

2016-17 Wrap-Up

PREVIEW

OF UNITED STATES SUPREME COURT CASES



U.S. SUPREME COURT October 2017 **Calendar**

MONDAY

October 2

EPIC SYSTEMS CORP. V. LEWIS

ERNST & YOUNG LLP V. MORRIS

NLRB V. MURPHY OIL USA

(CONSOLIDATED – 1 HR. FOR ARGUMENT),

SESSIONS, ATT'Y GEN. V. DIMAYA

(REARGUMENT)

October 9

Legal Holiday

TUESDAY

October 3

GILL V. WHITFORD

JENNINGS V. RODRIGUEZ

(REARGUMENT)

October 10

*TRUMP, PRESIDENT OF U.S. V. INT'L
REFUGEE ASSISTANCE*

TRUMP, PRESIDENT OF U.S. V. HAWAII

(CONSOLIDATED – 1 HR. FOR ARGUMENT)

*HAMER V. NEIGHBORHOOD HOUSING
SERVICES OF CHICAGO*

WEDNESDAY

October 4

DISTRICT OF COLUMBIA V. WESBY

CLASS V. UNITED STATES

October 11

*NATIONAL ASS'N OF
MANUFACTURERS V. DEPT. OF
DEFENSE*

JESNER V. ARAB BANK

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Division for
Public Education

(More) Change in the Patent System

by Kelly Casey Mullally and Coby S. Nixon

In each of its recent Terms, the Supreme Court has taken on a number of cases dealing with intellectual property issues. Many of those decisions resulted in significant changes to the legal landscape, particularly for the patent system. The 2016–2017 Term was no different. The justices issued eight decisions dealing with patents, copyrights, or trademarks, making up over 10 percent of the Court’s docket. Six of those decisions focused on patent law, and the Court continued to make sweeping course corrections to the trajectory of patent law. As described below, the Court abolished the defense of laches as applied to claims for damages in patent cases, imposed new restrictions on the venues in which domestic corporate defendants may be sued for patent infringement, and put an end to patentees’ ability to contract around the patent exhaustion defense—in all cases, disrupting law that had existed for at least two decades and, in one case, over a century. The Court’s radical changes to such long-standing rules and practices serve as a cautionary reminder against treating anything in patent law as truly settled.

The Role of Laches in Resolving Patent Damages Claims

In a case argued early in the Term, the Court in *SCA Hygiene Products v. First Quality Baby Products, LLC* (Docket No. 15-927) addressed, and unsettled, the long-standing approach to the equitable defense of laches in patent law. Upending what Justice Breyer considered to be “a century and a half of history” recounted in his dissent, Justice Alito’s opinion for the 7-1 majority held that courts could not rely on a patentee’s unreasonable and prejudicial delay in filing suit as a basis to reject an infringement action brought within the six-year deadline allowed by the Patent Act. The decision overturned a practice that had been previously allowed by trial and intermediate appellate courts.

This patent case arose against the backdrop of a recent Supreme Court copyright case, *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. ___ (2014), which held that the equitable defense of laches could not be invoked to shorten the three-year statutory limit for obtaining legal relief in a copyright-infringement lawsuit. After that ruling, the U.S. Court of Appeals for the Federal Circuit, sitting en banc, decided that the Patent Act’s six-year statutory damages period presented different circumstances than those applicable to copyright law and held that its previous rule allowing laches to be applied to shorten the time for legal relief in a patent-infringement lawsuit continued to apply even after *Petrella*. In *SCA Hygiene*, the Supreme Court determined that this different outcome is not warranted in patent law.

The Court’s decision largely followed from *Petrella*. Justice Alito’s opinion began with a review of *Petrella* and its general principles, not specific to copyright law. In particular, he emphasized that congressional enactment of a statute of limitations, such as 35 U.S.C. § 286 of the Patent Act, specifically addresses the issue of timeliness in filing lawsuits and provides a rule for determining whether a claim is too late. In contrast, the Court had previously explained in *Petrella*

and again reaffirmed in *SCA Hygiene* that laches is a “gap-filling doctrine.” But “where there is a statute of limitations, there is no gap to fill.” Thus, to apply laches where Congress has spoken would give judges a “legislation-overriding” role that impermissibly expands the scope of the judiciary’s power.

Recognizing that the wording of the relevant copyright and patent statutes, respectively, are not identical, the Court nevertheless explained that the separation-of-powers principles of *Petrella* apply equally in the patent context. Both statutes constituted, in the majority’s view, a judgment by Congress that a claim filed within the stated time could not be dismissed on timeliness grounds. Section 286’s prohibition on suits filed more six years after the infringement was committed accordingly represented “a judgment by Congress that a patentee may recover damages for any infringement committed within six years of the filing of the claim.”

Reviewing the defendant’s arguments, Justice Alito found no basis for distinguishing *Petrella*. The Court also rejected the statutory interpretation and long line of lower court decisions that had grounded the appeals court decision. In disposing of lower courts’ application of laches to patent damages claims prior to enactment of the Patent Act (that would inform the background against which Congress acted), the Court held that such decisions did not override the general Supreme Court precedent “regarding the relationship between laches and statutes of limitations.” Indeed, it would take “nothing less than a broad and unambiguous consensus of the lower court decisions . . . [to] support the inference that . . . [the Patent Act] codified a very different patent-law-specific rule.” Reviewing at length the lower court decisions prior to the 1952 enactment of the modern patent code, the majority found no such consensus. The Court therefore concluded that there had been no uniform practice of applying laches to damages claims in the patent context at that time.

Justice Breyer filed a dissenting opinion. In contrast to the reasoning in Justice Alito’s opinion, he found a long-established, routine application of laches to damages claims in patent law, both before and after the 1952 Patent Act. While the majority focused on separation-of-powers concerns, Justice Breyer was sympathetic to the risks of abuse in the patent system. He expressed concern that, without laches, a patentee might be able to “wait for a decade or more while the infringer (who perhaps does not know or believe he is an infringer) invests heavily in the development of an infringing product (of which the patentee’s invention could be only a small component), while evidence that the infringer might use to, say, show the patent is invalid disappears with time.” The majority responded in a footnote, stating that applying laches based on misgivings about such undesirable outcomes was a matter of policy that *Petrella* had expressly disclaimed as outside the scope of the judicial role.

The majority’s decision removes a formerly robust defense for litigants accused of patent infringement that has occurred over many years. Laches can no longer be invoked to limit the recovery of

damages where the infringement took place within the Patent Act's six-year limitations period. By virtue of Justice Breyer's description of various strategic actions patentees may take in waiting to file suit and maximize the damages they can recover and the majority's direct response acknowledging those possibilities, *SCA Hygiene* provides a roadmap for just the concerns raised by Justice Breyer. Because the defense of laches is raised in a limited number of cases and additional defenses based on a patentee's delay remain available to defendants, however, the greatest practical impact of *SCA Hygiene* may be in signaling once again that the patent system cannot be overly comfortable in relying on even long-accepted doctrine not yet tested by the Supreme Court.

Where a Domestic Corporation “Resides” for Purposes of Venue in Patent Cases

In another decision displacing long-standing doctrine, *TC Heartland LLC v. Kraft Foods Group Brands LLC* (Docket No. 16-341) overturned the rules on venue applicable in patent lawsuits. In a unanimous opinion, the Court held that a domestic corporation “resides” only in its state of incorporation for purpose of the patent venue statute. The Court's ruling was a departure from the broader interpretation of corporate “residence” that courts had applied to patent infringement actions for over 25 years.

In reaching its conclusion, Justice Thomas focused his opinion for the Court on the history, both legislative and judicial, of the statutes relevant to the case. Initially, patent cases were governed by the venue rules of the Judiciary Act of 1789 generally applicable to civil lawsuits. In 1897, however, Congress enacted a patent-specific venue statute, permitting suit where a defendant was an “inhabitant.” At that time, a corporation was understood to “inhabit” only the state in which it was incorporated. Later, in 1948, Congress enacted what is still the current version of the patent venue statute, 28 U.S.C. § 1400(b). Section 1400(b) provides, “Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” The statute does not define corporate residence. The general venue statute, 28 U.S.C. § 1391, enacted at the same time as section 1400, does include a definition, however. Section 1391(c) extended “residence” to include “any judicial district . . . in which it is . . . licensed to do business.”

Supreme Court precedent on the initial and recodified patent venue statutes also developed over the years. In particular, the Court held in *Stonite Products Co. v. Melvin Lloyd Co.*, 315 U.S. 561 (1942), that the patent venue statute constituted the exclusive provision governing venue in a patent infringement case. And in its 1957 decision in *Fourco Glass Co. v. Transmirra Products Corp.*, 353 U.S. 222 (1957)—precedent that was ultimately key to the resolution of *TC Heartland*—the Supreme Court held that “resides” in section 1400(b) “refers only to the State of incorporation” and that section 1400(b) did not incorporate section 1391(c)'s definition of “residence.” The *Fourco* opinion expressly rejected the notion that the patent-specific venue statute dovetails with the general venue statute, concluding that section 1400(b) “is the sole and exclusive provision controlling venue in patent infringement actions” and is not supplemented by section 1391(c).

Decades after *Fourco*, Congress amended section 1391(c) to read, “For purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced.” Based on the “[f]or purposes of venue under this chapter” clause, the Federal Circuit concluded that the 1988 amendments superseded common-law definition of corporate residence and the *Fourco* holding. As a result, defendants accused of patent infringement could be sued wherever they had sales, effectively allowing patentees to bring suit in nearly any United States district court.

In *TC Heartland*, however, the Supreme Court disagreed with the Federal Circuit regarding the impact of the 1988 amendments to section 1391(c) on section 1400(b) and *Fourco*. Justice Thomas reasoned that *Fourco* “definitively and unambiguously held that” the reference to “resides” in section 1400(b) refers only to the state of incorporation. And since *Fourco* was decided, while Congress has amended the general venue statute, it has not amended section 1400(b). Further, Justice Thomas noted that “the current version of § 1391 does not contain any indication that Congress intended to alter the meaning of § 1400(b) as interpreted in *Fourco*.” Consequently, the Court concluded that the clear-statement rule of statutory interpretation, whereby courts look for a “relatively clear indication”

By restricting a plaintiff's venue options, the Supreme Court's *TC Heartland* decision will naturally reduce forum shopping and make patent-infringement suits more costly to file and maintain.

that Congress intended to change the meaning of a statute, mandated the Court's adherence to *Fourco*. Thus, the Court limited the venues in which patentees can bring infringement lawsuits against corporate defendants to their states of incorporation or

where the defendant has committed infringement and has a regular and established place of business.

By restricting a plaintiff's venue options, the Supreme Court's decision will naturally reduce forum shopping and make patent-infringement suits more costly to file and maintain. As described in the amicus briefs filed in *TC Heartland*, nearly 5,000 patent infringement cases are filed every year, and the new, more stringent venue requirements could decrease that number. The scourge of “troll” lawsuits—brought by patent-holding entities that do not actually practice the subject matter claimed in the patent—may be particularly affected. Before *TC Heartland*, patent-assertion entities could readily file suit against multiple corporate defendants in a favorable district and seek settlements from each for a sum less than the cost of litigation or even less than the cost of a motion to transfer venue, thus facilitating the undesirable practice of patent trolls forcing settlement on weak patents and meritless claims. Although Justice Thomas's opinion makes no mention of policy-based rationales such as this, curbing lawsuits would be a welcome outcome of the case to many stakeholders in the patent system. In response, litigants wishing to maintain the broad choices available under the Federal Circuit's rule will shift their focus to convincing courts to give the “regular and established place of business” prong of the venue rule a broad reading in trying to obtain the same pre-*TC Heartland* venues.

TC Heartland will likely also impact the concentration of patent cases in a few selected districts. Under the Federal Circuit's rule, patentees flocked to a handful of forums they perceived, whether justifiably or not, as patent friendly. Over the course of more than two decades under the broad understanding of corporate residence,

one jurisdiction in particular had become a well-known forum for patent plaintiffs to bring infringement suits, the Eastern District of Texas, in Marshall, Texas. The Supreme Court's decision may expose more district courts to patent cases, bringing additional views to bear on patent issues. At the same time, given the high concentration of incorporation in a few select states such as Delaware, the decision may simply shift the loci of the concentration of cases, rather than redistribute them more generally.

As a procedure-related decision that affects the filing of every patent lawsuit, *TC Heartland* is set to have a widespread impact on the patent system. The Court's decision turned on the "relatively clear indication" standard for determining whether subsequent legislative changes effectively overrule judicial opinions. In essence, the justices and Federal Circuit judges disagreed on how clear the indication was in this case. It will now require action by Congress to provide the necessary clarity the Court found lacking. Members of the House Judiciary Committee's intellectual property subcommittee are already studying the decision. In the meantime, the patent system is braced for change.

The Scope and Nature of the Patent Exhaustion Doctrine

In *Impression Products, Inc. v. Lexmark International, Inc.* (Docket No. 15-1189), the Supreme Court yet again shattered settled expectations by abolishing prior Federal Circuit precedent that allowed patentees to limit the doctrine of "patent exhaustion." Under this doctrine, when a patentee sells one of its products, its patent rights are said to "exhaust" and the purchaser and all subsequent owners are free to use or resell the product without fear of an infringement lawsuit. For the last two decades, however, the Federal Circuit's precedent allowed patentees to withhold certain patent rights from a sale through clearly disclosed lawful restrictions, thereby contracting around the exhaustion rule. In *Impression Products*, the Supreme Court concluded that such restraints on the alienation of personal property are contrary to well-established common-law principles and that the exhaustion doctrine, which reflects these principles, functions automatically to limit a patentee's rights upon an authorized sale. As a result of the Supreme Court's decision, accused infringers will have a broader exhaustion defense available to them, and certain patentees will be looking to contract law and/or complex licensing strategies to try to obtain the protection and control previously afforded by the Federal Circuit.

At issue in the underlying case were Lexmark's toner cartridges, which Lexmark makes and sells worldwide for use in laser printers. When the cartridges run out of toner, they can be refilled and used again. Impression Products is one of many companies, known as "remanufacturers," that acquire empty Lexmark cartridges from purchasers in the United States and abroad, refill them with toner, and resell them at a lower price than Lexmark's new cartridges.

In an attempt to curtail this kind of competition, Lexmark offered incentives to encourage its customers to return spent cartridges. Through its "Return Program," Lexmark would sell cartridges at a discounted price to customers that signed a contract agreeing to use the cartridges only once and to refrain from transferring the empty

cartridges to anyone but Lexmark. Not bound by the single-use/no-resale agreements with Lexmark's initial customers, Impression Products and others continued to acquire Return Program cartridges and use them in their resale business.

Lexmark, undeterred, sued Impression Products (and other remanufacturers that eventually fell out of the lawsuit) for patent infringement. Two groups of cartridges were at issue: (1) Return Program cartridges Lexmark sold in the United States under the post-sale restriction that Impression Products refurbished and resold in the United States; and (2) cartridges Lexmark sold outside the United States that Impression Products refurbished and imported into the United States for sale. Impression Products moved to dismiss with respect to both groups of products on the sole ground that Lexmark's sales, both within the United States and abroad, exhausted its patent rights in the cartridges. The district court granted Impression Products's motion as to the domestic Return Program cartridges but denied the motion as to the cartridges Lexmark sold outside the United States.

The Federal Circuit considered the issues en banc (*sua sponte*) and ruled for Lexmark on both groups of cartridges. For the Return Program products, the Federal Circuit relied on its prior decision in *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (1992), holding that a patentee may sell an item and retain enforceable patent rights through clearly communicated, lawful restrictions as to post-sale use or resale. For the cartridges

sold abroad, the Federal Circuit again relied on its own precedent, *Jazz Photo Corp. v. International Trade Commission*, 264 F.3d 1094 (2001), which held that a patentee's decision to sell a product outside the United States (where United States patent law does not apply and thus the patentee cannot charge a premium for its goods), did not exhaust the patentee's ability to bring an infringement suit against a buyer that imported and sold the product in the United States.

In a nearly unanimous decision (Justice Ginsburg dissented only as to the products sold abroad), the Supreme Court reversed. The Supreme Court rejected the Federal Circuit's limitations on the scope of patent exhaustion, concluding that "a patentee's decision to sell a product exhausts all of its patent rights in that item, regardless of any restrictions the patentee purports to impose or the location of the sale." The opinion, authored by Chief Justice Roberts, emphasized that patent rights must yield to the common-law principle against restraints on alienation. According to the Court, the Federal Circuit erred by viewing patent exhaustion as a "presumption" or "default rule" about the scope of patent rights flowing from a sale that parties are free to contract around. Rather, the Supreme Court explained, the exhaustion rule serves as a "uniform and automatic" limit on a patentee's right to exclude.

Consequently, when a patentee sells its product, it may not withhold selective patent rights from the buyer. The Supreme Court noted that the single-use/no-resale restrictions in Lexmark's customer contracts "may have been clear and enforceable under contract law," but they "did not entitle Lexmark to retain patent rights in an item that it has elected to sell." Citing pronouncements from Lord Coke

In *Impression Products, Inc.*, the Court concluded that when a patentee sells its product, it may not withhold selective patent rights from the buyer.

in the seventeenth century, the Court found that such conditional limitations on alienation are “obnoxious to the public interest.” The Court gave its rationale that “[p]atent exhaustion reflects the [common-law] principle that, when an item passes into commerce, it should not be shaded by a legal cloud on title as it moves through the marketplace.” The Court also made clear that, notwithstanding prior views to the contrary, a sale automatically transfers all patent rights to the buyer “because those are the rights that come with ownership” and the buyer “is free and clear of an infringement lawsuit because there is no exclusionary right left to enforce.”

With regard to the cartridges Lexmark sold abroad, the Supreme Court again disagreed with the Federal Circuit’s conclusion that patent exhaustion could be avoided. The Supreme Court held that “[a]n authorized sale outside the United States, just as one within the United States, exhausts all rights under the Patent Act.” The Court relied on its prior decision in *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519 (2013), which addressed international exhaustion in the context of copyright law and held that the first-sale doctrine applies to copies of a copyrighted work lawfully made and sold abroad. Because both patent exhaustion and the copyright-first sale doctrine have their roots in the antipathy toward restraints on alienation, the Court found that “[a]pplying patent exhaustion to foreign sales is just as straightforward” as the application of the first-sale rule in *Kirtsaeng* and dismissed Lexmark’s argument that certain differences between patent rights and copyright protections called for a different result. The Court explained that exhaustion occurs by virtue of a sale abroad because

“the patentee elects to give up title to an item in exchange for payment,” regardless of whether that payment reflects a premium for the right to access the American market. Returning to an emphasis on common-law principles, the Court admonished that “[a]llowing patent rights to stick remora-like to that item as it flows through the market would violate the principle against restraints on alienation.”

Justice Ginsburg concurred in the Court’s holding regarding domestic exhaustion but dissented with regard to international exhaustion. According to Justice Ginsburg, “[b]ecause a sale abroad operates independently of the U.S. patent system, it makes little sense to say that such a sale exhausts an inventor’s U.S. patent rights.” Justice Ginsburg dissented from the Court’s decision in *Kirtsaeng* concerning copyright but said that “even if I subscribed to *Kirtsaeng*’s reasoning,” the decision “should bear little weight” due to the substantive differences between patent law and copyright law.

The *Impression Products* decision is highly significant for companies that have historically relied on patent law to control downstream uses of their products or to minimize aftermarket competition, as well as for companies that sell patented products in foreign countries. While the decision deals with toner cartridges specifically, many other products are sold at preferential prices to special users and/or for special uses (e.g., equipment is often sold at a discount to universities “for research only” and pharmaceuticals are often sold at lower prices in poorer nations). Affected companies will be forced to rethink and restructure their pricing strategies, customer contracts, licensing arrangements, and other business practices. While the decision leaves the door open to enforce post-sale restraints via contract law, the parties to such contracts are typically limited and

do not include downstream buyers. The decision also distinguishes sales from licenses, stating that a “patentee can impose restrictions on licensees because a license does not implicate the same concerns about restraints on alienation as a sale.” The Court made clear that “[s]o long as a licensee complies with the license when selling an item, the patentee has, in effect, authorized the sale.” Creative lawyers may focus on these aspects to, for example, craft licenses that strategically limit what constitutes an authorized sale. Finally, the decision did not address the doctrine of “repair and reconstruction,” which may provide a patent infringement cause of action if a downstream purchaser goes beyond simply “repairing” an article and “reconstructs” the patented article; such a reconstructed product is generally considered new and infringing in its own right.

Conclusion

Given the Supreme Court’s keen interest in patent cases in recent years and the major impact of those decisions, it should come as no surprise that the Court continued to cause disruptions to the patent system this Term. The patent community has become accustomed to adjusting their practices, businesses, and courtrooms to align with Supreme Court decisions that affect the way patents are issued, evaluated, and litigated. Indeed, the trend is not likely to end anytime soon.

For the October 2017 Term, the Court has already agreed to hear two patent-related appeals, including one brought by Oil States Energy Services LLC (Docket No. 16-712) that asks whether *inter*

Next term, if the Court finds that *inter partes* review trials are unconstitutional, it would be one of the most significant patent decisions in decades.

partes review (IPR)—an extremely popular adversarial process established by the America Invents Act and used by the U.S. Patent and Trademark Office to analyze the validity of existing patents—violates the Constitution by extinguishing private property rights through a non-Article III forum without a jury. If the Court finds that IPR trials are unconstitutional, it would be one of the most significant patent decisions in decades. In addition to eliminating a system that has processed over 7,000 invalidity petitions to date and requiring that all future patent challenges be brought in district court, the ruling could spark numerous legal battles over all of the patents that have previously been deemed invalid through IPR. The patent community is bracing itself for more changes to come.



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