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# Justices Seem Less Receptive To SG's Take On IP Cases

By **Dani Kass**

*Law360 (November 10, 2022, 9:09 PM EST)* -- The U.S. Supreme Court has decided to review a patent case about enablement that the solicitor general explicitly recommended against, a move attorneys found surprising, especially given the justices' unprecedented decision to deny a patent eligibility case the government backed just months before.

Over the last 40 years, there have only been five patent cases where the justices made a different call about whether to hear a case from what the solicitor general recommended. When the Supreme Court announced Nov. 4 that it'd be reviewing Amgen v. Sanofi over the government's recommendation to deny, attorneys said it was unexpected, as the court's docket is limited and the justices generally rely on the solicitor general's expertise.

"When the solicitor general says, 'take a case,' and [the justices] don't, there [are] lots of reasons to not take a case," said McKool Smith principal Nicholas Matich. "But to say 'yes, we wanted to hear this issue' when the solicitor general said 'don't' in this case, is interesting and surprising."

**Justices Reject Solicitor General's Take in 5 Patent Cases**

| Year SG Filed | Case Name | SG's Recommendation | Justices' Decision |
|---|---|---|---|
| 2000 | J.E.M. Ag Supply v. Pioneer Hi-Bred | Deny | Granted |
| 2004 | LabCorp v. Metabolite Laboratories | Deny | Granted |
| 2011 | Vernon Hugh Bowman v. Monsanto | Deny | Granted |
| 2022 | American Axle v. Neapco | Grant | Denied |
| 2022 | Amgen v. Sanofi | Deny | Granted |

None of the justices have backgrounds in patent law, and due to the national jurisdiction of the Federal Circuit, they don't get the benefit of hearing about the issue from opposing circuit courts. The solicitor general's office can be there to help in situations like this, as its attorneys are neutral, have patent experience and a deep understanding of what makes a good case for the high court.

"They're not just good appellate lawyers, they're good Supreme Court lawyers," said Temple University's Beasley School of Law professor Paul Gugliuzza. "They know the ins and outs of Supreme Court procedures and decision-making in a way that very few lawyers in private practice do."

The justices actively asked for the solicitor general's help on Amgen, the enablement case, and an eligibility case, American Axle v. Neapco.

Since the Federal Circuit opened 40 years ago, the justices have adopted the solicitor general's recommendation in patent cases 91% of the time, according to data from Gugliuzza. That's higher than the percentage of cases overall, which, albeit only accounting for cases between 2002 and October 2021, had the Supreme Court agreeing with the government 80% of the time.

Between 1982 and 2021, the Supreme Court and the solicitor general had only disagreed on granting patent petitions three times, the data shows. The government in 2000, 2004 and 2011 briefs recommended a denial, and the court granted the cases anyway.

In June 2022, the court refused American Axle, the highly anticipated patent eligibility case that had a ringing endorsement from the solicitor general, who noted that even the Federal Circuit admits it needs help. In September, the solicitor general said Amgen v. Sanofi had been decided properly.

While what happened in Amgen has been more common historically, the combination of the two cases in one year raised eyebrows.

"There's two stories you can tell about that. One is potentially a story about the court refusing to follow the SG's recommendation," Gugliuzza said, adding that it fits into the larger image of a conservative-leaning court not wanting to defer to the executive branch. "But you could also tell this as a story about the SG. I think there's an argument to be made both in American Axle and in Amgen that the SG has made the wrong recommendation."

The Supreme Court has been asked to tackle patent eligibility countless times since it released a series of rulings on the topic from 2010 to 2014, but has always declined. Attorneys saw promise in American Axle, where a drive-shaft patent had been invalidated for being directed to a law of nature, causing vocal division at the Federal Circuit. The solicitor general's support had further raised hopes.

Over the last 20 years, the solicitor general has urged the court to take up just over a quarter of all cases it was asked to review, showing that the office's attorneys are "very deliberate" about what they recommend, according to Gugliuzza.

"It's a recommendation the SG doesn't take lightly," he said.

Attorneys say American Axle, while enticing, would have opened a can of worms for the justices, without actually getting at what practitioners want: clarity on diagnostics and software patents.

But that doesn't explain why the solicitor general didn't recommend one of the many other cases on

deck, such as the government did in 2019 when it told the Supreme Court to take up Athena v. Mayo rather than Hikma v. Vanda in a diagnostics patent fight. The court ultimately rejected both petitions.

"I don't think the court has much of an appetite to wade back into the waters of patent eligibility," said Withers partner Gina Bibby. "What it will take for them to satisfy the desires of the patent bar and lower courts is to revamp their patent eligibility doctrine. I think they just don't want to go down that rabbit hole."

The novelty of an enablement case may be why the Supreme Court thought it was still worth pursuing Amgen, Bibby said. While the Supreme Court has tackled enablement under an older version of the patent act, it hasn't taken up an enablement case under the Patent Act of 1952.

"We can sit back and think about all the reasons why the Supreme Court is doing what it's doing, but ultimately we may never know," she said. "I think it's safe to say that they don't want to wade into the patent eligibility pool because they've done that numerous times in the last several years. [But] they haven't done it with respect to enablement."

The question over when a patent is enabled is also an issue that has been "really a mess" for some time, furthering its appeal, Gugliuzza said.

Frustratingly, it's impossible to know what happened inside the solicitor general's office behind the scenes — such as who was making the decisions and what discussions they had — because all the public sees is its brief, said University of California, Berkeley School of Law professor Tejas Narechania.

"We'd think that these sorts of policy decisions should be informed by our usual process constraints, including things like transparency and public feedback," Narechania said. "[The solicitor general is] effectively setting patent policy because so much patent policy happens to be made through litigation."

The Department of Justice didn't respond to a request for comment.

--Editing by Emily Kokoll.