetheless, the court's delay hindered development of the law and increased confusion and litigation costs.

110. 35 U.S.C. § 316(d) (2012).

111. See 37 C.F.R. § 42.21(d) (2015).

112. U.S. PATENT & TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD MOTION TO AMEND STUDY 3 (2016), <https://www.uspto.gov/sites/default/files/documents/2016-04-30%20PTAB%20MTA%20study.pdf>.

113. *CBS Interactive, Inc. v. Helferich Patent Licensing, LLC*, No. IPR2013-00033, Paper 122 (P.T.A.B. Mar. 3, 2014).

114. *Id.* at 50.

115. *Id.* at 51-58.

motion to amend requirements established in 37 C.F.R. § 42.121.<sup>116</sup> Those requirements do not include establishing patentability as a condition of amending a claim. The patent owner argued that shifting the burden of proof to a patent owner would conflict with the AIA.<sup>117</sup> Although the AIA gives the USPTO authority to promulgate regulations “setting forth standards and procedures for allowing the patent owner to move to amend the patent under [§ 316(d)],”<sup>118</sup> this delegation did not confer on the USPTO authority to alter the statutory burden of proof. The USPTO intervened and argued that its procedures were in line with Congress’s purpose behind creating IPR proceedings – to eliminate claims that should not have been issued.<sup>119</sup> Although the general motions practice rule of 37 C.F.R. § 42.20(c) places the burden of proof on the moving party, that regulation “is a procedural rule allocating the burden of proof in motions practice; it does not change the substantive showing required, which is spelled out in section 42.121.”<sup>120</sup> Notwithstanding this ambiguity in the law, the Federal Circuit summarily affirmed the PTAB’s decision.<sup>121</sup>

The Federal Circuit has since resolved this motion to amend issue.<sup>122</sup> In *Microsoft Corp. v. Proxyconn, Inc.*, the Federal Circuit deferred to the PTAB’s reasoning, affirming that, among other things, the patent owner bears the burden of proving patentability of amended claims.<sup>123</sup> The Federal Circuit could have easily employed this strategy in *Helfrich Patent Licensing, LCC* to affirm the PTAB’s decision and simultaneously clarify the law. Instead, the

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116. Brief for Appellants at 41–42, *Helfrich Patent Licensing, LLC v. CBS Interactive, Inc.*, 599 F. App’x 995 (Fed. Cir. 2015) (No. 2014-1556).

117. *Id.* at 45 (“In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”) (quoting 35 U.S.C. § 316(e)).

118. 35 U.S.C. § 316(a)(9).

119. Brief for Intervenor, *Helfrich Patent Licensing, LLC v. CBS Interactive, Inc.*, 599 F. App’x 955 (Fed. Cir. 2015) (No. 14-1556).

120. Reply Brief of Appellants at 18, *Helfrich Patent Licensing, LLC v. CBS Interactive, Inc.*, 599 F. App’x 955 (Fed. Cir. 2015) (No. 14-1556).

121. *Helfrich Patent Licensing, LLC v. CBS Interactive, Inc.*, 599 F. App’x 955 (Fed. Cir. 2015) (mem.).

122. *See, e.g., Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1306–08 (Fed. Cir. 2015) (“The Board has reasonably interpreted these provisions as requiring the patentee to show that its substitute claims are patentable over the prior art of record. . . .”).

123. *Id.* at 1307–08.

Federal Circuit waited a year before declaring an important motion to amend standard. Perhaps *Helfrich Patent Licensing, LLC* was summarily affirmed for justifiable reasons, but the striking similarities in the issues between these two cases suggests that the Federal Circuit missed an opportunity to provide a helpful, precedential opinion.

## 2. Waiver

In *Nichia Corp. v. Emcore Corp.*, the PTAB construed a patent owner's claims as obvious and therefore unpatentable.<sup>124</sup> The patent owner argued that the petitioner's references to prior art deviated from the claimed method.<sup>125</sup> In its response to a motion to amend claims, the petitioner introduced a new reference in hopes of rebutting the patent owner's argument.<sup>126</sup> Relying in part on this new reference, the PTAB rejected the patent owner's defense.<sup>127</sup>

On appeal, the patent owner argued that it was improper for the PTAB to consider the petitioner's new reference submitted in petitioner's response to a motion to amend claims.<sup>128</sup> The USPTO argued that because the patent owner failed to move to exclude the reference before the PTAB, it had waived this argument.<sup>129</sup> The patent owner defended its argument by contending that it "had no obligation to move to exclude evidence that was never offered for the purpose for which the Board ultimately used it."<sup>130</sup> Petitioner did not submit the reference to invalidate the original claim, but to invalidate the amended claims.<sup>131</sup> Despite this waiver issue, the Federal Circuit issued a Rule 36 judgment.<sup>132</sup>

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124. *Nichia Corp. v. Emcore Corp.*, No. IPR2012-00005, Paper 68 (P.T.A.B. Feb. 11, 2014).

125. See Anthony C. Tridico et al., *PTAB Affirmance at the Federal Circuit*, FINNEGAN (June 2015), <https://www.finnegan.com/en/insights/ptab-affirmance-at-the-federal-circuit.html>.

126. *Nichia's Opposition to Emcore's Motion to Amend*, *Nichia Corp. v. Emcore Corp.*, No. IPR2012-00005 (P.T.A.B. Aug. 30, 2013), 2013 WL 5379466.

127. *Nichia Corp.*, No. IPR2012-00005, Paper 68.

128. Tridico et al., *supra* note 125.

129. Brief for Intervenor at 18-23, *Emcore Corp. v. Nichia Corp.*, 599 F. App'x 959 (Fed. Cir. 2015) (No. 14-1508).

130. Reply Brief for Appellant at 2, *Emcore Corp. v. Nichia Corp.*, 599 F. App'x 959 (Fed. Cir. 2015) (No. 14-1508).

131. See *Nichia's Opposition to Emcore's Motion to Amend* at 5-9, *Emcore Corp. v. Nichia Corp.*, No. IPR2012-00005 (P.T.A.B. Aug. 30, 2013), 2013 WL 5379466.

132. *Emcore Corp. v. Nichia Corp.*, 599 F. Appx. 959 (Fed. Cir. 2015) (mem.).

The Federal Circuit has responded to other waiver questions such as whether a patent owner's arguments made only in a preliminary response are waived on appeal.<sup>133</sup> However, *Emcore Corp.* presented an interesting IPR specific waiver issue the Federal Circuit has yet to resolve. Like in *Helfrich Patent Licensing, LCC*, the Federal Circuit may have been justified in its issuance of a Rule 36 judgment. However, by summarily affirming the decision of the PTAB, the Federal Circuit missed the opportunity to answer an important waiver question.

### III. EXPLANATIONS FOR THE FEDERAL CIRCUIT'S SUMMARY AFFIRMANCE PRACTICE

In an ideal world, the Federal Circuit would issue an opinion in every case it heard. However, the ideal world is not reality. Circuit courts are overrun with appeals. Summary disposition is a useful and arguably necessary tool used to control a court's docket. But if summary disposition was used solely to control an overrun docket, one would expect the circuit courts with the largest caseloads to use summary disposition the most; such is not the case. The Federal Circuit—whose caseload is dwarfed by other circuit courts' dockets<sup>134</sup>—uses summary affirmance on a much more regular basis,<sup>135</sup> suggesting that factors beyond docket size may be contributing to the court's summary affirmance rate.

#### *A. De Novo Review*

The de novo standard of review often employed by the Federal Circuit likely contributes to the court's frequent use of summary affirmance. Most appellate courts apply a "substantial evidence" or

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133. *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1336 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 2510 (2016); *SAP Am., Inc. v. Versata Dev. Grp., Inc.*, No. CBM2012-00001, Paper 81 at 3, 2013 WL 8605252 (P.T.A.B. Sept. 13, 2013) (holding *Versata* waived issues not raised once the trial was instituted).

134. For example, in 2015, 11,531 cases were initiated in the Ninth Circuit and 7843 cases commenced in the Eleventh Circuit. During the 2015 fiscal year, 1711 appeals were filed in the Federal Circuit. See sources cited *infra* note 192.

135. Ted L. Field, "Judicial Hyperactivity" in the Federal Circuit: An Empirical Study, 47 U.S.F. L. REV. 721, 746 (2012) ("The Federal Circuit was the only one of the circuits studied that uses summary affirmances in any appreciable amount.").

“clearly erroneous” standard when reviewing questions of fact.<sup>136</sup> The Federal Circuit is unique in that it regularly uses a *de novo* standard when reviewing matters that “are undeniably factual in nature,” leading one practitioner to suggest the court has a “love affair with *de novo* review.”<sup>137</sup> *De novo* review requires an appellate court to comb the record and become pseudo-experts in the case subject matter, a task that takes time. The Federal Circuit may be using summary affirmance as a means of compensating for the extra time spent reviewing factual decisions in complex cases.

Some Federal Circuit judges have acknowledged flaws with the court’s rampant *de novo* review, suggesting the court “must avoid the temptation to label everything legal and usurp the province of the fact finder with [a] manufactured *de novo* review.”<sup>138</sup> The Supreme Court has likewise acknowledged the issue and recently decided to curb the practice in the context of claim construction.<sup>139</sup> However, given the recency and narrowness of the Court’s decision, it is difficult to know whether the Federal Circuit’s obsession with *de novo* review will come to an end. If it does not, the court may continue to use summary affirmance as a means of creating time to thoroughly review select cases.

#### *B. Then and Now: The Current Need for Summary Affirmance*

It is possible that prior to the recent increase in the number of appeals, the Federal Circuit was issuing opinions in cases in which use of Rule 36 was justified. Thus, what the court may be doing now is simply summarily affirming where they could have already been

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136. See Martha S. Davis, *A Basic Guide to Standards of Judicial Review*, 33 S.D. L. REV. 469, 475–81 (1988).

137. Gene Quinn, *Supremes End Federal Circuit Love Affair with De Novo Review*, IPWATCHDOG (Jan. 20, 2015), <http://www.ipwatchdog.com/2015/01/20/supremes-end-federal-circuit-love-affair-with-de-novo-review/id=53873/>; see also Paul R. Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1820–21, 1831–36 (2013) (explaining that the court often gives little deference to the USPTO and district courts).

138. *Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc.*, 701 F.3d 1351, 1362 (Fed. Cir. 2012) (dissenting opinion).

139. *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (“We hold that the appellate court must apply a ‘clear error,’ not a *de novo*, standard of review.”).

doing so.<sup>140</sup> If this is the case, the court is obviously justified in its practice.

Even though the Federal Circuit decides fewer cases than other circuits, most agree that the subject matter the court deals with can be quite complicated.<sup>141</sup> Combine the complicated nature of the court's cases with the increase in appeals from the PTAB and you get the perfect recipe for justifying an increased use of summary affirmance.

### *C. Panel Collegiality*

An additional contributing factor could be an attempt to maintain panel collegiality. Judges care about collegiality on the bench.<sup>142</sup> And on a court that works in panels, disagreement is uncomfortable and often results in additional work, such as issuing an opinion. Summary affirmance provides a means to avoid this extra work while creating unanimity. Additionally, judges may have strategic goals beyond articulating the law or promoting ideological preferences.<sup>143</sup> For example, a judge may desire to be in the majority, further the aims of the court at large, "or build[] capital for future cases."<sup>144</sup>

### *D. Inadequate Briefing*

Another factor could be inadequate party briefing. Many are of the view that judges should answer only the questions explicitly

140. See Ryan Davis, *Fed. Circ.'s Embrace of PTAB to Fuel More AIA Reviews*, LAW360 (Mar. 8, 2016, 1:41 PM), <https://www.law360.com/articles/767549> ("The purpose of writing an opinion is to provide guidance to the lower courts and litigants. . . . If all the Federal Circuit is doing is reviewing a fact-intensive determination on settled legal principles, there may be no guidance to be given and less use for a written opinion.") (internal quotations omitted).

141. See Jennifer F. Miller, *Should Juries Hear Complex Patent Cases?*, 4 DUKE L. & TECH. REV. 1, 13 (2004) ("Patent litigation involves some of the most complex legal theories and underlying factual issues of any type of litigation today.").

142. See VIRGINIA A. HETTINGER, STEFANIE A. LINDQUIST & WENDY L. MARTINEK, *JUDGING ON A COLLEGIAL COURT: INFLUENCES ON FEDERAL APPELLATE DECISION MAKING* 112 (2006).

143. See generally LEE EPSTEIN & JACK KNIGHT, *THE CHOICES JUSTICES MAKE* (1998) (discussing the strategic model of judicial decision-making).

144. Harry T. Edwards, *The Effects of Collegiality on Judicial Decision Making*, 151 U. PA. L. REV. 1639, 1653 (2003). To clarify, Judge Edwards opposes this view of strategic judicial decision-making. See *id.* at 1645-46.

presented before the court.<sup>145</sup> If parties fail to adequately brief important, unanswered questions, fault arguably rests with the litigants and not the court.<sup>146</sup> Summary affirmance may be perfectly appropriate if the potential for legal precedent is abolished by insufficient or scanty briefing.<sup>147</sup>

### *E. Cert-Proofing*

Although the aforementioned factors may be the causes of the Federal Circuit's high summary affirmance rate, below, I consider one additional hypothesis that, if true, is a cause of great concern and certainly justifies the call for reducing the court's summary affirmance rate: "cert-proofing." By issuing a summary affirmance, the court potentially shields the case from future Supreme Court review.<sup>148</sup> While this hypothesis likely does not fully explain the court's practice, it is a plausible factor in light of the recent relationship between the Federal Circuit and the Supreme Court.<sup>149</sup>

As shown in section II.B, multiple cases recently appealed to the Federal Circuit present interesting questions of law. The Federal Circuit's summary affirmances with respect to these issues not only hindered development of the law but they limited Supreme Court

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145. See Sarah M.R. Cravens, *Involved Appellate Judging*, 88 MARQUETTE L. REV. 251, 254-55 (2004).

146. See *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 800 (Fed. Cir. 1990) ("[A]n issue not raised by an appellant in its opening brief . . . is waived"); *Cubic Def. Sys., Inc. v. United States*, 45 Fed. Cl. 450, 467 (1999) ("Any experienced appellate litigator knows that issues not raised in a brief are waived.").

147. The complexity of patents aside, it is difficult to see why patent litigators would be significantly worse at briefing issues than other civil litigators practicing before the other circuit courts of appeals where summary affirmance rates are much lower.

148. See Marla Brooke Tusk, Note, *No-Citation Rules as a Prior Restraint on Attorney Speech*, 103 COLUM. L. REV. 1202, 1216 (2003) ("There is even some speculation that, because the Supreme Court is less likely to grant certiorari to an appeal from an unpublished opinion, appellate judges may decide controversial cases via unpublished opinions simply to insulate those decisions from Supreme Court review.").

149. I note that I am not the first to suggest that the Federal Circuit may inappropriately be using Rule 36 summary affirmance. See Paul Stancil, *Cert-Proof 97-98* (J. Reuben Clark Law Sch., Brigham Young U., Research Paper No. 16-05, Mar. 29, 2016), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2756112](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2756112); Matthew Bultman, *Fed. Cir. Asked to Decide When Appeals Require Opinion*, LAW360 (Mar. 1, 2017, 6:57 PM), <https://www.law360.com/articles/897013/fed-circ-asked-to-decide-when-appeals-require-opinion>. I, like Professor Paul Stancil, cannot definitively say that the Federal Circuit uses summary affirmance to reduce the likelihood of Supreme Court review. I merely present cert-proofing as a plausible theory.

review. A summary disposition is less likely to warrant review by the Supreme Court.<sup>150</sup> This is particularly true in the context of Federal Circuit summary affirmances because such cases lack precedential value.<sup>151</sup> The Supreme Court is unlikely to consider a case void of precedential value. Not only is such a case assumed to lack significant questions of law, but the Court would be required to expend extra time and resources to determine if an important, cert-worthy question exists.<sup>152</sup>

Because Rule 36 cases are unlikely to be reviewed by the Supreme Court and given that tension seems to exist between the Federal Circuit and the Supreme Court,<sup>153</sup> one could argue that the Federal Circuit may be using summary affirmance as a means of “cert-proofing” cases. No appellate court enjoys being overruled.<sup>154</sup> This general statement holds true for the Federal Circuit. Multiple scholars have pointed out that there appears to be a growing tension between the Supreme Court and the Federal Circuit.<sup>155</sup> From its inception, the Federal Circuit has recognized its unique role in patent law jurisprudence and asserted its position in developing the law.<sup>156</sup> Yet in the last decade, the Supreme Court has

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150. Stancil, *supra* note 149, at 24; *see also* Rachel Hughey, *How to Get to Federal Circuit Rule 36*, LAW360 (July 29, 2015, 10:19 AM), <http://www.law360.com/articles/684264/how-to-get-to-federal-circuit-rule-36> (“A Rule 36 affirmance is nearly impossible to obtain rehearing or rehearing en banc, or seek U.S. Supreme Court certiorari, because there is no appellate decision to challenge.”).

151. *Rates Tech., Inc. v. Mediatix Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012) (citing *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir. 1997)).

152. Stancil, *supra* note 149, at 24.

153. Daniel Kazhdan, *Beyond Patents: The Supreme Court's Evolving Relationship with the Federal Circuit*, 94 J. PAT. & TRADEMARK OFF. SOC'Y 275, 276 (2012).

154. *See* MARK HERRMANN, *THE CURMUDGEON'S GUIDE TO PRACTICING LAW* 4 (2006) (“Judges do not like to be reversed. Accordingly, if a precedent contains the implicit threat of reversal, I will use that threat (gently, of course) when I discuss that case. . . .”).

155. *See, e.g.*, Arthur J. Gajarsa & Lawrence P. Cogswell, III, *The Federal Circuit and the Supreme Court*, 55 AM. U. L. REV. 821, 844 (2006) (discussing how the Federal Circuit is potentially becoming the “‘Ninth Circuit’ of the twenty-first century”); Gretchen S. Sween, *Who's Your Daddy? A Psychoanalytic Exegesis of the Supreme Court's Recent Patent Jurisprudence*, 7 NW. J. TECH. & INTELL. PROP. 204 (2009).

156. Debra D. Peterson, *Can This Brokered Marriage Be Saved? The Changing Relationship Between the Supreme Court and Federal Circuit in Patent Law Jurisprudence*, 2 J. MARSHALL REV. INTELL. PROP. L. 201, 210–11 (2003).

attempted to “rein in” the Federal Circuit.<sup>157</sup> Beginning in 2005, the Supreme Court reversed a trend of avoiding patent cases, hearing twenty-seven cases over the next ten years and overturning the Federal Circuit’s holding in twenty-two of those cases.<sup>158</sup>

One strong example highlighting the conflict between the courts is the debate over the patentability of isolated human genes. In 2011, the Federal Circuit decided a case in favor of patentability of isolated DNA strands.<sup>159</sup> The Supreme Court remanded the case, instructing the Federal Circuit to consider the Court’s recent restriction on the scope of patent-eligible subject matter. On remand, the Federal Circuit reached the same result as in 2011 using much of the same analysis.<sup>160</sup> As one law professor stated, “The Federal Circuit wrote the same decision twice.”<sup>161</sup> Not surprisingly, the Supreme Court reviewed the case and unanimously reversed the decision of the Federal Circuit.<sup>162</sup> The remarks of Chief Justice John Roberts effectively summarize the tug-of-war relationship between the courts evident in the example just described. Speaking of the circuit courts of appeals, the Chief Justice said, “Well, they don’t have a choice, right? They can’t say, I don’t like the Supreme Court rule so I’m not going to apply it, *other than the Federal Circuit.*”<sup>163</sup>

The theory that the court uses summary affirmance to cert-proof its decisions is not without flaws, the biggest being that the Federal Circuit may have summarily affirmed each case for a legitimate reason (i.e., an opinion would have no precedential

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157. Steven Seidenberg, *Tug-of-War over Interpretations of Patent Law Continues Between Federal Circuit and SCOTUS*, A.B.A. J. (Jan. 1, 2016, 3:00 AM), [http://www.abajournal.com/magazine/article/tug\\_of\\_war\\_over\\_interpretations\\_of\\_patent\\_law\\_continues\\_between\\_federal](http://www.abajournal.com/magazine/article/tug_of_war_over_interpretations_of_patent_law_continues_between_federal).

158. *Id.*

159. *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 653 F.3d 1329, 1351 (Fed. Cir. 2011), *cert. granted, judgment vacated sub nom.*; *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 132 S. Ct. 1794 (2012), and *opinion vacated, appeal reinstated sub nom.*; *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 467 F. App’x 890 (Fed. Cir. 2012).

160. *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 689 F.3d 1303 (Fed. Cir. 2012), *aff’d in part, rev’d in part sub nom.*; *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

161. Seidenberg, *supra* note 157.

162. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

163. Transcript of Oral Argument at 18, *Carlsbad Tech., Inc. v. HIF BIO, Inc.*, 556 U.S. 635 (2009) (No. 07-1437) (emphasis added).

value and the trial court or administrative agency correctly decided the case). Qualifying for summary disposition is not an easy task. A party must show that its position “is so clearly correct as a matter of law that no substantial question regarding the outcome of the appeal exists.”<sup>164</sup> This high bar checks the courts from disposing of meritorious questions of law. Yet, as the case sampling herein reveals, it seems likely that substantial questions of law have been ignored by the Federal Circuit.<sup>165</sup>

An additional counter-argument against the idea of cert-proofing is that no case is ever truly cert-proofed. “[T]he Court grants certiorari to review unpublished and summary decisions with some frequency.”<sup>166</sup> As recently as 2015, the Supreme Court reviewed an appellate summary affirmance decision.<sup>167</sup> The Justices themselves have noted that an unpublished opinion—the effect of which is similar to a summary affirmance—sometimes signals to the Court the need for review.<sup>168</sup> Although the Court certainly can and does sometimes review summarily affirmed cases, the simple truth is that the likelihood of granting such review is decreased.<sup>169</sup> Since the inception of the AIA, no summarily affirmed Federal Circuit case has generated certiorari from the Supreme Court.

A survey of cert petitions emerging from cases summarily affirmed by the Federal Circuit reveals the potential for cert-proofing. I have chosen to examine three cases—*Hyundai Motor America, Inc. v. Clear with Computers, LLC*; *Cloud Satchel, LLC v. Barnes & Noble, Inc.*; and *Luv N’ Care Ltd. v. Munchkin, Inc.*—to illustrate this point.

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164. *Joshua v. U.S.*, 17 F.3d 378, 380 (Fed. Cir. 1994).

165. Even if “substantial” questions of law are not being ignored, “cases are rarely identical and it can be argued that a rule of law develops and gains certainty in the frequency and changing circumstances in which it is expressed and applied.” Simonett, *supra* note 101, at 199.

166. STEPHEN M. SHAPIRO ET AL., *SUPREME COURT PRACTICE* 264 (10th ed. 2013).

167. See *Christeson v. Roper*, 135 S. Ct. 891 (2015).

168. See *Plumley v. Austin*, 135 S. Ct. 828, 831 (2015) (Thomas, J., dissenting from denial of certiorari) (noting that the decision not to publish was “another reason to grant review”).

169. See Stancil, *supra* note 149, at 24 (arguing that a summary affirmance is unlikely to generate certiorari because (1) the Court may be influenced by the traditional understanding that such opinions are less important and (2) the Court will have to invest additional time and energy to determine if a cert-worthy issue is present).

Before proceeding, I wish to clarify that I do not intend to suggest that the Federal Circuit is consistently and blatantly seeking to evade Supreme Court review. It is unlikely that cert-proofing is the driving explanation for the court's summary affirmance rate. I simply argue that it is plausible that a panel may dispose of a case (or group of cases related to the same issue) using summary affirmance hoping, be it consciously or subconsciously, that the case will not find its way to the Supreme Court.<sup>170</sup>

### 1. Hyundai Motor America, Inc. v. Clear with Computers, LLC

Clear with Computers, LLC (CWC) filed a patent infringement suit against Hyundai Motor America, Inc. (HMA), alleging that HMA infringed on a patent for an electronic proposal preparation system. CWC secured an \$11.6 million judgment in the district court. This suit represented CWC's sixth attempt to sue HMA, each suit being a variation on the same theme, and all prior suits were resolved in HMA's favor.<sup>171</sup> At trial and on appeal, HMA argued that prior to the filing of CWC's patent application, "the marketplace was awash in electronic proposal" preparation systems.<sup>172</sup> HMA also objected to jury instruction that HMA bears the burden of proving invalidity by the clear and convincing evidence standard.<sup>173</sup> HMA contended that such a standard to patent invalidity, without distinguishing between factual and legal aspects of the inquiry, conflicts with Supreme Court precedent. Specifically, a clear and convincing evidence standard should apply only to factual matters, such as whether a prior art reference had been published, and should not be considered in determining

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170. Regardless of the court's intentions, it should be reemphasized that litigation costs and legal ambiguities could be reduced if the court took a hard look at its summary affirmance habit.

171. Brief for Appellant at 1, *Clear with Computers, LLC v. Hyundai Motor America, Inc.*, No. 2012-1291 (Fed. Cir. June 27, 2012), 2012 WL 9082954, at \*1.

172. *Id.* at 3.

173. *Id.* at 66.

how to apply the law to the facts.<sup>174</sup> HMA also raised an interesting question concerning the “anticipation doctrine.”<sup>175</sup>

The Federal Circuit passed over the opportunity to decide the validity of non-practicing inventors’<sup>176</sup> method patents and the proper extent of the “anticipation doctrine” in modern patent law. In its petition for writ of certiorari, HMA argued that there was no justification for the Federal Circuit’s “one-line summary affirmance.”<sup>177</sup> HMA found the court’s summary affirmance egregious given that Congress established the Federal Circuit for the express purpose of promoting unity in patent law, and the court’s one-line decisions leaves parties and the lower courts in confusion.<sup>178</sup>

HMA’s pleas for review did not resonate with the Supreme Court as its petition for certiorari was denied. Like with many cert denials, one cannot know exactly why the Supreme Court chose to deny HMA’s petition. However, given that the Supreme Court has been reluctant to review summarily disposed cases, it is likely that the Federal Circuit’s summary affirmance played a role in the denial of HMA’s cert petition.

## 2. *Cloud Satchel, LLC v. Barnes & Noble, Inc.*

In *Cloud Satchel, LLC v. Barnes & Noble, Inc.*, a district court invalidated a patent for memory-conserving wireless exchange of documents between a handheld device and remote database. Cloud Satchel questioned whether the district court correctly applied the

174. *Microsoft Corp. v. I4I Ltd. P’ship*, 564 U.S. 91, 114 (2011) (“[I]n this area of law as in others the evidentiary standard of proof applies to questions of fact and not to questions of law.”).

175. *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.”) (internal citation omitted).

176. In other words, “patent trolls.” “A patent troll uses patents as legal weapons, instead of actually creating any new products or coming up with new ideas. Trolls are in the business of litigation (or even just threatening litigation). They often buy up patents cheaply from companies down on their luck who are looking to monetize what resources they have left, such as patents.” *Patent Trolls*, ELECTRONIC FRONTIER FOUNDATION, <https://www.eff.org/issues/resources-patent-troll-victims>.

177. Petition for Writ of Certiorari at 26, *Hyundai Motor America, Inc. v. Clear with Computers, LLC*, 134 S. Ct. 619 (2013) (No. 13-296).

178. *Id.* at 29.

two-step analysis required by *Alice Corporation v. CLS Bank* and argued that the Federal Circuit's use of Rule 36 to affirm the district court's ruling defies the right to appeal set forth in 28 U.S.C. § 1295(a). In its petition for certiorari, Cloud Satchel argued that "[t]he most prevalent and significant issue facing litigants of patent rights today is the proper application of [the Supreme] Court's decision in *Alice* to cases involving computer and internet technology."<sup>179</sup> The Federal Circuit's brief affirmance of the lower court's decision skirted this "significant issue."<sup>180</sup> As the lone patent law gatekeeper below the Supreme Court, the Federal Circuit shirked its responsibility when it failed to provide "a reasoned opinion that would provide the parties . . . [and] the district courts additional guidance on how to avoid improperly applying *Alice*."<sup>181</sup> Cloud Satchel argued that the Federal Circuit's use of summary affirmance "has reduced the right to appeal . . . to simply a right to a hollow affirmation of an improper lower court opinion."<sup>182</sup>

The general reception toward *Alice* was that the Court failed to provide sufficient guidance for future cases.<sup>183</sup> *Cloud Satchel* presented the Supreme Court with an opportunity to clearly define principles such as the boundary between abstract ideas and patent-eligible implementations of ideas. Nonetheless, the Court denied Cloud Satchel's petition for certiorari.<sup>184</sup> Although multiple factors may have contributed to the cert denial, the Federal Circuit's summary affirmance likely created a hurdle the Court chose not to jump.

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179. Petition for Writ of Certiorari at 34, *Cloud Satchel, LLC v. Barnes & Noble, Inc.*, 136 S. Ct. 1723 (2016) (No. 15-1161).

180. For a list of other cases where this has been raised and summarily affirmed by the Federal Circuit, see Harter & Quinn, *supra* note 10.

181. Petition for Writ of Certiorari, *supra* note 179, at 35.

182. *Id.*

183. See Brian Fung, *The Supreme Court's Decision on Software Patents Still Doesn't Settle the Bigger Question*, WASH. POST (June 20, 2014), <https://www.washingtonpost.com/news/the-switch/wp/2014/06/20/the-supreme-courts-decision-on-software-patents-still-doesnt-settle-the-bigger-question/> ("[T]he court decided the most basic conflict in the case, but more or less declined to offer guidance for other, future cases."); Rob Merges, *Symposium: Go Ask Alice—What Can You Patent After Alice v. CLS Bank?*, SCOTUSBLOG (June 20, 2014, 12:04 PM), <http://www.scotusblog.com/2014/06/symposium-go-ask-alice-what-can-you-patent-after-alice-v-cls-bank/> ("To say we did not get an answer is to miss the depth of the non-answer we did get.").

184. *Cloud Satchel, LLC v. Barnes & Noble, Inc.*, 136 S. Ct. 1723 (2016).

### 3. *Luv N' Care Ltd. v. Munchkin, Inc.*

*Luv N' Care Ltd. v. Munchkin, Inc.* presented a number of meritorious issues. First, the case came to the Federal Circuit on appeal from an IPR proceeding before the PTAB. Additionally, the case represented the first IPR of a design patent. The PTAB instituted review on obviousness grounds of a patent directed to the ornamental design for a drinking cup. During the proceeding, the PTAB rejected an argument that the references used to challenge Luv N' Care's (LNC) patent were not prior art. The PTAB also denied LNC's motion to amend a claim, finding that such an amendment would improperly enlarge the claimed subject matter. The latter issue is particularly interesting given that the Federal Circuit had offered little to no guidance on the requirements for amending claims during an IPR proceeding. On appeal to the Federal Circuit, LNC argued that the PTAB unfairly introduced new issues in its final written decision in violation of due process rights and the Administrative Procedure Act (APA).<sup>185</sup> Despite the importance and novelty of the issues, the Federal Circuit affirmed the PTAB's decision without an opinion.<sup>186</sup>

In its petition for certiorari, LNC sought review of its case by arguing that the PTAB inappropriately conducted the administrative trial, denying petitioner due process guarantees. Again, the Supreme Court denied the petition.<sup>187</sup> Because the antedating references and motion to amend claims issues were not preserved on appeal, it is very unlikely that the Supreme Court would have decided those issues.<sup>188</sup> However, the confluence of the APA and due process rights, as they relate to raising new issues in a final decision, is something the Supreme Court would perhaps deem warranting judicial review. Yet again, it would seem that the Federal Circuit's summary affirmance may have provided the necessary insulation from the Supreme Court.

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185. Petition for Writ of Certiorari at 20-24, *Luv n' Care, Ltd. v. Munchkin, Inc.*, 136 S. Ct. 405 (2015) (No. 15-242).

186. Granted, *Luv N' Care* did not challenge the PTAB's denial of its motion to amend on appeal.

187. *Luv N' Care, Ltd. v. Munchkin, Inc.*, 136 S. Ct. 405 (2015).

188. SUP. CT. R. 14 ("Only the questions set out in the petition, or fairly included therein, will be considered by the Court.").

In short, in each of these cases, though multiple factors likely played a role in the court's choice to invoke Rule 36, the potential for cert-proofing is apparent and deserving of attention.

#### IV. POSSIBLE SOLUTIONS

Although the purpose of this Comment is to highlight an issue in the Federal Circuit and not definitively propose solutions to the problem, some plausible solutions (and their shortcomings) are worth mentioning. These solutions by and large assume the court is using summary affirmance for the legitimate reason of reducing its caseload.<sup>189</sup>

One possible fix is to increase the number of Federal Circuit judges to handle the court's expanding caseload. This solution has been suggested as a means of assisting not only the Federal Circuit but the judiciary as a whole.<sup>190</sup> However, it is unlikely that the Federal Circuit will see an increase in the number of active judges in the near future.<sup>191</sup> The Federal Circuit is far from overburdened when comparing its caseload with that of the other circuits.<sup>192</sup> Not only is it unlikely that the Federal Circuit will see an increase in the number of active judges, but this solution is also not without

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189. If the court is using summary affirmance for illegitimate reasons, a more dramatic solution may be necessary.

190. Jennifer Bendery, *Federal Judges Are Burned Out, Overworked and Wondering Where Congress Is*, HUFFINGTON POST (Oct. 1, 2015, 2:15 PM), [http://www.huffingtonpost.com/entry/judge-federal-courts-vacancies\\_us\\_55d77721e4b0a40aa3aaf14b](http://www.huffingtonpost.com/entry/judge-federal-courts-vacancies_us_55d77721e4b0a40aa3aaf14b) ("The last time Congress passed a major judgeship bill was in 1990. Since then, there's been a 39 percent increase in filings at district and circuit courts but only a 4 percent increase in judgeships. The Judicial Conference recommended in March that Congress create 77 more judgeships for district courts and five more for circuit courts to keep up with current workloads.").

191. Michel, *supra* note 57, at 1190 ("Similarly, it is unlikely that the complement of authorized, active judges on the court, which now stands at twelve, will ever be increased. The total number of cases decided per year by the court is already considerably less than other circuits."). Perhaps the complexity of the court's docket would justify increasing the number of judges. But again, this is unlikely.

192. See, e.g., Table B-8. *United States Court of Appeals for the Federal Circuit – Appeals Filed, Terminated, and Pending During the Twelve-Month Period Ended September 30, 2015*, U.S. CT. APPEALS FOR FED. CIR. (2015), [http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/appeals\\_filed\\_terminated\\_and\\_pending.pdf](http://www.cafc.uscourts.gov/sites/default/files/the-court/statistics/appeals_filed_terminated_and_pending.pdf) (showing that 1711 cases were filed in the Federal Circuit between September 30, 2014, and September 30, 2015); *U.S. Courts of Appeals Federal Court Management Statistics (June 30, 2016)*, U.S. CTS. (2016), <http://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2016/06/30-2> (showing, for example, that 8675 cases were filed in the Fifth Circuit during the 2015 fiscal year).

serious institutional flaws. Enlarging the size of the judiciary increases inefficiencies, internal conflicts, and uncertainty in legal outcomes.<sup>193</sup>

Another potential solution to resolving the court's overburdened docket, and the consequential inability to issue a written decision in many of its cases, is to decentralize patent law's uniformity. The Federal Circuit was designed to clarify ambiguities in patent law jurisprudence.<sup>194</sup> Although the court may, in part, be achieving this goal, it is far from perfect in creating a unified body of law. Some empirical studies suggest that the Federal Circuit is often divided, much like other circuit courts who are often split on areas of the law.<sup>195</sup> Dividing patent jurisdiction could serve the beneficial effect of creating circuit splits that allow for experimentation and for appellate courts to make informed decisions regarding which interpretation to follow. However, the fact cannot be denied that patent disputes are often best handled by those with particular expertise. Patent law is quite technical, and there is a real danger in allowing other circuit courts to adjudicate patent appeals.<sup>196</sup> Furthermore, patent attorneys, examiners, and bureaucrats are likely to resist any attempt to restore patent jurisdiction to the regional circuit courts. For these reasons, many commentators

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193. Harvie J. Wilkinson III, *We Don't Need More Federal Judges*, WALL STREET J. (Feb. 9, 1998, 12:01 AM), <http://www.wsj.com/articles/SB886954981630694500> (explaining that the consequences of increasing the size of the judiciary include inefficiency, litigiousness, and intrusiveness).

194. See S. Rep. No. 97-275, at 5 (1981) ("The . . . [c]ommission singled out patent law as an area in which the application of the law to the facts of a case often produces different outcomes in different courtrooms in substantially similar cases.").

195. See, e.g., Petherbridge, *supra* note 15, at 466 ("[I]t is at least possible that areas of law within the Federal Circuit's jurisdiction might actually have more variety than a comparative area of law subject to regional circuit jurisdiction."); R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105, 1176-78 (2004) (calling for "evangelism" among individual judges to resolve a methodological split); Patricia Martone, *Why Is the Fed. Cir. So Deeply Divided on Patent Cases?*, LAW360 (Oct. 13, 2015, 6:29 PM), <http://www.law360.com/articles/712916/why-is-the-fed-circ-so-deeply-divided-on-patent-cases> ("[T]he outcome of an appeal has long been quite dependent on the panel hearing the case. The disagreements have just become more prominent.").

196. Shapiro, *supra* note 96.

are “skeptical that the Federal Circuit will be stripped of its patent jurisdiction anytime soon.”<sup>197</sup>

The Supreme Court could further check the Federal Circuit’s obsession with de novo review.<sup>198</sup> Doing so would ideally free up time needed to publish an opinion in those summarily affirmed cases deserving a written decision. However, given the recency of the Court’s admonition to limit de novo review,<sup>199</sup> it seems unlikely that the Court will step in and further chastise the Federal Circuit. Furthermore, the reality is that patent law disputes are highly fact intensive and some level of de novo review is arguably needed to effectively resolve certain cases appealed to the Federal Circuit.<sup>200</sup>

A final solution<sup>201</sup> to deal with the Federal Circuit’s growing caseload is to publish shorter per curiam opinions that briefly explain the essential rationale for a decision. Because judges are identified as the authors of judicial opinions, they often feel pressured to produce lengthy, scholarly opinions.<sup>202</sup> One former Federal Circuit judge has reasoned that perhaps as much as half of the delay in the average case can be attributed to the human factor of the opinion process.<sup>203</sup> Published per curiam opinions could help save the court’s time, thus allowing judges to issue more published opinions whilst simultaneously giving the court a chance to explain its reasoning.

A per curiam opinion puts forth the rationale agreed upon by all three members of a panel of judges.<sup>204</sup> Per curiam opinions, if published, can have the binding force of law and function as precedent just as authored, published opinions do.<sup>205</sup> However, per curiam opinions may be shorter, and because the opinion is

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197. Paul R. Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 GEO. L.J. 1437, 1464 (2012); see LAWRENCE BAUM, *SPECIALIZING THE COURTS* 229 (2011).

198. See *supra* Section III.A.

199. *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015).

200. See J. Jonas Anderson, *Specialized Standards of Review*, 18 STAN. TECH. L. REV. 151, 165–87 (2014) (discussing the Federal Circuit’s use of the de novo standard of review).

201. Professor Dennis Crouch recommends an additional fix: require the Federal Circuit to write opinions in all appeals stemming from PTO actions. Crouch, *supra* note 9, at \*26–27; *Petition for Writ of Certiorari at 11, Shore v. Lee*, 137 S. Ct. 2197 (2017) (No. 16-1240), 2017 WL 1406097. Given his coverage of this solution, I do not address it here.

202. Michel, *supra* note 57, at 1201.

203. *Id.*

204. *Id.* at 1202.

205. *Id.*

unanimous, often less time is taken by individual judges drafting and editing the opinion. The Federal Circuit rarely uses per curiam opinions to hand down precedential decisions.<sup>206</sup> The court could reverse this trend and use published per curiam opinions to decide Rule 36 summary affirmance cases—cases in which the judges already unanimously agree on the outcome. If the court really is using summary affirmance as a tool to cert-proof cases, then the per curiam opinion fix would help resolve the issue because published per curiam opinions that even tersely declare the law are less likely to avoid Supreme Court review.

#### V. CONCLUSION

The Federal Circuit's decision-making has been under fire since the court's inception. Yet little has been written about the court's summary affirmance practice. The court has employed Rule 36 more frequently than ever, likely as a result of the court's increasing caseload. The passage of the AIA and the creation of new post-grant proceedings has only added to the court's burden. While the court's use of Rule 36 may be understandable given the number of complex appeals pending on the docket, the Federal Circuit's summary affirmance practice functions as a detriment to the development of the law. Although it is impossible to understand exactly why the court is using summary affirmance at such a high rate, the court's habit of de novo review, attempts to maintain panel collegiality, and poor party briefing may be contributing factors. One additional, plausible theory is that the Federal Circuit occasionally uses summary affirmance as a tool to cert-proof cases. This hypothesis is reasonable given the Federal Circuit's strained relationship with the Supreme Court, but it almost certainly does not fully explain the problem. The purpose of this Comment is not to fully resolve the issues created by the Federal Circuit's summary affirmance practice but simply functions to point out the problems and plausible causes. Future research can postulate a proper method for fixing these issues.

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206. *Id.*

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